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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHEW B. KENIGSBERG, GLENN LARSEN, and
ASHISH MEHTA¹

Appeal 2017-006010
Application 12/019,201
Technology Center 3600

Before MURRIEL E. CRAWFORD, BIBHU R. MOHANTY, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–4, 7, 20–25, 28, 30, 31, and 33, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

¹ The real party in interest is FMR LLC. App. Br. 2.

THE INVENTION

The Appellants' claimed invention is directed to methods and apparatuses for generating a savings plan (Spec., para. 1). Claim 1, reproduced below with the italics added, is representative of the subject matter on appeal.

1. A computer implemented method for generating a savings prioritization for financial accounts of a user, the method comprising:

receiving, by a computing device, financial information of the user including (a) plural existing debt accounts, (b) plural existing savings accounts, and (c) one or more sources of income;

receiving, by the computing device, retirement information comprising a current age of the user, a projected retirement age of the user, and investment criteria for the user;

assigning, by the computing device, each existing debt account and each existing savings account to one of a plurality of debt account categories or one of a plurality of savings account categories, respectively;

generating, by the computing device, a plurality of prioritized listings of (i) the plural savings account categories into which funds from the one or more sources of income should be saved and (ii) the plural debt account categories that should be paid down with the funds from the one or more sources of income, until the projected retirement age of the user;

eliminating, by the computing device, one or more undesirable prioritized listings from the plurality of prioritized listings using business rules that dictate that a first category type must outrank a second category type, the business rules being based on financial characteristics associated with the savings accounts and the debt accounts assigned to the first category type and the second category type;

forming, by the computing device, a subset of the plurality of prioritized listings, the subset being the plurality of

prioritized listings with the one or more undesirable prioritized listings excluded;

analyzing, by the computing device, all listings in the subset of the plurality of *prioritized listings to determine a single savings prioritization* that results in the combined future value of all assets in the accounts being maximized;

quantifying, by the computing device, *the single savings prioritization either in terms of units of currency available at the projected retirement age of the user or in terms of number of years money is available after the projected retirement age of the user*; and

displaying, by the computing device, *the units of currency or the number of years*.

THE REJECTION

Claims 1–4, 7, 20–25, 28, 30, 31, and 33 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.²

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellants argue that the rejection of claim 1 is improper because the claim is not directed to an abstract idea (App. Br. 12–16; Reply Br. 3).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

The Appellants argue further that the claim is “significantly more” than the alleged abstract idea (App. Br. 16–22; Reply Br. 4–7).

In contrast, the Examiner has determined that the rejection of record is proper (Final Action 2–6; Ans. 3–13).

We agree with the Examiner. An invention is patent eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“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.”); *see also 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.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes,

such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1853))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 176; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (internal citation omitted) (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

The PTO recently published revised guidance on the application of § 101. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”). Under the Guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and

(2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

(3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or

(4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See Guidance.

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an “‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (citation omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (alterations in original) (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

Here, the Examiner has determined that the claim is directed to the concept of “generating a saving prioritization for financial accounts for a user,” which is an “organizing [of] human activity” and therefore an abstract idea (Ans. 8). We substantially agree with the Examiner in this regard as claim 1 is directed to the steps that are italicized in the claim above. These steps are directed to the concept of receiving financial information for a user and generating a savings prioritization for them based

on their data which is a method of organizing human activities and a fundamental economic practice and an abstract idea. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016) (collecting information, analyzing it, and displaying results from certain results of the collection and analysis was held to be an abstract idea). A system, like the claimed system, “a process that employs mathematical algorithms to manipulate existing information to generate additional information is not patent eligible.” *See Digitech Image Techs, LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014). In *Intellectual Ventures I LLC v. Capital One Financial Co.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017) it was held that collecting, displaying, and manipulating data was directed to an abstract idea. In *OIP Technologies, Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) it was held that offer-based price optimization was directed to an abstract idea. Thus, we consider the claim to be directed to an abstract idea as identified above.

Turning to the second step of the *Alice* and *Mayo* framework, we determine that the claim does not contain an inventive concept sufficient to “transform” the abstract nature of the claim into a patent-eligible application. The claims do not improve computer functionality, improve another field or technology, utilize a particular machine, or effect a physical transformation. Rather, we determine that nothing in the claims imposes a meaningful limit on the judicial exception, such that the claims are more than a drafting effort to monopolize the judicial exception.

For example, in claim 1 the steps of [1] “receiving, by a computing device, financial information of the user”; [2] “receiving, by the computing device, retirement information”; [3] “assigning, by the computing device”

debt account categories or savings account categories; [4] “generating, by the computing device, a plurality of prioritized listings of . . . savings account categories . . . and . . . plural debt categories”; [5] “analyzing, by the computing device, all the listings . . . to determine a single savings prioritization”; [6] “quantifying, by the computing device, the single savings prioritization”; and [7] “displaying, by the computing device, the units of currency or the number of years”; are merely conventional steps performed by a generic computer that do not improve computer functionality. That is, these recited steps [1]–[7] “do not purport to improve the functioning of the computer itself” but are merely generic functions performed by a conventional processor. Likewise, these same steps [1]–[7] listed above do not improve the technology of the technical field and merely use generic computer components and functions to perform the steps. Also, the recited method steps [1]–[7] above do not require a “particular machine” and can be utilized with a general purpose computer, and the steps performed are purely conventional. In this case the general purpose computer is merely an object on which the method operates in a conventional manner and does not provide “significantly more” to the claim beyond a nominal or insignificant execution of the method. Further, the claim as a whole fails to effect any particular transformation of an article to a different state in a manner that would render the claim “significantly more” than the abstract idea. The recited steps [1]–[7] fail to provide meaningful limitations to limit the judicial exception and rather are mere instructions to apply the method to a generic computer. Considering the elements of the claim both individually and as “an ordered combination” the functions performed by the computer system at each step of the process are purely conventional. Each step of the

claimed method does no more than require a generic computer to perform a generic computer function.

Further the claim fails to add a specific limitation beyond the judicial exception that is not well-understood, routine, and conventional in the field. Rather the claim uses well-understood, routine, and conventional activities previously known in the art at a high level of generality to the judicial exception. The Specification at paragraphs 86–96 for example describes using conventional computer components including a laptop, web browser, and networks in a conventional manner. The claim specifically includes recitations for a “computing device” to implement the method but these computer components are all used in a manner that is well-understood, routine, and conventional in the field. The Appellants have not shown these claimed generic computer components which are used to implement the claimed method are not well-understood, routine, or conventional in the field. The Appellants have not demonstrated that the “computing device” and associated hardware described in the Specification are not a general purpose computer components beyond those known to be routine and conventional known to perform similar functions in a well-understood manner.

The Appellants have also cited to *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016) to show that the claim is not abstract but the claims in that case were not similar in scope to those here in contrast and were in contrast directed to a self-referential data table. The Appellants have also cited to *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016) but the claims in that case are distinguished from this case in being directed to rules for lip sync and facial expression animation.

We note the argument about pre-emption (App. Br. 15, 16). While pre-emption “‘might tend to impede innovation more than it would tend to promote it’, thereby thwarting the primary object of the patent laws” (*Alice*, 573 U.S. at 216 (quoting *Mayo*, 566 U.S. at 71), “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.*, 788 F.3d at 1362–63, cert. denied, 136 S. Ct. 701 (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.”).

For these reasons the rejection of claim 1 is sustained. The Appellants have presented the same arguments for the remaining claims, which are drawn to similar subject matter, and the rejection of these claims is sustained as well.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1–4, 7, 20–25, 28, 30, 31, and 33 are rejected under 35 U.S.C. § 101.

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DECISION

The Examiner's rejection of claims 1–4, 7, 20–25, 28, 30, 31, and 33 is sustained.

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED