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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STÉPHANE MOREAU, ASHISH DUGGAL,
SACHIN SONI, and ANMOL DHAWAN

Appeal 2019-003268
Application 14/525,760
Technology Center 3600

Before ALLEN R. MacDONALD, JEREMY J. CURCURI, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

AHMED, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–9 and 11–20, which are all of the claims pending in the application. Claim 10 has been cancelled. Appeal Br. 27. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “Applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Adobe Systems Incorporated. Appeal Br. 3.

TECHNOLOGY

The claims relate to testing marketing campaign communications.

Claim 1 is illustrative and reproduced below:

1. A method for dynamically testing the effectiveness of Internet marketing communications comprising:

receiving, by a processing device, input identifying a category of an Internet marketing campaign to be initiated by a marketer;

in response to identifying the category of the Internet marketing campaign, receiving, by the processing device, input indicating a first marketing communication content and a second marketing communication content in relation to the category of the Internet marketing campaign, wherein the first marketing communication content and the second marketing communication content are to be sent to test recipients;

retrieving, by a processing device, from a database information identifying recipients of prior Internet marketing communications containing content associated with the category of the Internet marketing campaign from a database;

determining, by the processing device, a past responsiveness of each recipient to each prior Internet marketing communication by:

determining whether the recipient viewed the prior Internet marketing communication using a recipient device and, if so, the time between when the prior Internet marketing communication was sent and when the recipient viewed the prior Internet marketing communication,

determining whether the recipient responded to the prior Internet marketing communication using the recipient device and, if so, the time between when the prior Internet marketing communication was viewed and when the recipient responded to the prior Internet marketing communication,

determining whether the recipient shared the prior Internet marketing communication with other users using the

recipient device and, if so, the time between when the prior Internet marketing communication was sent and when the recipient shared the prior Internet marketing communication, and

determining whether the recipient did not view the prior Internet marketing communication and did not share the prior Internet marketing communication with other users using the recipient device;

selecting, by the processing device, a set of test recipients by identifying those of the recipients who viewed or shared at least a predetermined number of the prior Internet marketing communications in less than a threshold response time;

in response to selecting the set of test recipients, creating, by the processing device, a first sub set of the test recipients and a second sub set of the test recipients;

in response to creating the first subset of the test recipients and the second subset of the test recipients, sending, by the processing device, the first marketing communication content to the first subset of the test recipients and sending, by the processing device, the second marketing communication content to the second subset of the test recipients; and

determining and assessing, by the processing device, responsiveness of the first subset of the test recipients to the first marketing communication content and determining and assessing responsiveness of the second subset of the test recipients to the second marketing communication content.

REJECTION

Claims 1–9 and 11–20 stand rejected under 35 U.S.C. § 101 for claiming patent-ineligible subject matter. Final Act. 2–3.

ISSUE

1. Did the Examiner err in concluding that claim 1 is directed to patent-ineligible subject matter without significantly more?

ANALYSIS

§ 101

35 U.S.C. § 101 defines patentable subject matter, but the Supreme Court has “long held that this provision contains an important implicit exception” that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012) (quotation omitted). “Eligibility under 35 U.S.C. § 101 is a question of law, based on underlying facts.” *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1166 (Fed. Cir. 2018). To determine patentable subject matter, the Supreme Court has set forth a two part test.

“First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts” of “laws of nature, natural phenomena, and abstract ideas.” *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014). A court must be cognizant that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas” (*Mayo*, 566 U.S. at 71), and “describing the claims at . . . a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016). Instead, “we evaluate the focus of the claimed advance over the prior art to determine if the character of the claim as a whole, considered in light of the specification, is directed to excluded subject matter.” *Trading Techs. Int’l, Inc. v. IBG LLC*, 921 F.3d 1084, 1092 (Fed. Cir. 2019) (quotation omitted). “The inquiry often is whether the claims are directed to ‘a specific means or method’ for improving technology or whether they are simply directed to an abstract

end-result.” *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1326 (Fed. Cir. 2017).

If the claims are directed to an abstract idea or other ineligible concept, then we continue to the second step and “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 79, 78). The Supreme Court has “described step two of this analysis as a search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself.” *Id.* at 217–18 (quotation omitted). However, “[t]he abstract idea itself cannot supply the inventive concept, no matter how groundbreaking the advance.” *Trading Techs.*, 921 F.3d at 1093 (quotation omitted).

In 2019, the U.S. Patent & Trademark Office published revised guidance on the application of § 101. USPTO, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”); USPTO, *October 2019 Update: Subject Matter Eligibility*, available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf (“Oct. Update”). Under that guidance, we look to whether the claim recites

- (1) a judicial exception, such as a law of nature or any of the following groupings of abstract ideas:
 - (a) mathematical concepts, such as mathematical formulas;
 - (b) certain methods of organizing human activity, such as a fundamental economic practice; or

- (c) mental processes, such as an observation or evaluation performed in the human mind;
- (2) any additional limitations such that the claim as a whole integrates the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)); and
- (3) any additional limitations beyond the judicial exception that, alone or in combination, were not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)).

See Guidance, 84 Fed. Reg. at 52, 55, 56.

USPTO Step 2A, Prong One

Here, claim 1 recites:

receiving . . . input identifying a category of an Internet marketing campaign to be initiated by a marketer;

in response to identifying the category of the Internet marketing campaign, receiving . . . input indicating a first marketing communication content and a second marketing communication content in relation to the category of the Internet marketing campaign, wherein the first marketing communication content and the second marketing communication content are to be sent to test recipients;

retrieving . . . from a database information identifying recipients of prior Internet marketing communications containing content associated with the category of the Internet marketing campaign from a database;

determining . . . a past responsiveness of each recipient to each prior Internet marketing communication by:

determining whether the recipient viewed the prior Internet marketing communication . . . and, if so, the time between when the prior Internet marketing communication was sent and when the recipient viewed the prior Internet marketing communication,

determining whether the recipient responded to the prior Internet marketing communication . . . and, if so, the time between when the prior Internet marketing communication was viewed and when the recipient responded to the prior Internet marketing communication,

determining whether the recipient shared the prior Internet marketing communication with other users . . . and, if so, the time between when the prior Internet marketing communication was sent and when the recipient shared the prior Internet marketing communication, and

determining whether the recipient did not view the prior Internet marketing communication and did not share the prior Internet marketing communication with other users . . . ;

selecting . . . a set of test recipients by identifying those of the recipients who viewed or shared at least a predetermined number of the prior Internet marketing communications in less than a threshold response time;

in response to selecting the set of test recipients, creating . . . a first sub set of the test recipients and a second sub set of the test recipients;

in response to creating the first subset of the test recipients and the second subset of the test recipients, sending . . . the first marketing communication content to the first subset of the test recipients and sending . . . the second marketing communication content to the second subset of the test recipients; and

determining and assessing . . . responsiveness of the first subset of the test recipients to the first marketing communication content and determining and assessing responsiveness of the second subset of the test recipients to the second marketing communication content.

“[W]ith the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper.” *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1318 (Fed. Cir. 2016). Here, other than the

generic computer components discussed below (specifically, the “processing device” and “recipient device”), the “identifying,” “determining,” and “selecting” steps can all be performed mentally. For example, before physically sending out invitations to a party, you might mentally, or with a pen and paper, determine who on your list did not respond to your previous invitation, who responded to your previous invitation and how soon, as well as who shared your invitation with one of their friends. You therefore have mentally divided a group into at least two subsets based on their response and whether they shared your invitation. Recipients that did not respond to your invitation may receive a more personal invitation this time, with a personalized sentence or two, while recipients that responded and shared your previous invitation may get the default invitation. *See also* Final Act. 3 (finding that “[d]etermining a past responsiveness of each recipient to each prior communication is performed by simply performing four similar comparisons which are elementary, abstract, and can be done by a person looking at a paper log of responses which includes time-stamps.”). The Examiner provided yet another example of the abstract idea being used in the real world:

For example, a particular issue of National Geographic magazine might include an advertisement with a blow-card which includes a return postcard for a person to express interest in a camera, and the return postcard includes a coded string of text which indicates to the advertiser which issue the ad appeared in. When a consumer returns the postcard, the coded string is sufficient to indicate to the advertiser when the issue was published, and the postmark on the postcard is sufficient to indicate to the advertiser when the advertisement solicited a response. . . . [or that] the magazine subscriber had simply handed the advertisement to a friend known to be a camera enthusiast, and the friend had returned the card, . . . [or compile] information about the

subscribers who did not respond. Further, certain types of mail sent to consumers is returned to sender if the mail is undeliverable, and receipt of such returned mail would certainly indicate that those consumers did not (because they could not have) viewed the magazine advertisement.

Id. at 3–5. Determining a past responsiveness of a recipient by performing simple comparisons has long been practiced in the real world. As the Federal Circuit has said, “analyzing information by steps people go through in their minds,” without more, constitutes “mental processes within the abstract-idea category.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146 (Fed. Cir. 2016) (quotation omitted).

Claim 1 therefore recites mental processes, which are an abstract idea.

Other than the generic computer components, the “receiving” and “sending” steps also can be performed by humans (e.g., verbally by talking or *via* physical methods of communication, e.g., through the mail). Claim 1 is specifically directed to “Internet marketing communications,” and recites sending marketing communication content to each subset of recipients. Claim 1 therefore recites a form of “advertising, marketing or sales activities or behaviors,” which falls within “certain methods of organizing human activity” that forms one grouping of abstract ideas. *Guidance*, 84 Fed. Reg. at 52; *cf. Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1344 (Fed. Cir. 2018) (holding that “the act of providing someone an additional set of information without disrupting the ongoing provision of an initial set of information is an abstract idea,” such as “the nontechnical human activity of passing a note to a person who is in the middle of a meeting or conversation”).

Moreover, “[a]dding one abstract idea . . . to another abstract idea . . . does not render the claim non-abstract.” *RecogniCorp*, 855 F.3d at 1327.

Accordingly, claim 1 recites an abstract idea.

USPTO Step 2A, Prong Two

Appellant asserts that “[t]he claims are directed to technical improvements to lead generation systems rather than an abstract idea.” Appeal Br. 10. According to Appellant, “[c]omputer-implemented systems for dynamically testing the effectiveness of Internet marketing communications are certainly technological systems, resulting from significant research and development efforts.” *Id.*; *see also id.* at 12–13 (citing *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349 (2016)). Appellant further argues that the Examiner’s abstract idea determination “disregards many specific elements of the claims.” *Id.* 10–11; Reply Br. 3–4 (pointing to the multiple “determining” steps recited in claim 1). “By intelligently selecting test recipient sets, the claimed invention can more accurately assess the merit of the different variants of marketing communication in a timely manner. Selecting the test recipient sets is intelligently performed by determining a past responsiveness of each recipient,” Appellant adds. Reply Br. 5. Therefore, Appellant argues, that “to the extent that the claims include an abstract idea, the pending claims integrate the abstract idea into a practical application of the exception and is patent eligible under the 2019 Guidance.” *Id.*

We are not persuaded by Appellant’s argument that the problem or solution is technological. The Federal Circuit is clear that “[t]he abstract idea itself cannot supply the inventive concept, no matter how groundbreaking the advance.” *Trading Techs. Int’l, Inc. v. IBG LLC*, 921 F.3d 1084, 1093 (Fed. Cir. 2019) (quotation omitted). As discussed above, other than the recited computer components of a “processing device” and

“recipient device,” the claim steps can be performed mentally or verbally. Thus, Appellant cannot rely on the abstract idea as providing significantly more.

Moreover, the Federal Circuit “look[s] 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.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016). Here, the computer components do not provide a specific means or method that improves technology. For example, claim 1 does not provide any *technological way* to determine “whether the recipient viewed the prior Internet marketing communication” or “whether the recipient shared the prior Internet marketing communication with other users.” Instead, the claim recites only an abstract idea that is to be performed “by” a processing device, and that the user uses a “recipient device.” As the Supreme Court has held, “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 573 U.S. at 223.

In the Reply Brief, Appellant further argues that “claim 1 applies the alleged abstract idea in a meaningful way that goes beyond generally linking the use of an abstract idea to a particular technological environment” because that “claim includes specific limitations other than what is well-understood, routine and conventional in the field and/or unconventional steps that confine the claims to a particular useful application.” Reply Br. 5. Specifically, Appellant relies on limitations of determining whether or not a recipient of Internet communication views, responds to, or shares that

communication to argue that “these determining steps are performed based on ‘redirection techniques’ and other known ‘monitoring techniques’ that track the interaction of the recipient with links embedded in the electronic communication.” Reply Br. 5; 3 (citing Spec. ¶ 32); Appeal Br. 12 (arguing that the term “Internet marketing communication” narrowly refers to “email communications, links embedded in text messages, [and] social media messages”). However, none of these are recited in claim 1 and “features that are not claimed are irrelevant as to step 1 or step 2 of the *Mayo/Alice* analysis.” *Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 939 F.3d 1355, 1363 (Fed. Cir. 2019). Moreover, all the “Internet marketing communication” restriction does is “confine the abstract idea to a particular technological environment,” and “merely limiting the field of use of the abstract idea to a particular existing technological environment does not render the claims any less abstract.” *See Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1258–59 (Fed. Cir. 2016); *see also Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1366 (Fed. Cir. 2015) (“An abstract idea does not become nonabstract by limiting the invention to a particular field of use or technological environment, such as the Internet.”).

Finally, to the extent sending and receiving were limited to an electronic communications between server and recipient devices (Reply Br. 5–6), rather than verbal or physical communication, those would be insignificant extra-solution activity or field of use, akin to merely automating a manual process. *See, e.g.*, MPEP § 2106.05(g), (h).

Thus, we are not persuaded that any additional limitation, alone or in combination, reflects an improvement in the functioning of a computer or other technology.

Appellant also argues that “the claims [do not] preempt all manners of performing lead generation on the Internet.” Appeal Br. 11. We agree with the Examiner, however, that preemption is not the test. Ans. 5. “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). “Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Id.* Therefore, claim 1 does not integrate the abstract idea into a practical application.

USPTO Step 2B

The additional limitations in claim 1 such as a “processing device” and “recipient device” were well-understood, routine, and conventional. The Specification explains that they can be any generic device. *E.g.*, Spec. ¶¶ 55 (“Any suitable computing system or group of computing systems can be used to implement the marketer system(s) 116, recipient device(s) 118, and server system 102. . . . The processor 902 may comprise a microprocessor, an application-specific integrated circuit (‘ASIC’), a state machine, or other processing device”), 56 (“The memory 904 can include any suitable computer-readable medium.”), 59 (“The network interface device 910 can include any device or group of devices suitable for establishing a wired or wireless data connection to one or more data networks 115.”), 60 (similar).

In sum, whether the additional limitations are considered individually or in ordered combination, claim 1 fails to recite an inventive concept beyond the abstract idea.

Accordingly, we sustain the rejection under § 101 of claim 1, and claims 2–9 and 11–20, which Appellant argues are patentable for similar reasons. *See* Appeal Br. 10, 22; 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

In summary:

Claims Rejected	Statute	Basis	Affirmed	Reversed
1–9, 11–20	§ 101	Eligibility	1–9, 11–20	

TIME TO RESPOND

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. § 1.36(a)(1)(iv).

AFFIRMED