



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/022,003	09/09/2013	Robert C. Dorr	2043.284US2	1006
49845	7590	10/15/2018	EXAMINER	
SCHWEGMAN LUNDBERG & WOESSNER/EBAY P.O. BOX 2938 MINNEAPOLIS, MN 55402 UNITED STATES OF AMERICA			HAMILTON, LALITA M	
			ART UNIT	PAPER NUMBER
			3691	
			NOTIFICATION DATE	DELIVERY MODE
			10/15/2018	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM
SLW@blackhillsip.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT C. DORR

Appeal 2017-006607
Application 14/022,003¹
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Robert C. Dorr (Appellant) seeks our review under 35 U.S.C. § 134(a) of the non-final rejection of claims 1–6, 8–15, and 17–22. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

¹ The Appellant identifies eBay Inc. as the real party in interest. App. Br. 2.

1. A method comprising:

determining, using one or more processors of a computer system, an interest in a type of an item by a prospective buyer based on an action by the prospective buyer with respect to a screen associated with the type of the item;

selecting a classification of items stored in a memory of the computer system based on a correlation between the type of the item and keywords associated with the classification of items;

generating a sales lead pertaining to the classification of items for insertion into the memory of the computer system; and

delivering the sales lead to a seller of at least one of the items included in the classification of the items, the delivering including transferring the sales lead from the memory of the computer system to a memory of a machine of the seller.

THE REJECTIONS

The following rejection is before us for review:

Claims 8–14 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.²

Claims 1–6, 8–15, and 17–22 are rejected under 35 U.S.C. § 101 as being directed to judicially-expected subject matter.

² This rejection, raised in the Non-Final Rejection that has been appealed, is not mentioned in the Answer. However, we see no statement expressly withdrawing it. Accordingly, we presume it is being maintained.

Claims 1–6, 8–15, and 17–22 are rejected on the ground of nonstatutory double patenting over claims 1–21 of U.S. Patent No. 8,533,094.³

ISSUES

Did the Examiner err in rejecting claims 8–14 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter?

Did the Examiner err in rejecting claims 1–6, 8–15, and 17–22 under 35 U.S.C. §101 as being directed to judicially-expected subject matter?

Did the Examiner err in rejecting claims 1–6, 8–15, and 17–22 on the ground of nonstatutory double patenting over claims 1–21 of U.S. Patent No. 8,533,094?

ANALYSIS

The rejection of claims 8–14 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

The Examiner’s position is:

Claims 8-14 directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See, *e.g.*, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

³ This rejection appears in the Final Rejection mailed Apr. 25, 2014 and was indicated as over claims 1–20. An amendment filed July 14, 2015 rendered the pending claims as claims 1–6, 8–15, and 17–22. Both the Non-Final Rejection mailed (Jan. 22, 2016) and the Answer mailed (Jan. 17, 2017) indicate that “[t]he double patenting rejection is maintained” (pages 5 and 2, respectively). Presumably, the Examiner means to maintain the rejection as to the currently pending claims 1–6, 8–15, and 17–22.

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. See, e.g., *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987).

The structural limitations of instant claims 8-14 are interpreted as computer code per-se and are therefore not statutory subject matter. Computer code does not fall one of the four statutory classes of invention.

To overcome this rejection, Applicant could amend the body of the claim language with "**processor and memory combined with processor ...**".

Non-Final Rej. 5–6.

We will reverse the rejection because we do not understand it.⁴ The rejection is apparently of the “software per se” variety. See MPEP, (Rev. 9, Aug. 2012; 2106 Patent Subject Matter Eligibility; I. THE FOUR CATEGORIES OF STATUTORY SUBJECT MATTER; Step 1: “vi. a computer program per se, *Gottschalk v. Benson*, 409 U.S. at 72.” Our difficulty is that the Examiner does not adequately explain what precisely is being “interpreted as computer code per-se.” A claim construction analysis would have been helpful.

Claim 8 calls for a “memory field” that (a) is set up in a memory of a computer system and (b) configures a processor of the computer system to perform the recited information “determin[ing],” “select[ing],”

⁴ Notwithstanding this rejection, later in the Non-Final Action the Examiner indicates the opposite: that the claimed subject matter is statutory. See page 7: “Each of the method, system and medium claims fall into one of the four statutory categories of the invention.”

“generat[ing],” and “deliver[ing]” steps. It is not entirely clear from reading the claim what a “memory field” is. However, when read in light of the Specification, it apparently refers to a conventional database field.

Para. 22 of the Specification states that “[t]he on-line auction service 500 then sets up the *memory field* shown in Figure 3 for memory 300 for the seller and for the item so that when a prospective buyer such as buyer 530 accesses the online auction web site his/her e-mail address is recorded and stored in memory 300.” Emphasis added. Figure 3 shows a box (300) with particular words (320, 220, 210, 310) in it. Box 300 “can be a conventional relational database.” Para. 20. Accordingly, it follows that “memory field” refers to a field in database 300. Since a database field is a record or file within which to place information, that is what the claim term “memory field” is reasonably broadly construed to encompass.

Thus, when read in light of the Specification, claim 8 is drawn to a record or file of a conventional database for “determin[ing],” “select[ing],” “generat[ing],” and “deliver[ing]” the particular types of information recited in claim 8.

In that light, claim 8 is not necessarily directed to “computer code per se.”

The rejection is not sustained.

The rejection of claims 1–6, 8–15, and 17–22 under 35 U.S.C. § 101 as being directed to judicially-expected subject matter.

The Appellant argued these claims as a group. *See App. Br. 17–24.* We select claim 1 as the representative claim for this group, and the

remaining claims 2–6, 8–15, and 17–22 stand or fall with claim 1.37 C.F.R. § 41.37(c)(1)(iv).

Alice Corp. Proprietary Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent-eligibility under 35 U.S.C. § 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 that regard, the Examiner determined that

claims 1-6 and 21-22 are directed to a method for delivering sales leads to a seller. Claims 8-14 are directed to a system for delivering sales leads to a seller. Claims 15 and 17-20 are directed to a medium for delivering sales leads to a seller.

Non-Final Rej. 7. The Examiner also made the determination that “[c]laim(s) 1[-]6, 8-15, and 17-22 are directed to the abstract idea of online auctioning.” Non-Final Rej. 7.

We are satisfied the Examiner provided sufficient reasoning to put the Appellant on notice that, under step one of the *Alice* analytical framework, a determination has been made that the claim 1 is directed to an abstract idea because (a) the claim has been characterized as being directed to “online auctioning” and (b) “online auctioning” is an abstract idea. *See* 35 U.S.C. § 132 which sets forth a more general notice requirement whereby the applicant is notified of the reasons for a rejection together with such information as may be useful in judging the propriety of continuing with prosecution of the application.

The Appellant understands the Examiner to be taking the position that claim 1 is directed to “online auctioning.” *See* App. Br. 18 (“the Examiner merely made conclusory statements that ‘the claims are directed to the abstract idea of online auctioning.’”)

However, according to the Appellant, “the claims at issue are [instead] directed to a particular operations pertaining to selecting a classification of items based on a correlation between a type of an item and keywords associated with the classification of items and generating and delivering a sales leads” (App. Br. 21), those operations being

selecting a classification of items stored in a memory of the computer system based on a correlation between the type of the item and keywords associated with the classification of items;

generating a sales lead pertaining to the classification of items for insertion into the memory of the computer system.

Claim 1.

Accordingly, there is a disagreement as to what claim 1 is directed to.

The Appellant understands the Examiner to be taking the position that “online auctioning” is an abstract idea and understands the Examiner to be citing *Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057 (Fed. Cir. 2011) and *BuySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350 (Fed. Cir. 2014) in support of that position (*see* Non-Final Rej. 3). The Examiner appears to cite these decisions because “the decisional mechanism courts now apply [to help answer the question of whether online auctioning] is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided,” *Amdocs (Israel) Limited v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016).

The Appellant does not appear to disagree with the Examiner’s position that “online auctioning” *per se* is an abstract idea. We do not see that as being in dispute. *Cf. The Jewelry Channel, Inc. USA d/b/a Liquidation Channel v. America's Collectibles Network, Inc.*, 2014 WL 5386840 (PTAB 2014), *aff'd*, 2017 WL 104471 (Mem) (Fed. Cir. 2017) (“conducting a reverse auction by adjusting the price and available quantities of units based on monitored preliminary indicators, i.e., characteristics of the calls and the auction's progress” is an abstract idea) and *Priceplay.com, Inc. v. AOL Advert., Inc.*, 83 F. Supp. 3d 577 (D. Del. 2015), *aff'd*, 627 F. App'x 925 (Fed. Cir. 2016) (“[p]erforming a sales transaction over the Internet, or in conjunction with an auction and a competitive activity” is an abstract idea).

The Appellant, however, argues that “the cases cited by the Examiner are either not applicable to the claims at issue in this case or demonstrate why, contrary to the Examiner's assertion, the claims at issue in this case *are* directed to patent-eligible subject matter.” App. Br. 19.

[T]he claims recite particular operations pertaining to selecting a classification of items based on a correlation between a type of an item and keywords associated with the classification of items and ***generating and delivering a sales lead pertaining to the classification of items***. ... [T]he claims at issue in this case are not directed to an abstract idea-----e.g., they put the idea to practical use.

App. Br. 21.

In other words, the Appellant is arguing that the claims are directed to “particular operations [as claimed] pertaining to selecting a classification of items based on a correlation between a type of an item and keywords

associated with the classification of items and generating and delivering a sales leads” (App. Br. 21) and those operations are not an abstract idea, thus claim 1 is not directed to an abstract idea.

Before we can determine whether claim 1 is directed to an abstract idea, we must first resolve the question of what claim 1 is directed to. Is it directed to “online auctioning” (Non-Final Rej. 7) or is it directed to “particular operations [as claimed] pertaining to selecting a classification of items based on a correlation between a type of an item and keywords associated with the classification of items and generating and delivering a sales leads” (App. Br. 21)?

This question implicates the “directed to” inquiry.

The “directed to” inquiry [] cannot simply ask whether the claims involve a patent-ineligible concept, because essentially every routinely patent-eligible claim involving physical products and actions involves a law of nature and/or natural phenomenon—after all, they take place in the physical world. *See Mayo*, 132 S. Ct. at 1293 (“For all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.”) Rather, the “directed to” inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether “their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015); *see Genetic Techs. Ltd. v. Merial L.L.C.*, [] 2016 WL 1393573, at *5 (Fed. Cir. 2016) (inquiring into “the focus of the claimed advance over the prior art”).

Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1335 (Fed. Cir. 2016).

With respect to computer-enabled claimed subject matter, it can be helpful to determine whether “the claims at issue [] can readily be understood as simply adding conventional computer components to well-

known business practices” or not. *Id.* at 1338. *See also Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

In *Enfish*, for example, the court noted that “[s]oft ware can make non-abstract improvements to computer technology just as hardware improvements can[.]” *Id.* The court put the question as being “whether the focus of the claims is on [a] specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish* at 1335–1336. In *Enfish*, the court found that the “plain focus of the claims” there was on “an improvement to computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity.” *Id.* at 1336.

“In determining the eligibility of respondents' claimed process for patent protection under § 101, their claims must be considered as a whole.” *Diamond v. Diehr*, 450 U.S. 175, 188 (1981). The question is whether claim 1 as a whole “focus[es] on a specific means or method that improves the relevant technology” or is “directed to a result or effect that itself is the abstract idea and merely invoke[s] generic processes and machinery.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016).

Claim 1 covers “[a] method comprising” four steps:

- “determining” information A;
- “selecting” information B;
- “generating” information C; and,
- “delivering” information D;

where

A = “an *interest* in a type of an item by a prospective buyer based on an action by the prospective buyer with respect to a screen associated with the type of the item”;

B = “a *classification* of items . . . based on a correlation between the type of the item and keywords associated with the classification of items”;

C = “a *sales lead* pertaining to the classification of items”; and,

D = “the *sales lead* to a seller of *at least one of the items* included in the classification of the items.” (emphasis added).

Claim 1 sets forth a series of steps whereby a sales lead for an item a buyer is interested in is delivered to a seller, the item having been classified according to a correlation between its type and a keyword. The four steps employ “a memory of [a] computer system” (claim 1) which is conventional. *See* Spec. para. 20 (“It is to be expressly understood that memory 300 and 400 can be the same memory and that the data fields can be combined together. In this environment, it can be a conventional relational database.”)

The plain focus of the claim is not on any improvement to computer functionality itself but on tasks for which a generic computer is used in its ordinary capacity so that various types of information can be “determin[ed],” “select[ed],” “generat[ed],” and “deliver[ed].” The different types of information are distinguished by their content. In particular, they are related to forming and communicating a sales lead for a classified item.

Accordingly, in this case, claim 1 as a whole is focused not on any asserted new technology but on using a generic computer to process different types of information in furtherance of a sales lead for a classified item. *Cf. In re TLI Communications LLC Patent Litigation*, 823 F.3d 607, 613 (Fed. Cir.

2016)(the claims' focus “was not on an improved telephone unit or an improved server.”)

In addition, “[t]he ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas v. DirectTV, LLC*, 838 F.3d at 1257 (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); see also *Enfish, LLC v. Microsoft Corp.*, 822 F.3d at 1335, quoted in *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1241 (Fed. Cir. 2016).

In that regard, the Specification states that “[t]he present invention relates to online auctioning.” Para. 2. The Background section of the Specification discusses the problem, which is that “[a] need exists to provide a service to retail sales organizations that use online auction services to generate sales leads.” Para. 6. According to the Specification, the inventor solved the problem “by providing a unique and novel method for generating sales leads based upon not only actual bidders to an item being auctioned but also to those prospective bidders that visit the web page for an item being auctioned.” Para. 7.

In light of Specification's description of the problem and solution, the advance over the prior art by the invention is in generating sales leads based on prospective bidders in the context of online auctions. This is the heart of the invention. *Cf. Intellectual Ventures I LLC v. Erie Indemnity Company*, 850 F.3d 1315, 1328 (Fed. Cir. 2017)(“the heart of the claimed invention lies in creating and using an index to search for and retrieve data . . . an abstract concept.”)

However, notwithstanding the heart of the invention is in generating sales leads based on prospective bidders in the context of online auctions, claim 1 is not limited to online auctions. “The § 101 inquiry must focus on the language of the Asserted Claims themselves.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1149 (Fed. Cir. 2016). *See Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1345 (Fed. Cir. 2013) (admonishing that “the important inquiry for a § 101 analysis is to look to the claim”); *see also Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1346 (Fed. Cir. 2014) (“We focus here on whether the claims of the asserted patents fall within the excluded category of abstract ideas.”).

Accordingly, the Examiner’s characterization of the claims as being directed to “online auctioning” (Non-Final Rej. 7) is inaccurate. Although such a characterization reflects the heart of the invention, it does not reflect what claim 1 recites. In fact, “online auctioning” is not mentioned in claim 1, or in any other claim on appeal.

By contrast, the Appellant’s characterization of what the claims are directed to (i.e., “particular operations [as claimed] pertaining to selecting a classification of items based on a correlation between a type of an item and keywords associated with the classification of items and generating and delivering a sales leads” (App. Br. 21)) more closely aligns to what the claims are reasonably characterized as being “directed to” (i.e., on tasks for which a generic computer is used in its ordinary capacity so that various types of information can be “determin[ed],” “select[ed],” “generat[ed],” and “deliver[ed]”). The Appellant’s characterization is simply at a lower level of

abstraction. *See Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1240–1241 (“An abstract idea can generally be described at different levels of abstraction. As the Board has done, the claimed abstract idea could be described as generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location. It could be described in other ways, including, as indicated in the specification, taking orders from restaurant customers on a computer.”)

We now turn to the question of whether claim 1 is "directed to" an abstract idea.

When “the focus of the asserted claims” is “on collecting information, analyzing it, and displaying certain results of the collection and analysis,” the claims are directed to an abstract idea. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d at 1343. Since “[d]etermining,” “selecting,” “generating,” and “delivering” information is analogous to collecting, analyzing and displaying information, it follows that the “determining,” “selecting,” “generating,” and “delivering” information concept to which claim 1 is directed to is an abstract idea.

Even when limited to particular content, information collection, analysis, and displaying remains within the realm of abstract ideas. Thus, notwithstanding that, in order to form and communicate a sales lead for a classified item, claim 1 calls upon certain types of information to be “determin[ed],” “select[ed],” “generat[ed],” and “deliver[ed],” the abstract nature of the concept remains unchanged. *See SAP America, Inc. v. Investpic, LLC*, 898 F.3d 1161, 1167 (Fed. Cir. 2018) (“Contrary to InvestPic's suggestion, it does not matter to this conclusion whether the

information here is information about real investments. As many cases make clear, 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.” (*Quoting Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d at 1355 (citing cases).) *Also, Praxair Distribution, Inc. v. Mallinckrodt Hospital Products IP Ltd.*, 890 F.3d 1024, 1032 (Fed. Cir. 2018)(“[c]laim limitations directed to the content of information and lacking a requisite functional relationship are not entitled to patentable weight because such information is not patent eligible subject matter under 35 U.S.C. § 101.”)

For the foregoing reasons, the claims are directed to the abstract idea of “determining,” “selecting,” “generating,” and “delivering” information (via a generic computer used in its ordinary capacity). Accordingly, while we agree with the Appellant’s suggestion that the Examiner’s characterization of what the claims are directed to is incorrect, the claims are still directed to an abstract idea even under a more reasonable characterization. For that reason, we are unpersuaded as to error in the Examiner’s determination that claim 1 is directed to an abstract idea.

We now turn to the second step in the analytical framework.

Step two is “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 (*quoting Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 US 66, 73 (2012)).

In that regard, the Examiner determined that

[t]he claim(s) does/do not include additional elements that are sufficient to amount to significantly more than the judicial exception, because the additional elements are simply a generic recitation of a computer and a computer network performing their generic computer functions. The Applicant's specification states the following:

[0021] In Figure 5, the block diagram environment showing the implementation of the method of the present invention is generally set forth. It is well within the skill of the art to set up Internet businesses including on-line auction services. An on-line auction service 500 is shown interconnected to a communications network 510 over connection 520. The communication network 510 can comprise many different components and is essentially transparent to the on-line auction service 500. Also connected to the communication network 510 is at least one prospective buyer 530 in communication with the network over communication link 540 and at least one seller 550 also in communication with the network 510 over communication link 560. Typically, the prospective buyer 530 and the seller 550 have home based or office based personal computers which are readily available from a large number of sources. Each computer system 530 and 550 is conventionally interconnected to the network 510 over a suitable communication device such as a modem or a DSL line 540, 560.

The claims amount to no more than stating determining, selecting, generating, and delivering on a computer and send it over a network.

Taking the elements both individually and as a combination, the computer components in claims 1-6, 8-15, and 17-22 perform purely generic computer functions. The independent and dependent claims as a whole do not amount to significantly more than the abstract idea itself.

Non-Final Rej. 8.

The Appellant argues:

The claims at issue recite setting up of one or more memory fields in a memory of one or more computer systems, the one or more memory fields configuring one or more processors of the one or more computer systems to perform various operations. The recited operations cannot be performed by a generic computer, such as a computer for which the memory fields are not set up to configure the one or more processors to perform the recited operations. . . . [T]he claims at issue in this case are directed to a computer-centric problem and have a solution that is necessarily in computer technology. For example, the claims at issue are directed to providing a sales lead to a seller of an item included in a classification of items stored in a memory of a computer system based on an action of a prospective buyer with respect to a user interface screen associated with a type of an item and a correlation between the type of the item and keywords associated with the classification of items, which is a technique that is not only rooted in computer technology, but is one that the Examiner has conceded is novel and non-obvious over the prior art.

App. Br. 22–23.

The argument is not commensurate in scope with what is claimed. We see nothing in the claim about “setting up of one or more memory fields” “to configure the one or more processors to perform the recited operations.”

Claim 1 mentions “memory” but simply to store information. *See* claim 1 (“selecting [information] stored in a memory”; “generating [information] for insertion into the memory”; and “delivering including transferring [information] from the memory of the computer system to a memory of a machine of the seller”). Not only does the Specification (para. 20) expressly disclose “memory fields” as conventional means for storing information, but storing information in memory is itself an abstract idea. Without more, the claim recitations of “memory” for performing its common storing function are insufficient to add anything significant to the “determining,” “storing,” “generating,” and “delivering” abstract idea so as

to transform the abstract idea into an inventive concept. *Cf. In re TLI Commc'ns*, 823 F.3d at 611 (“the abstract idea of classifying and storing digital images in an organized manner.”)

We have carefully considered the Appellant’s arguments presented in the Briefs. The difficulty here is that claim 1 has been drafted so that as a whole it provides no more than a result-oriented solution (“determining,” “storing,” “generating,” and “delivering”) without any of the computer-centric details necessary for accomplishing it. The Appellant suggests such details in arguing over “setting up” “memory fields.” But claim 1 does not now reflect those details. *Cf. Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1342 (Fed. Cir. 2017) (explaining that “[o]ur law demands more” than claim language that “provides only a result-oriented solution, with insufficient detail for how a computer accomplishes it”) and *Elec. Power Grp.*, 830 F.3d at 1354 (explaining that claims are directed to an abstract idea where they do not recite “any particular assertedly inventive technology for performing [conventional] functions”). As claimed, the “memory” “is merely a conduit for the abstract idea” (*In re TLI Commc'ns*, 823 F.3d at 612).

We have considered all of the Appellant’s remaining arguments, including those pertaining to the dependent claims (App. Br. 23) and those made in the Reply Brief, and find them unpersuasive. Accordingly, because we are not persuaded as to error in the determinations that representative claim 1, and claims 2–6, 8–15, and 17–22 which stand or fall with claim 1, are directed to an abstract idea and do not present an “inventive concept,” we sustain the Examiner's conclusion that they are directed to patent-

ineligible subject matter for being judicially-excepted from 35 U.S.C. § 101. *Cf. LendingTree, LLC v. Zillow, Inc.*, 656 Fed.Appx. 991, 997 (Fed. Cir. 2016)(“We have considered all of LendingTree's remaining arguments and have found them unpersuasive. Accordingly, because the asserted claims of the patents in suit are directed to an abstract idea and do not present an ‘inventive concept,’ we hold that they are directed to ineligible subject matter under 35 U.S.C. § 101.”); *see also, e.g., OIP Technologies, Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1364 (Fed. Cir. 2015) and *FairWarning IP, LLC v. Iatric Systems, Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016).

The rejection of claims 1–6, 8–15, and 17–22 on the ground of nonstatutory double patenting over claims 1–21 of U.S. Patent No. 8,533,094.

The Appellant does not appear to have responded to this rejection. Accordingly, it is summarily affirmed.

CONCLUSIONS

Claims 8–14 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter is reversed.

Claims 1–6, 8–15, and 17–22 are rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter is affirmed.

Claims 1–6, 8–15, and 17–22 are rejected on the ground of nonstatutory double patenting over claims 1–21 of U.S. Patent No. 8,533,094 is affirmed.

Appeal 2017-006607
Application 14/022,003

DECISION

The decision of the Examiner to reject claims 1–6, 8–15, and 17–22 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)(1)(iv).

AFFIRMED