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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte IAN CUMMINGS

Appeal 2018-001652
Application 12/113,989
Technology Center 3600

Before CARL W. WHITEHEAD JR, JEFFREY S. SMITH and
ERIC B. CHEN, *Administrative Patent Judges*.

WHITEHEAD JR., *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant is appealing the final rejection of claims 1–11 and 13–28 under 35 U.S.C. § 134(a). Appeal Brief 2–9. We have jurisdiction under 35 U.S.C. § 6(b) (2012).

We affirm.

Introduction

The invention is directed to “providing advertising content on a computerized navigator.” Specification ¶ 1.

Illustrative Claim

1. A method of conveying advertising content to a user of a navigation system, comprising the steps of:

providing a vehicle navigation system including a user input device and a display screen providing navigation guidance including the location of advertisers within a geographic region;

receiving information from or about the user indicating that the user would be interested in receiving advertising content through the navigation system, advertising content being defined as information relating to goods or services offered or sold by one of the advertisers;

displaying text or an icon overlaid on a map image on the display screen informing the user through the navigation system that advertising content is available through the navigation system;

receiving a command through the user input to convey the available advertising content; and

conveying the advertising content to the user in response to the command.

Rejections on Appeal

Claims 1–11 and 13–28 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to nonstatutory subject matter. Final Action 2–4.

Claims 1–4, 6–11, 14–19 and 21–27 stand rejected under pre-AIA 35 U.S.C. §103(a) as being unpatentable over Ramaswamy (US Patent 7,640,104 B2; issued December 29, 2009), Park (US Patent 5,627,549; issued May 6, 1977) and Mitsuoka (US Patent Application Publication 2002/0026355 A1; published February 28, 2002). Final Action 4–11.

Claim 5 stands rejected under pre-AIA 35 U.S.C. §103(a) as being unpatentable over Ramaswamy, Park, Mitsuoka and Kumar (US Patent 7,617,122 B2; issued November 10, 2009). Final Action 11.

Claim 13 stands rejected under pre-AIA 35 U.S.C. §103(a) as being unpatentable over Ramaswamy, Park, Mitsuoka and Rodriguez (US Patent

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Application Publication 2003/0154475 A1; published August 14, 2003).
Final Action 12.

Claim 20 stands rejected under pre-AIA 35 U.S.C. §103(a) as being unpatentable over Ramaswamy, Park, Mitsuoka and Smith (US Patent Application Publication 2007/0210937 A1; published September 13, 2007).
Final Action 12–13.

Claim 28 stands rejected under pre-AIA 35 U.S.C. §103(a) as being unpatentable over Ramaswamy, Park, Mitsuoka and Jobs (US Patent Application Publication 2008/0122796 A1; published May 29, 2008). Final Action 13.

ANALYSIS

Rather than reiterate the arguments of Appellant and the Examiner, we refer to the Appeal Brief (filed July 17, 2017), the Reply Brief (filed December 4, 2017), the Final Action (mailed November 18, 2016) and the Answer (mailed October 3, 2017) for the respective details.

35 U.S.C. §101 rejection

The Examiner determines the claims are patent ineligible under 35 U.S.C. § 101 because the claims are directed to an abstract idea comprising a fundamental economic practice or organizing human activity, and do not include additional elements that are sufficient to amount to significantly more than the abstract idea. Final Action 2; *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 Briefs 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 are not persuaded the Examiner’s rejection is in error. We adopt the Examiner’s findings and conclusions as our own, and we add the following primarily for emphasis and clarification with respect to the Memorandum.

Appellant argues the pending claims are not directed to an abstract idea because “Appellant’s claims reside in a method of conveying

advertising content to a user of a navigation system, and the claims include numerous references to positively recited physical elements. Thus, Appellant’s claims transcend mere ‘abstract ideas.’” Appeal Brief 2.

We agree with the Examiner’s determination that the claims are directed to an abstract idea. *See* Final Rejection 2–4. Claim 1 recites a “method of conveying advertising content to a user of a navigation system” wherein information is received by the user from an unspecified source where the user’s interest in receiving advertising content is not at issue and where the “advertising content being defined as information relating to goods or services offered or sold by one of the advertisers.” These steps comprise fundamental economic principles or practices and/or commercial or legal interactions; thus the claim recites the abstract idea of “certain methods of organizing human activity.” Memorandum, Section I (Groupings of Abstract Ideas); *see* Specification ¶ 27. Our reviewing court has found claims to be directed to abstract ideas when they recited similar subject matter. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (using advertising).

Appellant argues that although the Examiner acknowledged that claim 1 recited “‘additional limitations’ of a vehicle navigation system, user input device and display screen” - the Examiner stated that “‘all are described in the claim and specification as conventional electronic components.’” Appeal Brief 4 (*citing* Final Action 3.) Appellant contends, “*Never* did Appellant describe any of its physical hardware as ‘conventional.’” Appeal Brief 4.

We do not find Appellant’s argument persuasive because claim 1 appears to be utilizing the vehicle navigation system as merely a tool to distribute advertising content. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016). (“[W]e find it relevant to ask whether the claims are directed to an improvement to computer functionality versus being directed to an abstract idea . . . the focus of the claims is on the specific asserted improvement in computer capabilities (i.e., the self-referential table for a computer database) or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.”). Claim 1 does not recite an additional element or elements that reflect an improvement in the functioning of a computer, or an improvement to other technology or technical field. *See* Final Action 4 (“The ordered combination does not appear to improve the functioning of the computer itself or improvement to another technology or technical field.”); *Alice*, 573 U.S. at 222 (“In holding that the process was patent ineligible, we rejected the argument that ‘implement[ing] a principle in some specific fashion’ will ‘automatically fal[l] within the patentable subject matter of § 101.’”) (quoting *Parker v. Flook*, 437 U.S. 584, 593(1978)).

Accordingly, we determine the claim does not integrate the judicial exception into a practical application. *See* Memorandum, Section III(A)(2) (Prong Two: If the Claim Recites a Judicial Exception, Evaluate Whether the Judicial Exception Is Integrated Into a Practical Application). Nor do we find the claim includes a specific limitation or a combination of elements that amounts to significantly more than the judicial exception itself. *See* Memorandum, Section III(B)(Step 2B: If the Claim Is Directed to a Judicial Exception, Evaluate Whether the Claim Provides an Inventive Concept); *see*

also Aatrix Software, Inc. v. Green Shades Software, Inc., 890 F.3d 1354, 1359 (Fed. Cir. 2018) (“the ‘inventive concept’ cannot be the abstract idea itself”).

Appellant contends, “Assuming Appellant’s claims distinguish over the prior art, which Appellant certainly believes per the rebuttal arguments of record on the merits, then by definition the [claimed] steps *are not* routine, well-understood or conventional.” Reply Brief 2. Appellant further contends, “[s]ince Appellant’s method steps are [] non-obvious, no existing vehicle navigation system is simply performing Appellant’s functions, nor are such functions expected from any conventional navigation system. The Examiner has not pointed to any existing or ‘conventional’ navigation system which performs any of Appellant’s distinguishing functions.” Reply Brief 3. It is noted, as the Federal Circuit has explained, a “‘claim for a *new* abstract idea is still an abstract idea.’” *SAP America, Inc. v. Investpic, LLC*, 890 F.3d 1016, 1018 (Fed. Cir. 2018) (quoting *Synopsis, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016)). Even assuming the technique claimed was “‘innovative, or even brilliant,’” that would not be enough for the claimed abstract idea to be patent eligible. *See SAP America*, 890 F.3d at 1018.

The Examiner finds, “the input device and display screen are simply performing their generic function of receiving input and displaying information” and therefore “the additional limitations are simply performing their routine, well-understood and conventional function similar to what has been found by the courts (in *Alice*) not to be adding significantly more to the underlying abstract idea.” Final Action 3. The Examiner determines, “[t]he physical elements do not transform the abstract idea to a patent eligible

subject matter since the physical elements are performing their routine, well-understood and conventional function (Step 2B).” Answer 2–3.

We do not find Appellant’s argument persuasive. Other than the abstract idea itself, the remaining claim elements only recite generic computer components that are well-understood, routine, and conventional. *See Alice*, 573 U.S. at 226. Accordingly, we agree with the Examiner that claims 1–11 and 13–28, not argued separately, are not patent eligible. *See* Appeal Brief 2.

35 U.S.C. §103 rejections

Claims 1–4, 6–8, 9–11, 14–19 and 21–27

Appellant contends, “Ramaswamy relates to GPS navigation, but emphasizes the *locations of businesses* (*i.e.*, ‘waypoints’), which is not advertising content per Appellant’s claimed definition” and “Ramaswamy does not teach Appellant’s step of ‘receiving information from or about the user indicating that the user would be interested in receiving advertising content through the navigation system.’” Appeal Brief 5. Appellant further contends, “Col. 6:3-5 of Ramaswamy states that ‘[o]nce the logic filter 102 has been established, the navigation system receives advertising content from advertising providers.’” Appeal Brief 5. Appellant concludes, “[t]his is unrelated to receiving information indicating *that the user would be interested in receiving* through the navigation system.” Appeal Brief 5. We find Appellant’s contentions are counterintuitive to Ramaswamy’s actual disclosure.

Claim 1 recites, “receiving information from or about the user indicating that the user would be interested in receiving advertising content through the navigation system.” Ramaswamy discloses “the navigation system **20** optionally includes a system for extracting information regarding the occupants of the vehicle and then utilizes that extracted information to selectively display advertising regarding waypoints on the navigation screen **38**.” Ramaswamy, column 5, lines 5–9; Final Action 5. It is evident that Ramaswamy’s waypoints are not advertising content but entities from which the advertising content originates. It is also evident that Ramaswamy discloses the advertising content is modified based upon the interest of the vehicle’s occupants and the location of the vehicle. Ramaswamy, column 6, lines 36–43 (“[T]he display of advertising content on the navigation system screen **38** is filtered to not only limit the display of the advertising content to advertisements that may be of interest to the vehicle occupants, but to also filter the received advertising content as a function of the vehicle route so that only advertising content within a reasonable distance from the route will be shown on the display screen.”); Final Action 5.

Appellant argues that Park fails to address the alleged deficiency of Ramaswamy because, “[a]lthough in Park a user can select a data record of interest, Appellant’s claimed step requires ‘receiving information from or about the user indicating that the user would be interested in receiving advertising content through the navigation system,’ which Park fails to disclose or suggest.” Appeal Brief 6. We do not find Appellant’s argument persuasive because Park discloses, “device 40^[1] monitors the stream of data

¹ “A travel information device likely to be soon more commonly

provided in data broadcast 22 and compares location information therein to the current vehicle location to collect all references within a given distance of current vehicle location. Additionally, the user establishes a category of interest, e.g., auto parts advertisements, grocery store advertisements, sporting goods or restaurant advertisements, to further filter information available in data broadcast 22.” Park, column 7, lines 1–8; Final Action 6. Further, we find Park superfluous in view of the disclosure of Ramaswamy as discussed above.

Appellant notes:

The Examiner concedes that Ramaswamy and Park do not disclose several of Appellant’s steps, including:

informing the user through the navigation system that advertising content is available through the navigation system;

receiving a command through the user input to convey the available advertising content; and

conveying the advertising content to the user in response to the command.

Note that “informing the user through the navigation system that advertising content is available through the navigation system” is actually an incomplete paraphrasing of Appellant’s step, which reads in its entirety:

“displaying text or an icon overlaid on a map image on the display screen informing the user through the navigation system that advertising content is available through the navigation system.”

Appeal Brief 6.

incorporated into vehicles is a vehicle position detecting system, e.g., the well known global positioning system (GPS) providing satellite broadcast to determine location of a receiving GPS device.” Park, column 1, lines 15–21.

Appellant argues that Mitsuoka failed to address the alleged deficiencies of the Ramaswamy/Park combination. Appeal Brief 6. The Examiner finds Ramaswamy discloses displaying text or an icon on the map image that advertising content is available. Final Action 5 (citing Ramaswamy, column 1, lines 14–19, Figure 2). Ramaswamy discloses, “Once the appropriate waypoint has been identified and the waypoint is within the map currently display on the screen. The waypoint optionally containing additional information relative to the waypoint, is displayed on the screen **38** as shown at **64** (FIG. 2).” Ramaswamy, column 4, lines 18–24. Whereas it has been noted above that the additional information could contain advertising content. *See* Ramaswamy, column 6, lines 35–43.

Claim 1 recites, “providing a vehicle navigation system including a user input device and a display screen.” Ramaswamy in column 3, lines 13–19 discloses:

A receiving or entry device **40** for the navigation system **20** enables an occupant of the vehicle to enter a desired destination point to the navigation system **20**. The entry device **40** may be of any conventional construction, such as a touch screen (which may be the same as the display screen **38**), a keyboard, a speech processor that receives oral commands via a microphone, or the like.

As stated above, the navigation system includes a system for extracting information about the vehicle’s occupants and using the information to select relevant advertising regarding the waypoints wherein, “One method of extracting information concerning the occupants of the vehicle is to include a microphone **80** within the vehicle occupation compartment so that the microphone **80** picks up speech from the vehicle occupants.” Ramaswamy,

column 5, lines 10–13. It is evident that Ramaswamy provides both a user input device for the user to *command* or indicate advertising content preferences and a display screen as recited in claim 1. Also, as discussed above, Ramaswamy discloses the advertising content is modified based upon the interest of the vehicle’s occupants and the location of the vehicle.

Ramaswamy, column 6, lines 36–43. Accordingly, we do not find Appellant’s arguments persuasive because the disputed claim 1 limitations read upon Ramaswamy’s disclosure as discussed above and we further find Mitsuoka superfluous in view of the disclosure of Ramaswamy as discussed above. We consequently sustain the Examiner’s obviousness rejection of claims 1–4, 6–8, 9–11, 14–19 and 21–27 not argued separately. *See* Appeal Brief 5.

Claim 5

Appellants contend, “[c]laim 5 adds to claim 1 the limitation that the information about the user includes demographic information about the user.” Appeal Brief 7. The Specification merely discloses, “[a]lternatively, such information may include demographic information about the user.” Specification ¶ 12. Ramaswamy discloses wherein the user’s advertising content is based upon the vehicle occupants’ information, as discussed above, accordingly, we find it would have been obvious for the vehicle occupants in Ramaswamy to indicate their ages in order to receive age approximate advertising content within a geographical region. “As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 550 U.S.

398, 418 (2007).

The Examiner finds, “Kumar discloses wherein the information about the user includes demographic information about the user (claims 2, 8, 14).” Final Action 11. Appellant argues, “Kumar relate ‘improved targeted marketing techniques that target users navigating online environments,’ and has nothing to do with vehicle navigation, let alone wireless client-server vehicle navigation.” Appeal Brief 7. We do not find Appellant’s argument persuasive because the claimed user’s information is not based upon the vehicle navigation, it is based upon the user’s information which includes demographical information.

Claim 13

Appellant argues, “Rodriguez has nothing to do with Appellant’s invention. Rather, Rodriguez relates to television, and more particularly, to subscriber television systems and methods for increasing the viewing of television advertisements by reducing viewer *avoidance*.” Appeal Brief 8. The Examiner finds, “Rodriguez discloses wherein the text or icon is presented in a manner visually discernable from indicators for locations for which advertising content is not available ([0052], a value is associated with each of the advertisement (a value of zero implies that coupon has no value or not available).” Final Action 12. The Specification merely discloses, “[i]ndicators for locations for which advertising content is available may be presented in a manner visually discernable from indicators for locations for which advertising content is not available.” Specification ¶ 14. Claim 13 uses different icons or text to differentiate locations in which advertising content is not available. One of the prime purposes of employing icons or text is to differentiate elements and we find using

different icons or text to differentiate locations would have been an obvious modification to Ramaswamy's invention. "As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

Claim 20

Appellant argues, "[a]ppellant's claim 20 adds to claim 1 that the advertising content includes a telephone number, address, email address or other information enabling the user to contact a party associated with the advertisement." Appeal Brief 20. The Examiner finds, "Smith discloses wherein the advertising content includes a telephone number, address, email address or other information enabling the user to contact a party associated with the advertisement ([0064])." Final Action 12–13. Smith discloses, "[m]ap information and advertisements displayed in conjunction with the map information can be dynamically rendered as a function of a user advertising preference." Abstract. Smith further discloses, "[s]ome embodiments relate to advertisement information that is tailored for a particular user based in part on user preferences") and that map information can include detailed information in regard to a point of interest "regarding a name of a building or other structure can be provided upon request or automatically, such as when a user hovers a mouse over the object. Other information regarding the structure can also be provided, such as telephone numbers, email alias information, web-site information, hours of operation, special events, etc." Smith ¶¶ 9, 64. We do not find Appellant's argument persuasive because the incorporation of an advertiser's contact information

and business location is well known in the art and would have been an obvious modification to the Ramaswamy's invention.

Claim 28

Claim 28 recites “wherein user commands to provide advertising information and user commands to provide guidance to a destination are differentiated by the manner in which the user interacts with the touchscreen.” The Specification discloses in paragraph 19:

The navigation system may be a wireless client-server navigator, and the user may provide[] commands to the navigation system via a touchscreen, in which case user commands to provide advertising information and user commands to provide guidance to a destination may be differentiated by the manner in which the user interacts with the touchscreen.

Appellant argues:

The Examiner's *rationale* to combine Ramaswamy, Park, Mitsuoka, and Jobs is “to use different touch screen gestures as a command.” This motivation is difficult to follow. Does the Examiner mean, literally, that different touch screen gestures can be used *as the same* command? In any case, such a motivation is far too fundamental to support a finding of obviousness.

Appeal Brief 9.

It is not clear from the claim language the manner in which the user commands providing advertising information and the user commands providing guidance is supposed to differentiate. The Specification is silent in regard to the differentiation as well. Accordingly, Ramaswamy in column 3, lines 13–19 discloses:

A receiving or entry device **40** for the navigation system **20** enables an occupant of the vehicle to enter a desired destination

point to the navigation system **20**. The entry device **40** may be of any conventional construction, such as a touch screen (which may be the same as the display screen **38**), a keyboard, a speech processor that receives oral commands via a microphone, or the like.

We find Ramaswamy differentiates the user's commands by recognizing the manner in which the command is received by the entry device in the same manner as required by the claim. Subsequently, we sustain the Examiner's obviousness rejection of claim 28.

DECISION

The Examiner's nonstatutory subject matter rejection of claims 1–11 and 13–28 is affirmed.

The Examiner's obviousness rejections of claims 1–11 and 13–28 are affirmed.

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). *See* 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED