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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DOUGLAS A. BULLEIT and STANLEY K. YEATTS

Appeal 2018-005562
Application 13/570,420
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
MICHAEL C. ASTORINO, *Administrative Patent Judges*.

ASTORINO, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–12, 14–19, and 21. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. The Appellant identifies the real party in interest as “AT&T Intellectual Property I, L.P., by transfer of ownership from AT&T Delaware Intellectual Property, Inc., formerly known as BellSouth Intellectual Property Corporation.” Appeal Br. 1.

Appeal 2018-005562
Application 13/570,420

We REVERSE and enter a NEW GROUND OF REJECTION
pursuant to our authority under 37 C.F.R. § 41.50(b).

STATEMENT OF THE CASE

Subject Matter on Appeal

Claim 1, reproduced below, with bracketed notations and indents added, is illustrative of the claimed subject matter.

1. A network communication method comprising:

[(a)] switching from a standard quality of service Internet connection to a higher, relative to the standard quality of service, quality of service Internet connection, in response to user selection of the higher quality of service Internet connection via a persistent browser interface, at a user device, that persists as the user device navigates the Internet to a plurality of Web pages;

[(b)] displaying on the user device a series of links to a plurality of sponsored Web sites of a plurality of sponsors that subsidize the higher quality of service Internet connection in the persistent browser interface at the user device as the user device navigates the Internet to the plurality of Web pages and that supercede indicia of sponsorship that are associated with the plurality of Web pages, in response to the user selection of the higher quality of service Internet connection at the user device, the series of links being provided to the user device by a proactive search engine that is configured to search the Web independent of user key word input as the user device navigates the Internet to the plurality of Web pages; and

[(c)] linking the user device to one of the sponsored Web sites of one of the plurality of sponsors of the higher quality of service Internet connection in response to user selection of a corresponding link at the user device,

wherein a plurality of Internet connection options are displayed in the persistent browser interface at the user device as the user device navigates the Internet to the plurality of Web pages, and

wherein the plurality of Internet connection options displayed in the persistent browser interface comprises:

a first option that selects the standard quality of service Internet connection; and

a second option that selects the higher quality of service Internet connection.

REJECTION

Claims 1–12, 14–19, and 21 stand rejected under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more.

ANALYSIS

Patent Eligibility

The 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019), hereinafter “2019 Revised Guidance,” supersedes the earlier guidance that was in effect at the time the Appeal Brief was filed (Dec. 21, 2017) and the Reply Brief was filed (May 7, 2018). *Id.* at 51 (“Eligibility–related guidance issued prior to the Ninth Edition, R–08.2017, of the MPEP (published Jan. 2018) should not be relied upon.”). Therefore, we will not analyze the sufficiency of the Examiner’s rejection against the Office’s previous guidance. Rather, our analysis will comport with the 2019 Revised Guidance.

35 U.S.C. § 101 provides that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor.” Independent claim 1 covers a process -- i.e., a network communication

method -- and therefore is a claim to a statutory category of patentable subject matter identified by 35 U.S.C. § 101.²

The rejection posed by the Examiner and disputed by the Appellant is whether claim 1 contains an important implicit exception, specifically an abstract idea, which is not patentable. *See Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014). *Alice* identifies a two-step framework for determining whether claimed subject matter is directed to an abstract idea. *Id.* at 573 U.S. 217. According to *Alice* step one, “[w]e must first determine whether the claims at issue are *directed to* a patent-ineligible concept.” *Id.* at 218 (emphasis added).

The Examiner determines that claim 1 is directed to the abstract idea of sales and marketing behavior by determining sponsors for the purpose of generating revenue, i.e., a fundamental economic practice. *See* Final Act. 3, 6 (citing Spec. ¶ 28), 7; *see also id.* at 4 (determining the claimed steps “describe the concept of advertising and rewards over communication networks” (citing *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014))). The Appellant argues that claim 1 is not directed to an abstract idea. Appeal Br. 8. The Appellant contends:

[The] claim[] focus[es] on a specific means or method that improves the relevant technology. Namely, a proactive search engine that searches the Web/Internet for options for switching to an improved Internet connection in the background (i.e., as the user device is used to navigate to other Web pages) and providing those options to the user by way of a persistent

² This corresponds to Step 1 of the 2019 Revised Guidance which requires determining whether a “claim is to a statutory category.” 2019 Revised Guidance at 53. *See also id.* at 53–54 (“consider[] whether the claimed subject matter falls within the four statutory categories of patentable subject matter identified by 35 U.S.C. 101.”).

browser interface without needing to process, parse, and act upon user input.

Reply Br. 2. Also, the Appellant submits:

the proactive search engine may improve network performance by searching the Web independently on behalf of the user of a user device to determine sponsored Web sites that are candidates for sponsoring the higher quality of service Internet connection enjoyed by the user without the user needing to devote processor time in the user device and the network in performing similar searches.

Appeal Br. 8; *see id.* at 7 (citing Spec. ¶¶ 26, 28).

Accordingly, there is a dispute over what claim 1 is directed to: a fundamental economic practice of sales and marketing; or an improvement to computer functionality with regard to a proactive search engine.

We consider claim 1 as a whole giving it the broadest reasonable construction as one of ordinary skill in the art would have interpreted it in light of the Specification at the time of filing. Claim 1 describes “[a] network communication method comprising:”

step (a), based on a user’s selection at a user’s device, switching from a standard to a higher quality of service Internet connection, i.e.,

switching from a standard quality of service Internet connection to a higher, relative to the standard quality of service, quality of service Internet connection, in response to user selection of the higher quality of service Internet connection via a persistent browser interface, at a user device, that persists as the user device navigates the Internet to a plurality of Web pages;

step (b), based on the user’s selection, displaying on the user device a series of links that are provided to the user device by a *proactive search engine* that is configured to search the Web independent of user key word

input as the user device navigates the Internet to a plurality of Web pages,
i.e.,

displaying on the user device a series of links to a plurality of sponsored Web sites of a plurality of sponsors that subsidize the higher quality of service Internet connection in the persistent browser interface at the user device as the user device navigates the Internet to the plurality of Web pages and that supercede indicia of sponsorship that are associated with the plurality of Web pages, in response to the user selection of the higher quality of service Internet connection at the user device, the series of links being provided to the user device by a proactive search engine that is configured to search the Web independent of user key word input as the user device navigates the Internet to the plurality of Web pages; and

step (c), based on a user's selection of a link, provided by *the proactive search engine*, at the user device, linking the user device to a sponsored website, i.e.,

linking the user device to one of the sponsored Web sites of one of the plurality of sponsors of the higher quality of service Internet connection in response to user selection of a corresponding link at the user device.

Additionally, claim 1 recites two "wherein" clauses that further detail aspects of the claimed concept, i.e.,

wherein a plurality of Internet connection options are displayed in the persistent browser interface at the user device as the user device navigates the Internet to the plurality of Web pages, and

wherein the plurality of Internet connection options displayed in the persistent browser interface comprises:

a first option that selects the standard quality of service Internet connection; and

a second option that selects the higher quality of service Internet connection.

Broadly, the claimed method is directed to using a proactive search engine for providing and displaying a series of links to a plurality of sponsored Web sites, where the proactive search engine is configured to search the Web independent of user key word input as the user device navigates the Internet.

As described in the Specification, a “proactive search engine” is distinct from a “conventional search engine.” Spec. ¶ 26; *see also id.* ¶ 40. The Specification describes, “a ‘proactive search engine’ is a search engine that repeatedly and/or continuously searches for relevant Websites, including sponsored links or sites, as a user navigates various Websites, independent of or in addition to, when the user enters key words in a search window of a browser user interface,” whereas “[a] conventional search engine searches for Web pages that include key words in response to user searches that are entered into a search window in a browser user interface.” *Id.* ¶ 26; *see id.* ¶ 7 (“Search engines often are utilized to facilitate searching the Web. . . . As is well known to those having skill in the art, a search engine conventionally provides a search window in which key words can be entered by a user. In response, a listing of Web pages is provided that contain the search terms.”).

These passages go to the problem, the presentation of a series of links without the invention from the user of a user device to initiate a search for sponsored links. And, the solution to this problem is the use of a “proactive search engine” as claimed. Accordingly, the subject matter that claim 1 is directed to, i.e., using “a proactive search engine” to identify sponsored links, is not a matter that falls within the enumerated groupings of abstract ideas; that is “Mathematical concepts,” “Certain methods of organizing

human activity,” and “Mental processes.” 2019 Revised Guidance, 84 Fed. Reg. at 54.

In this case, it is the characterization the Appellant has put forward, *supra*, which is the more accurate characterization. In our view, the claim as a whole reflects a specific asserted improvement in technology, rooted in computer technology, over that which was available in the prior art. Accordingly, we find the Appellant’s arguments that the claimed subject matter is not directed to sales and marketing but a technical improvement persuasive, given the present record. It should be noted that we have addressed purported specific asserted improvements in technology under step one of the *Alice* framework. Additionally, we determine that there is an integration into a practical application. *See id.* at 84 Fed. Reg. at 54.

Thus, we do not sustain the Examiner’s rejection of independent claim 1 and claims 2–10 and 21, which depend therefrom.

In view of our determination that independent claims 11 and 14 are indefinite, *infra*, in this case, it follows that the rejection of these claims, as well as the claims that depend from these claims, under 35 U.S.C. § 101 must fall because it is necessarily based on a speculative assumption as to the meaning of the claims. *See also In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962). Thus, we do not sustain the Examiner’s rejection of claims 11, 12, and 14–19 under this ground of rejection. It should be understood, however, that our decision in this regard is *pro forma* and based solely on the indefiniteness of the claimed subject matter set forth below.

New Ground of Rejection

Independent claims 11 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter, which Appellant regards as the invention. *See In re Packard*, 751 F.3d 1307, 1310–13 (Fed. Cir. 2014) (“[A] claim is indefinite when it contains words or phrases whose meaning is unclear,” i.e., “ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention.”); *see also Ex parte McAward*, 2017 WL 3669566, at *5 (PTAB Aug. 25, 2017) (precedential) (explaining that the USPTO considers a claim indefinite when it “contains words or phrases whose meaning is unclear”).

Claim 11 recites “a user device” including “a display to display a series of links . . . , the series of links being provided to the user device by a proactive search engine that is configured to search the Web independent of user keyword input as the user device navigates the Internet to the plurality of Web pages.” Appeal Br., Claims App. It is unclear if the “proactive search engine” is a feature of the claimed “user device” or a distinct device which is part of a communication network. Therefore, the full scope (i.e., the metes and bounds) of claim 14 is unclear.

Additionally, we note that the Specification includes overlapping descriptions of the structure of a “user device” and “proactive search engine.” The Specification, at paragraph 23, describes “user devices **110** may be embodied as one or more enterprise, application, personal, pervasive and/or embedded computer devices that may themselves be interconnected by one or more public and/or private, wired and/or wireless local and/or wide area networks, including the Internet.” Spec. ¶ 23; *see* Fig. 1. The

Specification, at paragraph 26, describes “[proactive] search engine **150** may be embodied as one or more enterprise, application, personal, pervasive and/or embedded computing devices that may themselves be interconnected by one or more public and/or private, wired and/or wireless local and/or wide area networks, including the Internet.” *Id.* ¶ 26, Fig. 1 (referencing reference number 150 as “(PROACTIVE) SEARCH ENGINE”). Although Figure 1 depicts user device 110 and proactive search engine 150 in different boxes, it is unclear whether user device 110 and proactive search engine 150 may be part of the same structure. Therefore, the Specification includes the possibility that the same structure performs the functions of both the “user device” and the “proactive search engine.”

Claim 14 is indefinite for a similar reason as claim 11. Claim 14 recites, “[a] network connection provider device” including “a computing device to display on selected user devices, a series of links . . . , the series of links being provided to the selected user devices by a proactive search engine that is configured to search the Web independent of user key word input as the selected user devices navigate the Internet to the plurality of Web pages.” Appeal Br., Claims App. It is unclear if the “proactive search engine” is feature of the claimed “network connection provider device,” “computing device,” or a distinct device which is part of a communication network. Therefore, the full scope (i.e., the metes and bounds) of claim 14 is unclear. And, similar to the discussion above, the Specification includes overlapping descriptions of the structure of a “network connection provider device” and “proactive search engine.” *See* Spec. ¶¶ 24 (describing “[t]he network connection provider device **130** may be a standalone server and/or may be embodied in one or more enterprise, application, personal, pervasive

and/or embedded computing devices that may themselves be interconnected by one or more public and/or private, wired and/or wireless local and/or wide area networks, including the Internet.”), 26. Therefore, the Specification includes the possibility that the same structure performs the functions of both the “network connection provider device” and the “proactive search engine.”

Further, claims 12 and 15–19, which depend from either independent claim 11 or claim 14, are indefinite due to their dependency on an indefinite claim.

CONCLUSION

We REVERSE the Examiner’s rejection of claims 1–10 and 21 under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more.

We REVERSE *pro forma* the Examiner’s rejection of claims 11, 12, and 14–19 under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more.

We enter a NEW GROUND OF REJECTION of claims 11, 12, and 14–19 under 35 U.S.C. § 112, second paragraph, as indefinite pursuant to our authority under 37 C.F.R. § 41.50(b).

37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record.

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. § 1.136(a)(1)(iv).

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed	New Ground
1-12, 14-19, 21	101	Eligibility		1-12, 14-19, 21	
11, 12, 14-19	112 ¶ 2	Indefinite			11, 12, 14-19
Overall Outcome				1-12, 14-19, 21	11, 12, 14-19

REVERSED; 37 C.F.R. § 41.50(b)