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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRYAN T. STARBUCK,
ROBERT L. ROUNTHWAITE, DAVID E. HECKERMAN,
JOSHUA T. GOODMAN, ELIOT C. GILLUM,
NATHAN D. HOWELL, and KENNETH R. ALDINGER

Appeal 2010-007936
Application 10/601,741
Technology Center 2400

Before ERIC B. CHEN, MICHAEL J. STRAUSS, and JOHN G. NEW,
Administrative Patent Judges.

NEW, *Administrative Patent Judge*.

DECISION ON APPEAL

SUMMARY

Appellants file this appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1-12, 42-52, and 73. Specifically, the Examiner rejected claims 1-12 and 73 as unpatentable under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.[1] Claims 1-8, 10-12, 42-49, 51, 52, and 73 stand rejected as unpatentable under 35 U.S.C. § 102(e) as being anticipated by Buford et al. (US 2003/0041126 A1, February 27, 2003) ("Buford"). The Examiner also rejected claims 9 and 50 as unpatentable under 35 U.S.C. § 103(a) as being obvious over the combination of Buford and Capiel (US 2003/0149733 A1, August 7, 2003) ("Capiel").

We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

Appellants' invention is directed to a system and method that facilitates detecting spam, including components and other operations which enhance or promote finding characteristics that are difficult for the spammer to avoid and finding characteristics in non-spam that are difficult for spammers to duplicate. Abstract.

[1] The Examiner also rejected claims 42-52 on this ground; the rejection was withdrawn by the Examiner. Ans. 9.

GROUPING OF CLAIMS

Because Appellants argue that the Examiner erred for substantially the same reasons with respect to claims1-12, 42-52, and 73, we select claim 1 as representative of this group. App. Br. 4, 6, 8. Claim 1 recites:

> 1. A computer-implemented spam detection system comprising:
>
> a message parsing component that identifies features relating to at least a portion of origination information of a message; and
>
> a feature pairing component that combines the features into useful pairs, the features of the pairs are evaluated for consistency with respect to one another to determine if the message is spam.

App. Br. 10.

ISSUES AND ANALYSES

A. Claim rejections under 35 U.S.C. § 101.

Issue

Appellants argue that the Examiner erred in rejecting claim 1 as unpatentable under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. Specifically, Appellants argue that the Examiner erred because the claims as amended produce a useful, concrete, and tangible result and, as such, recite patentable subject matter. App. Br. 4. We therefore address the issue of whether the Examiner so erred.

Analysis

Appellants argue that claim 1's recitation of "the features of the pairs are evaluated for consistency with respect to one another to determine if the message is spam" is directed to a result that is useful, concrete, and tangible

to one receiving spam e-mails, as such a determination can facilitate filtering the e-mail, reporting the e-mail, or any number of actions. App. Br. 4-5. Furthermore, Appellants point to the U.S. Court of Appeals for the Federal Circuits' opinion in *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005), as support for their argument that software patent claims, such as those in the instant appeal, constitute per se patentable subject matter. App. Br. 5. Specifically, Appellants quote *Eolas* with respect to 35 U.S.C. § 101:

> Title 35, section 101, explains that an invention includes "any new and useful process, machine, manufacture or composition of matter." Without question, **software code <u>alone</u> qualifies as an invention eligible for patenting under these categories, at least as processes**. (emphasis added) (citations omitted).

Id. (quoting *Eolas*, 399 F.3d at 1338-39).

The Examiner responds that computer programs claimed as computer listings per se (i.e., the descriptions or expressions of the programs) are not physical "things." Ans. 9. The Examiner finds that computer programs are neither computer components nor statutory processes, as they are not "acts" being performed and are consequently unpatentable. *Id.* The Examiner finds that such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. *Id.* The Examiner therefore finds that the claims do not constitute statutory subject matter under 35 U.S.C. § 101.

As an initial matter, we reject Appellants' argument that the Federal Circuit's *Eolas* opinion holds that computer programs are per se statutory subject matter under 35 U.S.C § 101. As we have previously noted, the

language of *Eolas* quoted by Appellants is dicta within a discussion of "whether software code made in the United States and exported abroad is a 'component[ ] of a patented invention under 271(f).'" *Ex Parte Cristian Petculescu and Amir Netz*, Appeal No. 2008-002859, 2009 WL 1718896, at *8 (Bd. Pat. App. & Interf., June 4, 2009) (quoting *Eolas*, 399 F.3d at 1338-39). We therefore do not accept Appellants' contention that *Eolas* necessarily holds that computer programs are per se statutory subject matter.

Moreover, we observe that both *Eolas* and the instant appeal were filed prior to the Supreme Court's opinion in *Bilski v Kappos*, 130 S.Ct. 3218 (2010). In *Bilski*, the Supreme Court set aside the Federal Circuit's holding in *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008), that the "machine-or-transformation" test is "the sole test governing § 101 analyses," and thus the "test for determining patent eligibility of a process under § 101." 130 S.Ct. at 3224 (quoting *In re Bilski*, 545 F.3d at 955, 956).[2] The Supreme Court acknowledged that "the machine-or-transformation test is a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under § 101," but held that "[t]he machine-or-

[2] The Federal Circuit's decision in *In re Bilski* had, in turn, rejected its prior test for determining whether a claimed invention was a patentable "process" under § 101 (as articulated in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373 (1998), and *AT & T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1357 (1999)), *viz.*, whether it produces a "useful, concrete, and tangible result," and upon which Appellants rely in the instant appeal. *See In re Bilski*, 545 F.3d 943, 959–960, and n.19 (Fed. Cir. 2008) (en banc).

transformation test is not the sole test for deciding whether an invention is a patent-eligible 'process.'" 130 S.Ct. at 3227.

Since the Supreme Court's decision in *Bilski*, the Federal Circuit has repeatedly addressed the issue of whether software claims are patent-eligible under 35 U.S.C. § 101. Consequently, we must look to those decisions in determining whether the software claims presented in the instant appeal constitute statutory subject matter under 35 U.S.C. § 101.

In *Ultramercial, LLC v. Hulu LLC*, 657 F.3d 1323 (Fed. Cir. 2011) the Federal Circuit held that the software claims at issue were patent-eligible under 35 U.S.C. § 101. 657 F.3d at 1329. The '545 patent-in-suit in *Ultramercial* claimed a particular method for monetizing copyrighted products constituting a number of specific steps. *Id.* at 1328. Furthermore, as the court observed, many of these steps were likely to require "intricate and complex computer programming" and certain steps required "specific application to the Internet and a cybermarket environment." *Id.* Viewing the subject matter as a whole, the court found that the invention involved an extensive computer interface. *Id.* While declining to define a requisite level of programming complexity by which a computer-implemented method becomes patent-eligible, and further declining to hold that the use of an Internet website is necessary or sufficient in every case to satisfy § 101, the court found that the claims in the '545 patent-in-suit were patent-eligible, in part because of these factors. *Id.*

By contrast, in two other recent cases, *Dealertrack, Inc. v. Huber*, 674 F.3d 1315 (Fed. Cir. 2012) and *Fort Properties, Inc. v. American Master Lease LLC*, 671 F.3d 1317 (Fed Cir. 2012) the Federal Circuit has held that the software claims at issue were not directed to statutory subject

matter. In *Dealertrack*, the Federal Circuit held that software claims directed to establishing a clearinghouse for automotive credit applications were invalid as being "directed to an abstract idea preemptive of a fundamental concept or idea that would foreclose innovation in this area." 674 F.3d at 1333. Specifically, the court found that the claim "explain[s] the basic concept" of processing information through a clearinghouse, just as claim 1 in Bilski "explain[ed] the basic concept of hedging" and that the steps constituting the claimed method did not "impose meaningful limits on the claim's scope." *Id.* (quoting *Bilski*, 130 S.Ct. at 3231; *In re Bilski*, 545 F.3d at 961-62).

Furthermore, the Federal Circuit found that although the claims cited "computer aided" as a limitation, the patent-in-suit did not "specify how the computer hardware and database are specifically programmed to perform the steps claimed in the patent" and that adding the limitation to an abstract concept, without more, was insufficient to render the claim patent eligible. 674 F.3d at 1333.

Likewise, in *Fort Properties*, the Federal Circuit held that claims directed to a computer-aided real estate investment tool designed to enable tax-free transfers of property was not directed to statutory subject matter. 671 F.3d at 1323. According to the court "the basic character of a process claim drawn to an abstract idea is not changed by claiming only its performance by computers, or by claiming the process embodied in program instructions on a computer readable medium." *Id.* (quoting *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011)). Instead, "to impart patent-eligibility to an otherwise unpatentable process under the theory that the process is linked to a machine, the use of

the machine 'must impose meaningful limits on the claim's scope.'" 671 F.3d at 1323 (quoting *In re Bilski*, 545 F.3d at 961). The court explicitly contrasted the claims of the patent-in-suit with those of *Ultramercial*, noting that in the latter the addition of the computer to the claims was not merely insignificant post-solution activity; rather, the invention itself involved "advances in computer technology," and it was thus sufficient to qualify the claims for patent eligibility under § 101. 671 F.3d at 1323 (quoting *Ultramercial*, 657 F.3d at 1329).

We find that claim 1 of the instant appeal more closely resembles the claims at issue in *Ultramercial* than those at issue in *Dealertrack* and *Fort Properties*. Claim 1 recites a system for the detection of email spam by parsing the features of an incoming method and detecting paired features for consistency of a type that is characteristic of email spam messages and difficult for the generators of email spam to disguise. Claim 1; *see also* Specification, p. 2, ll. 28-31. As such, the system requires "intricate and complex computer programming" and certain steps required "specific application to the Internet and a cybermarket environment." *Ultramercial*, 657 F.3d at 1328. Moreover, we find that the limitations recited in claim 1, *viz.*, "a message parsing component that identifies features relating to at least a portion of origination information of a message" and "a feature pairing component that combines the features into useful pairs, the features of the pairs are evaluated for consistency with respect to one another to determine if the message is spam," impose meaningful limits on the claim's scope rather than "[s]imply adding a 'computer aided' limitation to a claim covering an abstract concept." *Fort Props.*, 671 F.3d at 1323 (quoting *Dealertrack*, 674 F.3d at 1333). We consequently find that, under the

analyses set forth by the Federal Circuit in the cases discussed *supra*, claim 1 is directed to statutory subject matter and we reverse the Examiner's rejection of those claims under 35 U.S.C. § 101.

B. Claim rejections under 35 U.S.C. § 102(e).

Issue

Appellants argue that the Examiner erred because Buford fails to disclose each and every element recited in the subject claims. App. Br. 6. Specifically, Appellants argue that Buford fails to disclose the limitation of claim 1 reciting "features of the pairs are evaluated for consistency with respect to one another to determine if the message is spam." App. Br. 7. We therefore address the issue of whether the Examiner so erred.

Analysis

Appellants contend that Buford teaches or suggests isolating information in messages for storage and subsequent reporting or data access. App. Br. 7. According to Appellants, these values are input into a database, e.g., such that they are isolated into cells and are therefore not combined into pairs as recited in the subject claims. *Id.* Appellants argue further that the values of Buford are not evaluated to determine if a message is spam as recited in the claims; rather, Appellants assert, the message in Buford has already been identified as spam by the user and reported to a complaint system. *Id.* Appellants assert that Buford does not teach, for example, comparing the features to one another to determine if the message is spam. *Id.* Therefore, Appellants argue, no determination is made regarding spam in Buford, much less a determination made by evaluating

the feature pairs of the e-mail with respect to one another, as recited in the subject claims. *Id.*

The Examiner responds that Buford teaches "parsing or separating of the nested electronic mail document into a plurality of message components such as a header and a body of the e-mail. Ans. 10 (citing Buford, ¶ [0036]). The Examiner finds that it is well known to one of ordinary skill in the art that the header of the email message comprises the "origination information of a message" such as the domain name, source IP address, etc. Ans. 10. The Examiner therefore finds that Buford teaches or suggests that the e-mail message is parsed to obtain URL and email address of a spam source. *Id.*

The Examiner agrees with Appellants' assertion that Buford teaches or suggests that the claimed invention already "knows" the message is spam upon receiving the message for parsing. *Id.* However, the Examiner finds that Buford teaches or suggests using an analysis protocol on the spam email to analyze the message components by way of the common presentation format and extract specific information from the message, such as IP address, a domain name and an electronic mail address using extractor. *Id.* (citing Buford, ¶ [0036]). The Examiner finds that the evaluating feature of Buford takes place when the last validated header is obtained to identify the actual source of the embedded email from multiple received lines of the validated header. Ans. 10-11 (citing Buford, ¶ [0041]). Consequently, the Examiner finds that Buford teaches or discloses all of the limitations of claim 1.

We are not persuaded by the Examiner's findings. Buford teaches that:

> [T]he analysis process loops through the embedded headers … to find the source of the spam email and validate the IP address of the spam source using an analysis protocol, as shown in FIG. 4. Then, the last validated header, as shown in FIG. 6(b), is obtained to identify the actual source of the embedded email from multiple Received lines the validated header … in Step 4.1.

Buford, ¶ [0041]. Buford, however, is silent regarding the limitation of claim 1 reciting "features of the pairs are evaluated for consistency with respect to one another to determine if the message is spam," indeed, Buford neither teaches nor suggests claim 1's recited "feature pairing component that combines the features into useful pairs." Instead, Buford teaches a looping process through which the program attempts to validate successive IP addresses until the actual IP address of the spam source is validated. *Id.*, *see also* Buford, Fig. 4. There is no mention in Buford of the pairing of features or of the evaluation of those pairs for consistency.

We therefore find that the Examiner erred in finding that Buford discloses each and every element recited in claim 1. Furthermore, we find that Capiel fails to cure the deficiency of Buford with respect to claims 1 and 42, from which claims 9 and 50 depend, and we therefore also find that the Examiner erred in rejecting claims 9 and 50 under 35 U.S.C. § 103(a).

DECISION

The Examiner's rejection of claims 1-12 and 73 as unpatentable under 35 U.S.C. § 101 as being directed to nonstatutory subject matter is reversed.

The Examiner's rejection of claims 1-8, 10-12,42-49,51-52, and 73 as unpatentable under 35 U.S.C. 102(e) as being anticipated by Buford is reversed.

The Examiner's rejection of claims 9 and 50 as unpatentable under 35 U.S.C. § 103(a) as being obvious over the combination of Buford and Capiel is reversed.

REVERSED

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