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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* TIMOTHY DARREN NORMAN and  
BRYAN WILBOURNE PRUET

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Appeal 2017-000493  
Application 13/799,851<sup>1</sup>  
Technology Center 3600

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Before BRUCE T. WIEDER, TARA L. HUTCHINGS, and  
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1–4, 6–8, 14, 17, 18, 20, 21, 23, 29–31, and 35. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> According to Appellants, the real party in interest is Lowe's Companies, Inc. (Appeal Br. 2.)

CLAIMED SUBJECT MATTER

Appellants' invention "relates generally to customized products and more particularly to the ordering and/or management of customized products and related information." (Spec. ¶ 2.)

Claim 1 is the sole independent claim on appeal. It recites (paragraph numbering added):

1. A method comprising:

[1] receiving, by a paint customization station in a retail location of a retailer, a selection of a customized paint color;

[2] determining, by the paint customization station in the retail location of the retailer, a unique product identifier corresponding to the customized paint color;

[3] initiating, by a point-of sale device in the retail location, a purchase of the customized product by a consumer in the retail location;

[4] receiving, by the point-of-sale device in the retail location of the retailer and as part of the purchase of the customized paint color by the consumer in the retail location, the unique product identifier, wherein the point-of-sale device is different than the paint customization station;

[5] receiving, by the point-of-sale device in the retail location of the retailer and as part of the purchase of the customized paint color by the consumer in the retail location, an account identifier corresponding to an online account of the consumer purchasing the customized paint color, wherein the online account corresponds to the retailer of the customized paint color and the online account is accessible to the consumer through a website of the retailer, wherein the unique product identifier and the account identifier are received by the point-of-sale device through at least one input device;

[6] as part of the purchase of the customized paint color or thereafter, using the account identifier and the unique product identifier to associate the customized paint color with the online account of the consumer such that the customized paint color purchased by the consumer in the retail location is viewable in

the online account of the consumer when the consumer accesses the online account through the website;

[7] as part of the purchase or thereafter, determining an object in the online account to associate with the customized paint color, the object representing a portion of a building;

[8] as part of the purchase or thereafter, using at least one of the unique product identifier or the account identifier to associate the object with the customized paint color in the online account; and

[9] completing, by the point-of-sale device, the purchase, [10] wherein each of the steps of the method is performed by at least one processor.

#### REJECTION

Claims 1–4, 6–8, 14, 17, 18, 20, 21, 23, 29–31, and 35 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

#### ANALYSIS

“Whoever 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. Section 101, however, “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) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

*Alice* applies a two-step framework, earlier set out in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural

phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355.

Under the two-step framework, it must first be determined if “the claims at issue are directed to a patent-ineligible concept.” *Id.* If the claims are determined to be directed to a patent-ineligible concept, then the second step of the framework is applied to determine if “the elements of the claim . . . contain[] an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Id.* at 2357 (citing *Mayo*, 566 U.S. at 72–73, 79).

With regard to step one of the *Alice* framework, the Examiner determines that the claims are “directed to associating information relating to the purchase of paint with an object in [an] account of [a] customer, which is considered an abstract idea.” (Answer 6.) The Examiner further determines that the claims are directed to concepts similar to those found in several cases, e.g., *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1354–55 (Fed. Cir. 2014) (creating contractual relationships) and *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016) (collecting, analyzing, and displaying information, and organizing human activities). (Answer 7–9.)

Appellants argue that the Examiner “provide[s] no analysis with respect to the ***Claims-at-Issue*** under the first step of the *Alice* test.” (Reply Br. 2.) Appellants further argue that “[w]ithout providing analysis as to why the Claims-at-Issue are allegedly ‘directed to’ an abstract idea, the Examiner cannot satisfy his initial burden of establishing a *prima facie* case for a rejection under § 101 by a preponderance of the evidence under the first step of the *Alice* test.” (*Id.*)

We are not persuaded of error. The USPTO carries its procedural burden of establishing a prima facie case 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) (alteration in original) (quoting 35 U.S.C. § 132(a)). Here, pursuant to the first step of the *Alice* test, the Examiner notified Appellants that the claims are directed to a patent-ineligible abstract idea, i.e., that the claims are directed to “associating information relating to the purchase of paint with an object in [an] account of [a] customer.” (Answer 6.) Thus, Appellants have been notified of the reason for the rejection with such information “as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *See* 35 U.S.C. § 132(a).

In making the “directed to” inquiry under step one of the *Alice* framework, we “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 Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp.*, 830 F.3d at 1353). Thus, although we consider the claim as a whole, the “directed to” inquiry focuses on the claim’s “character as a whole.”

The Specification provides evidence as to what the invention is directed. The Specification discloses that the invention “relates generally to customized products and more particularly to the ordering and/or management of customized products and related information.” (Spec. ¶ 2.) Claim 1 recites “receiving, by a . . . station . . . a selection,” “determining, by

the . . . station . . . a unique product identifier,” “initiating, by a . . . device . . . a purchase,” “receiving, by the . . . device . . . the unique product identifier,” “receiving, by the . . . device . . . an account identifier corresponding to an . . . account of the consumer purchasing,” “using the account identifier and the unique product identifier to associate the [selection] with the . . . account of the consumer,” “determining an object in the . . . account to associate with the [selection],” “using at least one of the unique product identifier or the account identifier to associate the object with the [selection] in the . . . account,” and “completing, by the . . . device, the purchase.”

Although we and the Examiner describe, at different levels of abstraction, to what the claims are directed, it is recognized that “[a]n abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). That need not and, in this case does not, “impact the patentability analysis.” *See id.* at 1241. In short, we agree with the Examiner that the claims are directed to an abstract idea; in this case, a method of associating information relating to the purchase of a paint color with an object in an account of a customer. (*See Answer 6.*)

Nonetheless, Appellants seek to analogize the claims to the claims in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016). (Reply Br. 3 n.1.) Appellants argue that “the Claims-at-Issue provide computer-functionality improvements. In *Enfish*, the claims improved upon traditional databases and the Claims-at-Issue here improve upon traditional online accounts.” (*Id.*) We disagree. Unlike the present claims, the claims in *Enfish* were “specifically directed to a *self-referential* table for a computer

database.” *Enfish*, 822 F.3d at 1337. That is, “the plain focus of the claims [was] on an improvement to computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity.” *Id.* at 1336. The Federal Circuit noted that this was “an improvement of an existing technology” as evidenced “by the specification’s teachings.” *Id.* at 1337. In other words, unlike the invention sought to be claimed here, the invention claimed in *Enfish* does more than “simply instruct the practitioner to implement the abstract idea with routine, conventional activity.” *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014).

Appellants also seek to analogize the present claims to the claims in *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1313 (Fed. Cir. 2016). (Reply Br. 4.) Appellants argue that, like the claims in *McRO*, “the Claims-at-Issue here focus on specific improvements to traditional online accounts.” (*Id.*) We disagree. In *McRO*, the court determined that

the claimed improvement here is allowing computers to produce “accurate and realistic lip synchronization and facial expressions in animated characters” that previously could only be produced by human animators. As the district court correctly recognized, this computer automation is realized by improving the prior art through “the use of rules, rather than artists, to set the morph weights and transitions between phonemes.” The rules are limiting in that they define morph weight sets as a function of the timing of phoneme sub-sequences.

*McRO*, 837 F.3d at 1313 (citations omitted). Here, the asserted improvement is to a business practice regarding what information is associated with an account. In other words, “[t]hese claims in substance [are] directed to nothing more than the performance of an abstract business practice . . . using a conventional computer. Such claims are not patent-

eligible.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014).

To the extent Appellants argue that the claims are directed to patent-eligible subject matter because “the Examiner acknowledges that the Claims-at-Issue are distinguished over the prior art” (Reply Br. 4), we do not find this argument persuasive of error. “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).

In view of the above, we are not persuaded that the Examiner erred in determining that the claims are directed to an abstract idea.

We now look to step two of the *Alice* framework. Step two of the *Alice* framework has been described “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*, 134 S. Ct. at 2355 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

The Examiner finds “that the claims merely recite generic computer elements such as [a] paint customization station and POS device. Each of these computer elements perform functions that are routine and convention [sic] for computer elements to perform, such as gathering data and correlating data together.” (Final Action 3.)

Appellants disagree and argue that the Examiner provides no argument or explanation as to why the claimed “paint customization station” or “point-of-sale device” are supposedly generically-recited computer elements. *See* Appeal

Brief, pp. 9-12. A paint customization station involves significantly more than a generic computer. Generic computers can't mix paint or otherwise customize it without significantly more. Generic computers don't communicate information identifying a customized paint color a consumer purchases in a retail location to a customer's online account . . . .

(Reply Br. 4.)

We are not persuaded of error. As an initial matter, Appellants do not point to any claim language regarding mixing or customizing paint. Nor do we see any step in method claim 1 reciting mixing or customizing paint. Claim 1 recites, e.g., "receiving, by a paint customization station . . . a selection of a customized paint color" and "determining, by the paint customization station . . . a unique product identifier."

We find Appellants' argument that "[g]eneric computers don't communicate information identifying a customized paint color" to also be unpersuasive of error. "[W]e have treated collecting [and communicating] information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas." *Elec. Power Grp.*, 830 F.3d at 1353. Additionally, we note that Appellants' Specification discloses that the disclosed method may be performed by generic computer elements, e.g., "by one or more electronic devices, such as a tablet computer, mobile phone, notebook computer, desktop computer, point-of-sale system, or other computing device(s) comprising an input device such as a mouse, trackpad, keyboard, touch-screen, barcode scanner, or other input device ." (Spec. ¶ 17.)

Moreover, taking the claim elements separately, the computer functions performed by the customization station and point-of-sale device at each step are purely conventional. Receiving, determining, initiating, and

using/processing information are basic computer functions. And, as noted above, the Specification discloses that the method may be performed by generic computer elements. (*Id.*) In short, each step does no more than require a generic computer/processor to perform routine computer functions.

Considered as an ordered combination, the computer/processor elements of Appellants' method add nothing that is not already present when the steps are considered separately. The claims do not, for example, purport to improve the functioning of the processor of the customization station or point-of-sale device. Nor do they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea. That is not enough to transform an abstract idea into a patent-eligible invention. *Alice*, 134 S. Ct. at 2360.

In view of the above, we are not persuaded that the Examiner erred in rejecting claim 1. Dependent claims 2–4, 6–8, 14, 17, 18, 20, 21, 23, 29–31, and 35 are not separately argued and fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

#### DECISION

The Examiner's rejection of claims 1–4, 6–8, 14, 17, 18, 20, 21, 23, 29–31, and 35 under 35 U.S.C. § 101 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