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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK GREENSTEIN and BRIAN TARBOX

Appeal 2017-002346
Application 10/492,205¹
Technology Center 3600

Before MICHAEL J. STRAUSS, ADAM J. PYONIN, and
NABEEL U. KHAN, *Administrative Patent Judges*.

PYONIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from a final rejection of claims 101–115, which are all of the pending claims. *See* App. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

STATEMENT OF THE CASE

Introduction

The Application is directed to “assisting in the purchase or lease of products or services which may consider various factors including quality,

¹ The real party in interest is identified as Mark Greenstein. App. Br. 1.

price and convenience in a manner that is free from or ameliorates the traditional conflicts of interest.” Abstract. Claims 101, 108, and 115 are independent. Claim 101 is reproduced below for reference:

101. A method for providing recommendations, over the internet, regarding a purchase or lease of goods or services for at least one purchaser or lessor comprising the steps of:

receiving a request regarding the purchase or lease of goods or services;

storing the request in a computerized database;

providing data which is independent of at least one person who will profit depending on the decision of the purchaser or lessor;

retrieving from the database information necessary to process the request;

processing the request using software to present a recommendation, the software in a computer which accesses the data which is independent of the at least one person who will profit depending on the decision of the purchaser or lessor;

insuring,² using software in a computer, that the data used to arrive at the recommendation are originated by a person who is independent of at least one person who will profit depending on whether the at least one purchaser or lessor purchases or leases the goods or services; and

transmitting via a computer, over the internet, the recommendation by the at least one person who will profit depending on the decision concerning the purchase or lease of goods or services to at least one purchaser or lessor.

Claims Appendix, Response to Notification of Non-Compliant Appeal Brief, filed April 25, 2016.

² In the event of further prosecution, Appellants and the Examiner may wish to consider whether the claim term “insuring” should be replaced with the term “ensuring.” *See* Spec. 25:20–22; *see also, e.g.*, <https://www.merriam-webster.com/words-at-play/how-to-use-insure-vs-ensure-vs-assure> (last retrieved April 20, 2018).

*References and Rejections*³

Claim 108 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Final Act. 3–4.

Claims 101–115 stand rejected under 35 U.S.C. § 101 as not being directed to patentable subject matter. Final Act. 4–6.

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments. Any other arguments Appellants could have made but chose not to make are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). We are not persuaded the Examiner erred; we adopt the Examiner's findings and conclusions as our own, and we add the following primarily for emphasis.

A. 112 Rejection

Appellants do not challenge the Examiner’s rejection of claim 108 as being indefinite. Accordingly, we summarily affirm this rejection. *See Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (“[T]he Board will not, as a general matter, unilaterally review . . . uncontested aspects of the rejection.”).

B. 101 Rejection

Appellants do not separately argue the claims with respect to the Examiner’s patent eligibility rejection. *See* App. Br. 12–13. We select claim 101 as representative. *See* 37 C.F.R. §41.37(c)(1)(iv).

³ The Examiner has withdrawn the prior art rejections of record. *See* Ans. 3.

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: laws of nature, natural phenomena, and abstract ideas are not patentable. *See, e.g., Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014). The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1300 (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. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” e.g., to an abstract idea. *Alice*, 134 S. Ct. at 2355. If the claims are directed to a patent-ineligible concept, the inquiry proceeds to the second step, where the elements of the claims are considered “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 (quoting *Mayo*, 132 S. Ct. at 1297).

Appellants argue the Examiner erred in finding the claims are patent ineligible under 35 U.S.C. § 101, because the “[c]laim[s] were not directed to an[y] abstract ideas as they solve an internet-centric problem of trust and more specifically the manipulation of recommendations transmitted over the internet to benefit persons with a conflict of interest.” App. Br. 12.

Appellants do not persuade us the Examiner errs in finding claim 101 is directed to “the abstract idea of providing recommendations for the purchase or lease of goods or services for a purchaser or lessor,” which is “a

fundamental economic practice, as well as a method of organizing [human] activities.” Final Act. 6, 24. Claim 101 recites insuring that the recommendations are “originated by a person who is independent of at least one person who will profit.” Rather than being directed to a technical problem, claim 101 solves the business/legal/financial problems of conflicts of interest arising from facilitating transactions. *See, e.g.*, Spec. 6–7 (“systems and methods of the present disclosure eliminate or at least ameliorate possible economic conflict of interest,” by “separating or not separating advice and/or selection of products and/or services from those who benefit to varying degrees . . . in such a way that conflicts of interests are, if not eliminated, at least ameliorated.”). We agree with the Examiner that such concept is Abstract.⁴ *See* Final Act. 22; *see also Bilski v. Kappos*, 561 U.S. 593, 643 (2010) (“neither the Patent Clause, nor early patent law, nor the current § 101 contemplated or was publicly understood to mean that [better ways to conduct business] are patentable.”).

⁴ The Examiner’s position is supported by case law, as our reviewing court has held claims similarly directed to certain methods of fundamental economic practices and organizing human activities to be directed to abstract ideas. *See Buysafe, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (claims that “are squarely about creating a contractual relationship—a ‘transaction performance guaranty’” held as “directed to an abstract idea”); *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 [of generating insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer” not patent eligible); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) (the abstract idea of verifying credit card transactions); *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015) (holding the claimed tailoring content presented to a user based on particular information is abstract).

Appellants refer to publications showing “the importance of using technology reflected in the claims to a number of internet-business models,” as providing “evidence that the [claimed] solution is necessarily rooted in computer technology.” App. Br. 12. We have reviewed the submitted evidence and find it to be unpersuasive of Examiner error, because the claims are not directed to an internet-centric problem. *See* Final Act. 22–23. Claim 101 recites receiving a transaction request, processing data to present a recommendation originated by an independent party, and transmitting the recommendation. Such process could be performed by a “natural person” (Spec. 17) or generic computer “as is known to those skilled in the art” (Spec. 27–28), and “after Alice, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (Fed. Cir. 2014) (“use of the Internet does not transform an otherwise abstract idea into patent-eligible subject matter”).

Further, the problem of trustworthy recommendations pre-dates the internet. Appellants’ specification describes various existing methods of providing recommendations, including Consumer Reports. *See* Spec. 4, 15, 29. Consumer Reports was an outgrowth of Consumer’s Research, which was founded in 1927 to provide product reviews without conflicts of interest. *See* https://en.wikipedia.org/wiki/Consumers%27_Research (last retrieved April 20, 2018) (“this was a publication with the mission to investigate, test and report reliably ... hundreds of common commodities purchased” and would “accept no money or compensation of any kind from manufacturers, dealers, advertising agencies or other commercial

enterprises”) (quotations removed); *compare* Spec. 16 (“Payment for use of the systems and methods of the present disclosure may come from . . . any other means that generally would not materially compromise the integrity of the process.”).

Appellants’ arguments focus on the recitations of the internet in claim 101; however, Appellants do not identify ways in which the claim provides an improvement to the relevant technology. *See* App. Br. 12–13. Instead, we agree with the Examiner that “the instant claims provide a generically computer-implemented solution to a business-related or economic problem and are thus incomparable to the claims at issue in *DDR*.” Ans. 6; *see also DDR Holdings*, 773 F.3d at 1257 (Finding the claims at issue were “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.”); *compare* Spec. 13 (representative systems and representative methods . . . to assist individuals including consumers in the lease or purchase of products or services . . . [are] through a facilitator 14 which may be a natural person or a machine, such as, for example, a computer or equivalent.”).

Appellants argue “the operation of the claims transforms the recommendations into something functionally very different, which are claims that can be relied on, because, as stated by an expert above, if consumers can’t rely on the content, then the service is of no value.” App. Br. 12 (quotations omitted). Particularly, Appellants contend “the claims provide a . . . function of validating the validity and source of the recommendations, while adding a number of other limitations.” App. Br. 13. Appellants do not persuade us that validating recommendations transforms the nature of the claims. Rather, we find the limitations,

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including “insuring . . . independent of at least one person who will profit” are part of the abstract idea itself. We agree with the Examiner that claim 101 “do[es] not contain any limitations either individually or as an ordered combination that transform the claim[] into a patent eligible application.” Final Act. 22–23.

Accordingly, we are not persuaded the Examiner erred in finding claim 101 patent ineligible.

DECISION

The Examiner’s decision rejecting claims 101–115 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