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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN S. PENBERTHY, SIMON A ASSAAD,
DAVID V. CARSON, and BRADLEY G. JOHNSON

Appeal 2020-001335
Application 13/584,154
Technology Center 3600

Before ERIC S. FRAHM, KALYAN K. DESHPANDE, and
CATHERINE SHIANG, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 21–23, 25, 29–32, 34–38, 40, 42–44, 46–50, 52, 54–56, and 58, which are all the claims pending and rejected in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ We use “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Nytell Software LLC as the real party in interest. Appeal Br. 3.

STATEMENT OF THE CASE

Introduction

The present invention relates to “a method and system for selecting and delivering media content, such as video content and advertisements, via a packet based network such as the internet.” Spec. ¶ 2. In particular,

[t]he present invention . . . select[s] portions of content, and media content sets to be delivered over a packet based . . . network. The selected portions of content . . . may be keywords such as a word or a group of words. . . . the present invention provides a heuristic model employing a piece-wise linear optimization function to select keywords and the media content sets for delivery by a media delivery provider.

Spec. ¶ 9. Claim 32 is exemplary:

32. A method comprising:

determining, by a first computing device, a plurality of values for a plurality of keywords of a web page, wherein each of the plurality of values is based on a combination of variables including location, local time, and content being viewed;

receiving, by the first computing device from a second computing device, a request for identification of the plurality of keywords of the web page;

receiving, by the first computing device from the second computing device, data associated with the second computing device;

determining, by the first computing device, a location of the second computing device, a local time at the second computing device, and content being viewed at the second computing device based on the data associated with the second computing device;

selecting, by the first computing device, a value from among the plurality of values for the plurality of keywords that corresponds to the location of the second computing device, the local time at the second computing device, and the content being viewed at the second computing device;

determining, by the first computing device, that the value meets a criterion;

responsive to determining that the selected value meets the criterion, selecting, by the first computing device, a keyword associated with the selected value;

determining, by the first computing device, keyword identifying information based on the value and the keyword, wherein the keyword identifying information comprises a link that, when activated, causes a request for selected video content to be generated;

transmitting, by the first computing device to the second computing device, the keyword identifying information;

receiving the request for the selected video content to be generated; and presenting the selected video content to the second computing device for display in a video player having an interactive video skin displayed along at least a portion of a periphery of the video player, the interactive video skin comprising a hyperlink configured to be actuated by a user and one or more form elements configured to receive input from the user.

References and Rejections²

Claims Rejected	35 U.S.C. §	References
32, 34, 35, 46, 47, 58	103	Henkin (US 2010/0138452 A1, published June 3, 2010), Agarwal (US 2005/0076014 A1, published Apr. 7, 2005), Knight (US 2008/0320512 A1, published Dec. 25, 2008).

² Throughout this opinion, we refer to the (1) Final Office Action dated Nov. 20, 2018 (“Final Act.”); (2) Appeal Brief dated July 16, 2019 (“Appeal Br.”); (3) Examiner’s Answer dated Oct. 11, 2019 (“Ans.”); and (4) Reply Brief dated Dec. 9, 2019 (“Reply Br.”).

21, 22, 25, 29–31, 36, 37, 40, 42–44, 48, 49, 52, 54–56	103	Henkin, Agarwal, Knight, Ramer (US 2007/0061198 A1, published Mar. 15, 2007)
23, 38, 50	103	Henkin, Agarwal, Knight, Ramer, Campbell (US 2008/0243822 A1, published Oct. 2, 2008)

ANALYSIS³

We have reviewed the Examiner’s rejection in light of Appellant’s contentions and the evidence of record. We concur with Appellant’s contention that the Examiner erred in this case.

“[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.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007); *see also Metalcraft of Mayville, Inc., v. The Toro Co.*, 848 F.3d 1358, 1367 (2017) (Fed. Cir. 2017) (“Without any explanation as to . . . why the references would be combined to arrive at the claimed invention, we are left with only hindsight bias that *KSR* warns against. . . . [W]e cannot allow hindsight bias to be the thread that stitches together prior art patches into something that is the claimed invention.”).

Further, the USPTO “must examine the relevant data and articulate a satisfactory explanation for its action including a rational connection between the facts found and the choice made” and that articulation requirement “appl[ies] with equal force to the motivation to combine

³ Appellant raises additional arguments. Because the identified issue is dispositive of the appeal, we do not address the additional arguments.

analysis.” *In re Nuvasive, Inc.*, 842 F.3d 1376, 1382–83 (Fed. Cir. 2016). When “motivation to combine . . . is disputed,” USPTO “must articulate a *reason why* a PHOSITA would combine the prior art references.” *Id.*

The Examiner cites the combination of Henkin and Agarwal for teaching the “determining” and “selecting” limitations of independent claim 32. *See* Final Act. 14–17. The Examiner concludes:

it would have been obvious to one of ordinary skill in the art at the time of the invention to combine or modify the valuation of Henkin with the factors of Agarwal *in order to determine and select value(s) based on location, local time, content being viewed.*

The rationale for combining in this manner is that using determining and selecting value(s) based on location, local time, content being viewed *is applying a known technique to a known device, method or product to yield predictable results* as explained above.

Final Act. 17 (emphases added).

“[M]odifying Henkin in view of Agarwal . . . would be the use of the claimed variables or factors as taught by Agarwal and combined into Henkin *per the stated rationale.*” Ans. 9 (emphasis added).

We agree with Appellant that the Examiner has not provided the requisite rationale for combining the teachings of Henkin and Agarwal. *See* Appeal Br. 20; Reply Br. 3–6. In particular, the Examiner’s assertion that “it would have been obvious to one of ordinary skill in the art at the time of the invention to combine or modify the valuation of Henkin with the factors of Agarwal *in order to determine and select value(s) based on location, local time, content being viewed*” (Final Act. 17 (emphasis added)) is inadequate, because the Examiner’s rationale merely paraphrases a portion of the

disputed limitations. *See KSR*, 550 U.S. at 418. That is, the Examiner’s rationale to combine is merely to achieve the claim language, without setting forth a *reason* why one skilled in the art would have made the modification or combination.

Nor is the Examiner’s statement that the “rationale for combining in this manner is that using determining and selecting value(s) based on location, local time, content being viewed is *applying a known technique to a known device, method or product to yield predictable results* as explained above” (Final Act. 17 (emphasis added)) adequate, because the Examiner’s reasoning does not “articulate a *reason why* a PHOSITA would combine the prior art references.” *See Nuvasive*, 842 F.3d at 1382. As a result, the Examiner has not provided “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” as required by *KSR*. *See KSR*, 550 U.S. at 418.

Because the Examiner fails to provide sufficient support for the legal conclusion of obviousness, we are constrained by the record to reverse the Examiner’s rejection of claim 32. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (we will not resort to speculation or assumptions to cure deficiencies in the Examiner’s fact finding or reasoning).⁴

⁴ If prosecution reopens, we recommend the Examiner consider whether one skilled in the art would have modified Henkin’s method to incorporate Agarwal’s features in order to customize content delivery based on, among other things, location and local time associated with the user computing device. Such customization would create the benefit of delivering more targeted and effective content to the user. *See KSR*, 550 U.S. at 424 (“[t]he proper question to have asked was whether a . . . designer of ordinary skill . . . would have seen a benefit to upgrading Asano with a [feature from the secondary reference]”).

For each of independent claims 35 and 47, the Examiner cites the same reasoning (discussed above for claim 32) for the legal conclusion of obviousness. *See* Final Act. 17, 19. Therefore, for similar reasons, we are constrained by the record to reverse the Examiner’s rejection of independent claims 35 and 47.

We also reverse the Examiner’s rejection of corresponding dependent claims 21–23, 25, 29–31, 34, 36–38, 40, 42–44, 46, 48–50, 52, 54–56, and 58.

CONCLUSION

We reverse the Examiner’s decision rejecting claims 21–23, 25, 29–32, 34–38, 40, 42–44, 46–50, 52, 54–56, and 58 under 35 U.S.C. § 103.

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
32, 34, 35, 46, 47, 58	103	Henkin, Agarwal, Knight		32, 34, 35, 46, 47, 58
21, 22, 25, 29–31, 36, 37, 40, 42–44, 48, 49, 52, 54–56	103	Henkin, Agarwal, Knight, Ramer		21, 22, 25, 29–31, 36, 37, 40, 42–44, 48, 49, 52, 54–56
23, 38, 50	103	Henkin, Agarwal, Knight, Ramer, Campbell		23, 38, 50
Overall Outcome				21–23, 25, 29–32, 34–38, 40, 42–44, 46–50, 52, 54–56, 58

REVERSED