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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BINDU RAMA RAO

Appeal 2019-003465
Application 13/869,678
Technology Center 3600

Before ERIC B. GRIMES, RICHARD M. LEBOVITZ, and
TAWEN CHANG, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

The Examiner rejected the claims under 35 U.S.C. § 103 as obvious and 35 U.S.C. § 101 for lack of patent-eligibility. Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject the claims. 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 Qualtrics, LLC. Appeal Br. 1.

STATEMENT OF THE CASE

The Examiner rejected the claims as follows:

Claims 9–15, 17, 19, and 21–26 under pre-AIA 35 U.S.C. § 101 because the claimed invention is directed to judicial exception to patent-eligibility. Non-Final Act. 3.

Claims 9–15, 17, 19, and 21–26 under pre-AIA 35 U.S.C. § 103(a) as obvious in view of Ramer et al. (US 2008/0009268 A1, published Jan. 10, 2008) (“Ramer”), Maes et al. (US 7,685,252 B1, issued Mar. 23, 2010) (“Maes”), and Smith et al. (US 7,337,127 B1, Feb. 26, 2008) (“Smith”). Non-Final Act. 5.

There are three independent claims on appeal, claims 9, 19, and 23. The claims have similar limitations and therefore we have selected claim 9 as representative. Claim 9 is reproduced below (bracketed numbering has been added for reference to the claim limitations):

9. A system comprising:

[1] a server comprising at least one processor;
[2] at least one non-transitory computer readable storage medium storing instructions thereon that, when executed by the at least one processor, cause the system to:

[3] receive user generated interactive media content;
[4] add system generated content to the user generated interactive media content to:

[5] create a first version of an interactive media survey for use with an interactive-media-client component, wherein the first version of the interactive media survey comprises:

[6] a first segment of the interactive media survey that includes a first survey question and a first navigation element for navigating within the first version of the interactive media survey; and

[7] a second segment of the interactive media survey that includes a second survey question and a

second navigation element for navigating within the first version of the interactive media survey;

[8] create a second version of the interactive media survey for use with a web browser and not for use with the interactive-media-client component, wherein the second version of the interactive media survey comprises an individual segment that includes the first question and the second question;

[9] identify a plurality of recipient devices corresponding to a plurality of recipient profiles corresponding to a profile characteristic from metadata within the user generated interactive media content;

[10] determine that at least one mobile recipient device of the plurality of recipient devices includes the interactive-media-client component;

[11] based on determining that the at least one mobile recipient device includes the interactive-media-client component, select the first version of the interactive media survey for delivery to the at least one mobile recipient device; and

[12] provide the first version of the interactive media survey to the at least one mobile recipient device, the first version of the interactive media survey comprising the user generated interactive media content and the system generated content for presentation on the at least one mobile recipient device.

SECTION 101 REJECTION

The Examiner found that claim 9 “is directed to the abstract idea of creating two versions of content and delivering an interactive version of the content to a device that supports the interactivity or a non-interactive version to a device that does not support interactive features.” Non-Final Act. 3. The Examiner stated that “the focus of the claims is not on such an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools.” Ans. 3. The Examiner further explained

that “[m]ore specifically, the claims in the instant application do not contain a teaching of a novel data storage structure or algorithm for creating the two version of the ‘interactive media survey’, but rather claim the idea of creating two versions of a survey.” *Id.*

Principles of Law

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” However, not every discovery is eligible for patent protection. *Diamond v. Diehr*, 450 U.S. 175, 185 (1981). “Excluded from such patent protection are laws of nature, natural phenomena, and abstract ideas.” *Id.* The Supreme Court articulated a two-step analysis to determine whether a claim falls within an excluded category of invention. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014); *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 566 U.S. 66, 75–77 (2012).

In the first step, it is determined “whether the claims at issue are directed to one of those patent-ineligible concepts.” *Alice*, 573 U.S. at 217. If it is determined that the claims are directed to an ineligible concept, then the second step of the two-part analysis is applied in which it is asked “[w]hat else is there in the claims before us?” *Id.* The Court explained that this step involves

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.”

Alice, 573 U.S. at 217–18 (citing *Mayo*, 566 U.S. at 75–77).

Alice, relying on the analysis in *Mayo* of a claim directed to a law of nature, stated that in the second part of the analysis, “the elements of each claim both individually and ‘as an ordered combination’” must be considered “to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 573 U.S. at 217.

The PTO has published revised guidance on the application of 35 U.S.C. § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50, 51–57 (2019) (“2019 Eligibility Guidance”). This guidance provides additional direction on how to implement the two-part analysis of *Mayo* and *Alice*.

Step 2A, Prong One, of the 2019 Eligibility Guidance, looks at the specific limitations in the claim to determine whether the claim recites a judicial exception to patent eligibility. In Step 2A, Prong Two, the claims are examined to identify whether there are additional elements in the claims that integrate the exception in a practical application, namely, is there a “meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” 84 Fed. Reg. at 54 (2. Prong Two).

If the claim recites a judicial exception that is not integrated into a practical application, then as in the *Mayo/Alice* framework, Step 2B of the Eligibility Guidance instructs us to determine whether there is a claimed inventive concept to ensure that the claims define an invention that is significantly more than the ineligible concept, itself. 84 Fed. Reg. at 56.

With these guiding principles in mind, we proceed to determine whether the claimed subject matter in this appeal is eligible for patent protection under 35 U.S.C. § 101.

Discussion

The Examiner stated that claim 9 “is directed to the abstract idea of creating two versions of content and delivering an interactive version of the content to a device that supports the interactivity or a non-interactive version to a device that does not support interactive features.” Non-Final Act. 3. The Examiner also described the steps in claim 9 and concluded that they correspond “to concepts identified as abstract ideas by the courts.” Non-Final Act. 3. However, the Examiner did not specifically explain, under the first part of the *Alice/Mayo* test, which of the steps recited an excluded category of invention, such as a method of organizing human activity, a mathematical concept, or mental process. The Examiner discussed various Federal Circuit cases in which the court found the claims to be directed to an abstract idea, but the Examiner did not explain how the recited steps of claim 9 are similar to the ineligible claims in the cited cases. *Id.*

Appellant argues in the Appeal Brief that “the independent claims cover a concrete improvement to an electronic survey system by creating different versions of an interactive media survey for improved flexibility and by providing a device the interactive media survey based on determining whether the device includes an interactive media client component.” Appeal Br. 8. We agree with Appellant.

Prong Two of Step 2A asks whether there are additional elements that integrate the exception into a practical application. As in the *Mayo/Alice* framework, we must look at the claim elements individually and “as an

ordered combination” to determine whether the additional elements integrate any recited abstract idea into a practical application. As discussed in the Eligibility Guidance, “[a] claim that integrates a judicial exception into a practical application will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” 84 Fed. Reg. at 54. Integration into a practical application is evaluated by identifying whether there are additional elements which go beyond the judicial exception, and evaluating those additional elements individually, and in combination, to determine whether they integrate the exception into a practical application. *Id.* at 54–55.

One indication that a judicial exception may be integrated into a practical application is an additional element that reflects an improvement to the functioning of a computer or an improvement in another technology. *Id.* at 55. As further explained in the October 2019 Update to Subject Matter Eligibility² “first the specification should be evaluated to determine if the disclosure provides sufficient details such that one of ordinary skill in the art would recognize the claimed invention as providing an improvement.” PEG Update 12.

The Specification explains that “[e]lectronic devices, such as mobile phones and personal digital assistants (PDA’s), often contain small screens with very limited viewing area. They are constrained in terms of how much information can be displayed, and in terms of user interaction capabilities.” Spec. 3:2–4. The Specification discloses that “[i]nformation access from

² Available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf (last accessed Nov. 15, 2019) (“PEG Update.”)

typical Internet based websites from mobile devices are quite often unsatisfactory and not useful due to several factors, not least of which is the multi-media and graphics rich format in which most Internet websites are designed and made available and the verbosity of text.” Spec. 3:19–21. The Specification further discloses that “[a] mobile phone with a small screen is not a good candidate for viewing such complicated and graphics rich (with graphics, flash screens, video components, etc.) content.” Spec. 3:21–22.

To address these problems, the Specification describes a server that determines whether a mobile device “can handle interactive media” because the device comprises “the client component capable of handling the interactive media, and because the interactive media comprise metadata used to determine appropriateness for a device.” Spec. 10:16–21. “In order to play all the components of an interactive media, . . . the recipient devices, such as the recipient device 111, have a client component that can handle all the components of an interactive media, audio, textual, graphics and even video components.” Spec. 11:14–17.

“Some mobile devices . . . may not have the interactive media client.” Spec. 11:21–22. For such devices, the server “makes it possible for them to receive and display/play the interactive media by sending them the same interactive media in an alternate form, such as a simplified set of web pages.” Spec. 12: 1–3. Thus, the Specification describes an improvement to presenting content on a mobile device by presenting the content in different forms, depending on whether the mobile device has a “client component” on it that enables a user of the device to view interactive media.

Claim 9 reflects this solution to the problem of displaying information on the small screens of mobile devices by claiming a system that creates two

versions of an interactive media survey for display on mobile recipient devices, depending on whether a device includes an “interactive-media-client component” which enables the display of the interactive media formatted for the device. The claim creates a first version of an interactive media survey for use with an “interactive-media-client component” (steps [5]–[7]) and a second version of the interactive media survey for use with a “web browser” (step [8]). Based on identifying a mobile recipient device that includes the interactive-media-client component (steps [9], [10]), the claimed technology provides the interactive-media-client component version of the interactive media survey to the mobile recipient device (steps [11], [12]).

Providing different forms of interactive media content depending on whether a mobile device includes an “interactive-media-client component” is therefore an additional element which improves the display of interactive media content on the mobile device. In *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014), claims were found to be patent-eligible because “the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” Claims “directed to an improvement in the functioning of computers, particularly those with small screens” were found to be patent-eligible in *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, 880 F.3d 1356, 1363 (Fed. Cir. 2018). Similarly, claim 9 overcomes the problem of displaying interactive media content on the small screen of a mobile device by first determining whether the device includes the client component and then providing the “first version of the interactive media survey.” We conclude that the additional elements in claim 9 solve a

technological problem by improving the functioning of a mobile device.

The rejection of claim 9, and claims 10–15, 17, 19, and 21–26, under 35 U.S.C. § 101 is reversed.

SECTION 103 REJECTION

The Examiner found that Ramer describes all the steps of claim 9, except for the interactive media survey and creating two separate versions of interactive media content, as recited in steps [5] and [8] of claim 9. Non-Final Act. 6–7. However, the Examiner found that Maes describes “creating multiple versions of content from a base input language,” including a web browser version. *Id.* at 7. The Examiner determined it would have been obvious to the skilled worker “to modify Ramer with the use of different versions of content as taught by Maes in order to produce content that is ‘modality-independent.’” *Id.* With respect to the “interactive media survey,” the Examiner found that Smith describes “an advertising system that presents users with surveys.” *Id.* The Examiner determined it would have been obvious to a person of ordinary skill in the art at the time of the invention “to modify Ramer with the method of presenting surveys as content as taught by Smith in order to better target advertising.” *Id.*

Appellant contends that “*Maes* and *Ramer* nowhere describe or suggest creating two different versions of an interactive media survey with the particular segments recited in the independent claims.” Appeal Br. 20. We agree with Appellant that the Examiner did not establish by preponderance of the evidence that the cited publications disclose or suggest first (step [5]) and second versions (step [7]) of an interactive media survey, where the first version is “for use with an interactive-media-client

component” on a mobile recipient device and a second version is “for use with a web browser.”

Ramer, as found by the Examiner, describes allowing a sponsor “to select the types of mobile communication facilities on which the sponsor would like to present the sponsor content.” Ramer ¶ 1039. Ramer discloses that “the sponsor may wish to select a subset of mobile communication facility models that are best suited for presentation of the sponsor’s content due to technological requirements for the content to optimally present.” *Id.* However, the Examiner acknowledged that this disclosure was deficient because it does not “specify creating two separate versions with the first comprising interactive elements for navigating within the interactive media survey and the second for use with a web browser and not for use with interactive-media-client component.” Non-Final Act. 7 (referencing limitations [5] and [7] of claim 9).

The Examiner cited Maes to make up for this deficiency. Maes describes “services that are device and modality independent” by designing a markup language for authoring “information content and interaction logic that is modality independent.” Maes, col. 6, l. 59–col. 7, l. 2. As Maes explains that “[e]ither CML pages are served to browsers that can parse and render CML content (see Case B below) or they are served to legacy browsers that can only handle legacy languages, e.g., HTML, WML, VoiceXML, etc. (see Case A below).” Maes, col. 14, ll. 26–30.

In Case A, “[w]hen a page is requested, it is fetched in CML and transcoded on the fly using the gesture-based XSL transformation rules into the target ML.” Maes, col. 14, ll. 35–38. In Case B, “[t]he target browser handles CML. Therefore, it knows exactly what are the modalities that it

supports (single or multiple) as well as the rules required to optimally render a given gesture in its supported modalities.” Maes, col. 14, ll. 39–42.

Thus, Maes teaches a *single* content version which is translated differently (Case A and B) upon delivery to the device. In contrast, the claims require first and second versions, where the first version is created (step [5]) and provided to a mobile recipient device (step [12]) and the second version is for use with a web browser (step [8]). Maes therefore solves the problem of presenting content to different devices in a different manner than the claims, namely by creating one version written in a markup language that is translated differently depending on the device which receives it. Therefore, the Examiner’s reliance on Maes to make up for the deficiency in Ramer is not supported by a preponderance of the evidence in this record.

The Examiner also did not establish that the cited publications disclose or suggest the claimed “interactive-media client component” that is for use with a first version of a media survey, but not for use with a web browser (“a second version of the interactive media survey for use with a web browser and not for use with the interactive-media-client component”). The Examiner cited the disclosure in Ramer of “Java” on a mobile device as the claimed interactive-media-client component. Non-Final Act. 6; Ans. 6–7. However, the Examiner did not establish that Java is for use with the mobile device and not for use with a web browser. Appeal Br. 21; Reply Br. 18. To the contrary, the Examiner inconsistently stated that Java was also used for web browsers and enabled by a browser. Ans. 7.

Summary

For the foregoing reasons, the rejection under 35 U.S.C. § 103 of claims 9–15, 17, 19, and 21–26, is reversed.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
9–15, 17, 19, 21–26	101	Eligibility		9–15, 17, 19, 21–26
9–15, 17, 19, 21–26	103	Ramer, Maes, Smith		9–15, 17, 19, 21–26
Overall Outcome				9–15, 17, 19, 21–26

REVERSED