UNITED STATES PATENT AND TRADEMARK OFFICE

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13/807,654	12/28/2012	Kenji Sugiura	Q200714	8135

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SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037	FRUNZI, VICTORIA E.

ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

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	Application No. 13/807,654	**Applicant(s)** Sugiura et al.
Office Action Summary	**Examiner** VICTORIA E FRUNZI	**Art Unit** 3688	**AIA Status** No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

   A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☑ Responsive to communication(s) filed on <u>10/9/2018</u>.
    ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2a)☑ This action is **FINAL.**   2b) ☐ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

5) ☑ Claim(s) <u>9-18</u> is/are pending in the application.
    5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6) ☐ Claim(s) _____ is/are allowed.

7) ☑ Claim(s) <u>9-18</u> is/are rejected.

8) ☐ Claim(s) _____ is/are objected to.

9) ☐ Claim(s) _____ are subject to restriction and/or election requirement

* If any claims have been determined <u>allowable</u>, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to **PPHfeedback@uspto.gov.**

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    Certified copies:
       a)☐ All   b)☐ Some**   c)☐ None of the:
         1.☐ Certified copies of the priority documents have been received.
         2.☐ Certified copies of the priority documents have been received in Application No. _____.
         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☑ Notice of References Cited (PTO-892)

2) ☐ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)
    Paper No(s)/Mail Date _____.

3) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

4) ☐ Other: _____.

E atDETAILED CORRESPONDENCE

Notice of Pre-AIA or AIA Status

1.   The present application is being examined under the pre-AIA first to invent

provisions.

Response to Amendment

2.   The following is a **Final** Office Action in response to communications received on

10/9/2018. Claims 9-18 are currently pending and have been examined. Claims 9 and

18 have been amended. Claims 1-8 have been cancelled.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title

4.   Claims 9-18 are rejected under 35 U.S.C 101 because the claimed

invention is directed to a judicial exception (i.e., a law of nature, a natural

phenomenon, or an abstract idea) without significantly more.

5.   **Step 1:** Claim 1 (device) and claim 18 (method) is directed to displaying

an advertisement to a user and therefore is a statutory category of invention.

6.   **Step 2A:** Claim 1 (device) and claim 18 (method) is directed to displaying

an advertisement to a user which is an abstract idea. Claim 9 recites transmitting

code configured to cause to transmit display data, the display data comprising an

advertisement display area that includes advertisement content comprising an

image that is the same size as the advertisement display area, the image

showing a single commercial transaction target, wherein each of a plurality of

partial areas included in the advertisement display area is allocated to one of a

plurality of providers providing the single commercial transaction target; acquiring

code configured to cause acquire position information including coordinates

corresponding to user input detected within the advertisement display area,

wherein the detected user input includes at least one of a clicking operation or a

tapping operation; and selecting code configured to cause select one of the

providers based on the acquired position information, wherein each of the

plurality of partial areas comprises a plurality of dot areas that each comprise a

plurality of pixel units, the dot areas are randomly distributed within the

advertisement display area and the selecting one of the providers further

comprises determining the dot area corresponding to the coordinates included in

the acquired position information.

7.   The abstract idea is "an idea itself" comprising activities such as data

recognition, comparing data and storage or a "method of organizing human

activities" comprising advertising and marketing. The abstract ideas identified

above are found to be similar to data recognition and storage (*Content*

Extraction); collecting and comparing known information (*Classen*); using

advertising as an exchange or currency *(Ultramercial)*; customizing information

based on information known about the user (*Affinity Labs*). Thus, the

representative claim is directed to an *abstract idea* previously identified by the

courts.

7.   **Step 2B:** The additional element identified in the claims 9 and 18 are:

10.   Claim 9 recites: an information providing device that provides display data

including an advertisement display area to a terminal device with at least one display

through a network, the information providing device comprising: at least one memory

operable to store program code; and at least one processor operable to access said

memory and read said program code and operate as instructed by said program code,

said program code including: transmitting code configured to cause at least one of said

at least one processor to transmit display data over a network to a terminal device,

acquiring code configured to cause at least one of said at least one processor to acquire

position information; and selecting code configured to cause at least one of said at least

one processor to select one of the providers based on the acquired position information.

11.   Claim 18 recites an information providing method executed by a computer,

transmitting display data over a network to a terminal device, acquiring position

information including coordinates; and selecting one of the providers based on the

acquired position information, selecting one of the providers further comprises

determining the dot area corresponding to the coordinates included in the acquired

position information.

12.   The Examiner finds individually the additional elements of the claims to recite

conventional computer functions based on the cited portions of the specifications. In

considering the additional elements in combination, in view of the Berkheimer memo

(dated 4/19/2018), the claim does not include **additional element**(s) that are sufficient

to amount to significantly more than the judicial exception because they represent

routine and conventional computer task activity, representing insignificant extra solution

activity.

The additional element(s) or combination of elements in the claim(s), other than the

abstract idea per se, amount(s) to no more than: i) mere instructions to implement the

idea on a computer, and/or (ii) recitation of generic computer structure that serves to

perform generic computer functions that are well-understood, routine, and conventional

activities previously known to the pertinent industry for instance:

Based on the review of the **instant specification** Applicant expressly discloses that the

identified above additional element "terminal device" is considered well-understood,

routine, and conventional because Applicant expressly recites:

"**Conventionally, a commercial transaction system is known** which connects to a

network such as Internet using a terminal device such as a personal computer, and

which enables commercial transaction such as purchase of a product or reservation to

use service through...", paragraph 0002 of original specification.

The "transmission" element also expressly stated by the Applicant that is considered

well-understood, routine, and conventional, "**Patent Literature 1 discloses** a technique

which is capable of automatically changing advertisement content which has already

been listed only by **transmitting advertisement data from a client terminal to a**

management server....", paragraph 0004 of instant specification.

Still further, **per MPEP 2106.05 (d) II**, the courts have recognized the following

computer elements pertinent to the instant invention as well-understood, routine, and

conventional functions when they are claimed in a merely generic manner (*e.g.,* at a

high level of generality) or as insignificant extra-solution activity:

Limitation such as "transmitting display data over a network to a terminal device, the

display data comprising an advertisement display area ...", fails to satisfy Step 2B

consideration because the Symantec court recognized it as well-understood, routine,

conventional activity "Receiving or transmitting data over a network, *e.g.,* using the

Internet to gather data, *Symantec,* 838 F.3d at 1321, 120 USPQ2d at 1362 (utilizing an

intermediary computer to forward information).

Limitation such as "acquiring, using at least one of said at least one processor...

acquiring position information including coordinates corresponding to user input

detected within the advertisement display area", fails to satisfy Step 2B consideration

because the buySAFE court recognized it as well-understood, routine, conventional

activity, (computer receives and sends information over a network). *buySAFE, Inc. v.*

Google, Inc., 765 F.3d 1350, 1355, 112 USPQ2d 1093, 1096 (Fed. Cir. 2014);

8.   Looking at the combination of elements in claims 9 and 18 also fails to

show an inventive concept. Unlike the eligible claims in Diehr and Bascom, in

which the elements limiting the exception were individually conventional but

taken together provided an inventive concept because they improved a technical

field, the claim here does not invoke any of the considerations that courts have

identified as providing significantly more than an exception. **The combination of**

elements is no more than the sum of their parts, and provides nothing more than

mere automation of displaying advertisements to a user. Mere automation of an

abstract idea does not provide significantly more (i.e., provide an inventive

concept). For these reasons, claims 9 and 18 are ineligible.

9.   With respect to the dependent claims 10-17, the review of the claims

concluded that the dependent claims are merely data transmitted specifying the

particulars of the provider and particulars of the advertisement and do not add

significantly more to the abstract idea. The Examiner's review of the dependent

claims concludes that the limitations do not add significantly more to the abstract

idea as they merely further limit the type of data. Further the dependent claims

merely recite types of data that are received over a network which has been held

by the Federal courts to be generic, routine and conventional computer functions

(see page 7 of the 2015 July Subject Matter Eligibility 2015 note 25).

10.   These additional elements do not provide significantly more to the abstract

idea as the additional elements do not:

- Improve another technology or technical field

- Improve the functioning of a computer itself

- Add a specific limitation other than what is well-understood, routine, and

conventional in the field

- Add meaningful limitations that amount to more than generally linking the

use of the exception to a particular technological environment

- Improve computer related technology by allowing computer performance

of a function not previously performable by a computer.

11.   **Viewed as a whole**, these additional claim elements do not provide

meaningful limitation(s) to transform the abstract idea into a patent eligible

application of the abstract idea such that the claims amount to significantly more

than the abstract idea itself. Therefore, the claims 9-19 are rejected under 35

U.S.C. 101 as being directed to non-statutory subject matter. (Step 2B: No, from

the July 2015 Subject Matter Eligibility Update).

Claim Rejections - 35 USC § 103

12.   In the event the determination of the status of the application as subject to AIA 35

U.S.C. 102 and 103 (or as subject to pre-AIA 35 U.S.C. 102 and 103) is incorrect, any

correction of the statutory basis for the rejection will not be considered a new ground of

rejection if the prior art relied upon, and the rationale supporting the rejection, would be

the same under either status.

13.   The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis

for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102, if the differences between the subject matter sought to be patented
> and the prior art are such that the subject matter as a whole would have been obvious at the
> time the invention was made to a person having ordinary skill in the art to which said subject
> matter pertains. Patentability shall not be negatived by the manner in which the invention was
> made.

14.   **Claim 9-18 are rejected under pre-AIA 35 U.S.C. 103(a) as being**

unpatentable over Isobe (U.S. Pub. No. 2005/0203797) in view of Karassner (U.S.

Pub. No. 2009/0265243) in further view of Ericson (WO 0175781).

15.   Regarding claims 9 and 18, Isobe teaches:

16.   An information providing device that provides display data including an

advertisement display area to a terminal device with at least one display through a

network**(network 1) ("The computer system 2 is formed by a computer having a**

known structure including a CPU, a storage unit, and input and output devices

such as a display unit. The terminal equipment 3 is formed by a personal

computer having a known structure including a CPU, a storage unit and input and

output devices such as a display unit.", Paragraph 0044), the information providing

device comprising: at least one memory operable to store program code; and at least

one processor operable to access said memory and read said program code and

operate as instructed by said program code, said program code including (claim 9)

(**"The computer system 2 forms the first embodiment of the information**

distribution apparatus, and executes a program stored in the first embodiment of

the computer-readable storage medium such as the storage unit", Paragraph

0044):

17.   An information providing method executed by a computer, the information

providing method comprising (claim 18):

18.   transmitting code configured to cause at least one of said at least one processor

to transmit display data over a network to a terminal device **(display screen 52)**, the

display data comprising an advertisement display area that includes advertisement

content **(element 52)** comprising an image that is the same size as the advertisement

display area **(Shown in Figure 25 and Paragraph 0131)**, the image showing a single

commercial transaction target, wherein each of a plurality of partial areas included in the

advertisement display area is allocated to one of a plurality of providers providing the

single commercial transaction target **(Cell phone B of Company in Figure 25 and**

"selects the advertisements at random by the provider, from the selected product

category, so as to match the ratios of the setting information. In addition, a step

S66 stores a list of advertisements selected by the provider into the

advertisement insertion information part 29, as the advertisement list, and the

process advances to the step S64 described above. [0099] When initially

selecting the advertisements completely at random, the provider mode in which

the receiving format is selected by the provider may be selected on the

advertisement select mode selection screen or, the ratio for the provider's choice

may be set to 100% on the product category selection screen shown in FIG. 11",

Paragraph 0098-099);

19.   selecting code configured to cause at least one of said at least one processor to

select one of the providers based on the acquired position information **(Ad Receiving**

Format Selection in Figure 5 and "detail setting of format for receiving AD S25-

27), the dot areas are randomly distributed within the advertisement display area

(select ad at random in S65) and the selecting one of the providers further comprises

determining the dot area corresponding to the coordinates included in the acquired

position information **("According to the individual setting, products are selected by**

the computer system 2 at random according to a ratio which will be described

later, from the products for which the details are set in the above described mode

for independently selecting the advertisements. According to the provider's

choice, the product categories and/or products are selected by the computer

system 2 at random according to the ratio which will be described later, excluding

the products which are set to be rejected by the user.", Paragraph 0066, 0098-99)

20.   While Isobe teaches the randomized presentation of the advertisements based

on a set of criteria, Isobe does not expressly disclose:

•   acquiring code configured to cause at least one of said at least one processor to

acquire position information including coordinates corresponding to user input detected

within the advertisement display area, wherein the detected user input includes at least

one of a clicking operation or a tapping operation; and

- wherein each of the plurality of partial areas comprises a plurality of dot areas

that each comprise a plurality of pixel units

21.   However Karassner teaches:

22.   acquiring code configured to cause at least one of said at least one processor to

acquire position information including coordinates corresponding to user input detected

within the advertisement display area, wherein the detected user input includes at least

one of a clicking operation or a tapping operation; and **("([0010] "network location**

display screens" and see at least Abstract; ¶¶ [0015], [0016] disclosing ... The

present invention, in a preferred embodiment, uses file server direct connection

or "FSDC" technology to process ad viewer activity tracking data. This allows the

system to send a tracking string with information (variables) received from the

dispatcher server by the ad file directly to a tracking server. [...]; see also ¶¶

[0022] disclosing ... by specifying a predefined area on the ad content display

page which, when its coordinates correspond in a pre-defined manner with

coordinates of the viewer's browser dimensions and scrolling position, triggers

content rendering at the ad content display page, [...] what actions were taken on

the advertisement in the form of clicks, the click rate in relation to the number of

views, and other meta data in relation to the rendered content. [...]; see also ¶

[0025] disclosing ... the system server-side application retrieves data from the

viewer's request as well as the record with data for the particular ad content

display page and generates code, referred to as a "correlator code" which is

preferably JavaScript code, that dynamically creates a marker for the ad content

display page area, and also correlates the pre-defined ad content display page

triggering area with viewer browser window scrolling position and dimensions, and the correlator code generates a query string link which is stored as a variable on the ad content display page, including data collected from the viewer's browser via the correlator code. The marker may be HTML code or coordinates in the correlator code, or can be created by other means for creating a page area marker. [...]);

23.   Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the interface placing the advertisement in the invention of Isobe with acquiring code configured to cause at least one of said at least one processor to acquire position information including coordinates corresponding to user input detected within the advertisement display area, wherein the detected user input includes at least one of a clicking operation or a tapping operation, as taught in Karassner, in order to place the advertisement based on the user interaction.

24.   While Isobe in view of Karassner teaches the presentation of the advertisement on an interface based on the product and the user interaction, the combination does not expressly disclose:

•   wherein each of the plurality of partial areas comprises a plurality of dot areas that each comprise a plurality of pixel units

25.   However Ericson teaches:

26.   wherein each of the plurality of partial areas comprises a plurality of dot areas that each comprise a plurality of pixel units (**"shown in elements 227 and 228 of Figures 2a and 2b)**

27.   Therefore it would have been obvious to one having ordinary skill in the art at the time of invention to modify the advertisement display of Isobe in view of Karassner to include wherein each of the plurality of partial areas comprises a plurality of dot areas that each comprise a plurality of pixel units and in the combination each element merely performs the same function as it does separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."), since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

28.   Regarding claim 10, Isobe in view of Karassner in further view of Ericson teaches the limitations set forth above.

29.   Isobe further discloses:

30.   wherein said program code further comprises area allocating code configured to cause at least one of said at least one processor to allocate the partial area per provider based on a usage fee for utilizing the advertisement display area **("charging advertising fees for the advertisements to an advertiser", Paragraph 0060, 0080, 101).**

31.   Regarding claim 11, Isobe in view of Karassner in further view of Ericson teaches the limitations set forth above.

32.   While Isobe teaches charging a fee for the advertisement, but does not expressly disclose:

- wherein said program code further comprises specifying count memory code configured to cause at least one of said at least one processor to store a specifying count of the partial area per partial area, wherein the area allocating code is further configured to cause at least one of said at least one processor to compare specifying counts of the stored respective partial areas, and allocate the provider of a relatively high bid of the usage fee to a partial area of a relatively high specifying count

33.   However Karassner teaches:

34.   wherein said program code further comprises specifying count memory code configured to cause at least one of said at least one processor to store a specifying count of the partial area per partial area, wherein the area allocating code is further configured to cause at least one of said at least one processor to compare specifying counts of the stored respective partial areas, and allocate the provider of a relatively high bid of the usage fee to a partial area of a relatively high specifying count **(see at least ¶ [0112] The real-time auction to select the ad to be displayed can be based on the advertiser bids or the advertisement parameters of the advertisements, such as, without limitation: click-through rate, ad space size, display region and ad type, or a combination of such parameters and bids.; see also ¶¶ [0112], [0115], [0118], [0154], [0174]; see also Claim 41).**

35.   Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the fee of the advertisement in Isobe to include wherein said program code further comprises specifying count memory code configured to cause at least one of said at least one processor to store a specifying count of the partial area per partial area, wherein the area allocating code is further configured to

cause at least one of said at least one processor to compare specifying counts of the

stored respective partial areas, and allocate the provider of a relatively high bid of the

usage fee to a partial area of a relatively high specifying count, as taught in Karassner,

in order to increase competition amongst advertisers for advertising space.

36.   Regarding claims 12-14, Isobe in view of Karassner in further view of Ericson

teaches the limitations set forth above.

37.   Isobe further discloses:

38.   wherein said program code further comprises allocation changing code

configured to cause at least one of said at least one processor to change a provider

allocated to the partial area based on a predetermined condition **(see Ad receiving**

format selection such as present point amount in Figure 16 and S121 in Figure

20).

39.   Regarding claim 15-17, Isobe in view of Karassner in further view of Ericson

teaches the limitations set forth above.

40.   Isobe further discloses:

41.   wherein said program code further comprises specifying count memory code

configured to cause at least one of said at least one processor to store a specifying

count of the partial area per partial area, wherein the allocation changing code is further

configured to cause at least one of said at least one processor to change a provider

allocated to a partial area whose specifying count exceeds a threshold **("a step SI21**

decides whether or not the number of points exceeds or, is less than, the number

of points required to acquire the contents selected by the user. The process ends

if the decision result in the step SI21 is NO. If the decision result in the step SI21

is YES, a step SI22 subtracts or adds the points owned by the user and read from

the point accumulating part 27, from or to the number of points detected in the

step SI21. A step S123 decides whether or not a result of the subtraction or

addition in the step SI22 is less than or equal to zero. The process advances to a

step SI24 if the decision result in the step SI23 is NO, and the process advances

to a step S125 if the decision result in the step SI23 is YES.", Paragraph 0113-

114).

Response to Arguments

68.   Applicant's arguments filed 10/9/2018 have been fully considered but they are

not persuasive for the reasons set forth below.

69.   Applicant's Remarks (page 8) : Rejection under 35 USC 112

The Examiner has withdrawn the rejection in view of the claim amendments.

70.   Applicant's Remarks (page 12-17) : Rejection under 35 USC 101

The Examiner first asserts that the rejection under 35 USC 101 has been update in view

of the claim amendments. While the claim recites specific steps for providing the

advertisement, the steps merely recite the parameters used in the presentation of the

advertisement and not reciting an improvement to the interface or computer itself as

was determined in Core Wireless. The particulars of the claim limitations recited such as

the "dot areas of each partial area are randomly distributed across the advertisement

display area" are merely parameters used in the determination of the presentation of the

advertisement.

With respect to the remarks directed to DDR Holdings, while the claims recite a problem

in the internet environment, the instant case does not recite the technological

improvement in the same manner recited in DDR Holdings. DDR Holdings case was found to recite a technological improvement that went beyond merely presenting the website to a user.

71.   Applicant's Remarks (page 17-20) : Rejection under 35 USC 103

With respect to the remarks directed to the rejection under 35 USC 103, the Examiner has considered the remarks and updated the rejection in view of the claim amendments. The rejection now relies on the combination of Isobe, Karassner and Ericson and therefore the remarks are considered moot.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA E. FRUNZI whose telephone number is (571)270-1031. The examiner can normally be reached on Monday- Friday 7-4 (EST).

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at http://www.uspto.gov/interviewpractice.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 5712726702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VICTORIA E FRUNZI/
Examiner, Art Unit 3688
12/28/2018

/RAQUEL ALVAREZ/
Primary Examiner, Art Unit 3688

REMARKS

Status of Application

Claims 9-18 are all the claims pending in the application. By this Amendment, claims 9 and 18 are amended, without prejudice or disclaimer. Support for the amendments can be found throughout the original disclosure, e.g., at least at Figures 5A and 5B and paragraphs [0080] and [0081] of the published specification. No new matter is added.

Claim Rejections - 35 U.S.C. § 101

Claims 9-18 are rejected under 35 U.S.C 101 because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more.

Applicant respectfully disagrees for at least the reasons discussed in Applicant's previous remarks, and for the reasons discussed below.

On January 7, 2019, a Federal Register Notice titled *2019 Revised Patent Subject Matter Eligibility Guidance* was issued. (84 Fed. Reg. 4, 50, January 7, 2019) This revised guidance changes the procedures for determining whether a patent claim or patent application claim is directed to a judicial exception under Step 2A of the USPTO's Subject Matter Eligibility Guidance. Specifically, the revised guidance provides a two-pronged procedure for performing the Step 2A analysis.

In Prong One of revised Step 2A, examiners evaluate whether the claim recites a judicial exception. If the claim recites a judicial exception (i.e., an abstract idea enumerated in Section I of the revised guidance, a law of nature, or a natural phenomenon), the claim requires further analysis in Prong Two. If the claim does not recite a judicial exception, then the claim is eligible at Prong One of revised Step 2A.

In Prong Two, examiners evaluate whether the claim recites additional elements that integrate the exception into a practical application of that exception. If the recited exception is integrated into a practical application of the exception, then the claim is eligible at Prong Two of revised Step 2A.

A. The claims are patent eligible under prong one of the revised step one of the *Alice* test

The revised guidance provides that "[i]n Prong One, examiners should evaluate whether the claim recites a judicial exception, i.e., an abstract idea, a law of nature, or a natural phenomenon." *See Id.* at page 15. Further, the revised guidance provides that "[t]o determine whether a claim recites an abstract idea in Prong One, examiners are now to: (a) identify the specific limitation(s) in the claim under examination (individually or in combination) that the examiner believes recites an abstract idea; and (b) determine whether the identified limitation(s) falls within the subject matter groupings of abstract ideas enumerated in [the revised guidance and as reproduced below]." *See Id.* at page 17.

The claims do not recite a law of nature, a natural phenomenon, or subject matter that falls within the enumerated groupings of abstract ideas as provided in the revised guidance, and are thereby patent eligible under prong one of step one of the *Alice* test.

First, the claims do not recite a 1) **mathematical concept** (mathematical relationships, mathematical formulas or equations, mathematical calculations); 2) **certain methods of organizing human activity** ((fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including

social activities, teaching, and following rules or instructions)); or 3) **mental processes**

((concepts performed in the human mind (including an observation, evaluation, judgment,

opinion)).

The Examiner asserts on pages 2-3 of the Office Action that the present independent

claims are directed to displaying an advertisement to a user which is an abstract idea, such as

data recognition, comparing data and storage or a "method of organizing human activities"

comprising advertising and marketing. However, Applicant respectfully submits that the subject

matter of independent claims 9 and 18 do not fall within any of categories of organizing human

activity enumerated above. Plainly, the subject matter of independent claims 9 and 18 do not fall

within any of (i) fundamental economic principles or practices (including hedging, insurance,

mitigating risk); (ii) commercial or legal interactions (including agreements in the form of

contracts; legal obligations; advertising, marketing or sales activities or behaviors; business

relations); and (iii) managing personal behavior or relationships or interactions between people

(including social activities, teaching, and following rules or instructions).

Accordingly, the claims are patent eligible under prong one of the revised step one of the

Alice test.

**B. The claims are patent eligible under prong two of the revised step one of the *Alice*
test**

Even assuming *arguendo* that the claims recite a judicial exception, which the Applicant

in no way concedes, the claims are nonetheless patent eligible under prong two of the revised

step one of the *Alice* test because the claims integrate the alleged judicial exception into a

practical application.

The Revised Guidance provides that "[i]n Prong Two, examiners should evaluate whether the claim as a whole integrates the recited judicial exception into a practical application of the exception. A claim that integrates a judicial exception into a practical application will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception." *See Id.* at page 18.

The claims recite an "additional element [that] reflects an improvement in the functioning of a computer, or an improvement to other technology or technical field," and thereby integrate the alleged judicial exception into a practical application.

That is, independent claim 18 recites, among other things, "transmitting display data over a network to a terminal device, the display data comprising one advertisement display area that includes advertisement content comprising an image that is the same size as the advertisement display area, the image showing a single commercial transaction target, wherein a plurality of partial areas that constitute the image of the advertisement content comprise a plurality of dot areas that each comprise a plurality of pixel units, the plurality of dot areas being respectively allocated to a plurality of providers providing the single commercial transaction target, and locations of dot areas allocated to each of the plurality of providers being randomly distributed in the image of the advertisement content," "acquiring position information including coordinates corresponding to a user input detected within the image of the single commercial transaction target, wherein the detected user input includes at least one of a clicking operation or a tapping operation on a dot area among the plurality of dot areas in the image of the advertisement content," and "determining the dot area corresponding to the coordinates included in the acquired

position information, and selecting one of the plurality of providers to which the determined dot

area is allocated."

In this way, the claims are directed to patent-eligible subject matter because the claims

are directed to an improvement in providing a proper selection of the provider irrespective of an

image of advertisement is possible. In detail, in the prior art, there is a possibility that a specific

portion (a central portion, a right portion, and so on, of advertisement area) is clicked easily

based on an image of advertisement. However, in the claimed invention, since dot areas are

randomly distributed throughout the entire advertisement display area, a dot area associated with

a provider is included in any portion including a central portion, a right, left, upper, or lower

portion of advertisement area, and therefore, it is possible to perform a proper selection of the

provider. Further, since a provider is determined based on the position on which a clicking

operation is performed, it is possible to reduce the processing load caused by the selection of

provider. See Figures 5A and 5B and paragraphs [0080] and [0081] of the published

specification.

Because the claims are directed to an improvement in the functionality of computing

devices, the claims are **integrated into a practical application,** and are patent eligible under

prong two of the revised guidance.

For at least the reasons set forth above along with Applicant's previous remarks,

Applicant respectfully submits that the claims satisfy 35 U.S.C. 101.

Claim Rejections - 35 U.S.C. § 103

Claim 9-18 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Isobe

(U.S. Pub. No. 2005/0203797) in view of Karassner (U.S. Pub. No. 2009/0265243) in further

view of Ericson (WO 0175781).

Applicant respectfully submits that the cited references, alone or in combination, fail to

teach or suggest each and every element of amended independent claim 18. More particularly,

the cited references fail to teach or suggest at least following subject matter recited by amended

independent claim 18:

> transmitting display data over a network to a terminal
> device, the display data comprising one advertisement display area
> that includes advertisement content comprising an image that is the
> same size as the advertisement display area, the image showing a
> single commercial transaction target, <u>wherein a plurality of partial
> areas that constitute the image of the advertisement content
> comprise a plurality of dot areas that each comprise a plurality of
> pixel units, the plurality of dot areas being respectively allocated to
> a plurality of providers providing the single commercial
> transaction target, and locations of dot areas allocated to each of
> the plurality of providers being randomly distributed in the image
> of the advertisement content;</u>
> acquiring position information including coordinates
> corresponding to a user input detected within the image of the
> single commercial transaction target, wherein the detected user
> input includes at least one of <u>a clicking operation or a tapping
> operation on a dot area among the plurality of dot areas in the
> image of the advertisement content;</u> and
> determining the dot area corresponding to the coordinates
> included in the acquired position information and selecting one of
> the plurality of providers to which the determined dot area is
> allocated; and
> controlling to transmit information matching the selected
> one of the plurality of providers to the terminal device.

As noted above, according to the invention of claim 18, with respect to <u>one</u> advertisement

display area that includes an advertisement content comprising an image showing a <u>single</u>

commercial transaction target, (i) a plurality of partial areas that constitute the image of the

advertisement content comprise <u>a plurality of dot areas that each comprise a plurality of pixel</u>

<u>units,</u> (ii) the plurality of dot areas are <u>respectively allocated to a plurality of providers providing</u>

<u>the single commercial transaction target,</u> and (iii) <u>locations of dot areas</u> allocated to each of the

plurality of providers are <u>randomly distributed in the image of the advertisement content.</u>

For illustrative purposes, FIG. 5B of the present application shows that a distribution

ratio of dot areas (the ratio the dot areas occupy in the advertisement display area R) varies per

partial area. For example, dot areas in a partial area A (that is allocated to one of a plurality of

providers providing the single commercial transaction target) in FIG. 5B are indicated by

symbols o, and these dot areas are scattered in the advertisement display area R at 50% of the

distribution ratio. Different stores (or providers) are allocated to respective partial areas by

partial area allocation processing, and a store ID of the allocated store is associated with an area

ID of a partial area, and registered. See paras. [0080]-[0084] of the published specification.

FIG.5B

<FIG. 5B of the present application>
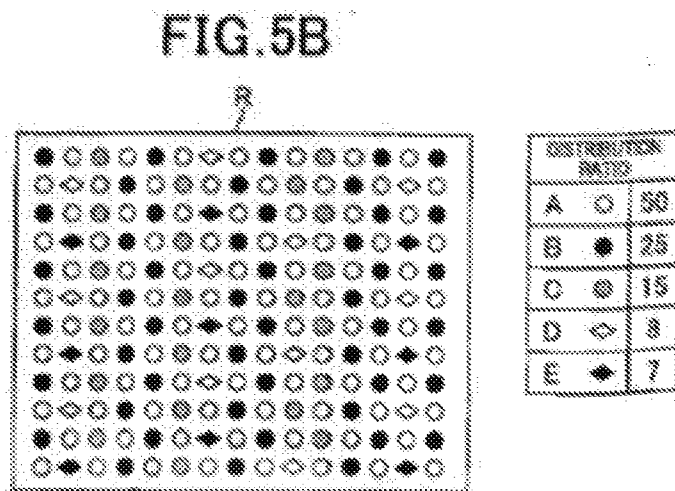
Because each dot area corresponds to a partial area and each partial area corresponds to

an advertiser, the random distribution of dot areas across the advertisement display area assigns a

probability of selection for each of the advertisers in an image of the advertisement content

showing a single commercial transaction target. By changing the size of the partial area and the

distribution of dot areas, it is possible to increase or decrease the probability for selecting an

advertisement.

Applicant respectfully submits that Isobe fails to disclose the above mentioned subject

matter recited in amended independent claim 18. Isobe, at para. [0066] and FIG. 11, merely

discloses that the product category is selected on the details setting screen shown in FIG. 10,

where a tree including the categories of all of the products, and the products within each

category, is displayed, and according to the individual setting, products are selected by the

computer system 2 at random according to a ratio, from the products for which the details are set

for independently selecting the advertisements.   Simply put, Isobe merely discloses randomly

selecting products for advertisement content among a plurality of products and product

categories.

For example, FIG. 25 of Isobe shows that a product 60 which is to be advertised

("USEFUL CELL PHONE OF COMPANY B"), is included within the contents that are

displayed in the display screen 52. However, the image of the product 60 in Isobe is not

constituted of partial areas which comprise a plurality of dot areas being respectively allocated to

a plurality of providers providing the single commercial transaction target, and locations of dot

areas allocated to each of the plurality of providers being randomly distributed in the image of

the advertisement content. Isobe is entirely silent on the claimed invention's specific technique

of providing each of the plurality of partial areas comprising a plurality of dot areas that each

comprise a plurality of pixel units, locations of dot areas allocated to each of the plurality of

providers being randomly distributed in the image of the advertisement content, and selecting

one of the providers that is allocated to a dot area corresponding to coordinates corresponding to

user input detected within the advertisement display area.

Karassner and Ericson fail to remedy the above noted deficiencies in Isobe.

In view of the above remarks, Applicant respectfully submits that the cited references,

alone or in combination, fail to teach or suggest each and every element of the subject matter

recited by amended independent claim 18.

Accordingly, allowance of claim 18 is respectfully requested for at least these reasons.

Also, allowance of independent claim 9 and all claims dependent therefrom is warranted for at

least reasons similar to those of claim 18.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed

to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is

kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue

Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any

overpayments to said Deposit Account.

Respectfully submitted,

/ Sujin Park /

SUGHRUE MION, PLLC   Sujin Park
Telephone: 202.293.7060   Registration No. 74,061
Facsimile: 202.293.7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: March 8, 2019

AMENDMENTS TO THE CLAIMS

This listing of claims will replace all prior versions and listings of claims in the application:

LISTING OF CLAIMS:

1.-8. (Cancelled)

9. (Currently Amended): An information providing device that provides display data including an advertisement display area to a terminal device with at least one display through a network, the information providing device comprising:

at least one memory operable to store program code; and

at least one processor operable to access said memory and read said program code and operate as instructed by said program code, said program code including:

transmitting code configured to cause at least one of said at least one processor to transmit display data over a network to a terminal device, the display data comprising ~~an~~ one advertisement display area that includes advertisement content comprising an image that is the same size as the advertisement display area, the image showing a single commercial transaction target, wherein ~~each of~~ a plurality of partial areas that constitute the image of the advertisement content comprise a plurality of dot areas that each comprise a plurality of pixel units, the plurality of dot areas being respectively ~~included in the advertisement display area is~~ allocated to ~~one of~~ a plurality of providers providing the single commercial transaction target, and locations of dot areas allocated to each of the plurality of providers being randomly distributed in the image of the advertisement content;

acquiring code configured to cause at least one of said at least one processor to acquire position information including coordinates corresponding to a user input detected within the ~~advertisement display area~~ image of the single commercial transaction target, wherein the detected user input includes at least one of a clicking operation or a tapping operation on a dot area among the plurality of dot areas in the image of the advertisement content; and

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selecting code configured to cause at least one of said at least one processor to
~~select one of the providers based on the acquired position information, wherein each of the~~
~~plurality of partial areas comprises a plurality of dot areas that each comprise a plurality of pixel~~
~~units, the dot areas are randomly distributed within the advertisement display area and the~~
~~selecting one of the providers further comprises determining~~ determine the dot area
corresponding to the coordinates included in the acquired position information and select one of
the plurality of providers to which the determined dot area is allocated; and

controlling conde configured to cause at least one of said at least one processor to
control to transmit information matching the selected one of the plurality of providers to the
terminal device.

10. (Previously Presented) The information providing device according to claim 9,
wherein said program code further comprises area allocating code configured to cause at
least one of said at least one processor to allocate a partial area per provider based on a usage fee
for utilizing the advertisement display area.

11. (Previously Presented) The information providing device according to claim 10,
wherein said program code further comprises specifying count memory code configured
to cause at least one of said at least one processor to store a specifying count of the partial area
per partial area,
wherein the area allocating code is further configured to cause at least one of said at least
one processor to compare specifying counts of the stored respective partial areas, and allocate the
provider of a relatively high bid of the usage fee to a partial area of a relatively high specifying
count.

12. (Previously Presented) The information providing device according to claim 9,
wherein said program code further comprises allocation changing code configured to
cause at least one of said at least one processor to change a provider allocated to a partial area
based on a predetermined condition.

13. (Previously Presented) The information providing device according to claim 10,

wherein said program code further comprises allocation changing code configured to cause at least one of said at least one processor to change a provider allocated to the partial area based on a predetermined condition.

14. (Previously Presented) The information providing device according to claim 11,

wherein said program code further comprises allocation changing code configured to cause at least one of said at least one processor to change a provider allocated to the partial area based on a predetermined condition.

15. (Previously Presented) The information providing device according to claim 12,

wherein said program code further comprises specifying count memory code configured to cause at least one of said at least one processor to store a specifying count of the partial area per partial area,

wherein the allocation changing code is further configured to cause at least one of said at least one processor to change a provider allocated to a partial area whose specifying count exceeds a threshold.

16. (Previously Presented) The information providing device according to claim 13,

wherein said program code further comprises specifying count memory code configured to cause at least one of said at least one processor to store a specifying count of the partial area per partial area,

wherein the allocation changing code is further configured to cause at least one of said at least one processor to change a provider allocated to a partial area whose specifying count exceeds a threshold.

17. (Previously Presented) The information providing device according to claim 14,

wherein said program code further comprises specifying count memory code configured to cause at least one of said at least one processor to store a specifying count of the partial area per partial area,

wherein the allocation changing code is further configured to cause at least one of said at least one processor to change a provider allocated to a partial area whose specifying count exceeds a threshold.

18. (Currently Amended): An information providing method executed by a computer, the information providing method comprising:

transmitting display data over a network to a terminal device, the display data comprising one advertisement display area that includes advertisement content comprising an image that is the same size as the advertisement display area, the image showing a single commercial transaction target, wherein a plurality of partial areas that constitute the image of the advertisement content comprise a plurality of dot areas that each comprise a plurality of pixel units, the plurality of dot areas being respectively allocated to a plurality of providers providing the single commercial transaction target, and locations of dot areas allocated to each of the plurality of providers being randomly distributed in the image of the advertisement content;

acquiring position information including coordinates corresponding to a user input detected within the image of the single commercial transaction target, wherein the detected user input includes at least one of a clicking operation or a tapping operation on a dot area among the plurality of dot areas in the image of the advertisement content;

determining the dot area corresponding to the coordinates included in the acquired position information, and selecting one of the plurality of providers to which the determined dot area is allocated; and

controlling to transmit information matching the selected one of the plurality of providers to the terminal device.

~~transmitting display data over a network to a terminal device, the display data comprising an advertisement display area that includes advertisement content comprising an image that is the same size as the advertisement display area, the image showing a single commercial transaction target, wherein each of a plurality of partial areas included in the advertisement display area is allocated to one of a plurality of providers providing the single commercial transaction target;~~

~~acquiring position information including coordinates corresponding to user input detected within the advertisement display area, wherein the detected user input includes at least one of a clicking operation or a tapping operation; and~~

~~selecting one of the providers based on the acquired position information, wherein each of the plurality of partial areas comprises a plurality of dot areas that each comprise a plurality of pixel units, the dot areas are randomly distributed within the advertisement display area and the selecting one of the providers further comprises determining the dot area corresponding to the coordinates included in the acquired position information.~~