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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER JOHN McGREAL

Appeal 2017-003593
Application 14/301,067
Technology Center 3600

Before DEBRA K. STEPHENS, DANIEL J. GALLIGAN, and
DAVID J. CUTITTA II, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

DECISION ON APPEAL

Introduction

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of
claims 1–6 and 8–10, which are all of the claims pending in the application.
We have jurisdiction under 35 U.S.C. § 6(b). Claim 7 has been cancelled.

We AFFIRM.[1]

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[1] Our Decision refers to Appellant's Appeal Brief filed May 2, 2016 ("Br.");
Examiner's Answer mailed November 4, 2016 ("Ans."); and Final Office
Action mailed December 17, 2015 ("Final Act.").

STATEMENT OF THE CASE

Claims on Appeal

Claim 1, the sole independent claim, is reproduced below:

1.   A network-based method of email subscriber profiling comprising:

receiving, at an email marketing system with a processor and memory, comprising data collection and management module and subscriber profile database module stored in memory, subscriber identifying, preference and behavioral information, wherein the subscriber identifying, preference and behavioral information is obtained from subscriber email engagement activities comprising email click thru streams as the subscriber interacts with websites on the network;

recording the subscriber information in the subscriber profile database module;

assigning a particular subscriber to a one or more groups of subscribers with a specific interest based on the recorded identifying, preference and behavioral information recorded in the subscriber profile database module;

executing a process to determine the relative depth of the subscriber's interest in a first group and a second group to which the subscriber is assigned, wherein depth of interest is identified by scaling the subscriber interest based on weighted values assigned to recency and frequency of behavioral information related to each group and recorded in the subscriber profile database module; and

sending a personalized message from the email marketing system, the message comprising relevant content provided by a dynamic content module, to a selected group of subscribers over a network, whereby subscribers in the group receiving the relevant content have similar depths or weights of interest in the group defined by the segment.

Examiner's Rejections

Claims 1–6 and 8–10 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 4.

Claims 1–6 and 8–10 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Appellant's Admitted Prior Art (AAPA) (Spec. ¶¶ 4–8). *Id.* at 5–7.

Our review in this appeal is limited only to the above rejections and the issues raised by Appellant. Arguments not made are waived. *See* MPEP § 1205.02; 37 C.F.R. §§ 41.37(c)(1)(iv) and 41.39(a)(1).

ANALYSIS

Rejection of Claims 1–6 and 8–10 under 35 U.S.C. § 101

The Examiner concludes that claims 1–6 and 8–10 are directed to patent-ineligible subject matter. Final Act. 4. We agree with the Examiner.

In *Alice,* the Supreme Court 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." *Alice Corp. Pty. Ltd. v. CLS Bank Int'l,* 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.,* 566 U.S. 66, 77 (2012)). 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 so, the second step is to consider the elements of the claims "individually and 'as an ordered combination' to determine whether the additional elements 'transform the nature of the claim' into a patent-eligible application." *Id.* (quoting *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

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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.* (brackets in original) (quoting *Mayo*, 566 U.S. at 72–73).

As an initial matter, we observe independent claim 1 recites a method. As such, the claim is directed to a statutory class of invention within 35 U.S.C. § 101, namely, a process.

Turning to the first step of the *Alice* analysis, the Examiner determines that the claim is directed to the abstract concept of "managing internet ad campaigns based on interactions/engagements." Final Act. 2, 4 (emphasis omitted); Ans. 2. The Examiner further finds that this concept is similar to concepts such as "data recognition and storage, comparing new and stored information[,] using rules to identify options, [and] organizing information through mathematical organizations." *See* Ans. 2–3 (emphases omitted). Our reviewing court has determined that the processes of "1) collecting data, 2) recognizing certain data within the collected data set, and 3) storing that recognized data in a memory" are directed to an "abstract idea." *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass'n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014); *see Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016). And, our reviewing court has further determined that "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). Here, claim 1 recites abstract processes of collecting and storing data by "receiving . . . subscriber identifying, preference and behavioral

information" from email clicks and then "recording the subscriber
information." The claim further recites an abstract process of characterizing
data based on recognized data within the received subscriber information by
"assigning a particular subscriber to one or more groups . . . based on the
recorded . . .information" and "executing a process to determine the relative
depth of the subscriber's interest in a first group and a second group to
which the subscriber is assigned." We agree with the Examiner's
determination that claim 1 is directed to an abstract idea.

Because the claim is directed to an abstract idea, we proceed to the
second step of the *Alice* analysis and consider whether the additional
elements recited by the claim transform the claim into a patent-eligible
application of the claimed subject matter. We agree with the Examiner that
the claim recites a generic computing system that implements abstract idea
processes and, thus, does not transform the claim into a patent-eligible
application. Ans. 3; Final Act. 3–4. In particular, the abstract idea processes
are performed by an "email marketing system with a processor and memory"
having a "data collection and management module and subscriber profile
database module." As the Examiner points out, that system is a generic
computing system having a processor, memory, and databases to "perform
[the] basic computer functions of retrieving, storing, manipulating, and
processing data, which are all well-understood, routine and conventional."
Ans. 3. Indeed, Appellant's Specification teaches that email systems are
known to perform the computing functions of receiving data from "customer
interact[ions] with a link," analyzing that data to "put[] the customer into the
group related to that link," and sending marketing messages to those groups.
Spec. ¶¶ 6–8.

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Appellant argues "the elements not taught by the [prior art] . . . add specific limitations other than what is well-understood, routine and convention[al] in the field." Br. 13–14. However, the alleged improvements recited by the claimed elements are directed to improvements to the abstract idea and not to "'improv[ing] the functioning of the computer itself.'" *Intellectual Ventures*, 838 F.3d at 1315 (quoting *Alice*, 134 S. Ct. at 2359). The Specification teaches that the invention is directed to an improvement that allows marketers to determine the level of interest a customer has in a particular group. Spec. ¶ 11. Such an improvement is not an improvement to any particular computing element and instead uses generic computing elements to accomplish the abstract process of interest determination. Appellant highlights the specific type of data that is recorded (Br. 13), but recognizing "indication[s] of the characteristic[s] of the data" received does not prove that such an "implementation is not routine and conventional." *Intellectual Ventures*, 838 F.3d at 1315. Further, the determination of the subscriber's interest based on a scaling process is at best an "improved mathematical analysis," which is an improvement to the abstract idea, but "not [to] any improved computer or network." *SAP Am., Inc. v. Investpic, LLC*, 890 F.3d 1016, 1022 (Fed. Cir. 2018). "[A]n invocation of already-available computers that are not themselves plausibly asserted to be an advance, for use in carrying out improved mathematical calculations, amounts to a recitation of what is 'well-understood, routine, [and] conventional.'" *Id.* at 1023 (alteration in original) (quoting Mayo, 566 U.S. at 73).

Additionally, Appellant has not proffered sufficient evidence or argument to persuade us that any of the dependent claims recite a

meaningful limitation that transforms the claims into patent-eligible subject matter. *See* Br. 15. Accordingly, Appellant has not persuaded us claims 1–6 and 8–10 are directed to patent-eligible subject matter. Therefore, we sustain the rejection of claims 1–6 and 8–10 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

Rejection of Claims 1–6 and 8–10 under 35 U.S.C. § 102(a)

Appellant contends the Examiner erred in finding Appellant's Admitted Prior Art (AAPA) discloses "wherein depth of interest is identified by scaling the subscriber interest based on weighted values assigned to recency and frequency of behavioral information related to each group and recorded in the subscriber profile database module," as recited in claim 1. Br. 15–18. Specifically, Appellant argues "there is no mention of depth, recency, frequency, or scaling in the AAPA." Br. 18.

We are persuaded. The Examiner finds that, "[i]f a customer interacts with a link (understood as an interaction or visit to a website), the eMarketing system puts the customer into the group related to that link" and that "AAPA teaches that a subscriber clicks on 25 links related to men's shoes and 1 click on a link related to women's shoes." Ans. 4 (citing AAPA ¶¶ 7–8); Final Act. 5–6. Further, the Examiner determines that "[i]t is apparent to one of ordinary skill in the art that the subscriber that has clicked on 25 links related to a certain topic . . . is more interested in that topic and the relevancy of those links is higher than the link that has received only 1 click." Ans. 4; Final Act. 6.

The Examiner, however, has not identified where AAPA discloses the depth of interest by scaling interest level based on that higher interaction

frequency or based on how recently a user has clicked links. Thus, the Examiner does not explain sufficiently where or how AAPA discloses "scaling the subscriber interest based on weighted values assigned to recency and frequency of behavioral information." *See* Ans. 4; *see also* Final Act. 5–6. Instead, the Examiner determines that "[i]s apparent to one of ordinary skill in the art" that more clicks related to one subject than another shows more interest in the former topic. Ans. 4; Final Act. 5–6. Such an analysis is more appropriate for an obviousness rejection under 35 U.S.C. § 103(a). However, that is not a question before us because the Examiner has not made those conclusions under a 35 U.S.C. § 103(a) rejection, and we will not speculate in that regard here in the first instance on appeal. Further, because we agree with at least one of the arguments advanced by Appellant, we need not reach the merits of Appellant's other arguments. *See* Br. 18.

Therefore, we cannot sustain the rejection of independent claim 1 and dependent claims 2–6 and 8–10, which stand with independent claim 1 under 35 U.S.C. § 102(a) as being anticipated by AAPA.

DECISION

We affirm the Examiner's decision rejecting claims 1–6 and 8–10 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

We reverse the Examiner's decision rejecting claims 1–6 and 8–10 under 35 U.S.C. § 102(a) as being anticipated by Appellant's Admitted Prior Art (AAPA).

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