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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* LIRON SLONIMSKY

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Appeal 2018-000967  
Application 14/469,617  
Technology Center 3600

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Before ELENI MANTIS MERCADER, NORMAN H. BEAMER,  
and ADAM J. PYONIN, *Administrative Patent Judges*.

MANTIS MERCADER, *Administrative Patent Judge*.

DECISION ON APPEAL  
STATEMENT OF THE CASE

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–25, which constitute all the pending claims in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> Appellant identifies AWEAR SOLUTIONS LTD. as the real party in interest (App. Br. 3).

## THE INVENTION

Appellant's claimed invention is directed to a "method for promoting sales" through use of a "signal from a wireless tag located in [a] tangible consumer product" that permits "issuing a reward associated directly with the tangible consumer product." Abstract.

Independent claim 1, reproduced below, is representative of the subject matter on appeal:

1. A method for promoting sales, comprising:

receiving by a server a request from a potential customer's device for additional information about a wearable product;

wherein the additional information is not included in a wireless signal that is transmitted by a wireless tag concerning the wearable product;

wherein the request is generated by a computerized application hosted by the potential customer's device;

wherein the potential customer's device is a smartphone equipped with a communication device capable of short range communication with the wireless tag and capable of communication over a cellular network;

wherein the wireless tag is positioned on the wearable product or inside the wearable product;

wherein the computerized application is activated by a potential customer on the potential customer's device after the potential customer sees the wearable product and after the potential customer's device receives from the wireless tag the wireless signal concerning the wearable product;

identifying by the server the wearable product according to a value identifying the wearable product, the value identifying the wearable product is included in the wireless signal from the wireless tag;

transmitting the additional information to the potential customer's device;

issuing, by the server and responsive to the request for additional information, a reward associated directly with the wearable product.

App. Br. 25 (Claims Appendix).

#### REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is the following:

Kwon	US 2008/0194238 A1	Aug. 14, 2008
Shoarinejad	US 7,492,258 B1	Feb. 17, 2009
Maytal	US 2009/0106042 A1	Apr. 23, 2009
Ku	US 2009/0248520 A1	Oct. 1, 2009
Gerdes	US 2009/0287408 A1	Nov. 19, 2009
Garner	US 2010/0075666 A1	Mar. 25, 2010
Falk	US 2010/0198873 A1	Aug. 5, 2010
Isabell	US 2010/0321161 A1	Dec. 23, 2010
Pfuhl	US 2013/0162429 A1	June 27, 2013
Cole	US 8,502,674 B1	Aug. 6, 2013
Boyd JR	US 2013/0325525 A1	Dec. 5, 2013
Plut	US 2013/0325572 A1	Dec. 5, 2013
Werner	US 2014/0224867 A1	Aug. 14, 2014

## REJECTIONS

The Examiner made the following rejections<sup>2</sup>:

R1: Claims 1–25 stand rejected under 35 U.S.C. § 112(a) as failing to comply with the written description requirement. Final Act. 3.

R2: Claims 1–25 stand rejected under 35 U.S.C. § 112(a) as failing to comply with the enablement requirement. Final Act. 3–4.

R3: Claims 1–25 stand rejected 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. Final Act. 5.

R4: Claims 1–3, 11, 12, 19, 21, and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Werner and Kwon. Final Act. 8.

R5: Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Werner, Kwon, and Pfuhl. Final Act. 12.

R6: Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Werner, Kwon, and Cole. Final Act. 13.

R7: Claims 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Werner, Kwon, and Isabell. Final Act. 14.

R8: Claims 8 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Werner, Kwon, and Falk. Final Act. 15.

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<sup>2</sup> The rejection of claim 25 under 35 U.S.C. § 112(b) was withdrawn in the Answer. *See* Final Act. 4, Ans. 2.

R9: Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Werner, Kwon, and Garner. Final Act. 16.

R10: Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Werner, Kwon, and Shoarinejad. Final Act. 17.

R11: Claims 13 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Werner, Kwon, and Santaella. Final Act. 18.

R12: Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Werner, Kwon, and Gerdes. Final Act. 19.

R13: Claim 16 stands rejected under 35 U.S.C. § 103 as being unpatentable over Werner, Kwon, and Ku. Final Act. 20.

R14: Claims 17, 18, and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Werner, Kwon, and Plut. Final Act. 20.

R15: Claim 22 stands rejected under 35 U.S.C. § 103 as being unpatentable over Werner, Kwon, and Boyd JR. Final Act. 22.

R16: Claim 25 stands rejected under 35 U.S.C. § 103 as being unpatentable over Werner, Kwon, and Maytal. Final Act. 23.

## ISSUES

The issues are whether the Examiner erred in finding:

1. claims 1–25 as failing to comply with both the written description requirement and the enablement requirement;
2. the claimed invention to be directed to a judicial exception without significantly more;
3. the combination of Werner and Kwon teaches or suggests the limitation of “issuing, by the server and responsive to the request for

- additional information, a reward associated directly with the wearable product,” as recited in independent claim 1;
4. the combination of Werner and Kwon teaches or suggests the limitation of “the reward is issued before the wearable product is purchased,” as recited in dependent claim 24;
  5. the combination of Werner, Kwon, and Pfuhl teaches or suggests the limitation of “identifying wearable product by the server despite the changes in the value identifying the wearable product,” as recited in dependent claim 4;
  6. the combination of Werner, Kwon, and Cole teaches or suggests the limitation of  

the value identifying the wearable product changes according to other values sent between the potential customer’s device and the wireless tag; and wherein the method comprises identifying the wearable product by the server despite the changes in the value identifying the wearable product,

as recited in dependent claim 5; and
  7. the combination of Werner, Kwon, and Plut teaches or suggests the limitation of  

storing by the server a log of previous events associated with the wearable product and sending by the server a message to an electronic device associated with an owner of the wearable product when a change in rewards characteristics exceeds a predetermined value,

as recited in dependent claim 23.

## ANALYSIS

Except where indicated, we adopt the Examiner’s findings in the Answer and Final Office Action and we add the following primarily for emphasis. We note that if Appellant failed to present arguments on a particular rejection, we decline to unilaterally review those uncontested aspects of the rejection. *See Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential); *Hyatt v. Dudas*, 551 F.3d 1307, 1313–14 (Fed. Cir. 2008) (the Board may treat arguments Appellant failed to make for a given ground of rejection as waived).

### *Issue 1*

Appellant argues that “claim 1 does not claim that the server or the potential customer device or the wireless tag [identifies] when *the potential customer sees the wearable product*” and “*the potential customer cannot activate the computerized application before seeing the wearable product* — as he needs to see the wearable product before starting the process illustrated in claim 1” (App. Br. 12).

We agree with Appellant. The Examiner finds that “it is unclear how the invention knows that the user **has seen** the wearable product. There is no mechanism described in the specification which shows how the invention knows that the user sees or has seen the wearable product” (Ans. 2, emphasis in original). The claim does not require that the “invention knows that the user has seen the wearable product”; rather, the claim requires the “potential customer sees the wearable product” and thereafter “the potential customer’s device receives from the wireless tag the wireless signal concerning the wearable product.” As indicated in the disclosure, more than one wireless

signal may be picked up by the potential customer's device, and then the user is presented with a set of products to choose from. *See* Fig. 3 and Spec. 17:13–23. While it may be possible for the user to see a wearable product that is outside of the range of the wireless signal for the application to detect (and thus the wearable product is not identified), that occurrence is excluded by the claim. Accordingly, we are constrained by the record to reverse the Examiner's rejections of claims 1–25 under 35 U.S.C. § 112(a), as failing to comply with both the written description and enablement requirements.

*Issue 2*

The Examiner determines the claims are patent ineligible under 35 U.S.C. § 101, because

the user's interest in a wearable product is used to target information about the wearable product to the user and provide the user with a reward. As such, the description in claim 1 of receiving a request from a potential customer for additional information about a wearable product, identifying the wearable product according to a value identifying the wearable product, transmitting the additional information to the potential customer, issuing a reward associated with the wearable product is an abstract idea

(Final Act. 6) and

the ordered combination of steps describe a marketing practice of providing targeted information based on information known about the user, which leads to the conclusion that the ordered combination does not add anything further than looking at the limitations individually. Selecting additional information about a wearable product would be performed the same way with or without a computer

(Final Act. 7; *see also Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 217 (2014) (Describing the two-step framework “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.”)).

After the mailing of the Answer and the filing of the Brief in this case, the USPTO published revised guidance on the application of § 101. (2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (hereinafter “Memorandum”).) Under the Memorandum, the Office first looks to whether the claim recites:

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

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

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

*See* Memorandum.

We agree with the Examiner that the claim recites an abstract idea (here, certain methods of organizing human activity as a fundamental economic process), because claim 1 recites “promoting sales” as it issues “a reward associated directly with the wearable product.” Such an issuance of a reward may sway a potential customer that is on the fence to make a query for additional information regarding a product, and nudge that potential customer into a sale that would not have occurred but for the enticement of the reward. Such a promotion is an abstract fundamental economic practice.

If the claim recites an abstract idea, we then “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.* (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.*

Appellant contends that

[t]he subject matter of claim 1 includes the establishment of communication between specific devices (server, wireless tag included in or connected to a wearable product, and a potential customer’s device that is a smartphone with a communication device capable of short range and cellular communication) to exchange information (between the smartphone the server and the wireless tag) regarding a concrete wearable product that is carried by a person

(App. Br. 14). We agree with Appellant, as use of the wireless tag, and its communication with the customer’s smartphone, and the subsequent

communication between the customer's smartphone and server, transforms the multiple wireless communications into "additional information" the potential customer desires, thereby integrating the sales promotion into a practical application that is a patent-eligible invention pursuant to the Memorandum.

Accordingly, we reverse the Examiner's rejection of claims 1–25 under 35 U.S.C. § 101.

### *Issue 3*

Appellant argues that Werner "fails to teach or suggest *issuing, by the server and responsive to the request for additional information, a reward associated directly with the wearable product* (App. Br. 19 (emphasis in original), citing Werner ¶¶ 147, 149), because "the owner gets credit ONLY IF THE USER PURCHASES THE ITEM" (App. Br. 20, citing Werner ¶ 149).

We are not persuaded by Appellant's arguments. The Examiner finds, and we agree, that

Werner specifically says that in response to a user tapping an item (tapping means using the mobile device to read the wireless tag) the user is provided with an opportunity to buy the item at a preferred price from a website (i.e.,] discount) or may receive at their mobile device a voucher which may be redeemed at retail locations allowing the user to purchase the item at a preferred price. Both the opportunity to buy the item at a preferred price on a website and a voucher are a reward issued for requesting additional information

(Ans. 7, citing Werner ¶ 147). Appellant’s argument is not commensurate with the scope of the claim, as the claim does not require the reward have redeemable value irrespective of whether a purchase is made.

Accordingly, we sustain the rejection of independent claim 1, and dependent claims 2, 3, 6–22, and 25 not argued separately. *See* App. Br. 20–24.

*Issue 4*

Appellant argues that “Werner fails to teach or suggest (and even teaches away from) *the reward is issued before the wearable product is purchased*” (App. Br. 20 (emphasis in original), citing Werner ¶ 149).

We are not persuaded by Appellant’s argument. The Examiner finds, and we agree, that

[b]oth the opportunity to buy the item at a preferred price (discount) on the website and the voucher to buy the item at a preferred price in a retail store are both given prior to a purchase directly in response to the user requesting additional information by scanning the wireless tag

(Ans. 8; *see also* Ans. 7, citing Werner ¶ 147). Werner’s discount and voucher, unlike a rebate, are issued *prior* to purchase. Accordingly, we sustain the Examiner’s rejection of dependent claim 24.

*Issue 5*

Appellant argues that “Pfuhl fails to teach or suggest *identifying the wearable product by the server despite the changes in the value identifying the wearable product*” (App. Br. 21 (emphasis in original), citing Pfuhl ¶ 27).

We are not persuaded by Appellant’s argument. The Examiner finds, and we agree, that Pfuhl

teaches an RFID tag embedded in a suitcase which can be periodically updated by the user to update bag identifying information such as the owner[’]s name, address, contact information, etc. Thus if someone were to scan the tag, it would show the updated information and still provide the identifying information of the tag

(Ans. 9, citing Pfuhl ¶ 27). Appellant fails to challenge the Examiner’s findings regarding the updating of bag-identifying information, as no Reply was filed.

Accordingly, we sustain the Examiner’s rejection of dependent claim 4.

*Issue 6*

Appellant argues that “Figure 9 [of Cole] merely illustrates a method for registering an object to be tracked by a mobile device. Step 908 includes receiving a security code — that must be defined in order to track (in the future) the object” (App. Br. 22, citing Cole Fig. 9, 6:30–51).

We are not persuaded by Appellant’s argument. The Examiner finds, and we agree, that

Cole teaches appending a security code onto the identifier contained in the RFID tag. When the RF signal is received from the RFID tag, the tag will be identified only if the security code is defined. Therefore, Cole teaches adding information onto the identifier and still being able to identify the object. Therefore, Cole teaches adding information onto the identifier and still being able to identify the object

(Ans. 10, citing Cole 6:30–51). Appellant fails to challenge the Examiner’s findings regarding the identification of the tag once the security code is appended and defined, as no Reply was filed.

Accordingly, we sustain the Examiner’s rejection of dependent claim 5.

*Issue 7*

Appellant argues that

Plut teaches of providing awards based on the total value of purchases — but this does not amount to a change in rewards characteristic — and especially does not teach or suggest *sending by the server a message to an electronic device associated with an owner of the wearable product when a change in rewards characteristics exceeds a predetermined value*

(App. Br. 23 (emphasis in original), citing Plut ¶ 141).

We are not persuaded by Appellant’s argument. The Examiner finds, and we agree, that “Werner teaches tracking check-ins of an item based on the wireless tag in the item being scanned” and “Werner teaches sending message including by way of text, email, or push messages” (Ans. 10, citing Werner ¶¶ 14, 163). The Examiner further finds, and we agree, that

Plut teaches a referral system that only provides a reward when the purchase from the referred user exceeds a certain amount of money. The amount of money required to earn the reward is considered to be the predetermined value, the total amount of the purchase is considered to be the change in the reward characteristic, and the purchase amount is considered the reward characteristic

(Ans. 10–11, citing *Plut* ¶ 141). Appellant argues *Plut* individually and fails to consider the combination of the teachings of the references. “[O]ne cannot show non-obviousness by attacking references individually where . . . the rejections are based on combinations of references.” *In re Keller*, 642 F.2d 413, 426 (CCPA 1981). Appellant further fails to challenge the Examiner’s findings regarding *Plut*’s teachings and the interpretation of claim 23, as no Reply was filed.

Accordingly, we affirm the Examiner’s rejection of dependent claim 23.

#### CONCLUSION

The Examiner *erred* in finding:

1. claims 1–25 as failing to comply with both the written description requirement and the enablement requirement; and
2. the claimed invention to be directed to a judicial exception without significantly more.

The Examiner *did not err* in finding:

3. the combination of *Werner* and *Kwon* teaches or suggests the limitation of “issuing, by the server and responsive to the request for additional information, a reward associated directly with the wearable product,” as recited in independent claim 1;
4. the combination of *Werner* and *Kwon* teaches or suggests the limitation of “the reward is issued before the wearable product is purchased,” as recited in dependent claim 24;

5. the combination of Werner, Kwon, and Pfuhl teaches or suggests the limitation of “identifying wearable product by the server despite the changes in the value identifying the wearable product,” as recited in dependent claim 4;
6. the combination of Werner, Kwon, and Cole teaches or suggests the limitation of  

the value identifying the wearable product changes according to other values sent between the potential customer’s device and the wireless tag; and wherein the method comprises identifying the wearable product by the server despite the changes in the value identifying the wearable product,

as recited in dependent claim 5; and
7. the combination of Werner, Kwon, and Plut teaches or suggests the limitation of  

storing by the server a log of previous events associated with the wearable product and sending by the server a message to an electronic device associated with an owner of the wearable product when a change in rewards characteristics exceeds a predetermined value,

as recited in dependent claim 23.

## DECISION

The Examiner’s decision rejecting claims 1–25 under 35 U.S.C. § 112(a) is reversed.

The Examiner’s decision rejecting claims 1–25 under 35 U.S.C. § 101 is reversed.

The Examiner’s decision rejecting claims 1–25 under 35 U.S.C. § 103(a) is affirmed.

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The Examiner's decision is affirmed because we have affirmed at least one ground of rejection with respect to each claim on appeal. *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