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Table with columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
Row 1: 14/180,494, 02/14/2014, Canhui Ou, 2006-A0450Con\_7785-137-2, 1471
Row 2: 92384, 7590, 10/07/2020, AT&T Legal Department - G&G, Attention: Patent Docketing, Room 2A-212, One AT&T Way, Bedminster, NJ 07921, EXAMINER ROJAS, HAJIME S
Row 3: ART UNIT 3681, PAPER NUMBER
Row 4: NOTIFICATION DATE 10/07/2020, DELIVERY MODE ELECTRONIC

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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* CANHUI OU, J. BRADLEY BRIDGES,  
CHARLES ROBERT KALMANEK JR., RAGHVENDRA SAVOOR,  
ALBERT GORDON GREENBERG, STEVE SPOSATO, ZHI LI,  
JEROLD DAIZO OSATO, ALEXANDRE GERBER,  
OLIVER SPATSCHECK, and SUN-UK PARK

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Appeal 2020-001622  
Application 14/180,494  
Technology Center 3600

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Before ANTON W. FETTING, HUBERT C. LORIN, and  
NINA L. MEDLOCK, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

## CLAIMED INVENTION

The claimed invention “relates generally to communication services and more specifically to a method and apparatus for presenting advertisements” (Spec. ¶2).

Claims 1, 10, and 18 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A non-transitory computer-readable storage device, comprising computer instructions which, responsive to being executed by a processor operated by a first entity, cause the processor to perform operations comprising:

receiving search criteria from an advertisement hardware computing device, wherein the search criteria comprises a first search term, wherein the advertising hardware computing device provides the search criteria responsive to receiving an advertising request via Internet from a publisher device in response to an end user device of an end user visiting a website operated by a publisher hardware computing device, wherein the advertisement hardware computing device is operated by a second entity different from the first entity, and wherein the publisher hardware computing device is operated by a third entity different from the first entity;

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<sup>1</sup> We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Our decision references Appellant’s Appeal Brief (“Appeal Br.,” filed September 4, 2019) and Reply Brief (“Reply Br.,” filed December 30, 2019), and the Examiner’s Answer (“Ans.,” mailed October 31, 2019), and Final Office Action (“Final Act.,” mailed March 18, 2019). Appellant identifies AT&T Intellectual Property I, LP as the real party in interest (Appeal Br. 3).

monitoring packet communications associated with communication services provided by the first entity to an end user device, wherein the monitoring comprises:

searching for the first search term, via packet analysis, in a first plurality of packet headers associated with first packet traffic of the end user device, wherein the first packet traffic is associated with a first layer of an Open Systems Interconnection (OSI) model;

determining demographic and psychographic information associated with the end user device based on the monitoring of the packet traffic;

determining a behavioral profile for the end user device based on the demographic and psychographic information; and

submitting the behavioral profile over a network to the advertisement hardware computing device, wherein the advertisement hardware computing device determines targeted advertising according to the behavior profile and a publisher profile of the website visited by the end user device.

## REJECTION<sup>2</sup>

Claims 1–12 and 14–19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Jha et al. (US 2005/0033641 A1, published Feb. 10, 2005) (“Jha”) and Roker (US 2008/0040224 A1, published Feb. 14, 2008).

## ANALYSIS

### *Independent Claim 1 and Dependent Claims 2–9*

In rejecting claim 1 under 35 U.S.C. § 103(a), the Examiner cited Jha as disclosing substantially all of the claim elements (Final Act. 7–8). But, the Examiner acknowledged that Jha does explicitly disclose “monitoring

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<sup>2</sup> The Examiner has withdrawn the rejections of claims 1–20 under 35 U.S.C. §§ 101 and 112 (Ans. 4).

packet communications associated with communication services provided by the first entity to an end user device,” as called for in claim 1 (*id.* at 8–9). The Examiner cited Roker to cure the deficiency of Jha (*id.* at 9–10). And the Examiner concluded that it would have been obvious to a person of ordinary skill in the art at the time of Appellant’s invention to “modify the advertising delivery of Jha to include a packet inspection device, as taught by Rokker [sic] to better target advertisements” (*id.* at 10).

Appellant acknowledges that the cited portions of Jha describe “enabling use of a search referral query and/or past search referral queries to target advertisements on web sites” and that “[t]he ad targeting may be done by [a] publisher, advertiser, or third party, such as an ad serving network” (Appeal Br. 32). Appellant also acknowledges that “Jha further describes transmitting a response to a request from [a] browser application, where the response may include an ad script that may generate an ad request targeting on or more advertisements based on ad parameters in the request” and that “[t]he request may include a selection from a set of search results generated by a search engine in response to a search query” (*id.*). But, Appellant argues the rejection of claim 1 can nonetheless not be sustained because neither Jha nor Roker discloses or suggests “wherein the advertisement hardware computing device is operated by a second entity different from the first entity, and wherein the publisher hardware computing device is operated by a third entity different from the first entity,” as recited in claim 1 (*id.* at 27–38).

Appellant’s argument is not persuasive at least because the features that Appellant argues are not disclosed in the cited references constitute non-functional descriptive material that may not be relied on for patentability.

The Federal Circuit has long held that where a limitation claims printed matter that is not functionally or structurally related to its physical substrate, the printed matter may not be relied on to distinguish over the prior art for purposes of patentability. *See, e.g., In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). The rationale underlying the “printed matter” cases also has been extended to the analysis of the patentability of method claims. *King Pharms. Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1278–79 (Fed. Cir. 2010) (applying the “printed matter” reasoning to method claims containing an “informing” step that could be either printed or verbal instructions).

In this case, the relevant question is whether the recitation that “the advertisement hardware computing device is operated by a second entity different from the first entity, and . . . the publisher hardware computing device is operated by a third entity different from the first entity” has a “new and unobvious functional relationship” with the method. *Id.* at 1279. And, there is no objective evidence of record that it does.

Simply put, there is no evidence of record that the fact that the entity operating the advertisement hardware computing device is a second entity different from the first entity, and that the entity operating the publisher hardware computing device is a third entity different from the first entity, affects the function of the claimed method in any way. Regardless of the identity of the entity operating the advertisement hardware computing device or operating the publisher hardware computing device, the underlying method is the same. As such, the identity of the operator, i.e., the recitation

that “the advertisement hardware computing device is operated by a second entity different from the first entity, and . . . the publisher hardware computing device is operated by a third entity different from the first entity,” constitutes non-functional descriptive material that may not be relied on for patentability. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004).

We also are not persuaded by Appellant’s further argument that the rejection of claim 1 cannot be sustained because Roker teaches away from the modification required to meet the claim language (Appeal Br. 38–40).

Appellant observes that “Roker summarizes the purported novelty of its own system as ‘eliminating the need for third-party intervention’ in order to maintain confidentiality of user information” (Appeal Br. 38–39 (citing Roker ¶ 20)) and also “expressly states that the purpose of its system is to NOT disclose user information to the advertisers” (*id.* at 39 (citing Roker ¶ 18)). Therefore, according to Appellant, the rejection of claim 1 cannot be sustained because “[i]n order to support the recited features [of claim 1, i.e., specifically including “submitting the behavioral profile over a network to the advertisement hardware computing device,”] Roker must be modified so that the Internet service provider device of the first entity shares behavioral data with the advertising device of the second entity” (*id.* at 38) — a modification directly contrary to Roker’s stated objective of not providing behavioral or user information to advertisers (*id.* at 40).

There is no dispute that Roker expressly contemplates that the personal information of its system users be held by a trusted source and not disclosed to advertisers. Yet, Appellant’s argument is not persuasive because, as the Examiner points out, “Roker is used to show teachings of

packet monitoring, and Jha does not teach away [from] using packet monitoring to target advertising” (Ans. 5).

We are not persuaded, on the present record, that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 103(a). Therefore, we sustain the Examiner’s rejection of claim 1. We also sustain the rejection of dependent claims 2–9, which are not argued separately.<sup>3</sup>

*Independent Claims 10 and 18 and Dependent Claims 11–17, 19, and 20*

Appellant’s arguments with respect to independent claims 10 and 18 (Appeal Br. 41–46) are substantially similar to Appellant’s arguments with respect to claim 1, and are similarly unpersuasive. Therefore, we sustain the Examiner’s rejection under 35 U.S.C. § 103(a) of independent claims 10 and 18 for the same reasons set forth above with respect to claim 1. We also

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<sup>3</sup> Appellant further references this Board’s September 5, 2013 decision in “Appeal No. 20111-010770 of U.S. Application Serial No. 12/418,430 (a divisional application of the present application)”; Appellant notes that Board there reversed the rejection of the pending claims based on Roker and specifically points to the Board’s statement that “there is nothing in any of the cited paragraphs [ of Roker], on which the Examiner relies, that discloses that a behavioral profile is submitted to an ‘advertisement element [that] is operated by a second entity different from the first entity’” (Appeal Br. 40–41). To the extent Appellant maintains that the Board’s September 2013 reversal of a rejection under 35 U.S.C. § 102 based on Roker is controlling here, we note that what a different panel did in a different situation under a different set of facts has little bearing on the proper disposition of this case. The September 5, 2013 also is a non-precedential decision of the Board; therefore, it is not binding on this panel. That notwithstanding, the Board’s finding in the 2013 decision seemingly is consistent with Appellant’s position that Roker does not disclose submitting user information, e.g., a behavioral profile, to advertisers, which is not disputed here.

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sustain the rejection of dependent claims 11–17, 19, and 20, which are not argued separately.

### CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/ Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–12, 14–19	103(a)	Jha, Roker	1–12, 14–19	

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

**AFFIRMED**