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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* VAUGHAN THOMAS ESPREY<sup>1</sup>

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Appeal 2017-011218  
Application 13/158,355  
Technology Center 3600

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Before JAMES R. HUGHES, JASON J. CHUNG, and  
BETH Z. SHAW, *Administrative Patent Judges*.

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134(a) of the Examiner’s decision rejecting claims 1, 4, 6–8, 10–16, and 18–25. Claims 2, 3, 5, 9, and 17 have been canceled.<sup>2</sup> Final Act. 1–2; Appeal Br. 3.<sup>3</sup> We have jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> Illinois Tool Works Inc. (“Appellant”) is the applicant as provided in 37 C.F.R. § 1.46 and is identified as the real party in interest. Appeal Br. 2.

<sup>2</sup> The Examiner includes canceled claim 9 in the pending claims. *See* Final Act. 1–2. We find this typographical error harmless.

<sup>3</sup> We refer to Appellant’s Specification (“Spec.”) filed June 10, 2011; Appeal Brief (“Appeal Br.”) filed Mar. 13, 2017; and Reply Brief (“Reply Br.”) filed Aug. 30, 2017. We also refer to the Examiner’s Final Office

We affirm.

*Appellant's Invention*

The invention relates generally “an advertisement generating system, more particularly to an advertisement generating system adapted for a point-of-sale or a service point apparatus such as a weighing scale” (Spec. ¶ 2). See Spec. ¶¶ 6–16; Abstract.

*Representative Claim*

Independent claim 1, reproduced below, further illustrates the invention:

1. An advertisement generating system, comprising:
  - a product related database of product related data;
  - a promotional database of promotional data; and
  - a client device comprising:
    - an input device configured to receive one or more user selections relating to the product related data and the promotional data; and
    - a controller operable to permit selection of the promotional data from the promotional database based at least in part on the one or more user selections received via the input device, to access the product related database for selection of the product related data based at least in part on the one or more user selections received via the input device, to provide correlation of the product related data and the promotional data based at least in part on the one or more user selections received via the input device, to output the product related data and the promotional data on a background template in the form of an advertisement via a display unit of the client device, and to communicate the advertisement to one or more other client devices communicatively coupled to the client device via a network,

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Action (“Final Act.”) mailed Oct. 13, 2016; and Answer (“Ans.”) mailed June 30, 2017.

wherein the advertisement comprises a plurality of data types or layers superimposed on the background template.

*Rejections on Appeal*

1. The Examiner rejects claims 1, 4, 6–8, 10–16, and 18–25 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. *See* Final Act. 3–6.

2. The Examiner rejects claims 1, 4, 6–8, 10–16, and 18–25 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Schuller et al. (US 2004/0211600 A1, published Oct. 28, 2004) (“Schuller”), Evans (US 2010/0324997 A1, published Dec. 23, 2010), and Isomura et al. (US 2006/0078173 A1, published Apr. 13, 2006) (“Isomura”). *See* Final Act. 7–18.

ISSUES

Based upon our review of the record, Appellant’s contentions, and the Examiner’s findings and conclusions, the issues before us follow:

1. Did the Examiner err in finding Appellant’s claims were directed to patent-ineligible subject matter under 35 U.S.C. § 101?
2. Did the Examiner err in determining that the combination of Schuller, Evans, and Isomura would have collectively taught or suggested “a controller operable” “to communicate the advertisement to one or more other client devices communicatively coupled to the client device via a network, wherein the advertisement comprises a plurality of data types or layers superimposed on the background template” within the meaning of Appellant’s claim 1 and the commensurate limitations of claim 16?
3. Did the Examiner err in determining that the combination of Schuller, Evans, and Isomura would have collectively taught or suggested “a

controller operable” “to wirelessly push the advertisement to one or more client devices communicatively coupled to the client device via a wireless communication network” as recited in Appellant’s claim 25?

4. Did the Examiner err in determining that the combination of Schuller, Evans, and Isomura would have collectively taught or suggested the additional features recited in Appellant’s claims 20 and 24?

## ANALYSIS

### *Patent-Ineligible Subject Matter Rejection*

The Examiner rejects claims 1, 4, 6–8, 10–16, and 18–25 as a group based on claim 1 (*see* Final Act. 3–6) and concludes claim 1 is directed to patent-ineligible subject matter in that claim 1 is “directed to the abstract idea of generating advertisements through correlation of product and promotional data and outputting advertisements.” Final Act 4. The Examiner also concludes the claims “do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional computer elements, which are recited at a high level of generality, provide conventional computer functions that do not add meaningful limits to practicing the abstract idea.” Final Act. 4; *see* Final Act. 5–6. The Examiner expands on these findings and conclusions in the Examiner’s Answer. *See* Ans. 4–7.

Appellant contends the Examiner erred in rejecting the claims as being directed to patent-ineligible subject matter. *See* Appeal Br. 5–13; Reply Br. 2–9. Specifically, Appellant contends “the present claims do not recite abstract ideas” (Appeal Br. 7 (emphasis omitted)) and the claims neither fall within the categories nor are the claims similar to any examples

provided within the USPTO's subject matter eligibility guidance (*see* Appeal Br. 8–10; Reply Br. 3–6). Appellant further contends the claims are “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks” (Appeal Br. 9 (quoting *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014)) and “the present claims are directed to technology specific to solving an Internetcentric problem of expending time and effort experienced by users for generating advertisements,” and “are related to overcoming a problem specifically arising in the realm of computer networks” similar to *DDR Holdings* (Appeal Br. 10). *See* Appeal Br. 9–10; Reply Br. 5–6.

Appellant also reiterates the limitations of claim 1 (*see* Appeal Br. 12) and contends “the combination of features recited by the present claims amount to significantly more than the alleged abstract ideas themselves” (Appeal Br. 10 (emphasis omitted)), as well as “the present claims include meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment” (Appeal Br. 11 (emphasis omitted)). Additionally, Appellant cites *Google Inc. v. SimpleAir, Inc.*, CBM 2014-00170, 2015 WL 331089 (Jan. 22, 2015) (“*Google*”) as supporting the position that the claims “provide unconventional steps that confine the abstract idea to a particular useful application, and thus recites patent eligible subject matter.” Appeal. Br. 12.

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable *Alice Corp. Pty.*

*Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014) (quoting *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

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, 77–80 (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*, 573 U.S. at 217. Assuming that a claim nominally falls within one of the statutory categories of machine, manufacture, process, or composition of matter, the first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts” (*id.*), e.g., to an abstract idea. *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, but are not limited to, 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)).

If the claims are not directed to an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step of the *Alice* and *Mayo* framework where the elements of the claims are considered “individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible

application.” *Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 78–79). This second step is described as “a search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘. . . significantly more than . . . the [ineligible concept] itself.’” *Id.* at 217–218 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73). “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].’” *Alice*, 573 U.S. at 221 (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 Court acknowledged in *Mayo* that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

The PTO recently published revised guidance on the application of § 101. USPTO’s *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (hereinafter “2019 Revised 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) (hereinafter “Step 2A, prong 1”); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)) (hereinafter “Step 2A, prong 2”).

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 § 106.05(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.<sup>4</sup>

*See* 2019 Revised Guidance.

#### Eligibility Analysis—Revised Guidance Steps 1 and 2A, Prong 1

Turning to the first step of the eligibility analysis, “the first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish*, 822 F.3d at 1335–36. “The abstract idea exception prevents patenting a result where ‘it matters not by what process or machinery the result is accomplished.’” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 113 (1853)).

The Examiner determines independent claim 1 is directed to the abstract idea of “generating advertisements through correlation of product and promotional data and outputting advertisements” (Final Act. 4; *see* Ans. 4–5), similar to cases involving data comparisons that can be performed mentally—“comparing new and store information and using rules to identify

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<sup>4</sup> Items (3) and (4) are collectively referred to as “Step 2B” hereinafter and in the 2019 Revised Guidance.

options” (Final Act. 4; *see SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 F. App’x 950, 954-55 (Fed. Cir. 2014))—and organizing or analyzing information in a way that can be performed mentally— “organizing, categorizing, storing and transmitting information” (Final Act. 4; *see Cyberfone Sys., LLC v. CNN Interactive Grp., Inc.*, 558 F. App’x 988, 992 (Fed. Cir. 2014). *See* Final Act. 4; Ans, 4–5. Here, in rejecting the claims (in particular claim 1) under 35 U.S.C. § 101, the Examiner analyzed the claims using the *Mayo/Alice* two-step framework, consistent with the guidance set forth in the USPTO’s “2014 Interim Guidance on Patent Subject Matter Eligibility,” 79 Fed. Reg. 74618 (Dec. 16, 2014), in effect at the time the rejection was made, i.e., on Oct. 13, 2016. We agree with the Examiner that Appellant’s claim 1 (and the other pending claims) are directed to patent-ineligible abstract ideas or concepts. In view of the 2019 Revised Guidance, we clarify and expand the Examiner’s reasoning as follows.

We begin our analysis by broadly but reasonably construing Appellant’s claim 1. Claim 1 recites a computer implemented information generating system—an “advertisement generating system” that includes databases (a product-related data database and a promotional data database), a client device, and a controller. *See* claim 1; Spec. ¶¶ 2, 23–28, 30). The client device further includes an input device (interface) that receives user selections of the product-related data and the promotional data. *See* claim 1; Spec. ¶¶ 24, 28.

The controller facilitates access and selection of (is operable to permit selection of) the promotional data as well as product-related data, correlates (provides correlation of) the data (product-related data and promotional

data), outputs the data (product-related data and promotional data) to a background template in the form of an advertisement via a display unit of the client device, and communicates the advertisement to additional client devices networked with (communicatively coupled to) the first client device. The advertisement itself, which is a data structure, comprises a plurality of data types or layers superimposed on the background template. *See* claim 1; Spec. ¶¶ 23–28, 30. That is, the controller performs various functionality to correlate data from a product-related data database and a promotional data database, and output the correlated data to a background template in the form of an advertisement.

Claim 1 also includes additional features (elements) that are part of the advertisement generation system, appurtenant to the advertisement generation process, but do not further limit the advertisement generation system. These elements include: the product related database (database containing product related data), the promotional database (database containing promotional data), the client device (primary client device e.g., weighing scale) further including the input device for receiving user selections, the “other” client devices networked to the primary client device, and the controller that performs the advertisement generation functionality. Appellant’s Specification does not define these additional elements or explain in any detail the structure of the elements.

In each instance the above-identified additional elements consist of structural elements that, while necessary to perform the functionality of the advertisement generation process, do not limit how the functionality is actually performed. For example, the recited “controller” is described in the Specification as “a controller in the form of a processor” (Spec. ¶ 24) that

“executes computer executable program instructions” (Spec. ¶ 25). The Specification further describes the controller/processor as being “any number of computer processors, such as processors from Intel Corporation.” Spec. ¶ 25.

In summary, claim 1 recites a computer implemented advertising generation process, including the steps of correlating data from databases and output the correlated data to a background template in the form of an advertisement, utilizing a controller, client device and databases. Hereinafter, we refer to this process as the “advertisement generation process” and the system as the “advertisement generation system.”

We find that the claim recites a “system” comprising structural components (devices or apparatuses) and functionality (a process) for generating advertisements. Accordingly, we interpret the claim as a process or method for generating advertisements. A process is a statutory category of invention (subject matter) (USPTO’s Step 1). Utilizing our interpretation of claim 1 (*supra*), we analyze whether the claim is directed to an abstract idea (USPTO’s Step 2A). Here, Appellant’s claims generally, and independent claim 1 in particular (as summarized, *supra*), are directed to generating advertisements by correlating data and outputting the correlated data to a background template in the form of an advertisement. This is consistent with how Appellant describes the claimed invention. *See* Spec. 2; Appeal Br. 2–3 (citing Spec. ¶¶ 23–28, 30; Figs. 1–5).

Appellant’s claim 1 recites a judicial exception (USPTO’s Step 2A, Prong 1; *see* 2019 Revised Guidance). The advertisement generation process is a method of organizing human activity, in particular, a fundamental economic practice.

Processes for generating advertising are a well-known business practice that is not patent eligible. *See Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1266, 1267 (Fed. Cir. 2016) (the claims are directed to “a method for targeted advertising” where “an advertisement is selected for delivery to the user of a portable device based on at least one piece of demographic information about the user.” *Id.* at 1267. These claims fall within the category of “adding conventional computer components to well-known business practices.” *Id.* at 1270. As such, the at-issue claim(s) is “not directed to the solution of a ‘technological problem,’ . . . nor is it directed to an improvement in computer or network functionality.” The claims instead recite “the general concept of streaming user-selected content to a portable device. The addition of basic user customization features to the interface does not alter the abstract nature of the claims and does not add an inventive component that renders the claims patentable.” *Id.* at 1272.); *Intellectual Ventures I LLC v. Capital One Bank*, 792 F.3d 1363, 1369–70 (Fed. Cir. 2015) (tailoring of content (i.e., advertising) based on information about a user is an abstract idea and a fundamental business practice); *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714–15 (Fed. Cir. 2014) (claim directed to selecting and displaying an advertisement in exchange for access to media (*see id.* at 714) “is directed to an abstract idea” (*id.* at 715)).

Our conclusion, that the advertisement generation process is a method of organizing human activity, or more particularly, a fundamental economic practice, is supported by the similarities between Appellant’s claim 1 and the claims in precedent cases that “simply use computers to serve a conventional business purpose.” *Affinity Labs*, 838 F.3d at 1261; *see Alice*, 573 U.S. at

219 (concluding that concept of intermediated settlement was “a fundamental economic practice long prevalent in our system of commerce” and thus an abstract idea). As explained by the Federal Circuit, the claims at issue in *Affinity Labs* were not “directed to how to implement” the abstract concept, but claimed the function itself instead of a particular way to perform the function. *Affinity Labs*, 838 F.3d at 1258.

Claim 1 is no different. It broadly recites the commercial practice of advertisement generation. While the claim limitations provide steps for using various computers or devices to perform the process, the limitations contain no technical details or explanation of how to implement the claimed abstract idea using the computer. Absent such a disclosure, we cannot conclude that claim 1 covers anything more than the use of a computer for a conventional business purpose. *See Affinity Labs*, 838 F.3d at 1261.

Eligibility Analysis—Revised Guidance Step 2A, Prong 2

Appellant’s claim 1 also recites additional elements beyond the abstract advertisement generation process (the judicial exception) (*supra*). These elements include, as previously discussed (*supra*): the databases (product related data database and promotional data database), the client device further including the input device, the “other” client devices, and the controller that performs the advertisement generation functionality.

We evaluate these additional elements to determine whether the additional elements integrate the advertisement generation process (the judicial exception) into a practical application of the exception (USPTO’s Step 2A, Prong 2; *see* 2019 Revised Guidance). Appellant contends (*supra*) that the claims are “necessarily rooted in computer technology” (Appeal Br. 9 (quoting *DDR Holdings*, 773 F.3d at 1257)), “the present claims are

directed to technology specific to solving an Internetcentric problem . . . for generating advertisements,” and “are related to overcoming a problem specifically arising in the realm of computer networks” (Appeal Br. 10), similar to *DDR Holdings*. See Appeal Br. 9–10; Reply Br. 5–6. In other words, Appellant contends the claims recite meaningful limitations that sufficiently limit the practical application of the alleged abstract idea. We disagree. Appellant’s additional elements (or the combination of the additional elements) do not apply or use the advertisement generation process (the judicial exception) in a manner that imposes a meaningful limit on the judicial exception, such that it is more than a drafting effort designed to monopolize the exception. See *Alice*, 573 U.S. at 221–24 (citing *Mayo*, 566 U.S. at 78–85). Rather, Appellant’s claims recite computers (the controller (processor), client devices, and databases) that are utilized as tools to perform the advertisement generation process (the abstract idea). Utilizing a computer as a tool to perform the abstract idea does not impose a meaningful limit on the abstract idea. See MPEP § 2106.05(f); see also *Alice*, 573 U.S. at 223 (“if [the] recitation of a computer amounts to a mere instruction to implement an abstract idea on a computer that addition cannot impart patent eligibility” (quotations and internal citations omitted)).

Appellant’s claims can be distinguished from patent-eligible claims such as those in *McRO*, *Enfish*, *Bascom* (*Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)), and *DDR Holdings* that are directed to “a specific means or method that improves the relevant technology” (*McRO*, 837 F.3d at 1314), or “a specific improvement to the way computers operate” (*Enfish*, 822 F.3d at 1336), solving a technology-based problem (*BASCOM*, 827 F.3d at 1349–52), or a method “rooted in

computer technology in order to overcome a problem specifically arising in the realm of computer [technology]” (*DDR Holdings*, 773 F.3d at 1257). Contrary to Appellant’s arguments, claim 1 is not a specific technological improvement or an improvement in a technology. Appellant’s claim 1 does not “improve the functioning of the computer itself” or “any other technology or technical field.” *Alice*, 573 U.S. at 225. Nor, does it provide a technological solution to a technological problem. *See DDR Holdings*, 773 F.3d at 1257. *See* MPEP § 2106.05(a). Rather, Appellant’s claims and, in particular, the above-identified additional elements are similar to the claims in *Alice* (*see Alice*, 573 U.S. at 225–26) and *Versata Dev. Group, Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1333–34 (Fed. Cir. 2015) in that the instant claims implement a known business practice utilizing a general purpose computer.

In summary, “the focus of the claims is not on such an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016). Thus, we agree with the Examiner that the claims are directed to the abstract idea of performing “a series of steps for a travel-related financial transaction, which are a fundamental economic practice” (Final Act. 2), or as we clarify (*supra*) performing a transaction approval process utilizing a generic computer.

#### Eligibility Analysis—Step 2B (“Significantly More”)

Having concluded Appellant’s claims are directed to an abstract idea under the 2019 Revised Guidance Step 2A analysis, we next address whether the claims add significantly more to the alleged abstract idea. As directed by our reviewing court, we search for an “‘inventive concept’ sufficient to ‘transform the nature of the claim into a patent-eligible

application.” *McRO*, 837 F.3d at 1312 (quoting *Alice*, 573 U.S. at 217). The implementation of the abstract idea involved must be “more than performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347–48 (Fed. Cir. 2014) (alteration in original) (quoting *Alice*, 573 U.S. at 225). The “inventive concept” “must be significantly more than the abstract idea itself, and cannot simply be an instruction to implement or apply the abstract idea on a computer.” *Bascom*, 827 F.3d at 1349 (citation omitted).

Here, the Examiner reiterated the limitations of claim 1 and determined that Appellant’s claims do not add significantly more: “[t]he claim(s) do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional computer elements, which are recited at a high level of generality, provide conventional computer functions that do not add meaningful limits to practicing the abstract idea.” Final Act. 4; *see* Final Act. 5; Ans. 5–7. Appellant also reiterates the limitations of claim 1 (*see* Appeal Br. 12–13), contends “the combination of features recited by the present claims amount to significantly more than the alleged abstract ideas themselves” (Appeal Br. 10 (emphasis omitted)), and contends “the present claims include meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment” (Appeal Br. 11 (emphasis omitted)). *See* Reply Br. 6–9. Appellant fails to persuade us of error in the Examiner’s rejection with respect to the second *Alice* step. We agree with the Examiner that Appellant’s claim 1 (and the other pending claims) does not evince an “inventive concept” that is significantly more than the abstract

idea itself. In particular, Appellant fails to explain how the limitations (above) are not part and parcel of the abstract business practice—advertisement generation process. Nor does Appellant explain how the additional features (additional elements, *see supra*) (individually and in combination) are not routine or are unconventional.

As previously discussed, claim 1 merely recites additional non-abstract elements (above) – specifically computers (the controller (processor), client devices, input devices, and databases (residing in computer memory)) and utilizing computers (conventional computers and conventional computer processes) to receive, analyze (correlate), and display information, and to generate advertisement information. Appellant’s Specification describes the computers as conventional (generic) computers. *See, e.g.*, Spec. ¶¶ 24, 25 discussing the controller (the recited “controller” is “a controller in the form of a processor” (Spec. ¶ 24) that “executes computer executable program instructions” (Spec. ¶ 25), and may be “any number of computer processors, such as processors from Intel Corporation” (Spec. ¶ 25)).

Accordingly, Appellant’s Specification itself describes the additional elements as being well-understood, routine, and conventional. Such conventional computer processes operating on conventional computer hardware “do not alone transform an otherwise abstract idea into patent-eligible subject matter.” *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1096 (Fed. Cir. 2016) (citing *DDR Holdings*, 773 F.3d at 1256).

With respect to Appellant’s argument analogizing the instant claims to those in *Google* (Appeal Br. 12 ), we note that *Google* is a non-precedential Board decision denying institution of a covered business method patent

review, and, as such, is not binding on this panel. Nonetheless, for the reasons stated previously we are not persuaded by the analogy Appellant attempts to draw.

For at least the reasons above, we are not persuaded of Examiner error in the rejection of claim 1 under 35 U.S.C. § 101. Thus, we sustain the Examiner's rejection under § 101 of independent claim 1, independent claims 16 and 25, and dependent claims 4, 6–8, 10–15, and 18–24, which were not separately argued with specificity.

*Obviousness Rejection of Claims 1, 4, 6–8, 10–16, and 18, 19, and 21–23*

Appellant argues independent claims 1 and 16, and dependent claims 4, 6–8, 10–15, 18, 19, and 21–23, together as a group with respect to the § 103 rejection. *See* Appeal Br. 14–19. We select independent claim 1 as representative of Appellant's arguments with respect to claims 1, 4, 6–8, 10–16, and 18, 19, and 21–23. 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner rejects independent claim 1 (as well as independent claim 16, and dependent claims 4, 6–8, 10–15, 18, 19, and 21–23) as being obvious in view of Schuller, Evans, and Isomura. *See* Final Act. 7–9; *see also* Final Act. 12–18; Ans. 7–8. The Examiner finds Schuller describes a system for outputting and displaying product-related data and “promotional data in the form of an advertisement.” *See* Final Act.8 (citing Schuller Figs. 10B and 10C). The Examiner further finds Evans describes outputting “product related data and the promotional data on a background template in the form of an advertisement via a display unit of the client device.” Final Act. 8; *see* Final Act. 9; Ans. 8 (citing Evans ¶¶ 11, 67–69, 76, 84, 106). The Examiner also finds Isomura describes generating information (images) to be displayed (i.e., an advertisement) comprising “a plurality of media

layers superimposed on the background template” where the media layers are graphical images. Final Act. 9; *see* Ans. 8 (citing Isomura ¶ 99).

Appellant contends that the combination of Schuller, Evans, and Isomura does not teach the disputed features of claim 1. *See* Appeal Br. 13–16; Reply Br. 9–11. Specifically, Appellant contends, *inter alia*, that the combination of Evans and Isomura does not teach the limitation of “‘the advertisement comprises a plurality of data types or layers superimposed on the background template,’ as recited by independent claim 1” Reply Br. 10; *See* Appeal Br. 15–16; Reply Br. 10–11. Appellant further contends “Evans is completely silent regarding the advertisement comprising a plurality of data types or layers superimposed on a background template. Moreover, Isomura fails to obviate the deficiencies of Schuller and Evans.” Reply Br. 10.

We disagree with Appellant that Schuller, Evans, and Isomura do not teach outputting data (the product related data and the promotional data) “on a background template in the form of an advertisement via a display unit of the client device” “wherein the advertisement comprises a plurality of data types or layers superimposed on the background template” (claim 1). *See* Appeal Br. 13–16; Reply Br. 9–11. The Examiner provides an explanation how Schuller, Evans, and Isomura teach or suggest the disputed features of Appellant’s claim 1. We adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken (Final Act. 7–9), and (2) the reasons set forth by the Examiner in the Examiner’s Answer (Ans. 8–9) in response to Appellant’s Appeal Brief. We concur with the findings and conclusions reached by the Examiner, and we address specific findings, conclusions, and arguments for emphasis as follows.

We agree with the Examiner's findings that combination of Schuller, Evans, and Isomura at least suggests the disputed features of Appellant's claim 1. As explained by the Examiner, Schuller describes outputting and displaying various product-related data and promotional data as an advertisement. *See* Final Act. 8 (citing Schuller Figs. 10B and 10C). As further described by the Examiner, Evans describes outputting data on a background template and displaying the advertisement. *See* Final Act. 8–9; Ans. 8 (citing Evans ¶¶ 84, 106). The Examiner also explains that Isomura describes generating information (an advertisement) comprising multiple media layers (graphical images) superimposed on the background template. *See* Final Act. 9; Ans. 8 (citing Isomura ¶ 99).

Appellants do not address the Examiners findings with respect to the combination of Schuller, Evans, and Isomura. *See* Appeal Br. 13–16; Reply Br. 9–11. Accordingly, we find that Appellant attacks the references individually and do not address the combination of references. The references cited by the Examiner must be read, not in isolation, but for what each fairly teaches in combination with the prior art as a whole. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references).

Further, Appellants misconstrue the Examiner's rejection. The relevant feature of Isomura is whether Isomura at least suggests outputting information composed of multiple media images (layers) superimposed on one another.

Thus, Appellants' contentions do not persuade us of error in the Examiner's obviousness rejection of representative independent claim 1.

Accordingly, we affirm the Examiner’s rejection of representative claim 1, independent claim 16 that includes limitations of commensurate scope, and dependent claims 4, 6–8, 10–15, 18, 19, and 21–23 that depend from claims 1 and 16, respectively, but were not separately argued with particularity (*supra*).

*Obviousness Rejection of Claim 25*

The Examiner rejects independent claim 25 as being obvious in view of Schuller, Evans, and Isomura. *See* Final Act. 9–12; Ans. 8–9. The Examiner finds Schuller describes “to wirelessly push the advertisement to one or more other client devices communicatively coupled to the client device via a wireless communications network.” Final Act. 11; *see* Ans. 9 (citing Schuller ¶ 25).

Appellant contends that the combination of Schuller, Evans, and Isomura does not teach the disputed features of claim 25. *See* Appeal Br. 16–19; Reply Br. 11–14. Specifically, Appellant contends, *inter alia*, that Schuller does not teach the limitation of “wirelessly push[ing] the advertisement to one or more client devices communicatively coupled to the client device via a wireless communication network” (claim 25). *See id.* In particular, Appellant contends “the wireless interfaces taught by Schuller do not wirelessly *push* the advertisements to one or more client devices.” Reply Br. 12.

We agree with Appellant that the Examiner does not explain sufficiently how the cited portion of Schuller describes the disputed features. The Examiner cited portion of Schuller at best describe the client device (scale) receiving information from other networked devices (*see* Schuller

¶ 25). We discern no disclosure of sending (pushing) advertisements to other devices.

Without further explanation, we are left to speculate on how Schuller in combination with Evans and Isomura teaches the disputed features of claim 25. Consequently, we are constrained by the record before us to find that the Examiner erred in concluding the combination of Schuller, Evans, and Isomura renders obvious Appellant's claim 25. Accordingly, we do not sustain the Examiner's obviousness rejection of claim 25.

*Obviousness Rejection of Claim 20*

The Examiner rejects dependent claim 20 as being obvious in view of Schuller, Evans, and Isomura. *See* Final Act. 7–9, 17; Ans. 9–10. The Examiner finds Evans describes “correlating comprises assigning one or more classification terms to the media data in the product related database.” Final Act. 9; *see* Ans. 9 (citing Evans ¶¶ 11, 45, 53, 57, 58, 67–69, 74–76, 84, 106).

Appellant contends that the combination of Schuller, Isomura, and, in particular, Evans does not teach the disputed features of claim 20. *See* Appeal Br. 19; Reply Br. 14. Specifically, Appellant contends Evans instead describes an automatic checking feature. *See id.* (citing Evans ¶ 106).

We agree with Appellant that the Examiner does not explain sufficiently how the cited portions of Evans describes the disputed features. The Examiner cited portions of Evans at best describe selecting product information. We discern no disclosure of assigning classifications to the product information.

Without further explanation, we are left to speculate on how Evans in combination with Schuller and Isomura teaches the disputed features of

claim 20. Consequently, we are constrained by the record before us to find that the Examiner erred in concluding the combination of Schuller, Evans, and Isomura renders obvious Appellant's claim 20. Accordingly, we do not sustain the Examiner's obviousness rejection of claim 25.

*Obviousness Rejection of Claim 24*

The Examiner rejects dependent claim 24 as being obvious in view of Schuller, Evans, and Isomura. *See* Final Act. 7–9, 18; Ans. 10. As with claim 25, the Examiner finds Schuller describes “push[ing] the advertisement” and additionally finds the advertisement is pushed “to other wireless devices in a target vicinity of the client device.” Final Act. 18; *see* Ans. 10 (citing Schuller ¶ 25). As with claim 25, Appellant contends that the combination of Schuller in combination with Evans and Isomura does not teach the disputed features of claim 24. *See* Appeal Br. 19–20; Reply Br. 14–15. Specifically, Appellant contends that Schuller does not teach pushing the advertisements. *See id.*

For the same reasons as claim 25 (*supra*), we agree with Appellant that the Examiner does not explain sufficiently how the cited portion of Schuller describes the disputed features. Without further explanation, we are left to speculate on how Schuller in combination with Evans and Isomura teaches the disputed features of claim 24. Consequently, we are constrained by the record before us to find that the Examiner erred in concluding the combination of Schuller, Evans, and Isomura renders obvious Appellant's claim 24. Accordingly, we do not sustain the Examiner's obviousness rejection of claim 24.

### CONCLUSION

Appellant has not shown that the Examiner erred in rejecting claims 1, 4, 6–8, 10–16, and 18–25 under 35 U.S.C. § 101.

Appellant has not shown that the Examiner erred in rejecting claims 1, 4, 6–8, 10–16, and 18, 19, and 21–23 under 35 U.S.C. § 103(a).

Appellant has shown that the Examiner erred in rejecting claims 20, 24, and 25 under 35 U.S.C. § 103(a).

Because we affirm on at least one ground of rejection with respect to each claim on appeal, we affirm the Examiner’s decision to reject claims 1, 4, 6–8, 10–16, and 18–25. *See* 37 C.F.R. § 41.50(a)(1).

### DECISION

We affirm the Examiner’s rejection of claims 1, 4, 6–8, 10–16, and 18–25.

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