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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHEW W. HICKEY,
JAMES H. WOLFSTON, and
RAYMOND L. PRICE

Appeal 2016-002647
Application 10/003,471¹
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, Administrative Patent Judges.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Matthew W. Hickey et al. (Appellants) seek our review under 35 U.S.C. § 134(a) of the final rejection of claims 19–40. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

¹ The Appellants identify CollegeNET, Inc., as the real party in interest. App. Br. 3.

THE INVENTION

Claim 19, reproduced below, is illustrative of the subject matter on appeal.

19. A computer-implemented method of attracting visitors to a college-related web site, comprising:

executing web server software on a server, the web server software causing the server to provide a first electronic form on the web site, the first electronic form suited for display on a client computer for use in nominating a college student or prospective college student for potential receipt of a scholarship;

receiving by the server the completed first electronic form, the completed first electronic form including an indication of a nominee, the nominee comprising a college student or prospective college to be nominated for potential receipt of the scholarship;

executing web server software on a server, the web server software causing the server to provide a second electronic form on the web site, the second electronic form suited for display on a client computer through which a nominee or a member of the general public can cast a vote for one or more nominees;

receiving by the server the completed second electronic form, the second electronic form include an indication of a vote for the one or more nominees;

at the end of a given period, determining from the vote cast a scholarship winner or scholarship winners from among the nominees according the number of votes cast by the general public for those winners; and

posting an announcement of the winner on the web site.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Ireland US 7,062,462 B1 June 13, 2006

Official Notice is taken that it was old and well known at the time of the invention to provide a site where one or more member of the general public or a specified subset of the general public (e.g. based on age, location, etc.) may cast a vote for one or more nominees; to determine one or more winners from among the nominees based on the received votes; and to post the announcement of the winner(s).

Final Act. 9. (Official Notice).

The following rejections are before us for review:

1. Claims 19–40 are rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.
2. Claims 19–40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ireland and Official Notice.

ISSUES

Did the Examiner err in rejecting claims 19–40 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter?

Did the Examiner err in rejecting claims 19–40 under 35 U.S.C. § 103(a) as being unpatentable over Ireland and Official Notice?

ANALYSIS

The rejection of claims 19–40 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

The Appellants argued these claims as a group. *See* App. Br. 6–7; Reply Br. 2–4. We select claim 19 as the representative claim for this group, and the remaining claims 20–40 stand or fall with claim 19. 37 C.F.R. § 41.37(c)(1)(iv).

Alice Corp. Party Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under § 101.

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. *Alice*, 134 S. Ct. at 2355.

In that regard, the Examiner determined that “inviting visitors to a website to cast a vote and posting the winner who received the most number of votes on a website is a method of organizing human activities that falls under an entrepreneurial objective, rather than a technological one [and therefore] claim 19 includes an abstract idea.” Final Act. 5.

We do not see that the Appellants have challenged the Examiner’s determination under *Alice* step 1. The Appellants argue two points: novelty and preemption, points more relevant to the determination under *Alice* step 2.

Step two 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.’” *Alice*, 134 S. Ct. at 2355 (alteration in original) (quoting

Mayo Collaborative Servs. v. Prometheus Labs., Inc., 566 U.S. 66, 72–73 (2012)).

The Examiner determined that

The steps of providing a form for scholarship applicants to use to apply (or be nominated) for the scholarship sensor data (i.e. sending/displaying data), receiving the completed form (i.e. receiving data), providing a form for voters to use to vote on one or more nominees/applicants (i.e. sending/displaying data), receiving the completed voting forms (i.e. receiving data), determining the winner based on the votes cast (i.e. performing mathematical function, e.g. adding), and posting the announcement of the winner on the web site (i.e. sending/displaying data) are all steps requiring no more than a generic computer to perform generic computer functions. Specifically, sending, receiving, and displaying data, counting the votes, and posting the winner on the web page are all routine and conventional activities previously known in the industry. Therefore, based on the two-part Mayo analysis, there are no meaningful limitations in the claim that transform the exception into a patent eligible application such that the claim amounts to significantly more than the exception itself.

Final Act. 6.

The Appellants first argue that

the claims are not simply directed to sending and receiving data, counting the votes, and posting the winner on the web page. The claims are directed to a computer-implemented method for attracting visitors to a college-related web site by allowing members of the general public to nominate and vote for a recipient of a college scholarship using a network connected computer. Allowing members of the general public to nominate and vote for a recipient of a college scholarship using a network connected computer is not a conventional activity previously known in the industry. *See* Declaration of Lloyd Thacker, filed under 37 C.F.R. 1.132 on May 2, 2012. Because allowing members of the general public to nominate and vote for a

recipient of a college scholarship is not a conventional activity previously known in the industry, the additional limitations of claim 19 amount to significantly more than the abstract idea of inviting visitors to cast a vote and posting the winner who received the most number of votes.

App. Br. 6–7. This argument – that the claimed method “is not a conventional activity previously known in the industry” – is repeated in the Reply Brief at pages 2–3.

The argument is unpersuasive as to error in the rejection.

As a preliminary matter, this argument over novelty – that the claimed method “is not a conventional activity previously known in the industry” – is a factor to be considered when determining “whether the claims contain a ‘inventive concept’ to ‘transform’ the claimed abstract idea into patent-eligible subject matter.” *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014). “[N]ovelty in implementation of the idea is a factor to be considered only in the second step of the *Alice* analysis.” *Id.* “[P]ragmatic analysis of § 101 is facilitated by considerations analogous to those of §§ 102 and 103 as applied to the particular case.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1347 (Fed. Cir. 2015).

However, a finding of novelty or nonobviousness does not necessarily lead to the conclusion that subject matter is patentable eligible.

“Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2117 (2013)

Indeed, “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175,

188–89 (1981) (emphasis added); *see also Mayo*, 132 S. Ct. at 1303–04 (rejecting “the Government’s invitation to substitute §§ 102, 103, and 112 inquiries for the better established inquiry under § 101”). Here, the jury’s general finding that Symantec did not prove by clear and convincing evidence that three particular prior art references do not disclose all the limitations of or render obvious the asserted claims does not resolve the question of whether the claims embody an inventive concept at the second step of *Mayo/Alice*.”

Intellectual Ventures I LLC v. Symantec Corp., 838 F.3d 1307, 1315 (Fed. Cir. 2016).

Nor does a finding of obviousness necessarily lead to the conclusion that subject matter is patentable ineligible. *See also Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1050 (Fed. Cir. 2016) (“That each of the claims’ individual steps (freezing, thawing, and separating) were known independently in the art does not make the claim unpatentable.”) “[P]atent-eligibility does not turn on ease of execution or obviousness of application. Those are questions that are examined under separate provisions of the Patent Act.” *Id.* at 1052 (citing *Mayo*, 566 U.S. at 90).

Notwithstanding that “the § 101 patent-eligibility inquiry and, say, the § 102 novelty inquiry might sometimes overlap[,] . . . a claim for a new abstract idea is still an abstract idea.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (citation omitted) (quoting *Mayo*, 566 U.S. at 90). The question in step two of the *Alice* framework is not whether an additional feature is novel but whether the implementation of the abstract idea involved “more than the performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1347–48 (quoting *Alice*, 134 S. Ct. at 2359).

In that regard, the Appellants have not shown the novel features transform the abstract idea (“inviting visitors to a website to cast a vote and posting the winner who received the most number of votes on a website is a method of organizing human activities that falls under an entrepreneurial objective” (Final Act. 5)) into patent-eligible subject matter. “Allowing members of the general public to nominate and vote for a recipient of a college scholarship using a network connected computer” (App. Br. 6) adds little of significance to “transform” the claimed abstract idea into patent-eligible subject matter. The implementation – on generic computers – remains the same. *See Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012) (“[s]imply adding a ‘computer aided’ limitation to a claim covering an abstract concept, without more, is insufficient to render the claim patent eligible.”).) At best, “[a]llowing members of the general public to nominate and vote for a recipient of a college scholarship using a network connected computer” (App. Br. 6) characterizes what the claimed subject matter is directed to at a level of abstraction lower than what the Examiner has characterized it to be directed to. *See Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240–1241 (Fed. Cir. 2016) (“An abstract idea can generally be described at different levels of abstraction. As the Board has done, the claimed abstract idea could be described as generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location. It could be described in other ways, including, as indicated in the specification, taking orders from restaurant customers on a computer.”) But its abstract nature remains the same.

The second argument is that

the rejected claims, if allowed, would not preempt the broader practice of inviting visitors to cast a vote and posting the winner who received the most number of votes. The claims are specifically directed to a method of attracting visitors to a college-related web site. The claims are narrowly tailored

App. Br. 7 (*see also* Reply Br. 3–4).

However, preemption is not a separate test. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (*citing Alice*, 134 S. Ct. at 2354). With respect to the pre-emption concern, “[w]hat matters is whether a claim threatens to subsume the full scope of a fundamental concept, and when those concerns arise, we must look for meaningful limitations that prevent the claim as a whole from covering the concept's every practical application.” *CLS Bank Intern. v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269, 1281 (Fed. Cir. 2013). Here, the argued-over “attracting visitors to a college-related web site” simply narrows the abstract idea so that it is described at a lower level of abstraction. It does not render the abstract idea to which the claim is directed to any less an abstract idea. “Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the Mayo framework, . . . preemption concerns are fully addressed and made moot.” *Ariosa*, 788 F.3d at 1379.

The remaining arguments have been considered, but are not persuasive as to error in the rejection.

The rejection of claims 19–40 under 35 U.S.C. § 103(a) as being unpatentable over Ireland and Official Notice.

The Appellants argued these claims as a group. *See* App. Br. 8–16; Reply Br. 4–7. We select claim 19 as the representative claim for this group, and the remaining claims 20–40 stand or fall with claim 19. 37 C.F.R. § 41.37(c)(1)(iv).

The Appellants challenge the rejection, arguing that: (1) “Determining a scholarship winner based on a vote cast by the general public proceeds contrary to the accepted wisdom of awarding scholarships based on a decision made by a panel of experts and trusted representatives” (App. Br. 8–13); (2) “A person of skill in the art would not have not seen a benefit to awarding a scholarship based on a vote cast by the general public” (*Id.* at 13–14); (3) “The proposed modification of the prior art renders the prior art unsatisfactory for its intended purpose” (*id.* at 14); and, (4) “Commercial success of the claimed invention” (*id.* at 15).

The Reply Brief makes similar arguments. The Declaration of Lloyd Thacker, filed under 37 C.F.R. 1.132 on May 2, 2012 was provided in support thereof.

“Many of appellant’s arguments fail from the outset because . . . they are not based on limitations appearing in the claims.” *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). In fact, here, all the arguments – and the statements made in the Declaration – are premised on limitations that are not in fact recited in the claim.

The Appellants argue *inter alia* that “[p]rior art methods for awarding a scholarship were not based on popularity or a vote cast by the general public. Declaration at 11” (App. Br. 12 (as to argument 1)); “[a]warding a

scholarship in a manner that would reduce the likelihood that funding organizations will contribute funds for scholarships would not have been seen as a benefit over prior art scholarship award methods” (*id.* at 14 (as to argument 2)); “[a] method of awarding scholarships based on a vote by the general public eliminates any control organization has in ensuring that the goal of its funding investment is met, thereby rendering the scholarship award method unsatisfactory for its intended purpose of promoting those goals” (*id.* (as to argument 3)); and, “[t]he commercial success of CollegeNET’s method of awarding scholarships is not based on using a panel of experts or trusted representatives to award the scholarship” (*id.* at 16 (as to argument 4)).

But claim 19 does not exclude using, for examples, a panel of experts or trusted representatives. The Specification does not define “general public” as excluding anyone. Accordingly, in reciting “general public,” it is reasonably broadly construed to include a panel of experts or trusted representatives.

Nor does claim 19 say anything about *awarding* a scholarship. The claimed method broadly “determin[es] from the vote cast a scholarship winner [and posting the result].” But the claimed method does not limit *awarding* the scholarship consistent with said vote and posting.

Accordingly, the argument that “[a] method of awarding scholarships based on a vote by the general public eliminates any control organization has in ensuring that the goal of its funding investment is met” is not a persuasive one because it is not commensurate in scope with what is claimed, which is

much broader. Claim 19 is not limited so as to *award* scholarships based on a vote by the general public, *excluding a control organization*.

Given that all the arguments are premised on awarding a scholarship based on a vote by members of the general public, not to include members of a control organization, and that claim 19 is not so limited, the arguments cannot be persuasive as to error in the rejection as they are not commensurate in scope with what is claimed.

The rejection is sustained.

CONCLUSIONS

The rejection of claims 19–40 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter is affirmed.

The rejection of claims 19–40 under 35 U.S.C. § 103(a) as being unpatentable over Ireland and Official Notice is affirmed.

DECISION

The decision of the Examiner to reject claims 19–40 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)(iv).

AFFIRMED