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patent@alteralaw.com
jarmstrong@alteralaw.com
mlasky@alteralaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL A. MORGIA, PAT A. FONTANA JR.,
ALEX M. MORGIA, PAT A. FONTANA SR.,
RALPH E. ROLAND, SHAWN M. DAVIS,
MARK M. PIWOWARSKI, and JOHN P. GAUS

Appeal 2017-002496
Application 14/525,701
Technology Center 3700

Before MICHAEL L. HOELTER, PATRICK R. SCANLON, and
JEREMY M. PLENZLER, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal, under 35 U.S.C. § 134(a), from the Examiner's Final rejection of claims 21–36. App. Br. 1. Claims 1–20 have been canceled. *See* Amendment dated April 20, 2015. Appellants' counsel presented Oral argument on October 4, 2018. We have jurisdiction under 35 U.S.C. § 6(b). For the following reasons, we AFFIRM the Examiner's rejection under 35 U.S.C. § 101.

THE CLAIMED SUBJECT MATTER

The disclosed subject matter “is directed to a system and method of selection of a consensus from a collection of ideas.” Spec. ¶ 3. Claims 21, 35, and 36 are independent. Claim 21 is illustrative of the claims on appeal and is reproduced below.

21. An improved voting machine computer connected to a plurality of linked voting terminals capable of rating voting responses to a massive number of ideas while minimizing the effect of individual rater bias affecting overall ratings and with processing throughput being substantially time independent on the number of ideas to be rated, the number of ideas being numbered 1 to N, N being the last idea, the voting machine performing the following tasks:

a. in a first round, the voting computer electronically distributing a first universe of ideas, divided into idea sets, to a group of participants at said terminals, in parallel, wherein each participant at a terminal receives at least one idea set, and wherein the universe of ideas are divided so that the number of idea sets generally equals the number of participants and wherein each idea has a substantially equal and fair probability of being viewed and voted on by a generally equal number of participants;

b. receiving participant input at said terminals where each participant select from their idea set, via an input device, at least one highest ranking idea;

c. the voting computer having a threshold hurdle win rate which comprises a predetermined number against which said participant ranking for each idea are compared; segregating the ideas which exceed said predetermined number as winning ideas and creating a first subgroup of ideas which exceed said predetermined number;

d. in a second round, the voting computer electronically re-distributing the first subgroup of ideas divided into second idea sets to all participants at terminals in parallel wherein each participant receives at least one second idea set; wherein the universe of ideas are divided so that the number of second idea sets generally equals the number of participants and wherein

each idea has a substantially equal and fair probability of being viewed and voted on by a generally equal number of participants; whereby the number of ideas is reduced while the number of participants is generally not reduced, thereby more participants are applied to the remaining ideas;

e. receiving input at said terminals from participants selection from their second idea set, at least one highest ranking idea;

f. the voting computer having establishing a second threshold hurdle win rate which comprises a second predetermined number against which the participant rankings for each idea are compared; the voting computer segregating the ideas which exceed said second predetermined number as winning ideas and creating a second subgroup of ideas which exceed said second predetermined number;

wherein each of actions (a) and (d) comprises steps for dividing plurality of ideas into groups, each group of ideas to be distributed to each of a plurality of participants by;

the voting computer[,] using a sequence of integers method of assigning a sequence of idea numbers 1 to N distributing the ideas to said first sub-group into non-exclusive subsets

whereby the voting computer terminates further distribution to terminals and rating or proceeds to subsequent rounds of redistributing ideas to further increase the accuracy and throughput to find the group preferred idea and whereby effectively a large number of ideas is distillable by a mass participant group and the computer generates an output of a distilled consensus of ideas.

REFERENCES

Ferguson et al.	US 7,158,960 B2	Jan. 2, 2007
Jakobson	US 2007/0260996 A1	Nov. 8, 2007
Vander Mey et al.	US 7,519,562 B1	Apr. 14, 2009

THE REJECTIONS ON APPEAL

Claims 21–36 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 21–36 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 35 and 36 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention.

Claims 21–29, 31, 32, 35, and 36 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ferguson.

Claim 30 is rejected under 35 U.S.C. § 103(a) as unpatentable over Ferguson and Jakobson.

Claims 33 and 34 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ferguson and Vander Mey.

ANALYSIS

The rejection of claims 21–36 as being directed to non-statutory subject matter

Appellants argue claims 21–36 together, focusing primarily on independent claim 21. App. Br. 25–41. Throughout these arguments, Appellants also address independent claims 35 and 36 (*see* App. Br. 31, 32, 36) but acknowledge, “[e]ach of independent claims 35 and 36 recites elements similar or analogous to independent claim 21.” App. Br. 41. Accordingly, we select claim 21 for review, with the remaining claims standing or falling with claim 21. *See* 37 C.F.R. § 41.37(c)(1)(iv).

A patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement

thereof.” 35 U.S.C. § 101. The U.S. Supreme Court has “long held that this [statutory] provision contains an important implicit exception: Laws 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 *Association for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). Notwithstanding that a law of nature or an abstract idea, by itself, is not patentable, the practical application of these concepts may be deserving of patent protection. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293–94 (2012).

In *Alice*, the Supreme Court reaffirmed the framework set forth previously in *Mayo* “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 the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider 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.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1298, 1297).

It is not disputed that claim 21 pertains to “[a]n improved voting machine computer” with this “voting machine performing the following tasks” (such tasks being fully enumerated above). Suffice it to say that the enumerated tasks include a first round where “the voting computer electronically” distributes a plurality of “ideas” (divided into sets) that are to be voted on, and then “receiving participant input” at various terminals

which is tabulated to identify those ideas that have passed a “threshold hurdle win rate.” *See* claim elements a–c above. A “second round” of voting ensues, which is restricted to those ideas passing the first round, and, similarly, the voting computer establishes “a second threshold hurdle win rate.” *See* claim elements d–f above. Claim 21 further recites that these steps continue “to subsequent rounds” in order “to find the group preferred idea.” Claim 21 also recites that the voting computer “comprises steps for dividing [the] plurality of ideas into groups” and that the ideas so grouped are assigned “a sequence of integers” from “1 to N” to aid in their distribution and/or re-distribution. Figure 1 of Appellants’ Specification is a good visual depiction of the limitations recited. Paragraph 9 of Appellants’ Specification is also a good “Brief Summary of the Invention.”

The Examiner determines that claim 1 is directed to organizing human activity and, more specifically, voting, which is an abstract idea. Final Act. 3. From all of the above, i.e., the claims, the drawings, the description, it is fair to say that this application for a patent pertains to a computerized method of voting (albeit, as Appellants argue, different from previous voting methodologies).¹ This brings us to whether the claimed computer voting methodology (even if unique) is an abstract idea.

Appellants were prescient in stating, “It is apparent that the CAFC is in the process of modifying its interpretation of sec 101 and will continue to do so as this case moves toward a decision. It is respectfully requested that

¹ Appellants state, “The claim explicitly refers to a massive number of ideas (and hence a massive number of voters). This is not similar to paper ballots and voting machines. This system requires multiple rounds of voting *in parallel*. Paper voting could not possibly provide a real solution.” Reply Br. 19.

the Board apply the current CAFC case law at the time this case be taken up for consideration.” Reply Br. 19. We will endeavor to do so.

Although Appellants dispute the Examiner’s determination that claim 1 is directed to an abstract idea in the Appeal Brief and the Reply Brief (Appeal Br. 25–36; Reply Br. 19–20), at oral hearing, Appellants appeared to concede that claim 1 is directed to an abstract idea (*See* Transcript 24:4–12 (stating the argument that the claims are directed to an abstract idea but that the claims add significantly more is the “most applicable”). Even if Appellants did not concede that claim 1 is directed to an abstract idea, we agree with the Examiner that claim 1 is directed to the abstract idea of voting. This is because our reviewing court recently addressed a matter “directed to voting methods and systems that provide for ‘auto-verification’ of a voter’s ballot,” and we turn to that case for guidance. *See Voter Verified, Inc., v. Election Systems & Software LLC*, 887 F.3d 1376, 1379 (Fed. Cir. 2018). When addressing the eligibility of voting/verification claim limitations under 35 U.S.C. § 101, the Court, in *Voter Verified*, stated, “the claims as a whole are drawn to the concept of voting, verifying the vote, and submitting the vote for tabulation. Humans have performed this fundamental activity that forms the basis of our democracy for hundreds of years.”² *Voter Verified*, 887 F.3d at 1385. In this case, the Court reasoned:

These steps are therefore nothing more than abstract ideas. *Cf. CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) (“[M]ethods which can be performed entirely in the human mind are the types of methods that embody the ‘basic tools of scientific and technological work’ that are free to all men and reserved exclusively to none.” (quoting *Gottschalk*

² We note that the claims presently before us lack the verification limitation found in *Voter Verified*.

v. Benson, 409 U.S. 63, 67, 93 S.Ct. 253, 34 L.Ed.2d 273 (1972))).

Voter Verified, 887 F.3d at 1385–86. Thus, according to the first part of the *Alice* inquiry, we determine that the presently pending claims are directed to one of those patent-ineligible concepts. *See supra*.

Turning to the second part of the patent eligibility inquiry, “Applicant submits that the claims are directed to technology and recite elements that include a voting machine, not a general purpose computer.” App. Br. 27. Indeed, claim 21 is directed to a “voting machine computer,” however, claim 21 does not recite any specific computer structure that would deviate from that which one would reasonably expect from a general voting machine computer/system. As such, Appellants do not identify any limitation that might take Appellants’ machine out of this “general voting machine computer’ realm; instead, Appellants ask a series of question such as “does the integration of the computer amount to more than a mere instruction to implement an abstract idea on the computer.” App. Br. 37.

In answering that question, Appellants address the claims recited in *Alice* and state, “[i]n contrast, the claims at issue in this case recite terminals/consoles which provide input for the voter” and also allow the receipt of feedback as well as the ability to participate in later rounds. App. Br. 37. Providing terminals/consoles, however, for sending/receiving voter input/feedback is insufficient for one skilled in the art to understand that Appellants’ claimed device is anything other than a general purpose voting machine computer, and one similar to that addressed in *Voter Verified*. *See Voter Verified*, 887 F.3d at 1386. In other words, as per the Examiner, “designating a particular name to a generic computer system does not

change the fact regarding the generic computer implementation.” Ans. 62.

We agree with the Examiner’s analysis.

Appellants also argue, for example, that the claimed arrangement solves a technological problem, does not include purely conventional functions, improves the functioning of the computer, and are rooted in computer technology to overcome a problem specifically arising in a particular computer realm. Appeal Br. 38–41. As the Examiner explains, however, there is no technological problem addressed by the claimed arrangement. *See* Final Act. 8–9. Indeed, the recited tasks could be performed by a human using pen and paper. Appellants admitted as much at oral hearing. *See* Transcript 29:1–10.

Appellants additionally contend that the claimed arrangement does not preempt all ways of providing voter input. Appeal Br. 40. “While preemption concerns are “the basis for the judicial exceptions to patentability . . . , the absence of complete preemption does not demonstrate patent eligibility.” *BSG Tech v. Buyseasons*, 899 F.3d 1281, 1286 (Fed Cir. 2018) (internal citations omitted).

Regarding *BSG*, that court further held (a) “that claims are not saved from abstraction merely because they recite components more specific than a generic computer” and, (b) “[t]hese cases reflect that a claim is not patent eligible merely because it applies an abstract idea in a narrow way.” *BSG*, 899 F.3d at 1286–87. In other words, whether reciting a generic computer more specifically, or whether seeking protection of an abstract idea in a narrower manner, neither avenue will suffice to transform a generic computer/abstract idea into patent-eligible claim language.

Thus, following the guidance provided by our reviewing court above, we agree with the Examiner that claim 21, as written, is directed to an abstract idea. *See* Final Act. 2. Accordingly, we affirm the Examiner’s rejection of claims 21–36 “as being directed to non-statutory subject matter.” Final Act. 3.

Regarding the Examiner’s additional rejections under §§ 103 and 112, we are informed that “[t]he § 101 patent-eligibility inquiry is only a threshold test.” *Bilski v. Kappos*, 561 U.S. 593, 602 (2010). This means that if the Section 101 threshold is satisfied, further investigation under other sections of 35 U.S.C. is still warranted. On the other hand, should the threshold not be satisfied, there is little merit in pursuing further investigation into these other sections since the claim language is directed to ineligible subject matter. The latter situation is the case before us since it has been determined, via different rationales, that the claim language on appeal is not patent eligible. Accordingly, we do not reach the Examiner’s additional rejections under §§ 103 and 112.

DECISION

The Examiner’s rejection of claims 21–36 as being directed to non-statutory subject matter is affirmed.

We do not reach the merits of the Examiner’s rejections under §§ 103 and 112 for the above reasons.

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED