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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ABHISHEK KUMAR

Appeal 2017-010383
Application 12/711,565
Technology Center 3600

Before ERIC S. FRAHM, JASON J. CHUNG, and JOYCE CRAIG,
Administrative Patent Judges.

CRAIG, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 22–42, which are all of the claims pending in this application.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellant, the real party in interest is YAHOO! INC. App. Br. 2.

² Claims 1–21 have been canceled. *See* App. Br. 14 (Claims App'x).

INVENTION

Appellant's invention relates to serving localized advertisements.

Abstract. Claim 22 is illustrative and reads as follows:

22. A method, comprising:

generating, by a web server, browser code executable by a browser to cause the browser to perform operations including:

displaying a web page including search results, the search results including a sponsored search result that includes a graphical element that indicates an interactive user interface;

communicating a user selection of the graphical element to the web server;

in response to the selection of the graphical element, displaying the interactive user interface in a pop-up window that overlaps at least part of the search results;

the interactive user interface displaying a form for reserving a service of a service provider, the form including a user input field to receive a desired time period of the service;

the interactive user interface communicating at least a request to reserve the service and the desired time period to a database associated with service provider; and

the interactive user interface displaying verification of the reservation and the desired time period, the verification received from the database via the web server.

REJECTIONS

Claims 22–42 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to a judicial exception, without significantly more. Final Act. 3–6.

Claims 22–42 stand rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over the combination of Heyraud et al. (US 2008/0319803 A1;

published Dec. 25, 2008) (“Heyraud”) and Greene et al. (US 2007/0192186 A1; published Aug. 16, 2007) (“Greene”). Final Act. 7–13.

ANALYSIS

Rejection of Claims 22–42 under 35 U.S.C. § 101

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101.

However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[I]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). Concepts determined to be patent eligible include physical and chemical processes,

such as “molding . . . rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 193 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1853))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 176; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.” (emphasis omitted)).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (internal quotation marks omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to

monopolize the [abstract idea].” *Id.* (alterations in original)(quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of § 101. 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (hereinafter “2019 Guidance”). Under that guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)) (9th ed. 2018).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

- (3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or
- (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See 2019 Guidance. Patent eligibility under 35 U.S.C. § 101 is a question of law that is reviewable de novo. *See Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012).

Here, the Examiner concluded the claims are abstract because the claims are directed to abstract idea of “providing an interactive user interface in a pop up window.” Final Act. 3 (emphasis omitted).

Appellant contends the Examiner erred because “[t]he claims as a whole recite more than the oversimplification provided by the Final Office

Action” and “overcome technical problems related to computer and network specific ways of displaying information in a graphical user interface.” *Id.* at 5.

Alice Step One – Judicial Exception

In Step One of the *Alice* analysis, according to the 2019 Guidance, we first evaluate whether the claim recites a judicial exception. For abstract ideas, we determine whether claims recite mathematical concepts, certain methods of organizing human activity, or mental processes.

Claim 22 recites:

[the interactive user interface] displaying a form for reserving a service of a service provider, the form including a user input field to receive a desired time period of the service;

[the interactive user interface] communicating at least a request to reserve the service and the desired time period to a database associated with service provider; and

[the interactive user interface] displaying verification of the reservation and the desired time period, the verification received from the database via the web server.

We conclude that these limitations recite a method of organizing human activity. In particular, claim 22 is directed to the commercial interaction of processing reservations (“reserving the services of a service provider” for “a desired time period”).

Because we conclude the independent claims recite an abstract idea, we proceed to Prong Two to determine whether the claims are “directed to” the judicial exception.

Step 2A, Prong Two -- Practical Application

If a claim recites a judicial exception, we determine whether the recited judicial exception is integrated into a practical application of that

exception by: (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application. If the recited judicial exception is integrated into a practical application, the claim is not directed to the judicial exception.

Here, claim 22 recites the additional elements of:

generating, by a web server, browser code executable by a browser to cause the browser to perform operations including:

displaying a web page including search results, the search results including a sponsored search result that includes a graphical element that indicates an interactive user interface;

communicating a user selection of the graphical element to the web server;

in response to the selection of the graphical element, displaying the interactive user interface in a pop-up window that overlaps at least part of the search results;

Although the claimed browser is used to facilitate reservations, its functions go beyond those of a general purpose computer for merely organizing, storing, and transmitting information.

Considering claims 22, 29, and 36 as a whole, the additional elements apply or use the abstract idea in a meaningful way such that the claims as a whole are more than a drafting effort designed to monopolize the exception. For example, claim 22 recites that, in response to the selection of a graphical element, the interactive user interface is displayed in a pop-up window that overlaps at least part of the search results.

Claims 29 and 36 recite similar limitations. Claim 29 recites:

in response to user selection of the graphical element, communicating, by the web server,

data defining the interactive user interface, the interactive user interface located in a pop-up window that overlaps at least part of the search results, the interactive user interface including multiple tabs, including a first tab for selecting displaying of an image of an aspect of the service within the interactive user interface and a second tab for selecting displaying of a form for reserving the service within the interactive user interface, and the form including a user input field to receive a desired time period of the service;

Claim 36 recites:

in response to the user selection of the link, communicate data defining the interactive user interface to the web browser; and

a pop-up window executable by the web server, the pop-up window configured to:

render the interactive user interface within the pop-up window;

overlap at least part of the search results; and

display multiple tabs, the multiple tabs including a first tab for selecting displaying graphical information on the service within the pop-up window and a second tab for selecting displaying of a form for reserving the service within the pop-up window, the form including a user input field configured to receive a desired time period of the service and the form also including, in response to receiving the desired time period and the desired time period being verified, an output field configured to display verification of the reservation at the desired time period.

Because claims 22, 29, and 36 integrate the recited judicial exception into a practical application, the claims are not “directed to” a judicial exception and, therefore, our inquiry ends. Stated another way, we need not discuss whether the present claims are significantly more than any abstract idea under step 2B.

For these reasons, under the 2019 Guidance, we are persuaded that the

Examiner erred in concluding claims 22, 29, and 36 are judicially-excepted from patentability, and we reverse the Examiner's § 101 rejection of independent claims 22, 29, and 36.

Accordingly, we do not sustain the Examiner's § 101 rejection of independent claims 22, 29, and 36, or of dependent claims 23–28, 30–35, and 37–42, which stand with the claims from which they depend.

Rejection of Claims 22–42 under 35 U.S.C § 103(a)

We have reviewed the § 103(a) rejection of claims 22–42 in light of Appellant's arguments that the Examiner erred. 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, in the Briefs are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Appellant's arguments are not persuasive of error. We agree with and adopt as our own the Examiner's findings of facts and conclusions as set forth in the Answer and in the Action from which this appeal was taken. We provide the following explanation for emphasis.

Claims 22–28

With respect to independent claim 22, Appellant contends the cited portions of Heyraud do not teach or suggest the limitation “in response to the selection of the graphical element, displaying the interactive user interface in a pop-up window that overlaps at least part of the search results.” App. Br. 9. Appellant argues that Figure 1 of Heyraud “illustrates a pop-up window on a map, but does not illustrate, describe or suggest that the window overlaps the search results as claimed.” *Id.*

We are not persuaded that the Examiner erred. The Examiner interpreted “displaying the interactive user interface in a pop-up window that

overlaps at least part of the search results” as broad enough to encompass displaying the pop up user interface “on top of the page that the search results are on.” Ans. 7–8. Appellant has not persuasively rebutted the Examiner’s interpretation. In the Reply Brief, Appellant argues “[t]he Answer is attempting to rewrite the claims in view of the specification,” but nowhere does Appellant argue the Examiner’s interpretation is overly broad, unreasonable, or inconsistent with the Specification.³

Appellant next contends the cited portions of Greene and Heyraud fail to teach or suggest the limitation

[t]he interactive user interface communicating at least a request to reserve the service and the desired time period to a database associated with service provider; and the interactive user interface displaying verification of the reservation and the desired time period, the verification received from the database via the web server.

App. Br. 9. Appellant argues “the confirmation of Greene is not a ‘pop up interactive user interface’ as claimed, but is clearly an entire web page.” *Id.* at 10. Appellant further argues “the combination fails to disclose that the user interface is interactive as claimed.” *Id.*

We are not persuaded that the Examiner erred. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Appellant attacks Greene individually, even though the Examiner relied on the combination of Heyraud and Greene in rejecting claim 22. *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981))

³ We give the claim its broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

(“The test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art.”).

Here, the Examiner found Heyraud teaches the “interactive user interface” in Figure 1. Ans. 8–9. We agree with the Examiner’s finding that Greene’s reservation confirmation (*see* Greene Fig. 21), when combined with the cited teachings of Heyraud, teaches or suggests the disputed limitation.

For these reasons, we are not persuaded that the Examiner erred in finding that the combination of Heyraud and Greene teaches or suggests the disputed limitations of claim 22. Accordingly, we sustain the Examiner’s § 103(a) rejection of independent claim 22. We also sustain the Examiner’s § 103(a) rejection of dependent claims 23, 24, 27, and 28, not argued separately with particularity.

Appellant argues the combination of Heyraud and Greene fails to teach or suggest “[a first] tab[] for selecting displaying of the video on the service and a second tab for selecting displaying of the form,” as recited in dependent claim 25. App. Br. 10. Appellant further argues the cited prior art fails to teach or suggest “a third tab for selecting providing of general information on the service provider,” as recited in claim 26. *Id.* In addition to the arguments made for claim 22, discussed above, Appellant argues that, to the extent Greene teaches multiple tabs, they are tabs on a web page as opposed to a “pop up window interface.” *Id.*

Appellant’s arguments are not persuasive. Appellant again attacks Greene individually, even though the Examiner relied on the combined teachings of Heyraud and Greene in rejecting claims 25 and 26. *See Mouttet*, 686 F.3d at 1332.

For these reasons, we sustain the Examiner's § 103(a) rejection of dependent claims 25 and 26.

Claims 29–42

Appellant makes similar arguments for claims 29–42 (App. Br. 11–12), which we find unpersuasive for the reasons discussed above for claims 22–29.

Accordingly, we sustain the Examiner's § 103(a) rejection of independent claims 29 and 36, as well as dependent claims 30–35 and 37–42.

DECISION

We reverse the Examiner's decision rejecting claims 22–42 under 35 U.S.C. § 101.

We affirm the Examiner's decision rejecting claims 22–42 under 35 U.S.C. § 103(a).

Because we affirm at least one ground of rejection with respect to each claim on appeal, the Examiner's decision rejecting claims 22–42 is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED