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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/435,812	03/30/2012	James Schronrock	LEG-001-US1	4254
90879	7590	05/23/2018	EXAMINER	
Thomson Reuters c/o Intellectual Property 3 Times Square New York, NY 10036			SCHEUNEMANN, RICHARD N	
			ART UNIT	PAPER NUMBER
			3624	
			NOTIFICATION DATE	DELIVERY MODE
			05/23/2018	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES SCHRONROCK and ELLE MASON

Appeal 2017-002331
Application 13/435,812¹
Technology Center 3600

Before BRADLEY W. BAUMEISTER, HUNG H. BUI, and
MICHAEL M. BARRY, *Administrative Patent Judges*.

BUI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) from the Examiner’s Final Rejection of claims 1, 2, 4–10, and 12–16, which are all of the claims pending in the application. Claims App’x. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.²

¹ According to Appellants, Thomson Reuters Global Resources is the real party in interest. App. Br. 2.

² Our Decision refers to Appellants’ Appeal Brief filed March 28, 2016 (“App. Br.”); Examiner’s Answer mailed September 22, 2016 (“Ans.”); Final Office Action mailed March 12, 2015 (“Final Act.”); and original Specification filed March 30, 2012 (“Spec.”).

STATEMENT OF THE CASE

Appellants' invention relates to a "system, method and interface for evaluating a lead," where "[a] lead is an individual or organization that expresses interest in a firm's goods or services." Spec. 1:9–10, 18–19.

Claims 1 and 9 are independent. Claim 1 is illustrative of Appellants' invention, reproduced below with disputed limitations in *italics*:

1. A lead evaluation system comprising:
 - a processor;
 - a memory coupled to the processor; and
 - a lead evaluation module stored in the memory for execution by the processor, the lead evaluation module comprising:
 - a lead management module, the lead management module configured to receive a set of lead information associated with a lead;
 - a case evaluator module, the case evaluator module configured to generate a case evaluation associated with the set of lead information;
 - an additional information module, the additional information module configured to *automatically retrieve a set of additional information* using a subset of the set of lead information associated with the lead;
 - a notification module, the notification module configured to generate a notification when a set of criteria is satisfied, the set of criteria being associated with meeting or exceeding a threshold associated with the set of lead information, the case evaluation and the set of additional information, the notification adapted for use by a professional; and
 - a delivery module, the delivery module configured to:
 - generate a display signal associated with the set of lead information, the case evaluation, the set of additional information and the notification to the professional; and
 - transmit the display signal.

App. Br. 6 (Claims App'x).

Examiner's Rejections and References

(1) Claims 1, 2, 4–10, and 12–16 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to a judicial exception to statutory subject matter. Final Act. 4–6.

(2) Claims 1, 2, 4, 5, 7, 9, 10, 12, 13, and 15 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Dodell et al. (US 2006/0229999 A1; published Oct. 12, 2006) and Arni et al. (US 2011/0082721 A1; published Apr. 7, 2011). Final Act. 6–13.

(3) Claims 6 and 14 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Dodell, Arni, and Heckman et al. (US 5,875,431; issued Feb. 23, 1999). Final Act 13–15.

(4) Claims 8 and 16 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Dodell, Arni, and Ring (US 2009/0204418 A1; published Aug. 13, 2009). Final Act. 15–17.

ANALYSIS

35 U.S.C. § 101: Claims 1, 2, 4–10, and 12–16

In *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014), the Supreme Court has set forth an analytical “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71–73 (2012)). In the first step of the *Alice/Mayo*

analysis, we determine whether the claims at issue are “directed to” a judicial exception, such as an abstract idea. *Alice*, 134 S. Ct. at 2355. If not, the inquiry ends. *Thales Visionix Inc. v. U.S.*, 850 F.3d 1343, 1346 (Fed. Cir. 2017); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016). If the claims are determined to be directed to an abstract idea, then we consider under the second step of the *Alice/Mayo* analysis the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 566 U.S. at 79, 78). In other words, the second step is to “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.* (citing *Mayo*, 566 U.S. at 72–73).

In rejecting independent claims 1 and 9, and their dependent claims 2, 4–8, 10, and 12–16, the Examiner determines (1) the claims are directed to “[an] abstract idea of evaluating leads [e.g., an individual or organization that expresses interest in a firm’s goods or services]” (*i.e.*, a fundamental economic practice as a type of methods of organizing human activity) and that (2) the additional elements in the claim do not amount to significantly more than the abstract idea because (i) these “claims do not recite an improvement to another technology or technical field, nor do they recite an improvement to the functioning of the computer itself” and (ii) these “claims require no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry.” Final Act. 5–6.

Alice/Mayo—Step 1

Turning now to the first step of the *Alice* inquiry, Appellants argue the claims are not directed to “an abstract idea” because the Examiner ignores

the transformative activities claimed that could not be undertaken by a human, including for example, generating, using a lead evaluation module, a case evaluation associated with the set of lead information, retrieving, automatically using the lead evaluation module, a set of additional information using a subset of the set of lead information associated with the lead and generating, using the lead evaluation module, a notification when a set of criteria is satisfied, the set of criteria being associated with meeting or exceeding a threshold associated with the set of lead information, the case evaluation and the set of additional information, the notification being adapted for use by a professional.

App. Br. 5–6.

Appellants’ argument is not persuasive. The title of Appellants’ Specification provides the invention is directed to “system, method, and interface for evaluating a lead [i.e., an individual or organization that expresses interest in a firm’s goods or services].” Spec. 1:9–10, 18–19. The Specification further provides embodiments for evaluating a case based on lead information and then notifying a professional when a set of criteria is satisfied. *See* Fig. 2. Thus, we agree with the Examiner (Ans. 2) that the claims are directed to an abstract idea of evaluating leads, which is a fundamental economic practice.

Such activities are squarely within the realm of abstract ideas. The evaluation of lead information to assess the strength of a case is a fundamental business practice long prevalent in our system of commerce, like (1) risk hedging in *Bilski v. Kappos*, 561 U.S. 593 (2010), (2)

intermediated settlement in *Alice*, 134 S. Ct. at 2356–57, (3) verifying credit card transactions in *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011), (4) collecting and analyzing information to detect and notify of misuses in *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016), and (5) guaranteeing transactions in *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1354 (Fed. Cir. 2014)). Evaluating a lead (e.g., an individual or organization that expresses interest in a firm’s goods or services) is also a building block of a market economy. Thus, evaluating a lead, like risk hedging, intermediated settlement, and verifying credit card transactions, is an “abstract idea” beyond the scope of § 101. *See Alice*, 134 S. Ct. at 2356.

As also recognized by the Examiner, evaluating a lead (e.g., an individual or organization that expresses interest in a firm’s goods or services) could be performed in the human mind, or could be performed manually using, at most, a pen and paper, without need of any computer or other machine to determine whether the lead is worth pursuing. *See CyberSource*, 654 F.3d at 1372–73 (“[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.”); *see also In re Comiskey*, 554 F.3d 967, 979 (Fed. Cir. 2009) (“[M]ental processes—or processes of human thinking—standing alone are not patentable even if they have practical application.”); *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (“Phenomena of nature . . . , *mental processes*, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work” (emphasis added)).

Additionally, mental processes remain unpatentable even when automated to reduce the burden on the user of what once could have been

done with pen and paper. *CyberSource*, 654 F.3d at 1375 (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*.”). For example, the claimed “case evaluation associated with the set of lead information” could be determined by a person (e.g., paralegal or law clerk) receiving a set of lead information associated with a lead, and then using a set of additional information to notify a professional (e.g., a lawyer).
Spec. 3:16–4:2, Fig. 2.

In the Reply, Appellants argue “the simple fact that a task can be performed by a human is not enough to render a claim that recites a task patent ineligible, a notion that has been confirmed in the recent Federal Circuit decision, *McRO, Inc. dba Planet Blue v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016). Reply Br. 3.

Appellants’ reliance on the proposition that “processes that automate tasks that humans are capable of performing are patent eligible if properly claimed” is unavailing. *Id.* Unlike Appellants’ claims, *McRO*’s claims are not directed to an “abstract idea” because *McRO*’s claims contain (i) specific limitations regarding a set of rules and, when viewed as a whole, are directed to (ii) a “technological improvement over the existing, manual 3–D animation techniques” that uses “limited rules in a process specifically designed to achieve an improved technological result in conventional industry practice.” *McRO*, 837 F.3d at 1315.

In contrast to *McRO*, Appellants’ claims are directed to evaluating leads, which is both (1) “a fundamental economic practice” identified as an “abstract idea” by the Supreme Court in *Bilski* and *Alice*, and (2) “mental steps” identified as an abstract idea by the Supreme Court in its earlier

trilogy of *Benson* (*Gottschalk v. Benson*, 409 U.S. 63 (1972)), *Flook* (*Parker v. Flook*, 437 U.S. 584 (1978)), and *Diehr* (*Diamond v. Diehr*, 450 U.S. 175 (1981)).

Accordingly, Appellants do not persuade us the Examiner erred in finding the claims are directed to a patent-ineligible abstract idea.

Alice/Mayo—Step 2

In the second step of the *Alice* inquiry, Appellants argue the claims recite “significantly more” than the abstract idea and contain “an improvement to a technical field.” App. Br. 6–8. Appellants’ argument are unpersuasive. Rather, we agree with the Examiner that “evaluating leads is not rooted in computer technology.” Ans. 2.

In addition, we note (1) the steps of receiving a set of lead information, evaluating, retrieving, and notifying recited in Appellants’ independent claims 1 and 9 are executed on generic computer components (e.g., processor, memory, and various modules); (2) these generic computer components do not add significantly more than the abstract idea and when viewed either individually, or as an ordered combination, the additional limitations do not amount to a claim as a whole that is significantly more than the abstract idea; and (3) [t]here is no inventive concept recited. Appellants have not directed our attention to anything in the record that shows specialized computer hardware is required. Nor have Appellants shown how the claims are performed such that they are not routine, conventional functions of a generic computer. *See Alice*, 134 S. Ct. 2358 (“the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.”)

Appellants also argue their claims are similar to those in *DDR Holdings, LLC v. Hotels.com*, 773 F.3d 1245 (Fed. Cir. 2014), because “the combination of steps recited . . . are a specific new combination of steps rooted in computer technology to achieve the recited result.” App. Br. 7–8. We disagree. Contrary to Appellants’ arguments, claims 1, 2, 4–10, and 12–16 do not recite a specific improvement to the way computers operate, and Appellants do not present evidence to establish these claims recite a specific improvement to the computers. *See Enfish*, 822 F.3d at 1336, 1339. Appellants also have not demonstrated their claims are akin to an “improve[ment] to the way a computer stores and retrieves data in memory,” as the claims in *Enfish* were via the recited requirements for a “self-referential table for a computer database” (*see id.* at 1339).

In fact, none of the steps and elements recited in Appellants’ claims provides, and nowhere in Appellants’ Specification can we find, any description or explanation as to how the claimed evaluating a lead (e.g., an individual or organization that expresses interest in a firm’s goods or services) is intended to provide: (1) a “solution . . . necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks,” as explained by the Federal Circuit in *DDR Holdings*, 773 F.3d at 1257; (2) “a specific improvement to the way computers operate,” as explained in *Enfish*, 822 F.3d at 1336; or (3) an “unconventional technological solution . . . to a technological problem” that “improve[s] the performance of the system itself,” as explained in *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1300, 1302 (Fed. Cir. 2016).

Because Appellants' claims 1, 2, 4–10, and 12–16 are directed to a patent-ineligible abstract concept, and do not recite something “significantly more” under the second prong of the *Alice* analysis, we sustain the Examiner's rejection of these claims under 35 U.S.C. § 101 as being directed to non-statutory subject matter in light of *Alice* and its progeny.

35 U.S.C. § 103(a): Claims 1, 2, 4–10, and 12–16

In support of the rejection of independent claim 1 and, similarly, claim 9, the Examiner finds Dodell teaches Appellants' claimed “lead evaluation system” including all the claim limitations, except for an express disclosure of “a notification module . . . to generate a notification when a set of criteria is satisfied.” Final Act. 6–7 (citing Dodell ¶¶ 1, 6, 27–32, 38–39, 103–106, 140–149, Figs. 4A–4C).

The Examiner relies on Arni for teaching the missing feature, i.e., the notification module . . . to generate a notification when a set of criteria is satisfied, and determines the combination supports the conclusion of obviousness. Final Act. 7 (citing Arni ¶ 66).

Appellants do not dispute the Examiner's factual finding regarding Arni. Nor do Appellants challenge the Examiner's rationale to combine Dodell and Arni. Instead, Appellants argue Dodell does not teach or suggest the following disputed limitations of claims 1 and 9:

1. “automatic” retrieval of additional information; and
2. “the set of criteria being associated with meeting or exceeding a threshold associated with the set of lead information, the case evaluation and the set of additional information.”

App. Br. 11–12.

In particular, Appellants argue Dodell’s retrieval of additional information or documents requires “human interaction” and is, therefore, not “automatic.” App. Br. 11. In addition, Appellants acknowledge Dodell teaches the use of scores to assign the lead when a certain threshold is met, but argue that “Dodell, however, makes no mention of its operational phase scoring being associated with any criteria akin to the claimed ‘the set of criteria being associated . . . with the set of lead information, the case evaluation and the set of additional information.’” App. Br. 12.

Appellants’ arguments are unpersuasive. Instead, we find the Examiner has provided a comprehensive response to Appellants’ arguments supported by a preponderance of evidence. Ans. 3–4. As such, we adopt the Examiner’s findings and explanations provided therein. *Id.* For additional emphasis, we note (1) Dodell’s computer system is configured to perform automated steps, including the retrieval of information (*see* Dodell ¶¶ 131–133, 140–149), and (2) Dodell’s score is based on lead information and, if the score is above a threshold, the case is accepted for further consideration (*see* Dodell ¶¶ 85–87).

Based on this record, we are not persuaded of Examiner error. Accordingly, we sustain the Examiner’s obviousness rejection of independent claims 1 and 9 and their respective dependent claims 2, 4–8, 10, and 12–16, which Appellants do not argue separately. App. Br. 13.

CONCLUSION

On the record before us, Appellants have not demonstrated the Examiner erred in rejecting claims 1, 2, 4–10, and 12–16 under 35 U.S.C. §§ 101 and 103(a).

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DECISION

As such, we AFFIRM the Examiner's final rejection of claims 1, 2, 4–10, and 12–16 under 35 U.S.C. §§ 101 and 103(a).

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