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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THERESA MUENCH, ANDREA NOLTING, and
SUNDAR G. RAMAN

Appeal 2019-000629
Application 14/706,055
Technology Center 3600

Before ALLEN R. MacDONALD, BRADLEY W. BAUMEISTER and
NABEEL U. KHAN, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* MacDONALD.

Opinion Concurring filed by *Administrative Patent Judge* BAUMEISTER.

MacDONALD, *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 1–7. Appellant has cancelled claims 8–
14. Final Act. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellant identifies the real parties in interest as The Procter & Gamble
Company of Cincinnati, Ohio. Appeal Br. 1.

CLAIMED SUBJECT MATTER

Claim 1 is illustrative of the claimed subject matter (emphasis, formatting, and bracketed material added):

1. A method for structuring the content of an advertisement for a product or service, the method comprising steps of:
 - [A.] providing a first advertisement associated with a primary product or service, and comprising message copy and a message copy timeline;
 - [B.] providing a second advertisement comprising a message track;
 - [C.] inserting the secondary advertisement into the first advertisement;
 - [D.] presenting the combined first and second advertisement;
 - [E.] wherein the second advertisement is inserted into the first advertisement message copy time line as² or after the expression of a portion of the first advertisement message copy *relevant to the second advertisement message track*.

REFERENCES³

The Examiner relies upon the following prior art:

Name	Reference	Date
Billmaier	US 2004/0003406 A1	Jan. 1, 2004
Briggs	US 8,312,486 B1	Nov. 13, 2012

² For purposes of this appeal, we read this “as” as –at–.

³ All citations herein to patent and pre-grant publication references are by reference to the first named inventor only.

REJECTIONS

A.

The Examiner rejects claims 1–7 under 35 U.S.C. § 101 “because the claimed invention is directed to non-statutory subject matter.” (Final Act. 4), i.e., the claimed invention is directed to patent-ineligible subject matter. Final Act. 4–7.

We select claim 1 as the representative claim for this rejection. Appellant does not argue separate patentability for claims 2–7. Appeal Br. 3–4. Except for our ultimate decision, we do not address the § 101 rejection of claims 2–7 further herein.

B.

The Examiner rejects claims 1 and 2 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement. Final Act. 2–4.

We select claim 1 as the representative claim for this rejection. Appellant does not argue separate patentability for claim 2. Appeal Br. 2–3. Except for our ultimate decision, we do not address the § 112(a) rejection of claim 2 further herein.

C.

The Examiner rejects claims 1–3 under 35 U.S.C. § 103 as being unpatentable over the combination of Billmaier and Briggs. Final Act. 7–9. We select claim 1 as the representative claim for this rejection. Appellant does not argue separate patentability for claims 2 and 3. Appeal Br. 4–5.

The Examiner rejects claims 4–7 under 35 U.S.C. § 103 as being unpatentable over various combinations of Billmaier, Briggs, and numerous other references. Final Act. 9–13. To the extent that Appellant discusses the

§ 103 rejections of claims 4–7, Appellant merely repeats the arguments directed to claim 1. Appeal Br. 5–8. Such a repeated argument is not an argument for “separate patentability.” Thus, Appellant does not present separate arguments for claims 4–7. Thus, the rejections of these claims turn on our decision as to claim 1.

Therefore, except for our ultimate decision, we do not address the § 103 rejections of claims 2–7 further herein.

OPINION

We have reviewed the Examiner’s rejections in light of Appellant’s Appeal Brief and Reply Brief arguments.

A. Section 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 U.S. 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 Court’s two-part 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, 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 waterproof 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 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 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.* (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.”).

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 (quotation marks 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.*

B. USPTO § 101 Guidance

The U. S. Patent and Trademark Office (USPTO) published revised guidance on the application of § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (“2019 Memorandum”).⁴ Under that guidance, we first look to whether the claim recites:

⁴ The Office issued a further memorandum on October 17, 2019 (the “October 2019 Memorandum”) clarifying guidance of the January 2019 Memorandum in response to received public comments. *See* https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf. Moreover, “[a]ll USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.” January 2019 Memorandum at 51; *see also* October 2019 Memorandum at 1.

- (1) (*see* 2019 Memorandum Step 2A – Prong One) 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) (*see* 2019 Memorandum Step 2A – Prong Two) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).⁵

2019 Memorandum Steps 2A, B, 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 2019 Memorandum Step 2B, 84 Fed. Reg. 56.

⁵ This evaluation is performed by (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception, and (b) evaluating those additional elements individually and in combination to determine whether the claim as a whole integrates the exception into a practical application. *See* 2019 Memorandum - Section III(A)(2).

C. Examiner's § 101 Rejection - Alice/Mayo - Steps 1 and 2

C.1. 2019 Memorandum Step 2A – Prong One

Applying the *Alice/Mayo* analysis, the Examiner determines that claim 1 recites an abstract idea:

The claims are directed to the abstract idea of inserting a second advertisement into a first advertisement and providing the combined advertisement. The claimed concept is similar to that found to be patent ineligible in the *Intellectual Ventures [v.] Capital One Bank* (the '382 patent) decision, in which content is tailored to a user based on information about the user. Similarly, the claimed invention simply combines two advertisements based on an association between the two advertisements and then targets them to a user device.

Final Act. 4 (emphasis added).

C.2. 2019 Memorandum Step 2A – Prong Two

Further applying the *Alice/Mayo* analysis, the Examiner determines claim 1 is directed to an abstract idea.

The claims are truly directed to an “idea of itself” as there is no mention of a computer or other device performing any of the claim steps at all and the applicant's specification also recites no structure at all for any aspect of the invention.

Final Act. 4–5.

When considered as an ordered combination, the examiner sees only the logical steps necessary to carry out the abstract idea, namely to provide advertisement data, insert one data set into the other at a chosen location, and then deliver and present the combined data to a device.

Final Act. 6.

C.3. 2019 Memorandum Step 2B

Applying the *Alice/Mayo* analysis, the Examiner determines:

The claims beyond the abstract idea include providing of a first and second advertisement that include message copy, message timeline, and message track data. The providing step is assumed to be providing of the advertisement data to editing software for subsequent editing to insert one ad into the other for subsequent completion and then delivery to a user device. Such a providing step is considered conventional “receiving and/or transmission of data over a network” is listed on page 7 of the USPTO July 2015 Update for Subject Matter Eligibility as an example of computer functioning that is considered “well-understood, routine, and conventional,” citing *Ulramercial* and *buySAFE v Google*. The claims also include the placement of the second advertisement being placed at a point relevant to the second advertisement. However, such an insertion is simply an editing decision and simply automates a mental task using software or pen and paper. Such a step does not make the claims significantly more, as the claim steps still simply “automates a mental task,” which is also listed on page 7 of the USPTO July 2015 Update for Subject Matter Eligibility as an example of computer functioning that is considered “well-understood, routine, and conventional,” citing *Alice* and *buySAFE v Google*.

Final Act. 5–6.

D. Appellant’s § 101 Arguments & Panel’s Analysis

D.1. 2019 Memorandum Step 2A, Prong 1

Appellant does not dispute that the claims recite “the abstract idea of inserting a second advertisement into a first advertisement and providing the combined advertisement.” Final Act. 4; *see* Appeal Br. 3–4.

We determine that claim 1 recites a “method for structuring the content of an advertisement for a product or service,” including the following limitations:

[A.] *providing* a first advertisement associated with a primary product or service, and comprising message copy and a message copy timeline;

[B.] *providing* a second advertisement comprising a message track;

[C.] *inserting* the secondary advertisement into the first advertisement;

[D.] *presenting* the combined first and second advertisement;

[E.] wherein the second advertisement *is inserted* into the first advertisement message copy time line as or after the expression of a portion of the first advertisement message copy relevant to the second advertisement message track.

Claim 1 (emphasis, formatting, and bracketed material added).

In short, the Examiner correctly determines that claim 1 *recites* a method for creating a combined advertisement (i.e., a commercial interaction); and *a commercial interaction* is one of certain methods of organizing human activity identified in the 2019 Memorandum, and, thus, a recognized abstract idea. 2019 Memorandum, 84 Fed. Reg. at 52.

D.2. 2019 Memorandum Step 2A, Prong 2

Having determined that claim 1 *recites* a recognized abstract idea, we now turn to whether claim 1 *is directed to* that abstract idea, or instead integrates the judicial exception into a practical application.

Appellant contends:

The Office Action inappropriately trivializes Appellant’s claimed method by choosing to describe the

claimed methods while neglecting to include all aspects of the method in the description.

...

The Office Action sets forth simply inserting a second advertisement into a first advertisement and providing the combined advertisement. Lost are the requirements that the first advertisement comprise message copy and a message copy timeline, that the second advertisement comprise a message track and that the second advertisement be inserted into the first advertisement timeline [at] or after the expression of a portion of the fi[r]st advertisement message copy relevant to the second advertisement message track. ***Each of the aforementioned items comprises significantly more than an abstraction*** and renders the claim patentable as a tangible method.

Appeal Br. 3–4 (emphasis added).

Appellant’s argument is not persuasive. We disagree with Appellant’s contention that the aforementioned items are significantly more than an abstraction.⁶ Contrary to Appellant’s position, Appellant’s aforementioned items are instead merely details of the abstraction itself. These items set forth the informational content and informational relationship of the advertising. For example, we determine that Appellant’s “wherein” clause does not set forth an additional element, but rather sets forth a part of the abstract idea of inserting a first advertisement into a second advertisement.

⁶ To the extent that the Examiner goes through extra steps to analyze the aforementioned elements as additional elements beyond the abstract idea, that analysis is unnecessary.

The “wherein” clause merely states the abstract informational relationship of the first and second advertisements.

We determine under prong 2 that claim 1 contains no additional elements beyond the abstract idea. Therefore, when the claim is evaluated as a whole, the claim contains nothing that could integrate the judicial exception into a practical application of that exception.

We conclude that claim 1 does not integrate the judicial exception into a practical application. We determine claim 1 does not recite:

- (i) an improvement to the functioning of a computer;
- (ii) an improvement to another technology or technical field;
- (iii) an application of the abstract idea with, or by use of, a particular machine;
- (iv) a transformation or reduction of a particular article to a different state or thing; or
- (v) other meaningful limitations beyond generally linking the use of the abstract idea to a particular technological environment.

See MPEP §§ 2106.05(a)–(c), (e)–(h). We determine that claim 1 is ***directed to*** a judicial exception, and does not integrate the judicial exception into a practical application.

D.3. 2019 Memorandum Step 2B

Appellant contends:

The Office Action also ***fails to provide any reference*** supporting the contention that the precise insertion of the second advertisement into the first based upon a relation

in content between the first message copy and second message track *is in any way conventional or well known*.

Appeal Br. 4 (emphasis added).

Appellant's argument is not persuasive. The "well-understood, routine, conventional" analysis is required to evaluate whether the additional elements beyond the abstract idea are such that individually or in combination (the claim as a whole) they provide an inventive concept. As discussed *supra*, we determine under prong 2 that claim 1 contains no additional elements beyond the abstract idea. Therefore, as there are *no* additional elements, *no* reference is required to show they are well-understood, routine, or conventional.

We determine that beyond the abstract idea, the claims do not recite:

- (vi) a specific limitation other than what is well-understood, routine, conventional activity in the field or unconventional steps that confine the claim to a particular useful application.

See MPEP § 2106.05(d).

E. § 112(a)

E. 1.

An original claim may lack written description support when (1) the claim defines the invention in functional language specifying a desired result but the disclosure fails to sufficiently identify how the function is performed or the result is achieved or (2) a broad genus claim is presented but the disclosure only describes a narrow species with no evidence that the genus is contemplated. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1349-50 (Fed. Cir. 2010) (en banc).

MPEP § 2163.03 V.

E. 2.

The Examiner rejects claim 1 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement.

[C]laim[1] recite[s] “wherein the second advertisement is inserted into the first advertisement message copy timeline as or after the expression of a portion of the first advertisement message copy **relevant to the second message track.**” Generic claim language in the original disclosure does not satisfy the written description requirement if it fails to support the scope of the genus claimed. The specification only recited an *ipsis verbis* of the claim language, but gives no description of how this would be carried out.

Final Act. 2–3.

E. 3

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 112(a).

Page 2, line 4, page 5, line 10 [of the Specification] disclose in detail how the message copy of the first advertisement and the message track of the second advertisement may each be characterized such that the second advertisement may be inserted into the first advertisement at a point as or after a portion of the first advertisement message copy relevant to the message track of the second advertisement. *The act of inserting one set of graphic elements into another set of graphic elements is well known and needs no further disclosure* that to provide that conventional editing software may be used to accomplish the task. *The method relates to determining when to insert* the second advertisement and subsequently doing so, *not to a new editing process.*

Appeal Br. 2–3 (emphasis added).

Appellant’s argument is not persuasive because Appellant does not address the rejection made by the Examiner. Appellant’s argument only

addresses generic inserting, not the specific inserting, as claimed and rejected. The Examiner's rejection highlights concern with the specific claim requirement of "relevant to the second track" as a precondition for the inserting. We agree with the Examiner that the Specification "gives no description of how this would be carried out." Final Act. 3.

F. § 103

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103.

A rejection under 35 USC §103 requires that the cited combination of references disclose each limitation of the invention as set forth in the claims. In the instant case, the cited combination of references fails to disclose the claimed limitation that the second advertisement is inserted into the first advertisement message copy timeline as or after the expression of a portion of the first advertisement message copy relevant to the second advertisement message track.

Appellant defines [Spec. 5] message track as: the theme, or summary, of the overall message which the advertiser seeks to convey using the message-copy. None of the portions of the cited references relates the insertion of the second advertisement into the first advertisement as or after first advertisement message copy relevant to the second advertisement message track. ***Theme, summary and overall theme of the second advertisement are not consideration of the methods of the cited references.***

Appeal Br. 4–5 (emphasis added).

Appellant's arguments are not persuasive because Briggs at column 1, lines 49–66, and column 4, lines 6–20, teaches that theme is a consideration of the method of Briggs. Briggs uses a cue point in a first content to request a specific second content (a specific advertisement) from storage. We deem the cue point name to be a theme as the message track is defined by

Appellant. Cue point names include examples such as “soda can” or “pizza box,” which are part of the request and describe the theme of the ad to be inserted. Further, the stored advertisement includes its cue point name in its stored metadata.

We determine that nothing more is required by claim 1 than what is taught by Briggs.

CONCLUSION

The Examiner has not erred in rejecting claims 1–7 under 35 U.S.C. § 101 as being directed to patent ineligible subject matter.

The Examiner has not erred in rejecting claims 1 and 2 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement.⁷

The Examiner has not erred in rejecting claims 1–7 as being unpatentable under 35 U.S.C. § 103.

The Examiner’s rejections of claims 1–7 as being unpatentable under 35 U.S.C. § 101 is **affirmed**.

The Examiner’s rejections of claims 1 and 2 as being unpatentable under 35 U.S.C. § 112(a) is **affirmed**.

The Examiner’s rejections of claims 1–7 as being unpatentable under 35 U.S.C. § 103 is **affirmed**.

⁷ Although the Examiner’s 35 U.S.C. § 112(a) rejection of claim 1 is equally applicable to all its dependent claims, we do not extend the Examiner’s § 112(a) rejection to claims 3–7 (in a new ground of rejection) because we affirm the § 101 and § 103 rejections herein.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-7	101	Eligibility	1-7	
1, 2	112(a)	Written Description	1, 2	
1-7	103	Billmaier, Briggs	1-7	
Overall Outcome			1-7	

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

BAUMEISTER, *Administrative Patent Judge*, Concurring.

I agree with the Majority's determinations and reasoning relating to the affirmances of the rejections under 35 U.S.C. §§ 101 and 103. The propriety of the Examiner's written-description rejection under § 112(a), though, is dubious. If the claims are to be rejected under § 112 at all, it might be more appropriate to reject the claims under § 112(b) as indefinite because I question whether it is reasonably clear what it means for the portions to the first advertisement message copy to be "relevant to the second advertisement message track." But I will not reach this further issue because the examiner did not issue an indefiniteness rejection, and it is sufficient that the Panel sustains the other two rejections. *See Ex Parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (explaining that the Board reviews the appealed rejections for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon); *see also Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984) (indicating an agency (e.g., the ITC) can decide a single dispositive issue of numerous issues resolved by the presiding officer and that there is no need for the Commission to decide all issues decided by the presiding officer).