



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
**United States Patent and Trademark Office**  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/489,341	06/05/2012	Joe M. Alegre	20039.0001US01	2473
44306	7590	09/22/2017	EXAMINER	
WITHERS & KEYS, LLC P. O. BOX 71355 MARIETTA, GA 30007-1355			SEIBERT, CHRISTOPHER B	
			ART UNIT	PAPER NUMBER
			3625	
			MAIL DATE	DELIVERY MODE
			09/22/2017	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* JOE M. ALEGRE and TIMOTHY A. KELLY

---

Appeal 2016-008004  
Application 13/489,341  
Technology Center 3600

---

Before HUNG H. BUI, BETH Z. SHAW, and  
AARON W. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellants<sup>1</sup> appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 11–19 and 30, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

## THE INVENTION

The application is directed to “systems that provide information related to an item that is for sale” and, “[m]ore particularly, . . . to methods and systems that provide information in relation to a potential buyer being in physical proximity to the item for sale.” (Spec. ¶ 1.) Claim 11, reproduced below, exemplifies the subject matter on appeal:

11. A method of providing information related to an item that is for sale, comprising:

receiving electronic submissions of access information, the access information being indicative of a sender of the electronic submission being in physical proximity to the item;

maintaining an electronic registry of electronic addresses related to the electronic submissions of the access information that are received, and in response to receiving the electronic submissions, associating the electronic addresses to the item within the electronic registry;

in further response to receiving the electronic submissions of access information, transforming the sales information from an electronic sales database that associates the sales information to the item to a first electronic message that is addressed to the electronic addresses associated with the item within the registry;

outputting the first electronic message over a computer network to the electronic addresses; and

---

<sup>1</sup> Appellants identify Zipflip, LLC as the real party in interest. (App. Br. 3.)

upon electronically detecting an update to the sales information associated with the item within the sales database, transforming the update of the sales information within the electronic sales database to a second electronic message addressed to the electronic messages associated with the item within the registry; and

outputting the second electronic message containing the updated sales information over the computer network to the electronic addresses of the registry.

### THE REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Robertson	US 6,609,106 B1	Aug. 19, 2003
Rydbeck	US 6,922,567 B1	July 26, 2005
Liu	US 2007/0208879 A1	Sept. 6, 2007
Jagemann et al.	US 2011/0264460 A1	Oct. 27, 2011
Castro et al.	US 2012/0232995 A1	Sept. 13, 2012

### THE REJECTIONS

1. Claims 11–19 and 30 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

(*See* Final Act. 2–3.)

2. Claims 11–19 and 30 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor regards as the invention. (*See* Final Act. 3.)

3. Claims 11–19 and 30 stand rejected under 35 U.S.C. § 101 “because the claimed invention is directed to a judicial exception (i.e., a law

of nature, a natural phenomenon, or an abstract idea) without significantly more.” (See Final Act. 4–5.)

4. Claims 11, 12, 14, and 17–19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Castro and Jagemann. (See Final Act. 5–7.)

5. Claim 13 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Castro, Jagemann, and Liu. (See Final Act. 8.)

6. Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Castro, Jagemann, and Rydbeck. (See Final Act. 9–10.)

7. Claim 30 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Castro, Jagemann, and Robertson. (See Final Act. 10–11.)

## ANALYSIS

### *Written Description*

The Examiner finds “[c]laim 11 recites the amended limitations ‘transforming the sales information from an electronic sales database’ and ‘transforming the update of the sales information,’” but “[t]here is no support for these amended limitations in the specification,” because “[t]he specification describes placing the data into electronic messages and transmitting the data (ex. pp. 8-10) but does not describe ‘transforming’ the data or how the ‘transforming’ step is performed.” (Final Act. 2–3.)

Appellants contend pages 8–10 of the Specification support the claim recitations of transforming sales information from a sales database to an electronic message because they describe that “[d]ata stored in a database is . . . transformed into an electronic message that one of ordinary skill in the art knows has a particular format, such as a SMS text message or an email, including having header information used in delivering the electronic

message” and that “one of ordinary skill in the art knows exactly what is meant by transforming sales information from a sales database to an electronic message.” (App. Br. 4–5.)

“Whether a patent claim satisfies the written description requirement of 35 U.S.C. § 112, paragraph 1 depends on whether the description ‘clearly allow[s] persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.’” *Inphi Corp. v. Netlist, Inc.*, 805 F.3d 1350, 1355 (Fed. Cir. 2015) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562–63 (Fed. Cir. 1991)). Here, we agree with Appellants that the description is sufficient to clearly allow one of skill in the art “to recognize that the inventor invented what is claimed.” For example, paragraph 29 describes that “[t]he computer server 101 receives the electronic submission and then performs a look-up of the access information to find the associated item listing and return the sales information of the item listing to the device 142 of the potential buyer at a return action 210.” The paragraph further explains that “[t]he sales information that is returned may differ depending upon the form of electronic submission that has been received” and “[f]or instance, if a text message has been received, then a return text message may include only text or additionally a limited amount of multi-media information.” Because we agree with Appellants that, in view of this disclosure, one of ordinary skill in the art would understand that “transforming” refers to the described activity of taking data from a sales database and putting it into an electronic message, we do not sustain the rejection under 35 U.S.C. § 112, first paragraph.

*Indefiniteness*

The Examiner finds claim 11 indefinite because “[t]he term ‘transforming’ . . . is used by the claim to mean ‘transmitting,’ while the accepted meaning is make a thorough or dramatic change in the form, appearance, or character of an item.” (Final Act. 3.) The Examiner concludes that “[t]he term is indefinite because the specification does not clearly redefine the term.” (*Id.*) Because, as explained above, we do not agree that ‘transforming’ is used by the claim to mean ‘transmitting,’ we do not sustain the rejection under 35 U.S.C. § 112, second paragraph.

*Patent Eligibility*

The Examiner finds “[t]he claims are directed to providing item information which is considered to be an abstract idea inasmuch as such activity is considered both a fundamental economic practice and a method of organizing human activity.” (Final Act. 4.) The Examiner further finds “[t]he elements of the instant process, when taken alone, each execute in a manner routinely and conventionally expected of these elements” and “when taken in combination, together do not offer substantially more than the sum of the functions of the elements when each is taken alone.” (*Id.* at 4.) The Examiner concludes there are no “meaningful limitation(s) to transform the abstract idea into a patent eligible application . . . such that the claim(s) amounts to significantly more than the abstract idea itself” and that, as such, the claims are directed to non-statutory subject matter. (*Id.* at 5.)

Appellants contest the Section 101 rejection with five arguments that the claims are not directed an abstract idea (C.1.a–e, App. Br. 5–7), three arguments intended to show that the claims provide “provide significantly more” than the abstract idea (C.2.a–c, App. Br. 7–9), and one procedural

argument (C.3, App. Br. 8). We address these contentions in the order presented, referenced by their headings in lieu of page citations.

**[C.1.a.]** The argument that “[t]he claims are not ‘directed to’ an abstract idea” because they “include several elements that involve technical actions including receiving electronic submissions, performing database tasks including associating electronic addresses to items, outputting electronic messages, and transforming information from a database to an electronic message” is not persuasive because these various steps are all simply the manipulation of data, which, without more, is not eligible subject matter. *See, e.g., Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (claims directed to collection, manipulation, and display of data); *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015) (customizing information and presenting it to users based on particular characteristics); *Content Extraction and Transmission LLC v. Wells Fargo Bank, National Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (“collecting data, . . . recognizing certain data within the collected data set, and . . . storing that recognized data in a memory”).

**[C.1.b.]** The argument that “[t]he supposed idea of the claim is not a long-prevalent and fundamental economic practice” because “the claims are not about completing a sales transaction” but instead “are about providing information about an item that is for sale” is unpersuasive because “providing information about an item that is for sale” is, in fact, a fundamental economic practice, as virtually everyone who has ever purchased anything (be it land, or car, or a meal) would have done so only after having been provided with at least some information about it.

[C.1.c.] We do not agree that the claims are not directed to an abstract idea because “[t]here is a transformation that is occurring.” As explained above, manipulation of data alone is an abstract idea.

[C.1.d.] The argument that “[t]he claim is not so broad as to tie up an entire category of subject matter or preempt others from using the alleged abstract idea” is insufficient to show error because although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). Moreover, where, as here, “a patent’s claims are deemed only to disclose patent ineligible subject matter under the [*Alice/Mayo*] framework . . . , preemption concerns are fully addressed and made moot.” *Id.*

[C.1.e.] The argument that “[t]here has been no evidence to show that the collection of specific tasks set forth in the claim amount to merely an abstract idea” is also insufficient to show error because there is no requirement that examiners must provide evidentiary support in every case before a conclusion can be made that a claim is directed to an abstract idea. *See, e.g., USPTO July 2015 Update: Subject Matter Eligibility*,<sup>2</sup> p. 6 (explaining that “courts do not rely on evidence that a claimed concept is a judicial exception, and in most cases resolve the ultimate legal conclusion on eligibility without making any factual findings”). While evidence may be helpful in certain situations where, for instance, specific facts are in dispute, it is not always necessary. It is not necessary in this case, particularly given

---

<sup>2</sup> Presently available at <https://www.uspto.gov/patent/laws-and-regulations/examination-policy/subject-matter-eligibility>.

that Appellants readily admit their claims “are about providing information about an item that is for sale.” Appellants also do not identify any facts, or types of facts, that would tend to show that these claims are not abstract.

**[C.2.a.]** We do not agree that “controlling access to the updates to the sales information for the item that is for sale based on the submission that proves proximity being used to generate the registry of potential buyers for the item” is an inventive concept that makes the claim eligible. The concept of providing information about a product to someone who is or was physically near the product is still just an abstract idea.

**[C.2.b.]** We also do not agree that the “claim goes beyond merely reciting the abstract idea with an instruction to just apply it” because it “provide[s] the very specific actions to be taken in the electronic system.” Separately reciting the individual steps required to implement an abstract idea on a conventional computer does not make the abstract idea patent eligible. *See, e.g., Intellectual Ventures I*, 792 F.3d at 1370 (“[M]erely adding computer functionality to increase the speed or efficiency of the process does not confer patent eligibility on an otherwise abstract idea.”).

**[C.2.c.]** Lastly regarding the inventive step inquiry, Appellants assert that “[t]he claims include meaningful recitations that must be considered together, not just individually” and that “[o]ne must consider there is the submission with the access information that proves proximity to the item, together with the building of the registry from received submission, and then the sending of updated sales information based on the electronic addresses in that registry.” This again, however, is just a recast expression of the abstract idea of providing information about a product to an individual who is or was

near the product. Appellants do not persuade us that the ordered combination is anything “significantly more” than the abstract idea itself.

[C.3] Appellants additionally argue that “the rejection does not specifically address each claim in detail,” which, it is claimed, “is not a permissible manner of rejecting claims under 35 USC 101.” Appellants refer to claims 15 and 30, relating to a predefined proximity and update notification triggers, respectively, each of which is alleged to be a “technical task that provides further inventive concepts.” We are not persuaded. The USPTO carries its procedural burden when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (brackets in original, quoting 35 U.S.C. § 132). Here, the Examiner notified Appellant that the claims are directed to an ineligible abstract idea, specifically, to the idea of “providing item information,” where no additional claim elements “provide meaningful limitation(s) to transform the abstract idea into a patent eligible application of the abstract idea.” (Final Act. 4–5.) Thus, Appellant has been notified of the reasons for the rejection with such information “as may be useful in judging of the propriety of continuing the prosecution of [the] application,” which is all that is required from a procedural perspective. Appellants’ paraphrasing of claims 15 and 30 is insufficient to persuade us that the Examiners’ findings and conclusions should be disturbed as to those claims.

Because Appellants’ arguments are insufficient to show Examiner error, we sustain the rejection of claims 11–19 and 30 under Section 101.

*Obviousness*

Casto teaches a smartphone based system through which a user may request information about a particular vehicle. For example, one may use a smartphone to read a VIN number from a vehicle to receive an offer, a quote, or other information. (*See, e.g.*, Casto, Figure 5.) Jagemann describes a secure wedding registry-type system allowing a patient or others to purchase healthcare products and services. For example, a patient with cancer may register with the system to create a selection of relevant products or services that may be purchased by the patient or others for specific stages or treatment cycles. (*See, e.g.*, Jagemann ¶ 8.)

The Examiner finds that “Castro teaches a method of providing information related to an item that is for sale,” but does not teach

maintaining an electronic registry of electronic addresses related to the electronic submissions of the access information that are received and in response to receiving the electronic submissions, associating the electronic addresses to the item within the electronic registry, in further response to receiving the electronic submissions of access information, transmitting the sales information from an electronic sales database that associates the sales information to the item to a first electronic message that is addressed to the electronic addresses associated with the item within the registry, outputting the first electronic message over a computer network to the electronic addresses, upon electronically detecting an update to the sales information associated with the item within the sales database, transmitting the update of the sales information within the electronic sales database to a second electronic message address to the electronic messages associated with the item within the registry, and outputting the second electronic message containing the updated sales information over the computer network to the electronic addresses of the registry.

(Final Act. 5–6.) The Examiner further finds, however, that Jagemann teaches all of these other elements and that one of ordinary skill in the art “would have recognized that results of the combination were predictable, such as ‘the ability to manage the relationship between the catalog containing targeted products and services, recommenders, and customers, while maintaining privacy of personal customer data,’ as explicitly suggested by Jagemann (¶0054).” (*Id.* at 6–7.)

Appellants argue “the notification associated with the ‘registry’ of Jagemann . . . is to notify those interested in purchasing items for the individual that the registry for the individual has been set up” and “[t]his has nothing to do with sending an electronic message that contains an update to an item for sale.” (App. Br. 10.)

The Examiner responds that the claimed updating is present in Jagemann because [A] “[e]ach individual in Jagemann’s registry is associated with an address (e.g., ¶¶ 0064 and 0089) and a message is sent to every respective individual, at their provided address, when the sales information for the item that is associated with them in the registry is updated,” and [B] Jagemann “teaches that the sales information is updated by recommendations by experts and peers (e.g., ¶¶ 0008, 0062, 0067, and 0072).” (Ans. 8–9.) “Alternatively,” the Examiner finds “Castro teaches that sales information is updated in the database and sent to the dealers (e.g., ¶ 0029), which also reads on the limitation as nothing in the claims requires that the addresses be customer addresses.” (*Id.* at 8–9.)

We agree with Appellants. While Jagemann describes sending messages to individuals notifying them that a registry has been created for a patient (*see, e.g.*, ¶ 89), we do not see any teaching or suggestion in the cited

portions of Jagemann that subsequent messages are sent in the case of updates to the registry. The fact that experts and peers may update information in the registry does not mean that a message is then sent to the individuals who registered reflecting the update. While we agree that Castro similarly describes the concept of updating the database (*see, e.g.*, ¶ 29), the cited portions of Castro also do not appear to describe sending a message with the updated information. Thus, although the combination includes providing a message with information about a product to an end user based on proximity, and allowing updates to the central database, it does not include or suggest sending a subsequent message to the end user “upon electronically detecting an update,” as claimed.

Because we agree with Appellants’ argument, we do not sustain the rejection of claim 11 under Section 103 and, for the same reasons, we do not sustain the rejections of claims 12–19 and 30, all of which depend from claim 11 and thus include the same limitation. Because this issue is dispositive, we do not reach Appellants’ other prior art arguments.

DECISION

The rejections of claims 11–19 and 30 under Section 112 are reversed. The rejections of claims 11–19 and 30 under Section 101 are affirmed. The rejections of claims 11–19 and 30 under Section 103 are reversed.

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<sup>3</sup>

---

<sup>3</sup> Because we affirm at least one ground of rejection with respect to each claim on appeal, the Examiner’s decision rejecting claims 11–19 and 30 is affirmed. *See* 37 C.F.R. § 41.50(a)(1).