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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JEFFREY S. STACEY<sup>1</sup>

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Appeal 2017-003682  
Application 13/155,951  
Technology Center 3600

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Before CAROLYN D. THOMAS, JON M. JURGOVAN, and  
AARON W. MOORE, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant seeks our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of claims 1–4, 6, 8–12, 14, 16, 17, 19, and 21–24, all the pending claims in the present application. Claims 5, 7, 13, 15, 18, and 20 are canceled (*see* Claims Appendix). We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

The present invention relates generally to the simultaneous issuance of a news release with the submission and filing of a Security and Exchange

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<sup>1</sup>Appellant names NASDAQ, Inc. as the real party in interest (App. Br. 3).

Commission (SEC) Electronic Data-Gathering, Analysis, and Retrieval (EDGAR) filing (*see* Spec., Abstract).

Claim 1 is illustrative:

1. An electronic filing method implemented using an information processing apparatus having one or more computer processors and for performing an EDGAR filing while issuing a news release, the method comprising:

generating, by the one or more computer processors, a news release containing a material disclosure and disclosing an event related to an organization;

generating, by the one or more computer processors, an EDGAR filing based on a template for a type of EDGAR filing, the template being automatically customized based on an item category from one of several predefined category codes and the template being populated with an item text containing one or more paragraphs from the news release as an exhibit for submission with the EDGAR filing;

scheduling, by the one or more computer processors, a time for submitting the EDGAR filing and distributing the news release to one or more selected news distribution channels;

automatically formatting, by the one or more computer processors, the news release to correspond to a preferred format of each of the one or more distribution channels; and

electronically submitting, using at least the one or more computer processors, the EDGAR filing having the news release included as an exhibit to an authorities communication channel while issuing the corresponding news release to the one or more news release distribution channels at the scheduled time.

Appellant appeals the following rejections:

R1. Claims 1–4, 6, 8–12, 14, 16, 17, 19, and 21–24<sup>2</sup> are rejected under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement (Final Act. 2–3);

R2. Claims 1–4, 6, 8–12, 14, 16, 17, 19, and 21–24 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter (Final Act. 3–6); and

R3. Claims 1–4, 6, 8–12, 14, 16, 17, 19, and 21–24<sup>3</sup> are rejected under 35 U.S.C. § 103(a) as being unpatentable over Business Wire (BusinessWire.com, *Material News Disclosure* (Mar. 2010) and *EDGAR (US)* (Feb. 2010), retrieved from the Internet Archive Wayback Machine, <http://web.archive.org> (Feb. 20, 2013)), Messick (US 2004/0158533 A1, Aug. 12, 2004), Conklin (US 2002/0091621 A1, July 11, 2002), EDGAR Filer Manual (*EDGAR Filer Manual - Volume II*, version 8 (June 2008), <https://www.sec.gov/info/edgar/edgarfm-vol2-v8.pdf>), and Feola (US 2002/0059397 A1, May 16, 2002) (Final Act. 7–20).

We review the appealed rejections for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

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<sup>2</sup> Although the heading of the rejection only cites independent claims 1, 8, 9, and 16, the body of the rejection states that the “[d]ependent [claims] are rejected on the same grounds due to their dependency” (Final Act. 3). Therefore, we shall treat this rejection as applying to all of the pending claims.

<sup>3</sup> Although the heading of the rejection only lists claims 1–3, 6, 8–11, 14, 16, and 19 (*see* Final Act. 7), the body of the rejection also includes discussions and cites for claims 4, 12, 17, and 21–24 (*see id.* at 19–20). Therefore, we shall treat this rejection as including all of claims 1–4, 6, 8–12, 14, 16, 17, 19, and 21–24.

## ANALYSIS

### *Rejection under § 112, first paragraph*

**Issue 1:** Did the Examiner err in finding that the claims fail to comply with the written description requirement?

The Examiner finds that “[t]here is no language in the written description that discloses or describes a scheduling that is done by the computer system, instead, . . . [the Specification] describes a user scheduling time in which to issue news release” (Final Act. 3). We agree with the Examiner.

Although Appellant contends that “the user enters the date (and time) for distribution . . . [thus] the specification is clear that the system is used for scheduling the submission and distribution” (App. Br. 15), we find that the *system being used* is distinguishable from the *scheduling by the computer*. In other words, while we agree with Appellant that the user is using the computer to enter scheduling times/dates (*see* Appellant’s Fig. 6; Spec. ¶¶ 50–51), this shows that the user, not the computer, selects/schedules the time, and thereafter the computer merely implements the user’s selection.

Therefore, we agree with the Examiner that Appellant’s Specification fails to describe any scheduling *by a computer processor*. Accordingly, we sustain the Examiner’s 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, rejection of independent claims 1, 8, 9, and 16 for failing to comply with the written description requirement, and dependent claims 2–4, 6, 10–12, 14, 17, 19, and 21–24 for similar reasons.

*Rejection under § 101*

**Issue 2:** Did the Examiner err in finding that the claims are directed to non-statutory subject matter?

*Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014), identifies a two-step framework for determining whether claimed subject matter is judicially excepted from patent eligibility under § 101. According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

In this regard, with respect to independent method claim 1, and similarly, non-transitory computer-readable medium claim 8 and system claims 9 and 16, the Examiner finds that the claims are directed to an “abstract idea of electronic filing and information dissemination” (Final Act. 4). The Examiner further finds that the “courts have found the using of categories to organize, store and transmit information to be abstract . . . [here,] the claims are merely organizing, storing and transmitting investor relations information” (*id.* at 4–5).

Appellant challenges said findings on the ground that “[w]hile these features may be related to some type of ‘economic practice,’ the features are not directed to a ‘fundamental economic practice’ . . . [but are] for generating SEC compliant filings . . . to be automatically formatted . . . at the same time submitting a news release” (App. Br. 17).

The Examiner notes that Appellant’s argument “amounts to a general allegation without providing any support [because] Appellant has not offered any reasoning as to why the claims do not relate[] to a fundamental economic practice . . . [given that] the claim relates to legal obligations and

business relations” (Ans. 5 (citing Appellant’s Spec. ¶¶ 2–5)). We agree with the Examiner.

We find that the Examiner’s cogent analysis relying on judicial examples (*see* Ans. 5–6), shows the Examiner provided an adequate basis for determining that the claims are directed to an abstract idea.

We now turn to the second step of the *Alice* framework: “a 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.’” *Alice*, 134 S. Ct. at 2355 (alteration in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)).

Appellant contends that “[f]or similar reasons as those discussed in *Trading Tech*,<sup>4</sup> Appellant’s claimed system for performing an EDGAR filing is also patent-eligible . . . [because it] provides an easy-to-use system for issuing a news release . . . while at the same time complying with the requirements of the SEC . . . an internet-centric solution” (App. Br. 19).

In response, the Examiner looks at a similar controlling decision and finds that “[u]nlike the technical solution rooted in computer technology in *DDR* . . . the recited solution of ‘allowing a party to perform an SEC filing at the same time . . . as issuing a press release disclosing a material event’ is not rooted in computer technology since the alleged solution can be performed by a generic computing device” (Ans. 7). We agree with the Examiner.

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<sup>4</sup> *Trading Techs. Int’l v. CQG et al.*, Case No. 05-cv-4811, 2015 WL 774655 (N.D. Ill. Feb. 24, 2015), *aff’d*, 675 F. App’x 1001 (Fed. Cir. 2017).

In *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1259 (Fed. Cir. 2014), the subject claim was held patent-eligible because it encompassed “an inventive concept” for resolving a “particular Internet-centric problem.” In contrast, we find Appellant’s method performed by a computer processor (claim 1) does not provide a solution “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” *DDR*, 773 F.3d at 1257. Because we find all claims on appeal merely use a generic computer or processor as a tool which is used in the way a computer normally functions, we conclude that the claims fail to impart any discernible improvement upon the computer or processor; nor do Appellant’s claims solve “a challenge particular to the Internet” as considered by the court in *DDR*, 773 F.3d at 1256–57. In fact, Appellant “acknowledges that conventional technology allows for filing the required SEC forms using an electronic data gathering system” (App. Br. 18). Here, Appellant has merely added an additional conventional feature to this aforementioned conventional method, i.e., issuing a news release at the same time. Appellant is reminded that “relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.” *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (citing *Alice*, 134 S. Ct. at 2359 (“use of a computer to create electronic records, track multiple transactions, and issue simultaneous instructions” is not an inventive concept)).

Thus, we conclude none of Appellant’s claims are like the claim held patent-eligible by the court in *DDR*, in which the claimed invention was

directed to the “challenge of retaining control over the attention of the customer in the context of the Internet,” such that

[i]nstead of the computer network operating in its normal, expected manner by sending the website visitor to the third-party website that appears to be connected with the clicked advertisement, the claimed system generates and directs the visitor to the above-described hybrid web page that presents product information from the third-party and visual “look and feel” elements from the host website.

*DDR*, 773 F.3d at 1258–59. Thus, we find unavailing Appellant’s arguments that the claims are similar to *Trading Techs.* (or *DDR*), given that no convincing “inventive concept” for resolving a “particular Internet-centric problem” is identified by Appellant.

As recognized by the Supreme Court, “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 134 S. Ct. at 2358–59 (concluding claims “simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer” not patent eligible).

Because Appellant’s independent claims 1, 8, 9, and 16<sup>5</sup> are directed to a patent-ineligible abstract concept under the first prong of *Alice* and do not recite something “significantly more” under the second prong of the *Alice* analysis, we sustain the Examiner’s rejection of these claims as well as respective dependent claims 2–4, 6, 10–12, 14, 17, 19, and 21–24 under 35 U.S.C. § 101 as being directed to non-statutory subject matter in light of *Alice* and its’ progeny.

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<sup>5</sup> *Alice* also confirmed that if a patent’s systems claims are no different in substance from its method claims, they will rise and fall together. 134 S. Ct. at 2360. The same was true of the *Alice* patent’s media claims. *Id.*

For the foregoing reasons, Appellant's contentions are unpersuasive as to error in the rejection under 35 U.S.C. § 101.

*Rejection under § 103(a)*

**Issue 3:** Did the Examiner err in finding that the cited art collectively teaches or suggests *electronically submitting the EDGAR filing having the news release included as an exhibit while issuing the corresponding news release*, as set forth in representative claim 1?

Appellant contends that “Business Wire does not at all envision a system that automatically generates and formats the EDGAR filings . . . nor . . . submit both the EDGAR filing and a news release” (App. Br. 21). Appellant further contends that “Feola does not disclose or suggest the creation of an SEC/EDGAR filing created based on predefined codes associated with a template of the filing” (*id.* at 23). Appellant contends that “neither reference, [i.e., Business Wire nor Feola,] either alone or in combination, describes the automatic creation of a form used in an SEC/EDGAR filing while simultaneously issuing a news release” (App. Br. 23). Appellant further contends that “Conklin does not describe the template being customized based on an item category selected from predefined category codes, or the template being populated with text from a news release for submission” (App. Br. 23–24).

In response, the Examiner finds that Appellant's “argument is unpersuasive, as it completely ignores relevant prior art that was [also] applied to the claimed invention (Messick and EDGAR Filer Manual), and one cannot show nonobviousness by attacking references individually where

the rejections are based on combinations of references” (Ans. 15). We agree with the Examiner.

We refer to, rely on, and adopt the Examiner’s findings and conclusions set forth in the Answer. Our discussions here will be limited to the following points of emphasis.

Specifically, the Examiner finds that “[i]t would have been obvious . . . to modify Business Wire, which describes generating data to include in EDGAR filings based upon item text submitted and item codes . . . and incorporate the teachings of Conklin, which describes using such submitted information to automatically customize and populate an SEC template” (Ans. 12). Additionally, the Examiner finds that “EDGAR Filer Manual teaches that this concept of attaching an electronic copy of an exhibit, which in the case of an 8-K filing includes a press release, to an EDGAR filing is old and well known” (Ans. 13), Feola teaches “formatting the news story in the form of a content object” (Ans. 14), and Messick teaches “simultaneous delivery of required disclosures [i.e., EDGAR filings] and general press release information” (Final Act. 12 (alteration in original) (quoting Messick ¶ 5)). The Examiner further notes “such combination would have been obvious since the invention is merely a combination of known elements,” “that results of the combination were predictable,” and “merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art” (Ans. 13).

Here, Appellant’s argument *supra* attempt to rebut the teachings in three of the references, i.e., Business Wire, Feola, and Conklin, but ignores the teachings in Messick and EDGAR Filer Manual. In other words, Appellant’s arguments against each of Business Wire, Feola, and Conklin,

separately from the combined teachings of all five references, i.e., Business Wire, Feola, Conklin, EDGAR Filer Manual, and Messick, do not persuasively rebut the combination made by the Examiner. As noted by the Examiner (*see* Ans. 15), one cannot show nonobviousness by attacking references individually, where the rejections are based on combinations of references. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 425–26 (CCPA 1981).

For example, even if we assume *arguendo* that Business Wire does not automatically generate and format the EDGAR filings nor submit both the EDGAR filing and a news release, as argued by Appellant (*see* App. Br. 21), or that Feola does not teach predefined codes associated with a template (*see id.* at 23), or that Conklin does not describe the template being populated with text from a news release (*see id.* at 23–24), Appellant fails to rebut that the *combined teachings* of all five references, i.e., Business Wire, Messick, Feola, EDGAR Filer Manual, and Conklin, teach or suggest these features, as proffered by the Examiner.

Accordingly, we sustain the Examiner’s rejection of claim 1. Appellant’s arguments regarding the Examiner’s rejection of independent claims 8, 9, and 16 rely on the same arguments as for claim 1, and Appellant does not argue separate patentability for the dependent claims, except as noted below. We, therefore, also sustain the Examiner’s rejection of claims 3, 6, 8, 9, 11, 14, 16, 19, and 21–24.

*Claims 2 and 10<sup>6</sup>*

Appellant contends that “Business Wire manually delivers the press releases and does not simultaneously issue the news release with an EDGAR filing” (App. Br. 25).

In response, the Examiner points out, and we agree, that “the combination of Business Wire and Messick” was used to described the argued limitation (Ans. 15–17 (*citing* Final Act. 11–13)), not just Business Wire, as argued by Appellant. Specifically, as highlighted by the Examiner, Business Wire describes electronic submission of a filing and issuance of a news release (Business Wire 3) and Messick teaches simultaneous delivery of required disclosures (Messick ¶¶ 4–5). One cannot show nonobviousness by attacking references individually, where the rejections are based on combinations of references. *In re Merck*, 800 F.2d at 1097.

Accordingly, we affirm the rejection of claims 2 and 10 given that Appellant has not sufficiently argued the combination made.

*Claims 4, 12, and 17*

Appellant contends that “the Manual does not at all describe attaching an electronic copy of an issued news release to the EDGAR filing as an exhibit[, n]or does the Manual at all describe a system that attaches the electronic copy of the news release as an exhibit” (App. Br. 26).

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<sup>6</sup> In the event of further prosecution, we leave it to the Examiner to consider if claims 2, 4, 10, 12, and 17 should also be rejected under 35 U.S.C. § 112(d) or pre-AIA 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of the claim upon which they depend.

In response, the Examiner points out that “EDGAR Filer Manual teaches . . . this concept of attaching an electronic copy of an exhibit, which in the case of an 8-K filing includes a press release” (Ans. 17; *see also* Final Act. 19 and EDGAR Filer Manual section 8.1.1), along with the combined teachings of Business Wire, Messick, and Conklin. For example, at least Business Wire and Messick both teach submitting press releases (*see* Business Wire 3 and Messick ¶¶ 4–5), and EDGAR Filer Manual teaches uploading attachments, i.e., attaching electronic copies (*see* section 8.1.1).

One cannot show nonobviousness by attacking references individually, where the rejections are based on combinations of references. *In re Merck*, 800 F.2d at 1097. Accordingly, we affirm the rejection of claims 4, 12, and 17 given that Appellant has not sufficiently argued the combination made.

#### DECISION

We affirm the Examiner’s § 112(a), § 101, and § 103(a) rejections R1–R3 of claims 1–4, 6, 8–12, 14, 16, 17, 19, and 21–24.

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