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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DARRYL T. RATHBUN, TRYSH WAHLIG,
THERESA BIASI, and G. JONATHAN WOLFMAN

Appeal 2016-007034
Application 11/955,478¹
Technology Center 3600

Before HUBERT C. LORIN, BART A. GERSTENBLITH and
JAMES A. WORTH, Administrative Patent Judges.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Darryl T. Rathbun, et al. (Appellants) seek our review under 35 U.S.C. § 134(a) of the Final Rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

¹ The Appellants identify Pitney Bowes Inc. as the real party in interest. Br. 2.

THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A computer implemented method of facilitating the maintenance of an address list of each of a plurality of mailers, comprising;

maintaining master address information using the computer based on current address list information received from each of said mailers;

receiving, using the computer, change of address information specifying a new address for each of a plurality of movers, said change of address information being based on a change of address filed by each of said movers;

using the computer, comparing said change of address information to said master address information to determine a plurality of matching movers included in both said change of address information and said master address information;

providing each of said matching movers with a printed form including a list of at least two of said mailers that have the matching mover listed on their current address list and

for each of one or more responding matching movers:

(i) receiving a change of address notification authorization from the responding matching mover, said change of address notification authorization identifying a selected one or more of said at least two of said mailers included in the list provided to the responding matching mover, and

(ii) notifying each of the selected one or more of said at least two of said mailers of the new address of the responding matching mover.

THE REJECTION

The following rejection is before us for review:

1. Claims 1–20 are rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

ISSUE

Did the Examiner err in rejecting claims 1–20 under 35 U.S.C. §101 as being directed to non-statutory subject matter?

ANALYSIS

The Appellants argue these claims as a group. *See* Br. 3–7. We select claim 1 as the representative claim for this group, and the remaining claims 2–20 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

Alice Corp. Proprietary Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014), identifies a two-step framework for determining whether claimed subject matter is judicially excepted from patent eligibility under 35 U.S.C. § 101.

According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

In that regard, the Examiner determined that “[c]laims 1-20 are directed to the abstract idea in that the crux of the claims are directed towards “A computer implemented method of facilitating the maintenance of an address list of each of a plurality of mailers,” Final Rej. 2.

The Appellants dispute the Examiner’s determination.

The Appellants begin by arguing that

[i]t is submitted that the rejected claims are not directed to this, or any other, abstract idea. Rather, those claims are directed to very particular technique that provides a practical application to a real world problem. The claimed technique *involves* an abstract idea, but does not *claim* it.

Br. 3.

However, the Examiner did not make a determination of what is “claimed,” but rather – consistent with *Alice* step one – what the claim is *directed to*.

The Appellants next argue that “the Examiner has exclusively (and improperly) focused on the preamble portion of the claims, and ignored the steps recited in the claims.” *Id.*

First, it was not improper for the Examiner to center the determination on the claim’s preamble.

[W]e see no error here in the district court citing to the preamble in its review of whether the claims are directed to an abstract idea. *See, e.g., BASCOM [Global Internet Servs., Inc. v. AT&T Mobility LLC, 827 F.3d 1341, 1348 (Fed. Cir. 2016)]* (citing preamble for distillation of abstract idea). The district court’s inquiry centered on determining the “focus” of the claims, and was thus in accord with our precedent. *E.g., [Elec. Power Grp., LLC v. Alstom S.A., 830 F.3d 1350, 1353 (Fed. Cir. 2016)]*.

Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC, 874 F.3d 1329, 1340 (Fed. Cir. 2017).

And, second, the Examiner did not ignore the steps recited in the claim. They were analyzed in the context of the *Alice* step 2 determination (Final Rej. 6), a point the Appellants concede (Br. 4–5). It should be noted

that, in responding to the Appellants, a fuller analysis of the claim as a whole is provided in the Answer. Ans. 2–5.

The Appellants next argue that the claim’s preamble should not have been given the weight the Examiner gave it in characterizing what the claim is directed to. “[I]t is contrary to normal claim interpretation to look solely at the preamble for purposes of § 101 analysis The Examiner has characterized the invention unreasonably for purposes of what the invention is ‘directed to.’” Br. 4.

We have already indicated that it was not improper for the Examiner to center the step one determination on the claim’s preamble.

As far as the suggestion that a claim construction analysis should have preceded a characterizing of what the claim is directed to, “claim construction is not an inviolable prerequisite to a validity determination under § 101.” *Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266, 1273 (Fed. Cir. 2012).

“[H]owever, . . . it will ordinarily be desirable—and often necessary—to resolve claim construction disputes prior to a § 101 analysis, for the determination of patent eligibility requires a full understanding of the basic character of the claimed subject matter.” *Id.* at 1273–74.

In that regard, the method of claim 1 uses two types of information: (a) addresses on a master mailers’ address list and (b) a mover’s change of address. According to the method of claim 1, the two types of information are “maintain[ed]” and “receiv[ed], respectively, and then information (b) is compared to information (a) “to determine a plurality of matching movers included in both” information (b) and (a). Then, according to claim 1, each matching mover is provided “with a printed form including a list of at least

two [mailers] that have the matching mover listed on their current address list.” Once a change of address notification authorization identifying a selected mailer from the list on the printed form is received from a responding matching mover, the mailer is notified of the responding matching mover’s change of address.

Accordingly, generally speaking, claim 1 is directed to the combination of information gathering, comparing information, communicating via a printed form, and notifying, albeit involving specific types of information.

The Examiner’s characterization, of what claim 1 is directed to, is not inaccurate.

The “directed to” inquiry of the *Alice* step one determination applies a stage-one filter to claims, considered in light of the specification, based on whether “their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015); *see Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1375–76 (Fed. Cir. 2016) (inquiring into “the focus of the claimed advance over the prior art”). “The ‘abstract idea’ step of the inquiry calls upon us to 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 Tex. v. DirecTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp.*, 830 F.3d at 1353); *see also Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016), *quoted in Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1241 (Fed. Cir. 2016).

In this case, claim 1 as a whole is focused on “[a] computer implemented method of facilitating the maintenance of an address list of

each of a plurality of mailers,” as stated in the preamble, notwithstanding the recited steps call for information gathering, comparing information, communicating via a printed form, and notifying. *Cf. In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016) (the claims’ focus “was not on an improved telephone unit or an improved server”).

Furthermore, the Background section of the Specification discusses the problem as “there [being] a need for one or more methods for updating the address lists of mailers to stay current in light of customer moves and/or for simplifying and facilitating the process by which a mover changes an address or other contact information with one or more mailers.” Spec. ¶ 5. According to the Specification, the inventors solved the problem by “provid[ing] a method of facilitating the maintenance of an address list of each of a plurality of mailers.” *See id.* ¶ 6. In light of Specification’s description of the problem and solution, the advance over the prior art by the claimed invention is in a scheme to facilitate the maintenance of an address list of each of a plurality of mailers. This is the heart of the invention. *Cf. Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1328 (Fed. Cir. 2017) (“the heart of the claimed invention lies in creating and using an index to search for and retrieve data . . . an abstract concept”).

Given the focus of the claims as a whole is a scheme to facilitate the maintenance of an address list of each of a plurality of mailers and, in light of the Specification, the heart of the invention is “[a] computer implemented method of facilitating the maintenance of an address list of each of a plurality of mailers,” as the preamble of the claim states, the Examiner properly characterized claim 1 as being “directed to” “[a] computer

implemented method of facilitating the maintenance of an address list of each of a plurality of mailers.” Final Rej. 2.

Though the Examiner’s characterization, of the concept claim 1 is directed to, is somewhat different from the more generalized one we articulated above, it is simply a matter of having described it at a lower level of abstraction. *Cf. Apple*, 842 at 1240–41 (“An abstract idea can generally be described at different levels of abstraction. As the Board has done, the claimed abstract idea could be described as generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location. It could be described in other ways, including, as indicated in the specification, taking orders from restaurant customers on a computer.”).

We now turn to the question of whether the concept to which the claims are “directed to” is a patent-ineligible abstract idea. *Enfish*, 822 F.3d at 1335.

We stated above that, generally speaking, claim 1 is directed to information gathering, comparing information, communicating via a printed form, and notifying, albeit involving specific types of information. When “the focus of the asserted claims” is “on collecting information, analyzing it, and displaying certain results of the collection and analysis,” the claims are directed to an abstract idea. *Elec. Power Grp.*, 830 F.3d at 1353.

“[C]omparing one thing to another” is an abstract idea. *See Blue Spike, LLC v. Google Inc.*, No. 14-CV-01650-YGR, 2015 WL 5260506, at *5–*6 (N.D. Cal. Sept. 8, 2015), *aff’d*, No. 2016-1054, 2016 WL 5956746 (mem) (Fed. Cir. Oct. 14, 2016). Merely combining these abstract ideas (information gathering, comparing information, communicating via a printed form, and

notifying) does not render the combination any less abstract. *Cf. Shortridge v. Found. Constr. Payroll Serv., LLC*, No. 14-CV-04850-JCS, 2015 WL 1739256 (N.D. Cal. Apr. 14, 2015), *aff'd*, No. 2015-1898, 2016 WL 3742816 (Fed. Cir. July 13, 2016).

As for the Examiner's characterizing claim 1 as being directed to a "computer implemented method of facilitating the maintenance of an address list of each of a plurality of mailers," such a concept is no less abstract. This is so because it is similar to concepts courts have already determined to be abstract ideas. *See, e.g., Return Mail, Inc. v. U.S. Postal Serv.*, 868 F.3d 1350, 1368 (Fed. Cir. 2017) ("relaying mailing address data" is an abstract idea).

The Appellants argue that the Examiner needed to rely upon evidence to support the finding that the concept, to which claim 1 is directed, is an abstract idea. Br. 4 ("It should not be permitted that an overbroad 'abstract idea' assertion be used as an easy and evidence-free way of disallowing patents, without having to consider the merits of the recited invention."). But "both . . . [the Federal Circuit] and the Supreme Court have found it sufficient to compare claims at issue to those claims already found to be directed to an abstract idea in previous cases." *Enfish*, 822 F.3d at 1334. We cited such a previous case above.

The Appellants also suggest that the fact that the claims have not been rejected under prior art grounds constitutes a factor in favor of a determination that claim 1 is not directed to an abstract idea. *See* Br. 4 (referring to the Board's prior decision (2012-003813) reversing a rejection under 35 U.S.C. § 102(b) of the claims on appeal).

Claim limitations found to be novel and/or nonobvious can affect a patent-eligibility determination. *Cf. Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371 (Fed. Cir. 2015) (“For process claims that encompass natural phenomenon, the process steps are the additional features that must be new and useful.”). But “novelty in implementation of the idea is a factor to be considered only in the second step of the *Alice* analysis.”

Ultramercial, Inc. v. Hulu, LLC, 772 F.3d 709, 715 (Fed. Cir. 2014).

“[N]ovelty is a factor to be considered” when determining “whether the claims contain an ‘inventive concept’ to ‘transform’ the claimed abstract idea into patent-eligible subject matter.” *Id.* Here the question is whether claim 1 is directed to an abstract idea. “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). “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2117 (2013).

We now turn to the step two determination.

Step two is “a 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.’” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 73 (2012)).

In that regard, the Examiner determined that

[h]ere, the recitations of “maintaining”, “receiving”, “using”, “providing”, and “notifying” amounts to little more than reciting that a generic computer system (see, for examples,

applicant's specification at page 6, lines 7 and 8) applies the abstract idea using such tools to do so. The Claims can then be analyzed under the second part of the analysis and the claims require no more than a generic computer to perform generic computer functions. Further, as a/the computer only automates the abstract idea, the abstract idea is ineligible because the claim can also be performed without any apparatus, and even if it requires computer implementation, nothing more than a generic computer is required to perform this claim, which is insufficient to render the claim statutory. Having considered the claims as a whole, no element or combination of elements in the claims are sufficient to ensure that the claims amount to significantly more than the abstract idea itself. Indeed, the claims fail to recite any improvements to another technology or technical field, improvements to the functioning of the computer itself, and/or meaningful limitations beyond generally linking the use of an abstract idea to a particular environment.

Final Rej. 6–7.

The Appellants argue that

In this case, the novel (as determined by the PTAB) invention of the present application involves a computerized service that stores address list information for multiple mailers. When a mover from one of the address lists is detected, the mover is proactively contacted with the names mailers for whom they may wish to update their address. The mover then authorizes which mailers can receive the address update information. Upon authorization, the mailer is then provided with the address update.

Br. 5.

This not a persuasive argument. Claim 1 makes no mention of storing information. Nevertheless, “storing” information per se is itself an abstract idea. *See In re TLI Commc’ns*, 823 F.3d at 611 (“the abstract idea of classifying and storing digital images in an organized manner”). Adding an abstract idea is insufficient to ensure that the claimed subject matter in

practice amounts to significantly more than to be upon an abstract idea itself. “Contacting,” “authorizing,” and “providing” an address update are similarly abstract.

The Appellants also argue that the claimed process does not have a risk of tying up excepted subject matter and preempting others from using the abstract idea. Br. 5.

The difficulty with this argument is that it confuses preemption with the level of abstraction describing the abstract idea. With respect to preemption, “[w]hat matters is whether a claim threatens to subsume the full scope of a fundamental concept, and when those concerns arise, we must look for meaningful limitations that prevent the claim as a whole from covering the concept’s every practical application.” *CLS Bank Int’l v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269, 1281 (Fed. Cir. 2013) (Lourie, J., concurring). Here, the argued-over limitations (e.g., “authorizing”) simply narrow the abstract idea so that it is described at a lower level of abstraction. It does not lessen the abstract character of the idea to which the claim is directed. Preemption is not a separate test.

To be clear, the proper focus is not preemption per se, for some measure of preemption is intrinsic in the statutory right granted with every patent to exclude competitors, for a limited time, from practicing the claimed invention. *See* 35 U.S.C. § 154. Rather, the animating concern is that claims should not be coextensive with a natural law, natural phenomenon, or abstract idea; a patent-eligible claim must include one or more substantive limitations that, in the words of the Supreme Court, add “significantly more” to the basic principle, with the result that the claim covers significantly less. *See Mayo*, 132 S. Ct. at 1294. Thus, broad claims do not necessarily raise § 101

preemption concerns, and seemingly narrower claims are not necessarily exempt.

Id.; see also *Ariosa Diagnostics*, 788 F.3d at 1379 (“While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”). “Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, . . . preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics*, 788 F.3d at 1379. Therefore, our finding that the claims cover patent-ineligible subject matter necessarily addresses preemption.

We have considered all of the Appellants’ remaining arguments and have found them unpersuasive. Accordingly, because representative claim 1, and claims 2–20 which stand or fall with claim 1, are directed to an abstract idea and do not present an “inventive concept,” we sustain the Examiner’s determination that they are directed to ineligible subject matter under 35 U.S.C. § 101.

DECISION

The decision of the Examiner to reject claims 1–20 is 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).

AFFIRMED