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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ADRIAN DUMITRU CORDUNEANU,
EYAL MANOR, SCOTT SPENCER, and JOERG HEILIG

Appeal 2019-001651
Application 12/507,674
Technology Center 3600

Before ALLEN R. MacDONALD, CAROLYN D. THOMAS, and
BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–4, 6, 8, 11–17, and 22–25, which constitute all of the pending claims.¹ Appeal Br. 4. These claims stand rejected under 35 U.S.C. § 101 as being directed to a judicial exception to patent-eligible subject matter (an abstract idea) without significantly more. Final Action mailed January 9, 2018 (“Final Act.”), at 2–9. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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 Google, LLC. Appeal Brief filed July 5, 2018 (“Appeal Br.”), 1.

STANDARD OF REVIEW

The Board conducts a limited *de novo* review of 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).

CLAIMED SUBJECT MATTER

Appellant describes the present invention as follows:

Methods, systems, and apparatuses to match content providers and interested content users are described. Input indicating an accessing of a network location by a user is received along with the user's identifier. The identifier is obfuscated and transmitted to a content provider configured to provide content to the user at the network location. A re-direct identifier is transmitted to the user instructing the user to directly contact the content provider. When the user contacts the content provider, the user transmits a provider-specific identifier by which the content provider identifies the user and the obfuscated user identifier. The content provider updates a database of obfuscated user identifiers and provider-specific user identifiers based on the received identifiers. Thus, the content provider is enabled to identify interested users based on obfuscated and provider-specific user identifiers.

Abstract.

Independent claim 1 illustrates the subject matter of the appealed claims:

1. A method, performed by one or more computers, the method comprising:

receiving, by one or more computers, from a content provider, a network identifier that identifies the content provider;

generating, based on the network identifier received from the content provider, traffic detecting code;

providing the traffic detecting code to the content provider, wherein the content provider includes the traffic detecting code in a particular web page of a content publisher, and wherein the traffic detecting code causes a device that accesses the particular web page to transmit a user identifier of the user and the network identifier of the content provider to the one or more computers;

determining, by the one or more computers, that the device of the user is accessing the particular web page that includes the traffic detecting code based on the user identifier of the user and the network identifier of the content provider being generated by the traffic detecting code;

determining, by the one or more computers, that the content provider is associated with the traffic detecting code based on the network identifier of the content provider being generated by the traffic detecting code,

obfuscating, by the one or more computers, the user identifier received from the device of the user to generate an obfuscated user identifier, and

transmitting, by the one or more computers, to the content provider identified by the network identifier of the content provider received from the device of the user, the obfuscated user identifier rather than an identity of the user to request for content to be provided to the user;

matching, by the one or more computers and in a match table, the obfuscated user identifier to a provider-specific identifier different from the obfuscated user identifier;

receiving, from the content provider based on the obfuscated user identifier, an intent to provide content to the user; and

generating and transmitting, by the one or more computers and to the device of the user in response to receiving the intent to provide the content to the user from the content provider, a redirect instruction that causes the device of the user to (i) contact the content provider for the content and (ii) transmit to the content provider the provider-specific identifier different from

the obfuscated user identifier based on the match between the obfuscated user identifier and the provider-specific identifier in the match table.

PRINCIPLES OF LAW

A. SECTION 101

Inventions for a “new and useful process, machine, manufacture, or composition of matter” generally constitute patent-eligible subject 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. *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-step framework, described in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), and *Alice*. *Alice*, 573 U.S. at 217–18 (citing *Mayo*, 566 U.S. at 75–77). 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 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.* at 191 (citing *Benson* and *Flook*); *see also, 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 (internal 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 SECTION 101 GUIDANCE

In January 2019, the U.S. Patent and Trademark Office (“USPTO”) published revised guidance on the application of 35 U.S.C. § 101. *See* 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“2019 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) (“October 2019 Guidance Update”); *see also* October 2019 Patent Eligibility Guidance Update, 84 Fed. Reg. 55942 (Oct. 18, 2019) (notifying the public of the availability of the October 2019 Guidance Update). “All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.” 2019 Guidance, 84 Fed. Reg. at 51; *see also* October 2019 Guidance Update at 1. The Manual of Patent Examining Procedure (“MPEP”) now incorporates this revised guidance and subsequent updates at Section 2106 (9th ed. Rev. 10.2019, rev. June 2020).²

Under MPEP § 2106, we first look to whether the claim recites the following:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing

² All references to the MPEP are to the Ninth Edition, Revision 10.2019 (Last Revised June 2020), unless otherwise indicated.

human activities such as a fundamental economic practice, or mental processes); and

(2) additional elements that integrate the judicial exception into a practical application.³

MPEP §§ 2106.04(a), (d).

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, [and] conventional activity” in the field; 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.

MPEP § 2106.05(d).

ANALYSIS

The Examiner determines, “the independent claims . . . are directed, in part, to matching content providers with interested content users to send content without knowing the specific identi[t]y of the user.” Final Act. 2. The Examiner reasons that “[t]hese claim elements are considered to be abstract ideas because they are similar to ‘tailoring content based on

³ “Examiners evaluate integration into a practical application 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.” MPEP § 2106.04(d)II.

information about the user.” *Id.* (citing *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363 (Fed. Cir. 2015)).

The Examiner does not explain which groupings of abstract ideas under the 2019 Guidance the claims purportedly recite.⁴ But we understand that the purported abstract idea, as the Examiner characterizes it, would fall within the 2019 Guidance’s grouping of certain methods of organizing human activity, and more particularly, the sub-grouping of managing personal interactions between people. MPEP § 2106.04(a)(2)II.

The also Examiner determines that the additional elements of claim, including “one or more computers,” a “user’s device,” “the receipt and transmission of data among computers,” and “traffic detecting code” constitute mere generic recitations of technical elements—not any specific improvements of the additional elements. Final Act. 3. The Examiner further determines that the claims do not recite significantly more than the abstract idea because the additional elements merely perform well-understood, routine, and conventional computing functions. *Id.*

The Examiner additionally determines that while the claims describe the recited traffic detecting code element as something that is invoked by the user’s device, the claims do not affirmatively recite this process. Final Act. 3. According to the Examiner, the claims, instead, are directed to a procedure that occurs as a consequence of the reading of the source code of the web page that was provided to the content provider. *Id.*

Appellant argues, “the computer capabilities are improved by enhancing user privacy by changing the way information is shared among

⁴ The Final Rejection and Examiner’s Answer mailed in 2018, prior to the issuance of the 2019 Guidance.

the computers to address a problem that arises in the software arts.” Appeal Br. 6. According to Appellant,

[the claimed invention] specifically enables the computer allow “only [an] obfuscated user identifier to be transmitted to the content provider,” such that “the content provider . . . does not receive private information about the true identity of the user,” while “the content provider . . . is [still] equipped to identify the user . . . in a subsequent transaction . . .” This provides the advantage of protecting user privacy, while still enabling content providers to recognize the same user over multiple interactions and/or transactions.

Id. (citing Spec. ¶ 33).

[I]t is the ordered combination of specific operations, and the non-conventional way in which the various computers communicate that “improves the existing technological process” of protecting user privacy in the context of online content distribution, which is “unlike cases such as *Alice* where a computer was merely used as a tool to perform an existing process.”

Appeal Br. 7.

Appellant’s arguments are persuasive. The present claims go beyond merely “tailoring content based on information about the user,” as was the case in *Intellectual Properties v. Capital One Bank*. As even the Examiner notes, the claims require “send[ing] content without knowing the specific identi[t]y of the user.” Final Act. 2.

Our reviewing court has explained that to provide sufficient articulated reasoning as to why a claim is directed to an abstract idea or other patent-ineligible concept (e.g., a law of nature), an Examiner must adequately address both (a) what the character of the claim as a whole is directed to, and (b) whether that something is an abstract idea or a patent-

ineligible concept. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016).

To be sure, the Examiner determines that all of the claimed computer components, individually, constitute additional elements that are merely recited generically. Final Act. 3–4; Examiner’s Answer mailed Oct. 30, 2018, at 3–6. But this determination does not sufficiently address the claim limitations as an ordered combination. That is, the Examiner does not sufficiently explain whether, much less provide sufficient articulated reasoning for why, the process of obfuscating the user identifier to be transmitted to the content provider, such that the content provider does not receive private information about the true identity of the user, while the content provider is still equipped to identify the user in a subsequent transaction, as claimed, constitutes an abstract idea.

By oversimplifying the claims, the Examiner fails to provide sufficient articulated reasoning (i.e., notice) to Appellant of the Examiner’s determination of what the character of claim 1 as a whole is directed to. Such an oversimplified claim analysis, at best, may show that the claim involves an abstract idea, but cannot show the character of the claim as a whole is directed to an abstract idea. As such, the Examiner has not established pursuant to step 2A, prong 1, of the 2019 Guidance what abstract ideas are recited in the claims. Nor has the Examiner established pursuant to step 2A, prong 2, of the 2019 Guidance why the claims fail to integrate the abstract ideas into a practical application. Because the Patent Trial and Appeals Board is a body of appellate review, we decline to perform such an analysis *de novo*.

We, therefore, reverse the Examiner's rejection of claims 1–4, 6, 8, 11–17, and 22–25 under 35 U.S.C. § 101 as being directed to a judicial exception to patent-eligible subject matter.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1–4, 6, 8, 11–17, 22–25	101	Eligibility		1–4, 6, 8, 11–17, 22–25

REVERSED