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EXAMINER	
SNIDER, SCOTT	

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

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 13/869,678	Applicant(s) RAO, BINDU RAMA	
	Examiner SCOTT SNIDER	Art Unit 3622	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 3 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 2/5/2018.

☐ 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) 9-10,13-15,17,19 and 22-24 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5a) Of the above claim(s) _____ is/are withdrawn from consideration.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) 9-10,13-15,17,19 and 22-24 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 allowable, 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 2/8/2018.

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

4) ☐ Other: _____.

DETAILED ACTION

Notice of Pre-AIA or AIA Status

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

Information Disclosure Statement

The Information Disclosure Statement(s) (IDS) submitted on 2/8/2018 have/has been considered by the examiner.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/5/2018 has been entered.

Claims 9, 10, 13-15, 17, 19 and 22-24 have been amended.

Claims 1-8, 16, 18, and 20 have been cancelled.

No claims have been added.

Claims 9-15, 17, 19, and 21-26 are currently pending.

Response to Arguments

Applicant argues that the amendments to the claims render them patent-eligible under 35 U.S.C. § 101. Examiner disagrees and has updated the rejection under this statute presented herein to reflect the amendments to the claims.

Applicant's remarks with respect to the prior art rejections presented in the previous office action are moot in view of the new grounds of rejection presented herein which were necessitated by Applicant's amendments to the claims.

Applicant's remarks with respect to limitations that Applicant alleges weren't addressed in the previous office action are unpersuasive as each and every limitation of the claims was accounted for in the rejections. It appears that Applicant was not familiar with the format of grounds of rejection utilized by this Examiner. Examiner has updated the rejections to hopefully make it easier to understand the mapping of claim limitations with the verbiage of the rejections under 35 U.S.C. § 103.

All other arguments have been considered and are not persuasive or are believed to have been addressed and therefore moot in view of the new grounds of rejection below.

Claim Rejections - 35 USC § 101

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.

Claims 9-15, 17, 19, and 21-26 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. Claim 1 is directed to the abstract idea of creating two versions of content and delivering an interactive version of the content to a device that supports the interactivity or a non-interactive version to a device that does not support interactive features. The claim(s) do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional computer elements, which are recited at a high level of granularity, provide, conventional computer functions that do not add meaningful limits to practicing the abstract idea.

Claim 1 recites, in part, a system/medium for performing or method consisting of the steps of receive user generated interactive media content, modify the content to create a first interactive version and a second non-interactive version, identify at least one profile characteristic from metadata within the content, identify profiles based on the profile characteristic, identify a device corresponding to the profile, provide the content to user device with the first version delivered to devices that support the interactive features or the second version to devices that do not support the interactive features. These steps described the concept identified above, which corresponds to concepts identified as abstract ideas by the courts, such as receiving, screening and distributing e-mail in *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1313 (Fed. Cir. 2016), collecting information, analyzing it, and displaying certain results of the collection and analysis in *Electric Power Group, LLC. v. Alstom S. A.,* component based interface to handle tasks during claim processing in *Accenture Global Services*, and detecting fraud in a credit card transaction in *Cybersource Corp.* More specifically, like the claims described in *Electric Power Group, LLC. v. Alstom S. A.* the claims in the instant application define "a desirable information-based

result and [are] not limited to inventive means of achieving the result"; therefore, they fail under 35 U.S.C. § 101.

The claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional elements when considered both individually and as an ordered combination do not amount to significantly more than the abstract idea. The claim recites performing the method on "a server comprising at least one processor" utilizing "at least one non-transitory computer readable storage medium storing instructions thereon" is an attempt to limit the use of the abstract idea to a particular technological environment, and amounts to no more than mere instructions to implement the idea on a computer, or 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.

Generic computer components recited as performing generic computer functions that are well-understood, routing and conventional activities amount to no more than implementing the abstract idea with a computerized system. Applicant's Specification teaches, in on page 25, Ll. 6-10, that "One of average skill in the art will also recognize that the functional building blocks, and other illustrative blocks, modules and components herein, can be implemented as illustrated or by discrete components, application specific integrated circuits, processors executing appropriate software and the like or any combination thereof". Therefore, it is clear from Applicant's specification that the claims require no more than a generic device.

Independent claim(s) 19 and 23 contain similar subject matter to claim 1 and therefore is/are rejected under 35 U.S.C. § 101 based on similar rationale. Dependent claims 10-15, 17, 21, 22, and 24-26 are rejected as ineligible subject matter under 35 U.S.C. § 101 based on rationale similar to that of the rejection of the claims from which they depend.

Thus, taken alone, the additional elements do not amount to significantly more than the above-identified judicial exception (the abstract idea). Looking at the limitations as an ordered combination adds nothing that is not already present when looking at the elements taken individually. There is no indication that the combination of elements improves the functioning of a computer or improves any other technology. Their collective functions merely provide conventional computer implementation.

See "2014 Interim Guidance on Patent Subject Matter Eligibility" in the Federal Register (79 Fed. Reg. 74618), the "July 2015 Update: Subject Matter Eligibility", and the "May 2016 Subject Matter Eligibility Update" which are available at: http://www.uspto.gov/patent/laws-and-regulations/examination-policy/examination-guidance-and-training-materials.

Claim Rejections - 35 USC § 103

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.

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.

Claim 9-15, 17, and 19-26 is/are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Ramer et al. (Pub. #: US 2008/0009268 A1) in view of Maes et al. (Pub. #: US 7,685,252 B1) in view of Smith et al. (Pub. #: US 7,337,127 B1).

Claim 9:

A system comprising: a server comprising at least one processor; at least one non-transitory computer readable storage medium storing instructions thereon that, when executed by the at least one processor, cause the system to:

(**Ramer**: "[0318] It will be appreciated that the above processes, and steps thereof, may be realized in hardware, software, or any combination of these suitable for a particular application. The hardware may include a general purpose computer and/or dedicated computing device. The processes may be realized in one or more microprocessors, microcontrollers, embedded microcontrollers, programmable digital signal processors or other programmable device, along with internal and/or external memory...")

receive user generated interactive media content;

(**Ramer**: "[1063] ... For example, an advertisement 2004 may have content that requires a Java-enabled device. Therefore, it may be desirable for the advertisement 2004 to present its content only on those mobile communication facilities that are Java-enabled.")

... identify a plurality of recipient devices corresponding to a plurality of recipient profiles corresponding to a profile characteristic from metadata within the user generated interactive media content;...

(**Ramer**: [1035]-[1044] **and** "[1060] In embodiments, an advertisement 2002 may be presented to a mobile communication facility 102 based at least in part on information relating to mobile subscriber characteristics 112. This information may include a user's individual demographic variables contained in the mobile subscriber characteristics database 112, such be age, sex, race, religion, an area code, zip code, a home address, a work address, a billing address, credit information, family information, income range, birth date range, birthplace, employer, job title, length of employment, an affiliation or other such information as described herein. The mobile subscriber characteristic 112 may be associated with a personal filter. The mobile subscriber characteristic may be used in conjunction with a collaborative filter. The mobile subscriber characteristic 112 may include an aggregate of user characteristics or include a range of values. The range of values of a user characteristic may be a range of a user demographic. The range of values of a user characteristic may be a range of behaviors, or a range of age.")

Ramer teaches receiving interactive content by the disclosure of advertiser content requiring a java-enable phone in at least [1063]. Ramer in turn teaches presenting the "sponsored link" to the user wherein the "sponsored link" may contain "a space tailored for the user" in at least [0328] which contains variable data dependent upon system data such as time, location data, and volume of restaurant traffic which corresponds to "add system generated content to the user generated interactive media content". Ramer teaches providing content appropriate to a device based on that device's capabilities in at least [0749], [1063], [1064], and [0412] which corresponds to "determine that at least one mobile recipient device of the plurality of recipient devices includes the interactive-media-client component" and "select the first version of the interactive media survey for delivery to that at least one mobile recipient device". Ramer does not

appear to specify creating two separate versions with the first comprising interactive elements for navigating within the interactive media survey and the second for use with a web browser and not for use with interactive-media-client component. However, Maes teaches creating multiple versions of content from a base input language in at least Col. 6, L. 59 to Col. 7, L. 36, Col. 14, Ll. 25-49 and teaches a "web browser" version that includes "the first question and the second question" and interacting elements associated with each in at least Figure 6B.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Ramer with the use of different versions of content as taught by Maes in order to produce content that is "modality-independent" (Maes: Col. 7, Ll. 28-36) because the present disclosure is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Ramer does not appear to specify content that comprises a survey. However, Smith teaches an advertising system that presents users with surveys to users in at least Col. 6, L. 43 – Col. 7, L. 26.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Ramer with the method of presenting surveys as content as taught by Smith in order to better target advertising because the present disclosure is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 10:

further comprising instructions that, when executed by the at least one processor, cause the system to provide the second segment of the interactive media survey to the at least one mobile recipient device based on receiving an indication of a user interaction with the first navigation element from the at least one mobile recipient device

(**Ramer**: [0337])

Claim 11:

further comprising instructions that, when executed by the at least one processor, cause the system to provide a link for downloading the interactive-media-client component to at least one of the plurality of recipient devices.

(**Ramer**: [0322] and [1000]-[1005])

Claim 12:

further comprising instructions that, when executed by the at least one processor, cause system to send a push notification to the at least one mobile recipient device, wherein the push notification references the first version of the interactive media survey.

(**Ramer**: "[0109] The implicit query facility 164 provides for the display of relevant content to users based on user activities other than explicit search queries. For example, in GPS data the locator facility 110 may indicate that the cell phone user is in the vicinity of a sponsor's restaurant. In addition, the clock contained in the mobile communication facility 102 and/or the wireless communication facility may indicate that it is mid-evening. A predictive algorithm could merge this information and make the implicit query that the user is interested in restaurants in his immediate vicinity at which he could purchase dinner, and then push content (ads, phone numbers, menus, reviews) to his mobile communication facility 102 for immediate display. Other implicit queries could similarly be based upon a user's parental controls 150, the carrier business rules 158, results facility 148, and so forth, either alone or in combination." **and** "[0326] An implicit search scenario associated with the illustration of FIG. 11 could be as follows. The person 1104 is walking down the street at 7:00 p.m. The location of the mobile communication facility 102 is assessed using a GPS system (i.e. in association with the location facility 110). The location is then stored. An implicit search is initiated either because it is the time of day for the periodic implicit search, because user habits indicate the user is going to be looking for results soon, because there are advertisers 17 4 interested in pushing an advertisement, there is a local sale, there is an activity nearby, or there are other temporal, activity based, or other reasons to initiate the implicit search. Once the search is initiated, the stored location information may be transmitted to a mobile search host facility...")

Claim 13:

wherein the metadata within the user generated interactive media content comprises a category identification, and a target profile description.

(**Ramer**: [1035]-[1044], [1052], and [1060])

Claim 14:

wherein the first version of the interactive media survey comprises at least one of a graphic element, an audio element, a textual element, or a video element.

(**Ramer**: "[0749] In embodiments, an auction for search marketing may be performed related to a presentation of sponsored content on a mobile communication facility 102, wherein the sponsored content is related to aggregated content. Content, for example ringtone content, music content, or video content, may be aggregated through a spider, and presented by category in a high level aggregated form. The spider may determine the compatibility of the content with the capabilities of the mobile communication facility 102...")

Claim 15:

further comprising instructions that, when executed by the at least one processor, cause the system to add the system generated content to the user generated interactive media content by modifying at least one of the graphic element, the audio element, the textual element, or the video element.

(**Ramer**: "[1063] In embodiments, an advertisement 2004 may be presented to a mobile communication facility 102 based at least in part on information relating to a mobile communication facility 102. This information may form parameters that limit the advertisement 2002 search results to those compatible with, relevant to, or preferred for presentation on a given type of mobile communication facility 102. The display of advertisement 2002 result set(s) may, thus, omit information, prioritize information (e.g., presenting sponsor links prior to all others), highlight a subset of the search result set, or order the display of information based upon the presence or absence of a mobile communication facility 102 or a feature of a mobile communication facility 102. Examples of representative elements that may be stored within the mobile subscriber characteristics database 112 include search history, a parental control, or a carrier business rule 130, display resolution, processing speed, audio capability, visual capability,

and other technical characteristics. For example, an advertisement 2004 may be associated with only the subset of mobile communication facility 102 models that are best suited for presentation of the advertisement's 2004 content due to technological requirements for the content to optimally present. For example, an advertisement 2004 may have content that requires a Java enabled device. Therefore, it may be desirable for the advertisement 2004 to present its content only on those mobile communication facilities that are Java-enabled.")

Claim 17:

wherein the profile characteristic comprises a registration to a category of interactive survey.

(**Ramer**: Claim 1 and Claim 37 and "[0082] User preferences may be derived from user behavior or other implicit characteristics, or explicitly defined by a mobile communication facility user, or some combination of these..." and "[0080] The algorithm facility 144 may contain a collaborative filtering protocol, category filtering, a recommendation system and/or other process facilities for analyzing, refining, or filtering user input and/or search results...")

Claim 19:

A method comprising: receiving user generated interactive media content,

(**Ramer**: "[1063] ... For example, an advertisement 2004 may have content that requires a Java-enabled device. Therefore, it may be desirable for the advertisement 2004 to present its content only on those mobile communication facilities that are Java-enabled." and "[0412] In embodiments, a query entry 120 may be processed on a mobile communication facility 102 that produces sponsored results on the display of the mobile communication facility 102. Sponsor results may be paid inclusion results, auction results, or pay-per-click results (in connection with a WAP site or a phone number). A sponsor of the sponsored result may receive compensation as a result of activity associated with a mobile communication facility 102 phone number. The presentation of the sponsored results may be formatted as a link, presented as text, as a picture, as a video, or as an interactive application. Content may be formatted for the mobile communication facility 102 and relate to webpage content or links for syndicated advertisements...")

...identifying a plurality of recipient devices corresponding to a plurality of recipient profiles corresponding to a profile characteristic from metadata within the user generated interactive media content;...

(**Ramer**: [1035]-[1044] **and** "[1060] In embodiments, an advertisement 2002 may be presented to a mobile communication facility 102 based at least in part on information relating to mobile subscriber characteristics 112. This information may include a user's individual demographic variables contained in the mobile subscriber characteristics database 112, such be age, sex, race, religion, an area code, zip code, a home address, a work address, a billing address, credit information, family information, income range, birth date range, birthplace, employer, job title, length of employment, an affiliation or other such information as described herein. The mobile subscriber characteristic 112 may be associated with a personal filter. The mobile subscriber characteristic may be used in conjunction with a collaborative filter. The mobile subscriber characteristic 112 may include an aggregate of user characteristics or include a range of values. The range of values of a user characteristic may be a range of a user demographic. The range of values of a user characteristic may be a range of behaviors, or a range of age.")

Ramer teaches receiving interactive content by the disclosure of advertiser content requiring a java-enable phone in at least [1063]. Ramer in turn teaches presenting the "sponsored link" to the user wherein the "sponsored link" may contain "a space tailored for the user" in at least [0328] which contains variable data dependent upon system data such as time, location data, and volume of restaurant traffic which corresponds to "adding system generated content to the user generated interactive media content". Ramer teaches providing content appropriate to a device based on that device's capabilities in at least [0749], [1063], [1064], and [0412] which corresponds to "determine that at least one mobile recipient device of the plurality of recipient devices includes the interactive-media-client component" and "select the first version of the interactive media survey for delivery to that at least one mobile recipient device". Ramer does not appear to specify creating two separate versions with the first comprising interactive elements for navigating within the interactive media survey and the second for use with a web browser and not for use with interactive-media-client component. However, Maes teaches creating multiple

versions of content from a base input language in at least Col. 6, L. 59 to Col. 7, L. 36, Col. 14, Ll. 25-49 and teaches a "web browser" version that includes "the first question and the second question" and interacting elements associated with each in at least Figure 6B.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Ramer with the use of different versions of content as taught by Maes in order to produce content that is "modality-independent" (Maes: Col. 7, Ll. 28-36) because the present disclosure is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Ramer does not appear to specify content that comprises a survey. However, Smith teaches an advertising system that presents users with surveys to users in at least Col. 6, L. 43 – Col. 7, L. 26.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Ramer with the method of presenting surveys as content as taught by Smith in order to better target advertising because the present disclosure is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 21:

further comprising providing, via a communications network and to a computing device associated with an administrator, an interface for creating the user generated interactive media content.

(**Ramer**: "[1031] An aspect of the present invention relates to providing sponsored links. In embodiments a sponsor may be provided with an interface to allow it to enter sponsor information, such as bidding information, content to be presented in the event a bid is won,...")

Claim 22:

wherein the metadata within the user generated media content further comprises: a description of the user generated interactive media content

(**Ramer**: "[0446]... When creating an ad, the advertiser may supply information, such as, an ad title, URL, description, and/or website URL. Pay-Per-Call advertising combines search functionality 142 with live on-the-phone interaction, resulting in a powerful marketing opportunity for local businesses.")

Claim 23:

A non-transitory computer readable storage medium having stored thereon computer-executable instructions that, when executed by a processor, cause the computer to:

(**Ramer**: "[0318] It will be appreciated that the above processes, and steps thereof, may be realized in hardware, software, or any combination of these suitable for a particular application. The hardware may include a general purpose computer and/or dedicated computing device. The processes may be realized in one or more microprocessors, microcontrollers, embedded microcontrollers, programmable digital signal processors or other programmable device, along with internal and/or external memory...")

receive user generated interactive media content;

(**Ramer**: "[1063] ... For example, an advertisement 2004 may have content that requires a Java-enabled device. Therefore, it may be desirable for the advertisement 2004 to present its content only on those mobile communication facilities that are Java-enabled." and "[0412] In embodiments, a query entry 120 may be processed on a mobile communication facility 102 that produces sponsored results on the display of the mobile communication facility 102. Sponsor results may be paid inclusion results, auction results, or pay-per-click results (in connection with a WAP site or a phone number). A sponsor of the sponsored result may receive compensation as a result of activity associated with a mobile communication facility 102 phone number. The presentation of the sponsored results may be formatted as a link, presented as text, as a picture, as a video, or as an interactive application. Content may be formatted for the mobile communication facility 102 and relate to webpage content or links for syndicated advertisements...")

...identify a plurality of recipient corresponding to a plurality of recipient profiles corresponding to a profile characteristic from metadata within the user generated interactive media content;...

(**Ramer**: [1035]-[1044] **and** "[1060] In embodiments, an advertisement 2002 may be presented to a mobile communication facility 102 based at least in part on information relating to mobile subscriber characteristics 112. This information may include a user's individual demographic variables contained in the mobile subscriber characteristics database 112, such be age, sex, race, religion, an area code, zip code, a home address, a work address, a billing address, credit information, family information, income range, birth date range, birthplace, employer, job title, length of employment, an affiliation or other such information as described herein. The mobile subscriber characteristic 112 may be associated with a personal filter. The mobile subscriber characteristic may be used in conjunction with a collaborative filter. The mobile subscriber characteristic 112 may include an aggregate of user characteristics or include a range of values. The range of values of a user characteristic may be a range of a user demographic. The range of values of a user characteristic may be a range of behaviors, or a range of age.")

Ramer teaches receiving interactive content by the disclosure of advertiser content requiring a java-enable phone in at least [1063]. Ramer in turn teaches presenting the "sponsored link" to the user wherein the "sponsored link" may contain "a space tailored for the user" in at least [0328] which contains variable data dependent upon system data such as time, location data, and volume of restaurant traffic which corresponds to "add system generated content to the user generated interactive media content". Ramer teaches providing content appropriate to a device based on that device's capabilities in at least [0749], [1063], [1064], and [0412] which corresponds to "determine that at least one mobile recipient device of the plurality of recipient devices includes the interactive-media-client component" and "select the first version of the interactive media survey for delivery to that at least one mobile recipient device". Ramer does not appear to specify creating two separate versions with the first comprising interactive elements for navigating within the interactive media survey and the second for use with a web browser and not for use with interactive-media-client component. However, Maes teaches creating multiple

versions of content from a base input language in at least Col. 6, L. 59 to Col. 7, L. 36, Col. 14, Ll. 25-49 and teaches a "web browser" version that includes "the first question and the second question" and interacting elements associated with each in at least Figure 6B.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Ramer with the use of different versions of content as taught by Maes in order to produce content that is "modality-independent" (Maes: Col. 7, Ll. 28-36) because the present disclosure is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Ramer does not appear to specify content that comprises a survey. However, Smith teaches an advertising system that presents users with surveys to users in at least Col. 6, L. 43 – Col. 7, L. 26.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Ramer with the method of presenting surveys as content as taught by Smith in order to better target advertising because the present disclosure is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 24:

further comprising instructions that, when executed by the at least one processor, cause the system to receive a pull notification from the at least one mobile recipient device, wherein the pull notification references the first version of the interactive media survey.

(**Ramer**: [0328] and [0449])

Claim 25:

further comprising providing a link for downloading the interactive-media-client component to at least one of the plurality of recipient devices.

(**Ramer**: [0322] and [1000]-[1005])

Claim 26:

further comprising instructions that, when executed by the at least one processor, cause the computer system to provide a link for downloading the interactive-media-client component to at least one of the plurality of recipient devices.

(**Ramer**: [0322] and [1000]-[1005])

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT SNIDER whose telephone number is (571)272-9604. The examiner can normally be reached on M-F: 9:00-4:30 Mountain (11:00-6:30 Eastern).

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, Rob Wu can be reached on (571)272-3136. 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.

/ SMS /

/MICHAEL BEKERMAN/
Primary Examiner, Art Unit 3621

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

In re application of:	Bindu Rama Rao	
Application No.:	13/869,678	
Filed:	April 24, 2013	Art Unit
Conf. No.:	4376	3621
For:	SYSTEM FOR CREATING AND DISTRIBUTING INTERACTIVE ADVERTISEMENTS TO MOBILE DEVICES	
Examiner:	Scott Snider	
Customer No.:	151970	

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

Pursuant to the Notice of Appeal received by the U.S. Patent and Trademark Office on July 3, 2018, Appellant hereby submits this Appeal Brief in support of the appeal of the rejection set forth in the Office Action mailed on April 5, 2018 ("*Office Action*").

TABLE OF CONTENTS

REAL PARTY IN INTEREST

The real party in interest is Qualtrics, LLC, located at 2250 North University Parkway, No. 48C, Provo, UT 84604. Qualtrics, LLC is the assignee of the entire right, title, and interest in the subject application, as shown by an assignment recorded on Reel 036766, Frames 0709-0710, 0714.

RELATED APPEALS, INTERFERENCES, AND TRIALS

Appellant is unaware of any prior or pending appeals, interferences, trials, or judicial proceedings related to this appeal, as defined by 37 C.F.R. § 41.37.

SUMMARY OF CLAIMED SUBJECT MATTER

Claims 9-15, 17, 19, and 21-26 are pending with claims 9, 19, and 23 written in independent form. The independent claims generally cover a technology that creates a first version of an interactive media survey for use with an "interactive-media-client component" and a second version of the interactive media survey for use with a "web browser." Based on identifying a mobile recipient device that includes the interactive-media-client component, the claimed technology provides the interactive-media-client-component version of the interactive media survey to the mobile recipient device. Unlike conventional electronic survey systems at the time of filing, the first version of the interactive media survey comprises segments with different questions and navigation elements for navigating within the interactive media survey presented by the interactive-media-client component. *See, e.g.*, System for Creating and Distributing Interactive Advertisement to Mobile Devices, Specification, Application No. 13/869,678 (filed Apr. 24, 2013) (hereinafter "*Specification*") at [57] (abstract); *id.* 10:16-23, 11:12-20, 11:21-12:8, 12:16-22, 19:6-16; *id.* figs. 3A-3B.[1]

[1] This appeal brief cites column and line number of the *Specification* in its citations. Accordingly, a citation to "10:16-23" refers to column 10, lines 16-23, of the *Specification*.

In particular, independent claims 9, 19, and 23 respectively recite a system, a method, and a non-transitory computer readable medium comprising (or having instructions for) receiving "user generated interactive media content," *see, e.g.*, *id.* at 9:11-10:5, 11:1-9, 13:7-14:2, 16:14-17:2, FIG. 2, and adding "system generated content to the user generated interactive media content," *see, e.g.*, *id.* at 9:16-10:5, 13:1-14:2, FIG. 2.[2] By adding such content, the claimed system, method, and computer-readable medium facilitate creating "a first version of an interactive media survey for use with an interactive-media-client component" and "a second version of the interactive media survey for use with a web browser and not for use with the interactive-media-client component." *See, e.g.*, *id.* at 7:13-18, 8:4-7, 9:2-10, 10:16-23, 11:12-20, 11:21-12:8, 12:16-22, 19:6-16, 20:14-18; *id.* figs. 3A-3B.

Critical to the novelty rejections on appeal, the first version of the interactive media survey comprises "a first segment of the interactive media survey" and "a second segment of the interactive media survey." *See, e.g.*, *id.* at 8:4-7, 12:16-22, 16:14-21, 17:3-11, 17:12-17. The first segment includes "a first survey question and a first navigation element for navigating within the first version of the interactive media survey," and the second segment includes "a second survey question and a second navigation element for navigating within the first version of the interactive media survey." *See, e.g.*, *id.* at 8:4-7, 12:16-22, 16:14-21, 17:3-11, 17:12-17, FIGS. 3A-3B. By contrast, the second version of the interactive media survey comprises "an individual segment that includes the first question and the second question." *See, e.g.*, *id.* at 10:16-23, FIG. 3A; U.S. Provisional Application No. 60/530,175 at 4, 10 (incorporated by reference in the *Specification*).

[2] Independent claim 9 recites a system comprising "at least one-non-transitory computer readable storage medium storing instructions thereon that, when executed by the at least one processor, cause the system to" perform several acts. Similarly, independent claim 23 recites "[a] non-transitory computer readable medium having stored thereon computer-executable instructions that, when executed by at least one processor, cause the computer system to" perform several acts. For ease of reference, this appeal brief generally refers to a "system having instructions" when describing claim 9 and a "computer-readable medium having instructions" when describing claim 23.

Having created different versions of the interactive media survey, the claimed system, method, and computer-readable medium comprise (or have instructions for) identifying "a plurality of recipient devices corresponding to a plurality of recipient profiles corresponding to a profile characteristic from metadata within the user generated interactive media content." *See, e.g., id.* at 13:11-14:2, 15:5-7, 18:10-13. The claimed system, method, and computer-readable medium further comprise (or have instructions for) determining that "at least one mobile recipient device of the plurality of recipient devices includes the interactive-media-client component," *see, e.g., id.* at [57] (abstract), 10:16-23, 11:21-12:8, and—based on that determination—selecting the "first version of the interactive media survey for delivery to the at least one mobile recipient device," *see, e.g., id.* at [57] (abstract), 10:16-23, 11:21-12:8, 21:16-17. After selecting the first version, the claimed system, method, and computer-readable medium comprise (or have instructions for) providing the "first version of the interactive media survey to the at least one mobile recipient device," where this first version comprises the "user generated interactive media content and the system generated content for presentation on the at least one mobile recipient device." *See, e.g., id.* at 14:23-15:1, 20:21-22, 23:4-7; *id.* fig. 5.

SUMMARY OF THE OFFICE ACTION

The *Office Action* (at 3-5) rejects the pending claims as patent ineligible under the judicial exception to 35 U.S.C. § 101 for covering an alleged abstract idea recognized by *Alice Corp. Property Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014). Under *Alice* step one, the *Office Action* (at 3) asserts that the claims are "directed to the abstract idea of creating two versions of content and delivering an interactive version of the content to a device that supports the interactivity or a non-interactive version to a device that does not support interactive features."

Under *Alice* step two, the *Office Action* (at 4) asserts that the "claims" to not include additional elements that amount to "significantly more" than the alleged abstract idea. Rather, the

Office Action (at 4) states that the independent claim references a server, a processor, and a non-transitory computer readable storage medium to perform "generic computer functions that are well-understood, routine, and conventional activities previously known to the pertinent industry." The *Office Action* (at 4) adds that independent claims 19 and 23 "contain similar subject matter" and are rejected "based on [a] similar rationale." But the *Office Action* fails to (i) identify which functions are generic; (ii) find that such functions are widely prevalent or in common use; or (iii) support its conclusions of "well-understood, routine, and conventional activities" with citation to a statement in the *Specification*, a court decision, a publication, or official notice.

The *Office Action* (at 5-16) further rejects independent claims 9, 19, and 23 (and various dependent claims) as obvious under 35 U.S.C. § 103 based on a combination of U.S. Patent Publication No. 2008/0009268 to Ramer et al. (hereinafter "*Ramer*"), U.S. Patent No. 7,685,252 to Maes et al. (hereinafter "*Maes*"), and U.S. Patent No. 7,337,127 to Smith et al. (hereinafter "*Smith*").

Ramer discloses a method and system of receiving "a search request and information relating to a mobile communication facility," such as a mobile phone, and then "determining if the mobile communication facility is authorized to receive a type of mobile content relating to the search request." *Ramer* ¶ [0005]. *Ramer*'s system presents sponsored advertisements to "a mobile communication facility 102 based at least in part on information relating to mobile subscriber characteristics 112," such as age or other demographic information. *Id.* ¶ [1060]. *Ramer*'s system also presents sponsored advertisements to the mobile communication facility "based at least in part on information relating to" the mobile communication facility. *Id.* ¶ [1063]. For example, *Ramer*'s system selects an advertisement that "may be associated with only the subset of mobile communication facility 102 models that are best suited for presentation of the advertisement's 2004 content due to technological requirements for the content," such as an

advertisement having "content that requires a Java-enabled device." *Id.* But as the *Office Action* concedes (at 6-7), *Ramer* does not disclose "creating two separate versions [of an interactive media survey] with the first comprising interactive elements for navigating within the interactive media survey and the second for use with a web browser" (which paraphrases certain independent-claim limitations).

The *Office Action* instead relies on *Maes* for these paraphrased claim limitations. *Maes* discloses an XML-based language called "Conversational Markup Language" (or "CML") that represents "dialogs" or "conversations" a user may have with any computing device, such as text, graphical, and speech-based user interactions. *See Maes* at [57] (abstract). In some embodiments, a device "operating with downloaded CML code can transcode to, for example, HTML and VoiceXML, substantially simultaneously so as to synchronize the multiple browsers providing the user with access to information." *Id.* col. 4 ll. 60-64. The *Office Action* (at 7) cites a passage from *Maes*, *id.* col. 6 l. 59 – col. 7 l. 37, and Figure 6B from *Maes* to assert that *Maes* discloses creating two different versions of the interactive media survey. But the *Office Action* does not explain or analyze the cited passage or figure.

The *Office Action* (at 7) further recognizes that *Ramer* does not "specify content that comprises a survey" and relies on *Smith* for disclosing such a survey. *Smith* describes a method "for targeting marketing content to an online user" that includes "steps of collecting data describing the user in a user profile." *Smith* at [57] (abstract). In one embodiment, *Smith*'s method presents "[c]ontext-specific survey questions and random survey questions" as a viewer views content on a website. *Id.* col. 6 ll. 43-48. A user may be "browsing for a pair of shoes," for example, when *Smith*'s method presents a question in a browser "asking for the user's shoe size." *Id.* col. 6 l. 64 – col. 7 l. 7.

Despite citing *Ramer*, *Maes*, and *Smith* as allegedly disclosing some of the independent-claim limitations, the *Office Action* neither mentions nor cites prior-art references for significant independent-claim limitations describing components of the claimed first version of the interactive media survey: (i) "a first segment of the interactive media survey that includes a first survey question and a first navigation element for navigating within the first version of the interactive media survey" and (ii) "a second segment of the interactive media survey that includes a second survey question and a second navigation element for navigating within the first version of the interactive media survey." Nor does the *Office Action* (at 6-7) attempt to explain what objects in *Ramer* (or other prior-art references) allegedly constitute the claimed "interactive-media-client component." Appellant has repeatedly asked the Examiner to identify each claim limitation within the prior-art references, but this *Office Action* (like previous office actions) continues to fail to analyze each independent-claim limitation.

ARGUMENT

This appeal concerns a technology that solves inflexible limits of conventional electronic survey systems. Instead of then-existing system's use of a web page for an electronic survey delivered to any computing device accessing a network, the independent claims recite a technology that creates different versions of an interactive media survey for use with an "interactive-media-client component" and a "web browser" and—based on identifying a mobile recipient device that includes the interactive-media-client component—provides the interactive-media-client-component version of the interactive media survey to the mobile recipient device. Pursuant to *Alice* step one, the pending claims are patent eligible because they recite a concrete improvement to existing technology by introducing a flexible model of creating different versions of an interactive media survey and providing one such version to a mobile device based on identifying an interactive-media-client-component-enabled device. Pursuant to *Alice* step two, the pending claims are patent eligible because they recite a technological software-compatibility solution for delivery of interactive media surveys to mobile devices. Beyond disclosing patent eligible subject matter, the claimed technology is patentable over the cited art because it introduces a unique combination of creating different versions of an interactive media survey comprising unique segments found nowhere in the cited prior art.

Pursuant to binding precedent, the *Office Action* fails to carry the Examiner's burden of establishing *prima facie* support for his rejections under 35 U.S.C. §§ 101 and 103. *See Manual of Patent Examining Procedure* § 2106 (III) (explaining that the examiner bears the initial burden to show a *prima facie* case of patent ineligibility); *id.* § 2142 (explaining that the examiner bears the initial burden to show a *prima facie* case of obviousness). The *Office Action* cannot carry that burden to establish patent ineligibility when the Examiner fails to accurately identify an abstract idea either recognized by the courts or covered by the independent claims. The *Office Action* likewise cannot carry that burden to establish obviousness when the Examiner fails to analyze

significant limitations of the independent claims. For these and the other reasons set forth below, Appellant respectfully requests that the Patent Trial and Appeal Board (hereinafter "Board") reverse the rejections of claims 9-15, 17, 19, and 21-26.

I. THE TWO-STEP *ALICE* ANALYSIS SHOWS THAT INDEPENDENT CLAIMS 9, 19, AND 23 RECITE PATENT ELIGIBLE SUBJECT MATTER

The pending claims fall squarely within the categories Congress has approved as patent eligible under 35 U.S.C. § 101. The *Office Action* does not dispute the claims' statutory eligibility, but instead relies on *Alice*'s judicial exception. Rather than establish ineligibility, *Alice*'s two-step test demonstrates that the independent claims are patent eligible.

A. Independent Claims 9, 19, and 23 Recite Patent Eligible Subject Matter Under *Alice* Steps One and Two

1. Independent claims 9, 19, and 23 recite a concrete improvement to creating different software versions of an interactive media survey for mobile devices

Contrary to the Examiner's assertion that the claims cover something abstract, the independent claims cover a concrete improvement to an electronic survey system by creating different versions of an interactive media survey for improved flexibility and by providing a device the interactive media survey based on determining whether the device includes an interactive media client component. As the Federal Circuit recently explained, "[s]oftware can make non-abstract improvements to computer technology." *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). In applying this principle, the court held that the *Enfish* claims were not directed to an abstract idea, but rather to "a specific improvement to the way computers operate, embodied in [a] self-referential table." *Id.* at 1336. The court found the claims for a self-referential table directed to an improvement in computer technology in part because the table "increased [the] flexibility" of a conventional database, *id.* at 1337, by using a "self-referential model" that could be "configured on-the-fly" to create structure within the database instead of deploying a relational

database that configures "various tables and relationships in advance of launching [a] database," *id.* at 1333. In other words, the claimed technology in *Enfish* was patent eligible because, among other things, the claimed technology introduced a more flexible model for a computer database that adapted to data as it became available.

Similar to *Enfish*, the pending independent claims recite a flexible model of creating different versions of an interactive media survey for use with an "interactive-media-client component" and a "web browser" and—based on identifying a mobile recipient device that includes the interactive-media-client component—providing the interactive-media-client-component version of the interactive media survey to the mobile recipient device. As noted in the background of the *Specification*, at the time of filing, conventional systems typically created "surveys or questionnaires . . . for Internet based access via a PC," but such surveys or questionnaires were "not appropriate for cell phone access" or other electronic devices containing "small screens with very limited viewing area." *Specification* at 3:1-2, 4:19-20. Despite having delivered such surveys or other content on a "full page of textual information . . . made available to a PC," conventional technology had yet to deliver "such information in a format that is useable and convenient" for a "mobile phone." *Id.* at 3:12-15, 4:3-6. Instead of continuing to provide the conventional full-page surveys or other textual information to devices regardless of their software components and screen size, the inventors introduced an electronic survey system that can create a version of an interactive media survey for an "interactive media client component" and another version for a "browser."

As set forth in independent claim 9, for example, the claimed system creates "a first version of an interactive media survey for use with an interactive-media-client component" and "a second version of the interactive media survey for use with a web browser and not for use with the interactive-media-client component." By creating two different versions of the interactive media survey, the claimed system sets up a flexible model that detects and provides interactive media

based on the recipient mobile device's software capabilities. As the *Specification* puts it, the system, "determines which recipient mobile device can handle interactive media (because they comprise the client component capable of handling the interactive media . . .), and which need to be sent a simpler subset of the interactive media that can be displayed/rendered without the client component, such as by the use of a browser in the recipient mobile device." *Specification* at 10:16-21.

While the technology in the pending application differs from *Enfish*, the claimed inventions are no less directed to an improvement in computer technology and qualify as patent eligible under the principles of *Enfish*. *See, e.g.*, *Core Wireless Licensing SARL v. LG Electronics*, 880 F.3d 1356, 1362 (Fed. Cir. 2018) (describing three different cases in which patents claimed different technologies and were found patent eligible as improvements to computer technology). While prior systems could provide computing devices with surveys through "webpages," *Specification* at 3:23, none of the prior systems capture the flexibility of creating different versions of interactive media surveys that could be provided based on a recipient mobile device's software capabilities. Accordingly, claimed electronic survey system is patent eligible under *Alice* step one because its creation and delivery of different versions of an interactive media survey improve the flexibility of conventional electronic survey systems. *Cf. Enfish*, 822 F.3d at 1335 (finding claims "directed to an improvement of an existing technology" in part because "the claimed invention . . . increased flexibility" compared to conventional databases).

2. The independent claims recite a technological solution to a technological problem inhibiting mobile devices with relatively small screens and different software capabilities from displaying interactive media surveys

Even if the independent claims were directed to an abstract idea, which they are not, the claimed technology is nevertheless patent eligible under *Alice* step two. The independent claims recite a technological solution to a technological software-compatibility problem for delivery of

interactive media surveys to mobile devices—based on the principles of *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016). In *BASCOM*, the Federal Circuit held that—even if claims were directed to an abstract idea under *Alice* step one—claims are nevertheless patent eligible when they "provid[e] a specific technical solution beyond simply using generic computer concepts in a conventional way." *Id.* at 1352. Among other things, the U.S. Patent and Trademark Office (hereinafter "Office") has interpreted *BASCOM* to mean that "an inventive concept may be found in the non-conventional and non-generic arrangement of . . . additional elements." Memorandum from Robert W. Bahr to Patent Examining Corps, "Recent Subject Matter Eligibility Decisions," at 2 (Nov. 2, 2016) (describing *BASCOM*).

The *BASCOM* court applied these principles to (1) a first group of claims that generally covered individual-customizable filtering of content on a remote Internet service provider ("ISP") server and (2) a second group of claims that further limited the custom filtering to using a server comprising a master-inclusive list. *See BASCOM*, 827 F.3d at 1345. Both groups of claims exploited an ISP's ability to associate a request for Internet content with a specific individual account. *Id.* at 1344. The *BASCOM* claims exploited this ability by locating the filtering system on the ISP's server to provide customized filtering for a user. *Id.* at 1344-45. Because the *BASCOM* patent provided "a technology-based solution (not an abstract-idea-based solution implemented with generic technical components in a conventional way) to filter content on the Internet that overcomes existing problems with other Internet filtering systems," the Federal Circuit held that the patent claims were eligible under *Alice* step two. *Id.* at 1351.

Similar to *BASCOM*, the pending claims are patent eligible because they solve a technological problem that hindered prior electronic survey systems from providing interactive media surveys to mobile devices with software compatibilities and screen sizes differing from conventional personal computers. As noted in the *Specification*, this application claims the benefit

of a provisional application filed on February 5, 2007. At the time of the application's effective filing, "[e]lectronic devices, such as mobile phones and personal digital assistants (PDA's), often contain[ed] small screens with very limited viewing area." *Specification* at 3:1-2. With smaller screens, mobile phones were generally "not endowed with the features or applications necessary to facilitate easy access to" information online. *Id.* at 3:12-15. Mobile devices often could not access "Internet based web-sites" in a satisfying or useful way because such sites were formatted with "multi-media and graphics rich format." *Id.* at 3:18-21.

As the *Specification* puts it, "[a] mobile phone with a small screen is not a good candidate for viewing such complicated and graphics rich (with graphics, flash screens, video components, etc.) content . . . . ." *Id.* at 3:19-21. The smaller screens not only complicated presenting websites and other network-based information on a mobile device, but also complicated soliciting feedback from mobile-device users. "[T]here is a problem in presenting a mobile user with information in order to solicit user input when the user is using a cell phone. Soliciting user input from a user when the user is using a cell phone, rather than a PC, is a big problem." *Id.* at 4:14-17. That problem prevented conventional survey systems from sending surveys to mobile devices because "[a]sking one or more detailed questions with information on how to answer them" proved "unmanageable and difficult to browse and navigate on a cell phone with a small LCD screen and small keyboard." *Id.* at 4:20 – 5:2.

As found patent eligible by the holding in *BASCOM*, the inventors of the pending application solved the software-compatibility problem by proposing an unconventional system that both combines different versions of an interactive media survey with determinations of whether mobile recipient devices include an interactive-media-client component for provision of an interactive-media-client-component version to a mobile recipient device. Rather than a one-size-fits-all approach to providing surveys with "detailed questions . . . on a web page," *id.* at 4:20-22,

the claimed technology takes "user generated interactive media content" and modifies it to create a first version of an interactive media survey for use with an "interactive-media-client component" and a second version of the interactive media survey for use with a "web browser." The two different versions create a flexible-option delivery with (i) the first version separating the interactive media survey into two segments with different "question[s]" and different "navigation element[s]" and (ii) the second version consolidating the different "question[s]" into an "individual segment of the interactive media survey."

By creating these different versions of the interactive media survey—and determining that "at least one mobile recipient device . . . includes the interactive-media-client component"—the claimed technology configures a selective provision model for the interactive-media-client component. On the one hand, the claimed system can determine "which recipient mobile device can handle interactive media" because such a device comprises "the client component capable of handling the interactive media." *Specification* at 10:16-19. On the other hand, the claimed system can determine which recipient mobile device "need[s] to be sent a simpler subset of the interactive media that can be displayed/rendered" with a "browser," and "without the client component." *Id.* at 10:19-21.

Appellant submits that the independent claim's limitations reciting the creation of two different versions of an interactive media survey—with a determination of a device's interactive-media-client-component capabilities—provide the "inventive concept" beyond any alleged abstract idea and make the pending claims patent eligible. *Alice*, 134 S. Ct. at 2355, 2357-59. In sum, similar to *BASCOM*, the disclosed electronic survey system provides a flexible interactive-media-survey delivery model that, at the time of effective filing, made for a "more dynamic and efficient" electronic survey system for mobile devices. *BASCOM*, 827 F.3d at 1351. The Board should accordingly reverse the *Office Action*'s eligibility rejections and find the independent claims patent eligible under *Alice* step two.

B. The *Office Action* Mischaracterizes the Independent Claims and Fails to Follow Federal Circuit Precedent Under *Alice* Steps One and Two

1. The Examiner fails to accurately identify an abstract idea recognized by a federal court or covered by the independent claims

As noted above, the *Office Action* at (3) rejects the claims as "directed to the abstract idea of creating two versions of content and delivering an interactive version of the content to a device that supports the interactivity or a non-interactive version to a device that does not support interactive features." This characterization of the claims misapplies and violates principles under *Alice* step one, as explained by *Enfish* and other recent Federal Circuit cases.

In *Enfish*, the Federal Circuit reiterated that under *Alice* step one, "'[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept.'" 882 F.3d at 1335 (quoting *Alice*, 134 S. Ct. at 2355). Rather than a mere formality for patent applications covering software, the Federal Circuit explained that "the first step of the inquiry is a meaningful one" and "that a substantial class of claims are *not* directed to a patent-ineligible concept." *Id.* (emphasis in original). To identify an abstract idea, the *Enfish* court reasoned that "both this court and the Supreme Court have found it sufficient to compare claims at issue to those claims already found to be directed to an abstract idea in previous cases." *Id.* at 1334. With a focus on the claims, the court cautioned that "describing the claims . . . untethered from the language of the claims all but ensures that the [judicial] exceptions to § 101 swallow the rule." *Id.* at 1337. The court further warned that "[t]he 'directed to' inquiry . . . cannot simply ask whether the claims *involve* a patent-ineligible concept, because essentially every routinely patent-eligible claim involving physical products and actions *involves* a law of nature and/or natural phenomenon." *Id.* at 1335.

The *Office Action* (at 3-4) misapplies these principles of *Alice* for at least two reasons. First, no "previous cases" recognize as abstract the idea set forth in the *Office Action*, *Enfish*, 882 F.3d at 1332—that is, "creating two versions of content and delivering an interactive version of

the content to a device that supports the interactivity or a non-interactive version to a device that does not support interactive features." This alleged abstract idea is unlike any held ineligible by the Supreme Court or Federal Circuit.

Second, the *Office Action*'s alleged abstract idea is "untethered from the language of the claims," *Enfish*, 882 F.3d at 1337, because it describes features nowhere to be found in the pending claims. Contrary to the *Office Action*'s assertions (at 3), the claims do not recite delivering "a non-interactive version to a device that does not support interactive features." While this phrase from the *Office Action* presumably refers to the "second version" of the interactive media survey, the plain language of the claims recite the opposite of a "non-interactive version"—that is, a "second version of the interactive media survey." By its own terms, the second version is an "interactive media survey" and is nowhere delivered to a device that "does not support interactive features."

The *Office Action*'s attempt to expand on the broader alleged abstract idea demonstrates that the Examiner's initial mischaracterization of the independent claims is not an isolated error. The *Office Action* (at 3) asserts that claim 1 (again, presumably claim 9) covers a method of steps that, among other things, "modify [interactive media] content to create a first interactive version and a second non-interactive version, identify at least one profile characteristic from metadata within the content, identify profiles based on the profile characteristic, identify a device corresponding to the profile, provide the content to user device with the first version delivered to devices that support the interactive features or the second version to devices that do not support the interactive features." But neither the independent nor dependent claims recite creating a "second non-interactive version," identifying "a device corresponding to the profile," or providing "the second version to devices that do not support the interactive features." Appellant does not know where these foreign concepts come from or why the Examiner has relied on them to mischaracterize the claims.

Both the Supreme Court and the Federal Circuit require consideration of the actual claim elements—both individually and as an ordered combination—under *Alice*. *See Alice*, 134 S. Ct. at 2355 (considering "the elements of each claim both individually and 'as an ordered combination' to determine whether the additional elements 'transform the nature of the claim' into a patent-eligible application"); *BASCOM*, 827 F.3d at 1350 ("The inventive concept inquiry [under *Alice* step two] requires more than recognizing that each claim element, by itself, was known in the art."). The *Office Action* cannot satisfy that command or establish a *prima facie* case of patent ineligibility when, as here, the Examiner analyzes the wrong claim elements.

In addition to its mischaracterization of the claims, the *Office Action*'s cursory comparison of the mischaracterized steps to unrelated cases from the Federal Circuit underscores the Examiner's inability to find a case holding a similar concept as abstract. Without explanation, the *Office Action* (at 3) asserts that the inaccurately recited steps from above "correspond[] to concepts" held ineligible in prior cases of the U.S. Court of Appeals for the Federal Circuit. In particular, the *Office Action* asserts that some unidentified steps correspond to "receiving, screening and distributing e-mail" from *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307 (Fed. Cir. 2016); "collecting information, analyzing it, and displaying certain results of the collection and analysis" from *Electric Power Group, LLC v. Alstom SA*, 830 F.3d 1350 (Fed. Cir. 2016); "component based interface to handle tasks during claim processing" from *Accenture Global Services, GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336 (Fed. Cir. 2013); and "detecting fraud in a credit card transaction" in *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366 (Fed. Cir. 2011). None of these cases have an apparent connection to the alleged (and inaccurate) abstract idea of "creating two versions of content and delivering an interactive version of the content to a device that supports the interactivity or a non-interactive version to a device

that does not support interactive features"—let alone to the actual limitations of the independent claims.

Rather than drawing an analogy to the pending independent-claim limitations, the Examiner appears to be simply repeating a boilerplate analysis for patent-eligibility rejections—regardless of subject matter. *Compare Office Action* at 3 ("These steps described [sic] the concept identified above, which corresponds to concepts identified as abstract ideas by the courts, such as receiving, screening and distributing email in Intellectual Ventures I LLC v. Symantec Corp., 838 F.3d 1307, 1313 (Fed. Cir. 2016), collecting information, analyzing it, and displaying certain results of the collection and analysis in Electric Power Group, LLC. V. Alstom S.A., component based interface to handle tasks during claim processing in Accenture Global Services, and detecting fraud in a credit card transaction in Cybersource Corp."), *with* U.S. Application No. 14/169,631, Office Action (Aug. 10, 2018) (Exam'r Scott Snider) at 8 (same verbatim analysis); U.S. Application No. 14/071,775, Office Action (July 12, 2018) (Exam'r Scott Snider) at 4 (same verbatim analysis); U.S. Application No. 13/290,915, Office Action (Jan. 25, 2018) (Exam'r Scott Snider) at 4 (same verbatim analysis).

Such a rote recitation for a patent-ineligibility rejection commits the same error, and results in the same outcome, as that warned against in *Enfish*. As in *Enfish*, "describing the claims [here] at . . . a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule." *Enfish*, 882 F.3d at 1337. The Board should prevent the Examiner from violating *Enfish* by reversing the *Office Action*'s ineligibility rejections.

2. The *Office Action* fails to support its findings of well-understood, routine, and conventional activities

As suggested above, the *Office Action* (at 4) asserts that the claims recite "generic computer components" that perform "generic computer functions that are well-understood, routine, and

conventional activities previously known to the pertinent industry." Based on *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018), the Office now requires examiners to find an element represents a "well-understood, routine, [and] conventional activity **only** when the examiner can readily conclude that the element(s) is widely prevalent or in common use in the relevant industry." Memoranda from Robert W. Bahr to the Patent Examining Corps, "Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*)," at 3 (Apr. 19, 2018) (emphasis in original). Such a finding "must be based upon a factual determination" supported by the application's specification, a statement during prosecution, a court decision, a publication, or an examiner's official notice. *Id.* at 3-4.

The *Office Action* (at 4) neither includes such factual determinations, nor cites evidence in support of its assertions, nor identifies which of the claim limitations include computer functions that are well-understood, routine, and conventional activities. Independent of the deficiencies argued above, Appellant submits that the Examiner's bald assertions of well-understood, routine, and conventional activities therefore constitute reversible error.

Contrary to the *Office Action*'s assertions, Appellant disputes that the pending independent claims recite well-understood, routine, or conventional activities to "a skilled artisan at the time of the patent." *Berkheimer*, 881 F.3d at 1369. For instance, the record does not (and cannot) establish that a skilled artisan would have found it well-understood, routine, or conventional to create "a first version of an interactive media survey for user with an interactive-media-client component" and "a second version of the interactive media survey for use with a web browser and not for use with the interactive-media-client component," as the independent claims recite. Accordingly, Appellant requests that the Board reverse the *Office Action*'s ineligibility rejections.

II. THE *OFFICE ACTION* HAS NOT AND CANNOT ESTABLISH A *PRIMA FACIE* CASE OF OBVIOUSNESS FOR THE INDEPENDENT CLAIMS BASED ON *RAMER*, *MAES*, AND *SMITH*.

The *Office Action* asserts that a combination of *Ramer*, *Maes*, and *Smith* renders independent claims 9, 19, and 23 obvious under 35 U.S.C. § 103. Under such a theory of obviousness—and per longstanding precedent of the Federal Circuit—the *Office Action* must demonstrate that *Ramer*, *Maes*, and *Smith* individually or together disclose "all of the elements" of the independent claims and that a skilled artisan "would have been motivated to combine" the references to perform the claimed elements with reasonable expectation of success. *Personal Web Technologies, LLC v. Apple, Inc.*, 848 F.3d 987, 991 (Fed. Cir. 2017) (vacating the Board's determination of obviousness in an *inter partes* review). To establish a *prima facie* case that the prior art discloses all such claim elements and that a skilled artisan would have been motivated to combine the prior art with a reasonable expectation of success, the *Office Action* must "adequately articulate [the examiner's] reasoning" in support of a conclusion of obviousness. *In re Stepan Co.*, 868 F.3d 1342, 1345-46, 1348 (Fed. Cir. 2017) (vacating the Board's determination of obviousness for failing to adequately articulate its reasoning in support of obviousness).

In this application, the *Office Action* fails to adequately articulate the examiner's reasoning in support of a legal conclusion of obviousness for at least three reasons. First, the *Office Action* nowhere recites or analyzes the following independent-claim limitations: (i) "a first segment of the interactive media survey that includes a first survey question and a first navigation element for navigating within the first version of the interactive media survey" or (ii) "a second segment of the interactive media survey that includes a second survey question and a second navigation element for navigating within the first version of the interactive media survey." When, as here, an office action fails to cite prior-art references for (or otherwise analyze) significant limitations of the independent claims, the office action does not "adequately articulate [the examiner's] reasoning"

in support of a conclusion of obviousness. *Stepan*, 868 F.3d at 1345-46, 1348. An examiner cannot demonstrate how prior-art references disclose "all of the elements" of the independent claims by simply ignoring some of those elements. *Personal Web*, 848 F.3d at 991.

The *Office Action*'s omission is not only outcome determinative for the § 103 rejection, but also telling in what the cited prior art fails to disclose. While *Maes* discloses transcoding a new code language into HTML and VoiceXML, *Maes* and *Ramer* nowhere describe or suggest creating two different versions of an interactive media survey with the particular segments recited in the independent claims. In particular, neither *Maes* nor *Ramer* disclose a "first version of the interactive media survey for use with an interactive-media-client component," where the first version comprises two segments with different "question[s]" and different "navigation element[s]," or a "second version of the interactive media survey for use with a web browser" comprising the same questions within "an individual segment," as the independent claims recite.

The *Office Action* makes little effort in making findings or assertions to the contrary. Indeed, the *Office Action* (at 7) concedes that *Ramer* does not disclose "creating two separate versions [of an interactive media survey] with the first comprising interactive elements for navigating within the interactive media survey and the second for use with a web browser." Beyond this concession, the *Office Action* (at 7) cites a passage from *Maes*, *id.* col. 6 l. 59 – col. 7 l. 37, and Figure 6B from *Maes* to assert that *Maes* discloses creating two different versions of the interactive media survey—without mention of the "first segment" or "second segment" as the independent claims recite. A mere citation without more does not adequately articulate the examiner's reasoning and fails to establish a *prima facie* case of obviousness.

Second, the *Office Action* nowhere identifies what in *Ramer* or *Maes* constitutes the "interactive-media-client component" from the independent claims. Rather than provide such an explanation, the *Office Action* (at 6) suggests that either paragraphs [0412], [0749], [1063], or [1064]

of *Ramer* disclose determining that a mobile recipient device "includes the interactive-media-client component." These paragraphs generally concern formatting "sponsor results" as a link, webpage, or interactive application, *Ramer* ¶ [0412]; a "spider" that "determine[s] the compatibility of . . . content with the capabilities of the mobile communication facility" and aggregates content (e.g., ringtone content, music content, or video content) for presentation to a mobile communication facility in aggregated form, such as by extracting content from a Wireless Access Protocol ("WAP") "compatible content site," *id.* ¶ [0749]; or presenting sponsored advertisements to the mobile communication facility "based at least in part on information relating to" the mobile communication facility, such as information that limits the advertisement "search results to those compatible with . . . a given type of mobile communication facility," *id.* ¶ [1063]. But the *Office Action* points to nothing specific (or provides no suggestion) as to what object from these paragraphs constitutes the claimed interactive-media-client component.

To the extent the *Office Action* suggests that referencing "mobile communication facilities that are Java-enabled," *Ramer* ¶ [1063], refers to an "interactive-media-client component," the *Office Action* fails to explain how *Maes* creates (for such a Java-enabled device) a "first version of the interactive media survey for use with an interactive-media-client component," where the first version comprises two segments with different "question[s]" and different "navigation element[s]," as the independent claims recite. While the *Office Action* relies on *Maes* as allegedly disclosing the creation of two different versions of interactive media, it says nothing of how the prior art could create a version for the "interactive-media-client component" with the claimed (and unanalyzed) segments.

Third, the *Office Action* further fails to "articulate why a person of ordinary skill in the art would have had a reasonable expectation of success" in combining the teachings of *Ramer* and *Maes*. *Stepan*, 868 F.3d at 1346-47 (holding that an obviousness determination requires the Board to "adequately articulate its reasoning" in finding both that "a skilled artisan would have been motivated

to combine the teachings of the prior art" and that "the skilled artisan would have had a reasonable expectation of success in doing so"). To be sure, the *Office Action* (at 7) suggests that a skilled artisan would have been motivated to modify *Ramer* with "different versions of content as taught by" *Maes* to produce modality-independent content and asserts that the "present disclosure is merely a combination of old elements." But the *Office Action* articulates no reasoning that would explain why a skilled artisan would have reasonably expected to modify *Ramer* based on *Maes* to successfully create a version of the interactive media survey for the "interactive-media-client component" with the claimed (and unanalyzed) segments. Nor has the *Office Action* established a basis for finding the disclosure "a combination of old elements" when the *Office Action* has not analyzed several of those elements.

When, as here, the *Office Action* concedes that one prior-art reference does not disclose a claim element and then fails to show the other cited prior-art references disclose (or otherwise renders obvious) the claim elements at issue, the *Office Action* fails to establish a *prima facie* case of obviousness under § 103. *See Personal Web Technologies*, 848 F.3d at 993-94. Here, the *Office Action* simply does not articulate its reasoning. Consequently, the *Office Action* fails to provide "evidence and a reasoned explanation" for how *Ramer*, *Maes*, and *Smith* could render the relevant limitations obvious. *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1363 (Fed. Cir. 2016) (reversing the Board's determination of obviousness in an *inter partes* review for failure to provide a reasoned explanation for how a claim limitation was obvious in light of the prior art). Because the *Office Action* fails to provide the necessary evidence and explanation to support a conclusion of obviousness, the Board should reverse the *Office Action*'s § 103 rejection of claims 9-15, 17, 19, and 21-26.

CONCLUSION

For the foregoing reasons, Appellant respectfully asks the Board to reverse the *Office Action*'s rejections of claims 9-15, 17, 19, and 21-26 under a judicial exception to § 101 and under § 103 and hold the pending claims both patent eligible and patentable over the cited prior art.

Dated September 4, 2018.

Respectfully submitted,

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CLAIMS APPENDIX

1-8. (Canceled).

9. (Previously Presented) A system comprising:

a server comprising at least one processor;

at least one non-transitory computer readable storage medium storing instructions thereon that, when executed by the at least one processor, cause the system to:

receive user generated interactive media content;

add system generated content to the user generated interactive media content to:

create a first version of an interactive media survey for use with an interactive-media-client component, wherein the first version of the interactive media survey comprises:

a first segment of the interactive media survey that includes a first survey question and a first navigation element for navigating within the first version of the interactive media survey; and

a second segment of the interactive media survey that includes a second survey question and a second navigation element for navigating within the first version of the interactive media survey;

create a second version of the interactive media survey for use with a web browser and not for use with the interactive-media-client component, wherein the second version of the interactive media survey comprises an individual segment that includes the first question and the second question;

identify a plurality of recipient devices corresponding to a plurality of recipient profiles corresponding to a profile characteristic from metadata within the user generated interactive media content;

determine that at least one mobile recipient device of the plurality of recipient devices includes the interactive-media-client component;

based on determining that the at least one mobile recipient device includes the interactive-media-client component, select the first version of the interactive media survey for delivery to the at least one mobile recipient device; and

provide the first version of the interactive media survey to the at least one mobile recipient device, the first version of the interactive media survey comprising the user generated interactive media content and the system generated content for presentation on the at least one mobile recipient device.

10. (Previously Presented) The system of claim 9, further comprising instructions that, when executed by the at least one processor, cause the system to provide the second segment of the interactive media survey to the at least one mobile recipient device based on receiving an indication of a user interaction with the first navigation element from the at least one mobile recipient device.

11. (Previously Presented) The system of claim 9, further comprising instructions that, when executed by the at least one processor, cause the system to provide a link for downloading the interactive-media-client component to at least one of the plurality of recipient devices.

12. (Previously Presented) The system of claim 9, further comprising instructions that, when executed by the at least one processor, cause the system to send a push notification to the at least one mobile recipient device, wherein the push notification references the first version of the interactive media survey.

13. (Previously Presented) The system of claim 9, wherein the metadata within the user generated interactive media content comprises a category identification and a target profile description.

14. (Previously Presented) The system of claim 9, wherein the first version of the interactive media survey comprises at least one of a graphic element, an audio element, a textual element, or a video element.

15. (Previously Presented) The system of claim 14, further comprising instructions that, when executed by the at least one processor, cause the system to add the system generated content to the user generated interactive media content by modifying at least one of the graphic element, the audio element, the textual element, or the video element.

16. (Canceled).

17. (Previously Presented) The system of claim 9, wherein the profile characteristic comprises a registration to a category of interactive surveys.

18. (Canceled).

19. (Previously Presented) A method comprising:

receiving user generated interactive media content;

adding system generated content to the user generated interactive media content to:

create a first version of an interactive media survey for use with an interactive-media-client component, wherein the first version of the interactive media survey comprises:

a first segment of the interactive media survey that includes a first survey question and a first navigation element for navigating within the first version of the interactive media survey; and

a second segment of the interactive media survey that includes a second survey question and a second navigation element for navigating within the first version of the interactive media survey;

create a second version of the interactive media survey for use with a web browser and not for use with the interactive-media-client component, wherein the second version of the interactive media survey comprises an individual segment that includes the first question and the second question;

identifying a plurality of recipient devices corresponding to a plurality of recipient profiles corresponding to a profile characteristic from metadata within the user generated interactive media content;

determining that at least one mobile recipient device of the plurality of recipient devices includes the interactive-media-client component;

based on determining that the at least one mobile recipient device includes the interactive-media-client component, selecting the first version of the interactive media survey for delivery to the at least one mobile recipient device; and

providing, by at least one processor, the first version of the interactive media survey to the at least one mobile recipient device, the first version of the interactive media survey comprising the user generated interactive media content and the system generated content for presentation on the at least one mobile recipient device.

20. (Canceled).

21. (Previously Presented) The method of claim 19, further comprising providing, via a communications network and to a computing device associated with an administrator, an interface for creating the user generated interactive media content.

22. (Previously Presented) The method of claim 19, wherein the metadata within the user generated interactive media content further comprises a description of the user generated interactive media content.

23. (Previously Presented) A non-transitory computer readable storage medium having stored thereon computer-executable instructions that, when executed by at least one processor, cause the computer system to:

receive user generated interactive media content;

add system generated content to the user generated interactive media content to:

create a first version of an interactive media survey for use with an interactive-media-client component, wherein the first version of the interactive media survey comprises:

a first segment of the interactive media survey that includes a first survey question and a first navigation element for navigating within the first version of the interactive media survey; and

a second segment of the interactive media survey that includes a second survey question and a second navigation element for navigating within the first version of the interactive media survey;

create a second version of the interactive media survey for use with a web browser and not for use with the interactive-media-client component, wherein the second version of the interactive media survey comprises an individual segment that includes the first question and the second question;

identify a plurality of recipient devices corresponding to a plurality of recipient profiles corresponding to a profile characteristic from metadata within the user generated interactive media content;

determine that at least one mobile recipient device of the plurality of recipient devices includes the interactive-media-client component;

based on determining that the at least one mobile recipient device includes the interactive-media-client component, select the first version of the interactive media survey for delivery to the at least one mobile recipient device; and

provide the first version of the interactive media survey to the at least one mobile recipient device, the first version of the interactive media survey comprising the user generated interactive media content and the system generated content for presentation on the at least one mobile recipient device.

24. (Previously Presented) The system of claim 9, further comprising instructions that, when executed by the at least one processor, cause the system to receive a pull notification from the at least one mobile recipient device, wherein the pull notification references the first version of the interactive media survey.

25. (Previously Presented) The method of claim 19, further comprising providing a link for downloading the interactive-media-client component to at least one of the plurality of recipient devices.

26. (Previously Presented) The non-transitory computer readable storage medium of claim 23, further comprising instructions that, when executed by the at least one processor, cause the computer system to provide a link for downloading the interactive-media-client component to at least one of the plurality of recipient devices.

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Application Number: 13/869,678
Filing Date: 24 Apr 2013
Appellant(s): RAO, BINDU, RAMA

Christopher C. Funk
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/4/2018 appealing from the Office action mailed 4/5/2018.

(1) Grounds of Rejection to be Reviewed on Appeal

Every ground of rejection set forth in the Office action dated 4/5/2018 from which the appeal is taken is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(2) Response to Argument

Appellant argues, in Section I.A.1, "Similar to *Enfish*, the pending independent claims recite a flexible model of creating different versions of an interactive media survey for use with an 'interactive-media-client component' and a 'web browser' and--based on identifying a mobile recipient device that includes the interactive-media-client component--providing the interactive-media-client-component version of the interactive media survey to the mobile recipient device". However, the claims here are unlike the claims in *Enfish*. In *Enfish*, the court relied on the distinction made in Alice between computer-functionality improvements and uses of existing computers as tools in aid of processes focused on "abstract ideas". *Enfish*, 822 F.3d at 1335–36; see Alice, 134 S. Ct. at 2358–59. In *Enfish*, this distinction was applied to reject the claims under § 101 at stage one because the claims at issue focused not on asserted advances in uses to which existing computer capabilities could be put, but on a specific improvement—a particular database technique—in how computers could carry out one of their basic functions of storage and retrieval of data. *Enfish*, 822 F.3d at 1335–36; see *Bascom*, 2016 WL 3514158, at *5; cf. Alice, 134 S. Ct. at 2360 (noting basic storage function of generic computer). The present case is different: the focus of the claims is not on such an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools. Examiner notes that this line of argument is paraphrased from the Federal Circuit's precedential ruling in *Electric Power Group, LLC v. Alstom S.A., Alstom Grid Inc., Psymetrix, LTD,. Alstom Limited,* 2015-1778; directly quoting from the decision was not used to avoid too many layers of quotation. More specifically, the claims in the instant application do not contain a teaching of a novel data storage structure or algorithm for creating the two version of the "interactive media survey", but rather claim the idea of creating two versions of a survey. This is far from the teaching in *Enfish* of a particular database technique that improved the processing performance of the computing device when performing the prior art functions.

Appellant argues, in Section I.A.2, "Similar to *BASCOM*, the pending claims are patent eligible because they solve a technological problem that hindered prior electronic survey systems from providing interactive media surveys to mobile devices with software compatibilities and screen sizes differing from conventional personal computers". This argument posits a similarity between the inventive concept found in *BASCOM* and the invention in the instant application that simply does not exist. In the *BASCOM* decision, the court found the invention to be patent eligible because of "the installation of a filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each end user" that "gives the filtering tool both the benefits of a filter on a local computer and the benefits of a filter on the ISP server". That is, the specific arrangement of hardware was contrasted to the then-prior art and extolled the benefits of such an arrangement. Here, in contrast, the claims are not directed towards a novel arrangement of computer hardware, but rather employ generic hardware to produce two versions of content. The idea of presenting an appropriate version of content to a user based upon the user's device's capabilities does not become subject matter eligible by its application to the technical arena of mobile devices or to the restriction that the content comprises an "interactive media survey". Therefore, this argument is unpersuasive and the grounds of rejection under 35 U.S.C. § 101 is appropriate.

Appellant argues, in Section I.B.1, first makes the assertion, "First, no 'previous cases' recognize as abstract the idea set forth in the *Office Action*, *Enfish*, 882 F.3d at 1332--that is, 'creating two version of content and delivering an interactive version of the content to a device that supports the interactivity or a non-interactive version to a device that does not support interactive features.'" However, Appellant has not supplied any argument in support of this assertion. It appears that Appellant is asserting that the identified abstract idea is not analogous to previous court decisions because the identified abstract idea does not word-for-word match with that of a previous court decision. This would be an impossible burden and the courts have not held that the finding of an abstract idea need be to this level of precision. Therefore, in the absence of further rationale, this argument is incomplete and unpersuasive.

Appellant argues, in Section I.B.1, that the identified abstract idea does not represent the content of the claim language because "While this phrase from the *Office Action* presumably refers to the 'second version' of the interactive media survey, the plain language of the claims recite the opposite of a 'non-

interactive version'--that is, a 'second version of the interactive media survey'". The identified abstract idea correctly describes the claim language because the claim language posits an "interactive-media-client component" that presents the "first version of the interactive media survey" and the "second version of the interactive media survey" is "for use with a web browser. The claims, as currently written, take an initial "interactive media survey" and create different versions from this source material. The created versions are not required by the claim language to themselves be interactive and, in fact, claiming that the second version is interactive is contradictory to the claims and the specification, which states on page 11, Ll. 18-20: "In one embodiment the client component, an interactive media client, is required in a recipient mobile device 111 to handle the components of an interactive media, such as audio components and textual components". Appellant's argument seems to require that "second version" of the "interactive survey" also requires the "interactive-media-client component" in order for display, but the claims themselves require the "second version" to be "for use with a web browser and not for use with the interactive-media-client component". Appellant then asserts that the cited court decisions aren't pertinent in the instant application, but ignores the clear rationale provided that, like *Electric Power Group, LLC v. Alstom S.A.*, the claims in the instant application define "a desirable information-based results and [are] not limited to inventive means of achieving the result". The claims here are like those of *Electric Power Group* in that they claim a desirable informational result, i.e. "a first version of the interactive media survey" and "a second version of the interactive media survey", and posit a goal for these versions, but neither the claims nor the specification recite novel techniques for achieving these goals. In short, the invention claims a desirable result and does not claim techniques for achieving these goals. Both *Electric Power Group* and the instant application begin with receiving data and then creating an output data for a particular purpose but leave the detail in the "creat[ing]" step to PHOSITA to implement. The decision in *Electric Power Group* is analogous to the claims in the instant application while, as discussed above, the decisions in *Enfish* and *BASCOM* are not. Therefore, Examiner finds that the claims are directed towards an abstract idea without significantly more.

Appellant argues, in Section I.B.2, "The *Office Action* fails to support its findings of well-understood, routine, and conventional activities". Appellant then argues that the claims, as a whole, do not represent "well-understood, routine, or conventional". However, this is a misapplication of the

application of the *Berkheimer* memorandum which details how the "additional elements" beyond the abstract idea should be supported by a factual basis. This is not the same as a finding that the claims, as a whole, or the abstract idea itself comprise something that is "well-understood, routine, or conventional". As found in the grounds of rejection under 35 U.S.C. § 101 in the office action mailed 4/5/2018, the additional elements identified were "a server comprising at least one processor" and "at least one non-transitory computer readable storage medium storing instructions thereon". These elements were found to both be an attempt to limit the use of the abstract idea to a particular technological environment and no more than mere instructions to implement the idea on a computer, or recitation of generic computer structure that serves to perform generic functions that are well-understood, routine, and conventional activities previously known to the pertinent industry. This finding is supported using the first method of support identified in the *Berkheimer* memorandum: "A citation to an express statement in the specification or to a statement made by an applicant during prosecution that demonstrates the well-understood, routine, conventional nature of the additional element(s)". The grounds of rejection contained reference to appellant's specification on page 25, Ll. 6-10, that "One of average skill in the art will also recognize that the functional building blocks, and other illustrative blocks, modules and components herein, can be implemented as illustrated or by discrete components, application specific integrated circuits, processors executing appropriate software and the like or any combination thereof'. Thus, the grounds of rejection fully conforms to the requirements laid out in the *Berkheimer* memorandum.

Appellant presents three arguments in Section II; Examiner addresses each argument in turn.

Appellant argues, in the first argument presented in Section II, "While *Maes* discloses transcoding a new code language into HTML and VoiceXML, *Maes* and *Ramer* nowhere describe or suggest creating two different versions of an interactive media survey with the particular segments recited in the independent claims". The specification in the instant application on page 17, Ll. 12-18 describes the use of "an XML file comprising multiple segments", and on Page 12, Ll. 16-20 that the "user can browse through each step or segment" in the "interactive media". *Maes* teaches the segmentation of interactive content in at least Figure 6B with the disclosure of multiple questions through which a user can navigate; do note that the page displayed does not contain all of the segments in the "conversation" as the "What sports are you interested in?" question suggests further content below the fold. *Maes* further illustrates

the presentation of "conversational gestures" in at least Figure 3 and Col. 5, Ll. 14-20: "Since CML allows an application author to program gesture by gesture, such an application provides the flexibility for a use to provide requests/responses in a wide range of natural conversational manners". Further detail regarding the gestures presented in Fig. 6B is given in section L of *Maes* with each <cml> elements (e.g. "<cml name='cnn'>") represents a gesture or "segment" and the selection choices (i.e. the <choices>) element representing a manner in which the user may navigate through the segment. While a complete explanation of XML notation is not necessary herein, Examiner recommends the "XML" Wikipedia entry for an overview of the nested use of individual XML elements denoted by <>.

Appellant argues, in the second argument presented in Section II, "Second, the *Office Action* nowhere identifies what in *Ramer* or *Maes* constitutes the 'interactive-media-client component' from the independent claims". This is not so as both *Ramer* and *Maes* teach this element, though *Ramer* is relied upon in the previous Office action; specifically, paragraph [1063] teaches that the system of *Ramer* may present Java content "only on those mobile communication facilities that are Java-enabled". Java is an interactive-media-client component that while currently out of favor due to security concerns, was once nearly pervasive on web browsing devices. This is made abundantly clear in the "Java Applet" Wikipedia entry that states, "The applets are used to provide interactive features to Web applications that cannot be provided by HTML alone". Examiner does note that Java applications were referred to as applets. One of ordinary skill in the art would be familiar with Java or one of the many similar technologies that were present in the development of web browsing technologies and enabled through the use of browser plug-ins.

Appellant argues, in the third argument presented in Section II, "Third, the *Office Action* further fails to 'articulate why a person of ordinary kill in the art would have had a reasonable expectation of success' in combining the teachings of *Ramer* and *Maes*". This argument section largely relies upon the previously rebutted argument 1 that suggests that the two references (though there are three references in the grounds of rejection). However, one of ordinary skill in the art at the time of the invention would have readily combined the two references with the goal of producing content that is "modality-independent" (*Maes*: Col. 7, Ll. 28-36). *Maes* posits an improvement to existing web technologies that "[had] already evolved towards separating out content from presentation by adopting style sheets" and

that "the next evolutionary step is to factor out interaction logic from information content" (*Maes*: Col. 7, Ll. 6-9). That is to say that *Maes* as a reference suggests combining the improvements therein with existing web distributing systems, such as found in *Ramer*. The presentation of multiple versions of a base content depending upon the capabilities of the user/device upon which they are to be presented is old in the art and has been solved numerous times (e.g., JAVA, Flash, WebML) using a variety of client software components, both via browser plug-ins and native software. The present application merely applies these techniques to a vaguely defined "interactive media survey".

(3) Information Disclosure Statement

The information disclosure statements (IDS) submitted on 7/5/2018 and 10/25/2018 was filed after the mailing date of the office action on 4/5/2018. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/SCOTT SNIDER/
Examiner, Art Unit 3621

Conferees:

/Melanie Weinhardt/
RQAS, TC 3600

/RUTAO WU/
Supervisory Patent Examiner, Art Unit 3621

Requirement to pay appeal forwarding fee. In order to avoid dismissal of the instant appeal in any application or ex parte reexamination proceeding, 37 CFR 41.45 requires payment of an appeal forwarding fee within the time permitted by 37 CFR 41.45(a), unless appellant had timely paid the fee for filing a brief required by 37 CFR 41.20(b) in effect on March 18, 2013.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BINDU RAMA RAO

Appeal 2019-003465
Application 13/869,678
Technology Center 3600

Before ERIC B. GRIMES, RICHARD M. LEBOVITZ, and TAWEN CHANG, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

The Examiner rejected the claims under 35 U.S.C. § 103 as obvious and 35 U.S.C. § 101 for lack of patent-eligibility. Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the Examiner's decision to reject the 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. Appellant identifies the real party in interest as Qualtrics, LLC. Appeal Br. 1.

STATEMENT OF THE CASE

The Examiner rejected the claims as follows:

Claims 9–15, 17, 19, and 21–26 under pre-AIA 35 U.S.C. § 101 because the claimed invention is directed to judicial exception to patent-eligibility. Non-Final Act. 3.

Claims 9–15, 17, 19, and 21–26 under pre-AIA 35 U.S.C. § 103(a) as obvious in view of Ramer et al. (US 2008/0009268 A1, published Jan. 10, 2008) ("Ramer"), Maes et al. (US 7,685,252 B1, issued Mar. 23, 2010) ("Maes"), and Smith et al. (US 7,337,127 B1, Feb. 26, 2008) ("Smith"). Non-Final Act. 5.

There are three independent claims on appeal, claims 9, 19, and 23. The claims have similar limitations and therefore we have selected claim 9 as representative. Claim 9 is reproduced below (bracketed numbering has been added for reference to the claim limitations):

> 9. A system comprising:
> [1] a server comprising at least one processor;
> [2] at least one non-transitory computer readable storage medium storing instructions thereon that, when executed by the at least one processor, cause the system to:
> [3] receive user generated interactive media content;
> [4] add system generated content to the user generated interactive media content to:
> [5] create a first version of an interactive media survey for use with an interactive-media-client component, wherein the first version of the interactive media survey comprises:
> [6] a first segment of the interactive media survey that includes a first survey question and a first navigation element for navigating within the first version of the interactive media survey; and
> [7] a second segment of the interactive media survey that includes a second survey question and a

second navigation element for navigating within the first version of the interactive media survey;

[8] create a second version of the interactive media survey for use with a web browser and not for use with the interactive-media-client component, wherein the second version of the interactive media survey comprises an individual segment that includes the first question and the second question;

[9] identify a plurality of recipient devices corresponding to a plurality of recipient profiles corresponding to a profile characteristic from metadata within the user generated interactive media content;

[10] determine that at least one mobile recipient device of the plurality of recipient devices includes the interactive-media-client component;

[11] based on determining that the at least one mobile recipient device includes the interactive-media-client component, select the first version of the interactive media survey for delivery to the at least one mobile recipient device; and

[12] provide the first version of the interactive media survey to the at least one mobile recipient device, the first version of the interactive media survey comprising the user generated interactive media content and the system generated content for presentation on the at least one mobile recipient device.

SECTION 101 REJECTION

The Examiner found that claim 9 "is directed to the abstract idea of creating two versions of content and delivering an interactive version of the content to a device that supports the interactivity or a non-interactive version to a device that does not support interactive features." Non-Final Act. 3. The Examiner stated that "the focus of the claims is not on such an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools." Ans. 3. The Examiner further explained

that "[m]ore specifically, the claims in the instant application do not contain a teaching of a novel data storage structure or algorithm for creating the two version of the 'interactive media survey', but rather claim the idea of creating two versions of a survey." *Id.*

Principles of Law

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a "new and useful process, machine, manufacture, or composition of matter." However, not every discovery is eligible for patent protection. *Diamond v. Diehr*, 450 U.S. 175, 185 (1981). "Excluded from such patent protection are laws of nature, natural phenomena, and abstract ideas." *Id.* The Supreme Court articulated a two-step analysis to determine whether a claim falls within an excluded category of invention. *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014); *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 566 U.S. 66, 75–77 (2012).

In the first step, it is determined "whether the claims at issue are directed to one of those patent-ineligible concepts." *Alice*, 573 U.S. at 217. If it is determined that the claims are directed to an ineligible concept, then the second step of the two-part analysis is applied in which it is asked "[w]hat else is there in the claims before us?" *Id.* The Court explained that this step involves

> a search for an "inventive concept" — *i.e.*, an element or combination of elements that is "sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself."

Alice, 573 U.S. at 217–18 (citing *Mayo*, 566 U.S. at 75–77).

Alice, relying on the analysis in *Mayo* of a claim directed to a law of nature, stated that in the second part of the analysis, "the elements of each claim both individually and 'as an ordered combination'" must be considered "to determine whether the additional elements 'transform the nature of the claim' into a patent-eligible application." *Alice*, 573 U.S. at 217.

The PTO has published revised guidance on the application of 35 U.S.C. § 101. USPTO's January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50, 51–57 (2019) ("2019 Eligibility Guidance"). This guidance provides additional direction on how to implement the two-part analysis of *Mayo* and *Alice*.

Step 2A, Prong One, of the 2019 Eligibility Guidance, looks at the specific limitations in the claim to determine whether the claim recites a judicial exception to patent eligibility. In Step 2A, Prong Two, the claims are examined to identify whether there are additional elements in the claims that integrate the exception in a practical application, namely, is there a "meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception." 84 Fed. Reg. at 54 (2. Prong Two).

If the claim recites a judicial exception that is not integrated into a practical application, then as in the *Mayo/Alice* framework, Step 2B of the Eligibility Guidance instructs us to determine whether there is a claimed inventive concept to ensure that the claims define an invention that is significantly more than the ineligible concept, itself. 84 Fed. Reg. at 56.

With these guiding principles in mind, we proceed to determine whether the claimed subject matter in this appeal is eligible for patent protection under 35 U.S.C. § 101.

Discussion

The Examiner stated that claim 9 "is directed to the abstract idea of creating two versions of content and delivering an interactive version of the content to a device that supports the interactivity or a non-interactive version to a device that does not support interactive features." Non-Final Act. 3. The Examiner also described the steps in claim 9 and concluded that they correspond "to concepts identified as abstract ideas by the courts." Non-Final Act. 3. However, the Examiner did not specifically explain, under the first part of the *Alice/Mayo* test, which of the steps recited an excluded category of invention, such as a method of organizing human activity, a mathematical concept, or mental process. The Examiner discussed various Federal Circuit cases in which the court found the claims to be directed to an abstract idea, but the Examiner did not explain how the recited steps of claim 9 are similar to the ineligible claims in the cited cases. *Id.*

Appellant argues in the Appeal Brief that "the independent claims cover a concrete improvement to an electronic survey system by creating different versions of an interactive media survey for improved flexibility and by providing a device the interactive media survey based on determining whether the device includes an interactive media client component." Appeal Br. 8. We agree with Appellant.

Prong Two of Step 2A asks whether there are additional elements that integrate the exception into a practical application. As in the *Mayo/Alice* framework, we must look at the claim elements individually and "as an

ordered combination" to determine whether the additional elements integrate any recited abstract idea into a practical application. As discussed in the Eligibility Guidance, "[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." 84 Fed. Reg. at 54. Integration into a practical application is evaluated by identifying whether there are additional elements which go beyond the judicial exception, and evaluating those additional elements individually, and in combination, to determine whether they integrate the exception into a practical application. *Id.* at 54–55.

One indication that a judicial exception may be integrated into a practical application is an additional element that reflects an improvement to the functioning of a computer or an improvement in another technology. *Id.* at 55. As further explained in the October 2019 Update to Subject Matter Eligibility[2] "first the specification should be evaluated to determine if the disclosure provides sufficient details such that one of ordinary skill in the art would recognize the claimed invention as providing an improvement." PEG Update 12.

The Specification explains that "[e]lectronic devices, such as mobile phones and personal digital assistants (PDA's), often contain small screens with very limited viewing area. They are constrained in terms of how much information can be displayed, and in terms of user interaction capabilities." Spec. 3:2–4. The Specification discloses that "[i]nformation access from

[2] Available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf (last accessed Nov. 15, 2019) ("PEG Update.")

typical Internet based websites from mobile devices are quite often unsatisfactory and not useful due to several factors, not least of which is the multi-media and graphics rich format in which most Internet websites are designed and made available and the verbosity of text." Spec. 3:19–21. The Specification further discloses that "[a] mobile phone with a small screen is not a good candidate for viewing such complicated and graphics rich (with graphics, flash screens, video components, etc.) content." Spec. 3:21–22.

To address these problems, the Specification describes a server that determines whether a mobile device "can handle interactive media" because the device comprises "the client component capable of handling the interactive media, and because the interactive media comprise metadata used to determine appropriateness for a device." Spec. 10:16–21. "In order to play all the components of an interactive media, . . . the recipient devices, such as the recipient device 111, have a client component that can handle all the components of an interactive media, audio, textual, graphics and even video components." Spec. 11:14–17.

"Some mobile devices . . . may not have the interactive media client." Spec. 11:21–22. For such devices, the server "makes it possible for them to receive and display/play the interactive media by sending them the same interactive media in an alternate form, such as a simplified set of web pages." Spec. 12: 1–3. Thus, the Specification describes an improvement to presenting content on a mobile device by presenting the content in different forms, depending on whether the mobile device has a "client component" on it that enables a user of the device to view interactive media.

Claim 9 reflects this solution to the problem of displaying information on the small screens of mobile devices by claiming a system that creates two

versions of an interactive media survey for display on mobile recipient devices, depending on whether a device includes an "interactive-media-client component" which enables the display of the interactive media formatted for the device. The claim creates a first version of an interactive media survey for use with an "interactive-media-client component" (steps [5]–[7]) and a second version of the interactive media survey for use with a "web browser" (step [8]). Based on identifying a mobile recipient device that includes the interactive-media-client component (steps [9], [10]), the claimed technology provides the interactive-media-client component version of the interactive media survey to the mobile recipient device (steps [11], [12]).

Providing different forms of interactive media content depending on whether a mobile device includes an "interactive-media-client component" is therefore an additional element which improves the display of interactive media content on the mobile device. In *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014), claims were found to be patent-eligible because "the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks." Claims "directed to an improvement in the functioning of computers, particularly those with small screens" were found to be patent-eligible in *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, 880 F.3d 1356, 1363 (Fed. Cir. 2018). Similarly, claim 9 overcomes the problem of displaying interactive media content on the small screen of a mobile device by first determining whether the device includes the client component and then providing the "first version of the interactive media survey." We conclude that the additional elements in claim 9 solve a

technological problem by improving the functioning of a mobile device.

The rejection of claim 9, and claims 10–15, 17, 19, and 21–26, under 35 U.S.C. § 101 is reversed.

SECTION 103 REJECTION

The Examiner found that Ramer describes all the steps of claim 9, except for the interactive media survey and creating two separate versions of interactive media content, as recited in steps [5] and [8] of claim 9. Non-Final Act. 6–7. However, the Examiner found that Maes describes "creating multiple versions of content from a base input language," including a web browser version. *Id.* at 7. The Examiner determined it would have been obvious to the skilled worker "to modify Ramer with the use of different versions of content as taught by Maes in order to produce content that is 'modality-independent.'" *Id.* With respect to the "interactive media survey," the Examiner found that Smith describes "an advertising system that presents users with surveys." *Id.* The Examiner determined it would have been obvious to a person of ordinary skill in the art at the time of the invention "to modify Ramer with the method of presenting surveys as content as taught by Smith in order to better target advertising." *Id.*

Appellant contends that "*Maes* and *Ramer* nowhere describe or suggest creating two different versions of an interactive media survey with the particular segments recited in the independent claims." Appeal Br. 20. We agree with Appellant that the Examiner did not establish by preponderance of the evidence that the cited publications disclose or suggest first (step [5]) and second versions (step [7]) of an interactive media survey, where the first version is "for use with an interactive-media-client

component" on a mobile recipient device and a second version is "for use with a web browser."

Ramer, as found by the Examiner, describes allowing a sponsor "to select the types of mobile communication facilities on which the sponsor would like to present the sponsor content." Ramer ¶ 1039. Ramer discloses that "the sponsor may wish to select a subset of mobile communication facility models that are best suited for presentation of the sponsor's content due to technological requirements for the content to optimally present." *Id.* However, the Examiner acknowledged that this disclosure was deficient because it does not "specify creating two separate versions with the first comprising interactive elements for navigating within the interactive media survey and the second for use with a web browser and not for use with interactive-media-client component." Non-Final Act. 7 (referencing limitations [5] and [7] of claim 9).

The Examiner cited Maes to make up for this deficiency. Maes describes "services that are device and modality independent" by designing a markup language for authoring "information content and interaction logic that is modality independent." Maes, col. 6, l. 59–col. 7, l. 2. As Maes explains that "[e]ither CML pages are served to browsers that can parse and render CML content (see Case B below) or they are served to legacy browsers that can only handle legacy languages, e.g., HTML, WML, VoiceXML, etc. (see Case A below)." Maes, col. 14, ll. 26–30.

In Case A, "[w]hen a page is requested, it is fetched in CML and transcoded on the fly using the gesture-based XSL transformation rules into the target ML." Maes, col. 14, ll. 35–38. In Case B, "[t]he target browser handles CML. Therefore, it knows exactly what are the modalities that it

supports (single or multiple) as well as the rules required to optimally render a given gesture in its supported modalities." Maes, col. 14, ll. 39–42.

Thus, Maes teaches a *single* content version which is translated differently (Case A and B) upon delivery to the device. In contrast, the claims require first and second versions, where the first version is created (step [5]) and provided to a mobile recipient device (step [12]) and the second version is for use with a web browser (step [8]). Maes therefore solves the problem of presenting content to different devices in a different manner than the claims, namely by creating one version written in a markup language that is translated differently depending on the device which receives it. Therefore, the Examiner's reliance on Maes to make up for the deficiency in Ramer is not supported by a preponderance of the evidence in this record.

The Examiner also did not establish that the cited publications disclose or suggest the claimed "interactive-media client component" that is for use with a first version of a media survey, but not for use with a web browser ("a second version of the interactive media survey for use with a web browser and not for use with the interactive-media-client component"). The Examiner cited the disclosure in Ramer of "Java" on a mobile device as the claimed interactive-media-client component. Non-Final Act. 6; Ans. 6–7. However, the Examiner did not establish that Java is for use with the mobile device and not for use with a web browser. Appeal Br. 21; Reply Br. 18. To the contrary, the Examiner inconsistently stated that Java was also used for web browsers and enabled by a browser. Ans. 7.

Summary

For the foregoing reasons, the rejection under 35 U.S.C. § 103 of claims 9–15, 17, 19, and 21–26, is reversed.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
9–15, 17, 19, 21–26	101	Eligibility		9–15, 17, 19, 21–26
9–15, 17, 19, 21–26	103	Ramer, Maes, Smith		9–15, 17, 19, 21–26
Overall Outcome				9–15, 17, 19, 21–26

REVERSED