UNITED STATES PATENT AND TRADEMARK OFFICE

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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 BRUCE BALENT

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Appeal 2017–004037
Application 12/835,595
Technology Center 3600

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Before ANTON W. FETTING, AMEE A. SHAH, and
MATTHEW S. MEYERS, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE[1]

Bruce Balent (Appellant)[2] seeks review under 35 U.S.C. § 134 of a

final rejection of claims 34–43 and 45–54, the only claims pending in the

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application on appeal. We have jurisdiction over the appeal pursuant to
35 U.S.C. § 6(b).

The Appellant invented a personal automation and shopping system
for automating or improving personal or business productivity, efficiency
and goal attainment, and buying and selling of goods and services. Spec.,
para. 1.

An understanding of the invention can be derived from a reading of
exemplary claim 34, which is reproduced below (bracketed matter and some
paragraphing added).

> 34. A method, comprising:
>
> [1] receiving, by a system comprising at least one processor
> from a server device associated with a store via a wireless
> communication channel, store layout information defining a
> layout of the store;
>
> [2] categorizing, by the system and based on the store layout
> information, shopping list items identified by stored shopping
> list data according to aisles of the store in which the shopping
> list items are located to yield a categorized list;
>
> [3] facilitating, by the system, a display of the categorized list;
>
> [4] for respective items of the shopping list items, receiving, by
> the system via an optical scan performed by a keyless data entry
> device, selection data indicating that the respective items have
> been acquired;
>
> [5] generating, by the system and based on an order in which
> the selection data for the respective items is received, route
> information identifying a route through the store;
>
> [6] storing, by the system, the route information in association
> with the shopping list data;
>
> [7] in response to selection of the shopping list data subsequent
> to the storing the route information, sorting, by the system, the
> shopping list items based on the route information to yield
> sorted shopping list data;

[8] generating a device-readable composite barcode for an item of the shopping list items, wherein the composite device-readable barcode represents a product code for the item aggregated with a numeric prefix that identifies the sorted shopping list data;

and

[9] facilitating, by the system, a printing of the sorted shopping list data, wherein the facilitating comprises printing a descriptor for the item and the composite device-readable barcode.

Claims 34–43 and 45–54 stand rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

ISSUES

The issues of eligible subject matter turn primarily on whether the claims recite more than abstract conceptual advice of what a computer is to provide without implementation details.

ANALYSIS

Method claim 34 recites receiving store layout data, categorizing shopping list items, facilitating a display of the list, receiving optical scan selection data, generating and storing route information, and sorting and printing the shopping list data with device-readable composite barcode data. Thus, claim 34 recites receiving, analyzing, modifying, displaying, and printing data. None of the limitations recite implementation details for any of these steps, but instead recite functional results to be achieved by any and all possible means. Data retrieval, analysis, modification, display, and printing are all generic, conventional data processing operations to the point they are themselves concepts awaiting implementation details. The

sequence of data retrieval-analysis-modification-display-printing is equally
generic and conventional. The ordering of the steps is therefore ordinary
and conventional. The remaining claims merely describe process
parameters, with no implementation details.

> The Supreme Court

> set forth a framework for distinguishing patents that claim laws
> of nature, natural phenomena, and abstract ideas from those that
> claim patent-eligible applications of those concepts. First, . . .
> determine whether the claims at issue are directed to one of those
> patent-ineligible concepts. If so, we then ask, "[w]hat else is
> there in the claims before us? To answer that question, . . .
> consider the elements of each claim both individually and "as an
> ordered combination" to determine whether the additional
> elements "transform the nature of the claim" into a patent-
> eligible application. [The Court] described step two of this
> analysis as 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 Corp., Pty. Ltd. v CLS Bank Intl, 134 S. Ct. 2347, 2355 (2014) (citing
Mayo Collaborative Services v. Prometheus Laboratories, Inc., 566 U.S. 66
(2012)).

To perform this test, we must first determine whether the claims at
issue are directed to a patent-ineligible concept. The Examiner determines
the claims to be directed to organizing a shopping list according to the aisle
layout in a store and then sorting the list based on the actual route a shopper
takes when shopping at the store. This is considered to be an abstract idea
because it is amounts to nothing more than a method of organizing human
activity because it relates to how a person organizes his or her shopping list.
Final Act. 4–5.

Although the Court in *Alice* made a determination as to what the claims were directed to, we find that this case's claims themselves and the Specification provide enough information to inform one as to what they are directed to.

The preamble to claim 34 does not recite what it is directed to, but the steps in claim 34 result in printing a sorted shopping list having device-readable composite barcodes, absent any technological mechanism other than a conventional computer for doing so. The Specification at paragraph 1 recites that the invention relates to a personal automation and shopping system for automating or improving personal or business productivity, efficiency and goal attainment, and buying and selling of goods and services. Thus, all this evidence shows that claim 34 is directed to creating a sorted shopping list with barcodes, i.e., creating a list of what one wants to do. This is consistent with the Examiner's determination.

It follows from prior Supreme Court cases, and *Bilski* (*Bilski v Kappos*, 561 U.S. 593 (2010)) in particular, that the claims at issue here are directed to an abstract idea. Like the risk hedging in *Bilski*, the concept of creating a list of what one wants to do is a fundamental business practice long prevalent in our system of commerce. The use of creating a list of what one wants to do is also a building block of ingenuity in project management. Thus, creating a list of what one wants to do, like hedging, is an "abstract idea" beyond the scope of § 101. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2356.

As in *Alice*, we need not labor to delimit the precise contours of the "abstract ideas" category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of

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risk hedging in *Bilski* and the concept of creating a list of what one wants to do at issue here. Both are squarely within the realm of "abstract ideas" as the Court has used that term. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2357.

Further, claims involving data collection, analysis, and display are directed to an abstract idea. *Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (holding that "collecting information, analyzing it, and displaying certain results of the collection and analysis" are "a familiar class of claims 'directed to' a patent ineligible concept"); *see also In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016). Claim 34, unlike the claims found non-abstract in prior cases, uses generic computer technology to perform data retrieval, analysis, modification, display, and printing and does not recite an improvement to a particular computer technology. *See, e.g., McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314–15 (Fed. Cir. 2016) (finding claims not abstract because they "focused on a specific asserted improvement in computer animation"). As such, claim 34 is directed to the abstract idea of receiving, analyzing, modifying, displaying, and printing data.

The remaining claims merely describe process parameters. We conclude that the claims at issue are directed to a patent-ineligible concept.

The introduction of a computer into the claims does not alter the analysis at *Mayo* step two.

> [T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea "while adding the words 'apply it'" is not enough for patent eligibility. Nor is limiting the use of an abstract idea "'to a particular technological environment.'" Stating an abstract idea while adding the words "apply it with a

computer" simply combines those two steps, with the same deficient result. Thus, if a patent's recitation of a computer amounts to a mere instruction to "implement[t]" an abstract idea "on . . . a computer," that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our §101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of "additional feature[e]" that provides any "practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself."

Alice Corp. Pty. Ltd., 134 S. Ct. at 2358 (citations omitted).

"[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer." *Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2359. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer for receiving, analyzing, modifying, displaying, and printing data amounts to electronic data query and retrieval—one of the most basic functions of a computer. The limitation of receiving data via optical scan recites what has been a generic form of data entry for a long time. The limitation of generating a device-readable composite barcode for an item that represents a product code for the item aggregated with a numeric prefix that identifies the sorted shopping list data is no more than generating some form of data, as no particular implementation for how the data is generated or how it is formatted is recited. Indeed, generating such data by simply reading the data and copying it would be within the scope of the limitation, as copying data generates data. All of these computer functions are well-understood, routine, conventional activities previously known to the industry. *See Elec. Power Grp. v. Alstom S.A., supra. Also see In re Katz*

Interactive Call Processing Patent Litigation, 639 F.3d 1303, 1316 (Fed.Cir. 2011)("Absent a possible narrower construction of the terms 'processing,' 'receiving,' and 'storing,' . . . those functions can be achieved by any general purpose computer without special programming."). In short, each step does no more than require a generic computer to perform generic computer functions. As to the data operated upon, "even if a process of collecting and analyzing information is 'limited to particular content' or a particular 'source,' that limitation does not make the collection and analysis other than abstract." *SAP America Inc. v. InvestPic LLC*, 898 F.3d 1161, 1168 (Fed. Cir. 2018).

Considered as an ordered combination, the computer components of Appellant's method add nothing that is not already present when the steps are considered separately. The sequence of data retrieval-analysis-modification-display-printing is equally generic and conventional or otherwise held to be abstract. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (sequence of receiving, selecting, offering for exchange, display, allowing access, and receiving payment recited an abstraction), *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (sequence of data retrieval, analysis, modification, generation, display, and transmission), *Two-Way Media Ltd. v. Comcast Cable Communications, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (sequence of processing, routing, controlling, and monitoring). The ordering of the steps is therefore ordinary and conventional.

Viewed as a whole, Appellant's method claims simply recite the concept of creating a list of what one wants to do as performed by a generic computer. To be sure, the claims recite doing so by advising one to enter

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store layout and product selection data and generate a list that includes barcodes sorted based on the layout. But this is no more than abstract conceptual advice on the parameters for such creating a list of what one wants to do and the generic computer processes necessary to process those parameters, and do not recite any particular implementation.

The method claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in any other technology or technical field. The Specification spells out different generic equipment[3] and parameters that might be applied using this concept and the particular steps such conventional processing would entail based on the concept of creating a list of what one wants to do under different scenarios. They do not describe any particular improvement in the manner a computer functions. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of creating a list of what one wants to do using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2360.

> As to the structural claims, they

> are no different from the method claims in substance. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea. This Court has long "warn[ed] ... against" interpreting § 101"in ways that make patent eligibility 'depend simply on the draftsman's art.'"

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[3] The Specification describes using programmable, general or special purpose computing devices and optical character recognition via an image scanner, camera, or optical device. Spec. para. 155.

Id.

As to Appellant's Appeal Brief arguments, we adopt the Examiner's determinations and analysis from Final Action 2–6 and Answer 2–6 and reach similar legal conclusions. We now turn to the Reply Brief.

> We are not persuaded by Appellant's argument that claim 34
>
> differs from the claims at issue in *Accenture Global Servs., GmbH*[4] at least by inclusion of the substantive limitations of generating a device-readable composite barcode for an item of the shopping list items, wherein the composite device-readable barcode represents a product code for the item aggregated with a numeric prefix that identifies the sorted shopping list data; and facilitating, by the system, a printing of the sorted shopping list data, wherein the facilitating comprises printing a descriptor for the item and the composite device-readable barcode. Such meaningful limitations, when read with the other claim limitations as a while, tie down the claim in a manner that mitigates coverage of the alleged full abstract idea itself by restricting the alleged abstract idea to a practical application, wherein the practical application involves generation of a device-readable barcode representing a product code for an item aggregated with a numeric prefix that identifies sorted shopping list data. This device-readable barcode is not recited generically in claim 34. Instead, claim 34 (and similarly claims 43 and 51) recites that this device-readable barcode has a specific construction designed for use with the claimed electronic shopping system and methods.
>
> Reply Br. 4–5. As we determined *supra*, the limitation of generating

a device-readable composite barcode for an item that represents a product code for the item aggregated with a numeric prefix that identifies the sorted

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[4] *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336 (Fed.Cir.2013).

shopping list data is no more than generating some form of data, as no particular implementation for how the data is generated or how it is formatted is recited. Indeed, generating such data by simply reading the data and copying it would be within the scope of the limitation, as copying data generates data. To say this is a practical application is to say that most abstract ideas are practical applications to the extent they have practical benefits. But this is not a practical application in the sense of a concrete embodiment reciting and integrating specific technological implementation details.

> At that level of generality, the claims do no more than describe a desired function or outcome, without providing any limiting detail that confines the claim to a particular solution to an identified problem. The purely functional nature of the claim confirms that it is directed to an abstract idea, not to a concrete embodiment of that idea.

Affinity Labs of Texas, LLC v. Amazon.com Inc., 838 F.3d 1266, 1269 (2016).

Appellant goes on to compare these same limitations with several other cases, but the comparisons are unpersuasive for similar reasons. Reply Br. 5–9. At bottom, Appellant claims only the idea of printing such barcodes on a sorted list, and not the technological manner for doing so. This is the type of functional claiming without providing any limiting detail that confines the claim to a particular solution to an identified problem that the *Affinity Labs* Court described.

CONCLUSIONS OF LAW

The rejection of claims 34–43 and 45–54 under 35 U.S.C. § 101 as directed to a judicial exception without significantly more is proper.

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DECISION

The rejection of claims 34–43 and 45–54 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). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2011).

AFFIRMED