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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DELARAM FAKHRAI

Appeal 2017-001275
Application 13/468,009¹
Technology Center 3700

Before EDWARD A. BROWN, BRANDON J. WARNER, and
SEAN P. O’HANLON, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Delaram Fakhrai (“Appellant”) seeks review under 35 U.S.C. § 134(a) of the Examiner’s decision, as set forth in the Final Office Action dated October 14, 2015 (“Final Act.”), rejecting claims 13–16, 22–29, and 31–42.² We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The Appeal Brief identifies Delart Technology Services LLC as the real party in interest. Appeal Br. 2.

² Claims 1–12, 17–21, 30, and 43 have been cancelled. *Id.* at 22, 23, 26, 31 (Claims App.).

CLAIMED SUBJECT MATTER

Claims 13 and 31 are independent. Claim 13, reproduced below, illustrates the claimed subject matter:

13. A non-transitory machine readable medium storing a program for sharing course material among a plurality of instructors in an online learning system, the program executable by at least one processing unit[], the program comprising sets of instructions for:

receiving a request for searching for relevant course material for a first course taught by an instructor of the online learning system without receiving a search criteria;

identifying (i) courses having same objectives and requirements as the first course, (ii) courses linking to a same suggested learning material, and (iii) courses with enrolled student users searching for a same content as the content searched by students enrolled in the first course;

specifying the identified courses as courses similar to the first course;

searching for relevant course material for the first course based on the courses identified as similar to the first course;

providing a set of relevant course material items found in the search sorted based on a set of ranking and assessment criteria;

receiving an identification of a course material item in the provided set of relevant course material items to share for teaching the first course;

sending a request to an owner of the identified course material item to authorize sharing of the identified course material item; and

allowing sharing of the identified course material by the instructor for teaching the first course when an authorization for sharing the identified course material items is received from the owner.

Appeal Br. 22 (Claims App.).

REJECTION

Claims 13–16, 22–29, and 31–42 are rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

ANALYSIS

Patent-Ineligible Subject Matter

The Supreme Court has provided a two-step framework “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). The first step of the *Alice* test is to determine whether the claims at issue are directed to one of those ineligible concepts. *Id.* If they are not, the claims satisfy § 101. *Id.* If they are, the second step of the *Alice* test is to “consider the elements of each 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.” *Id.* (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, [566 U.S. 66, 79] (2012)). The Supreme Court characterizes the second step 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.’” *Id.* (quoting *Mayo*, 566 U.S. at 72–73).

As to *Alice* step 1, the Examiner determines that claims 13 and 31 are directed to several abstract ideas; namely, a series of mental steps that could be carried out by a person using a pen and paper for collecting and organizing information, and “creating a contractual relationship among a set

of instructors for sharing course material, which is a fundamental economic practice.” Final Act. 2–4. As to *Alice* step 2, the Examiner determines that the additional claim elements other than the abstract idea amount to no more than “mere instructions to implement an abstract idea on a computer.” *Id.* at 3. The Examiner finds that the additional elements, that is, “using a computer processor to perform the series of steps and utilizing the content in an online environment,” are well-understood, routine, and conventional operations performed by a generic computer. *Id.* at 4. The Examiner determines that, viewed as a whole, the additional elements do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself. *Id.* at 3.

Additionally, the Examiner determines that dependent claims 22, 25, 26, 28, 29, 35, 38, 39, 41, and 42 likewise do not recite additional limitations that are sufficient to transform the abstract idea into a patent eligible application of the abstract idea. *Id.* at 4.

Claims 13 and 31

Appellant contests the rejection of claims 13 and 31 collectively. Appeal Br. 13–18. We select claim 13 as representative, with claim 31 standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Alice Step 1

Appellant notes exemplary decisions by our reviewing courts in which claims have been found to be directed to an abstract idea. Appeal Br. 14–15. Then, Appellant contends, “[h]ere, the claims recite [a] program and method for sharing course material among a plurality of instructors in an online learning system and *do not fall into any of the above mentioned examples.*”

Id. at 15 (emphasis added). Therefore, Appellant concludes, the claims do not fall into any judicial exception. *Id.* The Examiner responds that this argument does not address specifically the Examiner’s characterization of the claims as being directed to several abstract ideas. Ans. 3. Appellant replies that, in *Enfish LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), the court noted that, when determining whether a claim is directed to an abstract idea in *Alice* step one, it is appropriate to compare the claim to other claims that have already been found to be directed to an abstract idea in a previous court decision. Reply Br. 4–5.

We agree it is appropriate to compare claim 13 to other claims that previously have been found directed to an abstract idea. We note that, for *Alice* step 1, “the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.” *Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016)). However, to the extent it is Appellant’s position that the Examiner is precluded from finding a claimed concept patent-ineligible *unless* it “fall[s] into” a concept previously identified as abstract in one of the specific decisions Appellant cites, we disagree. Appellant’s reliance on *Enfish* does not provide support for not having to address the abstract ideas identified by the Examiner.

Moreover, claim 13 relates to routine data manipulation concepts, which have been identified by our reviewing court as abstract ideas. As noted by Appellant, “using categories to organize, store and transmit information” has been identified as an abstract idea. Appeal Br. 14 (citing

Cyberfone Sys. v. CNN Interactive Grp., 558 Fed. Appx. 988 (Fed. Cir. 2014) (non-precedential). Additionally, abstract ideas include the concepts of collecting data, recognizing certain data within the collected data set, and storing the data in memory. *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (“The concept of data collection, recognition, and storage is undisputedly well-known.”). Additionally, the collection of information and analysis of information (e.g., recognizing certain data within the dataset) are also abstract ideas. *Elec. Power*, 830 F.3d at 1353. Similarly, “collecting, displaying, and manipulating data” is an abstract idea. *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017).

Claim 13 is directed to “[a] non-transitory machine readable medium storing a program for sharing course material among a plurality of instructors in an online learning system.” Appeal Br. 22 (Claims App.). As claimed, “the program [is] executable by at least one processing unit[]” and “compris[es] sets of instructions.” *Id.* As such, claim 13 pertains to software. The recited steps for sharing the course material include “[a] receiving a request for searching for relevant course material for a first course taught by an instructor of the online learning system without receiving a search criteria.” *Id.* (emphasis added). Step “a” requires receiving a request for searching for data (relevant course material) without a user providing a search criteria.

Claim 13 also recites the step of “[b] identifying (i) courses having same objectives and requirements as the first course, (ii) courses linking to a same suggested learning material, and (iii) courses with enrolled student users searching for a same content as the content searched by students

enrolled in the first course.” *Id.* (emphasis added). Step “b” requires identifying other courses based on comparisons to “objectives and requirements” and “suggested learning material” for the first course, and the content searched by students enrolled in the first course. Accordingly, step “b” relates to the concepts of “recognizing certain data within [a] collected data set” and “data collection.” *See Content Extraction*, 776 F.3d at 1347.

Claim 13 further recites the step of “[c] *specifying the identified courses* as courses similar to the first course.” Appeal Br. 22 (Claims App. (emphasis added)). This step relates to the concept of labeling or categorizing collected data.

Claim 13 further recites the step of “[d] *searching for relevant course material for the first course* based on the courses identified as similar to the first course.” *Id.* (emphasis added). This step relates to the concept of comparing data to collected data.

Claim 13 also recites the steps of “[e] *providing a set of relevant course material items* found in the search sorted based on a set of ranking and assessment criteria” and “[f] *receiving an identification of a course material item* in the provided set of relevant course material items to share for teaching the first course.” *Id.* (emphasis added). Accordingly, step “e” relates to the concepts of analyzing data (*see Elec. Power*, 830 F.3d at 1353) and “manipulating data” (*Intellectual Ventures I LLC*, 850 F.3d at 1340). Step “f” relates to the concepts of transmitting and receiving data.

Finally, claim 13 recites the steps of “[g] *sending a request* to an owner of the identified course material item to authorize sharing of the identified course material item” and “[h] *allowing sharing of the identified course material* by the instructor for teaching the first course when an

authorization for sharing the identified course material items is *received from the owner.*” Appeal Br. 22 (Claims App. (emphasis added)).

Accordingly, steps “g” and “h” also relate to the concept of transmitting and receiving information, as well as to the concept of forming an agreement between parties, which is a fundamental economic practice. Thus, claim 13 relates to concepts that have been identified as abstract ideas in the cases cited above, and as determined by the Examiner.

We note that, “[i]n cases involving software innovations, [the *Alice* step 1] inquiry often turns on whether the claims focus 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.’” *Finjan, Inc. v. Blue Coat Systems, Inc.*, 879 F.3d 1299, 1303 (Fed. Cir. 2018) (citing *Enfish*, 822 F.3d at 1335–36). Appellant does not show that the claimed steps provide an improvement in the capabilities of the recited “at least one processing unit[],” rather than “[the at least one processing unit being] invoked merely as a tool” to execute the recited steps. *Id.*

For these reasons, we are not persuaded that the Examiner erred in finding that claim 13 is directed to several abstract ideas.

Alice Step 2

Regarding *Alice* step 2, Appellant contends that, even assuming the claims are directed to a judicial exception, the claims are still patent eligible because the claimed invention provides advantages that are neither well-understood, routine, nor conventional in the field. Appeal Br. 15–16. In support, Appellant substantially reproduces the features recited in claim 13,

and then asserts that such a method of sharing material for online courses is not well-understood, routine, or conventional. *Id.*

This contention is not persuasive. Appellant fails to explain what specific “advantages” are purportedly produced by the claimed subject matter. In addition, Appellant does not explain persuasively why any particular step, or any particular ordered combination of steps, is *not* well-understood, routine, or conventional. As discussed above with regard to *Alice* step 1, claim 13 recites features that relate to well-known data manipulation and agreement concepts.

The Examiner submits that “the ordered combination of these steps, while not being explicitly found in the prior art, does not represent an improvement to the computer or any technology or technological field.”

Ans. 4. Rather, the Examiner submits, “the claim utilizes a generic computer to perform a series of steps that may represent an improvement to the field of sharing course material among instructors. The field of developing and sharing educational material for courses existed in the pre-computer world, for instance through writing and selling paper textbooks.” *Id.*

In reply, Appellant characterizes the purported improvement as “an improved process for searching relevant course material.” Reply Br. 5. This does not explain persuasively how the claimed subject matter is an improvement with regard to other processes of searching for relevant course material, or identify which specific claim elements purportedly provide such improvement. Rather, this contention is effectively just a different way of saying that the claimed subject matter is an improved abstract idea, which is

insufficient to transform an abstract idea into patent-eligible subject matter. Accordingly, this contention is not persuasive.

Appellant also contends that the Specification discloses “specialized components, servers, and databases that are used to implement the claimed invention.” *Id.* (citing Spec. pp. 79–82, Fig. 40). According to Appellant, “the improvements are defined by specialized logical structures and processes.” *Id.* at 6.

This contention is not persuasive. Claim 13 recites no “specialized components, servers, [or] databases.” For example, the claim does not explicitly limit the processing units(s). We note that the Specification describes, for example, that electronic system 4100 may be, for example, “a desktop computer, personal computer, [or] tablet computer.” Spec. p. 83, ll. 3–5. Such “processing units” are considered as generic, not “specialized.” Nor does Appellant explain persuasively how the claim requires “specialized” databases, also where none are recited.

Appellant further contends that the Examiner has failed to consider the specific language of the claims, and has characterized the claimed method at a high level of abstraction. Reply Br. 6.

This contention is not persuasive. Appellant does not persuasively address the Examiner’s characterization of the claim as being related to different abstract ideas. Further, as discussed above, the claimed steps can be characterized as relating to well-known concepts for data manipulation, including collecting, recognizing, organizing, sharing, and transmitting data, and to a contractual relationship for sharing course material items. We do not agree that this characterization of the claimed subject matter fails to consider the specific claim language.

Appellant further contends that the claimed invention amounts to significantly more than simply organizing and comparing data, but provides advantages not well-understood, routine, or conventional in the art. Reply Br. 7–8. In support, Appellant substantially reproduces features recited in claim 13 and asserts that “[s]uch a method of sharing material for online courses is not well-understood, routine, or conventional.” *Id.* at 8.

This contention does not explain persuasively why the claimed subject matter is more than well-understood, routine, or conventional. Claim 13 merely utilizes “at least one processing unit[]” to execute the recited steps of the program and does not recite any additional elements that transform the nature of the claim into a patent-eligible application. *Alice*, 134 S. Ct. at 2355.

Appellant also contends that the claims do not preempt all uses of a judicial exception and, particularly, “all uses of sharing course material among a plurality of instructors in an online learning system.” Appeal Br. 16–17. Rather, Appellant contends, the claims only recite “a very narrow and particular method of sharing course material among a plurality of instructors in an online learning system.” *Id.* at 16. Appellant contends that “there are many other references already in the same field of art with earlier filing dates and the current application has no way of preempting all uses of the alleged judicial exception,” and the claims do not preempt any future use of a judicial exception. *Id.* at 17. The Examiner responds that “pre-emption is not a stand-alone test of patent eligibility.” Ans. 4. In reply, Appellant acknowledges that “preemption may not be a stand-alone test for eligibility,” but it has an important role to play in the analysis. Reply Br. 9.

We are not persuaded by Appellant’s argument. 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).

Appellant also contends, “although sharing course material has been done by humans, the recited method of identifying and sharing the course material is not done by humans in the past.” Appeal Br. 17–18. Appellant asserts that the Examiner has not cited any reference that discloses the recited method has been performed without the use of a computer or machine. *Id.* at 18.

This contention is not persuasive. “[A]nalyzing information by steps people [can] go through in their minds, or by mathematical algorithms, without more [are] mental processes within the abstract-idea category.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146 (Fed. Cir. 2016) (quoting *Elec. Power*, 830 F.3d at 1354). The Examiner determines that the recited steps *could be done* without a computer, that is, “by a person using for example a pen and paper.” Final Act. 3. Appellant does not provide any persuasive reason why the Examiner’s position is in error. Appellant acknowledges that humans have shared course material in the past. Appeal Br. 17–18. Claim 13 does not limit the number of courses from which the “identified courses” are identified, or limit the type or amount of “relevant course material” associated with the “identified courses.” Even if using the “at least one processing unit[]” rather than “a pen and paper” would allow the recited steps to be executed more efficiently, or using more data, for example, we are not persuaded that the

use of such generic processing tools transforms the claim into patent-eligible subject matter.

For the foregoing reasons, we sustain the rejection of claim 13 as being directed to patent ineligible subject matter. Claim 31 falls with claim 13.

Claims 22, 25, 26, 28, 29, 35, 38, 39, 41, and 42

Appellant essentially reproduces the language of a representative set of these claims (i.e., claims 35, 38, 39, and 41) and then contends that the dependent claims strengthen the argument presented for claims 13 and 31. Appeal Br. 18–21. The Examiner responds that the limitations in the dependent claims merely further limit the judicial exceptions embodied in claims 13 and 31. Ans. 5.

Appellant’s contentions are not persuasive. To the extent the features of respective representative claims have been pointed out, this is considered no more than a general allegation of patentability and is not considered a separate argument for patentability. *See* 37 C.F.R. § 41.37(c)(1)(iv) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”); *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and naked assertion that the corresponding elements were not found in the prior art.”). Accordingly, we sustain the rejection of dependent claims 22, 25, 26, 28, 29, 35, 38, 39, 41, and 42 as being directed to patent ineligible subject matter.

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DECISION

We affirm the rejection of claims 13–16, 22–29, and 31–42.

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