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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LUIS A. JIMENEZ and ANGELO N. CHACLAS

Appeal 2017-005117
Application 12/332,591
Technology Center 3600

Before MURRIEL E. CRAWFORD, PHILIP J. HOFFMAN, and CYNTHIA L. MURPHY, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1–5 and 7–15. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

BACKGROUND

Appellants' invention is directed to a kiosk that allows a user to obtain an address, provided the user is familiar with the location of the address Spec. 2.

Claim 1 is illustrative:

1. A mail kiosk comprising:
a processing device to control operation of the mail kiosk;
an input/output device coupled to the processor;
the processing device being programmed to provide a mailing address of a location to which a mailer desires to send a mail piece by:
requesting, using the input/output device, information about the location;
obtaining a map based on the information about the location input by the mailer and displaying the map, using the input/output device, to the mailer;
allowing the mailer to navigate through the map to select a specific location that corresponds to the location to which the mailer desires to send the mail piece;
obtaining an image of the specific location selected by the mailer and displaying the image, using the input/output device, to the mailer;
requesting confirmation from the mailer that the displayed image corresponds to the location to which the mailer desires to send the mail piece;
obtaining the mailing address of the location that corresponds to the displayed image upon confirmation by the mailer; and
providing the mailing address of the location to the mailer.

Appellants appeal the following rejection:

Claims 1–5 and 7–15 under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more.

PRINCIPLES OF LAW

An invention is patent-eligible if it claims a "new and useful process, machine, manufacture, or composition of matter." 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include implicit exceptions: "[l]aws of nature, natural phenomena, and abstract ideas" are not patentable. *E.g.*, *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014).

In determining whether a claim falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court's two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is "directed to" a patent-ineligible abstract idea. *See Alice*, 134 S. Ct. at 2356 ("On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk."); *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) ("Claims 1 and 4 in petitioners' application explain the basic concept of hedging, or protecting against risk."); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) ("Analyzing respondents' claims according to the above statements from our cases, we think that a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter."); *Parker v. Flook*, 437 U.S. 584, 594–595 (1978) ("Respondent's application simply provides a new and presumably better method for calculating alarm limit values."); *Gottschalk v. Benson*, 409

U.S. 63, 64 (1972) ("They claimed a method for converting binary-coded decimal (BCD) numerals into pure binary numerals.").

The patent-ineligible end of the spectrum includes fundamental economic practices, *Alice*, 134 S. Ct. at 2357; *Bilski*, 561 U.S. at 611; mathematical formulas, *Parker*, 437 U.S. at 594–95; and basic tools of scientific and technological work, *Gottschalk*, 409 U.S. at 69. On the patent-eligible side of the spectrum are physical and chemical processes, such as curing rubber, *Diamond*, 450 U.S. at 184 n.7, "tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores," and a process for manufacturing flour, *Gottschalk*, 409 U.S. at 69.

If the claim is "directed to" a patent-ineligible abstract idea, we then consider the elements of the claim—both individually and as an ordered combination—to assess whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2355. This is a search for an "inventive concept"—an element or combination of elements sufficient to ensure that the claim amounts to "significantly more" than the abstract idea itself. *Id.*

In addition, the Federal Circuit has held that if a method can be performed by human thought alone, or by a human using pen and paper, it is merely an abstract idea and is not patent-eligible under § 101. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) ("[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101."). Accordingly, the mental processes recited in independent claim 1, e.g., assimilating information, creating a hypothetical resource, mapping hypothetical and actual resources, determining a minimum parameter increase and reconciling a parameter

increase with a scheduling policy, remain unpatentable, even when automated to reduce the burden on the user of what once could have been done with pen and paper. *Id.* at 1375 ("That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*, [409 U.S. 63 (1972)].").

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 Comm'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).

ANALYSIS

Rejection under 35 U.S.C. §101

The Examiner holds that the claims are directed to a method for organizing human activities. Final Act. 6. The Examiner also holds that the claims are directed comparing new and stored information using rules to identify options and that the method of the claims could readily be performed by a human mind using maps, pens, and paper. Ans. 5-6.

We agree with the Examiner. As claim 1 is directed to requesting data about location, obtaining data in the form of a map, inputting data by allowing the mailer to select a location, and processing the data to obtain the

mailing address, claim 1 is clearly directed to the collection, analysis, storage, and transmission of data, which is an abstract idea.

We are not persuaded of error on the part of the Examiner by Appellants argument that the claims are not similar to any of the concepts found to be abstract because the claims are directed to the collection, storage, analysis, display, and transmission, which has been found to be directed to an abstract idea. *See e.g. Elec. Power Grp. v. Alstom S.A.*, at 1353.

Appellants also argue that the claim recitations of presenting a map, a user interacting with a kiosk, and allowing a user to navigate a map to select a location, is the same as managing relationships. We agree with the Examiner's response to this argument found on pages 5–6 and adopt same as our own. In any case, as the claims are directed to the collection, analysis, display, and transmission of data, even if Appellants are correct, the claims are directed to an abstract idea on this basis.

We are not persuaded of error on the part of the Examiner by Appellants' argument that the claims recite significantly more because of the recitations of a processing device and an input/output device, and steps that, when viewed in an ordered combination, constitute significantly more than an abstract idea. We agree with the Examiner's response to this argument found on page 7 of the Answer. Specifically, as Appellants' own Specification discloses that the processor can be any type of general computer or the like, and that the input/output device may be a keyboard, mouse, or the like, the recitations of a processing device and input/output device are no more than the recitation of a general purpose computer.

We are not persuaded of error on the part of the Examiner by Appellants' argument that the claims do not preempt the broad category of organizing human activity, while preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility. *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), cert, denied, 136 S. Ct. 701, 193 (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."). And, "[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.

In view of the foregoing, we will sustain the Examiner's rejection of claim 1. We will also sustain the Examiner's rejection as it is directed to the remaining claims because the Appellants have not argued the separate patent eligibility of these claims.

DECISION

We affirm the Examiner's 35 U.S.C. § 101 rejection.

TIME PERIOD

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) (2009).

ORDER

AFFIRMED