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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL SULLIVAN, PAUL CALENTO,
and MILES DENNISON

Appeal 2017-010827
Application 14/218,807
Technology Center 3600

Before ALLEN R. MacDONALD, JON M. JURGOVAN, and
MICHAEL J. ENGLE, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL¹

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 12, 13, and 16–28. Appellants have cancelled claims 1–11, 14, and 15. App. Br. 30–31. We have jurisdiction under 35 U.S.C. § 6(b).

¹ Appellants indicate the real party in interest is ADPARLOR MEDIA, INC. App. Br. 4.

We REVERSE the rejection under 35 U.S.C. § 101. We AFFIRM the rejection under 35 U.S.C. § 103.

Illustrative Claim

Illustrative claim 12 under appeal reads as follows (emphasis, formatting, and bracketed material added):

12. A system comprising:

[A.] one or more first computing devices configured[:]

[i)] **to maintain a database of indices** associated with one or more video objects associated with a website of a plurality of web sites and

[ii)] **to provide**, in real-time, **index data associated with a website** to a real-time data exchange system that provides contents associated with the index data to the website page in response to a user access of the website page,

wherein each of the indices comprises[:]

[i)] one or more classifications of the one or more video objects and

[ii)] properties associated with the video presentation; and

[B.] one or more second computing devices **executing a web crawler**, wherein the one or more second computing devices are configured to:

i) access the plurality of web sites, including the website,

ii) perform a virtual rendering of a video object on each of the plurality of websites, wherein the virtual rendering of the video object comprises a full DOM (Document Object Model) object of the webpage, including layout and plugin associated therewith, the DOM object being fully rendered to memory of the one or more second computing devices,

- iii) *identify characteristics of each video object* as rendered, wherein the identifiable characteristics *include presence of one or more attributes* from a list of attributes used for filtering by the real-time data exchange system, and
- iv) *store in the database characteristics of the video*, including the one or more classifications of the one or more video objects and the properties associated with the video presentation, as the index data to be retrieved in association with access of the website by a given user.

References²

Koopmans et al.	US 2012/0030212 A1	Feb. 2, 2012
Tuttle et al.	US 2013/0066848 A1	Mar. 14, 2013

Rejections³

A.

The Examiner rejected claims 12, 13, and 16–28 under 35 U.S.C. § 101 “because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more,” i.e., because the claimed invention is directed to patent-ineligible subject matter. Final Act. 2–3.

We select claim 12 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv). Appellants do not separately argue claims 13 and 16–28. Except for our

² All citations herein to these references are by reference to the first named inventor only.

³ All citations to the “Final Action” are to the Final Action mailed on August 31, 2016.

ultimate decision, we do not discuss the § 101 rejection of claims 13 and 16–28 further herein.

B.

The Examiner rejected claims 12, 13, 18, 19, 21, and 23–28 under 35 U.S.C. § 103 as being unpatentable over the combination of Tuttle and Koopmans. Final Act. 4–7.

We select claim 12 as representative. Appellants do not separately argue claims 13, 18, 19, 21, and 23–28. Except for our ultimate decision, we do not discuss the § 103 rejection of claims 4–8, 10, 11, and 13–18 further herein.

C.

The Examiner rejected claims 14, 16, 17, 20, and 22 under 35 U.S.C. § 103 as being unpatentable over Tuttle and Koopmans in numerous combinations with other references. Final Act. 7–9.

Appellants do not present separate arguments for claims 14, 16, 17, 20, and 22. Thus, the rejections of these claims turn on our decision as to claim 12. Except for our ultimate decision, we do not discuss the § 103 rejections of claims 14, 16, 17, 20, and 22 further herein.

Issues on Appeal

Did the Examiner err in rejecting claim 12 as being directed to patent-ineligible subject matter?

Did the Examiner err in rejecting claim 12 as being obvious?

ANALYSIS

A. Section 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: “[l]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, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 192 (1981)); “tanning, dyeing, making waterproof cloth, vulcanizing India

rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); 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 187; *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.* (citation omitted) (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.”).

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 (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.*

B. *USPTO § 101 Guidance*

The United States Patent and Trademark Office (USPTO) recently published revised guidance on the application of § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (“Memorandum”). Under that guidance, we first look to whether the claim recites:

- (1) (*see* Memorandum Step 2A – Prong One) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human interactions such as a fundamental economic practice, or mental processes); and
- (2) (*see* Memorandum Step 2A – Prong Two) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).⁴

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 We acknowledge that some of these considerations may be properly evaluated under Step 2 of *Alice* (Step 2B of Office guidance). Solely for purposes of maintaining consistent treatment within the Office, we evaluate it under Step 1 of *Alice* (Step 2A of Office guidance). *See* USPTO’s January 7, 2019 Memorandum, “2019 Revised Patent Subject Matter Eligibility Guidance.”

(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 Memorandum Step 2B.

C. Requirement to Provide Sufficient Articulated Reasoning

The requirement that the Examiner must provide a proper notice of rejection is set forth by 35 U.S.C. § 132:

Whenever, on examination, any claim for a patent is rejected, . . . the Director shall notify the applicant thereof, stating the reasons for such rejection . . . together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application.

The Federal Circuit has held that the Office carries its procedural burden when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (brackets in original, quoting 35 U.S.C. § 132).

Put simply, the Office is required to set forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. *Id.*; see also *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (noting that § 132 “is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection”).

D. *Examiner's § 101 Rejection - Alice/Mayo - Step 1
Memorandum Step 2A – Prong One*

Applying step 1 of the *Alice/Mayo* analysis, the Examiner concludes claim 1 is directed to an abstract idea.

Claim 12 is directed to maintaining indices, a web crawler that accesses websites/performs a DOM virtual rendering of website video objects/saving video data, which is considered to be drawn to the abstract idea.

Final Act. 2 (emphasis added). The Examiner cites *SmartGene* and *Cyberfone* as examples of an abstract idea. Final Act 2.

E. *Appellants' § 101 Arguments*⁵

Appellants contend “claim 12 is patentable under 35 U.S.C. § 101(a) as the claim is (1) not ‘directed to’ any judicial exception.” App. Br. 10.

Appellants particularly contend:

[T]he test on the first prong of Alice is not whether an invention uses an abstract concept, but whether the claim *is directed to* an abstract concept. Appellants respectfully submit[] that the claims set for a specific *manner* of “maintaining indices, a web crawler that accesses websites/performs a DOM virtual rendering of website video objects/saving video data,” ***which is not an abstract idea.***

App. Br. 11 (emphasis added).

F. *Panel's § 101 Analysis*

We agree with Appellants' argument. We conclude that when evaluated under the Memorandum, the claim limitations of claim 12 do not recite a judicial exception in the form of one of the three abstract ideas

⁵ The contentions we discuss herein are determinative as to the § 101 rejection on appeal. Therefore, we do not discuss Appellants other § 101 contentions herein.

enumerated in the Memorandum. We do not sustain the rejection under 35 U.S.C. § 101 of claim 12.

G. Appellants' § 103 Arguments

We have reviewed the Examiner's § 103 rejections in light of Appellants' Appeal Brief arguments that the Examiner has erred. We disagree with Appellants. Except as noted below, we adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief arguments. We concur with the conclusions reached by the Examiner. We highlight the following points.

G.1.

Appellants raise the following argument in contending that the Examiner erred in rejecting claim 12 under 35 U.S.C. § 103(a).

The Final Office Action's sole rationale for obvious[ness] of independent claim 12 is that . . . it would have been obvious for someone skilled in the art at the time of the invention to "modify Tuttle's [*sic*] features of Claim 12, with Kookman's [*sic*] feature of Claim 12, since indexes *can be used* to identify requested content entry – Koopmans['] abstract." *See Final Office Action* at p 5 (emphasis added). . . . In other words, the rationale merely alleges that that a person skilled in the art would have understood that the references could be combined. But said rationale is not enough to support a finding of obviousness.

Appellant[s] respectfully assert[] that the rejection's reasoning is deficient in its finding that a relevant skilled artisan **would have been motivated to combine** the references in the way claimed. The Final Office Action is silent as to how or why one **would have been motivated** to make the claimed invention. Moreover, the rejection is entirely silent regarding whether one

would have a reasonable expectation of success making the combination.

App. Br. 22–23 (emphasis added).

We disagree. We conclude the combination of Tuttle’s indexing process and Koopmans real-time indexing is the mere substitution of one existing real-time indexing process for another existing indexing process without any change in the real-time indexing, i.e., yielding predictable results.

Appellants fail to cite or address *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). In *KSR*, the Supreme Court stated that “[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation.” *Id.* at 419. The Court also observed that an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418.

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

KSR, 550 U.S. at 417.

Appellants have not presented evidence sufficient to show that combining the prior art was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior

art.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418–19).

G.2.

Further, Appellants raise the following argument in contending that the Examiner erred in rejecting claim 12 under 35 U.S.C. § 103(a).

[T]here is no proper combination to teach or suggest “identify characteristics of each video object as rendered, wherein the identifiable characteristics include *presence* of one or more attributes from a list of attributes used for filtering by the real-time data exchange system.”

App. Br. 25 (emphasis omitted).

[P]ara. [0073] of Tuttle . . . merely provides that “attributes” are queried. As discussed above, *these attributes are information* of video data record 19 such as “title, description, URL, genre, video runtime or length, bit rate, date, and the like”, which are *not “presence of one or more attributes* from a list of attributes used for filtering,” as recited in the instant claims.

App. Br. 27 (emphasis omitted).

We are not persuaded by Appellants’ argument. Appellants are simply mistaken as Tuttle does identify the “presence” of certain information.

Specifically, some embodiments of the present invention provide a crawler that does not just parse text in an HTML file and inspect the contents for links indicating the *presence* of a video file.

Tuttle ¶ 18 (emphasis added). We read this to state that inspecting for “presence” is a known function of a web crawler, upon which Tuttle improves. Further, Tuttle states:

[T]he essence of the present invention may be viewed as crawling 70 and indexing 72 the object model of multiple running, instantiated documents or applications. Again, this may occur on an Internet scale and crawling may include traversing pages, files, documents, or applications of different machines. These pages, files, documents, or applications are instantiated

prior to inspection of clickable items to more thoroughly *inspect* each *for available content and/or metadata*.

Tuttle ¶ 128 (emphasis added). We understand inspecting for availability to at a minimum, include or strongly suggest determining the presence of the content/metadata.

CONCLUSIONS

(1) Appellants have established that the Examiner erred in rejecting claims 12, 13, and 16–28 under 35 U.S.C. § 101, as being directed to patent-ineligible subject matter.

(2) The Examiner has not erred in rejecting claims 12, 13, and 16–28 as being unpatentable under 35 U.S.C. § 103.

(3) Claims 12, 13, and 16–28 are not patentable.

DECISION

The Examiner’s rejection of claims 12, 13, and 16–28 under 35 U.S.C. § 101, as being directed to patent-ineligible subject matter, is **reversed**.

The Examiner’s rejections of claims 12, 13, and 16–28 as being unpatentable under 35 U.S.C. § 103 are **affirmed**.

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner’s decision 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).

AFFIRMED