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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DANA S. ROBBINS, VIVEK PALAN,
LIK MUI, and GABRIELLE TAO

Appeal 2018–007148
Application 14/478,994
Technology Center 3600

Before ANTON W. FETTING, KENNETH G. SCHOPFER, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE¹

Dana S. Robbins, Vivek Palan, Lik Mui, and Gabrielle Tao (Appellant²) seek review under 35 U.S.C. § 134 of a final rejection of claims 1, 4–10, and 13–20, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

The Appellant invented a way of enabling a marketer to provide a next best offer to a consumer without the use of personally identifiable information (PII). Spec. para. 5.

An understanding of the invention can be derived from a reading of exemplary claim 13, which is reproduced below (bracketed matter and some paragraphing added).

13. A computer-implemented method for determining a next best offer, comprising the steps of:

- a. receiving at a decision engine at a marketing services provider (MSP) server a request to construct a next best offer comprising a marketing message;
- b. determining at the MSP server whether the request comprises personally identifiable information (PII);
- c.

[c.1] accessing a known consumer data hub comprising a plurality of records pertaining to known consumers from

¹ Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed December 11, 2017) and Reply Brief (“Reply Br.,” filed July 2, 2018), and the Examiner’s Answer (“Ans.,” mailed May 3, 2018), and Final Action (“Final Act.,” mailed July 14, 2017).

² We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Acxiom Corporation (Appeal Br. 2).

the decision engine if PII is used in the next best offer request,

or

[c.2] accessing an anonymous consumer data hub comprising a plurality of records pertaining to anonymous consumers from the decision engine if PII is not used in the next best offer request,

wherein the anonymous consumer data hub comprises only records that contain no personally identifiable information (PII);

and

d. delivering the marketing message to a marketing channel in communication with a consumer device that is connected to the MSP server by a network.

The Examiner relies upon the following prior art:

| Name | Reference | Date |
|--------|--------------------|---------------|
| Daigle | US 2011/0178863 A1 | July 21, 2011 |

Claims 1, 4–10, and 13–20 stand rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

Claims 1, 4–10, and 13–20 stand rejected under 35 U.S.C. § 102(a)(1) as anticipated by Daigle.

ISSUES

The issues of eligible subject matter turn primarily on whether the claims recite more than abstract conceptual advice of results desired.

The issues of novelty turn primarily on whether the art describes the limitations.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Daigle

01. Daigle is directed to interfacing with a consumer in a retail environment. Daigle para. 2.

ANALYSIS

Claims 1, 4–10, and 13–20 rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more

STEP 1³

Claim 13, as a method claim, nominally recites one of the enumerated categories of eligible subject matter in 35 U.S.C. § 101. The issue before us is whether it is directed to a judicial exception without significantly more.

STEP 2

The Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, . . . determine whether the claims at issue are directed to one of those patent-ineligible concepts. If so, we then ask, “[w]hat else is there in the claims before us? To answer that question, . . . consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. [The Court] described step two of this

³ For continuity of analysis, we adopt the steps nomenclature from 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Revised Guidance”).

analysis as a search for an “inventive concept”—i.e., an element or combination of elements that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.”

Alice Corp., Pty. Ltd. v CLS Bank Intl, 573 U.S. 208, 217–18 (2014) (citations omitted) (citing *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012)). To perform this test, we must first determine what the claims are directed to. This begins by determining whether the claims recite one of the judicial exceptions (a law of nature, a natural phenomenon, or an abstract idea). Then, if claims recite a judicial exception, determining whether the claims at issue are directed to the recited judicial exception, or whether the recited judicial exception is integrated into a practical application of that exception, i.e., that the claims “apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” Revised Guidance at 54. If the claims are directed to a judicial exception, then finally determining whether the claims provide an inventive concept because the additional elements recited in the claims provide significantly more than the recited judicial exception.

STEP 2A Prong 1

At a high level, and for our preliminary analysis, we note that method claim 13 recites receiving request data, determining whether the request data has data meeting criteria, accessing one of two data hubs depending on that determination, and delivering message data. Determining whether criteria are met is rudimentary data analysis. Accessing data hubs is data reception, and delivering data is data transmission. Thus, claim 13 recites receiving,

analyzing, and transmitting data. None of the limitations recite technological implementation details for any of these steps, but instead recite only results desired by any and all possible means.

From this we see that claim 13 does not recite the judicial exceptions of either natural phenomena or laws of nature.

Under Supreme Court precedent, claims directed purely to an abstract idea are patent in-eligible. As set forth in the Revised Guidance, which extracts and synthesizes key concepts identified by the courts, abstract ideas include (1) mathematical concepts,⁴ (2) certain methods of organizing human activity,⁵ and (3) mental processes⁶. Among those certain methods of organizing human activity listed in the Revised Guidance are commercial or legal interactions. Like those concepts, claim 13 recites the concept of managing a marketing promotion. Specifically, claim 13 recites operations that would ordinarily take place in advising one to deliver a marketing message after accessing one of two data hub sources depending on the nature of data received in a request. The advice to deliver a marketing message after accessing one of two data hub sources depending on the

⁴ See, e.g., *Gottschalk v. Benson*, 409 U.S. 63, 71–72 (1972); *Bilski v. Kappos*, 561 U.S. 593, 611 (2010); *Mackay Radio & Telegraph Co. v. Radio Corp. of Am.*, 306 U.S. 86, 94 (1939); *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1163 (Fed. Cir. 2018).

⁵ See, e.g., *Bilski*, 561 U.S. at 628; *Alice*, 573 U.S. at 219-20; *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014); *Smart Sys. Innovations, LLC v. Chicago Transit Auth.*, 873 F.3d 1364, 1383 (Fed. Cir. 2017); *In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157, 1160–61 (Fed. Cir. 2018).

⁶ See, e.g., *Benson*, 409 U.S. at 67; *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1371–72 (Fed. Cir. 2011); *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1318 (Fed. Cir. 2016).

nature of data received in a request involves delivering the marketing message, which is an economic act, and a request to construct a next best offer comprising a marketing message, which is an act ordinarily performed in the stream of commerce. For example, claim 13 recites “delivering the marketing message,” which is an activity that would take place whenever one is promoting commerce through marketing. Similarly, claim 1 recites “a request to construct a next best offer comprising a marketing message,” which is also characteristic of managing such promotion.

The Examiner determines the claims to be directed to providing an offer based on non-personally identifiable customer information. Final Act. 3.

The preamble to claim 13 recites that it is a method for determining a next best offer. The steps in claim 13 result in delivering the marketing message absent any technological mechanism other than a conventional computer for doing so.

As to the specific limitations, limitations a and c recite receiving data. Limitations b and d recite generic and conventional receiving, analyzing, and transmitting of marketing offer data, which advise one to apply generic functions to get to these results. The limitations thus recite advice for delivering a marketing message after accessing one of two data hub sources depending on the nature of data received in a request. To advocate delivering a marketing message after accessing one of two data hub sources depending on the nature of data received in a request is conceptual advice for results desired and not technological operations.

The Specification at paragraph 5 describes the invention as relating to enabling a marketer to provide a next best offer to a consumer without the

use of personally identifiable information (PII). Thus, all this intrinsic evidence shows that claim 13 recites managing a marketing promotion. This is consistent with the Examiner's determination.

This in turn is an example of commercial or legal interactions that are method of organizing human activity because managing marketing promotions is a conventional practice in organizing commercial activity to induce sales. The concept of managing a marketing promotion by delivering a marketing message after accessing one of two data hub sources depending on the nature of data received in a request is one idea for translating customer information into a communication for marketing. The steps recited in claim 13 are part of how this might conceptually be premised.

Our reviewing court has found claims to be directed to abstract ideas when they recited similar subject matter. *Ultramerical, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (advertising).

From this we conclude that at least to this degree, claim 13 recites managing a marketing promotion by delivering a marketing message after accessing one of two data hub sources depending on the nature of data received in a request. This is a commercial and legal interaction, which is one of certain methods of organizing human activity identified in the Revised Guidance, and, thus, is an abstract idea.

STEP 2A Prong 2

The next issue is whether claim 13 not only recites, but is more precisely directed to this concept itself or whether it is instead directed to

some technological implementation or application of, or improvement to, this concept, i.e., integrated into a practical application.⁷

At the same time, we tread carefully in construing this exclusionary principle lest it swallow all of patent law. At some level, “all inventions ... embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” Thus, an invention is not rendered ineligible for patent simply because it involves an abstract concept. “[A]pplication[s]” of such concepts “ ‘to a new and useful end,’ ” we have said, remain eligible for patent protection. Accordingly, in applying the § 101 exception, we must distinguish between patents that claim the “ ‘buildin[g] block[s]’ ” of human ingenuity and those that integrate the building blocks into something more.

Alice, 573 U.S. at 217 (citations omitted).

Taking the claim elements separately, the operation performed by the computer at each step of the process is expressed purely in terms of results, devoid of implementation details. Steps a and c are pure data gathering steps. Limitations describing the nature of the data do not alter this. Step d is insignificant post-solution activity, such as storing, transmitting, or displaying the results. Step b recites generic computer processing expressed in terms of results desired by any and all possible means and so present no more than conceptual advice. All purported inventive aspects reside in how the data is interpreted and the results desired, and not in how the process physically enforces such a data interpretation or in how the processing technologically achieves those results.

Viewed as a whole, Appellant’s claim 13 simply recites the concept of managing a marketing promotion by delivering a marketing message after

⁷ See, e.g., *Alice*, 573 U.S. at 223, discussing *Diamond v. Diehr*, 450 U.S. 175 (1981).

accessing one of two data hub sources depending on the nature of data received in a request as performed by a generic computer. This is no more than conceptual advice on the parameters for this concept and the generic computer processes necessary to process those parameters, and do not recite any particular implementation.

Claim 13 does not, for example, purport to improve the functioning of the computer itself. Nor does it affect an improvement in any other technology or technical field. The 17 pages of the Specification only spell out different generic equipment⁸ and parameters that might be applied using this concept and the particular steps such conventional processing would entail based on the concept of managing a marketing promotion by delivering a marketing message after accessing one of two data hub sources depending on the nature of data received in a request under different scenarios. They do not describe any particular improvement in the manner a computer functions. Instead, claim 13, at issue, amounts to nothing significantly more than an instruction to apply managing a marketing promotion by delivering a marketing message after accessing one of two data hub sources depending on the nature of data received in a request using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 573 U.S. at 225–26.

None of the limitations reflect an improvement in the functioning of a computer, or an improvement to other technology or technical field; applies

⁸ The Specification describes specially programmed computer servers and desktop computers, laptop computers, tablets, and smartphones. Spec. para. 13.

or uses a judicial exception to effect a particular treatment or prophylaxis for a disease or medical condition; implements a judicial exception with, or uses a judicial exception in conjunction with, a particular machine or manufacture that is integral to the claim; effects a transformation or reduction of a particular article to a different state or thing; or applies or uses the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception.

We conclude that claim 13 is directed to achieving the result of managing a marketing promotion by advising one to deliver a marketing message after accessing one of two data hub sources depending on the nature of data received in a request, as distinguished from a technological improvement for achieving or applying that result. This amounts to commercial or legal interactions, which fall within certain methods of organizing human activity that constitute abstract ideas. The claim does not integrate the judicial exception into a practical application.

STEP 2B

The next issue is whether claim 13 provides an inventive concept because the additional elements recited in the claim provide significantly more than the recited judicial exception.

The introduction of a computer into the claims does not generally alter the analysis at *Mayo* step two.

[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility. Nor is limiting the use of an abstract idea “to a particular technological environment.”

Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implement[t]” an abstract idea “on . . . a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our § 101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional feature[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

Alice, 573 U.S. at 223–24 (citations omitted).

“[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice*, 573 U.S. at 225. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer for receiving, analyzing, and transmitting data amounts to electronic data query and retrieval—one of the most basic functions of a computer. All of these computer functions are generic, routine, conventional computer activities that are performed only for their conventional uses. *See Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). *See also In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303, 1316 (Fed. Cir. 2011) (“Absent a possible narrower construction of the terms ‘processing,’ ‘receiving,’ and ‘storing,’ . . . those functions can be achieved by any general purpose computer without special programming”). None of these activities are used in some unconventional manner nor do any produce some unexpected result. Appellant does not contend they invented any of these activities. In short, each step does no more than require a generic computer to perform generic computer functions. As to the data operated

upon, “even if a process of collecting and analyzing information is ‘limited to particular content’ or a particular ‘source,’ that limitation does not make the collection and analysis other than abstract.” *SAP America, Inc. v. InvestPic LLC*, 898 F.3d 1161, 1168 (Fed. Cir. 2018).

Considered as an ordered combination, the computer components of Appellant’s claim 13 add nothing that is not already present when the steps are considered separately. The sequence of data reception-analysis-transmission is equally generic and conventional. *See Ultramercial*, 772 F.3d at 715 (sequence of receiving, selecting, offering for exchange, display, allowing access, and receiving payment recited an abstraction), *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (sequence of data retrieval, analysis, modification, generation, display, and transmission), *Two-Way Media Ltd. v. Comcast Cable Communications, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (sequence of processing, routing, controlling, and monitoring). The ordering of the steps is therefore ordinary and conventional.

We conclude that claim 13 does not provide an inventive concept because the additional elements recited in the claim do not provide significantly more than the recited judicial exception.

REMAINING CLAIMS

Claim 13 is representative. The remaining method claims merely describe process parameters. We conclude that the method claims at issue are directed to a patent-ineligible concept itself, and not to the practical application of that concept.

As to the structural claims, they are no different from the method claims in substance. The method claims recite the abstract idea implemented on a generic

computer; the system claims recite a handful of generic computer components configured to implement the same idea. This Court has long “warn[ed] ... against” interpreting § 101 “in ways that make patent eligibility ‘depend simply on the draftsman’s art.’

Alice, 573 U.S. at 226. We note that structural claim 1 lists several component limitations, viz, a data layer, two data hubs, a decision engine, and an MSP routine on a server. The data layer is just that, data. A data hub is a generic data repository, and a decision engine and MSP routine are program instruction data in the form of some unrecited algorithm. Such generic components cannot confer eligibility.

The use and arrangement of conventional and generic computer components recited in the claims—such as a database, user terminal, and server—do not transform the claim, as a whole, into “significantly more” than a claim to the abstract idea itself. “We have repeatedly held that such invocations of computers and networks that are not even arguably inventive are ‘insufficient to pass the test of an inventive concept in the application’ of an abstract idea.”

Credit Acceptance Corp. v. Westlake Services, 859 F.3d 1044, 1056 (Fed. Cir. 2017) (citations omitted).

As a corollary, the claims are not directed to any particular machine.

LEGAL CONCLUSION

From these determinations, we further determine that the claims do not recite an improvement to the functioning of the computer itself or to any other technology or technical field, a particular machine, a particular transformation, or other meaningful limitations. From this we conclude the claims are directed to the judicial exception of the abstract idea of certain methods of organizing human activity as exemplified by the commercial and legal interaction of managing a marketing promotion by delivering a

marketing message after accessing one of two data hub sources depending on the nature of data received in a request, without significantly more.

APPELLANT'S ARGUMENTS

As to Appellant's Appeal Brief arguments, we adopt the Examiner's determinations and analysis from Final Action 2–5 and Answer 3–5 and reach similar legal conclusions. We now turn to the Reply Brief.

We are not persuaded by Appellant's argument that the Examiner has alleged in a merely conclusory fashion that all of the claim elements are well-understood, routine, and conventional. With respect to Item #1 in the Guidance, the Examiner has not identified any express statement in the specification or during prosecution that the elements are well-understood, routine, and conventional.

Reply Br. 3. Such determinations are supported under Step 2B *supra*.

Claims 1, 4–10, and 13–20 rejected under 35 U.S.C. § 102(a)(1) as anticipated by Daigle

We are persuaded by Appellant's argument that Daigle fails to describe accessing an anonymous consumer data hub. App. Br. 24–25. Although Daigle describes acquiring data anonymously, it does not describe accessing it as claimed.

CONCLUSIONS OF LAW

The rejection of claims 1, 4–10, and 13–20 under 35 U.S.C. § 101 as directed to a judicial exception without significantly more is proper.

The rejection of claims 1, 4–10, and 13–20 under 35 U.S.C. § 102(a)(1) as anticipated by Daigle is improper.

CONCLUSION

The rejection of claims 1, 4–10, and 13–20 is affirmed.

In summary:

| Claims Rejected | 35 U.S.C. § | Basis | Affirmed | Reversed |
|------------------------|--------------------|--------------|-----------------|-----------------|
| 1, 4–10, 13–20 | 101 | Eligibility | 1, 4–10, 13–20 | |
| 1, 4–10, 13–20 | 102(a)(1) | Daigle | | 1, 4–10, 13–20 |
| Overall Outcome | | | 1, 4–10, 13–20 | |

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) (2011).

AFFIRMED