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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GABRIELE ELIA, MARCO MARCHETTI, and
GIOVANNI MARTINI

Appeal 2019-002541
Application 14/651,163
Technology Center 3600

Before CARL W. WHITEHEAD JR., DAVID M. KOHUT, and
IRVIN E. BRANCH, *Administrative Patent Judges*.

BRANCH, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use “Appellant” to reference the “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as “Telecom Italia S.p.A.” Appeal Br. 3.

STATEMENT OF THE CASE

Appellant's Invention

Appellant's invention "relates to a method and system for providing advertisement to a user of a communication network." Spec. ¶ 1. Claim 1, reproduced below with emphasis, is illustrative of argued subject matter.

1. A method comprising:

storing, ***at an advertisement database***, an association between an identifier of a first user ***of a first user device of a communication network*** and at least one visual advertisement associated with the first user;

receiving, from a second user ***of a second user device of the communication network***, a selection of at least one visual advertisement associated with the second user;

storing, ***at the advertisement database***, an association between an identifier of the second user ***of the second user device of the communication network*** and the at least one visual advertisement associated with the second user, ***wherein the advertisement database is located remotely from the first user device and the second user device***;

setting up a communication session ***in the communication network*** between ***the first user device of*** the first user and ***the second user device of*** the second user;

using, ***by an advertisement manager computing device***, the identifier of the second user for retrieving, ***from the advertisement database***, a visual advertisement selected from amongst the at least one visual advertisement associated with the second user, ***wherein the advertisement manager computing device is located remotely from the first user device and the second user device***; and

transmitting, ***from the advertisement manager computing device and to the first user device of the first user***, the selected visual advertisement, ***wherein the selected visual***

advertisement is configured to be displayed on a display of the first user device.

Appeal Br. 19 (Claims Appendix).

Rejections

Claims 1–20 stand rejected under 35 U.S.C. § 101 as being directed to a judicial exception of § 101 without significantly more. Final Act. 3–6.

Claims 1–20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in scope. Final Act. 2.

Claims 1, 2 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Patwa (US 2012/0054039 A1; Mar. 1, 2012) and Hwang (US 2012/0232975 A1; Sept. 13, 2012). Final Act. 6–15.

Claims 3 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Patwa, Hwang, and Lim (US 2010/0088246 A1; Apr. 8, 2010). Final Act. 15–17.

Claims 4–10, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Patwa, Hwang, Lim, and Purvy (US 2011/0258025 A1; Oct. 20, 2011). Final Act. 18–23.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Patwa, Hwang, Lim, Purvy, and Ellis (US 2002/0042921 A1; Apr. 11, 2002). Final Act. 24–25.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Patwa, Hwang, and McCollom (US 6,343,274 B1; Jan. 29, 2002). Final Act. 25–26.

Claims 16–18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Patwa, Hwang, and Flickinger (US 2002/0083441 A1; June 27, 2002). Final Act. 26–28.

Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Patwa, Hwang, and Zakas (US 2011/0016023 A1; Jan. 20, 2011). Final Act. 29–31.

35 U.S.C. § 101

For the rejection of claims 1–20 under § 101, Appellant addresses the claims as two groups: independent claims 1 and 15; and dependent claims 2–14 and 16–20. *See, e.g.*, Appeal Br. 6–11 (heading), 11 (heading). We select claims 1 and 16 as representative claims of their respective groups. *See* 37 C.F.R. § 41.37(c)(1)(iv). For the below reasons, we are unpersuaded of error in the rejections of claims 1 and 16. We accordingly do not sustain the § 101 rejection of claims 1–20.

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.*

PTO Guidance

The PTO provides guidance for 35 U.S.C. § 101. USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”). 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 activity such as a fundamental economic practice, and 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.

Analysis for Independent Claims: Representative Claim 1

Step 1: Does Claim 1 Fall within a Statutory Category?

There is no dispute that the claimed subject matter falls within a § 101 category of patentable subject matter. *See* Guidance, 84 Fed. Reg. at 53–54 (“Step 1”).

Step 2A(1):² Does Claim 1 Recite Any Judicial Exceptions?

We agree with the Examiner’s determination that claim 1 recites judicial exceptions. *See* October 2019 Patent Eligibility Guidance

² The Guidance separates the enumerated issues (1) to (4) (*see supra* 6–7) 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]

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Update (“Guidance Update”) at 1 (meaning of “describe”), *available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf*; *see also* 84 Fed. Reg. 55942 (Oct. 18, 2019) (notifying the public of the Guidance Update). Specifically, we agree claim 1 encompasses the “abstract idea of providing information to a person based on what is known about her, which is similar to the concept identified as abstract by the court in *Affinity Labs of Texas LLC v. Amazon.com, Inc.*, 838 F.3d 1266, 1270 . . . (Fed. Cir 2016).” Final Act. 3.

We add the Examiner’s cite to *Affinity Labs* reflects that claim 1 encompasses targeted “advertising, marketing[, and] sales activities” and thus “commercial . . . interactions” identified by the Guidance’s judicial-exception category of “(b) Certain methods of organizing human activity.”³ Guidance, 84 Fed. Reg. at 52. *Affinity Labs* holds that “the concept of delivering user-selected media content to portable devices is an abstract idea” because “tailoring [] content based on information about the user . . . [, e.g.,] providing different newspaper inserts for different neighborhoods” is an abstract idea. 838 F.3d at 1269, 1271 (addressing *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363 (Fed. Cir. 2015)); *see also Capital One Bank*, 792 F.3d at 1369–70 (abstract

84 Fed. Reg. at 51 (referencing, via the omitted footnote, “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/memo-berkheimer-20180419.PDF>*[. . . ‘USPTO *Berkheimer* Memorandum’].”).

³ The Guidance was published on January 7, 2019, and thus unavailable to the Examiner while preparing the Answer (mailed December 13, 2018).

idea of tailoring advertisements to a person's demographics and current activity).

We also add that claim 1 encompasses a process of facilitating communication ("communication session") from a person ("first user") to a business ("second user") and then selectively providing an advertisement of the business to that person based on the person's presumed desire (e.g., need, preference, etc.) for a product of the business. *See, e.g.*, Spec. ¶¶ 2, 5–7, 51, 64. This process is encompassed by the claimed activities of:

receiving, from a second user . . . , a selection of at least one visual advertisement associated with the second user;

storing . . . an association between an identifier of the second user . . . and the at least one visual advertisement associated with the second user . . . ;

setting up a communication session . . . between . . . the first user and . . . the second user;

using . . . the identifier of the second user for retrieving . . . a visual advertisement selected from amongst the at least one visual advertisement associated with the second user . . . ; and

transmitting, . . . to . . . the first user, the selected visual advertisement[.]

The *receiving* reads on a marketing service (or the like) receiving advertisements from respective clients. The *storing* reads on the service maintaining a record of the advertisement/s submitted by each client. The *setting up* reads on the service directing a communication from a person to a client. The *using* reads on the service identifying that client and respective advertisement/s. The *transmitting* reads on the service providing the advertisement/s to the above person.

We further add that the claimed “storing . . . an association between an identifier of a first user . . . and at least one visual advertisement associated with the first user” (not part of above block quote) also encompasses targeted “advertising, marketing or sales activit[y] or behavior[.]” (Guidance, 84 Fed. Reg. at 52). In regards to the above exemplary process, the *storing* reads on the service determining (and thus storing) demographic information shared by the person and submitted advertisements—e. g., to further determine, per the person’s accordingly presumed preferences, a ‘best fit’ of multiple advertisements submitted by the client. *See, e.g.*, Spec. ¶ 41 (determining a person’s preferences for this purpose).

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

We agree with the Examiner’s determination that the claimed additional elements do not integrate the claimed judicial exceptions (i.e., claim 1’s judicially-expected activities identified above) 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]”); *id.* at 55 (“exemplary considerations . . . indicative [of] a practical application”). Specifically, we agree the emphasized limitations of reproduced claim 1 (*supra* 2–3) are “recited at a high degree of generality” and “only perform generic computer functions of manipulating information and sharing information.” Final Act. 4; *see also generally id.* at 3–5; Ans. 4–5.

We also agree with the Examiner's specific characterizations of the claimed additional elements. *See* Final Act. 3–4; Ans. 4–5.

As the Examiner finds, the operations of the additional elements are nondescriptly recited. The storing of device identifiers, advertisements, and associations “can be performed . . . by pencil-and-paper means” (Final Act. 3). Transmitting of something for display on a device, e.g., “advertisement is configured to be displayed” thereon, is a generic transmission and display of information. Final Act. 3; Ans. 4.

As the Examiner further finds, the operations and capabilities of the additional elements are ubiquitous. “That a database on a server is remote from a user is a ubiquitous feature of Internet access.” Ans. 5. “[T]he fact that multiple users can communicate information to each other by employing servers is . . . ubiquitous.” Final Act. 31. “[A] server communicating with user devices was . . . ubiquitous.” *Id.* at 4. “[F]ormatting [transmissions] so that they can be displayed on user devices was . . . ubiquitous.” *Id.* at 5. “Setting up a communication between two . . . devices requires nothing more than use of long known, ubiquitous computer technologies.” *Id.*

We add that MPEP § 2106.05(a)–(c) and (e)–(h) support the Examiner's determination that the claimed additional elements do not confer a practical application. *See* Guidance 84 Fed. Reg. at 55, nn.25, 27–32 (citing these MPEP sections).

MPEP § 2106.05(a) concerns “Improvements to the Functioning of a Computer or To Any Other Technology or Technical Field.” MPEP at 2100-50. Specifically, it concerns “whether the claim purports to improve computer capabilities or, instead, invokes computers merely as a tool.” *Id.* at 2100-51–52. There is no indication the claimed invention improves a

technology. The claimed computer technology merely, and only in a ubiquitous manner, allocates the judicially-expected activities (*supra* 8–9) to client devices, a server, and database. In the above exemplary process, the “user devices” are merely client devices of a person and business that communicate with each other and thereby activate the service of selectively providing the person an advertisement of the business. The claimed “advertisement manager computing device” is a server providing the above service. The claimed “advertisement database” is the server’s database that stores, organizes, and accesses the needed information.

MPEP § 2106.05(b) and (c) respectively concern use of a “Particular Machine” and “Particular Transformation.” MPEP at 2100-54, 56 (transformation must be “of an article”). Claim 1 does not recite a particular machine; the hardware is generic (e.g., “user devices”). Nor does claim 1 recite a particular transformation.

MPEP § 2106.05(e) concerns “Other Meaningful Limitations.” MPEP at 2100 62. Specifically, it concerns whether the claim “limitations [go] beyond generally linking the use of the judicial exception to a particular technological environment.” *Id.* It also describes, as an example of limitations falling short of this threshold, a “data processing system and communications controllers . . . [that] merely linked the use of the abstract idea to a particular technological environment[,] i.e., ‘implementation via computers’[.]” *Id.* (quoting *Alice*, 573 U.S. at 226). For the reasons discussed with respect to MPEP § 2106.05(a), the additional elements merely link the recited judicial exceptions to data processing and communication.

MPEP § 2106.05(f) concerns “Mere Instructions To Apply An Exception.” MPEP at 2100-63. Specifically, it concerns the “particularity or generality of the application of the judicial exception.” *Id.* at 2100-66–67. It explains that “generically recit[ing] an effect of the judicial exception[,] or claim[ing] every mode of accomplishing that effect, amounts to . . . merely adding the words ‘apply it’ to the judicial exception.” *Id.* at 2100-66. Because claim 1 only recites judicial exceptions (*supra* 8–10) and generic computer elements (“user devices,” a “computing device,” and a “database”) performing their generic functions in a generic architecture (*supra* 12) to achieve those activities, claim 1 constitutes a mere instruction to apply judicial exceptions.

MPEP § 2106.05(g) concerns “Insignificant Extra Solution Activity.” MPEP at 2100-67–69. Specifically, it concerns whether “the additional elements add more than . . . activities incidental to the primary process or product.” *Id.* at 2100-67. “[L]imitations . . . recite only insignificant extra-solution activity . . . [if] unrelated to how the solution is achieved.” *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1311 (Fed. Cir. 2016). Such limitations include mere “natural consequence[s] of carrying out the abstract idea in a computing environment.” *Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1329 (Fed. Cir. 2017) (cited by MPEP § 2106.05(g) at 2100-68). Claim 1’s additional elements are merely incidental, natural consequences of the claimed object and solution—i.e., of selectively providing an advertisement for someone (object) based on their communicating with a second person, business, etc. (solution). For example, the claimed “visual advertisement . . . configured to be displayed on a display of the first user device” is an

incidental, natural consequence of displaying the advertisement. *See* MPEP at 2100-67 (insignificant “post-solution activity”), 69 (“printing or downloading”). Similarly, the claimed receiving and storing data is an incidental, natural consequence of gathering information from the first and second users. *See id.* (insignificant “pre-solution activity”), 68 (“mere data gathering”).

MPEP § 2106.05(h) concerns “Field of Use and Technological Environment.” MPEP at 2100-69. Specifically, it concerns whether an industry-specific claim limitation “simply . . . acquiesce[s] to limiting the reach of the patent” by reciting a field of use or technological environment. *Id.* It identifies, as an example, limitations that do “not alter or affect how the process steps . . . were performed.” *Id.* at 2100-70. There is no indication that claim 1’s industry specific limitations—e.g., a “visual advertisement” and “advertisement database”—alter how the claim steps are performed.

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

Step 2B: Does Claim 1 Recite Anything That Is Beyond the Recited Judicial Exceptions and Not a Well-Understood, Routine, Conventional (“WURC”) Activity?

We agree with the Examiner’s determination that all claim features, i.e., all limitations alone and in combination, constitute either one of the recited judicial exceptions or WURC activity. 84 Fed. Reg. at 56. Specifically, we agree the claimed uses of computer technology are “ubiquitous” and thus WURC activity. *See generally* Ans. 4–6; Final Act. 3–5, 31–33; *see also supra* 11 (listing the “ubiquitous” features).

We add a claim's additional elements do not confer "significantly more" to an invention if merely: (i) adding the words "apply it" or an equivalent to an abstract idea (*Alice*, 573 U.S. at 221–23); (ii) instructing to implement an abstract idea on a computer (*id.* at 222–23); or (iii) requiring a generic computer to perform generic computer functions (*id.* at 225). Claim 1's additional elements entirely and squarely fall within these categories (i) and (iii) of WURC activity. *See e.g., Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1318 (Fed. Cir. 2016) ("The patent discloses only generic computers performing generic functions" and "thus confirms that the implementation of the abstract idea is routine and conventional."). The claimed storing requires only a generic "database" and its generic function of storing data elements (identifiers and advertisements) and associations. The claimed receiving requires only a generic "user device" communicating over a generic "network." The claimed "setting up" requires only a generic "communication session" established over the generic "network" and between the generic "user devices." The claimed "using" requires only a generic "computing device" using one of the data elements (identifier) to retrieve an associated data element (advertisement). The claimed transmitting requires only the generic "computing device" and its generic function of configuring and transmitting a retrieved data element (the advertisement) for display on a device (user device).

Claim 1 accordingly recites *only* judicial exceptions and generic computer components (user devices, a database, and computing device) performing their generic functions. As further discussed above, the judicially-expected activities and generic functions are performed in a

generic architecture and per a ubiquitous allocation of tasks to the client, server, and database. *See, e.g., supra* 12.

Appellant's Arguments

Our above determinations address most of Appellant's arguments. Only the arguments below require further discussion.

Appellant contends "the Office Action fails to provide any evidence that the features and steps recited in [claim 1] are well-understood, routine, and conventional as required in *Berkheimer*." Appeal Br. 8; *see also supra* n.2 (description of *Berkheimer* and the USPTO *Berkheimer* Memorandum). We are unpersuaded for each of two reasons.

First, we are unpersuaded in view of our analysis for Step 2B.

Second, Appellant recognizes the Examiner has taken official notice on this issue but does not traverse the official notice. *Id.* at 8–9. Specifically, Appellant characterizes the Examiner findings of WURC activity by quoting two findings; each stating that claimed computer technology was "not only routine and common but ubiquitous." *Id.* at 8 (quoting Final Act. 4, 5). Appellant then emphasizes that "[o]fficial notice 'should be used **only** when the examiner is certain, based upon his or her personal knowledge, that the additional element(s) represents WURC activity.'" *Id.* at 9 (quoting *Berkheimer* Memorandum at 4). The Examiner's use of "ubiquitous" specifies a certainty based upon personal knowledge. Or, in other words, it specifies "facts . . . of notorious character," which are facts appropriate for official notice. MPEP § 2144.03.E, *Reliance on Common Knowledge in the Art or "Well Known" Prior Art*, at 2100-240; *see also* *Berkheimer* Memorandum at 4 ("Procedures for taking official notice . . . are discussed in MPEP § 2144.03.").

Appellant also contends:

Similar to [*BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)], the features recited in claim 1 allow the system to uniquely customize advertisements for multiple users/user devices using both an advertisement manager computing device and an advertisement database that are located remotely from the user devices. . . . The selected visual advertisement transmitted to the first user device of the first user is customized for the first user by, for example, the selection of at least one visual advertisement received from the second user.

Appeal Br. 10. We are unpersuaded for each of two reasons.

First, the above-argued advantage—“uniquely customize advertisements . . . for the first user by . . . selection of at least one visual advertisement received from the second user” (*id.*)—arises entirely from claim 1’s judicially-excepted activities. *See SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1163 (Fed. Cir. 2018) (“[An] advance [that] lies entirely in the realm of abstract ideas . . . is ineligible for patenting.”).

Second, claim 1’s additional elements describe only “generic computers . . . perform[ing] generic computer functions” and are accordingly “distinguishable from those in *BASCOM* . . . describing ‘how a particular arrangement of elements is a technical improvement[.]’” *Symantec Corp.*, 838 F.3d at 1315–16 (internal brackets omitted).

Appellant also contends:

[T]he examiner states “[t]he step of storing information in a database . . . requires no computers at all; the card catalogs once ubiquitously present in public libraries are databases, as is the telephone directory and a dictionary.” Answer, p. 4. This is an unreasonable interpretation of the term “advertisement database” and apparently an attempt to characterize the claims as mere mental processes.

Reply Br. 3. We are unpersuaded because the Examiner is not characterizing claim 1 or its storing steps as mere mental processes. Ans. 4. The Examiner is rather emphasizing that, but for the recitation of a generic database, claim 1’s storing steps would not distinguish over even pre-computer means of recording such information. *Id.*; *see also, e.g.*, Ans. 6 (“not in any way technical”).

Analysis for Dependent Claims—Representative Claim 16

Appellant contends dependent claim 16 results in “a technical advantage that improve[s] upon prior systems,” such as in *McRO Inc. v. Bandai Namco Games America*, 837 F.3d 1299 (Fed. Cir. 2016).

Appeal Br. 12–13. Specifically, Appellant contends:

Similar to *McRO*, [t]he features recited in claim 16 result in a technical advantage that improve upon prior systems. . . . For example . . . , transmitting the selected advertisement “via a different communication channel from the communication session” allows more processing resources and communication bandwidth to be allocated to the communication session in the communication network between the first user device and the second user device.

These unique technical advantages are further described throughout the specification, such as at paragraphs [0066] and [0067] of the substitute specification filed June 10, 2015.

Id.

We are unpersuaded because Appellant does not show the argued technical advantage—use of different communication channels for a communication session and advertisement—is claimed specifically enough to prevent preemption of the claimed judicial exceptions. As explained in *McRO*, a technical feature confers patent-eligibility *if specific enough* to prevent preemption of the recited abstract idea. *See, e.g.*, 837 F.3d at 1314

(“The preemption concern arises when the claims are not directed to a specific invention[.] . . . We therefore look to whether the claims in these patents focus on a specific means or method that improves the relevant technology.”); *see also DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1259 (Fed. Cir. 2014) (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, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016) (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)); *BASCOM*, 827 F.3d at 1352 (The claims “do not preempt . . . filtering content,” but rather “carve out a specific location for the filtering system (a remote ISP server).”).

Appellant also contends the Examiner unreasonably interprets claim 16’s features as mental processes. Reply Br. 6–7. We are unpersuaded because the Examiner is rather emphasizing that claim 16 does not describe the channels (aside from them respectively carrying an advertisement and communication session). Ans. 7 (“non-specific use of communication techniques”).

With regard to all dependent claims, Appellant also contends: “[T]he Office Action fails to specifically address each feature of the dependent claims and fails to provide evidence that the features recited in the dependent claims are ‘well-understood, routine, and conventional to a skilled

artisan,’ as required by *Berkheimer*.” Appeal Br. 12. We are unpersuaded for each of two reasons.

First, we have selected claim 16 as representative and are not persuaded of error by the foregoing respective arguments.

Second, even assuming each dependent claim is separately argued by the above contention, the Examiner provides respective findings for the dependent claims and Appellant does not specify a failure of each finding to present *Berkheimer* evidence. For example, Appellant does not contest the Examiner’s finding that “[c]laims 3, 4, 14 and 20 consist entirely of nonfunctional printed matter” (Final Act. 5). It is Appellant’s burden to identify respective errors for separately argued claims. *See, e.g.*, 37 C.F.R. § 41.37(c)(1)(iv) (“[A]ny claim(s) argued separately . . . shall be argued under a separate subheading[.] A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”).

35 U.S.C. § 112, ¶ 2—INDEFINITENESS

We are persuaded of error in the § 112, ¶ 2, rejection of claim 15. We accordingly do not sustain the rejection.

The at-issue claim limitation recites: “upon setting up of the communication session, use the identifier of the second user for retrieving . . . a visual advertisement.” Final Act. 2; Ans. 5. The Examiner finds “upon setting up of the communication session” renders the limitation because claim 15 does not first recite the session as having begun. Ans. 3. Appellant contends the Examiner “fails to cite any authority for this assertion.” Appeal Br. 5.

We are persuaded of error because the Examiner does not explain why a claimed condition (“upon”) has an uncertain scope unless triggered by a prior recited step. *In re Miller*, 441 F.2d 689, 693 (CCPA 1971) (describing indefiniteness as an issue of whether “those skilled in the art will be . . . uncertain[of] what subject matter falls within the scope of the claims”). The lack of such explanation, e.g., by citation to case law, prevents a meaningful rebuttal by Appellant. *See, e.g., In re Packard*, 751 F.3d 1307, 1312 (Fed. Cir. 2014) (A *prima facie* case for indefiniteness constitutes an “obligation to explain adequately the shortcomings . . . so that the applicant is properly notified and able to respond.”).

35 U.S.C. § 103(a)

For the rejections under § 103(a), Appellant contests only the Examiner’s reliance on Patwa that extends to all claims, i.e., as applied to each of the independent claims (1 and 15). Appeal Br. 14–18. We select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv). We are unpersuaded of error in the § 103(a) rejection of claim 1 and accordingly sustain all § 103(a) rejections.

As discussed above, the claimed invention establishes the communication session between two users and then selects an advertisement: for the *first* user (transmitted to the first user); and, associated with the *second* user. These features are claimed as follows: “a first user device[;] receiving, from . . . a second user device . . . , a selection of at least one visual advertisement associated with the second user; . . . setting up a communication session . . . between the first user device . . . and the second user device[;] using . . . the identifier of the second user for retrieving . . . a visual advertisement selected from amongst the at least

one visual advertisement associated with the second user[; and] transmitting, . . . to the first user device . . . , the selected visual advertisement.”

Contesting the Examiner’s reliance on Patwa, Appellant contends: “[T]he cited portions of Patwa discuss deriving advertising targeting metrics relevant to *a user* based on images associated with *the [same] user* (Patwa ¶ [31]) and causing an advertisement to be displayed to *the [same] user* (Patwa ¶ [24]). Appeal Br. 15–16. The Examiner cites Hwang for the above feature. Final Act. 9–10. Appellant thus fails to identify an error.

We note the reliance on Hwang is reasonable. Hwang teaches a VOIP session between two users, an advertisement (e.g., coupon) pushed by the VOIP service to the a display of one user, and then sharing of the advertisement from that user (per an instruction to the VOIP service) to the other user (pushed by the VOIP service). Hwang ¶¶ 6, 15.

The combination of Patwa and Hwang is also reasonable. The Examiner finds Patwa teaches: a database storing user identifiers, advertisements, and associations therebetween; and pushing advertisements that are selected for the recipients based on the associations. Final Act. 7–9 (citing Patwa ¶¶ 21, 24–25, 28, 31). The combination of Patwa’s and Hwang’s above teachings results in a communication session (e.g., VOIP) that: has a database storing user identifiers, advertisements, and associations therebetween; uses the associations to select an advertisement for a session user (claimed “second user”); and, per an instruction of the above user, selects the same advertisement for the other user (claimed “first user”). Appellant does not show this combination is erred, e.g., fails to suggest the claimed “using . . . the identifier of the second user for retrieving . . . a visual

advertisement selected from amongst the at least one visual advertisement associated with the second user.”

OVERALL CONCLUSION

We affirm the Examiner’s decision to reject claims 1–20.⁴

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–20	101	Eligibility	1–20	
1–20	112, ¶ 2	Indefiniteness		1–20
1, 2, 15	103(a)	Patwa, Hwang	1, 2, 15	
3, 11	103(a)	Patwa, Hwang, Lim	3, 11	
4, 10, 12	103(a)	Patwa, Hwang, Lim, Purvy	4, 10, 12	
13	103(a)	Patwa, Hwang, Lim, Purvy, Ellis	13	
14	103(a)	Patwa, Hwang, McCollom	14	
16–18	103(a)	Patwa, Hwang, Flickinger	16–18	
19, 20	103(a)	Patwa, Hwang, Zakas	19, 20	
Overall Outcome			1–20	

⁴ “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.” 37 C.F.R. § 41.50.

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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