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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GEOFF BAUM and WALTER CHANG

Appeal 2020-000257
Application 13/039,266
Technology Center 3600

Before ERIC S. FRAHM, LARRY J. HUME, and
LINZY T. MCCARTNEY, *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 1, 3–4, 22–26, 28–33, and 35–40, which are all rejections pending in the application. Appellant has canceled claims 2, 5–21, 27, and 34. *See* Appeal Br. 50 *et seq.* We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ 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. 2.

STATEMENT OF THE CASE²

The claims are directed to a persistent metadata for a user-controlled policy of personal data disclosure and usage for online advertising. *See* Spec. (Title). In particular, Appellant’s disclosed embodiments and claimed invention “generally relate[] to advertising [and m]ore particularly, the disclosure relates to a user-controlled policy for advertising.” Spec. ¶ 2.

Exemplary Claim

Claim 1, reproduced below, is representative of the subject matter on Appeal (*emphasis* added to limitations contested for lack of written description support):

1. A computer-readable storage memory device for protecting user information of users to which micro-segmented electronic offers are targeted, the computer-readable storage memory comprising a compliance module stored as instructions that are executable and, responsive to execution of the instructions by a computing device, the computing device performs operations of the compliance module comprising to:

receive the user information and a user policy from a client device of a user by the computing device, the user policy defined according to user input received via the client device and indicating a type of offer that the user is interested in receiving from a plurality of offers, the user policy further defining user policy criteria for disclosure of the user information and a price, the user policy criteria for disclosure comprising permission to receive offers that are micro-segmented, and the price defined according to the user input

² Our decision relies upon Appellant’s Appeal Brief (“Appeal Br.,” filed Feb. 28, 2019); Reply Brief (“Reply Br.,” filed Oct. 14, 2019); Examiner’s Answer (“Ans.,” mailed Aug. 27, 2019); Final Office Action (“Final Act.,” mailed Oct. 11, 2018); and the original Specification (“Spec.,” filed Mar. 2, 2011).

received via the client device indicating the price that the user will be paid for the disclosure of the user information;

generate metadata for communication to a micro-segmentation system, the metadata persisting the received user policy and the user policy criteria;

store the user information and the generated metadata associated with the user in a computer store of the computing device;

communicate the user information and the metadata that is associated with the user from the computing device to the micro-segmentation system that protects the user information with a digital rights management system that implements the user-defined policy to protect the user information;

based on the micro-segmentation system determining with a natural language processing (NLP) technique that the user information matches a set of key discriminating features of a micro-segment targeted by a campaign, receive the offer for the user over the network from the micro-segmentation system by the computing device, the offer including offer data that indicates a description of offer content and an offer criterion indicating the micro-segment, the set of key discriminating features including a size of the micro-segment;

compare the offer criterion to the user policy criteria, by the computing device, to validate that the offer criterion complies with the user policy criteria in the persisted metadata from the computer store; and

communicate the received offer by the computing device, to the client device of the user based on the validation that the offer criterion complies with the user policy criteria in the persisted metadata from the computer store.

REJECTION³

Claims 1, 3, 4, 22–26, 28–33, and 35–40 stand rejected under pre-AIA 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Final Act. 8.⁴

CLAIM GROUPING

Based on Appellant’s arguments (Appeal Br. 14–17) and our discretion under 37 C.F.R. § 41.37(c)(1)(iv), we decide the appeal of the written-description rejection of claims 1, 3, 4, 22–26, 28–33, and 35–40 on the basis of representative claim 1.⁵

ISSUE

Appellant argues (Appeal Br. 14–17; Reply Br. 2–7) the Examiner’s rejection of claim 1 under 35 U.S.C. § 112, first paragraph, as lacking written description support, is in error. These contentions present us with the following issue:

³ The Examiner withdrew the § 101 subject matter eligibility rejection and the § 103 obviousness rejection of claims 1, 3, 4, 22–26, 28–33, and 35–40. Ans.

⁴ Although the Examiner provides alternative bases for rejection under pre-AIA and AIA statutes (Final Act. 8), based upon the filing date of March 2, 2011, this application falls under pre-AIA provisions of Title 35 U.S.C.

⁵ “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).

Did the Examiner err in finding limitation of “based on the micro-segmentation system determining with a natural language processing (NLP) technique that the user information matches a set of key discriminating features of a microsegment targeted by a campaign, receive the offer for the user over the network from the micro-segmentation system by the computing device,” as recited in claim 1, lacks written description support?

PRINCIPLES OF LAW

The test for compliance with the written description requirement is “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (*en banc*). “[T]he level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Id.*; *cf. U.S. v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988) (“The test of *enablement* is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.”).

However, “actual ‘possession’ or reduction to practice outside of the specification is not enough. Rather, . . . it is the specification itself that must demonstrate possession.” *Ariad*, 598 F.3d at 1352; *see also PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306-07 (Fed.Cir.2008) (explaining that § 112, first paragraph, “requires that the written description actually or inherently disclose the claim element”). “[I]t is not a question of

whether one skilled in the art might be able to construct the patentee's device from the teachings of the disclosure. . . . Rather, it is a question whether the application necessarily discloses that particular device. . . . A description which renders obvious the invention for which an earlier filing date is sought is not sufficient." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (quoting *Jepson v. Coleman*, 314 F.2d 533, 536 (CCPA 1963)).

ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellant. 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 disagree with Appellant's arguments with respect to claims 1, 3, 4, 22–26, 28–33, and 35–40 and, unless otherwise noted, we incorporate by reference herein and 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 in the Examiner's Answer in response to Appellant's arguments. We highlight and address specific findings and arguments regarding claim 1 for emphasis as follows.

The Examiner finds the Specification does not clearly describe the limitation "based on the micro-segmentation system *determining with a natural language processing (NLP) technique* that the user information matches a set of key discriminating features of a micro-segment targeted by a campaign." Final Act. 8 (emphasis added).

Appellant contends the Specification in paragraphs 28 through 30 provides “*at least implicit support, if not express support*” for the disputed limitation of claim 1. Appeal Br. 14. In particular, Appellant argues “[i]n relation to ‘incrementally and continuously’ updating ‘memberships within micro-segments,’ the specification at ¶[0028] describes that ‘intentional semantics may be automatically ***detected and extracted utilizing behavioral and natural language processing*** (“NLP”) information.” Appeal Br. 15.

The full text of paragraph 28 of the Specification reads as follows:

Further, membership within micro-segments may be incrementally and continuously updated within micro-segments. In addition, *intentional semantics may be automatically detected and extracted utilizing behavioral and natural language processing (“NLP”) information.*

Spec. ¶ 28 (emphasis added). This is the only mention of NLP processing in the Specification.

In response, the Examiner finds:

The term “natural language processing” is recited once in Appellants’ specification. Appellants refer to the one recitation in their argument (App. Br. 15). Particularly, Appellants’ specification discloses “intentional semantics may be automatically detected and extracted utilizing behavioral and natural language processing (‘NLP’) information” (Spec. [0028]).

First, the Examiner notes that while the above disclosure mentions “natural language processing [] *information*” (emphasis added) there is no mention of a “natural language processing (NLP) *technique*” (emphasis added), as recited by the claims. On this basis alone, the claims contain new matter in the form of a “[NLP] technique” found nowhere in Appellants’ 16 original disclosure, and therefore the new matter rejection should be sustained.

Second, as discussed in further detail below, the Examiner notes that the function associated with NLP as discussed in Appellants' specification is not the function associated with NLP as recited by the claims, which again results in the claims containing new matter.

Particularly, the function associated with NLP as discussed in Appellants' specification is "automatically detect[ing] and extract[ing]" "intentional semantics" (Spec. id.), where the function is performed by "utilizing behavioral and natural language processing ('NLP') *information*" (Spec. id.; emphasis added). This is not the function added to the claims via amendment.

Ans. 3–4.

Thus, the distinction the Examiner draws is between use of NLP information, and techniques to obtain that information for application in a particular situation, i.e., the Specification only identifies and supports use of behavioral and NLP information *to automatically detect and extract intentional semantics* while, in contrast, the claim recites conditionally "receiv[ing] the offer for the user over the network from the micro-segmentation system by the computing device" in response to "*determining with a natural language processing (NLP) technique that the user information matches a set of key discriminating features of a microsegment targeted by a campaign,*" as recited in claim 1 (emphasis added), and as similarly recited in each of independent claims 24 and 31. We see no explicit or implicit disclosure of using NLP information for matching purposes.

Appellant responds by alleging:

Appellant submits that the capability to perform natural language processing to produce information certainly supports use and/or possession of a "natural language processing (NLP)

technique,” as claimed. Appellant also submits that use of the term “technique,” rather than simply reciting “natural language processing (NLP),” is not an addition of new subject matter as alleged by the Examiner. The Examiner also alleges that the claims contain new matter because the function associated with NLP, as discussed in Appellant’s specification, is not the function recited by the claims (Examiner’s Answer, p. 3). Appellant submits that the claimed feature is not new matter as alleged by the Examiner

Reply Br. 3.

Thus, Appellant argues that the use of NLP *information* necessarily (and implicitly) supports disclosure of a *technique* for determining or obtaining such NLP information. However, Appellant does not cite to any disclosure of actually using a NLP technique (or NLP information) to carry out the functions claimed, in particular, the function of “determining . . . that the user information matches a set of key discriminating features of a microsegment targeted by a campaign,” as recited in claim 1.

We are not persuaded by Appellant’s argument, and agree with the Examiner’s finding that the Specification’s disclosure of using behavioral and NLP information to “detect and extract intentional semantics” does not provide sufficient explicit or implicit support for the conditional recitation of “based on the micro-segmentation system determining with a natural language processing (NLP) technique,” “receiv[ing] the offer for the user” in response to determining that “the user information matches a set of key discriminating features of a microsegment targeted by a campaign,” as recited in claim 1. *See Ans. 2 et seq.*

We agree with the Examiner because we see no support in the originally-filed Specification for using NLP information or techniques to perform the recited matching function.

Therefore, based upon the findings above, on this record, we are not persuaded of error in the Examiner's factual findings in support of a determination that the disputed limitation lacks written description support.

Accordingly, we sustain the Examiner's written description rejection of independent claim 1, and grouped claims 3–4, 22–26, 28–33, and 35–40 which fall therewith. *See Claim Grouping, supra.*

REPLY BRIEF

To the extent Appellant *may* advance new arguments in the Reply Brief (Reply Br. 2–7) 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.

CONCLUSION⁶

The Examiner did not err with respect to the written description rejection of claims 1, 3, 4, 22–26, 28–33, and 35–40 under pre-AIA 35 U.S.C. § 112, first paragraph, and we sustain the rejection.

⁶ In the event of further prosecution, we invite the Examiner's reconsideration of the subject matter eligibility of the claims under the USPTO's Revised Guidance concerning the application of § 101. *See 2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (January 7, 2019) ("Revised Guidance") (<https://www.govinfo.gov/content/>

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Basis / References	Affirmed	Reversed
1, 3, 4, 22–26, 28–33, 35–40	§ 112, ¶ 1 (pre-AIA),	Written Description	1, 3, 4, 22–26, 28–33, 35–40	

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

pkg/FR-2019-01-07/pdf/2018-28282.pdf). All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.” *Id.* at 51; *see also* October 2019 Update at 1 (*October 2019 Update: Subject Matter Eligibility*). Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* Manual of Patent Examining Procedure (MPEP) § 1213.02.