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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAWAN RAJPANTH MURTHY¹

Appeal 2015-005330
Application 11/715,578
Technology Center 3600

Before BIBHU R. MOHANTY, NINA L. MEDLOCK, and
AMEE A. SHAH, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the Final Rejection of claims 9, 11–14, 16, 17, 19–22, and 24, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

¹ An assignment of the present application to Bayerische Motoren Werke Aktiengesellschaft, which is the real party in interest, was recorded on March 2, 2007.

THE INVENTION

The Appellant's claimed invention is directed to advertising and online private party vehicle sales (Spec., para. 1). Claim 9, reproduced below, is representative of the subject matter on appeal.

9. A vehicle transaction server comprising:

a network interface configured to couple the vehicle transaction server to a network;

a memory containing computer-executable instructions; and a processor coupled to the network interface and to the memory, said processor to execute the computer-executable instructions to:

receive vehicle information, including a vehicle sales price, over the network from a private seller of a vehicle, wherein the private seller is not a licensed vehicle dealer,

calculate a periodic payment amount for said vehicle based on said vehicle sales price provided by the private seller and predetermined financing terms,

generate, in response to receiving the vehicle information, a unique vehicle advertisement number; associate the unique vehicle advertisement number with said vehicle information and said periodic payment amount, generate an advertisement for said vehicle which includes said vehicle advertisement number and the vehicle sales price represented by said periodic payment amount, access, in response to receiving the advertisement number from a potential buyer over the network, said vehicle information and periodic payment amount using only the advertisement number, and provide the vehicle information and periodic payment amount to the potential buyer over the network.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 9, 11–14, 16, 17, 19–22, and 24 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
2. Claims 9, 11, 12, 16, 17, 19, 20, and 24 are rejected under 35 U.S.C. § 103(a) as unpatentable over Shah², Crites³, Henning⁴, Jarzmik⁵, and Murakami.⁶
3. Claims 13, 14, 21, and 22 are rejected under 35 U.S.C. § 103(a) as unpatentable over Shah, Crites, Henning, Jarzmik, Murakami, and Stone.⁷

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.⁸

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellant first argues that the rejection of claims 9, 11–14, 16, 17, 19–22, and 24 under 35 U.S.C. § 101 in the Answer is improper because it is a new ground of rejection that was not approved by the Technology

² Shah et al., US 2008/0046316 A1, published Feb. 21, 2008

³ Crites, US 7,529,694 B2, issued May 5, 2009

⁴ Henning et al., US 2005/0119939 A1, published Jun. 2, 2005

⁵ Jarzmik, US 2004/0128233 A1, published July 1, 2004

⁶ Murakami, US 2012/0054798 A1, published Mar. 1, 2012

⁷ Stone et al., US 7,240,025 B2, issued July 3, 2007

⁸ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

Center Director or identified as a “New Grounds of Rejection” in accordance with MPEP § 1207.03 (Reply Br. 1, 2).

This argument is not taken as the rejection of claims 9, 11–14, 16, 17, 19–22, and 24 under 35 U.S.C. § 101 was made in the non-final Rejection mailed September 26, 2014. Thus, the cited rejection is not a new ground of rejection (*see* pages 3–8 and specifically page 8 of that rejection mailed September 26, 2014 which lists the rejection). The Appellant made no arguments in response to the rejection in the Appeal Brief.

The Appellant has also argued that this rejection under 35 U.S.C. § 101 is improper (Reply Br. 2–9).

We agree with the Examiner’s rejection of the claims under 35 U.S.C. § 101.

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 9 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 determine 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.* The Court also stated that “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 134 S. Ct. at 2358.

Here, we determine that claim 9 is directed to the concept of generating an advertisement using specific data for the article to be sold. 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 the additional elements of the claim, both individually and as an ordered combination, 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 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 claim limitation is purely conventional. Each claim limitation does no more than require a generic computer to perform a generic computer function when considered both individually and as an ordered combination.

For these above reasons, the rejection of claim 9 under 35 U.S.C. § 101 is sustained. The Appellant has provided the same arguments for the remaining rejected claims under this rejection and the rejection of these claims is sustained as well.

Rejections under 35 U.S.C. § 103(a)

The Appellant argues that the rejection of claim 9 is improper because the prior art fails to disclose the claim limitation to

access, in response to receiving the advertisement number from a potential buyer over the network, said vehicle information and periodic payment amount using only the advertisement number (App. Br. 7–10, Reply Br. 9–12). The Appellant further argues that the combination of the references of Shah, Crites, Henning, Jarzmik, and Murakami is improper and based on hindsight (App. Br. 11–13).

In contrast, the Examiner has determined in regard to the argued claim limitation that “[it] is not necessary to provide each customer with their unique advertisement numbers, since the system would work without providing the customer said unique advertisement numbers” (Ans. 20). The Answer sets forth the reasons for the combination of references in the Answer at pages 9–14.

We agree with the Appellant. In *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) the Supreme Court noted that in an obviousness analysis “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* at 418. Here, even taking the argued claim limitation to be encompassed by the cited prior art, we determine that the combination of the references of Shah, Crites, Henning, Jarzmik, and Murakami lacks articulated reasoning with rational underpinnings without impermissible hindsight to support a conclusion of obviousness. For this reason, this rejection of claim 1 and its dependent claims is not sustained. Claim 17 has

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been rejected on the same grounds and the rejection of this claim and its dependent claims is not sustained for the same reason given above.

CONCLUSIONS OF LAW

We conclude that Appellant has not shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 101.

We conclude that Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a) as listed in the Rejections section above.

DECISION

The Examiner's rejection of claims 9, 11–14, 16, 17, 19–22, and 24 is sustained.

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)(iv).

AFFIRMED