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<td>05/15/2012</td>
<td>Charles P. Brown</td>
<td>BR02-001-01</td>
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EXAMINER  
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The time period for reply, if any, is set in the attached communication.
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHARLES P. BROWN

Appeal 2015-006969
Application 13/472,246
Technology Center 3600

Before HUBERT C. LORIN, BIBHU R. MOHANTY, and

LORIN, Administrative Patent Judge.

DECISION ON APPEAL

STATEMENT OF THE CASE


SUMMARY OF DECISION

We REVERSE and enter a NEW GROUND OF REJECTION.

¹ The Final Office Action mailed July 15, 2013 identified claims 34–58 as rejected, but claim 54 is canceled. See amendment filed Mar. 19, 2013.
THE INVENTION

Claim 34, reproduced below with bracketed numerals added, is illustrative of the subject matter on appeal.

34. A method comprising:

[1] receiving a one-time fee payment from a user in exchange for continued, periodic pre-payment of any future renewal fees, automatically by a server network device, required to maintain registration of a first registered domain name with a first domain name registrar;

[2] storing, by the server network device in a database, a record including information associated with the first registered domain name, the database including a plurality of records, each record corresponding to a respective registered domain name associated with a respective one-time fee payment from a respective user for continued, periodic pre-payment of any respective future renewal fees, automatically by the server network device, required to maintain registration of the respective registered domain name;

[3] automatically generating, by the server network device based on the database, a first list of registered domain names that will expire by a first date unless a respective renewal fee is paid to a respective corresponding domain name registrar by the first date for each registered domain name of the first list, the first list including the first registered domain name;

[4] automatically paying electronically, by the server network device and by the first date, a first renewal fee to the first domain name registrar for renewing the first registered domain name, without requiring any payment from the user in addition to the one-time fee payment;

[5] determining, by the server network device, that all respective renewal fees for the generated first list of registered domain names were paid to the respective corresponding domain name registrar by the first date;

[6] automatically generating, by the server network based on the database, a second list of registered domain names that will expire by
a second date unless a respective renewal fee is paid to a respective corresponding domain name registrar by the second date for each registered domain name of the second list, the second list including the first registered domain name; and

[7] automatically paying electronically, by the server network device and by the second date, a second renewal fee to the first domain name registrar for renewing the first registered domain name, without requiring any payment from the user in addition to the one-time fee payment.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

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<tr>
<td>Loeb et al.</td>
<td>US 6,014,641</td>
<td>Jan. 11, 2000</td>
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<td>(hereinafter “Loeb”)</td>
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Staff Writer, *Tonga to offer 100-year domain name registrations*, CNET News (Sept. 22, 1999) (hereinafter “Tonga”).


The following rejections are before us for review:

1. Claims 34–53 and 55–58 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.²

² The Final Rejection listed claims 34-54 as being rejected and the body of the rejection discusses claim 58. Final Rej. 2 and 3, respectively. Presumably said rejection was intended to list all of claims 34-58. Also, claim 54 was cancelled. See footnote 1. We have corrected that error, too.

ISSUES

Did the Examiner err in rejecting claims 34–53 and 55–58 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; and claims 34–53 and 55–58 under 35 U.S.C. § 103(a) as being unpatentable over Fellman, Loeb, Tonga, and Times-Colonist?

ANALYSIS

The rejection of claim 34–53 and 55–58 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The Examiner finds that the Specification does not provide support for the limitation “without requiring any payment from the user in addition to the one-time payment fee” in claims 34, 48, and 49 (Final Act. 2–3; Ans. 2–4).

The Appellant argues that paragraphs 60 and 71 of the published version of the application (US 2012/0226606 A1) provide support for the above limitation (App. Br. 15–18; Reply Br. 5–8).

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact and is assessed on a case-by-case basis. See, e.g., Purdue Pharma L.P. v. Faulding, Inc., 230 F.3d 1320, 1323 (Fed. Cir. 2000) (citing Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1561 (Fed. Cir. 1991)). The disclosure, as originally filed, need not literally describe the claimed subject matter
(i.e., using the same terms or in haec verba) in order to satisfy the written description requirement. But the Specification must convey with reasonable clarity to those skilled in the art that, as of the filing date, the Appellant was in possession of the claimed invention. See id.

Although the Specification does not explicitly disclose “without requiring any payment from the user in addition to the one-time payment fee,” a person of ordinary skill in the art reviewing the Appellant’s Specification, which discloses that the one-time fee is the only necessary fee, would reasonably understand that the invention does not require additional payment from the user, and would have known that the Appellant was in possession of the claimed subject matter as of the filing date.

The Examiner also finds that the Specification does not provide support for the limitation “automatically” in claims 43, 47, and 53 (Final Act. 3).

The Appellant argues that paragraphs 42, 56–60, and 71 of the published version of the application provide support for the above limitation (App. Br. 17; Reply Br. 7).

Paragraph 71 discloses “automatic pre-payment and verification of registration fees.” We agree with the Appellant that this disclosure satisfies the written description requirement.

Accordingly, the rejection is not sustained.

The rejection of claims 34–53 and 55–58 under 35 U.S.C. § 103(a) as being unpatentable over Fellman, Loeb, Tonga, and Times-Colonist.

The independent claims are 34, 49, and 58.
The Appellant’s main contention is that the Examiner used impermissible hindsight to reach the claimed subject matter given the cited prior art combination. See App. Br. 19–35; Reply Br. 8–20. We agree.

The question is whether one of ordinary skill would have been led to apply Loeb’s subscription model for magazines to Fellman’s domain name registration. The parties agree that Fellman does not disclose any mention of renewing a domain name prior to expiration or payment for any corresponding renewal fees. See, e.g., Final Act. 5. The Examiner states that “[o]ne of ordinary skill in the art would recognize that the fee/payments from the user can be structured in different manners and the third party can themselves decide how they want to structure the payments” (id. at 10) and “[w]ith a domain name registration, it is obvious that nobody wants to let the registration expire . . .” (Id. at 11).

In our view, this is insufficient as “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006). The difficulty is that there is insufficient evidence on record supporting the Examiner’s proposed modification of the prior art.

For the foregoing reasons, the rejection of claims 34, 49, and 58 is not sustained. A prima facie case of obviousness has not been made out in the first instance by a preponderance of the evidence. Claims 35–48, 50–53, and 55–57 depend from claims 34 and 49, and their rejection is not sustained for the same reasons.

NEW GROUND OF REJECTION
Claims 34–53 and 55–58 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.


According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Id.* at 2355.

Taking claim 34 as representative of the claims on appeal, the claimed subject matter is directed to paying renewal fees. Paying renewal fees is a method of organizing human activity and/or fundamental economic practice. As such, it is an abstract idea.

Step two of *Alice* is “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.” *Id.* at 2355 (citation omitted).

We see nothing in the subject matter claimed — individually or as an ordered combination — that transforms the abstract idea of paying renewal fees into an inventive concept.

The method of claim 34 includes seven steps of (1) receiving payment, (2) storing data in a database, (3) generating first information (a first list of registered domain names), (4) paying first renewal fees, (5) determining that the first renewal fees were paid, (6) generating second information (a second list of registered domain names), and (7) paying second renewal fees.
All of the claim limitations are well-understood, routine, conventional activities previously known to the industry. The information receiving, storing, and generating are known information gathering operations and thus add little to patentably transform the abstract idea of paying renewal fees. Receiving and paying fees is a routine, conventional practice. That the information and renewal fees relate to domain names may add a “degree of particularity” to the claims, but does not provide an inventive concept. See Ultramercial, Inc. v. Hulu, LLC, 772 F.3d 709, 715 (Fed. Cir. 2014) (“Although certain additional limitations, such as consulting an activity log, add a degree of particularity, the concept embodied by the majority of the limitations describes only the abstract idea of showing an advertisement before delivering free content.”).

Furthermore, each of the information gathering and fee paying steps are themselves abstract ideas. For example, using an intermediary to receive funding from users via the internet is an abstract idea. See, e.g., Kickstarter, Inc. v. Fan Funded, LLC, No. 11 CIV. 6909 KPF, 2015 WL 3947178, at *1 (S.D.N.Y. June 29, 2015), aff’d, 654 F. App’x 481 (Fed. Cir. 2016) (“system for marketing and funding one or more projects” including server for receiving and registering information in a database held ineligible); Paying fees at a particular time for non-technical reasons is also an abstract idea. See CMG Fin. Servs., Inc. v. Pac. Trust Bank, F.S.B., 50 F. Supp. 3d 1306, 1325 (C.D. Cal. 2014), aff’d sub nom. CMG Fin. Servs., Inc. v. Pac. Trust Bank, 616 F. App’x 420 (Fed. Cir. 2015) (“abstract idea of a mortgagee paying down a mortgage early when funds are available and borrowing funds as needed to reduce the overall interest charged by the mortgage.”).
See also LendingTree, LLC v. Zillow, Inc., No. 2014-1435, 2016 WL 3974203 (Fed. Cir. July 25, 2016) (internet-based loan-application clearinghouse for receiving loan offers from a “plurality of lending institutions” using “a filter comprising [a] plurality of selection criteria” and receiving a decision from the user held to be an abstract idea).


Finally, we note that claim 34 calls for “a server network device” and “a database.” But any general-purpose computer and database available at the time the application was filed would have satisfied these limitations. The Specification supports that view. See, e.g., Spec. 12 (“a processing system with at least one high speed Central Processing Unit (‘CPU’) and memory”). “[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea ‘while adding the words ‘apply it’’ is not enough for patent eligibility.” Alice, 134 S. Ct. at 2358.

The method of independent claim 58 contains similar limitations as claim 34, with two additional “comparing” steps. Comparing information is also an abstract idea. See Blue Spike, LLC v. Google Inc., 2015 WL 5260506 (N.D. Cal. 2015), aff’d, No. 2016-1054, 2016 WL 5956746 (Mem) (Fed. Cir. 2016).
Thus, “the claims at issue amount to ‘nothing significantly more’ than an instruction to apply the abstract idea . . . using some unspecified, generic computer.” *Alice*, 134 S. Ct. at 2360 (citing *Mayo*, 132 S. Ct. at 1298).

We reach the same conclusion as to apparatus claims 49–53. As in *Alice*, “[t]he method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea.” *Id.*

Therefore, we enter a new ground of rejection of claims 34–53 and 55–58 under 35 U.S.C. § 101.

**CONCLUSIONS**


The rejection of claims 34–53 and 55–58 under 35 U.S.C. § 103(a) as unpatentable over Fellman, Loeb, Tonga, and Times-Colonist is reversed.

Claims 34–53 and 55–58 are newly rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

**DECISION**

The decision of the Examiner to reject claims 34–53 and 55–58 is reversed.

Claims 34–53 and 55–58 are newly rejected.

**NEW GROUND**

This decision contains a new ground of rejection pursuant to 37 C.F.R.
§ 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that the Appellant(s), WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

REVERSED: 37 C.F.R. § 41.50(b)