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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MELVIN L. BARNES JR.

Appeal 2018-000642
Application 13/335,354
Technology Center 3600

Before NINA L. MEDLOCK, TARA L. HUTCHINGS, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1, 3–17, and 19–23. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held on October 15, 2019.

We AFFIRM.

¹ We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Our decision references Appellant’s Appeal Brief (“Appeal Br.,” filed March 30, 2017) and Reply Brief (“Reply Br.,” filed October 25, 2017), and the Examiner’s Answer (“Ans.,” mailed August 25, 2017) and Final Office Action (“Final Act.,” mailed October 28, 2016). Appellant identifies the real party in interest as Gula Consulting Limited Liability Company. Appeal Br. 1.

CLAIMED INVENTION

Appellant describes that the present disclosure “relates, generally, to the field of mobile communications and computer processing” and, more particularly, to “a system, method, apparatus, and computer program product for providing location based services, mobile e-commerce, and other functions” (Spec. ¶ 2).

Claims 1, 15, and 20 are the independent claims on appeal. Claim 1, reproduced below with bracketed notations added, is illustrative of the claimed subject matter:

1. A method of transmitting an advertisement to a client device, the method comprising:

[(a)] selecting, via a processor, an advertisement from a plurality of available advertisements based on information in a profile of a user and also based on targeting criteria associated with the available advertisements;

[(b)] transmitting to the client device via a communication network the advertisement selected from the plurality of available advertisements so that the advertisement can be presented via the client device;

[(c)] determining a location of the client device, wherein selecting the advertisement from the plurality of available advertisements is further based on the location of the client device and a location of a vender associated with the available advertisements;

[(d)] receiving from the client device via the communications network a response to the advertisement; and

[(e)] transmitting to the client device via the communication network a notification of an existing product of the vender based on the location of the client device and the response to the advertisement.

REJECTIONS

Claims 1, 3–17, and 19–23 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

Claims 8, 9, and 19 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter that Appellant regards as the invention.

Claims 1, 3–17, and 19–23 are rejected under 35 U.S.C. § 103(a) as unpatentable over Jokinen et al. (US 2002/0095333 A1, published July 18, 2002) (“Jokinen”) and Nye (US 2002/0156917 A1, published Oct. 24, 2002).

ANALYSIS

Patent Ineligible Subject Matter

Appellant argues the pending claims as a group (Appeal Br. 5–12). We select independent claim 1 as representative. The remaining claims, thus, stand or fall with claim 1. *See* 37 C.F.R. §41.37(c)(1)(iv).

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. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (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 Corp.*, 573 U.S. at 217.

The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, 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.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78). This is “a search for an ‘inventive concept’ — *i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* at 217–18 (alteration in original).

In rejecting the pending claims under 35 U.S.C. § 101, the Examiner determined that claim 1 is directed to “targeting advertisement[s],” which the Examiner concluded is an abstract idea similar to other concepts that the courts have held abstract (Final Act. 4–8). The Examiner also determined that claim 1 does not include additional elements that are sufficient to amount to significantly more than the abstract idea (*id.* at 8–10), and that the remaining claims are patent ineligible for substantially similar reasons (*id.* at 10).

After Appellant’s briefs were filed, and the Examiner’s Answer mailed, the U.S. Patent and Trademark Office (the “USPTO”) published revised guidance on January 7, 2019 for use by USPTO personnel in evaluating subject matter eligibility under 35 U.S.C. § 101. 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50, 57 (Jan. 7, 2019) (the “2019 Revised Guidance”). That guidance revised the USPTO’s examination procedure with respect to the first step of the

Mayo/Alice framework by (1) “[p]roviding groupings of subject matter that [are] . . . considered an abstract idea”; and (2) clarifying that a claim is not “directed to” a judicial exception if the judicial exception is integrated into a practical application of that exception. *Id.* at 50. The 2019 Revised Guidance, by its terms, applies to all applications, and to all patents resulting from applications, filed before, on, or after January 7, 2019. *Id.*²

Step One of the Mayo/Alice Framework (2019 Revised Guidance, Step 2A)

The first step in the *Mayo/Alice* framework, as mentioned above, is to determine whether the claims at issue are “directed to” a patent-ineligible concept, e.g., an abstract idea. *Alice Corp.*, 573 U.S. at 217. This first step, as set forth in the 2019 Revised Guidance (i.e., Step 2A), is a two-prong test; in Step 2A, Prong One, we look to whether the claim recites a judicial exception, e.g., one of the following three groupings of abstract ideas: (1) mathematical concepts; (2) certain methods of organizing human activity, e.g., fundamental economic principles or practices, commercial or legal interactions; and (3) mental processes. 2019 Revised Guidance, 84 Fed. Reg. at 54. If so, we next consider whether the claim includes additional elements, beyond the judicial exception, that “integrate the [judicial] exception into a practical application,” i.e., that apply, rely on, or

² The 2019 Revised Guidance supersedes MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) § 2106.04(II) and also supersedes all versions of the USPTO’s “Eligibility Quick Reference Sheet Identifying Abstract Ideas.” *See* 2019 Revised Guidance, 84 Fed. Reg. at 51 (“Eligibility-related guidance issued prior to the Ninth Edition, R-08.2017, of the MPEP (published Jan. 2018) should not be relied upon.”). Accordingly, Appellant’s arguments challenging the sufficiency of the Examiner’s rejection will not be addressed to the extent those arguments are based on now superseded USPTO guidance.

use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception (“Step 2A, Prong Two”). *Id.* at 54–55. Only if the claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application do we conclude that the claim is “directed to” the judicial exception, e.g., an abstract idea.

We are not persuaded by Appellant’s arguments that the Examiner erred in determining that claim 1 is directed to an abstract idea (Appeal Br. 7–9). The Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). It asks whether the focus of the claims is on a specific improvement in relevant technology or on a process that itself qualifies as an “abstract idea” for which computers are invoked merely as a tool. *See id.* at 1335–36. Here, the Specification (including the claim language) makes clear that the claims focus on an abstract idea, and not on any improvement to computer technology and/or functionality.

The Specification is entitled “TRANSMITTING CUSTOM ADVERTISEMENTS TO A CLIENT DEVICE,” and describes, in the Background section, that although mobile phones and personal digital assistants (PDAs) typically include functionality for providing a telephone/data communication link, and a set of software applications (e.g., a calendar, email client, mini-browser, and word processor), very few of these devices include image input capabilities, voice recording capabilities,

significant voice control capabilities, or location determining or location based capabilities (Spec. ¶ 3). In addition, although users often carry portable devices when traveling through cities, shopping complexes, and other facilities and geographical areas, the Specification describes that these devices typically lack Web services capabilities or access and, as a result, fail to provide substantial mobile e-commerce services, location based functions, and functions or services available through the use of a wireless LAN (*id.* ¶ 4). According to the Specification, “to date,” venders have not been able to take advantage of location information associated with customers and potential customers or obtain information about prospective customers (*id.* ¶ 5). “Consequently, venders are typically not aware of the nearby or approaching presence of a past customer, potential customer, or person seeking a product that the vender offers” (*id.*). And, even if a vender had such information, the vendor has no mechanism for presenting advertisements to the person or otherwise enticing the person to visit the vender store location or make a purchase (*id.*). Moreover, even if such a mechanism were in place, the vender typically has no information about the person that can be used as a basis for selecting an advertisement to be presented to the person or for customizing such an advertisement (*id.*).

The claimed system and method are ostensibly intended to address these deficiencies by providing, *inter alia*, “location based services, location based mobile e-commerce, automated processing, wireless network communications, [and] mobile telephone communications” (*id.* ¶ 6). Claim 1, thus, recites a method for transmitting an advertisement to a client device comprising: (1) determining the location of the client device, and selecting an advertisement, from a plurality of available advertisements,

based on the location of the client device, information concerning a user of the client device, targeting criteria associated with the available advertisements, and a location of a vender associated with the available advertisements, i.e., “selecting, via a processor, an advertisement from a plurality of available advertisements based on information in a profile of a user and also based on targeting criteria associated with the available advertisements” and “determining a location of the client device, wherein selecting the advertisement from the plurality of available advertisements is further based on the location of the client device and a location of a vender associated with the available advertisements” (steps (a) and (c)); (2) transmitting the selected advertisement to the client device for presentation to the device user, i.e., “transmitting to the client device via a communication network the advertisement selected from the plurality of available advertisements so that the advertisement can be presented via the client device” (step (b)); (3) “receiving from the client device via the communications network a response to the advertisement” (step (d)); and (4) “transmitting notification of a vender product based on the location of the client device and the response to the advertisement, i.e., “transmitting to the client device via the communication network a notification of an existing product of the vender based on the location of the client device and the response to the advertisement” (step (e)).

These limitations, when given their broadest reasonable interpretation, recite collecting information, selecting an advertisement based on the collected information, transmitting the selected advertisement to a user device, and depending on the user’s response to the advertisement, transmitting additional targeted product information to the user device —

i.e., targeted advertising, which a method of organizing human activity, and, therefore, an abstract idea. *See* 2019 Revised Guidance, 84 Fed. Reg. at 52.

The Federal Circuit has held similar concepts abstract. Thus, for example, the Federal Circuit has held that abstract ideas include the concepts of collecting data, analyzing the data, and displaying the results of the collection and analysis, including when limited to particular content. *See, e.g., Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017) (identifying the abstract idea of collecting, displaying, and manipulating data); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (characterizing collecting information, analyzing information by steps people go through in their minds, or by mathematical algorithms, and presenting the results of collecting and analyzing information, without more, as matters within the realm of abstract ideas); *see also SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1168 (Fed. Cir. 2018) (“As many cases make clear, even if a process of collecting and analyzing information is ‘limited to particular content’ or a particular ‘source,’ that limitation does not make the collection and analysis other than abstract.”) (quoting *Elec. Power Grp.*, 830 F.3d at 1353, 1355 (citing cases))). Targeting customers with particular targeted marketing material also is a longstanding marketing and advertising practice, and is substantially similar to other commercial practices that the courts have held patent ineligible. *See, e.g., Affinity Labs of Texas, LLC v. Amazon.com, Inc.*, 838 F.3d 1266, 1271 (Fed. Cir. 2016) (customizing a user interface to have targeted advertising based on user information); *Morsa v. Facebook, Inc.*, 77 F. Supp. 3d 1007, 1013 (C.D. Cal. 2014), *aff’d*, 622 F. App’x 915 (Fed. Cir. 2015) (concluding that targeting advertisements to certain

consumers is no more than an abstract idea); *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015) (tailoring information presented to a user based on particular information); *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 713 (Fed. Cir. 2014) (offering media content in exchange for viewing an advertisement).

Having concluded that claim 1 recites a judicial exception, i.e., an abstract idea (Step 2A, Prong 1), we next consider whether the claim recites additional elements that integrate the judicial exception into a practical application (Step 2A, Prong 2).

The only additional elements recited in claim 1, beyond the abstract idea, are the recited “processor,” “client device,” and “communications network” — elements that are recited at a high level of generality, i.e., as generic computer components performing generic computer functions (*see, e.g.*, Spec. ¶¶ 27, 31, 40, 43, 412). We find no indication in the Specification, nor does Appellant direct us to any indication, that the operations recited in claim 1 require any specialized computer hardware or other inventive computer components, i.e., a particular machine, invoke any assertedly inventive programming, or that the claimed invention is implemented using other than generic computer components to perform generic computer functions. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”).

We also find no indication in the Specification that the claimed invention effects a transformation or reduction of a particular article to a different state or thing. Nor do we find anything of record that attributes an

improvement in technology and/or a technical field to the claimed invention or that otherwise indicates that the claimed invention integrates the abstract idea into a “practical application,” as that phrase is used in the 2019 Revised Guidance.³

Appellant asserts that the Examiner has failed to properly address “determining a location of the client device,” as recited in claim 1; that the Examiner refers to this limitation only as “determining a location,” omitting “of the client device”; and that the Examiner and has, thus, improperly characterized the claims as directed to an abstract idea (Appeal Br. 8–9). Appellant, thus, maintains that even if “targeted advertising is a fundamental economic practice or [a] method of organizing human activity as alleged by the Examiner, . . . targeting advertising to a client device is not” (*id.* at 8 (noting that a client device “does not decide to make a purchase” and “is not a human” and arguing that adding the client device to the claim language “fundamentally changes the meaning of the claim,” i.e., “the addition of ‘the client device’ is not merely performing the determining by the client device”; rather, “ the addition characterizes what is performed, the determination of the location of the client device”))).

Appellant’s argument, as best understood, is that claim 1 is not directed to an abstract idea, i.e., to targeted advertising, because the claim

³ The 2019 Revised Guidance references MPEP § 2106.05(a)–(c) and (e) in describing the considerations that are indicative that an additional element or combination of elements integrates the judicial exception, e.g., the abstract idea, into a practical application. 2019 Revised Guidance, 84 Fed. Reg. at 55. If the recited judicial exception is integrated into a practical application, as determined under one or more of these MPEP sections, the claim is not “directed to” the judicial exception.

requires physical components, i.e., “non-abstract devices with known positions and [a] combination of data from signals[,] from satellites[,] or from the client device, received at the cell towers to determine the position of the client device” (Reply Br. 1–2). Yet, “not every claim that recites concrete, tangible components escapes the reach of the abstract-idea inquiry.” *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 611–12 (Fed. Cir. 2016). Similar to the situation in *In re TLI Communications*, claim 1 is not directed to an improvement in any physical device; the recited physical components, including the “processor,” “client device,” and “communications network,” merely provide a generic platform on which to carry out the abstract idea, i.e., targeted advertising. Indeed, it could not clearer from the Specification that the sole reason for determining a location of a client device, and selecting and transmitting an advertisement to the client device based on the determined physical location, is to facilitate the presentation of the advertisement to the *human user* of that client device, i.e., to take advantage of location information associated with customers and potential customers as a basis for targeting advertisements to those customers and potential customers (*see, e.g.*, Spec. ¶ 5).

We conclude, for the reasons outlined above, that claim 1 recites a method of organizing human activity, i.e., an abstract idea, and that the additional elements recited in the claim are no more than generic components used as tools to perform the recited abstract idea. As such, they do not integrate the abstract idea into a practical application. *See Alice Corp.*, 573 U.S. at 223–24 (“[W]holly generic computer implementation is not generally the sort of ‘additional feature[e]’ that provides any ‘practical assurance that the process is more than a drafting effort designed to

monopolize the [abstract idea] itself.” (quoting *Mayo*, 566 U.S. at 77)). Accordingly, we agree with the Examiner that claim 1 is directed to an abstract idea.

Step Two of the Mayo/Alice Framework (2019 Revised Guidance, Step 2B)

Having determined under step one of the *Mayo/Alice* framework that claim 1 is directed to an abstract idea, we next consider under Step 2B of the 2019 Revised Guidance, the second step of the *Mayo/Alice* framework, whether claim 1 includes additional elements or a combination of elements that provides an “inventive concept,” i.e., whether the additional elements amount to “significantly more” than the judicial exception itself.

2019 Revised Guidance, 84 Fed. Reg. at 56.

Appellant asserts that even “[a]ssuming for the sake of argument that the claims are directed towards an abstract idea, . . . the present claims . . . nonetheless satisfy § 101 because the claims as a whole recite significantly more than that alleged abstract idea” (Appeal Br. 9). Appellant argues that “the claim language does not merely take the alleged abstract idea and add ‘apply it using a generic computer’” (*id.*), and summarily asserts that the claims recite more than a generic computer (*id.* at 10). Yet, we find no indication in the Specification, nor does Appellant direct to any indication, that any of the recited “processor,” “client device,” and “communications network” is anything other than a generic computer component. The Specification, in fact, discloses just the opposite.⁴

⁴ See, e.g., Spec. ¶ 27 (explaining that detailed descriptions of well-known networks, communication systems, computers, terminals, devices, components, techniques, data and network protocols, formats, software products and systems, enterprise applications, operating systems, enterprise technologies, middleware, interfaces, and hardware are “omitted so as not to

Appellant further asserts that “the addition of ‘of the client device’ is not mere data processing by a ‘generic computer’” but instead “further characterizes the particular operation” (App. Br. 10). Appellant, thus, maintains that “the system must be capable of determining a location of a client device, not just mere moving data or thinking about a client device” (*id.*). Yet, we find nothing in the Specification (including the claim language) that discloses any specialized hardware or assertedly inventive programming for determining the location of the client device. Claim 1 merely recites “determining a location of the client device” without any technical details regarding how the location of the device is determined. And although Appellant, by its argument, suggests such details exist, those details are not reflected in the claim. *Cf. Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1342 (Fed. Cir. 2017) (“The claim language here provides only a result-oriented solution with insufficient detail for how a computer accomplishes it. Our law demands more.”). It also is particularly telling that, in describing the various embodiments, the

obscure the description of the various embodiments”); *id.* 31 (disclosing that multi-function communication device 101, i.e., the claimed “client device,” includes “conventional mobile phone and personal digital assistant (PDA) capabilities” and one or more functional modules, each “comprised of a combination of hardware and software and may share (i.e., may be formed by) hardware and software of other modules as is well known in the art”); *id.* ¶ 40 (“Preferably, the device 101 is configured to operate with a conventional mobile telephone network or wireless wide area network (WWAN), and one or more other wireless local area networks (wireless LAN or WLAN), wireless Metropolitan Area Networks (MAN), and a wireless personal area networks (PAN) (e.g., a Bluetooth® network).”); *id.* ¶ 43 (“The following descriptions of various networks, standards, formats and protocols are well-known in the art, [and] are provided as a matter of convenience.”).

Specification states that “any suitable means of determining an absolute or relative location [of device 101, i.e., the claimed “client device”] that is suitable for the embodiment or an application may be used” (Spec. ¶ 97).

Appellant’s further argument that the claims pose no credible risk of preemption (Appeal Br. 10–12) is similarly unpersuasive of Examiner error. Although the Supreme Court has described “the concern that drives [the exclusion of abstract ideas from patent-eligible subject matter] as one of preemption,” *Alice Corp.*, 573 U.S. at 216, characterizing preemption as a driving concern for patent eligibility is not the same as characterizing preemption as the sole test for patent eligibility. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice Corp.*, 573 U.S. at 216). “[P]reemption may signal patent ineligible subject matter, [but] the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

Appellant also misapprehends the controlling precedent to the extent Appellant maintains that claim 1 recites significantly more than an abstract idea because the claim is allegedly novel and/or non-obvious (Appeal Br. 12). Neither a finding of novelty nor a non-obviousness determination automatically leads to the conclusion that the claimed subject matter is patent eligible. Although the second step in the *Mayo/Alice* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for “an element or combination of elements that is ‘sufficient to ensure that the patent in

practice amounts to significantly more than a patent upon the [ineligible concept] itself.” *Alice Corp.*, 573 U.S. at 217–18 (citation omitted).

“Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent ineligible. *See Mayo*, 566 U.S. at 90; *see also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (“The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.”).

We are not persuaded, on the present record, that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection of claim 1, and claims 3–17 and 19–23, which fall with claim 1.

Indefiniteness

We are persuaded that the Examiner erred in rejecting claims 8, 9, and 19 under 35 U.S.C. § 112, second paragraph. The Examiner takes the position that “causing an additional-information indication to be presented on a display associated with the client device,” as recited in claim 8, and similarly recited in claims 9 and 19, renders the claim unclear in that “one of ordinary skill [in the art] would not be able to ascertain what the positive step is since ‘causing’ represents state rather than action” (Final Act. 10–11). We disagree.

In our view, a person of ordinary skill in the art would understand from the Specification (including the claim language) what is being claimed,

namely that “an additional-information indication” (i.e., an indication that additional information associated with an advertisement is available) is presented on a display associated with the client device. Therefore, we do not sustain the Examiner’s rejection of claims 8, 9, and 19 under 35 U.S.C. § 112, second paragraph. *See Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.”).

Obviousness

We are persuaded by Appellant’s argument that the Examiner erred in rejecting independent claims 1, 15, and 20 under 35 U.S.C. § 103(a) at least because neither Jokinen nor Nye, individually or in combination, discloses or suggests “transmitting to the client device . . . a notification of an existing product of the vender based on the location of the client device and the response to the advertisement,” as recited in claim 1, and similarly recited in claims 15 and 20 (Appeal Br. 17–19; Reply Br. 3–4).

In Final Office Action, the Examiner acknowledged that Jokinen does not teach the argued limitation, and relied on paragraphs 156–170, 172, 196, 208, 213, and 221, claims 3–5, and Figures 15 and 16 of Nye to cure the deficiency of Jokinen (Final Act. 12). The Examiner takes a different position in the Answer, relying on paragraphs 61, 134, 136, 144, 155, 176, 177, 216 and Figures 3, 15, and 16 of Nye as disclosing the argued limitation (Ans. 10–12). And, in a further reversal of the position set forth in the Final Office Action, the Examiner also cites paragraphs 53–58 and 63 of Jokinen as disclosing the argued feature (*id.* at 12).

We have carefully reviewed the portions of Nye and Jokinen on which the Examiner relies. And we agree with Appellant that none of the cited portions discloses or suggests transmitting a notification of an existing product to a client device based on the location of the device and the response to an advertisement (Appeal Br. 17–19; Reply Br. 3–4).

Therefore, we do not sustain the Examiner’s rejection of independent claims 1, 15, and 20 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the rejection of dependent claims 3–14, 16, 17, 19, and 21–23. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed
1, 3–17, 19–23	101	Eligibility	1, 3–17, 19–23	
8, 9, 19	112, second paragraph	Indefiniteness		8, 9, 19
1, 3–17, 19–23	103(a)	Jokinen, Nye		1, 3–17, 19–23
Overall Outcome			1, 3–17, 19–23	

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

AFFIRMED