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Mauriel Kapouytian Woods LLP			SARKER, SANCHIT K	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MATTHEW V. ABBOTT, DAVID ALVARADO,  
JASON B. BRETT, ERIC BUSLER, JASON CAI,  
JEFFREY S. DERNAVICH, and SERGEY TSYMBLER

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Appeal 2019-006653  
Application 15/372,843  
Technology Center 2400

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Before JENNIFER S. BISK, JASON J. CHUNG, and  
DAVID J. CUTITTA II, *Administrative Patent Judges*.

CUTITTA, *Administrative Patent Judge*.

DECISION ON APPEAL  
STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner’s decision to reject claims 1, 2, and 4–21, all of the claims under consideration. We have jurisdiction under 35 U.S.C. § 6(b). Oral arguments were heard on August 27, 2020. A transcript of that hearing will be added to the record in due time.

We REVERSE.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies International Business Machines Corporation as the real party in interest. Appeal Br. 2.

## CLAIMED SUBJECT MATTER

Appellant's claimed subject matter relates to automatically suspending electronic communications to a user for a period if a magnitude of user sales does not exceed a threshold. Spec. ¶ 34.<sup>2</sup> According to Appellant, the electronic communications may include "advertisements, fliers, mailings . . . and/or other types of marketing materials to announce sales and promote the sale of items." Spec. ¶ 2.

Claims 1, 4, and 14 are independent. Independent claim 1 is reproduced below, with certain limitations at issue emphasized, and is illustrative of the claimed subject matter:

1. A non-transitory computer-readable medium embodying a program executable in a computing device, comprising:

*code configured to receive a first request to suspend transmission of electronic communications to a recipient during a suspension period, wherein the first request is associated with a recipient identifier (ID) and is received in response to a determination to suspend transmission, wherein the determination to suspend transmission is based at least in part on a magnitude of sales to the recipient that is associated with a previous transmission of electronic communications to the recipient, and wherein the sales include transactions initiated from the previous transmission of electronic communications to the recipient;*

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<sup>2</sup> Throughout this Decision we refer to: (1) Appellant's Specification filed December 8, 2016 ("Spec."); (2) the Final Office Action ("Final Act.") mailed October 5, 2018; (3) the Appeal Brief filed April 8, 2019 ("Appeal Br."); and (4) the Examiner's Answer ("Ans.") mailed July 9, 2019; and (5) the Reply Brief filed September 9, 2019 ("Reply Br.").

code configured to associate the recipient ID with a suspension state in response to receiving the first request to suspend transmission of the electronic communications;

code configured to receive a second request to transmit an electronic communication to the recipient; and

code configured to prevent transmitting the electronic communication to the recipient during the suspension period based on the association of the recipient ID with the suspension state.

Appeal Br. 21 (Claims Appendix).

#### REFERENCES

The references<sup>3</sup> relied upon by the Examiner are:

Name	Reference	Date
Bhargava et al.	US 2003/0204568 A1	Oct. 30, 2003
Becker	US 2003/0233413 A1	Dec. 18, 2003
Ahopelto et al.	US 2010/0291953 A1	Nov. 18, 2010
Packer	US 2012/0143692 A1	June 7, 2012

#### REJECTIONS

The Examiner rejects claims 1, 2, 4, 6, 8–10, 14, 15, 18, 19, and 21 under 35 U.S.C. § 103 as unpatentable over Becker and Packer. Final Act. 12–22.

The Examiner rejects claims 5, 7, 11–13, 16, and 17 under 35 U.S.C. § 103 as unpatentable over Becker, Packer, and Ahopelto. *Id.* at 23–28.

The Examiner rejects claim 20 under 35 U.S.C. § 103 as unpatentable over Becker, Packer, and Bhargava. *Id.* at 28–29.

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<sup>3</sup> All citations to the references use the first-named inventor or author only.

OPINION

We review the appealed rejections for error based upon the issues identified by Appellant and in light of Appellant's arguments and evidence. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv)(2017).

Independent claim 1 recites, in part, code configured to receive a first request to suspend transmission of electronic communications, "wherein the first request . . . is received in response to a determination to suspend transmission, wherein the determination to suspend transmission is based at least in part on a magnitude of sales to the recipient that is associated with a previous transmission of electronic communications to the recipient." The Examiner notes "Becker does not explicitly disclose wherein the determination to suspend transmission is based at least in part on a magnitude of sales to the recipient that is associated with a previous transmission of electronic communications to the recipient . . . ." Final Act. 14. The Examiner relies on Packer's discussion of "a consumer interface to limit the quantity of advertisements received" to teach or suggest the limitation at issue. *Id.* (citing Packer ¶¶ 33, 45, 62, 63, 67).

Appellant argues that "Packer merely discusses a consumer interface through which consumers may be targeted for advertisements and/or may manually opt out of advertisements" but "does not disclose suspending transmission of advertising messages that is based on a magnitude of sales to the recipient." Appeal Br. 13 (emphasis omitted).

Appellant's argument is persuasive. Claim 1 requires that the determination to suspend transmission of electronic communications is based on a magnitude of sales to the recipient. The Examiner, however,

does not show sufficiently where Packer or Becker teaches or suggests calculating a magnitude of sales, let alone using a magnitude of sales to the recipient in connection with a determination to suspend transmission of electronic communications to the recipient.

The Examiner explains that “Packer shows sharing money, generation of money, receiving payments and incentive[s] based on advertisements that are relative to money that related to sale[s]” and that “Packer further teaches that consumer interface[s] also track account information.” Ans. 4 (citing Packer ¶¶ 63, 67, 68).

Even so, Packer is silent regarding determining a magnitude of sales to a recipient. Consequently, although Packer describes that a consumer may be able to “block an advertiser” (¶ 63), “use consumer interface 207 to limit the quantity of advertisements received” (¶ 61), or use scheduler 213 to place restrictions on advertisements (¶¶ 67, 68), the Examiner does not show how Packer teaches or suggests suspending advertisements to a recipient based on a magnitude of sales to the recipient (Reply Br. 4).

Accordingly, we find persuasive Appellant’s argument that the Examiner has not demonstrated sufficiently that the combination of Packer and Becker teaches or suggests suspending transmission of electronic communications to a recipient based at least in part on a magnitude of sales to the recipient, as recited in claim 1.

Because we agree with at least one of the dispositive arguments advanced by Appellant for claim 1, we need not reach the merits of Appellant’s other arguments. Accordingly, based on the record before us, we do not sustain the Examiner’s 35 U.S.C. § 103 rejection of independent claim 1. We also reverse the rejection of independent claims 4 and 14,

which recite commensurate limitations, and of dependent claims 2, 6, 8–10, 18, 19, and 21, for similar reasons.

With respect to the remaining obviousness rejections of claim 5, 7, 11–13, 16, 17, and 20, the Examiner does not rely on the additionally cited references, Ahopelto or Bhargava, to cure the deficiency noted for claim 1. Accordingly, we do not sustain these obviousness rejections for the reasons set forth above for claim 1.

### CONCLUSION

We reverse the Examiner’s rejections of claims 1, 2, and 4–21 under 35 U.S.C. § 103.

### DECISION SUMMARY

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 2, 4, 6, 8–10, 14, 15, 18, 19, 21	103	Becker, Packer		1, 2, 4, 6, 8–10, 14, 15, 18, 19, 21
5, 7, 11–13, 16, 17	103	Becker, Packer, Ahopelto		5, 7, 11–13, 16, 17
20		Becker, Packer, Bhargava		20
<b>Overall Outcome</b>				1, 2, 4–21

REVERSED