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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LIAM SEAN LYNCH, FRASER MacCONNELL SMITH,
SANDEEP BHALLA, and DEBORA E. AOKI

Appeal 2016-002985
Application 12/269,784
Technology Center 3600

Before JASON V. MORGAN, NABEEL U. KHAN, and
AARON W. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants¹ appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–12, 14, 15, 17–25, and 27–32, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

THE INVENTION

The application is directed to a “method and a system to register a user includ[ing] using some user information stored and provided by a third party system.” (Abstract.) Claim 1, reproduced below, exemplifies the subject matter on appeal:

1. A system comprising:

at least one processor;

a user service module coupled to the at least one processor and configured to provide a network-based service, the user service module comprising:

a user registration module coupled to the at least one processor and configured to receive an identifier from a user not registered with the network-based service to perform a user registration for the network-based service; and

a communication module coupled to the user registration module and configured to receive user information from a third party system based on the identifier, to provide the user an option to modify the user information received from the third party system, and to receive modification information from the user based on the option; wherein

the user registration module is configured to:

¹ Appellants identify eBay, Inc. as the real party in interest. (App. Br. 2.)

modify the user information received from the third party system with the modification information received from the user, and

at least partially complete the user registration using the user information received from the third party system as modified by the modification information received from the user.

THE REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Vianello	US 2003/0182171 A1	Sep. 25, 2003
Barrett et al.	US 2007/0277235 A1	Nov. 29, 2007
Klug et al.	US 7,412,434 B1	Aug. 12, 2008
Gui et al.	US 7,676,829 B1	Mar. 9, 2010

THE REJECTIONS

1. Claims 1–12, 14, 15, 17–25, and 27–32 stand rejected under 35 U.S.C. § 101 “because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more.” (*See* Final Act. 2–3.)

2. Claims 1, 4–6, 8–12, 17–23, 25, and 27–32 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Klug and Barrett. (*See* Final Act. 4–17.)

3. Claims 2, 3, 14, 15, and 24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Klug, Barrett, and Gui. (*See* Final Act. 17–19.)

4. Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Klug, Barrett, and Vianello. (*See* Final Act. 19.)

ANALYSIS

Appellants' claims are generally directed to a system in which a "user service module" that is "configured to provide a network-based service" (a) receives an identifier from a new user to perform a user registration; (b) receives user information from a third party system based on the identifier; (c) provides the user an option to modify the received user information; (d) modifies the user information; and (e) completes the user registration using modified user information. They stand rejected under Section 101, as directed to an abstract idea and lacking an inventive concept, and under Section 103, as obvious of in view of, primarily, Klug and Barrett.

Section 101

The Examiner finds the claims directed to the abstract idea of "user registration using an identifier to register a user." (Final Act. 2.) Accepting that as the abstract idea, we agree with Appellants that the claims, when considered as an ordered combination, *do* include an inventive concept sufficient to render the claims eligible for patenting. In particular, the claims are directed to a system in which user information to be used in a new registration is received from a third party system, the user is provided the option of modifying the received information, and user is registered using the modified registration. We agree with Appellants that this set of steps provides an improvement in the functioning of the computer, in that it allows a user to register for new websites without entering all of their information each time, but with the option of modifying the information if necessary.

These claims do not recite a routine business practice simply implemented on a general purpose computer; instead, they concern a

purportedly new² system for users to interact with computers. “To be sure, [Appellants’] claims do not recite an invention as technologically complex as an improved, particularized method of digital data compression,” but “nor do they recite a commonplace business method aimed at processing business information, applying a known business process to the particular technological environment of the Internet, or creating or altering contractual relations using generic computer functions and conventional network operations, such as the claims in *Alice*, *Ultramercial*, *buySAFE*, *Accenture*, and *Bancorp*.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1259 (Fed. Cir. 2014). The instant claims are similar in character to those approved in *Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), which also used conventional computer components but were found eligible because they arranged those components so as to provide specific advantages to users of the system. *See id.* at 1352 (describing the eligible claims as directed to “carv[ing] out a specific location for the filtering system (a remote ISP server) and requir[ing] the filtering system to give users the ability to customize filtering for their individual network accounts”); *see also Amdocs*, 841 F.3d at 1300–01 (approving a claim that “requires arguably generic components” but also “necessarily requires that these generic components operate in an unconventional manner to achieve an improvement in computer

² Whether the patent eligible system is also patentable over the prior art is a different question, *see Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1311 (Fed. Cir. 2016) (Reyna, J., dissenting) (“The inventiveness inquiry of § 101 should . . . not be confused with the separate novelty inquiry of § 102 or the obviousness inquiry of § 103.”), resolved below.

functionality”); *Trading Techs. Int’l, Inc. v. CQG, Inc.*, 675 F. App’x 1001, 1005 (Fed. Cir. 2017) (“Abstraction is avoided or overcome when a proposed new application or computer-implemented function is not simply the generalized use of a computer as a tool to conduct a known or obvious process, but instead is an improvement to the capability of the system as a whole.”).

Because we find Appellants’ claims to include the talismanic “inventive concept,” we decline to sustain the rejection under Section 101.

Section 103

The obviousness rejections rely primarily on Klug, which describes a system in which a user may store registration information that then may be used to register the user at various third party websites. In particular, Klug describes an embodiment in which the user provides registration information to a registrar web site and then, when the user wishes to register with a third party website, the user provides a user ID to the new website, allowing the new website to obtain the user’s information from the registrar web site for use in registering the user. (*See Klug 2:39–50.*) Klug is thus quite similar to Appellants’ system in that it allows a user to store user information for reuse in multiple new registrations.

The Examiner finds that Klug teaches all of the limitations of claim 1, except that “Klug does not specifically teach about modify[ing] information from [the] third party with modification information from [the] user.” (Final Act. 6.) The Examiner further finds, however, that “Barrett teaches about modify[ing] the user information on the third party system with the modification information received from the user” and that it would have been obvious to introduce that feature into a system like Klug “for the

motivation of providing a technique to users for managing their identification information on the internet.” (*Id.*)

Appellants argue the rejection of claim 1 is flawed “because Klug teaches that the information is provided to the third party web site from the registrar and the claim recites that the communications module receives information from a third party system.” (App. Br. 12.) This is not persuasive. As described above, Klug teaches that the third party web site receives the user’s information from the registrar. This is essentially the same as the claim 1 system, in which a “communication module” of “a user service module . . . configured to provide a network-based service” “receive[s] user information from a third party system based on the identifier.” The claimed “third party system” corresponds to Klug’s “registrar web site” because they both store the user information that is provided to a new website with which the user desires to register.

Appellants also argue with respect to claim 1 that “the alleged third party in Klug for [the “provide the user an option to modify”] element is *different from* the alleged third party in the earlier element.” (App. Br. 12.) We do not agree. In each case the claimed “third party” maps to Klug’s “registrar web site,” which provides the user information.

With respect to claim 9, Appellants argue that “Barrett, even in combination with Klug, teaches a registrar website that both verifies and modifies user information” and, as a consequence, “neither Barrett nor Klug, alone or in combination, teaches or suggests ‘modifying, *at the system providing the service, the user information received from the third party system* using the modification information received from the user.’” (App. Br. 13–14.) We are not persuaded of error. In paragraph 23, Barrett

describes “using [a] stored library of user data to partially complete a user logon form for [a] resource on behalf of the user.” We do not agree that this teaching is limited to editing the stored information on the website that stores it. Instead, we find it to teach that one of skill in the art would have understood it to be advantageous to provide the stored data for user review prior to registration. We further agree that, in light of this teaching, it would have been obvious to one of skill in the art to modify Klug such that the information provided from the registrar website to the third party website is presented to the user (including by the third party website) for verification and, if necessary, editing. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (“If a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”).

As we find Appellants’ arguments insufficient to show error, we sustain the rejections of claims 1 and 9 under Section 103.

Appellants’ arguments regarding claims 17 and 22 mirror the arguments for claim 1, and Appellants’ arguments for claim 25 mirror the arguments for claims 1 and 9. We find them insufficient to show error for the reasons identified above and, therefore, sustain the Section 103 rejections of claims 17, 22, and 25. For the same reasons, we also sustain the Section 103 rejections of dependent claims 2–8, 10–12, 14, 15, 18–21, 23, 24, and 27–32, which are not argued separately.

DECISION

The rejections of claims 1–12, 14, 15, 17–25, and 27–32 under 35 U.S.C. § 101 are reversed. The rejections of claims 1–12, 14, 15, 17–25, and 27–32 are under 35 U.S.C. § 103 are 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).

AFFIRMED³

³ Because we affirm at least one ground of rejection with respect to each claim on appeal, the Examiner’s decision rejecting claims 1–12, 14, 15, 17–25, and 27–32 is affirmed. *See* 37 C.F.R. § 41.50(a)(1).