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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PETER BRYAN MALCOLM, JOHN ANTHONY NAPIER,
ANDREW MARK STICKLER, NATHAN JOHN TAMBLIN,
PAUL JAMES BEADLE, and JASON PAUL CROCKER

Appeal 2017-002543
Application 11/958,270¹
Technology Center 3600

Before ELENI MANTIS MERCADER, LINZY T. McCARTNEY, and
JAMES W. DEJMEK, *Administrative Patent Judges*.

DEJMEK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–60. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify CA, Inc. as the real party in interest. App. Br. 4.

STATEMENT OF THE CASE

Introduction

Appellants' disclosed and claimed invention generally relates to an information management system comprising an analyzer to monitor outgoing electronic mail messages. *See* Spec. ¶¶ 277–289, Abstract. In a disclosed embodiment, if the electronic mail address of a recipient is determined to be associated with the electronic mail address of the sender, the electronic mail message may be re-directed to a third party. *See* Spec. ¶¶ 277–289.

Claim 1 is representative of the subject matter on appeal and is reproduced below:

1. An information management system comprising:
 - an application stored in a memory of a workstation for transmitting outbound data to a network;
 - policy data containing rules for determining one or more particulars of the outbound data, and for controlling the transmission of said outbound data in dependence on those particulars, said policy data including a predetermined list of internet mail domains;
 - an analyser comprising a processor, said analyser operable to scan an address of a recipient of an outbound message, wherein the address comprises an electronic mail address, to determine:
 - whether the electronic mail address is associated with an internet mail domain on the predetermined list of internet mail domains; and
 - whether the electronic mail address is associated with a sender of the outbound message by determining whether the address of the recipient contains at least one of a surname, a first name, or initials of the sender of the outbound message; and

said analyser being further operable to, based upon said policy data, re-direct the outbound message to a third party in response to determining that the electronic mail address of the recipient of the outbound message is associated with the internet mail domain, and is associated with the sender of the message.

The Examiner's Rejections

1. Claims 1–60 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 2–3.
2. Claims 1–60 stand rejected under the doctrine of obviousness-type double patenting over U.S. Patent No. 9,203,650 (“the ’650 patent”). Final Act. 4.

ANALYSIS²

Rejection under doctrine of obviousness-type double patenting

As the Examiner explains in the Final Office Action, “[a] timely filed terminal disclaimer . . . may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground.” Final Act. 4.

Subsequent to the Examiner’s Answer, on December 2, 2016, Appellants filed a terminal disclaimer identifying the ’650 patent. *See* Reply Br. 2. Accordingly, we summarily reverse the rejections of claims 1–60 under the doctrine of non-statutory obviousness-type double patenting.

² Throughout this Decision, we have considered the Appeal Brief, filed May 31, 2016 (“App. Br.”); the Reply Brief, filed December 5, 2016 (“Reply Br.”); the Examiner’s Answer, mailed October 5, 2016 (“Ans.”); the Examiner’s Supplemental Answer, mailed November 30, 2016 (“Supp. Ans.”); and the Final Office Action, mailed December 1, 2015 (“Final Act.”), from which this Appeal is taken.

Rejection under 35 U.S.C. § 101

Appellants dispute the Examiner's conclusion that the pending claims are directed to patent ineligible subject matter. App. Br. 14–29. In particular, Appellants argue the claims are not directed to patent-ineligible subject matter, but rather to a specific technological solution to a problem necessarily rooted in computer technology. App. Br. 15–21. Further, Appellants assert the claimed solution cannot be performed entirely in the human mind. App. Br. 22–23. Additionally, Appellants assert the claims recite significantly more than the abstract idea articulated by the Examiner. App. Br. 23–29. Appellants also contend the Examiner failed to consider the different scope of the independent claims or the additional limitations recited by the dependent claims. App. Br. 17, 26–27.

The Supreme Court's two-step framework guides our analysis of patent eligibility under 35 U.S.C. § 101. *Alice Corp. Pty. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014). If a claim falls within one of the statutory categories of patent eligibility (i.e., a process, machine, manufacture, or composition of matter) then the first inquiry is whether the claim is directed to one of the judicially recognized exceptions (i.e., a law of nature, a natural phenomenon, or an abstract idea). *Alice*, 134 S. Ct. at 2355. If so, the second step is to determine whether any element, or combination of elements, amounts to significantly more than the judicial exception. *Alice*, 134 S. Ct. at 2355.

Although the independent claims each broadly fall within the statutory categories of patentability, the Examiner concludes the claims are directed to a judicially recognized exception—i.e., an abstract idea. Final Act. 2–3. Further, the Examiner concludes the claims do not recite significantly more

than the abstract idea itself. Final Act. 2–3. Accordingly, the Examiner concludes the claims are not directed to patent-eligible subject matter. Final Act. 2–3.

Instead of using a definition of an abstract idea, “the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.” *Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016)); accord United States Patent and Trademark Office, July 2015 Update: Subject Matter Eligibility 3 (July 30, 2015), <https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf> (instructing Examiners that “a claimed concept is not identified as an abstract idea unless it is similar to at least one concept that the courts have identified as an abstract idea.”). As part of this inquiry, we must “look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Tex., LLC v. DirecTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

Our reviewing court has concluded that abstract ideas include the concepts of collecting data, recognizing certain data within the collected data set, and storing the data in memory. *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347 (Fed. Cir. 2014); see also *Smart Sys. Innovations, LLC v. Chicago Transit Authority*, 873 F.3d 1364, 1372 (Fed. Cir. 2017) (concluding “claims directed to the collection, storage, and recognition of data are directed to an abstract idea”). Additionally, the collection of information and analysis of information (e.g.,

recognizing certain data within the dataset) are also abstract ideas. *Elec. Power*, 830 F.3d at 1353–54 (“analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category”). Also, subsequent to Appellants’ filing of their Appeal Brief, and as identified by the Examiner (*see* Supp. Ans. 2–3), our reviewing court concluded “receiving e-mail (and other data file) identifiers, characterizing e-mail based on the identifiers, and communicating the characterization—in other words, filtering files/e-mail—is an abstract idea.” *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1313 (Fed. Cir. 2016). Additionally the court concluded claims related to “receiving, screening, and distributing e-mail” were not patent eligible under § 101. *Intellectual Ventures*, 838 F.3d at 1316.

Further, merely combining several abstract ideas does not render the combination any less abstract. *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“Adding one abstract idea (math) to another abstract idea . . . does not render the claim non-abstract.”); *see also FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (determining the pending claims were directed to a combination of abstract ideas).

Here, Appellants’ claims are directed to re-directing an electronic mail message to a third party if it is determined that an electronic mail address of an intended recipient is associated with the sender of the electronic mail message. This characterization is consistent for each of the independent claims. According to the claims, an analysis step determines whether the address of the electronic mail recipient contains “at least one of a surname, a

first name, or initials” of the sender. *See, e.g.*, claim 1. If so, the electronic email message is re-directed to a third party, pursuant to policy data rules.

The claimed scanning of an intended recipient’s electronic mail address to determine if it is associated with the electronic mail address of the sender is similar to the collection, analysis, and recognition of data ideas that our reviewing court has concluded to be abstract. *See Content Extraction*, 776 F.3d at 1347; *Elec. Power*, 830 F.3d at 1353; *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1366 (Fed. Cir. 2018). Further, the re-directing of emails that satisfy the claimed criteria (i.e., whether a recipient’s electronic mail address is associated with the sender based on an analysis of the addresses) is similar to the abstract ideas filtering, screening, and distributing electronic mail. *Intellectual Ventures*, 838 F.3d at 1313, 1316. Accordingly, we conclude the character as a whole of the claims is directed to an abstract idea.

Appellants’ arguments that the claims are directed to a technical solution to a problem rooted in computer technology (*see App. Br.* 18–21) are also unavailing. As the court in *Intellectual Ventures* explained, similar to a corporate mailroom implementing the organization’s business communication policies, the screening of messages “are abstract ideas, ‘fundamental . . . practice[s] long prevalent in our system’ and ‘method[s] of organizing human activity.’” *Intellectual Ventures*, 838 F.3d at 1317–18 (quoting *Alice*, 134 S. Ct. at 2356). Accordingly, we disagree that the problem is necessarily rooted in computer technology. Rather, “the focus of the claims is not on . . . an improvement to computers, but on certain independently abstract ideas that use computers as tools.” *Elec. Power*, 830 F.3d at 1354; *see also Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of*

Can. (U.S.), 687 F.3d 1266, 1278 (Fed. Cir. 2012) (“[T]he fact that the required calculations could be performed more efficiently via a computer does not materially alter the patent eligibility of the claimed subject matter.”).

Further, Appellants rely on statements from the Specification to suggest the claims recite specific technological features. *See* App. Br. 19–21. “[T]he main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable [T]he name of the game is the claim. . . .” *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998) (quoting Giles S. Rich, *Extent of the Protection and Interpretation of Claims--American Perspectives*, 21 *Int'l Rev. Indus. Prop. & Copyright L.* 497, 499 (1990)). The purported technological solutions are not recited in the claims.

Because we determine the claims are directed to an abstract idea or combination of abstract ideas, we analyze the claims under step two of *Alice* to determine if there are additional limitations that individually, or as an ordered combination, ensure the claims amount to “significantly more” than the abstract idea. *Alice*, 134 S. Ct. at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294, 1297–98 (2012)). The implementation of the abstract idea involved must be “more than [the] performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction*, 776 F.3d at 1347–48 (quoting *Alice*, 134 S. Ct. at 2359) (alteration in original).

Appellants assert the claims recite significantly more than the alleged abstract idea because the claims recite an unconventional step of re-directing an electronic email message. App. Br. 23–26. As discussed above, the re-

directing of the electronic mail message is part of the abstract idea. Further, the transmitting of data by a computing device (i.e., re-directing of the electronic mail message) is a conventional activity. *See buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (“That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive.”).

Further, to the extent Appellants are asserting a lack of rejection under Section 103 suggests the instant claims do not recite well understood, routine, or conventional activities or, otherwise, recite an inventive concept (*see* Reply Br. 4), we are not persuaded. Subject-matter eligibility under 35 U.S.C. § 101 is a requirement separate from other patentability inquiries. *See Mayo*, 566 U.S. at 90 (recognizing that the § 101 inquiry and other patentability inquiries “might sometimes overlap,” but that “shift[ing] the patent-eligibility inquiry entirely to these [other] sections risks creating significantly greater legal uncertainty, while assuming that those sections can do work that they are not equipped to do”); *see also Diamond v. Diehr*, 450 U.S. at 188–89 (“[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter”); *Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017) (“[e]ligibility and novelty are separate inquiries”).

Appellants’ argument that dependent claim 2 blocks outbound “data” as opposed to a “message” do not apprise us of error. App. Br. 26–27. The “block[ing] transmission of the outbound data to the address of the recipient” does not change the character of the claims (i.e., the abstract idea

to which they are directed) or recite an invent concept that is significantly more than the abstract idea.

To the extent Appellants contend the claims are not preemptive (*see* App. Br. 15–17) of the abstract idea, we are unpersuaded of Examiner error. “[W]hile 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.”). Further, “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa*, 788 F.3d at 1379.

For the reasons discussed *supra*, we are unpersuaded of Examiner error. Accordingly, we sustain the Examiner’s rejection of independent claim 1 under 35 U.S.C. § 101. For similar reasons, we sustain the Examiner’s rejection of independent claims 16, 31, and 46, which recite similar limitations. Additionally, we sustain the Examiner’s rejection of claims 2–15, 17–30, 32–45, and 47–60, which depend directly or indirectly therefrom.³ *See* 37 C.F.R. § 41.37(c)(1)(iv) (2015).

³ Appellants only presented arguments regarding dependent claim 2, which we addressed *supra*.

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Application 11/958,270

DECISION

We summarily reverse the Examiner's decision rejecting claims 1–60 under the doctrine of nonstatutory double patenting.

We affirm the Examiner's decision rejecting claims 1–60 under 35 U.S.C. § 101.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED