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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SHUMEET BALUJA

Appeal 2020-003221
Application 15/584,970
Technology Center 3600

Before MICHAEL J. STRAUSS, IRVIN E. BRANCH, and
STACEY G. WHITE, *Administrative Patent Judges*.

BRANCH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE¹

Pursuant to 35 U.S.C. § 134(a), Appellant² appeals from the Examiner’s decision to reject claims 21–40, which are all of the pending claims. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We refer to the Specification, filed May 2, 2017 (“Spec.”); Final Office Action, mailed May 31, 2019 (“Final Act.”); Appeal Brief, filed December 24, 2019 (“Appeal Br.”); Examiner’s Answer, mailed January 27, 2020 (“Ans.”); and Reply Brief, filed March 27, 2020 (“Reply Br.”).

² We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Google LLC. Appeal Br. 2.

CLAIMED SUBJECT MATTER

The claims are directed to “adapting an online electronic document environment to make content items more useful for devices with call functionality, and/or a limited ability to render Web pages in a manner satisfying to a user (e.g., due to small displays, slow communications connection speeds, and/or slow rendering), such as mobile phones. Spec.

¶ 1. Claim 21, reproduced below with disputed limitation emphasized in *italics*, is illustrative of the claimed subject matter:

21. A system for device configuration-based function delivery, comprising:

a server comprising one or more processors and memory to:

receive, from a computing device via a computer network, a data structure including device configuration information that indicates the computing device comprises an application programming interface to allow a command to access a type of function of the computing device;

identify, responsive to a request from the computing device that accessed an online resource having content, a first content item having the command corresponding to the type of function and a second content item without the command corresponding to the type of function;

determine, responsive to the request and based on the content of the online resource accessed by the computing device, a first document score indicating relevancy of the first content item to the content of the online resource, and a second document score indicating relevancy of the second content item to the content of the online resource, the second document score greater than the first document score;

determine, responsive to the request and based on the device configuration information that indicates the computing device comprises the application programming interface to allow the command to access the type of function of the computing device, a first function score indicating relevancy of the command of the first content item to the device configuration

information, and a second function score indicating relevancy of the second content item to the device configuration information, the second function score less than the first function score;

combine the first document score indicating relevancy to the content of the online resource with the first function score indicating relevancy to the device configuration information to generate a first overall score for the first content item;

combine the second document score indicating relevancy to the content of the online resource with the second function score indicating relevancy to the device configuration information to generate a second overall score for the second content item, the second overall score less than the first overall score based at least in part on the second function score less than the first function score; and

select, responsive to the request from the computing device and based on the first overall score being greater than the second overall score, the first content item with the command; and

transmit, via the computer network to the computing device comprising the application programming interface, the first content item with the command to cause the command to access or execute the type of function of the computing device.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Levin	US 2002/0128908 A1	Sept. 12, 2002
Kumar	US 2005/0027659 A1	Feb. 3, 2005
Reller	US 2007/0088609 A1	Apr. 19, 2007

REJECTION^{3, 4, 5}

Claims 21–40 stand rejected over 35 U.S.C. § 103(a) as unpatentable over Levin, Kumar, and Reller. Final Act. 9–19

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellant’s arguments. We have considered in this Decision only those arguments Appellant actually raised in the Briefs. Any other arguments Appellant could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

To the extent consistent with our analysis herein, we adopt as our own the findings and reasons set forth by the Examiner in (1) the action from which this appeal is taken (Final Act. 9–16) and (2) the Examiner’s Answer in response to Appellant’s Appeal Brief (Ans. 4–6) and concur with the conclusions reached by the Examiner. We highlight the following for emphasis.

35 U.S.C. § 103

Claim 21 recites in pertinent part, “combine the first document score indicating relevancy to the content of the online resource with the first

³ Claims 21–40 stand provisionally rejected on the ground of non-statutory double patenting as being unpatentable over claims 1–20 of co-pending Applications No. 15/189826. Final Act. 5–6. Because this rejection is provisional, we do not address it further.

⁴ The Examiner has withdrawn a rejection of claims 21 and 32 and their dependent claims under 35 U.S.C. § 112, 1st paragraph. Final Act. 6–8; Advisory Action (mailed August 12, 2019) 2.

⁵ The Examiner has withdrawn a rejection of claims 21–40 under 35 U.S.C. § 101 as directed to a judicial exception without significantly more. Ans. 3.

function score indicating relevancy to the device configuration information to generate a first overall score for the first content item.”

The Examiner finds this limitation to be taught by a combination of teachings from Levin, Kumar, and Reller, and provides a rationale for combining the teachings. Final Act. 9–16.

Appellant contends “**the Office Action splits [the limitation] into discrete elements in order to assert three different references Levin, Kumar and Reller for the single element,**” such that the Examiner improperly fails to consider the claim as a whole. Appeal Br. 22, (citing MPEP § 2103(I)(C)). Appellant then argues each reference individually, with reference to the entire limitation (*see* Appeal Br. 23–30), rather than argue the Examiner’s proposed combination of teachings and reasoning (*see* Final Act. 13–16).

With respect to Appellant’s impermissible splitting the limitation into discrete elements argument, MPEP § 2103(I)(C) reads as follows, in pertinent part:

Examiners may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981) (“In determining the eligibility of respondents’ claimed process for patent protection under § 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.”).

We disagree with Appellant’s characterization of the Examiner’s analysis, i.e., splitting the limitation into discrete elements for the purpose of asserting three different references.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). The Examiner can satisfy this burden by showing “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) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 550 U.S. at 416).

Here, the Examiner showed each element of the claim limitation existed in the prior art—that is, the Examiner showed them to be “familiar.” Final Act. 13–16; *Leapfrog*, 485 F.3d at 1161. The Examiner also provided “some articulated reasoning with some rational underpinning” why the claimed combination would be obvious. Final Act. 15, 16. We are not persuaded, as Appellant asserts, that the Examiner impermissibly “evaluate[d] the elements in isolation.” MPEP § 2103(I)(C). Accordingly, we are not persuaded of error based on this argument.

Nor are we persuaded by Appellant’s arguments against the references individually. Appeal Br. 22–31. One cannot show non-obviousness by attacking references individually when the rejection is based on a combination of references. *See In re Merck & Co., Inc.*, 800 F.2d 1091,

1097 (Fed. Cir. 1986); *see also In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Here, Appellant addresses each reference for its individual teaching but does not address the Examiner’s rejection, which is based on the combined teachings of the references. Accordingly, because Appellant does not persuasively address the substance of the Examiner’s rejection, we are unpersuaded of error.

We, therefore, sustain the rejection of claim 21. Because Appellant argued each claim based on the foregoing (Appeal Br. 8; Reply Br. 5), we also sustain the rejection of the remaining claims.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
21–40	103	Levin, Kumar, Reller	21–40	

TIME PERIOD FOR 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED