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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/985,484	11/14/2007	Martin Khang Nguyen	6841P001X4	8409
	7590 01/09/2015	Martin Khang Nguyen 1300 South Bristol Street Ste 229 Santa Ana, CA 92704	EXAMINER CHAMPAGNE, DONALD	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 01/09/2015	DELIVERY MODE PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARTIN KHANG NGUYEN

Appeal 2012-006173¹
Application 11/985,484²
Technology Center 3600

Before BIBHU R. MOHANTY, NINA L. MEDLOCK, and
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–27. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellant's Appeal Brief ("Br.," filed August 26, 2011), 'the Examiner's Answer ("Ans.," mailed December 6, 2011), and the Final Office Action ("Final Act., mailed October 4, 2010).

² Appellant identifies the inventor, Martin Khang Nguyen, as the real party in interest. Br. 3.



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CLAIMED INVENTION

Appellant's invention relates "to the field of commercial transactions, and more specifically to management of commercial transactions" (Spec. ¶ 2).

Claims 1 and 12, reproduced below, are illustrative of the subject matter on appeal:

1. A portal comprising:

a user interface to interface to a user performing a commercial transaction, the user being one of a consumer, a vendor, a retailer, a service provider, and a third-party entity, the commercial transaction being related to sale processing of a product or service;

a transaction management portal engine coupled to the user interface to manage the commercial transaction performed by the user using user information, the portal engine executing a business rule having a condition and an action by a rule execution function which performs the action if the condition is satisfied, the business rule being related to the sale processing of the product or service; and

a management database coupled to the portal engine to provide the user information related to the commercial transaction.

12. A computer-implemented method comprising:

interfacing to a user performing a commercial transaction using a user interface in a portal, the user being one of a consumer, a vendor, a retailer, a service provider, and a third party entity, the commercial transaction being related to sale processing of a product or service;

managing the commercial transaction performed by the user using user information, managing comprising executing a business rule having a condition and an action by a rule execution function which performs the action if the condition is satisfied, the business rule being related to the sale processing of the product or service; and

providing the user information related to the commercial transaction using a management database.

REJECTIONS

Claims 1–23 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1–27 are rejected under 35 U.S.C. § 102(b) as anticipated by Scroggie (WO 97/23838, pub. July 3, 1997).

ANALYSIS

Non-Statutory Subject Matter

Independent claim 1 and dependent claims 2–11

The Examiner takes the position that claims 1–11 are properly rejected under 35 U.S.C. § 101 because the claimed invention, i.e., a “portal,” does not fall within any of the four statutory categories of patentable subject matter (Ans. 4), i.e., (1) processes; (2) machines; (3) manufactures; and (4) compositions of matter. 35 U.S.C. § 101. We disagree.

The Specification describes, at paragraph 20, that the portal “provides functionalities for a point of access on the Web,” and states that the portal includes a transaction management portal engine, a management database, and a user interface. This also is reflected in the language of claim 1.

We agree with Appellant that a portal, as described in the Specification and recited in claim 1, is a physical entity, i.e., a machine (Br. 8). As such, it falls within one of the four statutory categories of patentable subject matter.

Accordingly, we do not sustain the Examiner’s rejection of claims 1–11 under 35 U.S.C. § 101.

Independent claim 12 and dependent claims 13–23

In rejecting claims 12–23 under 35 U.S.C. § 101, the Examiner concludes that the claims, considered as a whole, are directed to an abstract idea (Final Act. 3–4). In this regard, the Examiner reasons that independent claim 12 is “a mere statement of a general concept: a method of doing business online” and that “[u]se of the concept, as expressed in the method, would effectively grant a monopoly over the concept” (*id.* at 5).

Appellant argues that the rejection of claims 12–23 is improper because the claimed invention is tied to a particular machine and involves the transformation of a commercial transaction (Br. 8–12). Appellant also asserts that “the scope of the claim [i.e., claim 12] in the principles of retirement administration is such that there is no danger that it would wholly pre-empt all uses of the principle” (*id.* at 12).

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.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “laws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In judging whether claim 12 falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the

claim is “directed to” a patent-ineligible abstract idea. If so, we then consider the elements of the claim — both individually and as an ordered combination — to assess whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Id.* This is a search for an “inventive concept” — an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.*

Here, we find that claim 12 is directed to the concept of conducting a commercial transaction involving the sale of a product or service. This is a fundamental economic practice long prevalent in our system of commerce, and is an abstract idea beyond the scope of § 101.

We next consider whether additional elements transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the abstract idea of conducting a commercial sales transaction in an online environment, e.g., over the Internet, using generic computer components. We conclude that it does not.

Considering each of the claim elements in turn, the function performed by the computer system at each step of the process is purely conventional. Using a computer to interface with a user is one of the most basic functions of a computer. The same is true of the use of a computer to execute a business rule (i.e., perform an action if a condition is satisfied) and provide information from a database. Each step of the claimed method does no more than require a generic computer to perform a generic computer function.

Viewed as a whole, claim 12 simply recites the performance of a commercial sales transaction known from the pre-Internet world along with the requirement to perform it on the Internet, i.e., in an online environment using generic computer components. The claim does not purport, for example, to improve the functioning of the computer system itself. Nor does it effect an improvement in any other technology or technical field. Instead, claim 12 amounts to nothing significantly more than an instruction to implement the abstract idea of conducting a commercial sales transaction on an online system using generic computer components. This is insufficient to transform an abstract idea into a patent-eligible invention.

Therefore, we sustain the Examiner's rejection of claims 12–23 under 35 U.S.C. § 101.

Anticipation

Independent claims 1, 12, and 24 and dependent claims 2–4, 8, and 13–23

Appellant argues 1–4, 8, and 12–24 as a group (Br. 12–14). We select claim 1 as representative. The remaining claims stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2011).

We are not persuaded that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 102(b) as anticipated by Scroggie (Br. 12–13). Instead, we find that Scroggie meets the language of claim 1 for the reasons set forth by the Examiner at pages 4–5 of the Final Office Action.

Appellant asserts that Scroggie does not disclose any of the elements of claim 1, either expressly or inherently, and that Scroggie merely discloses (1) “selecting functions in the main menu (Scroggie, page 11, lines 16–17), or options in an offer (Scroggie, page 12, lines 13–27)” and (2) “creating a coupon (Scroggie, page 16, lines 6–10), transmitting incentives without the

physical coupons (Scroggie, page 19, lines 1–12), or generating and delivering focused incentives (Scroggie, page 20, lines 1–6)” (Br. 12–13). But Appellant offers no substantive argument nor identifies with particularity any findings by the Examiner that are unreasonable or unsupported. Instead, Appellant essentially ignores the Examiner’s pinpoint citations to Scroggie and the Examiner’s explanation of how quotations from those pinpoint citations correspond to specific claim language (*see* Final Act. 4–5).

Appellant has failed to present substantive arguments to rebut the Examiner’s *prima facie* showing of anticipation. Therefore, we sustain the Examiner’s rejection of claim 1 under 35 U.S.C. § 102(b). We also sustain the Examiner’s rejection of claims 2–4, 8, and 12–24, which fall with claim 1.

Dependent claims 5–7 and 9–11

Each of claims 5–7 and 9–11 ultimately depends from claim 1. Appellant quotes the language of each of these claims and asserts, without more, that Scroggie does not disclose the quoted limitation (Br. 13–14).

Appellant’s assertions do not rise to the level of a separate argument. *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (holding that the Board reasonably interpreted 37 C.F.R. § 41.37 (c)(1)(vii) (2011) as requiring “more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art”). Therefore, we sustain the Examiner’s rejection of claims 5–7 and 9–11 under 35 U.S.C. § 102(b).

Appeal 2012-006173
Application 11/985,484

DECISION

The Examiner's rejection of claims 1–11 under 35 U.S.C. § 101 is reversed.

The Examiner's rejection of claims 12–23 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejection of claims 1–27 under 35 U.S.C. § 102(b) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED

Klh