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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ELLISON SCUDDER,
JOHN SELLE, ROBERT AZUMA, and JEFF SCHAFER

Appeal 2016-004364
Application 14/068,617¹
Technology Center 3600

Before HUBERT C. LORIN, TARA L. HUTCHINGS, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 21–40. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The Appellants identify American International Group, Inc. as the real party in interest. Appeal Br. 1.

ILLUSTRATIVE CLAIM

21. A computer server-implemented method for processing transactions involving a travel insurer and a travel service provider, comprising:

receiving, by a travel insurer computing device, itinerary data in a travel service provider messaging format generated by the travel service provider;

generating, by the travel insurer computing device, itinerary data in a travel insurer messaging format by converting the itinerary data in the travel service provider messaging format to the itinerary data in the travel insurer messaging format based on a mapping of the travel service provider messaging format to the travel insurer messaging format, wherein the mapping is one of a plurality of mappings between messaging formats associated with travel service providers and the travel insurer messaging format;

determining, by the travel insurer computing device, a travel insurance policy based on the itinerary data in the travel insurer messaging format; and

transmitting, by the travel insurer computing device, information pertaining to the determined travel insurance policy to a customer computing device for presentation to a customer of the travel service provider.

REJECTION

Claims 21–40 are rejected under 35 U.S.C. § 101 as ineligible subject matter.

ANALYSIS

Applying the first step of the methodology delineated in *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347, 2355 (2014), the rejection states that independent claim 21 is directed to processing transactions involving a travel insurer and a travel service provider, which the rejection identifies as an abstract idea that is not eligible for patenting.

Final Action 3. The rejection bases this determination upon the comparison of claim 21 to court-determined abstract ideas — the use of categories for organizing, storing, and transmitting information, and to organizing information through mathematical correlations using rules to identify options. *Id.* The rejection applies the same reasoning to independent claims 28 and 35, as well. Answer 6. The rejection likewise regards the dependent claims as directed to abstract ideas, determining that each (like the independent claims) uses categories to organize, store and transmit information and/or compares new and stored information and uses rules to identify options. *Id.* at 6–8.

Under the second step of the *Alice* analysis, the rejection determines that the various elements of claim 21, whether regarded individually or as an ordered combination, amount to no more than the performance of generic computer functions that are well-understood, routine, and conventional — the claim being no more than instructions to apply the abstract idea on a computer — such that claim 21 does not constitute patent-eligible subject matter. *Id.* at 3–5. According to the rejection, the same analysis applies to all the other claims in the Appeal. *Id.* at 5–6; *see also* Answer 9.

Disputing the rejection, the Appellants argue, as to the first *Alice* step, that independent claim 21 does not monopolize any basic tool of scientific and technological work, but instead “recites a specific ordered combination of components and limitations that provide a particular manner of solving a network-centric problem relating to the usage of different messaging formats for itinerary by travel insurer computing devices and travel service provider computing devices.” Appeal Br. 4.

Yet, “[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). *See also* Answer 11. Further, although the Appellants contend that the claimed subject matter is not directed to an abstract idea, because it “provide[s] a particular manner of solving a network-centric problem” (Appeal Br. 4; *see also id.* at 7–8), the Appellants do not specify any error in the Examiner’s characterization of claim 21 in the identified abstract idea. Simply proposing an alternative characterization does not undermine the Examiner’s characterization of the claimed subject matter. Indeed, “[a]n abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016).

Turning to the second step of the *Alice* analysis, the Appellants argue that recited elements amount to significantly more than the identified abstract idea itself. Appeal Br. 6–9. In particular, the Appellants liken the subject matter recited in claim 21 to that of *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1258 (Fed. Cir. 2014) (the example on pages 4–6 of the USPTO Guidance entitled “Examples: Abstract Ideas,” Jan. 27, 2015, which is cited on page 6 of the Appeal Brief). *See* Appeal Br. 6, 8–9; *see also* Reply Br. 6–7. Yet, the Appellants’ argument is unpersuasive, because it does not identify any aspect of claim 21 that achieves the critical “result that overrides the routine and conventional sequence of events ordinarily triggered by the” operation of generic technology. *DDR Holdings*, 773 F.3d at 1258. *See also* Answer 11–15.

The Appellants also argue that the claimed elements, as an ordered combination, provide “technical integration of a travel insurer’s web

applications into their partnering travel service provider’s websites without requiring the travel service provider’s computing devices to have input applications and corresponding data structures to the travel insurer’s specifications.” Appeal Br. 9. However, the Appellants identify no specific claim elements (or combination thereof) for performing such “technical integration” that might give rise to patent eligibility under the second *Alice* step. Instead, the Appellants’ argument simply refers to the general concept of converting data from one format to another — an activity that is not shown to involve anything other than conventional technology, in any event.

The Appellants’ Reply Brief contends that the Examiner’s Answer sets forth a “new analysis” that “failed to consider what the claimed invention accomplishes in practice as an ordered combination,” but instead “focused only on characterizing each individual element of the claim as being ‘abstract’ or a ‘post-solution activity.’” Reply Br. 2–3 (citing Answer 3–9). According to the Appellants, “[v]irtually any claim, when dissected in this manner, can be accused of being abstract.” *Id.* at. 2.

However, the identified aspects of the Examiner’s Answer regard features of dependent claims 22–27, 29–34, and 36–40 as using categories to organize, store and transmit information and/or comparing new and stored information and using rules to identify options (*see* Answer 6–8) — which are the same court-designated abstract ideas identified in the Final Office Action (pages 3–4 and 6–7). Specifically, these abstract-idea descriptions are drawn from *Cyberfone Systems, LLC v. CNN Interactive Group, Inc.*, 558 F. App’x 988, 992 (Fed. Cir. 2014) (nonprecedential) (“[U]sing categories to organize, store, and transmit information is well-established. Here, the well-known concept of categorical data storage, *i.e.*, the idea of

collecting information in classified form, then separating and transmitting that information according to its classification, is an abstract idea that is not patent-eligible.”) and *SmartGene, Inc. v. Advanced Biological Laboratories, SA*, 555 F. App’x 950, 955 (Fed. Cir. 2014) (nonprecedential) (“Whatever the boundaries of the ‘abstract ideas’ category, the claim at issue here involves a mental process excluded from section 101: the mental steps of comparing new and stored information and using rules to identify medical options.”) The Federal Circuit has endorsed such reliance upon concepts determined by courts to be abstract ideas, in patent-eligibility determinations. *See Amdocs (Israel) Limited v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (a “decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.”) Therefore, what the Appellants identify as a “new” analysis (*see* Reply Br. 2–3) simply applies the same approach employed in the Final Office Action.

The Appellants’ Reply Brief also contends that the Examiner’s Answer “conflate[s] 35 U.S.C. § 103 with 35 U.S.C § 101 such that the Answer is able to reject the claims on obviousness while bypassing the burden under 35 U.S.C § 103 to identify prior art that supports the obviousness argument.” Reply Br. 6 (citing Answer 11–13). This argument is not persuasive. Although the second step of the *Alice* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or nonobviousness, but rather, it is a search for “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. “The ‘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). Notwithstanding the foregoing, the Appellants, nevertheless, do not identify any element, or combination of elements, that is allegedly not routine and conventional.

Because the Appellants’ arguments are not persuasive of error, we sustain the rejection of claims 21–40 under 35 U.S.C. § 101.

DECISION

We AFFIRM the Examiner’s decision rejecting claims 21–40 under 35 U.S.C. § 101.

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

AFFIRMED