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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RONALD S. HENDERSON

Appeal 2017-010377
Application 14/152,579¹
Technology Center 2400

Before ALLEN R. MACDONALD, ADAM J. PYONIN, and
SHARON FENICK, *Administrative Patent Judges*.

PYONIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1, 3, 4, 9–12, and 14–24, which are all of the pending claims. *See* App. Br. 6. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellant, Ronald S. Henderson, is identified as the real party in interest. App. Br. 2.

STATEMENT OF THE CASE

The Application is directed to “storing, in a database of a computer, information pertaining to subscriptions of subscribers that have signed up to have their names displayed on a scrolling fan ticker during a sports broadcast,” and “providing to a television network a list of the names of the subscribers that are to be displayed on the scrolling fan ticker during the sports broadcast.” Abstract. Claims 1, 10, and 24 are independent. Claim 1 is reproduced below for reference (with formatting added):

1. A method comprising
 - storing in a database of a computer information pertaining to subscriptions of subscribers that have signed up to have the names of the subscribers displayed on a scrolling fan ticker during a sports broadcast,
 - providing to a television network a list of the names of the subscribers that are to be displayed on the scrolling fan ticker during the sports broadcast,
 - populating the database with information received from a sports organization pertaining to season ticket holders and offering the subscriptions only to the season ticket holders,
 - contacting the season ticket holders to offer subscriptions, wherein contacting the season ticket holders to offer subscriptions comprises at least one of the following:
 - e-mailing at least some of the season ticket holders,
 - text messaging at least some of the season ticket holders,
 - calling at least some of the season ticket holders using a telephone, and
 - mailing literature to at least some of the season ticket holders,
 - hosting a website that is used by subscribers to establish their subscriptions, and
 - providing on the website selectable fields for a plurality of sports organizations that are used by subscribers to establish their subscriptions.

Claims 1, 3, 4, 9–12, and 14–24 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. *See* Final Act. 3.

ANALYSIS

We have reviewed the Examiner’s rejection in light of Appellant’s arguments. We have considered in this Decision only those arguments Appellant actually raised in the Briefs. Any other arguments Appellant could have made but chose not to make are deemed waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). We are not persuaded of Examiner error; we adopt the Examiner’s findings and conclusions as our own, and we add the following for emphasis.

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted 35 U.S.C. § 101 to include an implicit exception: laws of nature, natural phenomena, and abstract ideas are not patentable. *See, e.g., Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014). The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” e.g., to an abstract idea. *Alice*, 134 S. Ct. at 2355. If the claims are directed to a patent-ineligible concept, the inquiry proceeds to the second step, where the elements of the claims are considered “individually and ‘as an ordered

combination” to determine whether there are additional elements that “transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1297).

I. Independent Claim 1

Appellant argues the Examiner’s rejection of independent claim 1 and dependent claims 3, 4, 9, and 19 is in error, because the “claims are not directed toward an abstract idea (i.e., a patent ineligible concept), and “the claims, as a whole, amount to significantly more than the [purported] abstract idea.” App. Br. 7. We select claim 1 as representative of this group, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(iv).

A. Alice Step One

Appellant argues the Examiner errs in “stat[ing] that the claims recite the abstract idea of ‘using advertising as an exchange wherein subscribers pay a premium to have content advertised’” (App. Br. 7), because “the present application makes a distinction between advertising and a scrolling fan ticker” (Reply Br. 3). Appellant argues that “a scrolling fan ticker is not considered to be advertising because the fans are simply demonstrating their loyalty to a sports entity and are not offering anything for sale.” Reply Br. 3.

We are not persuaded the Examiner’s determination, that claim 1 is directed to an abstract idea, is in error. *See* Final Act. 4. Appellant’s arguments refer to “advertising” as offering something “for sale,” and ignore the Examiner’s use of the term, as a “public notice” or the “action of making

generally known; a calling to the attention of the public.” Ans. 6–7 (quoting <http://www.dictionary.com/browse/advertisement>). We find the Examiner’s application of advertising to the characterization of the claim to be reasonable: claim 1 recites subscribers that have signed up to have their names displayed during a sports broadcast, which is an “advertisement” of their names. *See* Final Act. 3–4; Ans. 13. Thus we agree with the Examiner that claim 1 is directed to an abstract idea, as the idea of having subscribers pay a premium for their names to be called to the attention of the public is similar to concepts that have been found abstract. *See* Ans. 7; *see also, e.g., Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014); *Smartflash LLC v. Apple Inc.*, 680 F. App’x 977, 983 (Fed. Cir. 2017) (holding the “claims are directed to the abstract idea of ‘conditioning and controlling access to data based on payment’”); *NexusCard, Inc. v. Kroger Co.*, 173 F. Supp. 3d 462, 467 (E.D. Tex. 2016), *aff’d*, No. 2016-2074, 2017 WL 1908190 (Fed. Cir. 2017) (collecting customer information and membership discount programs); *Affinity Labs of Texas, LLC v. Amazon.com, Inc.*, 838 F.3d 1266, 1271 (Fed. Cir. 2016) (finding determining customizing a user interface to have targeted advertising based on user information is abstract).

Additionally, we do not find the use of the term “advertising,” with respect to the claims, to be dispositive. Appellant contends “[t]he ultimate aim of the independent claims of the present application is the provision of a ‘scrolling fan ticker’ on a ‘sports broadcast.’” App. Br. 8; *see also* Reply Br. 4 (“The scrolling fan ticker which is the subject of the claims of the present application is a narrowly tailored term which refers to very limited content (e.g., fan names) shown in very limited circumstances (e.g., a sports

broadcast).”). Displaying the names of subscribers, such as on a sports broadcast fan ticker, is an idea of itself, or a method of organizing human activity, that does not place a claim within the realm of patent eligibility.² Nor has Appellant shown the claimed scrolling fan ticker to be distinct, under *Alice*, from prior methods of publishing subscriber names. *See* Spec. ¶¶ 2–3 (describing known ways of publicly displaying subscriber information); *see also FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1094 (Fed. Cir. 2016) (merely implementing an old practice in a new environment is abstract).

We are also unpersuaded by Appellant’s contention that “[t]here is no attempt in the claims of the present application to constrain others from practicing the abstract idea of using advertising as an exchange,” thus “others would not be precluded or pre-empted from using advertising in exchange for a premium in light of the claims of the present application.” App. Br. 7. Preemption, however, is not the sole test for patent eligibility, and any questions on preemption in the instant case have been resolved by the above analysis. As our reviewing court has explained: “questions on preemption are inherent in and resolved by the § 101 analysis,” and, although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”

² We find displaying subscriber names to be similar to claims our reviewing court has found abstract. *See, e.g., EasyWeb Innovations, LLC v. Twitter, Inc.*, 2017 WL 1969492, 2 (Fed. Cir. 2017); *see also Elec. Power Grp. LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent-ineligible concept”).

Ariosa Diagnostics, Inc. v. Sequenom, Inc., 788 F.3d 1371, 1379 (Fed. Cir. 2015); *cf. OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”).

Accordingly, we agree with the Examiner that claim 1 is directed to an abstract idea. See Ans. 3–7.

B. Alice Step Two

Appellant argues that, “[e]ven if the claims are directed toward an abstract idea, the claims, as a whole, amount to significantly more than the abstract idea.” App. Br. 8 (emphasis omitted). Particularly, Appellant contends the aim of claim 1, “[h]aving a scrolling fan ticker during a sports broadcast on which subscribers’ names appear[,] is not well-understood or conventional or routine,” because “[i]f it were, the examiner could find it in the prior art.” App. Br. 8–9. Appellant elaborates that, “while scrolling tickers on sports broadcasts may be known, . . . [o]ffering subscriptions may be known,” and “[h]osting a website may be known,” what is not known is the ordered combination of claim 1: “[scrolling tickers on sports broadcasts] dedicated to displaying the names of subscribing fans, including only the names of season ticket holders,” “offering subscriptions to people (only season ticket holder in claim 1) to have their names displayed on a scrolling fan ticker,” and “hosting [a website] for people to subscribe to have their names included on a scrolling fan ticker of a sports broadcast.” App. Br. 9.

We are not persuaded the Examiner errs in finding “whether taken individually or together as an ordered combination, the claim elements fail

to transform the claimed abstract idea into a patent-eligible application.”
Advisory Act. 2. Appellant does not challenge the Examiner’s evidence, or present sufficient reasoning, to show the Examiner errs in finding the claim elements are well-understood, routine, and conventional to a skilled artisan. *See* Ans. 10–11, citing (at n.26) US Patent No. 7,774,815 B1, iss. Aug. 10, 2010 (“Context-Sensitive Interactive Television Ticker”); US 2011/0296476 A1, publ. Dec. 1, 2011 (“Systems And Methods For Providing A Social Mashup In A Content Provider Environment”); Spec. ¶¶ 2–3, 33.

Further, we agree with the Examiner that claim 1 does not provide a technical benefit; rather the claim recites “the performance of some business practice known from the pre-Internet world (i.e., subscribers advertising during sports broadcasts) along with the requirement to perform it on the Internet.” Ans. 13; *see also* Spec. 2–3; *Alice*, 134 S. Ct. at 2359 (finding claims do not recite significantly more when the “claims do not, for example, purport to improve the functioning of the computer itself”); *compare Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1351 (Fed. Cir. 2016) (“the claimed invention represents a ‘software-based invention[] that improve[s] the performance of the computer system itself”).

Accordingly, we agree with the Examiner that independent claim 1 does not include elements that transform the nature of the claim into a patent-eligible application. *See* Ans. 7–14. We sustain the Examiner’s rejection of claim 1, and claims 3, 4, 9, and 19.

II. Independent Claims 10 and 24

Appellant argues the Examiner’s rejection of independent claim 10 is in error, for the same reasons as presented for independent claim 1, and also because claim 10 additionally “requires two classes of subscriptions for the scrolling fan ticker, namely, a ‘general subscription’ and a ‘premium subscription,’” which is “more costly than the general subscription.” App. Br. 10–11. “More importantly,” according to Appellant, “claim 10 requires that a larger area on the scrolling fan ticker is occupied for each of the premium subscriptions than each of the general subscriptions.” App. Br. 11. Appellant presents similar arguments for independent claim 24, and quotes further limitations from this claim. *See* App. Br. 15–16.

We are not persuaded the Examiner errs in finding claim 10 is unpatentable pursuant to the two step *Alice* analysis. *See* Ans. 15–16. Appellant does not challenge the Examiner’s findings in the Answer. Nor do Appellant’s statements in the Appeal Brief show how the disputed limitations, which are directed to benefits for classes of subscribers, are anything more than the abstract idea encompassed by independent claim 1, or transform the nature of the claim into a patent-eligible application. Accordingly, we sustain the Examiner’s rejection of independent claim 10, and independent claim 24 for similar reasons. *See* Ans. 27–30.

III. Dependent Claims 11, 12, 14–18, 20, and 21–23

For each of the remaining claims, Appellant quotes the respective claim limitations, and states the Examiner’s “conclusory, boilerplate

sentences cannot possibly be considered a sufficient examination of the particularly recited limitations.” App. Br. 11–14.

We are not persuaded the Examiner errs. We find the Examiner has provided a thorough analysis of each of the argued dependent claims, which we incorporate herein. *See* Ans. 16–27. Appellant does not challenge this analysis. Thus, we find Appellant has been notified of the reasons for the rejection with such information “as may be useful in judging of the propriety of continuing the prosecution of [the] application,” as required. *In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (alteration in original) (quoting 35 U.S.C. § 132). Accordingly, we sustain the Examiner’s rejection of claims 11, 12, 14–18, 20, and 21–23.

DECISION

The Examiner’s decision rejecting claims 1, 3, 4, 9–12, and 14–24 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED