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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL A. MARTH and KEN BEATON

Appeal 2019-004003
Application 14/630,377
Technology Center 3600

Before JOHNNY A. KUMAR, JENNIFER S. BISK, and JOYCE CRAIG,
Administrative Patent Judges.

BISK, *Administrative Patent Judge.*

DECISION ON APPEAL¹

¹ Throughout this Decision we have considered the Specification filed February 24, 2015 (“Spec.”), the Final Rejection mailed October 18, 2018 (“Final Act.”), the Appeal Brief filed March 6, 2019 (“Appeal Br.”), the Examiner’s Answer mailed April 15, 2019 (“Ans.”), and the Reply Brief filed April 25, 2019 (“Reply Br.”).

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant² appeals from the Examiner’s decision to reject claims 1–16 and 21–24. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

The claims are directed to managing content for marketing, including content creation, deployment collaboration, activity stream, and task management. Spec. ¶ 4. Claims 1, 11, and 21 are independent. Claim 1, reproduced below, is illustrative of the claimed subject matter (bracketed numbers added):

1. In a digital medium environment for creating a marketing activity, where the marketing activity involves creation of content as part of the marketing activity, a computing device comprising:

- [1] a processing system; and
- [2] a computer-readable storage medium having instructions stored thereon that, responsive to execution by the processing system, causes the processing system to perform operations including:
 - [3] receiving a search input describing a characteristic of the content to be included as part of the marketing activity;
 - [4] locating content by performing a search based on the search input by comparing metadata of the content that describes an image editing operation used to create the content as initiated by a content creator with the characteristic of the content;
 - [5] finding a content creator that has created the located content based on the metadata; and

² We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Adobe, Inc. Appeal Br. 3.

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[6] causing output of an identifier of the found content creator for inclusion in a user interface to cause communication of an offer to the content creator to create content based on the characteristic of the content.

Appeal Br. 38 (Claims App.).

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Dudas	WO 2008/033840 A2	March 20, 2008
O'Donnell	U.S. 9,396,279 B1	July 19, 2016
Pattan	U.S. 9,524,077 B1	Dec. 20, 2016
Sohma	U.S. 2002/0040360 A1	Apr. 4, 2002
Walker	U.S. 2004/0174434 A1	Sep. 9, 2004

REJECTIONS

Claims 1–16 and 21–24 are rejected under 35 U.S.C. § 101 because the claimed invention is not directed to patent eligible subject matter. Final Act. 4–7.

Claims 1, 9–11, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dudas, Sohma, and O'Donnell. Final Act. 8–15.

Claims 2, 3, 12, 22, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dudas, Sohma, O'Donnell, and Pattan. Final Act. 15–17.

Claims 4–8, 13–16, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dudas, Sohma, O'Donnell, and Walker. Final Act. 18–24.

OPINION

We review the appealed rejections for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced

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thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). To the extent Appellant has not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. 37 C.F.R. § 41.37(c)(1)(iv).

We have considered all of Appellant’s arguments and any evidence presented. We highlight and address specific findings and arguments for emphasis in our analysis below.

Rejection of Claims 1–16 and 21–24 under 35 U.S.C. § 101

Section 101 of the Patent Act provides that “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” is patent eligible. 35 U.S.C. § 101. But the Supreme Court has long recognized an implicit exception to this section: “Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). To determine whether a claim falls within one of these excluded categories, the Court has set out a two-part framework. The framework requires us first to consider whether the claim is “directed to one of those patent-ineligible concepts.” *Alice*, 573 U.S. at 217. If so, we then examine “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 Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78, 79 (2012)). That is, we examine the claims for an “inventive concept,” “an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent

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upon the [ineligible concept] itself.” *Alice*, 573 U.S. at 217–18 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

The Patent Office recently issued guidance regarding this framework. *See* USPTO, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Revised Guidance”). Under the Revised Guidance, to decide whether a claim is “directed to” an abstract idea, we evaluate whether the claim (1) recites subject matter falling within an abstract idea grouping listed in the Revised Guidance and (2) fails to integrate the recited abstract idea into a practical application. *See* Revised Guidance, 84 Fed. Reg. at 51. If the claim is “directed to” an abstract idea, as noted above, we then determine whether the claim recites an inventive concept. The Revised Guidance explains that when making this determination, we should consider whether the additional claim elements add “a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field” or “simply append[] well-understood, routine, conventional activities previously known to the industry.” Revised Guidance, 84 Fed. Reg. at 56.

For the § 101 rejections, Appellant argues claims 1–16 and 21–24 together. *See* Appeal Br. 8–14. As permitted by 37 C.F.R. § 41.37, we decide the appeal for this rejection based on claim 1. *See* 37 C.F.R. §41.37(c)(1)(iv). Noting claims 1 and 21 recite systems and claim 13 recites a method and, therefore, fall within the process category of § 101, we turn to the Examiner’s § 101 rejection.

The Judicial Exception—Abstract Idea

The Examiner determined that the claims “are directed to receiving market activity and content data, locating metadata, finding content creators

that correspond to the located metadata and displaying the content creators on a user interface” similar to “collecting information, analyzing it, and displaying certain results of the collection and analysis” found to be an abstract idea in *Electric Power*. Final Act. 4 (citing *Elec. Power Grp., LLC v. Alstom, S.A.*, 830 F.3d 1350 (Fed. Cir. 2016)). The Examiner also states that “each of the foregoing activities” of claims 1, 13, and 21 can “be performed by a human being, or by a ‘human analog’ mentally or manually, i.e. with pen and paper.” *Id.* at 5.

Between the mailing of the Final Action and the Answer, the Office issued the Revised Guidance. In response to this guidance, the Examiner added that claim 1 “recites receiving a search input, locating content, finding a content creator and outputting/displaying a content creator identifier,” which “is comparable to . . . marketing, sales activities or behaviors.” Ans. 4. The Examiner, therefore, explains that claim 1 falls within the category of “Certain Methods of Organizing Human Activity—Commercial or Legal Interactions” and, therefore, recites an abstract idea. *Id.*; see Revised Guidance, 84 Fed. Reg. at 53. For the reasons explained below, we agree that the claims recite an abstract idea.

According to the Specification, the invention overcomes problems related to having to select content for inclusion in marketing activities “from scratch.” Spec. ¶ 3. This often requires marketing professionals to create new marketing material by guessing why other marketing activities have been successful, “which could be complicated, time consuming, and may not be accurate.” *Id.* The Specification describes “[c]ontent and deployment collaboration techniques,” which use a “content creation service” and a “content deployment service,” so that deployment data may be tracked and reused in future marketing activities. *Id.* ¶ 4–5. Presenting a health

insurance plan to a user seeking such a plan falls within “advertising, marketing, or sales activities.” Revised Guidance, 84 Fed. Reg. at 52.

As quoted and enumerated above, claim 1 includes six main limitations. These limitations recite, in part, the following steps: *receiving* a search input describing content (limitation [3]), locating content by searching based on the search input by comparing metadata of the content with the characteristic of the content (limitation [4]), and finding the content creator of the located content (limitation [5]). Appeal Br. 38 (Claims App.). Under their broadest reasonable interpretation, all these limitations ([3]–[5]) contribute to a method of searching for and displaying marketing content, which is advertising, marketing or sales activity. Such activity has been found to be an abstract idea. *See, e.g., Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed Cir. 2014) (holding that claim “describ[ing] only the abstract idea of showing an advertisement before delivering free content” is patent ineligible); *In re Ferguson*, 558 F.3d 1359, 1364 (Fed Cir. 2009) (holding methods “directed to organizing business or legal relationships in the structuring of a sales force (or marketing company)” to be ineligible).

In addition, we agree with the Examiner that at least limitations [3]–[5] could be performed in the mind or with pencil and paper. For example limitations [3]–[5] encompass a process that could occur in a person’s mind—receiving a characteristic of content to be included as part of marketing activity, searching for content with that characteristic, and figuring out the creator of that content. Similar claims have been found ineligible by the Federal Circuit. For example, the Federal Circuit continues to “‘treat[] analyzing information by steps people go through in their minds, . . . without more, as essentially mental processes within the abstract-idea

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category.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146–47 (Fed. Cir. 2016) (quoting *Electric Power Group*, 830 F.3d at 1354).

Moreover, when claimed in a manner similar to the claims here, gathering and analyzing information using conventional techniques has been determined to be an abstract idea. *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 612–13 (Fed. Cir. 2016). Also, more recently, our reviewing court has also concluded that some acts of collecting, analyzing, manipulating, and displaying data are patent ineligible. *Univ. of Fl. Research Found., Inc. v. General Electric Co.*, 916 F.3d 1363, 1367 (Fed. Cir. 2019) (citing *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017); *Electric Power Group*, 830 F.3d at 1353–54).

Accordingly, we conclude claim 1 recites a certain method of organizing human activity or concepts performed in the human mind identified in the Revised Guidance, and thus, an abstract idea.³ Revised Guidance, 84 Fed. Reg. at 53.

³ Our reviewing court recognizes that “[a]n abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). That need not and, in this case does not, “impact the patentability analysis.” *Id.* at 1241. Further, “[a]n abstract idea can generally be described at different levels of abstraction. . . . The Board’s slight revision of its abstract idea analysis does not impact the patentability analysis.” *Id.* Moreover, merely combining several abstract ideas does not render the combination any less abstract. *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“Adding one abstract idea (math) to another abstract idea . . . does not render the claim non-abstract.”); *see also FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (determining the pending claims were directed to a combination of abstract ideas).

Integration of the Judicial Exception into a Practical Application

If a claim recites a judicial exception, we determine whether the recited judicial exception is integrated into a practical application of that exception by: (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application. If the recited judicial exception is integrated into a practical application, the claim is not directed to the judicial exception.

Here, claim 1 recites the additional elements of “a processing system” (limitation [1]), “a computer readable storage medium having instructions stored thereon that, responsive to execution by the processing system, causes the processing system to perform operations” (limitation [2]), and displaying an identifier of the located content with an offer to the content creator (limitation [6]). Appeal Br. 38 (Claims App.). Considering claim 1 as a whole, the additional elements do not apply or use the abstract idea in a meaningful way such that the claim as a whole is more than a drafting effort designed to monopolize the exception. The Supreme Court guides that the “prohibition against patenting abstract ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or [by] adding ‘insignificant postsolution activity.’” *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (quoting *Diamond v. Diehr*, 450 U.S. 175, 191–92 (1981)).

The Specification describes each of these elements as generic components. For example, the Specification states that “[c]omputing devices that are used to implement the content creation service 102, content deployment service 104, and the client device 106 are configurable in a

variety of ways,” ranging from “full resource devices with substantial memory and processor resources (e.g., personal computers, game consoles) to a low-resource device with limited memory and/or processing resources (e.g., mobile devices).” Spec. ¶ 48; *see also* ¶¶ 153–166 (describing the system in terms of conventional computer hardware and software). The recited “processing system” is described in the Specification as “including hardware element 3510 that may be configured as processors, functional blocks, and so forth” and “are not limited by the materials from which they are formed or the processing mechanisms employed therein. *Id.* ¶ 155. The Specification also describes the recited “computer readable storage medium” as “including memory/storage 3512,” which “may include volatile media (such as random access memory (RAM)) and/or nonvolatile media (such as read only memory (ROM), Flash memory, optical disks, magnetic disks, and so forth),” “as well as fixed media (e.g., RAM, ROM, a fixed hard drive, and so on) as well as removable media (e.g., Flash memory, a removable hard drive, an optical disc, and so forth).” *Id.* ¶ 156. Moreover, we determine limitation [6] (“causing output of an identifier of the found content creator for inclusion in a user interface to cause communication of an offer to the content creator to create content based on the characteristic of the content”) constitutes insignificant post-solution activity. *See* MPEP 2106.05(g).

Appellant’s arguments have not persuaded us claim 1 is “directed to” a patent-eligible concept. Appellant argues that the claims “improve content creation technology by identifying content creators to therefore increase a likelihood of the content being successful relative to conventional content creation technology,” and, therefore, are not directed to an abstract idea. Appeal Br. 15, 22. To support this argument Appellant cites to language in the Specification stating that “[i]dentifiers of these content creators may then

be output automatically and without user intervention such that the marketer may make offers to these content creators to create desired content and thus improve the likelihood that the content will be successful as part of the marketing activity.” *Id.* at 16 (quoting Spec. ¶ 131).

Appellant supports this argument by citing to *Ancora Techs., Inc. v. HTC America, Inc.*, 908 F.3d 1343 (Fed. Cir. 2018). Appeal Br. 19–21. Specifically, Appellant argues that “the claimed advance is a concrete assignment of specified functions among a computer’s components to improve content creation technology, and this claimed improvement in computer functionality is eligible for patenting.” Appeal Br. 20–21. We disagree. Unlike Appellant’s claims, “[t]he claimed method [in *Ancora*] specifically identifies how that functionality improvement is effectuated in an assertedly unexpected way: a structure containing a license record is stored in a particular, modifiable, non-volatile portion of the computer’s BIOS.” *See Ancora*, 908 F.3d at 1348. In other words, in *Ancora*, “[t]he asserted innovation of the patent relates to where the license record is stored . . . The inventive method uses a modifiable part of the BIOS memory—not other computer memory—to store the information that can be used.” *Id.* at 1345.

Here, to the contrary, identifying content creators so as to determine what content to show the user does not describe an improvement to a user interface for displaying that data. The fact that users may find data displayed on a user interface to be useful has no bearing on whether there has been a technological improvement to the user interface itself. Appellant does not point to, and we do not see, any disclosure in the Specification that describes improving the user interface itself, but instead describes determining what data should be displayed by a conventional user interface.

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See Spec. ¶ 44 (“Content creators, in one such instance, receive this data to determine which of their content has been successfully employed as part of marketing activities and use this information in the creation of future content.”). We, therefore, disagree that the claims here are similar to those at issue in *Ancora* because they do not claim an improvement to computer functionality.

Appellant also argues that the claims “identify a particular tool for presentation,” “limit the technical means for performing functions,” and “require performance of the claimed function,” and, thus, are not similar to the claims found ineligible in *Electric Power Group*. Appeal Br. 17–18 (citing *Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1351 (Fed. Cir. 2016)).

We disagree with Appellant’s attempted differentiation of the claims of *Electric Power Group* from the claims in this case. In *Electric Power Group*, the Court held ineligible a recited method of detecting events on an interconnected power grid from plural data streams in real time and analyzing those events, where the method included, among other things, displaying event analysis results and diagnoses, metrics, and concurrent visualization of measurements from the data streams, and deriving a composite reliability indicator. *Elec. Power Grp.*, 830 F.3d at 1351–56. Notably, in *Electric Power Group*, the claimed invention was ineligible because it merely gathered and analyzed information, and then displayed results—an abstract idea that is strikingly similar to the one at issue here. Merely displaying the results of such abstract ideas does not integrate them into a practical application as illustrated in *Electric Power Group*. In addition to receiving and analyzing data using mathematical calculations, claim 12 in *Electric Power Group* also displayed the results of that analysis

“in visuals, tables, charts, or combinations thereof, the data comprising at least one of monitoring data, tracking data, historical data, prediction data, and summary data.” *Elec. Power Grp.*, 830 F.3d at 1352. It also displayed “concurrent visualization of measurements from the data streams and the dynamic stability metrics.” *Id.* The Court held that displaying information that results from collection and organizing is “abstract as an ancillary part of such collection and analysis.” *Id.* at 1354.

We do not agree with Appellant’s argument that “[c]ausing an output of an identifier a found content creator for inclusion in a user interface to cause communication of an offer to the content creator to create content based on a characteristic of the content” qualifies as “a particular tool for presentation of the offer to the content creator.” *See* Appeal Br. 17. Instead, this limitation simply determines what data will be presented by generic display devices using commonly available tools. Similarly, we do not agree with Appellant’s argument that the claims here “limit the technical means for performing functions” of locating content such that they are distinguishable from the claims at issue in *Electric Power Group*. We do not agree that by requiring presented content based on the result of “performing a search based on a search input by comparing metadata of the content that describes an image editing operation used to create the content as initiated by a content creator with a characteristic of the content” is “significantly limiting the technical means for performing functions.” *See id.* at 18. Instead, this restriction simply limits the data that is presented to a content creator in an analogous manner to that recited in the claims at issue in *Electric Power Group* (reciting displaying data after analysis). *Elec. Power Grp.*, 830 F.3d 1352. Finally, we do not agree that requiring a search input be received, a search performed based on that input by comparing

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metadata, and finding a content creator, in any way distinguishes the claims at issue with those in *Electric Power Group*. See Appeal Br. 18.

In contrast to the claims at issue, in *Core Wireless*, the claims recited an improved interface for a mobile device that displayed a summary of applications in unlaunched states so that users could quickly navigate to desired applications from the start up menu to find data of interest unlike known devices that required a user to switch views many times and drill through many layers to find the right data or functionality. *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, 880 F.3d 1356, 1362–63 (Fed. Cir. 2018). The interface displayed “a limited list of common functions and commonly accessed stored data” that were accessible directly from the main menu “rather than using conventional user interface methods to display a generic index on a computer.” *Id.* at 1363.

Here, claim 1 recites collecting comments and markups and displaying that data together based on contributor type depending on whether a supervisor need approve the display. In other words, the display functions generically; it displays data. What data is displayed and how it is arranged is described by the claims at issue, but not the mechanism of how that data is displayed.

Appellant also argues that the claims recite significantly more than an abstract idea because they “recite how interactions are manipulated to achieve a desirable result.” Appeal Br. 21 (citing *DDR Holdings, LLC v. Hotels.com*, 773 F.3d 1245, 1258 (Fed. Cir. 2014)). We do not agree with Appellant’s reading of *DDR Holdings* as holding that “[c]laims that recite how interactions are manipulated to achieve a desirable result recite significantly more than an abstract idea.” *Id.*

In *DDR Holdings*, the Court evaluated the eligibility of claims “address[ing] the problem of retaining website visitors that, if adhering to the routine, conventional functioning of Internet hyperlink protocol, would be instantly transported away from a host's website after ‘clicking’ on an advertisement and activating a hyperlink.” *Id.* at 1257. There, the Court found that the claims were patent eligible because they transformed the manner in which a hyperlink typically functions to resolve a problem that had no “pre-Internet analog.” *Id.* at 1258. The Court cautioned, however, “that not all claims purporting to address Internet-centric challenges are eligible for patent.” *Id.* For example, in *DDR Holdings* the Court distinguished the patent-eligible claims at issue from claims found patent-ineligible in *Ultramercial*. *See id.* at 1258–59 (citing *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (Fed. Cir. 2014)). As noted there, the *Ultramercial* claims were “directed to a specific method of advertising and content distribution that was previously unknown and never employed on the Internet before.” *Id.* at 1258 (quoting *Ultramercial*, 772 F.3d at 715–16). Nevertheless, those claims were patent ineligible because they “merely recite[d] the abstract idea of ‘offering media content in exchange for viewing an advertisement,’ along with ‘routine additional steps such as updating an activity log, requiring a request from the consumer to view the ad, restrictions on public access, and use of the Internet.’” *Id.*

Appellant’s asserted claims are analogous to claims found ineligible in *Ultramercial* and distinct from claims found eligible in *DDR Holdings*. The ineligible claims in *Ultramercial* recited “providing [a] media product for sale at an Internet website;” “restricting general public access to said media product;” “receiving from the consumer a request to view [a] sponsor message;” and “if the sponsor message is an interactive message, presenting

at least one query to the consumer and allowing said consumer access to said media product after receiving a response to said at least one query.” 772 F.3d at 712. Similarly, Appellant’s asserted claims recite collecting data and outputting certain of that data depending on content. This is the type of activity found ineligible in *Ultramercial*. The invention as a whole does not solve problems specifically arising in some aspect of computer technology, nor is it solving an Internet centric problem, but rather the computer in the instant claims is used as a mechanism to improve efficiency of the claimed abstract idea. See *FairWarning*, 839 F.3d at 1095 (citing *Bancorp Services, LLC v. Sun Life Assurance Co.*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (“[T]he fact that the required calculations could be performed more efficiently via a computer does not materially alter the patent eligibility of the claimed subject matter.”)); see also *Intellectual Ventures I LLC v. Erie Indemnity Co.*, 711 F. App’x 1012, 1017 (Fed. Cir. 2017) (unpublished) (“Though the claims purport to accelerate the process of finding errant files and to reduce error, we have held that speed and accuracy increases stemming from the ordinary capabilities of a general-purpose computer ‘do[] not materially alter the patent eligibility of the claimed subject matter.’” (alteration in original) (citation omitted)).

Accordingly, even in combination with all the other recited elements, the addition of “a processing system” and “a computer readable storage medium having instructions stored thereon that, responsive to execution by the processing system, causes the processing system to perform operations” does not integrate the abstract idea into a practical application because it does not impose any meaningful limits on practicing the abstract idea. For these reasons, we determine that claim 1 does not integrate the recited abstract idea into a practical application.

Inventive Concept

Because we agree with the Examiner that claim 1 is “directed to” an abstract idea, we consider whether an additional element (or combination of elements) adds a limitation that is not well-understood, routine, conventional (“WURC”) activity in the field or whether the additional elements simply append WURC activities previously known to the industry, specified at a high level of generality, to the judicial exception. Revised Guidance, 84 Fed. Reg. at 23. The Examiner’s finding that an additional element (or combination of elements) is WURC activity must be supported with a factual determination. *Id.* (citing MPEP § 2106.05(d), as modified by the *Berkheimer* Memorandum⁴).

Whether the additional elements “a processing system,” “a computer readable storage medium having instructions stored thereon that, responsive to execution by the processing system, causes the processing system to perform operations,” and displaying an identifier of the located content with an offer to the content creator are WURC activity is a question of fact. *See Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018) (“Whether something is well-understood, routine, and conventional to a skilled artisan . . . is a factual determination.”).

On the record before us, Appellant has not shown that the claims on appeal add a specific limitation beyond the judicial exception that is not “well-understood, routine, and conventional” in the field, whether the limitations are considered individually or as an ordered combination (*see*

⁴ Robert W. Bahr, *Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision* (*Berkheimer v. HP, Inc.*) (2018) (hereinafter “*Berkheimer* Memorandum”).

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MPEP § 2106.05(d)). Appellant does not point to any particular claimed element, or combination of elements, that does not qualify as WURC. *See* Appeal Br. 14–23.

In fact, Appellant’s Specification demonstrates the WURC nature of “a processing system” and “a computer readable storage medium having instructions stored thereon that, responsive to execution by the processing system, causes the processing system to perform operations” because it indicates they may be implemented with generic devices. Spec. ¶¶ 153–166.

For these reasons, we conclude that claim 1, considered as a whole, does not include an inventive concept.

Therefore, we sustain the Examiner’s § 101 rejection of independent claim 1. For the reasons discussed above, we also sustain the Examiner’s § 101 rejection of dependent claims 2–10. We also sustain the Examiner’s § 101 rejection of independent claims 11 and 21 and dependent claims 12–16 and 22–24 for which Appellant relies on the same arguments made with respect to claim 1. *See* Appeal Br. 22–23.

Rejection of Claims 1–16 and 21–24 under 35 U.S.C. § 103

The Examiner rejects independent claims 1, 11, and 21 as obvious over the combination of Dudas, Sohma, and O’Donnell. Final Act. 8–15. Specifically, the Examiner cites to Dudas as teaching the majority of limitations of the claims, but relies on Sohma “to illustrate the functionality of comparing inputted and stored metadata for searches in the same or similar context” (Final Act. 10) and on O’Donnell “to illustrate the functionality of the nature of the metadata in the same or similar context” (*id.* at 11).

Appellant argues that the combined references fail to teach or suggest “finding a content creator that has created the located content based on the metadata” (the “finding limitation”). Appeal Br. 23–26; Reply Br. 7–9. According to Appellant, Dudas does not teach or suggest the finding limitation because, although it “maintains metadata pertaining to users,” “Dudas does not have any reason to find a user based on metadata because Dudas has the mix, the user information, and the user contribution already.” *Id.* at 24. Appellant adds that “‘filtering’ of Dudas is not the same” as the finding limitation. *Id.* at 25. In addition, Appellant contends that Sohma does not teach or suggest the finding limitation. *Id.*

This argument does not persuade us of error in the rejection. Nonobviousness cannot be established by attacking references individually when the rejection is based on the teachings of a combination of prior art references. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). By arguing that Dudas and Sohma each individually fail to teach all aspects of the finding limitation, Appellant does not address the rejection as articulated, in which the Examiner relies on certain combined teachings of Dudas and Sohma. *See* Final Act. 9–10 (relying on Dudas as teaching storing metadata related to the author (content creator) and on Sohma searching based on metadata); Reply 7–9 (same); *see also In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“[T]he test [for obviousness] is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”). In addition, although Appellant contends no reference discloses *all aspects* of the disputed limitations, Appellant does not identify any alleged error in the Examiner’s individual factual findings regarding each reference.

Further, Appellant does not *explain* why the references do not satisfy the limitation at issue, and Appellant's summary conclusions do not show error. *See* 37 C.F.R. § 41.37(c)(1)(iv) ("The arguments shall explain why the examiner erred as to each ground of rejection contested by appellant."). The Board interprets Rule 41.37 "to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art." *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011); *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984). Here, Appellant merely summarizes Dudas's and Sohma's purported teachings and concludes that these teachings do not correspond to the finding limitation. Appeal Br. 24–25; Reply Br. 7–9. This is not enough to qualify as a substantive argument. Moreover, in looking at the rejection, we find Examiner's explanations reasonable. We are, therefore, not persuaded of error in the rejection by Appellant's conclusory assertions.

Appellant also argues that the combined references fail to teach or suggest "cause communication of an offer to the content creator" (the "offer limitation"). Appeal Br. 26–33. In response, the Examiner explains that "Dudas implicitly discloses / suggests" the offer limitation by describing making recommendations to users. Ans. 9 (quoting Dudas ¶¶ 26, 53, 86, 106, 116, 141, 185). In the Reply Brief, Appellant "respectfully disagrees," without further elaboration, with this explanation. Reply Br. 10. As discussed above, this contention does not qualify as substantive argument. *See* 37 C.F.R. § 41.37(c)(1)(iv). Moreover, in looking at the rejection, we find Examiner's explanations reasonable. We are, therefore, not persuaded of error in the rejection by Appellant's conclusory assertions.

Finally, Appellant argues that Dudas and Sohma “may not be combined without rendering one of the references inoperable.” Appeal Br. 34; Reply Br. 10–11. According to Appellant, “Dudas describes mixes are available to the online community and can be modified by the online community” and, therefore, “the main principal described by Sohma of providing predetermined candidates of metadata may not be combined with the dynamic metadata of Dudas without rendering one of the references inoperable.” *Id.*

We do not find this argument persuasive of error in the rejection. “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.” *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1294 (Fed. Cir. 2015) (*quoting In re Keller*, 642 F.2d 413, 425 (CCPA 1981)); *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed. Cir. 2007) (“[W]e do not ignore the modifications that one skilled in the art would make to a device borrowed from the prior art.”); *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) (“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.”).

Accordingly, we are not persuaded of error in the Examiner’s rejection of claim 1, 11, and 21 as obvious over the combination of Dudas, Sohma, and O’Donnell. Appellant does not make any additional arguments for claims 9 and 10, which depend from claim 1. Appeal Br. 36. Accordingly, we are not persuaded of error in the Examiner’s rejection of claims 9 and 10 as obvious over the combination of Dudas, Sohma, and O’Donnell.

Claims 2–8, 12–16, and 22–24

The Examiner rejects dependent claims 2, 3, 12, 22, and 23 over Dudas, Sohma, O’Donnell, and Pattan and dependent claims 4–8, 13–16, and 24 over Dudas, Sohma, O’Donnell, and Walker. Final Act. 15–24. Because these claims depend from claims 1, 11, and 21, these rejections suffer from the same deficiency as that of those claims. Moreover, Appellant does not make additional arguments for these claims. Appeal Br. 36–37. Accordingly, we do not sustain the Examiner’s rejection of claims 2–8, 12–16, and 22–24.

CONCLUSION

We affirm the Examiner’s rejections.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Basis/ Reference(s)	Affirmed	Reversed
1–16, 21–24	101	Eligibility	1–16, 21–24	
1, 9–11, 21	103(a)	Dudas, Sohma, O’Donnell	1, 9–11, 21	
2, 3, 12, 22, 23	103(a)	Dudas, Sohma, O’Donnell, Pattan	2, 3, 12, 22, 23	
4–8, 13–16, 24	103(a)	Dudas, Sohma, O’Donnell, Walker	4–8, 13–16, 24	
Overall Outcome			1–16, 21–24	

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) (1)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED