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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER J. CUNNINGHAM and
MATTHEW D. KOJIS

Appeal 2016-006723¹
Application 14/012,997
Technology Center 3600

Before CARL W. WHITEHEAD JR., AARON W. MOORE, and
DAVID J. CUTITTA II, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* CUTITTA.

Opinion Dissenting filed by *Administrative Patent Judge* MOORE.

CUTITTA, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's final decision rejecting claims 1–4, 9–17, and 22–26, which are all the claims pending in the application.² Appellants indicate this appeal is related to an appeal (2016-007751) for co-pending application 14/012,986. *See* Appeal Br. 4. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellants name Leadfusion Incorporated as the real party in interest. *See* Appeal Br. 3.

² Claims 5–8, 18–21, and 27–30 are cancelled. *See* Appeal Br. 26, 28.

STATEMENT OF THE CASE

Invention

Appellants' invention as claimed relates to providing a web site configured to receive and store data from a user in a first mode or a second mode. The user is provided with an alphanumeric code to access the stored data. The user may access the stored data using the code without authentication. *See Spec ¶ 7.*³

Exemplary Claim

Claims 1 and 14 are independent. Claim 1 is exemplary of Appellants' invention and is reproduced below:

1. Non-transitory computer-readable storage media encoded with a computer program including instructions executable by a processor to create an application comprising:
 - a. a software module configured to provide a web site wherein the web site is configured to receive data entered by a user in a first mode or a second mode and use the data to generate output, the output displayed on an interface;
 - b. a software module configured to receive a request from the user to generate a unique code;
 - c. a software module configured to generate the unique code in response to the request, the unique code comprising an alphanumeric code, a linear bar code, a two-dimensional bar code, or a combination thereof;
 - d. a software module configured to provide the unique code to the user;

³ This Decision refers to: (1) Appellants' Specification filed August 28, 2013 ("Spec."); (2) the Final Office Action ("Final Act.") mailed May 6, 2015; (3) the Appeal Brief ("Appeal Br.") filed October 5, 2015; (4) the Examiner's Answer ("Ans.") mailed April 27, 2016; and (5) the Reply Brief ("Reply Br.") filed June 27, 2016.

e. a software module configured to maintain persistence of state information and user-entered data between the first mode and the second mode of the web site across locations and interfaces without authentication;

f. a software module configured to store a copy of the unique code and link the copy of the unique code to the persistent state information and user-entered data; and

g. a software module configured to accept the unique code, match the unique code with the stored copy of the unique code, retrieve the persistent state information and user-entered data according to the link between the stored copy of the unique code and the persistent state information and user-entered data, and configure the web site according to the retrieved persistent state information and the user-entered data, wherein the persistent state information and user-entered data are from either the first mode or the second mode of a first web session and are used to configure the web site in a subsequent web session in either mode.

Appeal Br. 25.

REJECTION

Claims 1–4, 9–17, and 22–26 stand rejected under 35 U.S.C. § 101 as directed to non-patentable subject matter. Final Act. 2.

ANALYSIS

Appellants argue the claims as a group. *See* Appeal Br. 10. We select independent claim 1 as representative of Appellants’ arguments for claims 2–4, 9–17, and 22–26. 37 C.F.R. § 41.37(c)(1)(iv).

With respect to independent claim 1, the Examiner finds the claim is directed to a judicial exception, the abstract idea of “compiling research that is persistent and portable.” Ans. 2. The Examiner also finds the claim does “not include additional elements that are sufficient to amount to significantly more than the judicial exception.” *Id.*

Appellants present several arguments against the § 101 rejection. We do not find Appellants' arguments persuasive. Instead, we find the Examiner has provided a comprehensive response to Appellants' arguments supported by a preponderance of evidence. *See* Ans. 2–6. As such, we adopt the Examiner's findings and explanations. Final Act. 2–4; Ans. 2–6.

Section 101 provides that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. The provision, however, “contains an important implicit exception: “. . . [L]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). The “abstract ideas” category embodies the longstanding rule that an idea, by itself, is not patentable. *Alice*, 134 S. Ct. at 2355 (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)).

In *Alice*, the Supreme Court sets forth an analytical “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 77–78 (2012)). The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’ to determine whether [there are] additional elements [that] ‘transform the

nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78). In other words, the second step is to “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.’” *Id.* (brackets in original) (quoting *Mayo*, 566 U.S. at 73). The prohibition against patenting an abstract idea “‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or adding ‘insignificant postsolution activity’.” *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010).

Here, turning to the first step of the *Alice* inquiry, we agree with the Examiner that Appellants’ claim 1 is directed to an abstract idea because in the claim “[t]hese steps can be performed mentally, and are similar to the concepts identified as abstract ideas by the courts (e.g., using categories to organize and store information for transmission (Cyberfone) or comparing new and stored information and using rules to identify options in (SmartGene)).” Ans. 3 (citing *Cyberfone Sys., LLC v. CNN Interactive Grp.*, 558 Fed. Appx. 988 (Fed. Cir. 2014) and *SmartGene, Inc. v. Advanced Biological Laboratories, SA*, 555 Fed. Appx. 950 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 58 (2014)). We need not define the outer limits of “abstract idea,” or at this stage exclude the possibility that any particular inventive means are to be found somewhere in the claims, to conclude that these claims focus on an abstract idea—and hence require stage-two analysis under § 101.

Information as such is an intangible. *Bayer AG v. Housey Pharm., Inc.*, 340 F.3d 1367, 1372 (Fed. Cir. 2003). Accordingly, our reviewing court has treated storing or collecting information as within the realm of

abstract ideas. *See, e.g., OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011). Similarly, our reviewing court has treated activities that could be performed by a human, e.g., mentally, using pen and paper, and/or manually, without the use of a computer or any other machine, as essentially mental processes within the abstract-idea category. *See CyberSource*, 654 F.3d at 1372–73; *see also Bancorp Services, L.L.C. v. Sun Life Assurance Co. of Canada (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012). In addition, merely providing or displaying the results of abstract processes of storing or analyzing information, without more, is abstract as an ancillary part of such collection or analysis. *See, e.g., Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014); *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014).

Here, at the first step of the *Alice* analysis, we determine claim 1 is directed to the abstract idea of configuring a website, using stored data, for display to a user, without authentication, when a code entered by the user matches a stored code. Namely, claim 1 relates to storing data entered by a user in either a first mode or a second mode of a first web session and configuring a website in a subsequent web session in either mode. Claim 1, therefore, is focused on the combination of the abstract-idea processes of storing data, analyzing the data, and configuring certain stored data for display according to the analyzing. That is, the advancement Appellants purport to make is merely a process of storing and analyzing information of a specified content and then configuring the results for display, without any

particular inventive technology for performing those functions. Claim 1 does not recite a particular way of programming or designing the software to create the website that displays the content, but instead merely claims the result. Essentially, the claim is directed to certain functionality—here, the ability to configure certain stored data for display in response to entry of a code by the user. The claim is, therefore, directed to an abstract idea.

Appellants contend the Examiner has misapprehended the Court’s *Alice* analysis requirement in step 1 to consider the elements of the claim as a whole because the Examiner’s characterization of the claims in step one of the *Alice* analysis “specifically ignore[s] most of the positively recited limitations in the claim as well as the consistent context provided in the specification.” Appeal Br. 11.

We are unpersuaded. Contrary to Appellants’ argument, the Examiner properly considered the *claim elements* of claim 1 as a whole under the two-step *Alice* analysis when the Examiner considered all *claim elements*, both individually and in combination, under step 2 of the analysis. *See* Ans. 3. Appellants do not contend the Examiner failed to consider all *claim elements* of claim 1 as a whole under step 2 of the *Alice* analysis.

To the extent Appellants argue the claim’s character as a whole (considered in light of the consistent context of the Specification) is not directed to an abstract idea (Appeal Br. 11), we remain unpersuaded. Contrary to Appellants’ argument, Appellants’ Specification states in the Background section that “[c]urrently available technology fails to allow consumers of financial products and services to compile research that is persistent and portable across locations” and that advantages of the claimed invention include “offering guided selling dialogs to consumers of financial

products and services that include scripted questions based on best practices.” Spec. ¶¶ 4, 6. We conclude there is more than sufficient basis to conclude under step 1 of the *Alice* analysis that claim 1 is directed to an abstract idea of “compiling research that is persistent and portable.” Ans. 2. Although the Examiner describes claim 1 at a different level of abstraction than our characterization *supra*, this does not make the claim any less abstract. *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. . . . The Board’s slight revision of its abstract idea analysis does not impact the patentability analysis.”).

Appellants next argue that the appealed “claims do not preempt all applications of a graphical display” (Appeal Br. 13) and “the Answer does not address the question of preemption in this case or offer any evidence that the claimed subject matter ‘ties-up’ and preempts all applications of any abstract idea across all fields” (Reply Br. 9). We find Appellants’ argument unpersuasive because we agree with the Examiner that “the absence of complete preemption does not guarantee that a claim is eligible.” Ans. 4; *see Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility”). Furthermore, the fact that the claims do not preempt does not make them any less abstract. *See, e.g., OIP Technologies*, 788 F.3d at 1363 (finding that the claims do not become “any less abstract” due to lack of preemption); *Fairwarning IP LLC v. Iatric Systems, Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016). “Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they

are in this case, preemption concerns are fully addressed and made moot.”
Ariosa, 788 F.3d at 1379.

Turning to the second step of the *Alice* inquiry, we find nothing in Appellants’ claim 1 that adds “significantly more,” sufficient to transform the abstract concept of storing and displaying information into a patent-eligible application. *Alice*, 134 S. Ct. at 2357. We agree with the Examiner that in the instant claim, “the applicant has merely implemented routine computer protocols to implement routine off line activities” (Ans. 6), i.e., activities that could have been performed by hand or mentally. Merely storing information for display at a later time does nothing significant to differentiate a process from ordinary mental processes, whose implicit exclusion from § 101 underpins the information-based category of abstract ideas. Claim 1 does not require a new source or type of information, or a new technique for analyzing it. Moreover, the providing of stored data upon receipt of a unique alphanumeric code without authentication is no different than retrieving any stored computer file upon entry of the file name or retrieving any website data that corresponds to a specific URL. *See* claim 1. Consequently, claim 1 does not require an arguably inventive set of components or methods, such as measurement devices or techniques, that would generate new data or provide a new way of analyzing that data. Still further, the claim does not invoke any assertedly inventive programming. Merely manipulating stored data for display by itself does not transform the otherwise-abstract processes of information collection and analysis.

Appellants argue claim 1 recites significantly more than an abstract idea because the claim: (i) “recite[s] specific limitations other than what is well-understood, routine, and conventional in the field;” (ii) “recite[s]

improvements to a technical field;” and (iii) “recite[s] unconventional steps that confine the claim to a particular useful application.” *See* Appeal Br. 16–20 (emphases omitted).

We are unpersuaded. In the argument set forth in section (c)(i), Appellants fail to persuasively indicate any specific limitations that are other than well-understood, routine, and conventional in the field. *See* Appeal Br. 16–17.

In section (c)(ii), Appellants argue claim 1 recites improvements to a technical field because “the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” Appeal Br. 18 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014) (finding inventive concept in modification of conventional mechanics behind website display to produce dual-source integrated hybrid display)). Appellants further argue, “[s]imilar to *DDR Holdings*, the pending claims recite a specific technological solution that addresses a specific technological problem in the field of cross-channel product education, research, and recommendation and collaboration tools for both consumers and sales representatives.” Appeal Br. 23.

We disagree. The solution offered by Appellants’ claim is not rooted in any new computer technology. Rather, it offers portable storage of user research and “guided selling dialogs to consumers of financial products and services that include scripted questions based on best practices.” Spec. ¶ 6. The solution Appellants offer is “an entrepreneurial, rather than a technological, one.” *DDR*, 773 F.3d at 1265 (Mayer, J., dissenting). Claim 1 does not require an arguably inventive device or technique for displaying

information, unlike the claims at issue in *DDR Holdings*. Nothing in claim 1, understood in light of the Specification, requires anything other than an off-the-shelf computer, and display technology for extracting and presenting the desired data. Our reviewing court has repeatedly held that such invocations of computers and networks that are not even arguably inventive are “insufficient to pass the test of an inventive concept in the application” of an abstract idea. *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1353, (Fed. Cir. 2014); *see, e.g., Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015).

In section (c)(iii), Appellants argue claim 1 is confined “to a specific ordered way of accomplishing a particular useful application for systems which to allow consumers to move between two operating modes, breaking and reengaging from the process at will, without losing any of their work.” Appeal Br. 19–20.

We are not persuaded. Under the second step of the *Alice* analysis, we evaluate 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. Here, the claim essentially recites storing data entered by a user in either a first mode or a second mode, generating a unique code in response to a request and providing the code to the user, retrieving the stored data at a later time without authentication in response to receiving the unique code, and configuring a web site according to the retrieved data. *See* claim 1. Such steps constitute no more than gathering existing data, manipulating the existing data to generate additional data, and generating the data for display on a website. These activities are routine, if not necessary, for the creation of a website. We, therefore,

determine these steps represent insignificant pre-solution or post-solution activity. Appellants argue the “elements of the pending claims confine the invention to a specific ordered way of accomplishing the inventive process.” Appeal Br. 19. Regardless, the claimed arrangement is merely an improved abstract idea, i.e., an improved way of displaying data. As discussed above, this is insufficient to transform the abstract idea into patent-eligible subject matter.

Viewed as a whole, claim 1 does not provide additional meaningful limitations sufficient to transform the claimed abstract idea into a patent eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself. Because claim 1 is directed to a patent-ineligible abstract concept and does not recite “significantly more” under the second prong of the *Alice* analysis, we sustain the Examiner’s rejection of this claim under 35 U.S.C. § 101 as being directed to non-statutory subject matter in light of *Alice* and its progeny. We also sustain the Examiner’s rejection under 35 U.S.C. § 101 of the other disputed claims, which are not argued separately.

DECISION

We affirm the Examiner’s rejection of claims 1–4, 9–17, and 22–26.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER J. CUNNINGHAM and
MATTHEW D. KOJIS

Appeal 2016-006723
Application 14/012,997
Technology Center 3600

Before CARL W. WHITEHEAD JR., AARON W. MOORE, and
DAVID J. CUTITTA II, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*, DISSENTING.

DISSENTING OPINION

Appellants describe and claim a system for maintaining persistence of state information and user-entered data between a first mode and a second mode of a web site across locations and interfaces without authentication. The Specification states that the invention solves a problem in that “[c]urrently available technology fails to allow consumers of financial products and services to compile research that is persistent and portable across locations and channels.” (Spec. ¶ 4.)

Viewing the claims as a whole and in light of the Specification, I find them similar, from a patent eligibility perspective, to the claims approved in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014). The *DDR* claims were held eligible because they did “not merely recite the performance of some business practice known from the pre-Internet world along with the requirement to perform it on the Internet,” but instead recited a “solution . . . necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” 773 F.3d 1257. My view is that Appellants’ invention similarly is not simply relocation of a pre-Internet business practice to the Internet, but instead provides a new way to overcome a problem (the inability to compile research that is persistent and portable across locations and channels) specifically arising in the realm of computer networks. While it is true that Appellants’ invention is implemented by storing, retrieving, and displaying data, I would find that fact not disqualifying, just as it was not in *DDR*, because the claims as a whole are directed to an apparently new system for overcoming a specific problem.

For these reasons, I would find the claims patent eligible and, therefore, respectfully dissent from the Majority’s opinion affirming the rejection under 35 U.S.C. § 101.