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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALBIA A. DeMARANVILLE III, NORMAN G. HAUN,
MICHAEL K. HUTCHESON, RICHARD A. WYATT, and
WILLIAM E. REEVES

Appeal 2016-006632
Application 11/069,049
Technology Center 3600

Before BIBHU R. MOHANTY, MEREDITH C. PETRAVICK, and
JAMES A. TARTAL, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134(a) of the final rejection of claims 1–10, 23–26, and 31–44, 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.

THE INVENTION

The Appellants' claimed invention is directed to a system for facilitating the management of a retail marketing program in a networked environment (Spec., page 1, lines 15–16). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A non-transitory computer-readable medium tangibly embodying a program of computer-executable instructions that, when executed by a computer, present a user interface for output to a display device of a computer, the user interface including a plurality of computer-generated components, at least some of the components being dynamically and electronically manipulable by a user to aid in managing a retail marketing program in which at least one retailer earns credit from another entity to promote sale of the another entity's products, the components comprising:
 - a product identification component configured to identify products included in the retail marketing program in which the retailer earns credit from the another entity to promote the sale of another entity's products, the identified products being dynamically and electronically retrieved and arranged for inclusion in the product identification component in response to a user request for information about the retail marketing program; and
 - a scenario calculations component configured to facilitate user input of data relating to each of the products identified by the product identification component;wherein the product identification component and the scenario calculations component are dynamically generated, responsive to user interaction with the scenario calculations component, so as to form and be included in at least a part of a single page view, the single page view identifying an amount of credit earned or projected to be earned by the retailer to promote the sale of the another entity's products and being generated for presentation as at least a part of the user interface for output to the display device of the computer.

THE REJECTION

The following rejections is before us for review:

Claims 1–10, 23–26, and 31–44 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

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 evidence¹.

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellants argue that the rejection of claim 1 is improper because the claims are not directed to an abstract idea (App. Br. 9–15, Reply Br. 2–8). The Appellants also argue that the claims are “significantly more” than the alleged abstract idea (App. Br. 15–25, Reply Br. 8, 9).

In contrast, the Examiner has determined that rejection is proper (Final Act. 2–9, Ans. 2–8).

We agree with the Examiner. 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: “[l]aws 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).

¹ *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

In judging whether claim 1 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.” *Id.* at 2358.

Here, we determine that the claim is directed to the concept of identifying products and credits in a retail marketing program and determining the credits earned or projected. This is a method of organizing human activities and fundamental economic practice long prevalent in our system of commerce and is an abstract idea beyond the scope of § 101. *See Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016) (collecting information, analyzing it, and displaying results from certain results of the collection and analysis was held to be an abstract idea).

The Appellants argue at pages 8–11 of the Appeal Brief that the rejection in identifying claim 1 as both a “fundamental economic practice” and “method of organizing human activities” is flawed for failing to clearly articulate an abstract idea. However, abstract ideas can be characterized at

different levels of abstraction. *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240–41 (Fed. Cir. 2016) (“An abstract idea can generally be described at different levels of abstraction.”). Thus we are not persuaded by this argument put forth by the Appellants.

We next consider whether 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 over the 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. Each step of the claimed method does no more than require a generic computer to perform a generic computer function. For example, the Specification at pages 8 and 9 describes using known processor servers, computing devices, and markup languages in a conventional manner for their known functions.

We note the point about pre-emption (App. Br. 11). While pre-emption “might tend to impede innovation more than it would tend to promote it, ‘thereby thwarting the primary object of the patent laws’” (*Alice*, 134 S. Ct. at 2354 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012))), “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 *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015), cert. denied, 136 S. Ct. 701, 193 (2015)(“[T]hat the claims do not preempt

all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”).

We note the Appellants also argue that the Decision of March 13, 2014, established as “fact” that “the claimed combination . . . requires more than just using applying a computer program to automate the portions of Acer relied on by the Examiner” (App. Br. 16–23, Reply Br. 8, 9) and, therefore, that the claim should pass prong 2 of the *Alice* test. It is also argued that Footnote 4 of that Decision states that “the source of content affects how the underlying computer substrate operates to form the single page view,” showing that the claims pass the second prong of the *Alice* test (App. Br. 18–23, Reply Br. 8, 9).

We disagree with this contention in many regards. First, although the second step in the *Alice/Mayo* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, 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. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 132 S. Ct. at 1304.

Second, while the prior Decision used the phrase “*more* than just using applying a computer program,” it did not use the phrase “*significantly* more,” which is the standard used in the second prong of *Alice*. (Emphasis added).

Thirdly, the Appellants have taken the cited language from the Decision of March 13, 2014, out of context in relation to the issue at hand. In the rejection of record, the Examiner acknowledged that portions of the

claim were not disclosed by Acer, for which Official Notice was taken to meet the requirements of the claim. In that Decision the term “requires more than” merely refers to the portions of the claim language not shown by Acer rather than making a determination of whether or not the claim was directed to an abstract idea. The cited use of the term “requires more than” in that Decision does not refer to the claim in regards to patent eligibility analysis. With regard to the Footnote 4 of that Decision it is directed to the non-functional material descriptive issues being addressed. The determination there that the “underlying computer substrate operates to form the single page view” goes to that issue rather than a determination under 35 U.S.C. § 101 that the claim is significantly more than the abstract idea.

For these reasons, the rejection of claim 1 is sustained. The Appellants have presented the same arguments for the remaining claims and the rejection of these claims is sustained as well.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1–10, 23–26, and 31–44 under 35 U.S.C. § 101.

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Application 11/069,049

DECISION

The Examiner's rejection of claims 1–10, 23–26, and 31–44 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