UNITED STATES PATENT AND TRADEMARK OFFICE

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14/737,300	06/11/2015	Xin Jiang	16113-6550001	4727

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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 XIN JIANG and TUNA TOKSOZ

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Appeal 2020-002519
Application 14/737,300
Technology Center 3600

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Before KARA L. SZPONDOWSKI, SCOTT B. HOWARD, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant[1] seeks our review under 35 U.S.C. § 134(a) from a final
rejection of claims 1–5 and 10–23, i.e., all pending claims. We have
jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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[1] We use the word "Appellant" to refer to "applicant" as defined in
37 C.F.R. § 1.42 (2019). Appellant identifies the real party in interest
as Google LLC. Appeal Br. 1.

STATEMENT OF THE CASE

The Invention

According to the Specification, the invention concerns "information presentation." Spec. ¶ 1.[2] The Specification explains that "a web page can include slots in which content," such as advertisements, "can be presented" along with resources, such as "search results." *Id.* ¶ 2. "Slots can be allocated to content sponsors through a reservation system or an auction." *Id.* ¶ 3. Specifically, "slots can be allocated to sponsors according . . . to their bids and/or the relevance of the sponsored content to content presented on a page hosting the slot or a request that is received for the sponsored content." *Id.* The invention endeavors to allow a sponsor to "bid for a re-engagement opportunity for a user on a user device after the user has installed the application on the user device." *Id.* ¶ 8. "A re-engagement content item presented on a user device can be customized for a user based on information associated with the user and an application installed on the user device." *Id.*

Exemplary Claim

Independent claim 1 exemplifies the claims at issue and reads as follows (with formatting added for clarity):

    1. A method comprising:

    identifying a first application that is installed on a user device;

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[2] This decision uses the following abbreviations: "Spec." for the Specification, filed June 11, 2015; "Final Act." for the Final Office Action, mailed April 16, 2019; "Appeal Br." for the Appeal Brief, filed August 20, 2019; "Ans." for the Examiner's Answer, mailed December 12, 2019; and "Reply Br." for the Reply Brief, filed February 6, 2020.

accepting, by one or more servers, a bid from a sponsor of the first application for presenting customized content on the user device after installation of the first application on the user device and after the first application has not been launched on the user device for a specified amount of time post-installation;

determining, by the one or more servers, that the first application has not been launched on the user device for the specified amount of time;

enabling, by the one or more servers, presentation of a content item on the user device using the bid based on the determination that the first application has not been launched on the user device for the specified amount of time;

after enabling presentation of the content item:

identifying, after the accepting and the enabling, an opportunity to present content in a second different application that is installed on the user device, including receiving a request for content that identifies the user device and the second application;

conducting, by the one or more servers, an auction including evaluating the accepted bid along with other bids;

determining, by the one or more servers, that the accepted bid is the winning bid in the auction and providing, in response to the determining, a shell for the content item;

populating, at the user device, a placeholder in the shell with data from the first application that

(i) is stored on the user device,

(ii) corresponds to the placeholder, and

(iii) specifies a progress level of the user within the first application to produce a customized content item;

presenting the customized content item in the second application that is executing at the user device in response to the identified opportunity that occurs after

> the determination that the first application has not been
> launched on the user device for the specified amount of
> time[.]

Appeal Br. 12–13 (Claims App.).

The Prior Art Supporting the Rejections on Appeal

As evidence of unpatentability under 35 U.S.C. § 103, the Examiner

relies on the following prior art:

Ghosh et al. ("Ghosh")	US 2010/0228634 A1	Sept. 9, 2010
Niessen et al. ("Niessen")	US 2015/0169529 A1	June 18, 2015 (filed Dec. 16, 2013)
Garcia	US 2016/0267540 A1	Sept. 15, 2016 (provisional application filed Feb. 9, 2015)

The Rejections on Appeal

Claims 1, 2, 10–12, 16, 17, and 21–23 stand rejected under 35 U.S.C.
§ 103 as unpatentable over Garcia and Niessen. Final Act. 4–12.

Claims 3–5, 13–15, and 18–20 stand rejected under 35 U.S.C. § 103
as unpatentable over Garcia, Niessen, and Ghosh. Final Act. 12–19.

ANALYSIS

We have reviewed the rejections in light of Appellant's arguments
that the Examiner erred. For the reasons explained below, we disagree with
the Examiner's conclusions concerning unpatentability under § 103. We
provide the following to address and emphasize specific findings and
arguments.

The § 103 Rejection of Claims 1, 2, 10–12, 16, 17, and 21–23

As noted above, the § 103 rejection of independent claims 1, 11, 16, and 22 rests on Garcia and Niessen. *See* Final Act. 4–8. Appellant argues that the Examiner erred in rejecting each independent claim because the references do not teach or suggest the following limitation in claim 1 and similar limitations in claims 11, 16, and 22: "populating, at the user device, a placeholder in the shell with data from the first application that (i) is stored on the user device, (ii) corresponds to the placeholder, and (iii) specifies a progress level of the user within the first application to produce a customized content item." *See* Appeal Br. 9–10; Reply Br. 5–6.

Specifically, Appellant asserts that the independent claims differ from the references because the claims require that "**data from the first application** is used to populate the template to produce the customized content item." Appeal. Br. 9 (emphasis by Appellant). Appellant also asserts that Garcia contains no suggestion that "data from one application is used to populate a placeholder to produce a customized content item that is then presented in a different application." Reply Br. 6. In addition, Appellant contends that the data populating a presentation template in Niessen comes from a backend system instead of an application installed on a user device. Appeal. Br. 9 (citing Niessen ¶ 11). According to Appellant, the claimed "list of modifiers (i)-(iii)" applies to the claimed "data from the first application" installed on a user device. *Id.* at 10.

The Examiner finds that Garcia teaches identifying a first application installed on a user device and presenting a customized content item in a second application. Final Act. 5–6 (citing Garcia ¶¶ 4, 13, 18, 23, 28, 34); *see* Ans. 10–11. Further, the Examiner finds that Niessen teaches a

presentation template corresponding to a shell for receiving data. Final
Act. 7 (citing Niessen ¶¶ 1, 11, 16, 29–30, 34, 44–45); *see also* Ans. 9–10.
In addition, the Examiner determines that "there appears to be no limiting
factor of where the data" populating a shell comes from because "the three
elements (i)-(iii) appear to be reasonably referring to the 'first application'
recited in the claim, and not the 'data'." Final Act. 20; Ans. 8.

Based on the record before us, we agree with Appellant that the
Examiner has not adequately explained how the cited portions of the
references generally, and Garcia in particular, teach or suggest populating
a shell with "data from the first application that (i) is stored on the user
device, (ii) corresponds to the placeholder, and (iii) specifies a progress level
of the user within the first application to produce a customized content item"
as claimed. According to the claims, the data for populating a shell and
producing a customized content item "is stored on the user device." Appeal
Br. 12–13, 15, 17, 19 (Claims App.).

In contrast to the claims, Garcia discloses that a server device sends
a "reminder message" to a user device after "a given period of inactivity
relative to [a] retail application." Garcia ¶ 21. The "reminder message"
serves "to provide the end user of the user device . . . with a reminder to
reengage in a previously-engaged application." *Id.* ¶ 24. As an example, a
"server device . . . can be configured to collect real-time commerce behavior
associated with a user device . . . and to provide real-time messaging, such
as advertisement messages, to the user device . . . based on the detected
commerce behavior." *Id.* Because Garcia's server device sends reminder
messages containing content, e.g., advertising data, to a user device, the data
for producing a customized content item "is [not] stored on the user device."

Niessen discloses populating a presentation template with data that comes from a backend system instead of an application installed on a user device. *See* Niessen ¶¶ 11, 14–16. Thus, the data for populating a shell and producing a customized content item "is [not] stored on the user device."

Because the claims require that the data for populating a shell and producing a customized content item "is stored on the user device" and because neither Garcia nor Niessen teaches or suggests that feature, we do not sustain the § 103 rejection of claims 1, 11, 16, and 22.

Claims 2, 10, and 21 depend from claim 1; claim 12 depends from claim 11; claim 17 depends from claim 16; and claim 23 depends from claim 22. For the reasons discussed for claims 1, 11, 16, and 22, we do not sustain the § 103 rejection of these dependent claims.

The § 103 Rejection of Claims 3–5, 13–15, and 18–20

Claims 3–5 depend from claim 1; claims 13–15 depend from claim 11; and claims 18–20 depend from claim 16. On this record, the Examiner has not shown how the additionally cited Ghosh reference overcomes the deficiency in Garcia and Niessen discussed above for claims 1, 11, and 16. Hence, we do not sustain the § 103 rejection of claims 3–5, 13–15, and 18–20.

Because these determinations resolve the appeal for the § 103 rejections, we need not address Appellant's other arguments regarding Examiner error.[3] *See, e.g.*, *Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423

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[3] Because we reverse the § 103 rejections due to a deficiency in the teachings of the references, we need not address whether Garcia qualifies as prior art based on entitlement to priority to a provisional application's filing date. *See* Appeal Br. 6–9; Ans. 5–7; Reply Br. 1–5.

(Fed. Cir. 1984) (explaining that an administrative agency may render a decision based on "a single dispositive issue").

CONCLUSION

We reverse the § 103 rejections of claims 1–5 and 10–23.

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2, 10–12, 16, 17, 21–23	103	Garcia, Niessen		1, 2, 10–12, 16, 17, 21–23
3–5, 13–15, 18–20	103	Garcia, Niessen, Ghosh		3–5, 13–15, 18–20
Overall Outcome				1–5, 10–23

REVERSED