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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN A. OLSEN III, DAVID L. BRADLEY,
and RHESA M. JENKINS

Appeal 2016-007258
Application 10/842,907
Technology Center 3600

Before ERIC S. FRAHM, KRISTEN L. DROESCH, and
CATHERINE SHIANG, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–3, 5–11, 61–63, and 65–70, which are all the claims pending and rejected in the application. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Introduction

According to the Specification, the present invention relates to shipping and delivering items. *See generally* Spec. 1. Claim 1 is exemplary:

1. A system for determining whether a customer has one or more items to be picked up at a customer location comprising:
 - a service provider computing device comprising one or more memory storage areas, one or more processors, and one or more databases storing a plurality of location identifiers, wherein (1) each location identifier (a) identifies a customer location and (b) is associated with one or more network addresses that correspond respectively to one or more customer computing devices at the customer location, (2) each of the respective customer computing devices (a) comprises one or more memory storage areas and one or more processors and (b) is associated with a network address for external communications, and (3) the service provider computing device and the respective customer computing devices are in communication with one or more communications networks operating in accordance with one or more communications protocols for communicating between the service provider computing device and the respective customer computing devices,
 - wherein the service provider computing device is configured to:
 - (a) receive input from a user selecting a location identifier from the plurality of location identifiers,
 - (b) after receiving input selecting the location identifier, determine whether the strength of a communications signal from the customer computing device associated with the selected location identifier meets or exceeds a predetermined value,
 - (c) after determining the strength of the communications signal from the customer computing device associated with the selected location identifier meets or exceeds the predetermined value, establish electronic communication with the customer computing device associated with the selected location identifier

using the network addresses associated with the location identifier, and

(d) after establishing electronic communication with the customer computing device, receive data from the customer computing device (i) indicating that a customer has an item to be picked up, for shipment by a service provider, at the customer location, the data further indicating a location in which the item is to be shipped and a designated class, among a plurality of classes, identifying a priority of the shipment of the item, and (ii) comprising information about the item to be picked up from the customer location.

References and Rejections

Claims 1–3, 5–11, 61–63, and 65–70 are rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

Claims 1–3, 5–11, 61–63, and 65–70 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beard (US 6,124,800; issued Sept. 26, 2000), Jeong (US 5,912,628; issued June 15, 1999), French (US 2003/0041238 A1; published Feb. 27, 2003), and Bennett (US 7,458,612 B1; issued Dec. 2, 2005)

ANALYSIS

35 U.S.C. § 101

We disagree with Appellants’ arguments, and agree with and adopt the Examiner’s findings and conclusions in (i) the action from which this

appeal is taken and (ii) the Answer to the extent they are consistent with our analysis below.¹

The Examiner rejects the claims under 35 U.S.C. § 101 because they are directed to patent-ineligible subject matter. *See* Non-Final Act. 2–3; Ans. 3–9. In particular, the Examiner finds the claims are directed to the abstract idea of collecting, transferring, and comparing information. *See* Ans. 3–8. The Examiner further finds the claims use generic computer components to perform generic computer functions. *See* Ans. 3–9. Appellants argue the Examiner erred. *See* App. Br. 6–21; Reply Br. 2–16.

Appellants have not persuaded us of error. Section 101 of the Patent Act provides “[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. That provision “contains an important implicit exception: Laws 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). According to the Supreme Court:

[W]e set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . If so, we then ask, “[w]hat else is there in the claims before us?” . . . To answer that question, we consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the

¹ To the extent Appellants advance new arguments in the Reply Brief without showing good cause, Appellants have waived such arguments. *See* 37 C.F.R. § 41.41(b)(2).

claim” into a patent-eligible application. . . . We have described step two of this analysis as 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 Corp., 134 S. Ct. at 2355.

The Federal Circuit has described the Alice step-one inquiry as looking at the “focus” of the claims, their “character as a whole,” and the Alice step-two inquiry as looking more precisely at what the claim elements add—whether they identify an “inventive concept” in the application of the ineligible matter to which the claim is directed. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

Regarding Alice step one, the Federal Circuit has “treated *collecting information*, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.” *Elec. Power*, 830 F.3d at 1353 (emphasis added); *see also Internet Patents*, 790 F.3d at 1348–49 (Fed. Cir. 2015); *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015); *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014). “In a similar vein, we have treated *analyzing information* by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Elec. Power*, 830 F.3d at 1354 (emphasis added); *see also In re TLI Commc’ns. LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016). “And we have recognized that *merely presenting the results of abstract processes of*

collecting and analyzing information, without more (such as identifying a particular tool for presentation), is abstract as an ancillary part of such collection and analysis.” *Elec. Power*, 830 F.3d at 1354 (emphasis added); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714–15 (Fed. Cir. 2014).

The rejected claims “fall into a familiar class of claims ‘directed to’ a patent-ineligible concept.” *Elec. Power*, 830 F.3d at 1353. Contrary to Appellants’ arguments (App. Br. 6–12; Reply Br. 2–10), the claims are similar to the claims of *Electric Power*, and are focused on the combination of abstract-idea processes or functions. *See Elec. Power*, 830 F.3d at 1354. For example, claim 1 is directed to receiving or collecting information (“storing a plurality of location identifiers . . . receive input from a user . . . receive data from the customer computing device”), and analyzing information (“determine whether the strength of a communication signal”). Similarly, claim 61 is directed to receiving or collecting information (“receiving input from a user . . . receiving data from the customer computing device”), analyzing information (“determining whether the strength of a communication signal”), and displaying information (“causing display”). *See Elec. Power*, 830 F.3d at 1353. Dependent claims are directed to similar functions or processes, and Appellants have not shown such claims are directed to other non-abstract functions or processes. *See* claims 2, 3, 5–11, 62, 63, and 65–70.

Regarding the “efficient techniques” argued by Appellants (App. Br. 18–19; Reply Br. 9, 14),² our reviewing court has declared:

² Appellants also advance arguments that are not commensurate with the scope of the claims. *See, e.g.*, App. Br. 16–17; Reply Br. 8–9, 14–15. For

While the claimed system and method certainly *purport to accelerate the process of analyzing audit log data, the speed increase comes from the capabilities of a general-purpose computer, rather than the patented method itself*. See *Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (“[T]he fact that the required calculations could be performed *more efficiently* via a computer does not materially alter the patent eligibility of the claimed subject matter.”).

FairWarning IP, LLC v. Iatric Sys., Inc., 839 F.3d 1089, 1095 (Fed. Cir. 2016) (emphases added).

Applying this reasoning to the rejected claims, we similarly find any purported “efficient techniques” come from the capabilities of general-purpose computers (the recited “service provider computing device” and “customer computing device”), rather than the claimed steps or functions.³ Similar to the claims of *FairWarning*, the rejected claims “are not directed to an improvement in the way computers operate” and “the focus of the claims is not on . . . an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools.” *FairWarning*, 839 F.3d at 1095.

Further, Appellants’ assertion regarding pre-emption (App. Br. 20) is unpersuasive, because “[w]hile preemption may signal patent ineligible

example, Appellants assert the claims “*minimizes processing capacity* of communication devices and *conserves memory space* of communication devices” (Reply Br. 14–15), but have not shown the claims require such minimization or conservation. In any event, Appellants’ unsupported assertion is unpersuasive, as discussed below in connection with *FairWarning*.

³ Appellants argue *for example*, the recited “service provider computing device” is a Delivery Information Acquisition Device (DIAD). App. Br. 17. That *example* does not limit the term “service provider computing device” to a DIAD.

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, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP*, 788 F.3d at 1362–63 (“that 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”).

Regarding Alice step two, contrary to Appellants’ assertion (App. Br. 12–21; Reply Br. 10–16), Appellants have not shown the claims in this case require an arguably inventive set of components or methods, or invoke any assertedly inventive programming. *See Elec. Power*, 830 F.3d at 1355.

Further, contrary to Appellants’ arguments (App. Br. 12–21; Reply Br. 10–16), the claims are similar to the claims of *Electric Power*, because they do not require any nonconventional computer, network, or display components, or even a “non-conventional and non-generic arrangement of known, conventional pieces,” but merely call for performance of the claimed information collection, analysis, and display functions on generic computer components and display devices. *See Elec. Power*, 830 F.3d at 1355; *see also* Claim 1 (reciting “a service provider computing device . . . storing a plurality of location identifiers, . . . respective customer computing devices . . . wherein the service provider computing device is configured to: . . . receive input . . . determine whether the strength of a communications signal from the customer computing device associated with the selected location identifier meets or exceeds a predetermined value . . . receive data from the customer computing device”); Claim 61 (reciting “causing display, via a

service provider computing device, of a plurality of location identifiers . . . receiving data from the *customer computing device*.”) (emphases added). Dependent claims call for similar generic components and devices, and Appellants have not shown such claims require any non-conventional components or devices. *See* claims 2, 3, 5–11, 62, 63, and 65–70.

In short, Appellants have not shown the claims, read in light of the Specification, require anything other than conventional computer, network, and display technology for collecting, analyzing, and presenting the desired information. *See Elec. Power*, 830 F.3d at 1354. 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. *See Elec. Power*, 830 F.3d at 1355.

Because Appellants have not persuaded us the Examiner erred, we sustain the Examiner’s rejection of claims 1–3, 5–11, 61–63 and 65–70.

35 U.S.C. § 103

We have reviewed the Examiner’s rejection in light of Appellants’ contentions and the evidence of record. We concur with Appellants’ contention that the Examiner erred in finding the cited prior art portions teach “wherein the service provider computing device is configured to: (a) *receive input from a user selecting a location identifier from the plurality of*

location identifiers,” as recited in independent claim 1 (emphasis added).⁴
See App. Br. 26–28; Reply Br. 18–19.

The Examiner cites Beard and finds:

receiving input from a user selecting a location identifier from the plurality of location identifiers (i.e. via at least Figure 1 with accompanying description and/or Reference numerals 104 and 106 with corresponding detailed description and/or Abstract for the proposition that the end location and provider are communicating)[.]

Non-Final Act. 4.

We agree with Appellants that the Examiner has not shown the cited prior art portions teach the disputed limitation. *See* App. Br. 26–28. As pointed out by Appellants, Beard teaches “a route delivery vehicle **102** is utilized to transport goods and or services and related equipment to a remote product or service end point location **104**. . . . The end point location **104** utilizes a notifier communication unit **106** to collect, process and store product information data.” *See* App. Br. 27; Beard 2:59–3:2. The Examiner cites Beard’s reference numerals 104 and 106 (Non-Final Act. 4) for the mapping, but does not explain how Beard’s remote product or service end point location 104 and its associated notifier communication unit 106 teach the disputed limitation.

In response to Appellants’ arguments, the Examiner does not clarify the mapping. *See* Ans. 13. Instead, the Examiner incorrectly asserts “Appellants remarks on Bennett are not relevant.” Ans. 13.

⁴ Appellants raise additional arguments. Because the identified issue is dispositive of the appeal, we do not reach the additional arguments.

As discussed above, Appellants' arguments focus on Beard, which the Examiner cites for the disputed limitation—not Bennett. The Examiner also responds “French was used to teach the elements related to geographic resources and location.” Ans. 13. The Examiner's finding about French—even if it is correct—does not explain how under the Examiner's mapping, the cited references teach “wherein the service provider computing device is configured to: (a) receive input from a user selecting a location identifier from the plurality of location identifiers,” as required by the claim.

Further, as applied by the Examiner, the teachings of Jeong and Bennett do not remedy the deficiencies discussed above. *See* Non-Final Act. 5–7.

Because the Examiner fails to provide sufficient evidence or explanation to support the rejection, we are constrained by the record to reverse the Examiner's rejection of claim 1.

Independent claim 61 recites a claim limitation that is substantively similar to the disputed limitation of claim 1. *See* claim 61. Therefore, for similar reasons, we reverse the Examiner's rejection of independent claim 61.

We also reverse the Examiner's rejection of corresponding dependent claims 2, 3, 5–11, 62, 63, and 65–70.

DECISION

We affirm the Examiner's decision rejecting claims 1–3, 5–11, 61–63, and 65–70.

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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