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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MEIR ZOHAR and ELAD EFRAIM

Appeal 2019-004899
Application 12/019,379
Technology Center 3600

Before ST. JOHN A. COURTENAY III, LARRY J. HUME, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner’s decision rejecting claims 36–44, 46–52, 54, and 56–58, which are all the claims pending in the application. Claims 1–35, 45, 53, and 55 have been canceled. Appeal Br. 38–43. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “Applicant(s)” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as EXELATE MEDIA LTD. Appeal Br. 2.

STATEMENT OF THE CASE²

The Invention

The claims are directed to “advertising services, and more particularly are related to an Internet based interactive targeting event marketplace.” *See* Spec. 1:9–10. In particular, one embodiment of the invention is described as:

A system and method for providing a targeting event marketplace is provided. Generally, the method contains the steps of: at least one targeted publisher and a targeting event marketplace entity agreeing to financial terms associated with revenues received from at least one buyer that obtains access to the Internet browser of an end-user; providing an end-user tag on a Web page of the Web site, wherein the end-user tag is capable of calling a Web server from an Internet browser of the end-user; analyzing an end-user action associated with the Web page, wherein the step of analyzing is performed to categorize the action into a category of targeting event; the Web server determining if at least one buyer has interest in at least one end-user taking an action that is categorized into at least one category of targeting event; and receiving bids from at least one buyer for providing access to the Internet browser of the end-user and selecting at least one buyer.

Spec. 32 (Abstr.).

² Our decision relies upon Appellant’s Appeal Brief (“Appeal Br.,” filed Feb. 26, 2019); Reply Brief (“Reply Br.,” filed June 5, 2019); Examiner’s Answer (“Ans.,” mailed April 5, 2019); Final Office Action (“Final Act.,” mailed July 26, 2018); and the original Specification (“Spec.,” filed Jan. 24, 2008).

Exemplary Claim

Claim 36, reproduced below, is representative of the subject matter on appeal (*emphases* added to dispositive limitations):

36. A method to selectively store cookies on computers, the method comprising:

receiving an electronic communication at a first server from a targeted publisher via an end-user tag loaded from a Web page of the targeted publisher, the electronic communication including targeting event data that is based on an end-user computer interacting with the Web page of the targeted publisher;

maintaining, at a central database communicatively coupled with the first server, a list of a plurality of entities, the entities respectively associated with a web address and a targeting channel, the targeting channel associated with targeting event data;

matching, with the first server, a matched entity from the list of the plurality of entities to the end-user tag based on an association between the targeting event data and the targeting channel of the matched entity, the first server associated with a different entity than the matched entity; and

in response to matching the matched entity to the end-user tag with the first server, instructing an internet browser of the end-user computer to retrieve content from a web address of the matched entity to facilitate transmission of a request to a second server, the second server located at the web address of the matched entity, the transmitted request to cause at least one of an addition of a cookie or an update to the cookie, the update to add information associating the cookie with the targeting channel of the matched entity, the cookie stored in the internet browser of the end-user computer, and including information associating the cookie with the targeting channel of the matched entity, wherein the cookie is utilized by the matched entity to present a targeted advertisement.

Prior Art

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Caldwell et al. (“Caldwell”)	US 2002/0046286 A1	Apr. 18, 2002
Collins	US 2006/0026061 A1	Feb. 2, 2006
Levkovitz et al. (“Levkovitz”)	US 2007/0088801 A1	Apr. 19, 2007
Beck et al. (“Beck”)	US 7,254,547 B1	Aug. 7, 2007

Rejection on Appeal

Claims 36–44, 46–52, 54, and 56–58 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Collins, Caldwell, Levkovitz, and Beck. Final Act. 8.³

CLAIM GROUPING

Based on Appellant’s arguments (Appeal Br. 30–36) and our discretion under 37 C.F.R. § 41.37(c)(1)(iv), we decide the appeal of the obviousness rejection of claims 36–44, 46–52, 54, and 56–58 on the basis of representative independent claim 36.⁴

³ We note the Examiner withdrew a § 101 rejection of all claims. Ans. 3.

⁴ “Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.” 37 C.F.R. § 41.37(c)(1)(iv). In addition, when Appellant does not separately argue the patentability of dependent claims, the claims stand or fall with the claims from which they depend. *In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986).

ISSUES

Appellant argues (Appeal Br. 30–36; Reply Br. 2–10) the Examiner’s rejection of claim 36 under 35 U.S.C. § 103(a) as being obvious over Collins, Caldwell, Levkovitz, and Beck is in error. These contentions present us with the following issues:

(a) Did the Examiner err in finding the cited prior art combination teaches or suggests “[a] method to selectively store cookies on computers” that includes the step of “in response to matching the matched entity to the end-user tag with the first server, instructing an internet browser of the end-user computer to retrieve content from a web address of the matched entity to facilitate transmission of a request to a second server” in which “the transmitted request [] cause[s] at least one of an addition of a cookie or an update to the cookie, the update to add information associating the cookie with the targeting channel of the matched entity, the cookie . . . including information associating the cookie with the targeting channel of the matched entity, wherein the cookie is utilized by the matched entity to present a targeted advertisement,” as recited in claim 36?

(b) Did the Examiner err in rejecting claim 36 by providing improper motivation to combine the references in the manner suggested?

ANALYSIS

We have reviewed the Examiner’s rejection in light of Appellant’s arguments the Examiner erred. We disagree with Appellant’s conclusions with respect to the obviousness rejection of claims 36–44, 46–52, 54, and 56–58, and we adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the

reasons and rebuttals set forth by the Examiner in the Examiner's Answer in response to Appellant's Arguments. We highlight and address specific findings and arguments regarding representative claim 36 for emphasis as follows.

Issue (a): Are the Disputed Limitations Taught or Suggested?

Appellant argues against the Examiner's reliance upon Caldwell's teaching by asserting that Caldwell does not teach or suggest:

“an addition of a cookie or an update to the cookie, the update to add information associating the cookie with the targeting channel of the matched entity, the cookie stored in the internet browser of the end-user computer, and including information associating the cookie with the targeting channel of the matched entity, wherein the cookie is utilized by the matched entity to present a targeted advertisement.” Caldwell stores a cookie only for the purpose of user identification and only modifies a cookie upon the request of a user or operator, unlike **matching the matched entity to the end-user tag, and an update to the cookie, the update to add information associating the cookie with the targeting channel of the matched entity** as set forth in claim 36.

Appeal Br. 31.

The Examiner responds by finding

The primary reference of Collins discloses the overall process of targeting advertisements including the contemplation of and the creation (alteration) of cookies (0105). Caldwell discloses a method of synchronizing attributes/applications in a distributed network environment capable of causing an end user browser to transmit to a second server at a specific web address that will result in the addition or modification of a cookie on the end user's system (0075, 0086, and 0091). The use of cookies to target advertisements is further disclosed in additional detail [in] Levkovitz (Abstract, 0361). Beck discloses using cookies

to target (match) channel specific advertising (Abstract, Figures 4 & 5).

Ans. 3.

We are not persuaded by Appellant's argument because Appellant is arguing the references separately. The Examiner cites Caldwell for teaching "in response to matching the matched entity to the end-user tag with the first server, instructing an internet browser of the end-user computer to retrieve content from a web address of the matched entity to facilitate transmission of a request to a second server, the second server located at the web address of the matched entity, the transmitted request to cause at least one of an addition of a cookie or an update to the cookie." Final Act. 9 (citing Caldwell ¶¶ 75, 86, 91).

We are not persuaded because we find Caldwell's cookie data, that verifies the identity of the first client device before permitting access to use of an application (Caldwell ¶ 75), and Caldwell's input device that modifies a cookie (Caldwell ¶ 91), teach or at least suggest the disputed limitation.

Moreover, the Examiner finds Levkovitz, not Caldwell, teaches or at least suggests the disputed limitation "the cookie is utilized by the matched entity to present a targeted advertisement." Final Act. 9. We find Levkovitz's ad serving functions, which call the ad server for a cookie file with information associated with the advertisement, teach or at least suggest the disputed limitation. Levkovitz ¶ 361.

Furthermore, the Examiner finds Beck, not Caldwell, teaches or at least suggests using cookies to match channel specific advertising, i.e., the disputed limitation "wherein the cookie is utilized by the matched entity to present a targeted advertisement." Final Act. 9. We agree with the

Examiner because Beck's targeting program cookies, which flow to the segmented test groups presented with advertising messages, teach or at least suggest the disputed limitation. Final Act. 9; Ans. 3 (citing Beck, Abstr., Figs. 4, 5).

Appellant further contends:

While cookies are described in the Abstract and Para. [0361] of Levkovitz, the content of the cookie is **not** described here. Looking to Para. [0358], Levkovitz describes storing data indicating whether or not a WAP (Wireless Application Protocol) advertisement was already presented on a device. As such, Levkovitz does not teach or suggest an addition of a cookie or an update to the cookie, the update to add information associating the cookie with the targeting channel of the matched entity, the cookie stored in the internet browser of the end-user computer, and including information associating the cookie with the targeting channel of the matched entity, wherein the cookie is utilized by the matched entity to present a targeted advertisement as set forth in Claim 36.

Appeal Br. 31–32.

Appellant also argues Beck does not teach or suggest “an addition of a cookie or an update to the cookie, the update to add information associating the cookie with the targeting channel of the matched entity, the cookie stored in the internet browser of the end-user computer, and including information associating the cookie with the targeting channel of the matched entity, wherein the cookie is utilized by the matched entity to present a targeted advertisement as set forth in Claim 36.” Appeal Br. 32.

As explained above, Appellant continues to argue the Beck and Levkovitz references separately and ignores the Examiner's specific findings for each cited reference.

We are unpersuaded by Appellant's arguments and agree with the Examiner's factual findings and legal conclusions because "one cannot show non-obviousness by attacking references individually where . . . the rejections are based on combinations of references." *In re Keller*, 642 F.2d 413, 426 (CCPA 1981). "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *Id.* at 425. In *KSR*, the Court held "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

Issue 1(b): Does The Examiner Provide a Proper Motivation to Combine?

Appellant argues "the motivations provided in the Office Action failed to support a *prima facie* obviousness based on the Collins/Caldwell/Levkovitz/Beck combination. Appeal Br. 33. Appellant argues "[t]he Office Action alleges that Caldwell "is **capable** [of] causing an end-user browser to transmit to an alternative (second) server at a specific web address/location that will result in the addition or modification of a cookie on the end user's system." (*Final Office Action*, p. 9). Even if this were true (as disputed above), a mere capability of a system **does not** establish predictability." Appeal Br. 33.

We agree with the Examiner's motivation to combine the cited references in the manner suggested because we find the claimed invention is merely a combination of old elements according to known methods. *See*

KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398 (2007). In *KSR*, the Court stated “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416.

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. . . . [A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 417.

To the extent that the Examiner relies on the knowledge of one of ordinary skill in the art to combine the teachings of the references, this practice is consistent with current case law. For example, the Supreme Court explains:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. *See In re Kahn*, 441 F.3d 977, 988 (C.A.Fed.2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning

to support the legal conclusion of obviousness.”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR 550 U.S. at 418.

In this case, the Examiner's conclusions of obviousness are clearly articulated and are based on detailed factual findings that are supported by the references of record. *See* Final Act. 8–10; Ans. 3–4. Thus, we find a preponderance of the evidence supports the Examiner's findings and conclusions.

Moreover, Appellant has not demonstrated that the Examiner's proffered combination of references would have been “uniquely challenging or difficult for one of ordinary skill in the art.” *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418). Nor has Appellant provided objective evidence of secondary considerations which our reviewing court guides “operates as a beneficial check on hindsight.” *Cheese Sys., Inc. v. Tetra Pak Cheese and Powder Sys.*, 725 F.3d 1341, 1352 (Fed. Cir. 2013).

Therefore, based upon the findings above, on this record, we are not persuaded of error in the Examiner’s reliance on the cited prior art combination to teach or suggest the disputed limitations of claim 36, nor do we find error in the Examiner’s resulting legal conclusion of obviousness.

Accordingly, we sustain the Examiner’s obviousness Rejection of independent claim 36, and grouped claims 37–44, 46–52, 54, and 56–58 which fall therewith. *See* Claim Grouping, *supra*.

REPLY BRIEF

To the extent Appellant *may* advance new arguments in the Reply Brief (Reply Br. 2–10) not in response to a shift in the Examiner’s position in the Answer, arguments raised in a Reply Brief that were not raised in the Appeal Brief or are not responsive to arguments raised in the Examiner’s Answer will not be considered except for good cause (*see* 37 C.F.R. § 41.41(b)(2)), which Appellant has not shown.

CONCLUSION

The Examiner did not err with respect to the obviousness rejection of claims 36–44, 46–52, 54, and 56–58 under 35 U.S.C. § 103(a) over the cited prior art combination of record, and we sustain the rejection.

DECISION SUMMARY

Claims Rejected	35 U.S.C §	Basis/References	Affirmed	Reversed
36–44, 46–52, 54, 56–58	103	Obviousness Collins, Caldwell, Levkovitz, Beck	36–44, 46–52, 54, 56–58	

FINALITY AND 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