



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
11/187,310 07/22/2005 Gillian Jetson Tarinelli EXIN.106A 8990

20995 7590 07/03/2018
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614
UNITED STATES OF AMERICA

EXAMINER

AIRAPETIAN, MILA

ART UNIT PAPER NUMBER

3625

NOTIFICATION DATE DELIVERY MODE

07/03/2018

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jayna.cartee@knobbe.com
efiling@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GILLIAN JETSON TARINELLI, PHILLIP LLOYD DUNHAM,
SUNIL SITAULA, and ALDEN ALMAGRO

Appeal 2017-001433
Application 11/187,310¹
Technology Center 3600

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

BAIN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1, 8–10, and 52–56, and 59–65, which constitute all claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellants identify Orbitz, LLC as the real party in interest. App. Br. 2.

STATEMENT OF THE CASE

The Claimed Invention

The claimed invention relates to online purchase of travel-related products. Spec. ¶¶ 1, 4. According to the Specification, consumers may find the “requirement of creating a registration account” when making online travel purchases to be “time-consuming and undesirable,” and therefore consumers may abandon the purchase before it is completed. *Id.* ¶ 4. Appellants’ invention is an “improved guest registration” process and system for the online purchase of travel products. *Id.* ¶¶ 1, 4. Claims 1 and 65 are independent. Claim 1 is representative of the invention and the subject matter of the appeal, and reads as follows:

1. A method, implemented on a purchase application server, comprising:

receiving user identifying information from a user during an on-line purchasing process;

utilizing the user identifying information to determine whether or not the user has made prior product purchases via the host website;

establishing a new member registration account, on the purchase application server, if the user has not made prior purchases via the host website and storing the user identifying information in the new member registration account;

identifying an existing member registration account associated with the user if the user has made prior product purchases via the host website;

completing a product purchase; and

storing information regarding the new product purchase in one of the existing member registration account and the new registration account without the user having authenticated.

App. Br. 19 (Claims App’x) (emphases added).

The Rejections on Appeal

Claims 1, 8–10, and 52–56, and 59–65 are rejected under 35 U.S.C. § 101 as directed to ineligible subject matter. Final Act. 3–5; Ans. 3.

ANALYSIS

We have reviewed the Examiner’s rejection in light of Appellants’ arguments presented in this appeal. Arguments which Appellants 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 rejection 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

The Examiner rejects the claims as being directed to the abstract idea of using prior purchase information in an online purchasing process, which is both a “fundamental economic practice” and “method of organizing human activity.” Final Act. 3–4; Ans. 3. Appellants argue the Examiner erred because, even if the claims encompass an abstract idea, they “contain significantly more than the alleged abstract idea.”² App. Br. 12. We, however, are not persuaded of error.

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

² Appellants argue the claims as a single group, and we choose claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(iv).

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 Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589–590 (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, Appellants offer no arguments. App. Br. 12. Although Appellants contend they do not “conced[e]” the “accuracy” of the Examiner’s analysis regarding step one, Appellants do not identify any error in the Examiner’s determination that the claims are directed to an abstract idea, and we discern none on the record

before us. *Id.*; Final Act. 3–4. Accordingly, we proceed to step two of *Alice*.

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). Appellants argue the steps in claim 1 of “utilizing the user identifying information,” “establishing a new member registration account” under certain conditions, “identifying an existing member registration account” under certain conditions, and “storing information regarding the new product purchase” are “not routine or conventional to the on-line purchasing process” and therefore add something more to the abstract idea. App. Br. 13–14. Further, Appellants argue there is “no pre-Internet analog” for the process recited in the claims. *Id.* at 14.

As the Examiner finds (Ans. 3–4), however, Appellants’ claimed methods are carried out by “generic computer components.” Spec. ¶¶15–17 (describing generic, conventional computing elements). The use of generic computer components “do 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)); *see also Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (claims reciting “generalized software components arranged to implement an abstract concept [] on a computer” not patent eligible).

Moreover, we, like the Examiner, do not find the claims add improvements of a technical nature, such as those found to be patent eligible in *DDR Holdings*. Ans. 4–5; Reply Br. 3–5. We further agree with the Examiner’s finding that (absent the conventional “on-line” elements), the claimed methods could be carried out without “technology” at all, because elements such as “account,” “storing,” “purchase,” and “registration” simply describe basic sales transaction techniques. Ans. 4 (citing Spec. ¶ 25). Thus, contrary to Appellants’ argument, the claims are not directed to a problem that arises specifically in the context of computer networks. *Id.*

We are also unpersuaded by Appellants’ argument that the claims do not preempt the alleged abstract idea of “on-line purchasing.” App. Br. 15–16. Although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *FairWarning IP*, 839 F.3d at 1098 (quoting *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.”). Where, as here, “a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework . . . preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics*, 788 F.3d at 1379.

Finally, in the Reply Brief, Appellants argue that the claims are similar to those found not to constitute an abstract idea in *Enfish* and *McRO*. Reply Br. 2–3 (citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d

1299, 1312 (Fed. Cir. 2016)). Appellants, however, do not describe any advance in hardware or software that allows a computer to operate faster or more efficiently, as in *Enfish*. See *Enfish*, 822 F.3d at 1330–33, 1336 (claims “directed to a specific improvement to the way computers operate, embodied in the self-referential table”). Nor do Appellants identify any improvement in a technological process, as in *McRO*. *McRO*, 837 F.3d at 1299 (claims directed to a particular “technological improvement over the existing, manual 3–D animation techniques”). Appellants’ claims, in contrast, relate essentially to data gathering. 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”); see also *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016).³

Accordingly, for the foregoing reasons, we sustain the rejection of claims 1, 8–10, 52–56, and 59–65 as directed to ineligible subject matter.

DECISION

We affirm the Examiner’s decision rejecting claims 1, 8–10, and 52–56, and 59–65.

³ Appellants also briefly assert that “automatically generating a password,” as recited in dependent claim 9, further adds something more to the abstract idea, but this argument is unpersuasive for the same reasons discussed as to claim 1.

Appeal 2017-001433
Application 11/187,310

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