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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID H. TANNENBAUM

Appeal 2016-008466¹
Application 13/536,290²
Technology Center 3600

Before NINA L. MEDLOCK, AMEE A. SHAH, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

FINAMORE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Our Decision references Appellant’s Specification filed June 28, 2012 (“Spec.”), Appeal Brief filed December 29, 2015 (“Appeal Br.”), and Reply Brief filed September 6, 2016 (“Reply Br.”), as well as the Examiner’s Answer mailed July 5, 2016 (“Ans.”) and Final Office Action mailed July 2, 2015 (“Final Act.”). An oral hearing was held on October 23, 2018, and the record includes a transcript of the hearing.

² Appellant identifies Fantod Audio Limited Liability Company, which is affiliated with Intellectual Ventures Management LLC, as the real party in interest. Appeal Br. 1.

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant appeals from the Examiner's decision to reject claims 1, 2, 5, 7, 10–12, 14, 15, and 18. We have jurisdiction under § 6(b). We AFFIRM.

SUBJECT MATTER ON APPEAL

The invention “relates to the delivery of merchandise from a merchandise provider to a merchandise seeker and more particularly to a system and method for allowing a merchandise seeker to find merchandise not presently available for purchase.” Spec. ¶ 2. Claims 1 and 11 are the independent claims on appeal. Independent claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A system, comprising:
 - a search engine configured to receive one or more search queries associated with a user-specified item and to search one or more databases not affiliated with the search engine for a request for the user-specified item;
 - a processor in communication with the search engine, the processor configured to:
 - instruct the search engine to search the one or more databases for the request for the user-specified item;
 - determine whether a search result generated by the search engine indicates that the request for the user-specified item is available or unavailable; and
 - in response to the search result indicating that the request for the user-specified item is unavailable, instruct the search engine to continue searching the one or more databases at specified time intervals until the search result indicates that the request for the user-specified item is available; and
 - a delivery unit in communication with the processor, the processor further configured to communicate the search result to the delivery unit in response to the search result indicating that

the request for the user-specified item is available, wherein the delivery unit is configured to communicate to a user associated with the request for the user-specified item that the user-specified item is available for purchase.

REFERENCES

The Examiner relies on the following references in rejecting the claims on appeal:

Bisdikian et al.	US 5,974,406	Oct. 26, 1999	(“Bisdikian”)
Stebbins	US 6,564,253 B1	May 13, 2003	
Dahod et al.	US 6,574,608 B1	June 3, 2003	(“Dahod”)
Boyer et al.	US 7,165,098 B1	Jan. 16, 2007	(“Boyer”)

“Flag,” Microsoft Computer Dictionary (4th ed. 1999) (“Microsoft”).³

Eaglesham, Jean, “Court rules on internet trademark use,” Financial Times (June 2, 2000) (“Eaglesham”).⁴

Lee Gomes and Lisa Bransten, *New Web Technology Unites PCs --- Peer-to-Peer Pressures Conventional Practices by Cutting Out Middlemen --- Netscape’s Andreessen Jumps on Board*, Asian Wall Street Journal, July 6, 2000 at 13 (“Gnutella0”)⁵; Holman W. Jenkins, Jr., *Gangsta*

³ The Final Office Action refers to “Microsoft dictionary definition,” (Final Act. 7) and “Microsoft Dictionary” (*id.* at 10–15), but does not include a citation therefor. We rely on the citation provided in a Notice of References Cited (Form PTO-892) mailed November 15, 2007, for U.S. patent application no. 10/910,872 (“the ’872 application”), to which the present application claims priority. This citation is consistent with Appellant’s understanding. Appeal Br. 4.

⁴ The Final Office Action does not include a citation for Eaglesham. We rely on the citation provided in a Notice of References Cited for the ’872 application mailed April 17, 2008, which is consistent with Appellant’s understanding (Appeal Br. 3–4).

⁵ The Examiner refers to this reference as “Gnutella,” and also refers to several references collectively as “Gnutella.” Final Act. 7. To distinguish a

①*Napster*, Asian Wall Street Journal, May 17, 2000 at 10 (“Gnutella1”); Holman W. Jenkins, Jr., *Nice Try, Metallica*, Wall Street Journal Europe, May 12, 2000 at 9 (“Gnutella2”); Ian Ansdell, *Music chiefs stopped in their tracks*, Herald (United Kingdom), July 7, 2000 at 26 (“Gnutella3”); Doug Bedell, *Online Copyright Crisis Moves Beyond Music*, KTRBN Knight-Ridder Tribune Business News (Dallas Morning News - Texas), June 22, 2000 (“Gnutella4”); *Sightsound.com Expands Movie Distribution to Include the Gnutella File Sharing Network; Move Designed to Further Leverage Hyperdistribution Capabilities of the Internet*, Business Wire, June 14, 2000 (“Gnutella5”); *Programming Team Behind Gnutella Movement Pioneers World’s First Distributed, Real-Time Search Engine Prototype*, Business Wire, June 1, 2000 (“Gnutella6”); Eileen Fitzpatrick, 112 Billboard, no. 27, July 1, 2000 at 1 (“Gnutella7”); Vince Horiuchi, *Web Sites under Fire from Music Industry for Supplying Songs to Download*, KTRBN Knight-Ridder Tribune Business News (Salt Lake Tribune - Utah), May 8, 2000 (“Gnutella8”); Jorge A. Baales, *US-Internet New Open-Source Program Poses Challenge to Giant Internet Portals*, EFE News Service, May 18, 2000 (“Gnutella9”); Gnutella, <http://en.wikipedia.org/wiki/Gnutella> (last visited Nov. 6, 2007) (“Gnutella10”); *John Barker Writes: Dot Communism?*, Inside Multimedia, July 4, 2000 at 1 (“Gnutella11”); Timoth Barmann, *The Music Trade - On the Internet, a vast music library is a click away, but song swapping is turning copyright law on its ear*, Providence Journal, July 23, 2000 at A.08 (“Gnutella12”); David Streitfeld, *The Web’s Next Step: Unraveling Itself; Software Threatens Search Engines*, Washington Post, July 18, 2000 at A.01 (“Gnutella13”); Sean M. Dugan, *Peer-to-peer networking is poised to revolutionize the Internet once again*, InfoWorld, July 17, 2000 at 103 (“Gnutella14”); Gnutella, *Support: Tutorial*, <http://gnutella.wego.com/go/wego.pages.page?groupID=116705&view=page&pageId119427&folderId=118398&panelId=119597&action=view> [<http://web.archive.org/web/20000620214440/http://gnutella.wego.com/go/wego.pages.page?groupID=116705&view=page&pageId=119427&folderId=118398&panelId=119597&action=view>] (“Gnutella15”); Gnutella, *Support: Index*, <http://gnutella.wego.com/go/wego.pages.page?groupID=116705&view=page&pageId118400&folderId=118398&panelId=119597&action=view> [[---

citation to this particular reference from a citation to the collection, we refer to this reference as “Gnutella0.”](http://web.archive.org/web/20000620174435/http://gnutella.wego.com/go/wego.pages.page?groupID=116705&view=</p></div><div data-bbox=)

page&pageId=118400&folderId=118398&panelId=119597&action=view] (“Gnutella16”); Gnutella, *Support: FAQ*, <http://gnutella.wego.com/go/wego.pages.page?groupID=116705&view=page&pageId=118401&folderId=118398&panelId=119597&action=view> [<http://web.archive.org/web/20000620201407/http://gnutella.wego.com/go/wego.pages.page?groupID=116705&view=page&pageId=118401&folderId=118398&panelId=119597&action=view>] (“Gnutella17”); Steve Fox, *Can New Technology Revolutionize the Net?*, CNET Insider, June 1, 2000 (“Gnutella18”); and John Borland, *Napster-like technology takes Web search to new level*, CNET News, May 31, 2000 (“Gnutella19”) (collectively “Gnutella”).

REJECTIONS

The Examiner rejects the claims on appeal as follows:

claims 1, 2, 5, 7, 10–12, 14, 15, and 18 under 35 U.S.C. § 101 as directed to non-statutory subject matter⁶; and

claims 1, 2, 5, 7, 10–12, 14, 15, and 18 under 35 U.S.C. § 103(a) as unpatentable over Boyer, Bisdikian, Gnutella, Eaglesham or Stebbings, Microsoft, and Dahod.

ANALYSIS

35 U.S.C. § 101

An invention is patent eligible if it is a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014)

⁶ In the Final Office Action, the Examiner rejects only independent claim 1 under 35 U.S.C. § 101. Final Act. 3. In the Answer, the Examiner makes a new ground of rejection to the expand the rejection in the Final Office Action to include also claims 2, 5, 7, 10–12, 14, 15, and 18. Ans. 2.

(quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

To “distinguish[] patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts,” the Supreme Court, in *Alice*, reaffirmed the two-step analysis previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012). *Alice*, 134 S. Ct. at 2355. The first step of this analysis considers whether a claim is directed to a patent-ineligible concept, e.g., an abstract idea. *Id.* (citing *Mayo*, 566 U.S. at 77). If so, the second step considers whether the claim recites an inventive concept—an element or combination of elements sufficient to ensure the claim amounts to significantly more than the abstract idea and transform the nature of the claim into a patent-eligible application. *Id.* (citing *Mayo*, 566 U.S. at 72–73, 78, 79).

In rejecting the claims under 35 U.S.C. § 101 as directed to non-statutory subject matter, i.e., subject matter judicially excepted from statutory subject matter, the Examiner analyzes the claims using this two-step framework. Final Act. 3–6; Ans. 2–7. Pursuant to the first step, the Examiner determines the claims are directed to “allowing consumers [to] post requests for needed items of interest and services and sellers [to] answer requests for desired items and continuing a search [until] a desired item is found,” which the Examiner determines is both a fundamental economic practice and a method of organizing human activity, and, therefore, an abstract idea. Final Act. 4. Under the second step, the Examiner determines the claims do not recite significantly more than the abstract idea because the elements of the recited process, considered individually and as an ordered

combination, are “merely the combined and coordinated execution of generic computer functionalities which are well-understood, routine and conventional activities previously known to the industry.” *Id.* at 5. The Examiner also determines “the claims do not amount to an improvement to another technology or technical field, nor do the claims amount to an improvement to the functioning of the computer itself.” Ans. 3–4.

Appellant argues claims 1, 2, 5, 7, 10–12, 14, 15, and 18 as a group. Reply Br. 1–2. We select independent claim 1 as representative, and the remaining claims of the group stand or fall with independent claim 1.

37 C.F.R. § 41.37(c)(1)(iv).

Appellant argues the Examiner errs in determining that independent claim 1 is directed to an abstract idea pursuant to the first step of the *Alice* analysis. Appeal Br. 6–7; Reply Br. 1–2. More specifically, Appellant asserts the alleged abstract idea has no basis in the claim language. Reply Br. 1–2. Appellant also alleges the claim is not directed to an abstract idea because it is directed to a problem that arises specifically in the realm of search engines and the Internet. Appeal Br. 6. Appellant’s arguments do not apprise us of error.

In determining whether a claim is directed to excluded subject matter, e.g., an abstract idea, the Federal Circuit has explained that “the ‘directed to’ inquiry 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.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). For computer-implemented inventions in particular, such as the present invention, “the first step in the

Alice inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Id.* at 1335–36.

Here, independent claim 1 recites a system comprising a search engine, a processor in communication with a search engine, and a delivery unit in communication with the processor. The system uses these components to perform the steps of: receiving a search query associated with a user-specified item; searching a database not affiliated with the search engine for a request for the user-specified item; determining whether a search result indicates that the request for the user-specified item is available or unavailable; in response to the search result indicating that the request for the user-specified item is unavailable, continuing to search the database at specified time intervals until the search result indicates that the request for the user-specified item is available; and, in response to the search result indicating that the request for the user-specified item is available, communicating to a user associated with the request for the user-specified item that the user-specified item is available for purchase. Simply put, independent claim 1 recites a computer system that implements a process for searching for a request for a user-specified item until the user-specified item becomes available. Consequently, the issue is whether the focus of the claim is on a process for searching for a request for a user-specified item until it becomes available or on an improvement to the computer system.

In this regard, Appellant argues the claimed invention is an improvement to the computer system because it addresses the problem of a search engine being able to search only information existing on the Internet

at the time the information is sought. Appeal Br. 6 (citation omitted). Indeed, the claimed invention provides the ability to search for a request for a user-specified item that is not yet available by receiving a search query associated with a user-specified item and continuing to search a database not affiliated with the search engine for a request for the user-specified item until the search result indicates that the request for the user-specified item is available. The improvement, however, is to the search methodology, not to the computer system. Although the claimed invention implements the improved search methodology via a computer system such that the computer system can search for a request for a user-specified item that is not yet available, any implementation of the search methodology would be improved similarly. Accordingly, the claimed invention uses the components of the computer system as tools to implement an improved searching process, and the focus of the claimed invention is on a process for searching for a request for a user-specified item until the user-specified item becomes available, not on an improvement to computer technology. Appellant, therefore, does not apprise us of error in the Examiner's determination that independent claim 1 is directed to the abstract idea of "allowing consumers [to] post requests for needed items of interest and services and sellers [to] answer requests for desired items and continuing a search [until] a desired item is found" (Final Act. 4).

Seeing no error in the Examiner's determination that the claims are directed to an abstract idea under the first step of the *Alice* analysis, we turn to the second step. Appellant argues independent claim 1 recites significantly more than the abstract idea because the claimed invention addresses "a problem arising in peer-to-peer technology, *i.e.*, that the

requests available in such a network may be in constant flux and thus, requests that may not have existed after one search may appear in a second, subsequent search.” Appeal Br. 9. Appellant similarly asserts the claimed invention addresses the problem of searching in a database of constantly changing information such as the Internet. Reply Br. 2. Appellant does not persuade us of error.

The fact that the claimed invention recites a computer system, in and of itself, does not mean the claimed invention addresses a technological problem or represents a technical solution. Here, the problem of searching through information that is constantly changing is not a technical problem. Rather, the problem exists in any realm where information changes, e.g., a search engine searching the Internet for information or a person manually searching records that are updated. Moreover, the solution, i.e., the search methodology for searching for a request for a user-specified item until the user-specified item becomes available, is likewise untechnical, as performance of these steps does not require a computer.

As we explain above, the second step of the *Alice* analysis considers whether the claim “contains an inventive concept sufficient to transform the claimed abstract idea into a patent-eligible application.” *Alice*, 134 S. Ct. at 2357 (internal quotations omitted) (quoting *Mayo*, 566 U.S. at 72, 80). Apart from the search methodology, which describes the abstract idea of searching for a request for a user-specified item until the user-specified item becomes available, independent claim 1 recites a search engine, a processor, and a delivery unit. The Examiner determines, and Appellant does not refute, that the claimed computer components are generic computer structure. Final Act. 6; Ans. 4, 6; *see also* Spec. ¶ 34. Although the

computer system may be improved by implementing the recited search methodology that addresses the problem of searching through information that is constantly changing, any implementation of the search methodology would be so improved. Accordingly, the recited computer components are insufficient to transform the claimed abstract idea into a patent-eligible application. *See Alice*, 134 S. Ct. at 2358 (“Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of ‘additional featur[e]’ that provides any ‘practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.’” (alteration in original) (internal citation omitted) (quoting *Mayo*, 566 U.S. at 77)).

Appellant additionally argues that independent claim 1 is patent eligible because the claim is of modest scope and does not threaten to create problems relating to preemption. Appeal Br. 11. Preemption, however, is not the test for patent eligibility. Although preemption may be the concern behind the judicial exceptions to statutory subject matter, it is not the test for determining whether a claim is judicially excepted from statutory subject matter. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability. For this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citation omitted). For the reasons set forth above, Appellant does not apprise us of error in the Examiner’s determination that independent claim 1 is patent ineligible under the § 101 analysis set forth in *Alice*.

Appellant also argues that the Examiner’s rejection is improper because the Examiner has not cited evidence to support the rejection.

Although Appellant is correct that factual determinations must be adequately supported, our reviewing court has explained that a determination of patent ineligibility can be made without resolving fact issues. *See, e.g., Mortgage Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325–26 (Fed. Cir. 2016) (“[I]t is also possible, as numerous cases have recognized, that a § 101 analysis may sometimes be undertaken without resolving fact issues.”). Here, in making this argument, Appellant does not identify any factual dispute. To the extent Appellant’s other arguments suggest one or more facts are in dispute, there is sufficient support for the resolution of these disputes for the reasons discussed above.

In view of the foregoing, Appellant has not persuaded us the Examiner erred in determining that independent claim 1 is patent ineligible. We, therefore, sustain the Examiner’s rejection of independent claim 1 under 35 U.S.C. § 101, with claims 2, 5, 7, 10–12, 14, 15, and 18 falling therewith.

35 U.S.C. § 103(a)

With respect to independent claim 1, Appellant argues the combined teachings of the cited references would not have resulted in the limitation reciting “a search engine configured to receive one or more search queries associated with a user-specified item and to search one or more databases not affiliated with the search engine for a request for the user-specified item.” Appeal Br. 12–15; Reply Br. 3–8. Specifically, Appellant asserts that the combined teachings would not have resulted in this limitation because Boyer discloses transforming user requests into SQL requests, not querying databases for user requests. Appeal Br. 13 (citing Boyer 17:65–18:5). Appellant’s argument is not convincing.

In determining that the combined teachings of the cited references would have resulted in this limitation, the Examiner relies on Boyer for disclosing a search engine that queries databases for user requests. Final Act. 7 (citing Boyer 18:8–21). Even if Appellant is correct that Boyer discloses transforming user requests into SQL requests, Boyer also discloses “searching each source for scheduling information meeting the user defined requests” (Boyer 18:10–11). Appellant, therefore, does not apprise us of error in the Examiner’s finding that Boyer discloses a search engine that queries databases for user requests (Final Act. 8).

Appellant also asserts that the combined teachings of the cited references would not have resulted in this limitation because Gnutella’s system requires a user to know the exact file name to search for it such that Gnutella does not teach receiving one or more queries associated with a user-specified item. Reply Br. 3–5. Appellant’s argument does not apprise us of error because the Examiner is relying on Gnutella for a teaching of searching a database not affiliated with the search engine, and relies on Dahod, not Gnutella, for a teaching of searching for a user-specified item.

More specifically, the Examiner relies on the combined teachings of Gnutella and Dahod to teach the elements of this limitation that are missing from Boyer. As set forth above, the Examiner relies on Boyer for disclosing a search engine that queries databases for user requests (Final Act. 8), and the Examiner relies on the combination of Gnutella and Dahod for teaching a request for a user-specified item and searching one or more databases not affiliated with the search engine for a request for the user-specified item (*id.* at 9–12; Ans. 11–14). According to the Examiner, Dahod’s buyer-driven sales system enables individuals to post needs so that sellers can search these

needs and offer products in response thereto. Ans. 12; Dahod, Abstract. As such, Dahod teaches searching for a request for a user-specified item. The Examiner also explains that Gnutella's peer-to-peer network allows a user to search other users' computers for information. Ans. 14; Gnutella0, Abstract. Accordingly, Gnutella teaches searching databases not affiliated with the search engine. Given Boyer's disclosure of a search engine that queries databases for user requests, Dahod's teaching of searching for a request for a user-specified item, and Gnutella's teaching of searching databases not affiliated with the search engine, Appellant does not apprise us of error in the Examiner's determination that it would have been obvious to combine these teachings to result in "a search engine configured to receive one or more search queries associated with a user-specified item and to search one or more databases not affiliated with the search engine for a request for the user-specified item," as recited in independent claim 1.

Appellant further argues that the combined teachings of the cited references would not have resulted in "communicat[ing] to a user associated with the request for the user-specified item that the user-specified item is available for purchase," as recited in independent claim 1. Reply Br. 7-8. In particular, Appellant asserts Gnutella's peer-to-peer network results in anonymous users and would be incapable of communicating to a user. *Id.* Appellant's argument is not convincing. The Examiner is relying on Boyer, not Gnutella, for disclosing this limitation. Final Act. 9. Furthermore, as set forth above, the Examiner is not proposing to modify Gnutella's peer-to-peer network, but instead relies on Gnutella's peer-to-peer network for a teaching of searching databases not affiliated with the search engine. Ans. 14.

In view of the foregoing, Appellant has not persuaded us the Examiner erred in determining that the subject matter of independent claim 1 would have been obvious to one of ordinary skill in the art at the time of Appellant's invention. Accordingly, we sustain the rejection of independent claim 1 under 35 U.S.C. § 103(a). Appellant relies on the same arguments as independent claim 1 for independent claim 11 (Appeal Br. 12–15; Reply Br. 3–8), and Appellant relies on the same arguments as the independent claims for dependent claims 2, 5, 7, 10, 12, 14, 15, and 18 (Appeal Br. 15). Therefore, for the same reasons as independent claim 1, we sustain the rejection of claims 2, 5, 7, 10–12, 14, 15, and 18 under 35 U.S.C. § 103(a).

DECISION

The Examiner's decision to reject claims 1, 2, 5, 6, 10–12, 14, 15, and 18 under 35 U.S.C. § 101 is affirmed.

The Examiner's decision to reject claims 1, 2, 5, 6, 10–12, 14, 15, and 18 under 35 U.S.C. § 103(a) 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). 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED