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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WEI-YEH LEE and FRANK J. KOZAK

Appeal 2018-004425
Application 13/135,240
Technology Center 3600

Before KALYAN K. DESHPANDE, CHARLES J. BOUDREAU,
and SHARON FENICK, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–21, 23, and 25, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b)(1).

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Here Global B.V. as the real party in interest. App. Br. 2.

BACKGROUND

Appellant's invention relates to implementing an intermediary between clients and servers, through which communications between the clients and servers must pass, as part of a "trust architecture" to allow a user at a client to control unsolicited server operations without loss of functionality. Spec. ¶¶ 24, 38. For example, an intermediate server may be used to implement "a privacy service on the World Wide Web that acts as an intermediary for all of the data traffic to and from the user's client device, thereby allowing the privacy service to filter the user's data traffic and to perform certain privacy-enhancing functions on the user's data traffic." *Id.* ¶ 9; *see id.* ¶¶ 32, 36, 37.

Claims

Claims 1, 11, and 20 are independent. Claim 1 is exemplary and reproduced below with italicization added for emphasis:

1. An intermediary for use in a client-server architecture, the client-server architecture comprising at least one client in communication, via a network, with at least one server, each of the at least one server being operative to perform at least one unsolicited function with respect to each of the at least one client upon which one or more of the at least one server is at least partially dependent to facilitate stateful operation thereof with respect to the respective at least one client, each of the at least one unsolicited function comprising a passive function with respect to the respective client, the passive function comprising obtaining of client originated data therefrom independently of providing server originated data thereto, the intermediary comprising:

an interface in communication, via the network, with at least a first client of the at least one client and at least a first server of the at least one server and operative to, according to a direction of a user associated with the first client and derived at least in part from data indicative of previous interaction between the user and at least one of the at least one server, cause the first server to perform the at least one unsolicited function with respect to the intermediary on behalf of the

first client such that the first server is unaware that it is not performing the at least one unsolicited function with respect to the first client, *the unsolicited function comprising augmenting content requested by the at least one client with advertising*, the stateful operation of the one or more of the at least one server at least partially dependent on the at least one unsolicited function and subject to the direction of the user, wherein the interface is further operative to receive an instruction from the user with respect to profile information stored by the intermediary on behalf of the user, the profile information comprising a set of location related information items, each having a different level of specificity, the instruction comprising an instruction from the user to provide information of a particular level of specificity from the set based on the location related thereto to at least one of the at least one server, the profile information comprising stateful data configured to be used by at least one of the at least one server to facilitate stateful functionality with respect to the user's network activity and the provided information.

Rejection

The Examiner rejects claims 1–21, 23, and 25 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Ashley et al. (US 2005/0015429 A1; Jan. 20, 2005) (“Ashley”) in view of Stolfo et al. (US 7,536,360 B2; May 19, 2009) (“Stolfo”), Ko et al. (US 2008/0243593 A1; Oct. 2, 2008) (“Ko”), and Paretti et al. (US 2010/0077484 A1; Mar. 25, 2010) (“Paretti”). Final Act. 2–30.

ANALYSIS

The Examiner determines that claims 1–21, 23, and 25 would have been obvious over Ashley in view of Stolfo, Ko, and Paretti. Final Act. 2–30. The Examiner relies on Ko for the limitation that the “unsolicited function” that the server is operative to perform comprises “augmenting content requested by the at least one client with advertising” as recited in independent claims 1, 11, and 20. *Id.* at 7–8, 14, 19. Specifically, the Examiner finds that “Ko teaches server

provision of advertising to augment online content requested by a client device based on a user profile associated with the IP address of the client device and/or cookie information, in either case, gathered by the server from the client device in the process of client/server communications over the web.” *Id.* at 8 (citing Ko ¶¶ 29–30, 47–50). According to the Examiner, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Ashley and Stolfo’s teaching of a server performing unsolicited functions² with Ko’s teaching of supplementing requested content with advertising “in order to improve the targeting of advertising according to advertiser specifications . . . while affording users a degree of control over the dissemination and use of their information.” Final Act. 8 (citations omitted); *see also* Ans. 8.

Appellant argues that Ko fails to teach or suggest that the function (i.e., augmenting content with advertisements) is “unsolicited” as claimed. App. Br. 8. According to Appellant, “the functions provided by Ko are solicited by the user” because “they must log in at least once to identify themselves to the system of Ko.” *Id.* (citing Ko ¶ 50). In other words, Appellant argues that Ko requires the user to log in at least once to provide the user profile information by which targeted advertisements are tailored to the user and that, by logging in and providing user

² *See* Final Act. 3–4 (finding Ashley teaches a server performing an unsolicited function of exchanging cookie data) (citing Ashley ¶¶ 31, 34–35); *id.* at 6–7 (finding Stolfo teaches servers performing unsolicited functions of gathering client IP addresses or proxy server-generated IP addresses) (citing, *inter alia*, Stolfo 3:6–16, 16:48–65); Ans. 8 (finding “the combination of Ashley and Stolfo teaches or suggests that their respective privacy proxies intervene in unsolicited functions performed by a server to help the server deliver targeted content to clients”). Appellant does not dispute these findings.

profile information, the user solicits the advertisements. *See* Reply Br. 4–5 (citing Ko ¶¶ 47–48).

The Examiner disagrees that Ko requires user login, finding instead that Ko’s system “can and does obtain a user profile based on IP address information alone.” Ans. 9–10 (emphasis omitted) (citing Ko ¶¶ 29, 44, 46, 50). Further, the Examiner responds that, based on the phrase “advertising and other unsolicited functionality” in the Specification, the term “unsolicited function,” under its broadest reasonable interpretation, “must be read as including all advertising.” *Id.* at 9 (emphasis omitted) (citing Spec. ¶ 104).

We agree with Appellant that, in Ko, the user logs in at least once, making it possible for advertising content to be tailored to the user based on user profile information. *See* Ko ¶ 47 (“In order to provide the personal services, the system 200 should receive a user identification (ID) and a password from the user.”); *see also id.* ¶ 50 (explaining that, when a search service user logs in at least once, cookie or IP address information is stored in association with the user profile information so that advertising content may still be tailored to the user when the user subsequently performs a search without logging in). And we do not agree with the Examiner that the Specification’s use of the phrase “advertising and other unsolicited functionality” means that the term “unsolicited function” must be construed to encompass *all* advertising. In our view, the phrase “advertising and other unsolicited functionality” in the Specification indicates that unsolicited (i.e., not requested) functionality may include advertising, but does not preclude the possibility of solicited (i.e., requested) advertising. *See* Spec. ¶¶ 31, 32 (describing “unsolicited” functions as unauthorized by, without direction from, or without knowledge of the user and “solicited” operations as user-desired or requested); *see also id.* ¶¶ 54 (discussing a “user selected” advertisement), 102 (describing a user

earning rewards by viewing advertisements), 224 (describing “enabling a user to control or customize” received advertisements); Reply Br. 9 (Appellant stating that the definition of “unsolicited” is “not asked for or requested”).

However, we are unpersuaded by Appellant that the user, by logging in at least once “to identify themselves to the system of Ko,” solicits, i.e., requests, the advertising function. *See* App. Br. 8. As the Examiner points out:

Appellant’s reading [of Ko] requires that in a session where the user did not log in and the system provides tailored advertising to the user based on the IP address of the user’s device, the advertising is nevertheless “solicited” by the user because at some indefinite point in the past, the user did log into the system. Extending that logic, regardless of any disclosure provided or not provided at login, once the user logs into Ko’s system, the user has forever “solicited” all advertising that might be provided to the user’s device. . . . even where the user never logs in again.

Ans. 10. We agree with the Examiner that Appellant reads Ko too narrowly. *See id.* Ko describes a user entering a query word or search keyword to obtain information from the Internet, which is provided along with advertisement data, and Ko further describes a system which provides “personal services for each user” such as “search services, email functions, communities, [and] blogs.” Ko ¶¶ 3, 5–8, 47. We are unpersuaded that Ko’s login equates to soliciting, desiring, or requesting targeted advertisements during the use of Ko’s system, even if the user provides user profile information at login and receives advertisements during the use of the system. *See* App. Br. 8. Therefore we disagree with Appellant that in Ko the user solicits advertisements by merely logging in.

Thus, we are unpersuaded that the Examiner erred in finding that Ko, in combination with Ashley and Stolfo, would have taught or suggested to one of ordinary skill in the art the limitation of “the unsolicited function comprising augmenting content requested by the at least one client with advertising.”

Appellant argues that the Examiner uses improper hindsight reasoning and that “if Appellant’s claimed combination was so well known or ubiquitous, the Examiner should have had no problem locating a reference teaching these limitations.” Reply Br. 8 (responding to Examiner’s statement that it “would have required nothing more than common sense” to apply Ko’s teaching of supplementing requested content with advertising to Ashley and Stolfo because “supplementation of requested internet/web content with advertising was ubiquitous” at the time of the invention (*see* Ans. 8)). Appellant’s argument that all the limitations are not described in a single reference is unpersuasive because the Examiner has rejected the claims under 35 U.S.C. § 103, not § 102. Furthermore, Appellant’s bald statement that the combination of the references is based on improper hindsight reasoning does not present a specific argument regarding any error in the Examiner’s determinations relating to what the combination of disclosures taken a whole would have suggested to one of ordinary skill in the art at the time of the invention. *See In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971).

Appellant argues that “one of ordinary skill in the art would not be motivated to combine the teachings of Ko with those of Ashley, Stolfo and Paretti.” App. Br. 7–8. However, beyond this statement, no argument relating to a lack of motivation for the combination is supplied. *Id.* at 8. In the Reply Brief, Appellant argues for the first time that combining Ko with Ashley and Stolfo “would undermine the operation and stated goals of both Ashley and Stolfo to prevent identification of the user” (Reply Br. 5–6), that the Examiner fails to adequately explain how the combination would result in improved targeted advertising (*id.* at 11), that “neither the system of Ashley/Stolfo nor the system of Ko would be improved via the combination” (*id.* at 7), and that the function in Ko

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is not a passive function (*id.* at 9–10). We do not consider those assertions because they are improper new arguments. *See* 37 C.F.R. 41.41(b)(2).

For the foregoing reasons, we sustain the Examiner’s rejection under 35 U.S.C. § 103(a) of independent claims 1, 11, and 20 and dependent claims 2–10, 12–19, 21, 23, and 25, which are not argued separately.

CONCLUSION

The Examiner’s rejection of claims 1–21, 23, and 25 under 35 U.S.C. § 103(a) is affirmed.

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–21, 23, 25	§ 103(a)	Ashley, Stolfo, Ko, Paretto	1–21, 23, 25	

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