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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/914,884	06/11/2013	Max Eulenstein	079894.1705	7327
91230	7590	12/23/2019	EXAMINER	
BAKER BOTTS L.L.P./FACEBOOK INC. 2001 ROSS AVENUE SUITE 900 DALLAS, TX 75201			NGUYEN, THUY N	
			ART UNIT	PAPER NUMBER
			3681	
			NOTIFICATION DATE	DELIVERY MODE
			12/23/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MAX EULENSTEIN, DEBORAH LIU, and VIJAYE RAJI

Appeal 2018-008909
Application 13/914,884
Technology Center 3600

Before CARL W. WHITEHEAD JR., JASON V. MORGAN, and
JAMES B. ARPIN, *Administrative Patent Judges*.

MORGAN, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Introduction

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–19 and 21. Claim 20 is canceled. Appeal Br. 7, 20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ 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 Facebook, Inc. Appeal Br. 3.

Summary of the Disclosure

Appellant's claimed subject matter relates to providing a notification based on a determination that a user-initiated event is attributable to an electronic advertisement that is further associated with information identifying the advertisement. Abstract.

Representative Claims (disputed limitations emphasized)

1. A method comprising:

receiving, by a computing device, a notification complying with one or more specifications of a software development kit, the notification comprising:

first information associated with an identity of a user; and
second information identifying the occurrence of a[n]
event associated with a software application and initiated
by the user;

identifying, by the computing device, the user based at least in part on the first information;

determining, by the computing device, whether the event is attributable to an electronic advertisement based on a determination that the user paused navigation of a web page or application on a portion of the web page or application on which the electronic advertisement is displayed to the user; and

when the event is attributable to the advertisement:

determining, by the computing device, whether the electronic advertisement is associated with third information identifying the advertisement or an advertising campaign associated with the advertisement; and

when the electronic advertisement is associated with the third information, notifying, by the computing device, an advertiser associated with the electronic advertisement or

a developer associated with the software application that the third information is associated with the event.

21. A method comprising:

receiving, by a server computing device of a social network, a notification generated by a software application, wherein the software application complies with one or more specifications of the social network regarding use of information about the user, the notification comprising:

first information encoding an identity of a user; and
second information identifying the occurrence of an event associated with the software application and initiated by the user;

decoding, by the server computing device of the social network, the identity of the user;

determining, by the server computing device of the social network, that a user of the social network has perceived an electronic advertisement displayed on or served through the social network, based on a determination that the user paused navigation of a web page or application on a portion of the web page or application on which the advertisement is displayed to the user; and

notifying, by the server computing device of the social network, an advertiser associated with the electronic advertisement or a developer associated with the software application that the event is associated with the advertisement or an advertising campaign associated with the advertisement.

The Examiner's Rejections and Cited References

The Examiner rejects claims 1–19 and 21² under 35 U.S.C. § 101 as directed to patent-ineligible subject matter. Final Act. 2–6; Ans. 7.

² The Examiner incorrectly refers to canceled system claim 20, instead of method claim 21. Final Act. 5. This is merely a typographical error. Ans. 7.

The Examiner rejects claims 1–19 and 21 under 35 U.S.C. § 103 as unpatentable over Ting et al. (US 2011/0191714 A1; published Aug. 4, 2011) (“Ting”), Manafy et al. (US 2014/0304071 A1; published Oct. 9, 2014) (“Manafy”), Krassner et al. (US 2010/0153544 A1; published June 17, 2010) (“Krassner”), and Hsiao et al. (US 2012/0259854 A1; published Oct. 11, 2012) (“Hsiao”). Final Act. 6–25

PRINCIPLES OF LAW

To be statutorily patentable, the subject matter of an invention must be a “new and useful process, machine, manufacture, or composition of matter, or [a] new and useful improvement thereof.” 35 U.S.C. § 101. There are implicit exceptions to the categories of patentable subject matter identified in 35 U.S.C. § 101, including: (1) laws of nature; (2) natural phenomena; and (3) abstract ideas. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014). The U.S. Supreme Court has set forth a framework for distinguishing patents with claims directed to these implicit exceptions “from those that claim patent-eligible applications of those concepts.” *Id.* at 217 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012)). The evaluation follows a two-part analysis: (1) determine whether the claim is *directed to* a patent-ineligible concept, e.g., an abstract idea; and (2) if so, then determine whether any element, or combination of elements, in the claim is sufficient to ensure that the claim amounts to *significantly more* than the patent-ineligible concept itself. *See id.* at 217–18.

Earlier this year, the U.S. Patent and Trademark Office (USPTO) published guidance on the application of the two-part analysis. USPTO, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (January 7, 2019) (“Revised Guidance”); *see also* USPTO, *October 2019*

Update: Subject Matter Eligibility, available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf (Oct. 17, 2019) (“Oct. Update”). Under that 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) (*see id.* at 54 (step 2A, prong one)); and

(2) additional elements that integrate the judicial exception into a practical application (*see id.* at 54–55 (step 2A, prong two); MPEP §§ 2106.05(a)–(c), (e)–(h)).

See Revised Guidance, 84 Fed. Reg. 52–55.

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 Revised Guidance, 84 Fed. Reg. 56.

ANALYSIS

Revised Guidance Step 2A, Prong One

In rejecting claim 1 as directed to patent-ineligible subject matter, the Examiner determines the claim recitations

simply describe[] the concept of comparing/analyzing the receive notification e.g., user ID, occurrence of event; comparing/analyzing the third information identifying the advertisement or an advertising campaign against the electronic advertisement information in order to determine whether the event is attributable to the electronic advertisement by the user (e.g., *the user paused movement of a page or on a portion of the page or on which the advertisement is displayed to the user*) and determine whether the third information identifying the advertisement or an advertising campaign and if the advertisement is associated with the third advertisement then notifying an advertiser or developer[, etc.]).

Final Act. 3 (citing *Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016)). That is, the Examiner determines that claim 1 recites “limitations that can practically be performed in the human mind, including for example, observations, evaluations, judgments, and opinions,” limitations that represent mental processes that are abstract. Oct. Update 7; *see also* Revised Guidance, 84 Fed. Reg. 52.

Appellant’s arguments do not address whether claim 1 as least *recites* an abstract idea, and we find the Examiner’s determinations persuasive. In particular, claim 1 recites using information that identifies “the occurrence of a[n] event . . . initiated by the user,” “determining . . . whether the event is attributable to an electronic advertisement,” and notifying an advertiser when “the event is attributable to the [electronic] advertisement” that is associated with “third information identifying the advertisement or an advertising campaign associated with the advertisement.” That is, claim 1 recites collecting information (identifying an event representing how a user responds to an advertisement), analyzing it (characterizing the event and considering the information associated with the event), and displaying it (providing notice about the event). *Electric Power*, 830 F.3d at 1353. The

analysis performed, in particular, represents steps a person (e.g., an analyst observing how a user interacts with an advertisement) would go through mentally. *See id.* at 1354.

For these reasons, we determine that claim 1 recites an abstract idea in the form of mental processes (e.g., observation, evaluation, judgment, opinion). *See Revised Guidance*, 84 Fed. Reg. 52.

Revised Guidance Step 2A, Prong Two

Appellant contends the Examiner erred because claim 1 recites “a highly specific rule for determining whether an event is attributable to an electronic advertisement.” Appeal Br. 9. That is, “[u]nlike the claims in *Electric Power Group*, [claim 1] recite[s] a *specific implementation* of determining whether an event is attributable to an advertisement — *not* merely the generic end result of determining whether an event is attributable to an advertisement.” *Id.* at 10; *see also* Reply Br. 2–3 (citing *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016); *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1305–06 (Fed. Cir. 2018); *Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, 880 F.3d 1356, 1362 (Fed. Cir. 2018); *Electric Power*, 830 F.3d at 1356).

Appellant’s arguments are unpersuasive because the claimed analysis does not reflect a specific implementation that materially differs from the process that would have been used by a human analyst observing how a user interacts with an advertisement. *See McRO*, 837 F.3d at 1316. In particular, we are persuaded a human analyst would have relied on a “determination that the user paused navigation of a web page or application on a portion of the web page or application on which the electronic advertisement is displayed to the user” (i.e., on indicators that the user reacted to the

advertisement) in assessing whether the user had a notable interaction with the advertisement. As such, we agree with the Examiner that claim 1 does not include additional recitations that represent *technological* improvements. *See* Ans. 13. Rather, claim 1 merely recites limitations that generally link the underlying mental processes to a particular technological environment or field of use (i.e., to analyzing user interactions with advertisements on a web page) and use computer technology as a tool to perform the claimed mental processes. *See* Revised Guidance, 84 Fed. Reg. 55.

Accordingly, we determine that claim 1 does not recite additional recitations that integrate the underlying mental processes into a patent-eligible practical application.

Revised Guidance Step 2B

The Examiner determines that claim 1 does not have additional recitations that provide significantly more than the underlying patent-ineligible subject matter. *See* Final Act. 4–5. In particular, the Examiner determines claim 1 recites mere “**data gathering** and **transferring data** via a generic computer[,] e.g., a computing device,” along with other limitations that “are recited at a high level of generality and/or are recited as performing generic computer functions routinely used in . . . computer applications.” *Id.* at 4. The Examiner further determines that the lack of details in the Specification with respect to “how the ‘pausing’ is detected . . . demonstrates that the additional elements must [have been] well-known” (i.e., that the lack of details evinces inventor belief that detecting such pausing was well-understood, routine, conventional activity). Ans. 6; *see also* Final Act. 4–5.

Appellant contends the Examiner erred by failing to provide factual support to show that the additional limitations merely append well-

understood, routine, and conventional activities, previously known to the industry, specified at a high level of generality, to the purported underlying abstract idea. *See* Appeal Br. 7–8 (citing *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018)). Appellant further argues that “[w]hile a user ‘pausing navigation of a web page or application’ may on its own be well-known or conventional activity, there is no evidence that *using* a determination about such activity to attribute an event to an electronic advertisement is well-known or conventional activity.” Reply Br. 4.

Appellant’s arguments are unpersuasive because the Examiner’s reliance on Krassner to teach or suggest the claimed detection of a pause in navigation (Final Act. 12 (citing Krassner ¶¶ 149–51))—discussed in more detail below—provides sufficient additional support for the Examiner’s determination that the disputed recitation was well-known, routine, or conventional (*see Berkheimer Memorandum* at *4 (discussing use of a “citation to a publication” as evidence)). Moreover, we determine that using observable evidence (e.g., a pause in navigation) that a user is responding to an advertisement is part of the underlying mental processes, not an *additional* recitation that would transform the mental processes into patent-eligible subject matter. *See Genetic Techs. v. Merial LLC*, 818 F.3d 1369, 1376 (Fed. Cir. 2016) (the “inventive concept necessary at step two of the *Mayo/Alice* analysis cannot be furnished by the unpatentable law of nature (or natural phenomenon or abstract idea) itself”).

The Examiner’s determination that the additional recitations, even when considered as an ordered combination, merely append well-understood, routine, conventional activities, previously known to the industry, specified at a high level of generality, to the underlying abstract

idea is also supported by explicitly broad disclosures in the Specification. *See, e.g.*, Spec. ¶ 19 (“receiving computing device may be any suitable computing device, such as the client computing device; a computing device associated with an ad publisher; a computing devices associated with network 110, third-party system 170, or social networking system 160; any suitable combination thereof; or any other suitable computing device”).

Accordingly, we sustain the Examiner’s 35 U.S.C. § 101 rejection of claim 1 and of claim 12, which Appellant does not argue separately.

Independent Claim 21

Appellant contends the Examiner erred by failing to “address the distinct features of Claim 21.” Reply Br. 5. In particular, Appellant argues the Examiner merely rejected claims 1–19 and canceled claim 20. *See* Appeal Br. 7 n.1. As noted above, however, the Examiner’s identification of cancelled claim 20, instead of claim 21,³ in the rejection was a typographical error. *See* Ans. 2.

³ Claim 21 is directed to a method that substantially reflects the operations that would have been performed on the system of canceled claim 20, which had also been subject to a rejection under 35 U.S.C. § 101 as directed to patent-ineligible subject matter. *Compare, e.g.*, Amend. 6 (Feb. 10, 2017) with Amend. 6 (June 5, 2017); *see* Non-Final Act. 6 (Mar. 28, 2017); *see also* *Accenture Global Servs. GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1341 (Fed. Cir. 2013) (citing *CLS Bank Int’l v. Alice Corp.*, 717 F.3d 1269, 1274 n.1 (Fed. Cir. 2013) (en banc)) (“[a]lthough *CLS Bank* issued as a plurality opinion, in that case a majority of the court held that system claims that closely track method claims and are grounded by the same meaningful limitations will generally rise and fall together”); *Alice*, 573 U.S. at 226 (“[p]ut another way, the system claims are no different from the method claims in substance”).

Consequently, we disagree with Appellant that “the Examiner has failed as a matter of law to set forth a prima facie rejection of Claim 21” as being directed to patent-ineligible subject matter. Reply Br. 5. That is, the Examiner’s determinations show that claim 21 is directed to patent-ineligible subject matter for substantially the same reasons as claim 1. *See* Final Act. 5; Ans. 7, 14. Accordingly, we sustain the Examiner’s 35 U.S.C. § 101 rejection of claim 21.

Dependent Claims 2–11 and 13–20

The Examiner determines that the dependent claims “merely add further details of the abstract steps/elements recited . . . without including an improvement to [a] technology or technical field, an improvement to the functioning of the computer itself, or meaningful limitations beyond generally linking the use of the abstract idea to a particular technological environment.” Final Act. 5; *see also id.* at 5–6; Ans. 8–10.

Appellant argues “[t]he Examiner offers only a conclusion of unpatentability and has failed to analyze the limitations specifically recited by each dependent claim under either Step 1 or Step 2 of the *Alice* analysis.” Appeal Br. 9; *see also* Reply Br. 5–6. We are, however, unable to ascertain any error with the Examiner’s determinations with respect to the dependent claims, which merely recite features such as “wherein the electronic advertisement comprises an advertisement displayed on a mobile client computing device” (claim 2)—features that fail to integrate the underlying abstract idea into a practical application or otherwise provide significantly more than the underlying abstract idea.

Accordingly, we sustain the Examiner’s 35 U.S.C. § 101 rejection of claims 2–11 and 13–20.

35 U.S.C. § 103—CLAIMS 1–19

In rejecting claim 1 as obvious, the Examiner finds that Ting’s teaching that an action a user takes based on an advertisement is a conversion event teaches or suggests *determining whether the event is attributable to an electronic advertisement*. Final Act. 8 (citing Ting, Fig. 1, ¶ 20). The Examiner relies on Krassner’s teaching of detecting how long a predefined portion of ad content is in a visible area of a viewer’s browser window to teach or suggest the *determining being based on a determination that the user paused navigation of a web page*. Final Act. 12 (citing Krassner ¶¶ 149–51); *see also* Ans. 17–18 (further citing Krassner Fig. 35, ¶ 153). The Examiner concludes it would have been obvious to an artisan of ordinary skill to modify Ting with Krassner’s teaching “in order to detect an additional event . . . that is attributable to the displayed advertisement/ conversion information for determining advertisement’s effectiveness.” Final Act. 13.

Appellant argues that Krassner does not inherently detect that a user *paused* navigation of a web page because Krassner’s detection criteria could also be met by the user slowly scrolling through display that includes an advertisement. *See* Appeal Br. 13.; Reply Br. 7. That is, Appellant argues that “*Krassner* uses a fundamentally different mechanism for determining an advertisement impression than does the claimed invention.” Reply Br. 8.

We are unpersuaded by Appellant’s argument because, even if Krassner’s method of detecting a “viewable impression” or “view event” would be triggered on unclaimed behaviors—such as slowly scrolling through a web page without fully pausing—Krassner nonetheless teaches or suggests detection of behavior that includes a user *pausing* navigation. *See*

Krassner ¶ 150. That is, if a user stops scrolling for a predefined period while a predefined portion of advertisement content is visible on a web page—i.e., if the user *pauses* navigation of the web page—then Krassner’s method will detect the user behavior. *See, e.g., id.* (detecting a viewable impression or view event when 90% of the advertisement visible for at least one second). Claim 1 does not preclude other detections of behavior.

Accordingly, we sustain the Examiner’s 35 U.S.C. § 103 rejection of claim 1, and of claims 2–19, which Appellant does not argue separately. *See* Appeal Br. 14, 15.

35 U.S.C. § 103—CLAIM 21

Appellant contends claim 21 is non-obvious for the same reasons given with respect to claim 1. Appeal Br. 14. For the reasons discussed above, Appellant’s contention is not persuasive with respect to claim 21.

Appellant further argues the Examiner erred because “*Ting* does not disclose that the **software application generat[ing] the notification** (presumably, *Ting*’s web browser on the client device) *complies with one or more specifications of the social network regarding use of information about the user.*” *Id.* at 15 (brackets in original).

The Examiner concludes that claim 1 only recites *receiving* a generated notification, and, thus, the *generation* of the notification, as well as the software application’s compliance with specifications regarding use of information about the user, are “outside of the scope of” claim 21. Ans. 22; *see also* Final Act. 19, 21–22. Appellant disagrees, arguing “[t]he claim step recites ‘receiving . . . a notification . . .’ and *explicitly defines* the received notification by requiring that the notification be one that is ‘generated by a

software application’ that ‘complies with one or more specifications of the social network regarding use of information about the user.’” Reply Br. 10.

Appellant’s arguments are unpersuasive because we agree with the Examiner that *how* the notification is generated and *whether* the notification is generated by a “software application [that] complies with one or more specifications of the social network regarding use of information” does not affect the notification itself. *See* Ans. 22–23. As the Specification discloses, “as part of implementing the software development kit the developer of the software application may have to agree to a terms of service governing . . . the use of user information obtained by the application.” Spec. ¶ 20. That is, the software that generates the notification complies with specifications of the social network regarding use of information about the user if the developer has faithfully complied with the terms of service. That is, it is merely an *intended use* that the claimed method include receipt of a notification generated by a software application that *complies with one or more specifications of the social network regarding use of information about the user*. Contrary to Appellant’s argument, the claimed *compliance* does not define the notification. *See* Reply Br. 11 (citing *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329 (Fed. Cir. 2005)). Therefore, we agree with the Examiner that the disputed recitations of claim 21 are not entitled patentable weight. *See* Ans. 22; *Cf. also In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (“[i]t is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable”).

Furthermore, Ting’s tracking of attributable events that include, for example, moving a mouse over a particular part of an advertisement, evinces that Ting’s system (e.g., a web browser) complies with one or more

specifications of the social network regarding use of information about the user (e.g., determining whether the user moves the mouse over a particular part of an advertisement). *See* Ting ¶¶ 13, 16. Therefore, we agree with the Examiner that, although not entitled patentable weight, the disputed recitation of claim 21 is taught or suggested by Ting. *See* Ans. 22.

Accordingly, we sustain the Examiner's 35 U.S.C. § 103 rejection of claim 21.

CONCLUSION

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-19, 21	101	Eligibility	1-19, 21	
1-19, 21	103	Ting, Manafy, Krassner, Hsiao	1-19, 21	
Overall Outcome			1-19, 21	

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