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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NIRAJ GUPTA

Appeal 2018-008005
Application 14/048,589
Technology Center 3600

Before BIBHU R. MOHANTY, BRUCE T. WIEDER, and
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Adobe Systems Incorporated. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The Appellant's claimed invention relates to a method and apparatus for determining brand awareness before dismissing a video advertisement (Spec., para. 1). Claim 1, reproduced below with emphasis added, is representative of the subject matter on appeal.

1. A computer implemented method comprising:
 - accessing brand awareness information files* comprising brand awareness information associated with advertising content for a viewer, wherein the brand awareness information comprises indications whether the viewer has correctly answered test questions associated with brands in the advertising content;
 - selecting an advertisement for which the viewer has not previously shown brand awareness based on an accessed brand awareness information file* associated with the advertisement not including an indication that the viewer has correctly answered one or more test questions associated with the brand in the selected advertisement;
 - receiving video content, the selected advertisement, and a test question, wherein the test question tests brand awareness of the selected advertisement;*
 - playing the selected advertisement* within a graphical user interface;
 - presenting the test question* within the graphical user interface;
 - receiving, via the graphical user interface, a selection of an answer in association with the presented test question;*
 - stopping the selected advertisement when an input is received that correctly answers the test question;* and
 - playing the video content* within the graphical user interface.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 1–20 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

2. Claims 1–20 are rejected under 35 U.S.C. § 103 as unpatentable over Simons (US 2010/0228596 A1, published Sep. 9, 2010) and Nyhan (US 7,010,497 B1, issued Mar. 7, 2006).

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence².

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellant argues that the rejection of claim 1 is improper because the claim is not directed to an abstract idea (Appeal Br. 8–12; Reply Br. 2, 3). The Appellant argues further that the claim is “significantly more” than the alleged abstract idea (Appeal Br. 12–14; Reply Br. 3, 4).

In contrast, the Examiner has determined that the rejection of record is proper (Final Action 2–4, 10, 11; Ans. 3-6).

We agree with the Examiner. An invention is patent eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk . . .”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 79 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores” (*id.* at 187 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 187; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber

products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (internal citation omitted) (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

The PTO recently published revised guidance on the application of § 101. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”). Under the Guidance, we first look 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, i.e., evaluate whether the claim “appl[ies], rel[ies] on, or use[s] 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.” (*see* Guidance, 84 Fed. Reg. at 54; *see also* 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, do we then look to whether the claim:

- (3) adds a specific limitation beyond the judicial exception that is 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 Guidance.

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (citation omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (alterations in original) (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation [] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The Specification states that the invention relates to a method and apparatus for determining brand awareness before dismissing a video advertisement (Spec., para. 1). Here, the Examiner has determined that the claim sets forth a method of collecting information, analyzing it, and providing certain results of the collection analysis which is an abstract idea in and of itself (Final Act. 3). We substantially agree with the Examiner. We determine that the claim limitations presented in italics above recite the concept of determining advertising based on a particular user’s data which is a certain method of organizing human activities and fundamental economic practice in a method of advertising, or a mental process in determining whether to run an advertisement i.e. a judicial exception. In *Intellectual Ventures I LLC v. Capital One Bank (USA)* 792 F.3d 1363, 1370 (Fed. Cir. 2015) it was determined that an advertisement taking into account the time

of day and tailoring the information presented to the user based on that information was a fundamental economic practice and an abstract concept. Here, the claim tailors advertising based on information about the viewer. Thus, we consider the claim to be directed to a judicial exception as identified above.

We next determine whether the claim recites additional elements in the claim to integrate the judicial exception into a practical application. *See* Guidance, 84 Fed. Reg. at 54–55. The Revised Guidance references the MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) §§ 2106.05(a)–(c) and (e)–(h).

Here, the claims do not improve computer functionality, improve another field of technology, utilize a particular machine, or effect a physical transformation. Rather, we determine that nothing in the claims imposes a meaningful limit on the judicial exception, such that the claims are more than a drafting effort to monopolize the judicial exception.

For example, in claim 1 the steps of [1] “accessing brand awareness information files”; [2] “selecting an advertisement for which the viewer has not previously shown brand awareness based on an accessed brand awareness information file”; [3] “receiving video content, the selected advertisement, and a test question, wherein the test question tests brand awareness of the selected advertisement”; [4] “playing the selected advertisement; [5] “presenting the test question”; [6] “receiving . . . a selection of an answer in association with the presented test question”; [7] “stopping the selected advertisement when an input is received that correctly answers the test question; and playing the video content” are merely steps performed by a generic computer that do not improve computer

functionality. That is, these recited steps [1]–[7] “do not purport to improve the functioning of the computer itself” but are merely generic functions performed by a conventional processor. Likewise, these same steps [1]–[7] listed above do not improve the technology of the technical field and merely use generic computer components and functions to perform the steps. Also, the recited method steps [1]–[7] above do not require a “particular machine” and can be utilized with a general purpose computer, and the steps performed are purely conventional. In this case the general purpose computer is merely an object on which the method operates in a conventional manner. Further, the claim as a whole fails to effect any particular transformation of an article to a different state. The recited steps [1]–[7] fail to provide meaningful limitations to limit the judicial exception and rather are mere instructions to apply the method to a generic computer.

Considering the elements of the claim both individually and as “an ordered combination” the functions performed by the computer system at each step of the process are purely conventional. Each step of the claimed method does no more than require a generic computer to perform a generic computer function. Thus, the claimed elements have not been shown to integrate the judicial exception into a practical application as set forth in the Revised Guidance which references the MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) §§ 2106.05(a)–(c) and (e)–(h).

Turning to the second step of the *Alice* and *Mayo* framework, we determine that the claim does not contain an inventive concept sufficient to “transform” the abstract nature of the claim into a patent-eligible application. The claim fails to add a specific limitation beyond the judicial exception that is not well-understood, routine, and conventional in the field. Rather the

claim uses well-understood, routine, and conventional activities previously known in the art and they are recited at a high level of generality. The Specification at paragraph 14 for example describes using conventional computer components such as a CPU, memory, cache, and input/output circuits in a conventional manner. The claimed functions of the computer components are all used in a manner that is well-understood, routine, and conventional in the field. The Appellant has not shown these claimed generic computer components, which are used to implement the claimed method are not well understood, routine, or conventional in the field. The Appellant has not demonstrated that the computer components described in the Specification at paragraph 14 for instance are not general purpose computer components known to perform similar functions in a well-understood manner. The Specification at paragraph 13 discloses that the method can be implemented with general purpose computers. Here, the claim has not been shown to be “significantly more” than the abstract idea.

The Appellant cites to *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F. 3d 1245 (Fed. Cir. 2014) and argues that the claim is “rooted in computer technology” (Appeal Br. 10–12). We disagree, as the Appellant has not shown how the claimed subject matter is rooted in technology given that the Specification describes only the use of generic computer equipment used in routine, conventional, and generic manner.

For these above reasons the rejection of claim 1 is sustained. The Appellant has provided the same arguments for the remaining claims which are directed to similar subject matter and the rejection of these claims is sustained for the same reasons given above.

Rejection under 35 U.S.C. § 103

The Appellant argues that the rejection of claim 1 is improper because the prior art has not been shown to specifically disclose the claim limitation for:

selecting an advertisement for which the viewer has not previously shown brand awareness based on an accessed brand awareness information file associated with the advertisement not including an indication that the viewer has correctly answered one or more test questions associated with the brand in the selected advertisement

(Appeal Br. 16 (emphases added)).

In contrast, the Examiner has determined that the rejection of record is proper in view of Simons at Figure 4, and Nyhan at column 6, lines 42–57 and Nyhan at column 7, lines 21–30 (Ans. 6–10).

Simons at Figure 4 does disclose a consumer providing answers to a question to show brand awareness as shown by the quiz question about properties related to “Tom’s of Main Body wash”. Nyhan at column 6, lines 42–57 does disclose using “cookies” to track if a user has viewed an advertisement.

In *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) the Supreme Court at 418 noted that in an obviousness analysis that “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” We agree with the Examiner that the cited references do show, in disparate locations, the elements of the claim. However, in Simons the consumer quiz for brand awareness is not shown to determine what advertisement is to be played next but rather “to price individual advertisements based on consumers’

responses” (Simons, para. 1). While Nyhan at column 6, lines 42–57 does show conventional “cookie tracking” to determine what advertisement has been played, here the cited rejection lacks articulated reasoning with some rational underpinning without impermissible hindsight sustain the rejection of record. Here, the cited claim limitation is also required to be placed in a particular sequence in the claim and the rejection of record fails to provide articulated reasoning with rational underpinnings to meet the limitations of the claim.

For this reason, the rejection of claim 1 and its dependent claims is not sustained.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–20	101	Eligibility	1–20	
1–20	103	Simons, Nyhan/Obviousness		1–20
Overall Outcome			1–20	

TIME PERIOD FOR RESPONSE

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).

AFFIRMED