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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MOHAMMAD KHAN¹

Appeal 2018-002246
Application 13/211,082
Technology Center 3600

Before ALLEN R. MACDONALD, CARL W. WHITEHEAD JR and
JEFFREY S. SMITH, *Administrative Patent Judges*.

WHITEHEAD JR., *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant is appealing the final rejection of claims 1–7, 9–20 and 22–
27 under 35 U.S.C. § 134(a). Appeal Brief 10–11. We have jurisdiction
under 35 U.S.C. § 6(b) (2012).

We affirm.

Introduction

The invention is directed to “methods, systems, and computer
readable media for providing an electronic advertisement to a mobile
device.” Specification 1.

¹ According to Appellant, the real party in interest is MasterCard
International Incorporated. Appeal Br. 2.

Illustrative Claim

1. A method for providing an electronic advertisement to a mobile device, the method comprising:

at a trigger management server, serving as a central point of contact for electronic offer certificate request messages from a mobile device, receiving an electronic offer certificate request message from the mobile device in response to the mobile device interfacing with a touch point, obtaining a first offer identifier from the electronic certificate request message, identifying an advertising management server associated with the first offer identifier, and forwarding the electronic offer certificate request message to the advertisement management server;

receiving, by the advertisement management server, the electronic offer certificate request message including the first offer identifier obtained by interfacing the mobile device with the touch point and a subscriber identifier associated with the mobile device;

identifying, by an offer management module of the advertisement management server and based on the first offer identifier, a first electronic offer certificate;

communicating, by the offer management module, the first electronic offer certificate to an over the air (OTA) provisioning server separate from the trigger management server;

provisioning, by the OTA provisioning server, a wallet application on the mobile device with the first electronic offer certificate;

identifying, by an advertisement management module of the advertisement management server and based on the first offer identifier, an electronic advertisement for at least one product or service, wherein identifying the electronic advertisement includes querying an advertisement policy database to obtain an advertisement policy that specifies that the identified electronic advertisement is based at least on an electronic offer certificate history associated with the subscriber identifier, wherein the electronic offer certificate history includes location information of touch points previously interfaced by the mobile device; and

utilizing, by the advertisement management server, the subscriber identifier to communicate the identified electronic advertisement to the mobile device, wherein the electronic

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advertisement is provided to be displayed by the mobile device upon the redemption of the first electronic offer certificate.

Rejections on Appeal

Claims 1–7, 9–20 and 22–27 stand rejected under 35 U.S.C. § 112(b) or (for pre-AIA) 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor, a joint inventor, or (for pre-AIA) the applicant regards as the invention. Final Action 2–4.

Claims 1–7, 9–20 and 22–27 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to nonstatutory subject matter. Final Action 4–7.

Claims 1, 2, 4, 7, 10–11, 13–15, 17, 20, 23–24 and 26–27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar (US Patent Application Publication 2010/0241494 A1; published September 23, 2010); MacIlwaine (US Patent Application Publication 2011/0125565 A1; published May 26, 2011); Sakata (US Patent Application Publication 2002/0138347 A1; published September 26, 2002) and Sterling (US Patent Application Publication 2009/0265228 A1; published October 22, 2009). Final Action 7–21.

Claims 12 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar, MacIlwaine, Sakata, Sterling and Lin (US Patent Application Publication 2011/0161158 A1; published June 30, 2011). Final Action 21–22.

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Claims 5, 6, 8, 9, 18, 19, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar, MacIlwaine, Sakata, Sterling and Ramer (US Patent Application Publication 2009/0234745 A1; published September 17, 2009). Final Action 23–26.

Claims 3 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar, MacIlwaine, Sakata, Sterling and Tulloch (US Patent Application Publication 2010/0161410 A1; published June 24, 2010). Final Action 26–28.

ANALYSIS

Rather than reiterate the arguments of Appellant and the Examiner, we refer to the Appeal Brief (filed June 20, 2017), the Reply Brief (filed December 20, 2017), the Final Action (mailed December 20, 2016) and the Answer (mailed October 20, 2017) for the respective details.

35 U.S.C. § 112 rejection

The Examiner finds independent claims 1, 14 and 27 has two plausible distinct interpretations because:

[T]he definition of the term “upon” is: “a formal term for “on”, especially in an abstract sense.” The preposition upon has the same core meaning as the preposition on. However, in modern English upon tends to be restricted to more formal contexts or to established phrases and idioms, as in once upon a time and row upon row of seats.

Final Action 3.

Appellant “submits that the independent claims are not ambiguous and that [the] interpretation (i.e., the electronic advertisement is provided to be displayed by the mobile device) is the proper interpretation based on the reading of the claims. It is further submitted that the

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Specification supports this interpretation on page 11, line 24 – page 12, line 1.” Appeal Brief 11.

We find Appellant’s argument persuasive. We reverse the Examiner’s 35 U.S.C. § 112(b) rejection of claims 1–7, 9–20 and 22–27.

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)).

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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 “independent claims 1, 14, and 27 respectively recite a method, a system, and a computer readable medium for providing an electronic advertisement to a mobile device.” Appeal Brief 12–13.

We agree with the Examiner’s determination that the claims are directed to an abstract idea. *See* Final Rejection 4–7. Claim 1 recites a “method for providing an electronic advertisement to a mobile device” wherein upon “receiving an electronic offer certificate request message from the mobile device in response to the mobile device interfacing with a touch point” an “electronic advertisement is provided to be displayed by the mobile device upon the redemption of the first electronic offer certificate” in accordance to “an advertisement policy that specifies that the identified electronic advertisement is based at least on an electronic offer certificate history.” These steps comprise fundamental economic principles or

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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 1. 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 “the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” Appeal Brief 12. We do not find Appellant’s argument persuasive because claims 1, 14 and 27 appear to be utilizing the network 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.”). Claims 1, 14 and 27 do 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 6 (“[T]he step of obtaining an offer identifier through a generically described method of interfacing a mobile device with a touch-point/smart poster is not novel nor is it the focus of applicant’s invention; it is merely an application of the identified abstract concepts to a field of use; i.e. NFC [near field communications] and RFID [radio frequency identification] are technologies which are merely used but

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not which are themselves being improved upon and it is not disputed that such technology was old and well-known at the time of applicant's invention."); *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"). Other than the abstract idea itself, the remaining claim elements only recite generic computer components that are well-understood, routine, and conventional. See Final Action 6; Specification 5–7; *Alice*, 573 U.S. at 226.

Accordingly, we agree with the Examiner that claims 1–7, 9–20 and 22–27, not argued separately, are not patent eligible. See Appeal Brief 12.

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35 U.S.C. § 103 rejections

Claims 1, 2, 4, 7, 10–11, 13–15, 17, 20, 23–24 and 26–27

Appellant contend that Kumar’s “softcard coupon needs to be displayed on the mobile device and subsequently selected via the GUI sometime prior to the user redeeming the ecoupon/softcard coupon.” Reply Brief 4. Appellant further contends that “that providing the branding/issuer marketing data (which is needed to display the softcard coupon) to the mobile device after a redemption (or, alternatively, a transaction at a transaction terminal **105** as indicated in MacIlwain) would be impracticable and/or incompatible with the system described in Kumar.” Reply Brief 4. Appellant concludes, “the branding/issuer information disclosed in Kumar is necessarily provided to the mobile device for display on the mobile device prior to any conducted transaction, and therefore teaches away from any teaching or suggestion of providing an electronic advertisement after a transaction as disclosed in MacIlwaine.” Reply Brief 4.

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (citations and internal quotation marks omitted). *See also In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (noting that merely disclosing more than one alternative does not teach away from any of these alternatives if the disclosure does not criticize, discredit, or otherwise discourage the alternatives). Accordingly, we do not find Appellant’s argument persuasive because Appellant has not indicated where Kumar discourages modification by providing electronic advertisement as disclosed by MacIlwaine.

Claim 1 requires, “wherein the electronic advertisement is provided to be displayed by the mobile device upon the redemption of the first electronic offer certificate.”

Kumar’s Figure 3 is reproduced below:

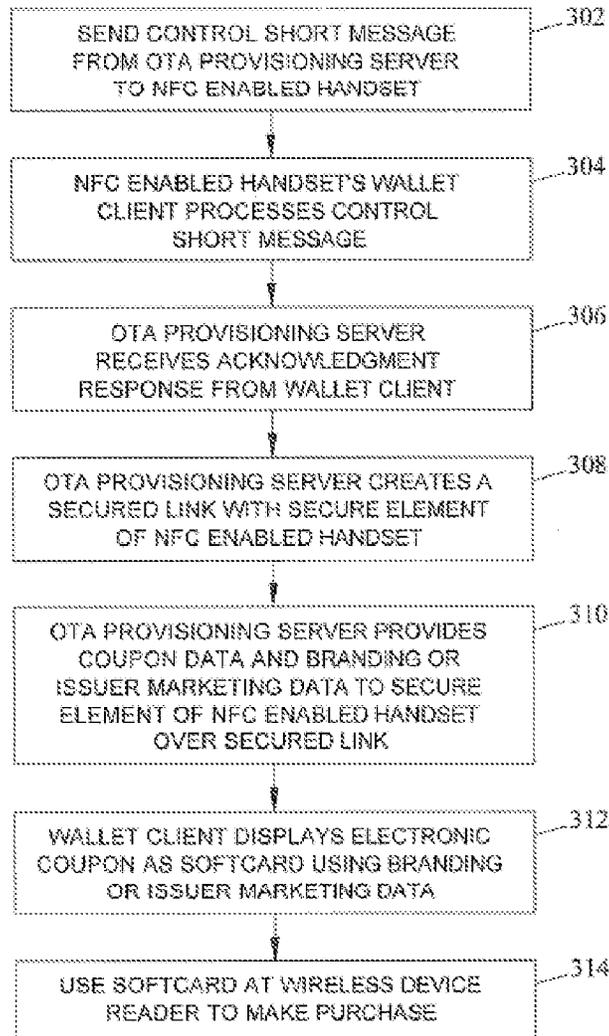


Figure 3 “depict a flow chart of an exemplary method 300 for delivering an electronic coupon to an NFC enabled mobile device.” Kumar, ¶ 41.

McIlwaine discloses, “an advertising network is provided based on a transaction handler to present personalized or targeted advertisements/offers on behalf of advertisers.” Mallwaine ¶ 29. McIlwaine further discloses accumulated transaction data is used to:

[G]enerate intelligence information about the purchase behavior, pattern, preference, tendency, frequency, trend, amount and/or propensity of the users (e.g., 101), as individuals or as a member of a group. The intelligence information can then be used to generate, identify and/or select targeted advertisements for presentation to the user (101) on the point of interaction (107), during a transaction, after a transaction, or when other opportunities arise.

Mallwaine ¶ 399; *see* Final Action 11.

“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Subsequently, we agree with the Examiner’s findings that it would have been obvious to one skilled in the art to modify Kumar by providing electronic advertisement to a mobile device upon the redemption of the first electronic offer certificate. We sustain the rejection for claim 1, as well as, dependent claims 2, 4, 7, 10, 11 and 13, not argued separately. *See* Appeal Brief 18. We also sustain the Examiner’s obviousness rejection for independent claims 14 and 27 wherein the arguments made for claim 1 as essentially the same. *See* Appeal Brief 15, 18–24. We sustain the obviousness rejection of dependent claims 15, 17, 20, 23, 24 and 26 which

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depend upon independent claim 14, not argued separately. *See* Appeal Brief 21.

Claims 3, 5, 6, 8, 9, 12, 16, 18, 19 and 21

We sustain the Examiner's obviousness rejections of dependent claims 5, 6, 8, 9, 12, 18, 19 and 21 because Appellant's arguments are based upon the rejection of the independent claims 1, 14 and 27 which we have sustained as discussed above. *See* Appeal Brief 24–27; *see also* Answer 13–15.

Appellant argues, “Tulloch’s disclosure of a user’s geographical location does not necessarily teach or suggest the determination, based on the first offer identifier, of a location of the touch point and the identification of an electronic advertisement based on the determined location of the touch point as recited in claims 3 and 16.” Appeal Brief 27. The Examiner finds, “Tulloch’s (see [0025]) ‘usage data’ is data regarding usage of a specific ‘smart poster’ and includes ‘geographic location’. As discussed at [0052] the ‘particular location’ refers to the location of the ‘smart poster’. Tulloch is not gathering GPS coordinates of the user device but instead Tulloch teaches that he knows the locations of his ‘smart posters’.” Answer 14. We do not find Appellant’s argument persuasive and agree with the Examiner’s findings. We sustain the Examiner’s obviousness rejection of dependent claims 3 and 16.

DECISION

The Examiner’s 35 U.S.C. § 112(b) rejection of claims 1–7, 9–20 and 22–27 is reversed.

The Examiner’s nonstatutory subject matter rejection of claims 1–7, 9–20 and 22–27 is affirmed.

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The Examiner's obviousness rejections of claims 1–7, 9–20 and 22–27 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