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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ANAND P. RANGARAJAN, VICTOR B. LORTZ,  
VIJAY SARATHI KESAVAN, SOMYA RATHI, and XINGANG GUO

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Appeal 2019-000306  
Application 13/992,801  
Technology Center 3600

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Before DAVID M. KOHUT, IRVIN E. BRANCH, and  
JOSEPH P. LENTIVECH, *Administrative Patent Judges*.

KOHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1, 5–11, 15–20, and 24–30.<sup>2</sup> Final Act. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> We use “Appellant” to reference the applicant as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as “Intel Corp.” Appeal Br. 3.

<sup>2</sup> Claims 2–4, 12–14, and 21–23 were cancelled in the request for reconsideration filed February 27, 2017.

STATEMENT OF THE CASE

APPELLANT'S INVENTION

Appellant's invention "relates generally to location based advertising." Spec. ¶ 1. Claim 1 recites the invention as follows.

1. A method comprising:

distributing a location based advertisement over a peer-to-peer network;

transmitting said advertisement to consumers including a first consumer;

automatically causing the first consumer to transmit the advertisement to another consumer; and

automatically causing the first consumer to append an identifier to the advertisement to identify the first consumer that transmits the advertisement to another consumer so that the first consumer can be rewarded for each subsequent distribution of the advertisement.

Appeal Br. 11 (claims appendix).

REJECTIONS

1. Claims 1, 5–11, 15–20, and 24–30 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Final Act. 2–9.

2. Claims 1, 5–11, 15–20, 24, and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dendi (US 2007/0282678 A1; Dec. 6, 2007) and Greenspun (US 2012/0185310 A1; July 19, 2012). Final Act. 9–12.

3. Claims 26–30 stand rejected under 35 U.S.C. § 102 as being anticipated by Dendi. Final Act. 13–14.

## OPINION

### 1. REJECTION UNDER 35 U.S.C. § 101

For the reasons below (sections 1.A–G), we are unpersuaded of error in this rejection of independent claim 1. For the same reasons, we are unpersuaded of error in this rejection of claims 5–11, 15–20, and 24–30, which are not separately argued for this rejection. *See* 37 C.F.R. § 41.37(c)(1)(iv).

#### *A. Principles of Law*

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) (citation omitted).

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*. *Alice*, 573 U.S. 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, 67 (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 water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1853))); 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.* (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.”).

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.* (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.*

### *B. PTO Guidance*

The PTO recently published revised guidance on the application of § 101. USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019). 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 activities such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* Manual of Patent Examining Procedure (MPEP) § 2106.05(a)–(c), (e)–(h) (9th ed. 2018)).

84 Fed. Reg. at 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 conclude the claim is directed to a judicial exception (*id.* at 54) and 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.

*Id.* at 56.

*C. Step 1: Does Claim 1 Fall within a Statutory Category?*

There is no dispute that claim 1 falls within a category of patentable subject matter. *See* 35 U.S.C. § 101 (“process, machine, manufacture, or composition of matter”); *see also* Guidance, 84 Fed. Reg. at 53–54 (“Step 1”).

*D. Step 2A(1):<sup>3</sup> Does Claim 1 Recite Any Judicial Exceptions?*

Turning to the first issue set forth by the Guidance (*see supra* 5, bullet “(1)”), we find claim 1 recites—and, more particularly, describes—

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<sup>3</sup> The Guidance separates the herein-enumerated issues (1) to (4) (*see supra* 5–6) into Steps 2A(1), 2A(2), and 2B, as follows:

[T]he revised procedure . . . focuses on two aspects [of whether a claim is “directed to” a judicial exception under the first step of the *Alice/Mayo* test (USPTO Step 2A)]: (1) [w]hether the claim recites a judicial exception; and (2) whether a recited judicial exception is integrated into a practical application. . . . [W]hen a claim recites a judicial exception and fails to integrate the exception into a practical application, . . . further analysis pursuant to the second step of the *Alice/Mayo* test (USPTO Step 2B) . . . is needed . . . in accordance with existing USPTO guidance as modified in April 2018.[footnote omitted]

84 Fed. Reg. at 51 (also instructing, via the omitted footnote, that Step 2B is addressed per the “USPTO Memorandum of April 19, 2018, ‘Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*)’ (Apr. 19, 2018), available at <https://www.uspto.gov/sites/default/files/documents/>

judicial exceptions. *See* October 2019 Patent Eligibility Guidance Update (“Update”) at 1 (*available at [https://www.uspto.gov/sites/default/files/documents/peg\\_oct\\_2019\\_update.pdf](https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf)*) (presenting meanings of: recite; set forth; describe). Specifically, we agree with the Examiner that “the heart of [the claimed invention] is providing, receiving, and sharing location based advertisements.” Final Act. 3; *see also* Spec. ¶ 1 (quoted *supra* 2).

We add that the claimed invention applies the above concepts as part of activities falling within the Guidance’s following category of judicial exceptions: “(b) Certain methods of organizing human activity— . . . commercial . . . interactions (including . . . advertising, marketing or sales activities or behaviors . . . ); managing personal behavior . . . or interactions between people (including . . . teaching . . . ).” Guidance, 84 Fed. Reg. at 52; *see also* Update at 2–9 (section addressing Step 2A(1)); *e.g., id.* at 6 (“advertising, marketing or sales activities or behaviors”). Specifically, the claimed “distributing a location based advertisement . . . [and] transmitting said advertisement to consumers including a first consumer” constitutes a commercial interaction (advertising). The claimed “causing the first consumer to append an identifier to the advertisement to identify the first consumer” and to “transmit[] the advertisement to another consumer[,] so that the first consumer can be rewarded for . . . distribution of the advertisement,” constitutes both a commercial interaction and management of interactions between people (incentivizing ‘word-of-mouth’ advertising).

For the foregoing reasons, claim 1 recites judicial exceptions.

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*memo-berkheimer-20180419.PDF* ([ . . . ‘USPTO Berkheimer Memorandum’].”).

*E. Step 2A(2): Are the Recited Judicial Exceptions Integrated Into a Practical Application?*

Turning to the second issue set forth by the Guidance (*see supra* 5, bullet “(2)”), we find the recited judicial exceptions are not integrated into a practical application. *See* Guidance, 84 Fed. Reg. at 53 (describing a “practical application” as a “meaningful limit on the [recited judicial exceptions], such that the claim is more than a drafting effort designed to monopolize the [exceptions]”); *see also id.* at 55 (“exemplary considerations . . . indicative that an additional element (or combination of elements) may have integrated the exception into a practical application”); Update at 10–15 (section addressing Step 2A(2)). Specifically, we agree with the Examiner that claim 1’s additional elements (i.e., claimed features not constituting judicial exceptions) are “a peer-to-peer network” (explicit) and “general purpose computers performing the generic computer functions” (implicit) of receiving, transmitting, and appending information. Adv. Act. 2. We further agree the additional elements are recited at a “high level of generality”—merely “distributing [] advertisements, transmitting [an] advertisement, causing the first consumer to transmit [the] advertisement, and causing the first consumer to append an identifier to [the] advertisement.” *Id.* We also agree that, because claim 1 lacks “details regarding the identifier, the appending process[,] or . . . tracking . . . [of] the appended identifier to provide rewards,” claim 1 “generically provide[s] for appending an identifier to an advertisement and . . . rewarding users[, i.e.,] without setting out how this is to be accomplished.” Ans. 5 (emphasis added).

We add that *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016), exemplifies why claim 1 lacks sufficient

detail for a practical application of the recited judicial exceptions. *McRO*'s claim was held patent-eligible because of "us[ing] a combined order of specific rules that renders information into a specific format that is then used and applied to create desired results." *McRO*, 837 F.3d at 1315 (emphasis added). The underlying basis for this finding was that ***the claim did not preempt the judicial exception***; i.e., the claimed rules satisfied this criterion. *Id.* at 1314. *McRO* explains:

The preemption concern arises when the claims are not directed to a specific invention[.] . . . A patent is not good for an effect . . . because such patents would prohibit all other persons from making the same thing by any means whatsoever. . . . We therefore look to whether the claims in these patents focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.

*Id.* (citations and quotation marks omitted). Claim 1 does not overcome these concerns. Claim 1 recites activities of: marketing a product by incentivizing distributions of related information (claimed advertisement); and, as part thereof, having a distributor append their identification (claimed first consumer and identifier) to the information in order to cause the recipient (claimed another consumer) to subsequently identify the distributor (claimed "so that the first consumer can be rewarded").<sup>4</sup> These features do

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<sup>4</sup> The Specification confirms the claimed "so that the first consumer can be rewarded" encompasses the above-noted activity of an advertisement's recipient (claimed second consumer) identifying the advertisement's sender (claimed first consumer) in a subsequent transaction. Spec. ¶ 5. As this activity constitutes a judicial exception, we need not address the Examiner's determination that the claimed "so that the first consumer can be rewarded"

not prevent preemption of the recited judicial exceptions, but rather constitute the judicial exceptions. *See also SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1163 (Fed. Cir. 2018), *cert. denied* 139 S. Ct. 2747 (2019) (“[An] advance [that] lies entirely in the realm of abstract ideas . . . is ineligible for patenting.”).

We also add that *Secured Mail Sols. LLC v. Universal Wilde, Inc.*, 873 F.3d 905 (Fed. Cir. 2017), *cert. denied*, 138 S. Ct. 2000 (2018), further exemplifies why claim 1’s description of the appended identifier does not impart patent-eligibility. *See also* Ans. 6 (citing *Secured Mail*). As to *Secured Mail’s* appended identifier, the Federal Circuit stated:

Secured Mail argues that the claims are specifically directed to a sender-generated unique identifier, which improved on the existing process both by reliably identifying the sender of the mail object and by permitting the sender to create a bi-directional communication channel between the sender and recipient of the mail object. The fact that an identifier can be used to make a process more efficient, however, does not necessarily render an abstract idea less abstract.

The claims of the Intelligent Mail Barcode patents are not directed to specific details of the barcode or the equipment for generating and processing it. The claims generically provide for the encoding of various data onto a mail object but do not set out how this is to be performed. The claims state that various identifiers are affixed to a mail object, stored in a database, scanned from the mail object, and retrieved from the database. No special rules or details of the computers, databases, printers, or scanners are recited. *Cf. McRO*, 837 F.3d

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limitation (which encompasses this activity) is an intended use. Ans. 5. We note, however, the *Digitech* decision instructs that a claim preamble’s description of an invention’s “purpose or intended use” is not a claim limitation for purposes of patent-eligibility under 35 U.S.C. § 101. *Digitech*, 758 F.3d at 1351.

at 1315 (finding patent eligibility where the “claimed process uses a combined order of specific rules that renders information into a specific format that is then used and applied to create desired results”)[.]

*Secured Mail*, 873 F.3d at 910. Similar to the claim recitations for *Secured Mail*'s identifier, claim 1's recitations for the identifier describe a “sender-generated unique identifier [for] . . . reliably identifying the sender of the [sent] object” in a subsequent electronic transaction, are “not directed to specific details of the [identifier] or the equipment for generating and processing it,” and thus “generically provide for the encoding of various data onto [the sent] object but do not set out how this is to be performed.” *Id.*

For the foregoing reasons, claim 1 is directed to the recited judicial exceptions—not to a practical application thereof.

*F. Step 2B: Does Claim 1 Recite Anything That Is Beyond the Recited Judicial Exceptions and Not a Well-Understood, Routine, Conventional Activity?*

Turning to the third and fourth issues set forth by the Guidance (*see supra* 5–6, bullets “(3)” and “(4)”), we find the claimed invention does not comprise a feature that is neither a judicial exception nor “well-understood, routine, conventional.” 84 Fed. Reg. at 56. Specifically, we agree with the Examiner that claim 1's additional elements (*see supra* 8) perform (at most) the following “computer functions [that are] well-understood, routine, and conventional: . . . receiving, processing, and storing data; electronically . . . extracting data . . . ; . . . automating me[n]tal tasks; and receiving or transmitting data over a network.” Final Act. 3 (emphasis omitted) (citing the “July 2015 Update: Subject Matter

Eligibility”);<sup>5</sup> *see also* Ans. 6 (“[G]eneral purpose computer functions[,] as identified by MPEP [§] 2106.05(d)(II)[,] . . . include at least distributing, receiving and transmitting data over a network, electronic record keeping, storing and retrieving information.”). We also agree the claimed peer-to-peer network and peer devices (first consumer and another consumer) encompass “common network nodes operating in commonplace LAN and WAN networking environments[,] as supported by at least Dendi [at paragraphs 13, 65, and 106].” *Id.* at 5.

For the foregoing reasons, the claimed additional elements merely append “well-understood, routine, conventional” technology to the recited judicial exceptions.

#### *G. Appellant’s Arguments*

We reviewed Appellant’s arguments (Appeal Br. 6–7; Reply Br. 1–2) and, in view of our above analyses, are not persuaded the Examiner erred. We address the below contentions for emphasis.

Appellant contends:

The [Examiner has determined claim 1 does] not detail the [invention’s] technological requirements[.] See Answer, p. 5. . . . [T]he claimed invention tells you exactly how to achieve the results. You have to apply an identifier for the referring customer so that each referred customer can then be tied back to the referring customer[, who then] gets credits for all the peer-to-peer referrals. The Examiner has no art that teaches this

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<sup>5</sup> The July 2015 Update is available at <https://www.uspto.gov/sites/default/files/documents/iegjuly-2015-update.pdf>. The Update presents a list of computer functions that are judicially-recognized as “well understood, routine, conventional.” *See also* MPEP § 2106.05(d)(II) (presenting a substantially similar list of computer functions that are judicially-recognized as conventional; cited by the *Berkheimer* Memorandum at, § III.A.2, as sufficient support for a Step 2B finding).

and the claims adequately detail how to do this. Certainly the elegance of the solution includes its simplicity and it is not seen how simplicity, which has never been achieved before, can be an argument against patent eligibility.

Reply Br. 2; *see also* Appeal Br. 6 (“[Claim 1] is not an attempt to patent some economic system that provides incentives[,] but rather . . . to claim the way this is done, [as] specifically adapted for implementation by a computer.”). We are unpersuaded for the reasons presented in our above discussion of *McRO* and *Secured Mail*. *See supra*, Step 2A(2).

Appellant also contends:

The [Examiner’s] analysis . . . ignores the way that the [claimed] identifier is placed on to the advertisement to achieve results in a computer . . . .

This limitation is simply brushed off as “organize information through mathematical correlations.” . . .

The claims do not involve either organizing information or doing so through mathematical correlations. It is not at all evident why the office action believes there is something mathematical here.

Appeal Br. 6 (addressing Final Act. 3–5). We are unpersuaded. The Examiner quotes “organiz[e] information through mathematical correlations” as the specific abstract idea addressed by *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344 (Fed. Cir. 2014). Final Act. 3, 5; Ans. 6. Even assuming (arguendo) the Examiner errs in analogizing the claimed appending of a sender-generated identifier to *Digitech*, the Examiner also analogizes the claimed appending to *Secured Mail*. Ans. 6; *see also supra* 11–12. Appellant does not address

*Secured Mail* nor otherwise rebut that appending a sender-generated identifier to a business communication is a judicial exception.

Appellant also contends claim 1 compels a finding of patent-eligibility under *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014) and *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016). Appeal Br. 6–7; Reply Br. 1–2. These decisions, like *McRO*, emphasize a need for a claimed mechanism that prevents preemption of recited judicial exceptions. *See DDR*, 773 F.3d at 1259 (The claims “do not attempt to preempt . . . making two web pages look the same,” but “[r]ather . . . recite a specific way to automate the creation of a composite web page.”); *Enfish*, 822 F.3d at 1339 (The claims “recited . . . a specific type of data structure . . . confirm[ing] . . . the § 101 analysis has not been deceived by the ‘draftsman’s art.’” (quoting *Alice*, 573 U.S. at 226)). As discussed with reference to *McRO*, the argued features of Appellant’s claim 1 do not prevent preemption of the judicial exceptions, but rather constitute judicial exceptions. *See supra* Step 2A(2).

Accordingly, as we are not persuaded of error, we sustain the rejection of claims 1, 5–11, 15–20, and 24–30 under 35 U.S.C. § 101.

#### 2 AND 3. REJECTIONS UNDER 35 U.S.C. §§ 103 AND 102

We select claim 1 as representative of the claims rejected under 35 U.S.C. § 103 and claim 26 as representative of the claims rejected under 35 U.S.C. § 102. *See* 37 C.F.R. § 41.37(c)(1)(iv). For the reasons below, we are persuaded of error in these rejections of claims 1 and 26.

Each of claims 1 and 26 recites the above-addressed feature of distributing (transmitting) an advertisement and, as part thereof, first appending an identifier of the distributor to the advertisement.

Before proceeding to Appellant’s arguments regarding the disputed feature (Appeal Br. 8–10; Reply Br. 3), we note the Examiner’s contradictory findings: for the rejection of claim 1, under 35 U.S.C. § 103, that “Dendi . . . does not specifically disclose that an identifier . . . is appended” (Final Act. 10); and for the rejection of claim 26, under 35 U.S.C. § 102, that “Dendi discloses . . . to append an identifier” (*id.* at 13). The Examiner does not reconcile these findings. Final Act. 13; Ans. 8–9.<sup>6</sup> We are, therefore, uncertain of whether—much less how—the Examiner perceives the claimed appending to be taught by Dendi.

Accordingly, we do not sustain the 35 U.S.C. § 102 rejection of claims 26–30 over Dendi.

Turning to the 35 U.S.C. § 103 rejection of claims 1, 5–11, 15–20, 24, and 25 over Dendi and Greenspun, and again to the claimed appending, the Examiner finds:

Greenspun discloses that it is well known to dynamically append a user identifier to output links in at least paragraph [0029]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to append the user identifier to the transmitted advertisements of Dendi. The rationale for doing so is that there are a limited number of predictable ways in which to track a shared advertisement for the purpose of rewarding the person that transmitted the advertisement[. A]ppending the user identifier to the advertisement is one such predictable way.

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<sup>6</sup> For example, the Examiner does not state claim 26’s “appending” language merely describes an intended use of the claimed apparatus. Final Act. 13; Ans. 8–9; *see also In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (“Schreiber’s contention that his structure will be used to dispense popcorn does not have patentable weight if the structure is already known, regardless of whether it has ever been used in any way in connection with popcorn.”).

Final Act. 10–11; *see also* Ans. 7–8. Appellant responds:

[P]aragraph 29 of Greenspun . . . talks about a user identifier that may be included on subsequent requests to a website. The user identifier allows the website to tailor content for the user according to the user context. In other words, all Greenspun is talking about here is an identifier for a user to enable customization for that user. Even if one could argue the identifier is appended to a request, there is no suggestion of using an identifier appended to a transmission to identify the entity that transmits an advertisement. In other words[,] there is no suggestion that when a downstream user sends a transmission of the advertisement on, he automatically appends an identifier to that advertisement.

Appeal Br. 9.

We agree with Appellant inasmuch the Examiner does not explain how Dendi and Greenspun show it would have been obvious to “track a shared advertisement . . . [by] appending the [person’s] user identifier to the advertisement” (Final Act. 10–11). At best, the Examiner’s findings for Dendi evidence a desire to incentivize a device’s promoting of a service provider’s “products or services” (Dendi ¶ 55) by tracking how many times the device shares related information and accordingly rewarding the device user. *See, e.g.*, Final Act. 14.<sup>7</sup> The findings for Greenspun evidence a capability to append a device identifier to information transmitted by the device (Greenspun ¶ 29). *See, e.g.*, Final Act. 10–11. There is still an unanswered question of whether an artisan would combine these teachings—that is, track how many times a device transmits information by appending a device identifier to the information. The Examiner cannot bridge that gap by

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<sup>7</sup> Page 14 of the Final action references Greenspun’s paragraph 55, but plainly intended to reference Dendi’s paragraph 55.

merely stating, as here, “there are a limited number of predictable ways in which to track a shared advertisement.” Final Act. 10–11 (block-quoted above). ***To take this obvious-to-try approach***, the Examiner must—but does not—first show: the art comprised a finite number of known solutions for tracking how many times a device transmits information; and appending a device identification to transmitted information was one of those known solutions. *See Rolls-Royce, PLC v. United Techs. Corp.*, 603 F.3d 1325, 1339 (Fed. Cir. 2010) (“To determine that an invention would have been obvious to try on the basis of the record before the time of invention, . . . the possible approaches and selection to solve the problem must be ‘known and finite.’” (citation omitted)); *see also Slot Speaker Techs., Inc. v. Apple Inc.*, 680 F. App’x 932, 941 (Fed. Cir. 2017) (“Apple’s expert . . . explained that the [modification] . . . would be a routine design choice, as one of a limited number of known solutions to minimize the presence of standing waves[.] . . . Based on this showing, we conclude that substantial evidence supports the Board’s finding that [an artisan] . . . would have recognized that [the modification] . . . suppresses standing waves.” (internal cite and quotation marks omitted)); MPEP § 2143.I.E (respective section titles are: Examples of Basic Requirements of a *Prima Facie* Case of Obviousness; Exemplary Rationales; “Obvious To Try”—Choosing From a Finite Number of Identified, Predictable Solutions, With a Reasonable Expectation of Success) (8th ed. 2017).

Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of claims 1, 5–11, 15–20, 24, and 25 over Dendi and Greenspun.

### CONCLUSION

We affirm the Examiner’s decision to reject claims 1, 5–11, 15–20, and 24–30 under 35 U.S.C. § 101. *See* 37 C.F.R. § 41.50 (“The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim[.]”).

### DECISION SUMMARY

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/ Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 5–11, 15–20, 24–30	101	Eligibility	1, 5–11, 15–20, 24–30	
1, 5–11, 15–20, 24, 25	103	Dendi, Greenspun		1, 5–11, 15–20, 24, 25
26–30	102	Dendi		26–30
<b>Overall Outcome</b>			1, 5-11, 15–20, 24–30	

### 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**