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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANTOINE EL DAHER, FARAH M. ALI, SALLY SALAS, and JAMES CLARK

Appeal 2018-001005
Application 12/788,808[1]
Technology Center 2100

Before CARL W. WHITEHEAD JR., MICHAEL M. BARRY, and MICHAEL J. ENGLE, *Administrative Patent Judges*.

ENGLE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1, 2, 4–10, 13–17, 19, and 20, which are all of the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Technology

The application relates to "providing hybrid search-results" by "augmenting a web-search result with an event-search result." Spec. ¶ 3.

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[1] According to Appellants, the real party in interest is Microsoft Technology Licensing, LLC, "which is a subsidiary of" Microsoft Corp. App. Br. 4.

Illustrative Claims

Independent claims 15 and 10 are illustrative and reproduced below, with certain portions at issue emphasized:

> 15. One or more computer storage media storing computer-useable instructions that, when used by one or more computing devices, cause the one or more computing devices to provide hybrid search-results, *the hybrid search-results comprising:*
>
> *a first portion of the hybrid search-results that includes an Internet search result*, the Internet search result identified from an Internet-document database and associated with an Internet page, wherein the Internet search result is responsive to an Internet search query received from a user; and
>
> *a second portion of the hybrid search-results that includes an event-search result*, the event-search result identified from an event database and associated with a time and a location, wherein the event-search result is identified based on a query of the event database, wherein the query comprises the Internet search query received from the user and a location of the user at a time when the Internet search query was received.

> 10. One or more computer storage media storing computer-useable instructions that, when used by one or more computing devices, cause the one or more computing devices to perform a method comprising:
>
> receiving an Internet search query from a user;
>
> based on receiving the Internet search query from the user, automatically identifying a location associated with the user;
>
> based on utilizing a combination of the received Internet search query and the location associated with the user to query an event database, determining whether the Internet search query is related to an event in the event database associated with the location;
>
> determining that there is no event in the event database associated with the location and the Internet search query;

> determining to provide an event alert link to the user, wherein determining to provide the event alert link comprises determining that at least one event category in the event database is associated with the received Internet search query, and further wherein selection of the event alert link generates an event-alert request for notification of subsequent events that are added to the event database and that are associated with the location and the Internet search query;
>
> identifying an Internet search result based on the Internet search query; and
>
> *providing the Internet search result and the event alert link with the Internet search result for display to the user.*

Rejections

Claims 1, 2, 4–10, 13–17, 19, and 20 stand rejected under 35 U.S.C. § 101 as directed to signals *per se*. Ans. 7.

Claims 1, 2, 4–10, 13–17, 19, and 20 stand rejected under 35 U.S.C. § 101 as directed to an abstract idea without significantly more. Ans. 2.

Claims 15–17 stand rejected under 35 U.S.C. § 102(b) as anticipated by Gibson et al. (US 8,731,526 B2; May 20, 2014). Final Act. 16.

Claims 1, 2, and 4–10 stand rejected under 35 U.S.C. § 103(a) as obvious over the combination of Gibson and Ott et al. (US 2008/0168033 A1; July 10, 2008). Final Act. 6, 11.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as obvious over the combination of Ott, Gibson, and Youn et al. (US 2008/0019527 A1; Jan. 24, 2008). Final Act. 14.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as obvious over the combination of Ott, Gibson, and Hendrickson (US 2011/0040655 A1; Feb. 17, 2011). Final Act. 15.

Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as obvious over the combination of Gibson and Ramer et al. (US 2007/0094042 A1; Apr. 26, 2007). Final Act. 18.

ISSUES

1. Did the Examiner err in concluding that the claims were directed to signals *per se* under § 101?

2. Did the Examiner err in concluding that the claims were directed to an abstract idea under § 101?

3. Did the Examiner err in finding that Gibson disclosed "hybrid search-results" including "an Internet search result" and "an event-search result," as recited in independent claim 15?

4. Did the Examiner err in finding that the combination of Gibson and Ott taught or suggested "providing the Internet search result and the event-search result," as recited in independent claim 1?

5. Did the Examiner err in finding that the combination of Gibson and Ott taught or suggested "providing the Internet search result and the event alert link with the Internet search result," as recited in independent claim 10?

ANALYSIS

§ 101

A) Signals Per Se

All three independent claims (1, 10, and 15) recite "[o]ne or more computer storage media storing computer-useable instructions" that when executed cause the performance of various steps.

The Examiner determines that the term "computer storage media" "does not exclude signals per se" and therefore the claims are directed to non-statutory subject matter under § 101. Ans. 7 (citing Spec. ¶ 23).

Appellants argue "the cited paragraph 0023 describes computer **readable** media" whereas "[c]omputer **storage** media is described in **paragraph 0024**, and is explicitly described as 'memory.'" Reply Br. 2.

We are not persuaded of Examiner error. Paragraph 24 of the Specification discloses, "Memory 112 includes computer-storage media in the form of volatile and/or non-volatile memory." Although this provides non-limiting examples of computer-storage media (e.g., "volatile and/or non-volatile memory"), it is not a definition and it does not exclude other forms of computer-storage media, such as signals *per se*.

The Federal Circuit has held that "transitory forms of signal transmission such as radio broadcasts, electrical signals through a wire, and light pulses through a fiber-optic cable . . . . are not directed to statutory subject matter." *In re Nuijten*, 500 F.3d 1346, 1353 (Fed. Cir. 2007). More recently, a precedential PTAB decision held that "those of ordinary skill in the art would understand the claim term 'machine-readable storage medium' would include signals *per se*." *Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013) (precedential). "[W]here, as here, the broadest reasonable interpretations of . . . the claims . . . covers a signal *per se*, the claims must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter." *Id.*; *Nuijten*, 500 F.3d at 1352.

Here, the claimed "computer storage media" is not distinguishable from the "machine-readable storage medium" in *Mewherter*.

Accordingly, we sustain the Examiner's rejection of claims 1, 2, 4–10, 13–17, 19, and 20 under § 101 for covering signals *per se*.

B) Abstract Idea

The Examiner determines that independent claims 1, 10, and 15 are "directed to the abstract idea of taking a user's location into account when receiving the user's query to provide search results associated with events or stores near that user and alerting the user." Ans. 2.

Appellants argue, "The claims are not merely directed toward 'taking a user's location into account' when providing search results. Rather, the claims recite . . . that a received Internet search query is utilized **in an unconventional manner**, e.g., to generate hybrid search results by performing two different types of searches." Reply Br. 3–4.

The Federal Circuit has held that "[t]he first stage of the *Alice* inquiry looks at the 'focus' of the claims, their 'character as a whole.'" *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1167 (Fed. Cir. 2018) (quotation marks omitted). We agree with Appellants that the Examiner's determination fails to address the "focus" of the claims, namely "to provide hybrid search-results" that include "an Internet search result" and "an event-search result," as recited in independent claim 15 and commensurately recited in claim 1. Similarly, independent claim 10 recites hybrid search results in the form of "providing the Internet search result and the event alert link with the Internet search result for display to the user." Thus, absent any hybrid search results, the Examiner's proposed abstract idea ("taking a user's location into account . . . to provide search results associated with events . . .") does not accurately reflect what the claims are "directed to." Consequently, we are persuaded by Appellants' arguments that the

Examiner has not shown the claims are "directed to" a judicial exception, such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

Accordingly, we do not sustain the Examiner's rejection of independent claims 1, 10, and 15 and their dependent claims 2, 4–9, 13, 14, 16, 17, 19, and 20 as being directed to an abstract idea.

§ 102
(Claims 15–17)

Independent claim 15 recites "hybrid search results" comprising "a first portion . . . that includes an Internet search result" and "a second portion . . . that includes an event-search result."

The Examiner relies on Gibson as anticipating claim 15. Final Act. 16. The Examiner finds that "Gibson does teach that third party web site(s) receive users' queries and display to the users, advertisements, supplementing or substituting information in addition to communicating with the network based system 110 [e.g., an online ticket marketplace] for further information/search results." Ans. 26; *see also id.* at 25 (citing Gibson 7:35–64).

Appellants argue that Gibson teaches "a search for an event" or tickets to an event using an online ticket marketplace, but not "searching the Internet" nor "hybrid search results" with both events and Internet search results. App. Br. 46–48. According to Appellants, "the cited portion of Gibson describes how a user may **access the online ticket marketplace** via a third-party website," but does not disclose providing both the third party results and the online ticket marketplace's event results in response to the same query. *Id.* at 15.

We agree with Appellants. The Examiner is correct that Gibson discloses a "third party" can be used "for promoting, enhancing, complementing, supplementing, and/or substituting for one [or] more services provided by the network-based system 110," such as "to provide the client 102 with additional services and/or information." Gibson 7:36–43; *see* Ans. 25. "The web site of the third party 112 (e.g., affiliate, partner) may comprise, for example, a hyperlinked advertisement, a web widget, and/or an API implementation . . . to present . . . content hosted by the network-based system 110 and/or to provide programmatic access to the network-based system 110." Gibson 7:49–55. Gibson even discloses that the third-party web site can be "a search engine web site." *Id.* at 7:56–64. Nevertheless, even if the third party "search engine web site" discloses Internet search results, the Examiner fails to explain how Gibson discloses "hybrid search results" with both "Internet search results" and "event search results" in response to the same query, as required by claim 15. *See* Final Act. 16–17.

Accordingly, we do not sustain the Examiner's rejection of independent claim 15 and its dependent claims 16 and 17 under § 102.

§ 103

A) Claims 1, 2, and 4–9

Similar to claim 15, independent claim 1 recites "providing the Internet search result and the event-search result for display to the user" in response to "an Internet search query."

The Examiner relies on the same portions of Gibson and fails to explain how either Ott or obviousness cure the deficiencies with Gibson discussed above. *See* Final Act. 6–11; Ans. 8–13.

Accordingly, we do not sustain the Examiner's rejection of claim 1 and its dependent claims 2 and 4–9 under § 103.

B) Claims 10, 13, and 14

Independent claim 10 addresses the circumstance when there is no event matching the user's search and location, in which case an "event-alert request" is provided instead of an "event search result." Specifically, claim 10 recites "providing the Internet search result and the event alert link with the Internet search result for display to the user," wherein "selection of the event alert link generates an event-alert request for notification of subsequent events that are added to the event database and that are associated with the location and the Internet search query."

Similar to independent claims 1 and 15, Appellants argue that neither Gibson nor Ott teaches or suggests providing hybrid search results with both the "internet search result" and the "event-alert link." App. Br. 36–37. We agree with Appellants that the Examiner fails to adequately address this limitation. *See, e.g.*, Final Act. 11–15; Ans. 19–20.

Accordingly, we do not sustain the Examiner's rejection of independent claim 10 and its dependent claims 13 and 14 under § 103.

C) Claims 19 and 20

Claims 19 and 20 ultimately depend from independent claim 15. We agree with Appellants that the Examiner has not explained how the additional reference Ramer cures the deficiencies with Gibson discussed above. Final Act. 18–19; App. Br. 15.

Accordingly, we do not sustain the Examiner's rejection of claims 19 and 20 under § 103.

DECISION

For the reasons above, we affirm the Examiner's decision rejecting claims 1, 2, 4–10, 13–17, 19, and 20 under § 101.

We reverse the Examiner's decision rejecting claims 15–17 under § 102 and claims 1, 2, 4–10, 13, 14, 19, and 20 under § 103.

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. § 41.50(f).

AFFIRMED