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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/011,181	08/27/2013	Ayman Omar Farahat	2893US01	2407

108982 7590 02/07/2020

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ART UNIT	PAPER NUMBER
3681	

NOTIFICATION DATE	DELIVERY MODE
02/07/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AYMAN OMAR FARAHAT and ABHISHEK PANI

Appeal 2018-008967
Application 14/011,181
Technology Center 3600

Before CAROLYN D. THOMAS, IRVIN E. BRANCH, and SCOTT RAEVSKY, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the Examiner's decision to reject claims 1–5, 7–9, and 11–22. Claims 6 and 10 are canceled. We have jurisdiction over the appeal 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 Adobe Systems, Inc. Appeal Br. 3.

The present invention relates generally to techniques for predicting success rates for online search terms based on offline advertising. *See* Abstr.

Independent claim 1, reproduced below, is representative of the appealed claims:

> 1. A method comprising:
>
> receiving, by a predictor component of a computing device, an offline advertising schedule describing future offline advertisements for a product, brand, or entity;
>
> generating, by the predictor component of the computing device, predicted success rates for online search terms associated with a same, similar, or related product, brand, or entity, the predicted success rates being generated based on offline advertising data indicating at least one of a number of persons to be exposed to the future offline advertisements or timing of the future offline advertisements; and
>
> outputting, by the predictor component of the computing device, the predicted success rates for the online search terms, the predicted success rates describing a predicted search volume and a predicted search rate for the online search terms relative to the offline advertising schedule.

Appellant appeals the following rejections:

R1. Claims 1–5, 7–9, and 11–22 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to patent-ineligible subject matter. Final Act. 2–4.; and

R2. Claim 1 is rejected under 35 U.S.C. § 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite. Final Act. 5.

We review the appealed rejections for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

ANALYSIS

Rejection under § 101

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).

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 the 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."). For example, 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, 69 (1972)).

The USPTO published revised guidance on the application of 35 U.S.C. § 101. USPTO's *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) ("Revised Guidance"). *Updated*

by USPTO, *October 2019 Update: Subject Matter Eligibility* (available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf) (jointly referred to as "Revised Guidance"); *see also* October 2019 Patent Eligibility Guidance Update, 84 Fed. Reg. 55942 (Oct. 18, 2019) (notifying the public of the availability of the October update).

Under the Revised Guidance "Step 2A," the office first looks 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 (*see* MPEP § 2106.05(a)-(c), (e)-(h)).

Revised Guidance, 84 Fed. Reg. at 51–52, 55.

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, does the Office then (pursuant to the Revised Guidance "Step 2B") 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.

Revised Guidance, 84 Fed. Reg. at 56.

Step 2A, Prong 1 (Does the Claim Recite a Judicial Exception?)

With respect to independent method claim 1, and similarly, system claim 20 and computer-readable storage media claim 14,[2] the Examiner determines that the claims are directed to "predicting online ad performance based on offline advertising data" (Final Act. 2), which we conclude are at least mental processes, which is a type of abstract idea. We further determine that the claims are directed to fundamental economic practices, such as commercial interactions involving advertising, which is another type of abstract idea, i.e., certain methods of organizing human activity. For at least the following reasons, we are persuaded that representative claim 1 recites plural abstract ideas.

The Specification discloses:

> Techniques for predicting success rates for online search terms based on offline advertising are described herein. The techniques enable marketers to determine appropriate values for online search terms based on their predicted success rates. By so doing, marketers may decide whether to pay online search engines for preferences for their website in response to a search using these online search terms.

Spec. ¶ 3.

> Alternatively or in addition to use of offline advertising schedules to predict success rates for online search terms, remote computing device 104 may predict success rates for online advertisements based on offline advertising schedule 106

[2] In the event of further prosecution, we leave it to the Examiner to consider if computer-readable storage media claim 14 should also be rejected under 35 U.S.C. § 101 for encompassing a transitory media. Signals are not patentable eligible subject matter under § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007); *see also* MPEP § 2106(I) (8th ed. Rev. 9 Aug. 2012); *Ex parte Mewherter*, 107 USPQ2d 1857 (PTAB 2013) (precedential).

> and provide predicted success rates 110 for those online advertisements. These online advertisements can be for various websites and presented in various manners currently used for presenting advertisements online, including advertisements on the online search engines. On receipt of these predicted success rates 110, local computing device 102 may present predicted success rates 110 through user interface 112 to better enable a marketer to decide whether or not to purchase advertisements on online search engines (or other websites). When used in combination, a marketer may determine, based on predicted success rates 110 for both online search terms and online advertisements, to purchase preferences for online search terms and to display advertisements on the online search engine's results page, for example.

Spec. ¶ 24. In other words, Appellant's Specification describes techniques for predicting the success rate for online search terms based on offline advertising, such as television commercials, radio commercials, print advertisements, and brick-and-mortar store ads, such as those on signs or in windows. *See* Spec. ¶ 20.

Claim 1 recites at least "receiving . . . an offline advertising schedule." *See* Claim 1. This limitation, under its broadest reasonable interpretation, recites a fundamental economic practice akin to advertising and/or marketing because this limitation recites an operation that would ordinarily take place in a commercial environment. For example, at least the following decisions from our reviewing court have found many types of fundamental commercial practices patent ineligible: *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 701 (mem) (2015) (offer-based price optimization); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350 (Fed. Cir. 2014) (transaction guaranty); *Personalized Media Commc'ns, L.L.C. v. Amazon.com Inc.*, 671 F. App'x 777 (mem) (Fed. Cir.

2016) (receiving instructions for ordering); *Macropoint, LLC v. Fourkites, Inc.*, 671 F. App'x 780 (mem) (Fed. Cir. 2016) (tracking freight); *Wireless Media Innovations, LLC v. Maher Terminals, LLC*, 636 F. App'x 1014 (mem) (Fed. Cir. 2016) (monitoring shipping containers); *America's Collectibles Network, Inc. v. Jewelry Channel, Inc. USA*, 672 F. App'x 997 (mem) (Fed. Cir. 2017) (conducting reverse auction by adjusting price and inventory); and *EasyWeb Innovations, LLC v. Twitter, Inc.*, 689 F. App'x 969 (Fed. Cir. 2017) (receiving, authenticating, and publishing data).

Additionally, a claim recites a mental process when the claim encompasses acts people can perform using their minds or pen and paper. *See, e.g., CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) (determining that a claim whose "steps can be performed in the human mind, or by a human using a pen and paper" is directed to an unpatentable mental process). This is true even if the claim recites that a generic computer component performs the acts. *See, e.g., Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1335 (Fed. Cir. 2015) ("Courts have examined claims that required the use of a computer and still found that the underlying, patent-ineligible invention could be performed via pen and paper or in a person's mind."); *see also* 2019 Eligibility Guidance 84 Fed. Reg. at 52 n.14 ("If a claim, under its broadest reasonable interpretation, covers performance in the mind but for the recitation of generic computer components, then it is still in the mental processes category unless the claim cannot practically be performed in the mind.").

Here, the claimed "receiving . . . an offline advertising schedule;" "generating . . . predicted success rates;" and "outputting . . . the predicted

success rates," under their broadest reasonable interpretations, encompass acts people can perform using their minds or pen and paper because: (1) people can perform the "receiving" step by simply reading or looking at the recited content, i.e., advertising schedule. People can perform the "generating" step by looking at the number of persons exposed to offline advertising data and observing the timing of future offline advertisements and using pen and paper to calculate a success rate. Finally, people can "output" the success rates by merely passing a piece of paper to one another.

Appellant does not directly challenge whether the claims recite an abstract idea, but instead make arguments more directly related to integrating the judicial exception into a practical application and whether specific limitations are not well-understood, routine, conventional activity in the field. We address such arguments below under our Prong 2 and Step 2B analysis.

Therefore, for at least the aforementioned reasons, we agree with the Examiner that representative claim 1 recites plural abstract ideas, which we conclude are "mental processes" and "certain methods of organizing human activity."

Step 2A—Prong 2 (integration into Practical Application)[3]

Under the Revised Guidance, we now must determine if additional elements in the claims integrate the judicial exception into **a practical application** (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

[3] We acknowledge that some of the considerations at Step 2A, Prong 2, properly may be evaluated under Step 2 of *Alice* (Step 2B of the Revised Guidance). For purposes of maintaining consistent treatment within the Office, we evaluate them under Step 1 of *Alice* (Step 2A of the Revised Guidance). *See* Revised Guidance, 84 Fed. Reg. at 55 nn.25, 27–32.

We discern no additional element (or combination of elements) recited in Appellant's representative claim 1 that integrates the judicial exceptions into a practical application. *See* Revised Guidance, 84 Fed. Reg. at 54–55 ("Prong 2"). For example, Appellant's claimed additional element (e.g., "predictor component of a computing device") does not: (1) improve the functioning of a computer or other technology; (2) is not applied with any particular machine (except for a generic computer); (3) does not effect a transformation of a particular article to a different state; and (4) is not applied in any 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. *See* MPEP §§ 2106.05(a)–(c), (e)–(h).

Appellant contends that "the specific language of claim 1 prevents preemption of all processes for predicting success rates of online search terms." Appeal Br. 19.

Although pre-emption "'might tend to impede innovation more than it would tend to promote it,' thereby thwarting the primary object of the patent laws" (*Alice*, 573 U.S. at 216 (citing *Mayo*, 566 U.S. at 71)), "the absence of complete preemption does not demonstrate patent eligibility" (*Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015)). Moreover, because we find the claimed subject matter covers patent-ineligible subject matter, the pre-emption concern is necessarily addressed. "Where a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, . . . preemption concerns are fully addressed and made moot." *Ariosa Diagnostics*, 788 F.3d at 1379.

Appellant also contends that representative claim 1 is similar to *Enfish*, *McRo*, and *DDR Holdings*. Appeal Br. 17, 20. We disagree with Appellant.

Appellant's Specification discloses:

> Techniques for predicting success rates for online search terms based on offline advertising are described herein. The techniques enable marketers to determine appropriate values for online search terms based on their predicted success rates. By so doing, marketers may decide whether to pay online search engines for preferences for their website in response to a search using these online search terms.

Spec. ¶ 3. In other words, the present invention generates "success rates" that can be used to inform marketers as to whether or not to purchase preferences to their websites.

The claims at issue in *Enfish* were directed to a specific type of data structure, i.e., a self-referential table for a computer database, designed to improve the way a computer carries out its basic functions of storing and retrieving data. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016). In rejecting a § 101 challenge, the court in *Enfish* held that "the plain focus of the claims is on an improvement to computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity." *Id.* at 1336.

Here, Appellant does not point to anything in the claim that resembles the inventive self-referential data structure at issue in *Enfish*. Appellant also does not direct our attention to anything in the Specification to indicate that the invention provides an improvement in the computer's technical functionality.

Instead, the claimed process improves economic tasks, i.e., determining whether or not to purchase preferences of their websites. That is, here the arguably innovative technique of the appealed claims is inextricably a part of the abstract idea of predicting online ad performance based on offline advertising data.

Moreover, nothing in the claims, understood in light of the Specification, requires anything other than an off-the-shelf conventional computer used for collecting and analyzing various data. *See* Spec. ¶ 60. Therefore, unlike *Enfish*, the claims are directed not to an improvement in computer capabilities, but to the results of applying an abstract idea.

In *McRO*, the Federal Circuit concluded that the claim, when considered as a whole, was directed to a "technological improvement over the existing, manual 3-D animation techniques" through the "use of limited rules specifically designed to achieve an improved technological result in conventional industry practice." *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1316 (Fed. Cir. 2016). Specifically, the Federal Circuit found that the claimed rules allow computers to produce accurate and realistic lip synchronization and facial expressions in animated characters that previously could only be produced by human animators; and the rules are limiting because they define morph weight sets as a function of phoneme sub-sequences. *Id.* at 1313 (citations omitted).

In contrast, here, Appellant has not identified any analogous improvement attributable to the claimed invention. Although providing "predicted success rates for online search terms" may improve a business process, i.e., how to calculate payments for website preferences, it does not achieve an improved technological result. We see no parallel between the

limiting rules described in *McRO* and the results-based rules recited in Appellant's claims.

Finally, in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1259 (Fed. Cir. 2014), the court held the subject claim patent-eligible because it encompassed "an inventive concept" for resolving a "particular Internet-centric problem." Specifically, the invention in *DDR Holdings* allowed a host merchant website to maintain the look and feel of the host website when hyperlinking to outside merchants' product pages, i.e., "specify how interactions with the Internet are manipulated to yield a desired result." *DDR Holdings*, 773 F.3d at 1257–58.

In contrast, we find Appellant's method performed by a predictor component of a computing device (*see* claim 1) does not provide a solution "necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks." *DDR*, 773 F.3d at 1257. Instead, analyzing offline advertising data, i.e., non-electronic advertising mechanisms, is an integral part of generating the predicted success rates.

Furthermore, we find all claims on appeal merely use a generic computing device as a tool, which is used in the way a computer normally functions. As such, we conclude that the claims fail to impart any discernible improvement upon the computer or processor; nor do Appellant's claims solve "a challenge particular to the Internet" as considered by the court in *DDR*, 773 F.3d at 1256–57. *See Alice*, 573 U.S. at 224 (concluding claims "simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer" not patent eligible).

For at least the reason noted *supra*, we determine that claim 1 (1) recites a judicial exception and (2) does not integrate that exception into a practical application. Thus, representative claim 1 is directed to an abstract idea.

Alice/Mayo—Step 2 (Inventive Concept)
Step 2B identified in the Revised Guidance

Turning to the second step of the *Alice* inquiry, we now look to whether claim 1 contains any "inventive concept" or adds anything "significantly more" to transform the abstract concept into a patent-eligible application. *Alice*, 573 U.S. at 216. As recognized by the Revised Guidance, an "inventive concept" under *Alice* step 2 can be evaluated based on whether an additional element or combination of elements:

> (1) adds a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field, which is indicative that an inventive concept may be present; or
> (2) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception, which is indicative that an inventive concept may not be present.

See Revised Guidance, 84 Fed. Reg. at 56; *see* MPEP § 2106.05(d).

We find no element or combination of elements recited in Appellant's claim 1 that contains any "inventive concept" or adds anything "significantly more" to transform the abstract concept into a patent-eligible application. Appellant has not adequately explained how claim 1 is performed such that it is not a routine and conventional function of a generic computer.

Appellant merely contends that the claimed feature "enables advantages over existing technology . . . [because they] are neither disclosed, taught, nor suggested by the references of record." Appeal Br. 17.

However, a finding of novelty or non-obviousness does not require the conclusion that the claimed subject matter is patent-eligible. Although the second step in the *Mayo/Alice* framework is termed a search for an "inventive concept," the analysis is not an evaluation of novelty or nonobviousness, but, rather, is a search for "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*, 573 U.S. at 216. "Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry." *Ass'n. for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90. *See also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) ("The 'novelty' of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.").

Appellant also contends that "the Examiner has ***failed to provide any facts*** showing that the features of the claims were widely prevalent or in common use in the relevant industry at the time the patent application was filed." Appeal Br. 14. In response, the Examiner states that "[t]he computing elements have been identified as 'generic' computing elements, not as 'well-understood, routine and conventional,' and therefore, no express support is required on the part of the Examiner." Ans. 4.

However, we note that a generic component is commonly known as a well-understood, routine, and conventional element. "Whether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination." *Berkheimer v. HP Inc*., 881 F.3d 1360, 1369 (Fed. Cir. 2018).

As noted *supra*, we supported the Examiner's factual determination of the claimed invention using generic components by citing Appellant's Specification at paragraph 60, which describes the predictor as software, firmware, hardware, or a combination thereof which is "platform-independent, meaning that the techniques may be implemented on a variety of commercial computing platforms having a variety of processor." Spec. ¶ 60. Appellant fails to persuasively argue why the functions performed in the claims – receiving an offline advertising schedule, generating predicted success rates, and outputting the predicted success rates – i.e., accessing data, analyzing data, and outputting data, are not routine, conventional, and well-known functions of a generic computer. *See buySAFE, Inc. v. Google, Inc*., 765 F.3d 1350, 1355 (Fed. Cir. 2014) ("[t]hat a computer receives and sends information over a network—with no further specification—is not even arguably inventive"); *In re TLI Communications LLC Patent Litigation*, 823 F.3d 607, 614 (Fed. Cir. 2016) (server that receives data, extracts classification information from the received data, and stores the digital images insufficient to add an inventive concept); *Lending Tree*, 656 Fed. Appx. at 996 ("automating conventional activities using generic technology does not amount to an inventive concept"). Thus, considering the features of the claims, individually and as an ordered combination, we

find there are no additional elements that transform the nature of the claim into a patent-eligible application. *Alice*, 573 U.S. at 216

The Examiner's noting of the generic nature of the component parts recited in the claims along with our supportive citation to Appellant's Specification provides sufficient evidence of a generic computer system used to implement the abstraction. *See Credit Acceptance Corp. v. Westlake Services*, 859 F.3d 1044, 1057 (Fed. Cir. 2017) ("Significantly, the claims do not provide details as to any non-conventional software for enhancing the financing process."); *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1342 (Fed. Cir. 2017) (explaining that "[o]ur law demands more" than claim language that "provides only a result-oriented solution, with insufficient detail for how a computer accomplishes it").

Because Appellant's independent claim 1 is directed to a patent-ineligible abstract concept, does not include additional elements that integrate the judicial exception into a practical application, and does not add a specific limitation beyond the judicial exception that is not "well-understood, routine, and conventional," we sustain the Examiner's rejection of the claims 1–5, 7–9, and 11–22 under 35 U.S.C. § 101 as being directed to non-statutory subject matter in light of *Alice*, its progeny, and the Revised Guidance.

Rejection under § 112

The Examiner finds that "[i]t is unclear and indefinite what a 'predicted search rate' is." Final Act. 5. "[W]e apply the approach for assessing indefiniteness approved by the Federal Circuit in *Packard*, i.e., '[a] claim is indefinite when it contains words or phrases whose meaning is

unclear.'" *Ex parte McAward*, 2017 WL 3669566, at *5 (PTAB Aug. 25, 2017) (precedential) (quoting *In re Packard*, 751 F.3d 1307, 1310, 1314 (Fed. Cir. 2014)). "Put differently, 'claims are required to be cast in clear—as opposed to ambiguous, vague, indefinite—terms.'" *Id.* (quoting *Packard*, 751 F.3d at 1313); *see also* MPEP § 2173 .02(1). "At the same time, this requirement is not a demand for unreasonable precision." *Packard*, 751 F.3d at 1313. For instance, the breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 693 (CCPA 1971).

Here, we find that the claimed "predicted search rate" (*see* claim 1) while broad, is not indefinite. Appellant contends that "the [S]pecification clearly . . . provides an example 'predicted search rate' as a search volume relative to a time period: 'six ads within a three-hour period.'" Appeal Br. 11, *citing* Spec. ¶ 32.

Specifically, Appellant's Specification states:

> Consider, by way of example, Fig. 3, which illustrates an historic success rate 302 for an online search term "Newboy" associated with a particular offline advertising schedule for *Newboy Internet Services.* The offline advertising schedule associated with historic success rate 302 (here measured in search volume) is relatively short - six ads within a three-hour period (for a three-hour sporting event with a very large market share). Offline advertising schedule 304 is shown as a mark on the graph for February 4th, 2012. Note that historic success rate 302 is based on searches that have at least a single term—the name of the entity that was advertised, *Newboy.* Another historic success rate, historic success rate 306 for a competitive entity, *Oldboy Internet Services*, which holds a larger market share and higher general search volumes, is shown for context and can be used by predictor 210 as a set of control data.

Spec. ¶ 32.

In response, the Examiner finds that "Appellant's Spec. does not further define a 'predicted search rate.' . . . Para 32 discusses success rate and search volume, as well as ad scheduling – 'six ads within a three-hour period.' An ad schedule is different from a 'predicted search rate.'" Ans. 3.

In response to the Examiner (although not directly addressing the Examiner's specific aforementioned interpretation), Appellant contends that Fig. 3 illustrate a search rate "by monitoring the search volume relative to time, as noted by the y-axis and x-axis . . . Likewise, Fig. 6 of Appellant's specification illustrates a predicted search volume relative to time." Reply Br. 5. We find Appellant's argument persuasive.

Specifically, Appellant directs our attention to Figures 3 and 6 in the disclosure, which Appellant believes define, by example, the claimed "search rate," i.e., search volume relative to time. We find that one of ordinary skill in the art would view the claimed "search rate" as a quantity of searches measured per unit of something else. Here, at least Appellant's Figures identify the something else as "time."

Accordingly, we reverse the Examiner's rejection of claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite.

CONCLUSION

Appellant has demonstrated that the Examiner erred in rejecting claim 1 as being indefinite under 35 U.S.C. § 112, second paragraph.

However, the Examiner's rejection of all the claims, i.e., claims 1–5, 7–9, and 11–22, under 35 U.S.C. § 101, is affirmed.

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–5, 7–9, 11–22	101	Eligibility	1–5, 7–9, 11–22	
1	112	Indefiniteness		1
Overall Outcome			1–5, 7–9, 11–22	

Because at least one rejection encompassing all claims on appeal is affirmed, the decision of the Examiner is affirmed.

No period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED