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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARIDEE JOY MARAZ, PETER JOSEPH JUNGER,
and DUSTIN ARES

Appeal 2016-006742
Application 13/787,394¹
Technology Center 3600

Before ERIC S. FRAHM, LINZY T. McCARTNEY, and
JAMES W. DEJMEK, *Administrative Patent Judges*.

DEJMEK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal from a Final Rejection of claims 1–22 and 26–28.
Appellants have withdrawn claims 23 and 25 and canceled claim 24.
Br. 18–19. We have jurisdiction over the remaining pending claims under
35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify e2interactive, Inc. d/b/a/ e2Interactive, Inc. as the real party in interest. Br. 1.

STATEMENT OF THE CASE

Introduction

Appellants' disclosed and claimed invention is directed to "electronic registration (ER) techniques that involve linking and/or otherwise correlating location-specific unique identifiers and manufacturer-provided unique identifiers." Abstract; Spec. ¶ 2.

Claim 1 is representative of the subject matter on appeal and is reproduced below with the disputed limitation emphasized in *italics*:

1. An electronic registration (ER) system, comprising:
processing resources including at least one processor;
an ER database configured to store records for a plurality of products, including:

location-specific unique identifiers associated with the products; and manufacturer-provided unique identifiers;

wherein the location-specific unique identifiers and manufacturer-provided unique identifiers are separately applied to and/or associated with the products; and

data correlating the location-specific unique identifiers and manufacturer-provided unique identifiers; and

a look-up module that, in cooperation with the processing resources, (a) for a given location-specific unique identifier returns the correlated manufacturer-provided unique identifier, and (b) for a given manufacturer-provided unique identifier returns the correlated location-specific unique identifier.

The Examiner's Rejections

1. Claims 1–22 and 26–28 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Final Act. 3–4.

2. Claims 1–3, 5, 10, 14–16, 18, and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Junger et al. (US 2004/0172260 A1; Sept. 2, 2004) (“Junger”). Final Act. 4–6.

3. Claims 26–28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Junger et al. (US 2010/0325020 A1; Dec. 23, 2010) (“Junger II”). Final Act. 6–7.

4. Claims 4, 6–9, 11–13, 17, and 19–21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Junger and Junger II. Final Act. 7–10.

Issues on Appeal

1. Did the Examiner err in concluding Appellants’ claimed invention is directed to an abstract idea and the recited claim limitations do not provide meaningful limitations to transform the abstract idea into patent-eligible subject matter?

2. Did the Examiner err in finding Junger discloses “location-specific unique identifiers,” as recited in the claims?

ANALYSIS²

Rejection under 35 U.S.C. § 101

Appellants dispute the Examiner’s conclusion that the pending claims are directed to patent-ineligible subject matter under 35 U.S.C. § 101.

Br. 5–10. In particular, Appellants argue the claims are not directed to an

² Throughout this Decision, we have considered the Appeal Brief, filed May 13, 2015 (“Br.”); the Examiner’s Answer, mailed August 6, 2015 (“Ans.”); and the Final Office Action, mailed December 5, 2014 (“Final Act.”), from which this Appeal is taken.

abstract idea, which, according to Appellants, is an idea that is long-prevalent and fundamental. Br. 5. Appellants also contend the lack of any anticipation or obviousness rejections suggests that the claims are not a recitation of a well understood, routine, or conventional activity. Br. 5–6. Additionally, Appellants argue the claims do not attempt to preempt every application of registering and locating products. Br. 7–8. Further, Appellants argue the claims apply the inventive concept by use of a particular machine and provide an improvement to a technology and, therefore, recite “significantly more” than just the abstract idea. Br. 8–10.

For the reasons discussed below, Appellants have not persuaded us of error. The Supreme Court’s two-step framework guides our analysis. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). If a claim falls within one of the statutory categories of patent eligibility (i.e., a process, machine, manufacture or composition of matter) then the first inquiry is whether the claim is directed to one of the judicially recognized exceptions (i.e., a law of nature, a natural phenomenon, or an abstract idea). If so, the second step is to determine whether any element, or combination of elements, amounts to significantly more than the judicial exception.

Although the independent claims each broadly fall within the statutory categories of patentability, the Examiner determines the claims are directed to a judicially recognized exception—i.e., an abstract idea. Final Act. 2–5; Ans. 3. In particular, the Examiner finds the claims are “directed to the abstract idea of registration and locating [sic] of products.” Final Act. 3; *see also* Ans. 2–5.

Instead of using a definition of an abstract idea, “the 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.” *Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016)); accord United States Patent and Trademark Office, *July 2015 Update: Subject Matter Eligibility 3* (July 30, 2015), <https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf> (instructing Examiners that “a claimed concept is not identified as an abstract idea unless it is similar to at least one concept that the courts have identified as an abstract idea.”). As part of this inquiry, we must “look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs. of Texas, LLC v. DirecTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

Here, Appellants’ claims generally relate to an electronic registration (ER) system that stores data corresponding to location-specific unique identifiers and manufacturer-provided unique identifiers in a database. The ER system may receive a request for information from the database and can perform a cross-reference function (i.e., a look-up function or correlation function) wherein for a given location-specific unique identifier, the ER system returns the manufacturer-provided unique identifier associated with (i.e., correlated) the location-specific unique identifier. Similarly, for a given manufacturer-provided unique identifier, the ER system may return the location-specific unique identifier associated with the manufacturer-provided unique identifier.

Our reviewing court has concluded that abstract ideas include the concepts of collecting data, recognizing certain data within the collected data

set, and storing the data in memory. *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347 (Fed. Cir. 2014). Additionally, the collection of information and analysis of information (e.g., recognizing certain data within the dataset) are also abstract ideas. *Electric Power*, 830 F.3d at 1353. Similarly, “collecting, displaying, and manipulating data” is an abstract idea. *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017). Further, “collecting and analyzing information to detect misuse and notifying a user when misuse is detected” has also been determined to be abstract. *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1094 (Fed. Cir. 2016). Also, more recently, our reviewing court has also concluded that the use of “a marking affixed to the outside of a[n] . . . object to communicate information about the . . . object” is an abstract idea. *Secured Mail Solutions LLC v. Universal Wilde, Inc.*, No. 2016-1728, 2017 WL 4582737, at *5 (Fed. Cir. Oct. 16, 2017).

Further, merely combining several abstract ideas does not render the combination any less abstract. *RecogniCorp, LLC v. Nintendo Co., Ltd.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“Adding one abstract idea . . . to another abstract idea . . . does not render the claim non-abstract.”); *see also FairWarning IP*, 839 F.3d at 1094 (determining the pending claims were directed to a combination of abstract ideas).

Here, we agree with the Examiner (*see* Final Act. 3) that the registration and location of products using location-specific unique identifiers and manufacturer-provided unique identifiers are similar to the abstract ideas of collecting, analyzing, and manipulating data wherein the analysis and manipulation of data provides a correlation (i.e., cross-

reference) between the different identifiers. Additionally, the sending of an alert message (as in independent claim 26) is similar to the analysis of information to detect misuse as discussed in *FairWarning IP*. See *FairWarning IP*, 839 F.3d at 1094.

Because we determine the claims are directed to an abstract idea, we analyze the claims under step two to determine if there are additional limitations that individually, or as an ordered combination, ensure the claims amount to “significantly more” than the abstract idea. *Alice*, 134 S. Ct. at 2357. The implementation of the abstract idea involved must be “more than the performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction*, 776 F.3d at 1347–48.

As an initial matter, we note, contrary to Appellants’ assertion (*see* Br. 5), the Examiner also rejected the claims under 35 U.S.C. §§ 102 and 103. See Final Act. 4–10. Further, to the extent Appellants are asserting a lack of rejection under Sections 102 and/or 103, suggests the instant claims do not recite well understood, routine, or conventional activities, we are not persuaded. Subject-matter eligibility under 35 U.S.C. § 101 is a requirement separate from other patentability inquiries. See *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 90 (2012) (recognizing that the § 101 inquiry and other patentability inquiries “might sometimes overlap,” but that “shift[ing] the patent-eligibility inquiry entirely to these [other] sections risks creating significantly greater legal uncertainty, while assuming that those sections can do work that they are not equipped to do”); *Diamond v. Diehr*, 450 U.S. 175, 190 (1981) (“The question . . . of whether a particular

invention is novel is ‘wholly apart from whether the invention falls into a category of statutory subject matter.’”).

Here, we agree with the Examiner that the additional limitations, separately, or as an ordered combination, do not provide meaningful limitations (i.e., do not add significantly more) to transform the abstract idea into a patent-eligible application. Final Act. 4; Ans. 3–4. The storing of data in a database, retrieving of data from a database, receiving of requests, and sending of messages are routine and conventional functions performed by a generic computing device. *See, e.g., BuySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (“That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive.”). The relevant question is whether the claims do more than simply instruct the practitioner to implement the idea on a generic computer. *See Alice*, 134 S. Ct. at 2359. As the Examiner explains:

The elements of the instant method, when taken alone, each execute in a manner routinely and conventionally expected of these elements. The elements of the instant process, when taken in combination, together do not offer substantially more than the sum of the functions of the elements when each is taken alone. That is, the elements involved in the recited process undertake their roles in performance of their activities according to their generic functionalities which are well-understood, routine and conventional. The elements together execute in routinely and conventionally accepted coordinated manners and interact with their partner elements to achieve an overall outcome which, similarly, is merely the combined and coordinated execution of generic computer functionalities which are well-understood, routine and conventional activities previously known to the industry.

Ans. 4. Contrary to Appellants’ assertions, the claims do not provide an improvement to the functioning of a computer.

Also, “[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *FairWarning IP*, 839 F.3d at 1098 (quoting *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) (“[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.”). Further, “[w]here 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.

For the reasons discussed *supra*, we are unpersuaded of Examiner error. Accordingly we sustain the Examiner’s rejection of independent claim 1. For similar reasons, we also sustain the Examiner’s rejection of independent claims 14, 22, and 26, which recite similar limitations and were not argued separately. *See* App. Br. 5–10; *see also* 37 C.F.R. § 41.37(c)(1)(iv). Additionally, we sustain the Examiner’s rejection of claims 2–13, 15–21, 27, and 28, which depend therefrom and were not argued separately.

Rejections under 35 U.S.C. § 102(b)

Appellants argue the Examiner erred in finding Junger discloses the claimed location-specific unique identifiers. Br. 11–12. In particular, Appellants argue Junger does not disclose using a location-specific unique identifier, as claimed, but instead discloses the use of a “store reference.” Br. 11–12 (citing Junger ¶¶ 119–127, Fig. 10C). Appellants contend the

store reference is not unique and indicates a store, but “does not indicate an item.” Br. 11.

Figure 10C of Junger is illustrative and is reproduced below.

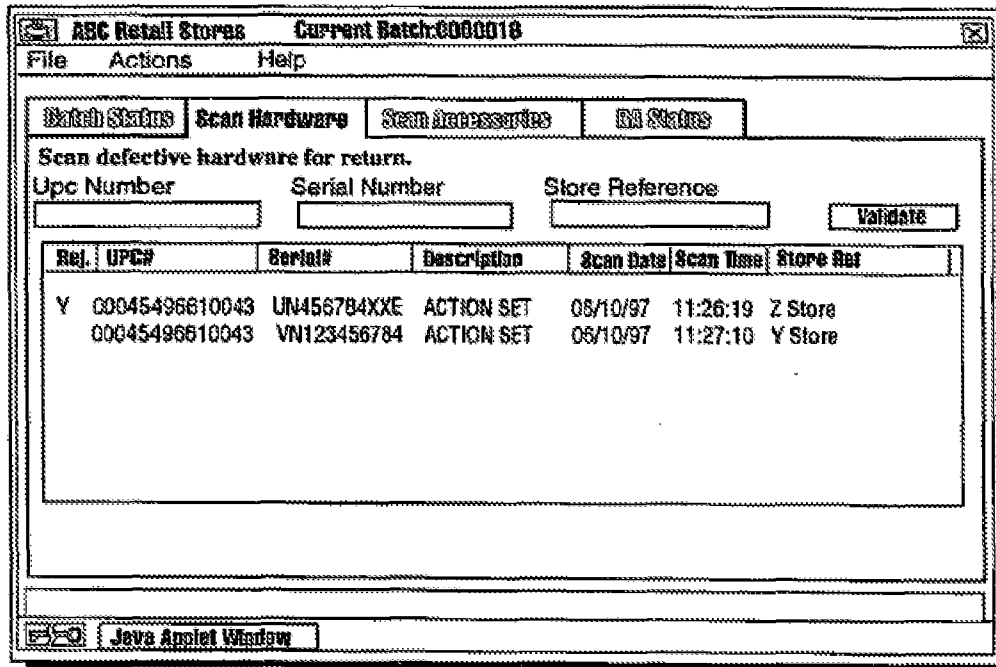


Fig. 10C

Figure 10C of Junger illustrates a user interface for screening hardware returns to ensure compliance with return criteria. Junger ¶¶ 45, 119. Junger discloses, for example, the UPC number for the product, the Serial Number, and a Store Reference Code “may be entered by scanning bar codes on the product.” Junger ¶ 119. In the example of Figure 10C, two returns (as indicated by the two lines listing UPC#, Serial#, Description, Scan Date, Scan Time, and Store Ref) have been entered. Associated with the first return, there is a Store Reference of “Z Store” whereas associated with the second item, the Store Reference is “Y Store.” See Junger, Fig. 10C.

Appellants' argument that Junger's Store Reference indicates a store and not an item (*see* Br. 11) is not persuasive of error because it is not commensurate in scope with the claim language, which requires only that the location-specific unique identifier be "associated with the products." *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (limitations not appearing in the claims cannot be relied upon for patentability). Additionally, because Junger discloses different Store References for different stores (i.e., locations), we are not persuaded that the Store References are not unique. *Compare* Spec. ¶ 167 (describing the unique identifiers applied by a particular location "sometimes" may not match the identifiers provided at other locations, or even stores within the same chain of stores).

For the reasons discussed *supra*, we are unpersuaded of Examiner error. Accordingly, we sustain the Examiner's rejection of independent claim 1 under 35 U.S.C. § 102(b). For similar reasons, we also sustain the Examiner's rejection of independent claims 14 and 22, which recite similar limitations and were not argued separately. *See* Br. 11–12. Additionally, we sustain the Examiner's rejection of claims 2, 3, 5, 10, 15, 16, and 18, which depend therefrom and were not argued separately. *See* Br. 12.

Further, Appellants do not advance any arguments in rebuttal to the Examiner's rejection of claims 26–28 under 35 U.S.C. § 102(b). Accordingly, we summarily sustain the Examiner's rejection of these claims. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Rejection under 35 U.S.C. § 103(a)

Appellants do not advance any arguments in rebuttal to the Examiner's rejection of claims 4, 6–9, 11–13, 17, and 19–21. Accordingly, we summarily sustain the Examiner's rejection of these claims. *See* 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

We affirm the Examiner's decision rejecting claims 1–22 and 26–28 under 35 U.S.C. § 101.

We affirm the Examiner's decision rejecting claims 1–3, 5, 10, 14–16, 18, and 22 under 35 U.S.C. § 102(b).

We summarily affirm the Examiner's decision rejecting claims 26–28 under 35 U.S.C. § 102(b).

We summarily affirm the Examiner's decision rejecting claims 4, 6–9, 11–13, 17, and 19–21 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED