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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/922,786	06/20/2013	Theodore Allen Goldman	20121573USNP/166552.40501	9404
145893	7590	06/28/2018	EXAMINER	
FOX ROTHSCHILD LLP / CONDUENT PRINCETON PIKE CORPORATE CENTER 997 LENOX DRIVE BLDG. #3 LAWRENCEVILLE, NJ 08648			BRINDLEY, BENJAMIN S	
			ART UNIT	PAPER NUMBER
			3697	
			NOTIFICATION DATE	DELIVERY MODE
			06/28/2018	ELECTRONIC

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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* THEODORE ALLEN GOLDMAN

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Appeal 2017-001414  
Application 13/922,786<sup>1</sup>  
Technology Center 3600

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Before JOSEPH L. DIXON, SCOTT E. BAIN, and  
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

BAIN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–19, which constitute all claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> Appellant identifies Xerox Corporation as the real party in interest. App. Br. 3.

## STATEMENT OF THE CASE

### *The Claimed Invention*

The claimed invention relates to systems and methods for financial planning and, specifically, retirement planning. Spec. ¶¶ 1–2. Claims 1, 10, and 11 are independent. Claim 1 is illustrative of the invention and the subject matter of the appeal, and reads as follows:

1. *A retirement income management system, comprising:*

a retirement planning system, the planning system being in electronic communication with an employer's employee information system via a networking device, wherein the employee information systems [sic] comprises one or more first processors, wherein the retirement planning system comprises one or more second processors, at least one computer-readable memory, and programming instructions that are configured to instruct one or more of the second processors to:

receive an employee's age and current salary information from one or more of the first processors of the employee information system;

determine a retirement age and payout period for the employee;

use the employee's age, current salary information, retirement age and payout period to determine a target retirement account value for a retirement account of the employee at the employee's retirement age;

use the target retirement account value and the current salary information to determine a periodic contribution amount for the employee, wherein the periodic contribution amount is an amount that, if the employee makes periodic retirement account contributions that equal at least the periodic contribution amount through retirement age at a default growth rate for

the retirement account, will result in the employee's retirement account reaching the target retirement account value at the employee's retirement age; and

send, to one or more first processors of the employer's employee information system without a requirement for any intervening command or approval by the employee, an instruction to make contributions to a retirement account for the employee in the employer's retirement plan *by automatic payroll deduction* of the periodic contribution amount for the employee.

Br. 22 (Claims App.) (emphasis added).

#### *The Rejections on Appeal*

Claims 1–19 are rejected under 35 U.S.C. § 101 as directed to ineligible subject matter. Final Act. 2–5.

Claims 1–8 and 10–18 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Dunne et al. (US 2014/0032444 A1, published Jan. 30, 2014) (“Dunne”), Stiff et al. (US 2012/0072371 A1, published Mar. 22, 2012) (“Stiff”) and Joao (US 2011/0119094 A1, published May 19, 2011). Final Act. 5–25.

Claims 9 and 19 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Dunne, Stiff, Joao, and Abrahamson (US 8,060,428 B1, Nov. 15, 2011). Final Act. 25–28.

#### ANALYSIS

We have reviewed the Examiner's rejections in light of Appellant's arguments presented in this appeal. Arguments which Appellant could have made but did not make in the Brief are deemed to be waived. *See* 37 C.F.R.

§ 41.37(c)(1)(iv). On the record before us, we are not persuaded the Examiner erred. We adopt as our own the findings and reasons set forth in the rejections from which the appeal is taken and in the Examiner’s Answer, and provide the following discussion for highlighting and emphasis.

*Rejection Under 35 U.S.C. § 101*

Appellant argues the Examiner erred in rejecting the claims as directed to ineligible subject matter, namely, the abstract idea of retirement income management.<sup>2</sup> App. Br. 10–11; Ans. 2–3. Appellant contends the Examiner’s explanation consists “simply [of] *Alice* buzzwords” and does not adequately identify the alleged abstract idea. *Id.* Appellant further argues that even if the claims include an abstract idea, they also require “significantly more than just the abstract idea.” *Id.* at 13–14. We, however, are not persuaded the Examiner erred.

Section 101 of the Patent Act provides “[w]hoever 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. The Supreme Court has long held that this provision contains an implicit exception: “[l]aws 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*

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<sup>2</sup> Appellant argues all claims as a group, and we choose claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(iv).

*Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589–90 (2013)). The Court has set forth a two-part inquiry to determine whether this exception applies. First, we must “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Alice*, 134 S. Ct. at 2355 (citation omitted). Second, if the claims are directed to one of those patent-ineligible concepts, we 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.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 77–78 (2012)). Put differently, we must search the claims for an “inventive concept,” that is, “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 (quoting *Mayo*, 566 U.S. at 72–73).

Regarding step one of the *Alice* analysis, as the Examiner finds, the claims are directed to “retirement income management,” which is a fundamental economic practice. Ans. 2. The claims recite receiving information about an employee and the employee’s financial status, and processing that information to determine a financial “contribution” or “payroll deduction.” App. Br. 22. Such data gathering and manipulation encompasses an abstract idea. *See, e.g., Elec. Power Grp. LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent-ineligible

concept”). Moreover, fundamental economic and business practices are abstract ideas, even if performed on a computer. *See, e.g., OIP Techs. Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015).

Appellant argues the claims “require a specific retirement income management system and computer-based method of managing retirement income.” App. Br. 12. This conclusory statement, however, does not explain what “specific” aspects of the claimed invention allegedly are non-abstract. We, like the Examiner, do not find any on the record before us.

In the Reply Brief, Appellant compares the claims to those at issue in *McRO*, *Enfish*, and *Bascom*. Reply Br. 5–8 (citations omitted). None of those cases, however, involved claims directed to a fundamental economic practice as the present claims are. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016) (self-referential database that improved the way computers operate); *Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016) (“harness[ing] technical feature of network technology in a filtering system” to customize content filtering); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (“specific . . . improvement in computer animation” for “achieving automated lip-synchronization,” using “unconventional rules that relate[d] sub-sequences of phonemes, timings, and morph weight sets”). We are not persuaded *McRO*, *Enfish*, or *Bascom* support Appellant’s arguments.

Accordingly, Appellant has not persuaded us of error in the Examiner’s analysis under *Alice* step one, and we proceed to step two.

In the second step of our analysis under *Alice*,

we must examine the elements of the claim to determine whether it contains an “inventive concept” sufficient to “transform” the claimed abstract idea into a patent-eligible application. A claim that recites an abstract idea must include “additional features” to ensure “that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].”

*Alice*, 134 S. Ct. at 2357 (internal citations omitted). Appellant argues the claims add “meaningful limitations” to the alleged abstract idea of retirement financial planning. App. Br. 14. Specifically, Appellant argues the claims “require a retirement planning system that is in electronic communication with an employer’s employee information system via a network device,” and “includes one or more processors,” which Appellant argues are not generic. *Id.*

Appellant, however, has not explained how the recited “electronic communication” and processing are performed by anything more than generic computing elements. We, like the Examiner, find Appellant’s invention is performed by standard, generic data-processing and network elements (as described, for example, in the Specification at paragraphs 23–26). Ans. 5–7. The use of such generic computing elements “do[es] not alone transform an otherwise abstract idea into patent-eligible subject matter.” *FairWarning, IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1096 (Fed. Cir. 2016) (citing *DDR Holdings, LLC, v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014)); Ans. 3. Accordingly, Appellant does not persuade us the Examiner erred in the second step of the *Alice* analysis.

For the foregoing reasons, we sustain the rejection of claims 1–19 as directed to ineligible subject matter.

*Rejections Under 35 U.S.C. § 103(a)*

Appellant argues the Examiner erred in finding the prior art teaches or suggests sending an instruction “to make contributions to a retirement account for the employee in the employer’s retirement plan *by automatic payroll deduction* of the periodic contribution amount for the employee,” as recited in claim 1.<sup>3</sup> App. Br. 13–18 (emphasis added). Specifically, Appellant argues Dunne “fails to teach or suggest sending an instruction to *make contributions to a retirement account* for an employee in an employer’s retirement plan,” and Stiff does not teach or suggest “automatic payroll deduction” of a periodic contribution amount. *Id.* at 16–17 (emphasis added). Appellant further argues Joao does not resolve these alleged deficiencies. *Id.* at 17. We, however, are not persuaded by Appellant’s arguments.

The Examiner relies not on any of the references alone as teaching or suggesting the disputed limitation, but rather relies on the combined teachings of Joao, Dunne and Stiff. Ans. 9–10. As the Examiner finds, Joao teaches an employer computer system communicating with a retirement benefits system through a central processing system. Ans. 10; Joao Abs., Fig. 1. Dunne teaches “automatic” enrollment in an employee retirement account, and Stiff teaches a defined retirement contribution plan with contributions by “payroll deduction” of preestablished amounts or

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<sup>3</sup> Appellant argues independent claims 1, 10, and 11 as a group (App. Br. 15, 20), and we choose claim 1 as representative. 37 C.F.R. § 41.37(c)(iv).

percentages. Ans. 9–10 (citing Dunne ¶¶ 35, 51, 59, 72, 86, 88; Stiff ¶¶ 111–112). Appellant’s arguments do not explain any alleged error in the Examiner’s findings regarding the *combined* teachings of the references, and we discern none on the record before us. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.”). Appellant further does not challenge the Examiner’s rationale in combining the references, and we discern no error in the rationale. Final Act. 8–9.

Accordingly, we are not persuaded the Examiner erred in rejecting independent claims 1, 10, and 11.

Appellant argues dependent claim 2 separately, contending the Examiner erred in finding Dunne teaches using “the revised salary information to determine a new periodic contribution amount,” as recited in claim 2. App. Br. 19. We disagree. As the Examiner finds, Dunne Figure 2 identifies “Forecast Average Wage Increases” as an “Input” to a retirement contribution plan. Ans. 10–11. The accompanying disclosures in Dunne describe utilizing that forecast, i.e., “revised salary information” to determine change in deferral amount. Final Act. 9 (citing Dunne ¶¶ 80, 84, 85). For the reasons discussed above (in reference to base claim 1), the foregoing passages of Dunne, combined with Joao and Stiff, teach or suggest the disputed claim limitation. Appellant’s arguments regarding the remaining limitation of claim 2, which are not argued with any specificity (App. Br. 18), do not persuade us of error for the same reasons.

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Accordingly, we are not persuaded of error regarding dependent claim 2. Appellant does not argue any of the remaining claims separately. We, therefore, sustain the Examiner's obviousness rejections of claims 1–19.

#### DECISION

We affirm the Examiner's decision rejecting claims 1–19.

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. § 41.50(f).

AFFIRMED