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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WEALTHY DESAI and SANDEEP BETARBET

Appeal 2017-000137
Application 10/999,325
Technology Center 3600

Before BIBHU R. MOHANTY, NINA L. MEDLOCK, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 from the final rejection of claims 1–6 and 8–21, which are all the claims pending in the Application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to providing service to a subscriber of an advertising program (Spec. 1:5–7). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A non-transitory computer-readable medium containing computer-executable instructions which, when executed by a processor, cause the processor to perform operations for providing call feedback to at least one subscriber of an advertising program, the operations comprising:
 - retrieving a report, the report including data associated with at least one call associated with the at least one subscriber of the advertising program;
 - generating a report message, the report message associated with at least one rule, wherein the report message is generated on a periodic basis without the need for the at least one subscriber of the advertising program to request the report;
 - sending, via an electronic message over a communication network, the at least one subscriber of the advertising program the report message, the report message containing subscriber specific information and the report;
 - determining whether the report message was received by the at least one subscriber of the advertising program;
 - in response to determining that the report message was not received by the at least one subscriber of the advertising program:
 - determining a reason the report message was not received by the at least one subscriber of the advertising program;
 - producing an alert comprising information associated with the at least one subscriber and the reason the report message was not received by the at least one subscriber of the advertising program; and
 - enabling a best remedial action to be determined for delivering the report message to the at least one subscriber based on the reason the report message was not received by the at least one subscriber of the advertising program, wherein if the reason the report message was not received by the

subscriber is related to an electronic message address of the subscriber, the best remedial action is determined to be contacting the subscriber to obtain an alternate electronic message address for sending the report message to the subscriber, and if the reason the report message was not received by the subscriber is related to an error in the communication network, the best remedial action is determined to be resending the report message to the subscriber.

THE REJECTION

The following rejection is before us for review:

Claims 1–6 and 8–21 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.¹

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellants argue that the rejection of claim 1 is improper because the claim is not directed to an abstract idea and is instead rooted in technology (App. Br. 10–12; Reply Br. 2–5). The Appellants also argue that the claim contains limitations that are “significantly more” than the alleged abstract idea (App. Br. 13, 14). The Appellants also argue that when

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

considered as an “ordered combination” that the claim recites more than an abstract idea (App. Br. 14-16).

In contrast, the Examiner has determined that the rejection of record is proper (Final Act. 2–5; Ans. 4–7).

We agree with the Examiner. Under 35 U.S.C. § 101, an invention is patent-eligible if it claims 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: “laws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In judging whether claim 1 falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. If so, we then consider the elements of the claim both individually and as “an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application of the abstract idea. *Id.* This is a search for an “inventive concept” an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.* The Court also stated that “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Id.* at 2358.

Here, we determine that the claim is directed to the concept of tracking advertising messages sent and determining remedial actions if not

received. This is a method of organizing human activities or a fundamental economic practice long prevalent in our system of commerce, and is an abstract idea beyond the scope of § 101. The preamble of the claim states that processor “perform[s] operations for providing call feedback to at least one subscriber of an advertising program.” In *Two-Way Media Ltd. v. Comcast Cable Comm., LLC*, 874 F.3d 1329, 1337, 1338 (Fed. Cir. 2017), it was held that the steps of sending information, directing sent information, and monitoring and accumulating records about the receipt of sent information are directed to an abstract idea. *See also Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016) where collecting information, analyzing it, and displaying results from certain results of the collection and analysis was held to be an abstract idea.

We next consider whether additional elements of the claim, both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the abstract idea using generic computer components. We conclude that it does not.

Considering each of the claim elements in turn, the function performed by the computer system at each step of the process is purely conventional both individually and as an ordered combination. Each step of the claimed method does no more than require a generic computer to perform a generic computer function. The Specification at pages 4 and 5 describes using generic computing devices such as a computing device, system memory (RAM, ROM, flash memory), operating system, keyboard, and display in a conventional manner.

We note the point about pre-emption (App. Br. 10–12; Reply Br. 2). Although pre-emption “might tend to impede innovation more than it would tend to promote it, ‘thereby thwarting the primary object of the patent laws’” (*Alice*, 134 S. Ct. at 2354 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012)), “the absence of complete preemption does not demonstrate patent eligibility” (*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.”).

The Appellants in the Reply Brief at pages 5–7 have also cited to *Enfish, LLC v. Microsoft*, 822 F.3d 1327, Fed. Cir. 2016) in attempting to show the claim to be patent eligible. The scope of the claims there was different than those at hand, which related to a self-referential data table. Here, the claim is not rooted in technology but rather directed to the abstract concept of tracking advertising messages sent and determining remedial actions if not received, in which the additional elements fail to transform the nature of the claim into a patent-eligible application of the abstract idea.

For these reasons the rejection of claim 1 is sustained. The Appellants have provided the same arguments for the remaining claims which are directed to similar subject matter and the rejection of these claims is therefore sustained as well.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1–6 and 8–21 under 35 U.S.C. § 101.

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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

DECISION

The Examiner’s rejection of claims 1–6 and 8–21 is sustained.

AFFIRMED