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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN NEWMAN FAITH, MATTHEW ALAN HOWITT, and
EITHAN ZILKHA

Appeal 2017-006744
Application 13/836,808
Technology Center 3600

Before ERIC B. CHEN, HUNG H. BUI, and MICHAEL J. ENGLE,
Administrative Patent Judges.

Opinion for the Board filed by *Administrative Patent Judge* ERIC B. CHEN.

Dissent by *Administrative Patent Judge* HUNG H. BUI.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 18–28. Claims 1–17 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

Appellants' invention relates to identifying an offers engine configured to provide information about offers to users. (Abstract.)

Claim 18 is exemplary:

18. A tangible, non-transitory, machine-readable medium storing instructions that, when executed by data processing apparatus, cause the data processing apparatus to perform operations comprising:

installing an offers application on a user device, wherein installing the offers application includes registering the offers application in memory of the user device as a designated application to handle offers intents, the offers intents being asynchronous calls from another application to request services related to offers; and

handling, with a processor, an offers intent upon another application accessing the offers intent, wherein handling the offers intent comprises:

launching the offers application;

receiving, with the offers application, an action related to offers and specified in the handled offers intent;

receiving, with the offers application, a parameter related to offers and specified in the handled offers intent; and

performing, with the offers application, the action based on the parameter.

Claims 18–28 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.

The rejection of claims 18–20, 24, 25, 27, and 28 under 35 U.S.C. § 102(e) has been withdrawn by the Examiner. (Ans. 2.)

The rejection of claims 21–23 and 26 under 35 U.S.C. § 103(a) has been withdrawn by the Examiner. (*Id.*)

ANALYSIS

We are persuaded by Appellants' arguments (App. Br. 3–4) that the Examiner has not satisfied the initial burden of demonstrating that independent claim 18 is directed to patent-ineligible subject matter under 35 U.S.C. § 101.

The Examiner determined that the claims “are directed to abstract idea receiving from a user search parameters or criteria associated with offers or promotions and providing a display of relevant offers associated with the parameters or criteria” (Final Act. 2) and “closely resembles the abstract idea of Managing a Game of Bingo” (*id.* at 3). In particular, the Examiner determined that the “invention is similar to the case of Planet Bingo, LLC v. VKGS LLC because it relates to the concepts of using a computer to receive and track selections of criteria or parameters with respect to offers or promotions to be displayed.” (Ans. 7; *see also* Final Act. 3.)

Although the Examiner generally states that independent claim 18 “relates to the concepts of using a computer to receive and track selections of criteria or parameters with respect to offers or promotions to be displayed” with a citation to *Planet Bingo* (Ans. 7), such statement does not provide a reasoned rationale that identifies the judicial exception recited in the claim and why it is considered an exception. In particular, in *Planet Bingo*, the Federal Circuit articulated that the claims “recite[] the steps of selecting, storing, and retrieving two sets of numbers, assigning a player identifier and a control number, and then comparing a winning set of bingo numbers with a selected set of bingo numbers.” *Planet Bingo, LLC v. VKGS LLC*, 576 F. App’x 1005, 1007–8 (Fed. Cir. 2014). While claim 18, a machine-readable medium claim for performing operations, recites “installing an offers application on a user device” and “handling . . . an offers intent,” such offers intent including receiving offers based upon parameters, the Examiner has not adequately articulated why the claimed concepts are analogous to managing a game of bingo. Therefore, the

Examiner has not satisfied the prima facie burden of clearly articulating the reasons why the claimed invention is not eligible.

Accordingly, we are persuaded by Appellants' arguments that:

The rejection does not properly identify an abstract idea to which the claims are directed. The Examiner has identified an idea only tangentially related to the claims and, then, announced that idea abstract. . . . To reject claims under Alice, the Examiner must analyze the subject matter to which the claims are directed, not some concept merely involved in the claims.

(App. Br. 3–4.)

Thus, we do not sustain the rejection of claim 18 under 35 U.S.C. § 101. Claims 19–28 depend from independent claim 18. We do not sustain the rejection of claims 19–28 under 35 U.S.C. § 101 for the same reasons discussed with respect to independent claim 18.

DECISION

The Examiner's decision rejecting claims 18–28 is reversed.

REVERSED

DISSENTING OPINION

BUI, *Administrative Patent Judge*.

I respectfully disagree with the majority decision to reverse the Examiner’s rejection of claims 18–28 under 35 U.S.C. § 101.

To determine whether subject matter is patent-eligible under § 101, the Supreme Court has set forth a two part test “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* For computer-related technologies, “the first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the *specific asserted improvement* in computer capabilities” (which would be eligible subject matter) or instead “on a process that qualifies as an ‘abstract idea’ for which *computers are invoked merely as a tool*” (which would be ineligible subject matter). *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36, 1338 (Fed. Cir. 2016) (emphasis added). If the claims are directed to eligible subject matter, the inquiry ends. *Id.* at 1339.

If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S.Ct. at 2355 (citing *Mayo*, 566 U.S. at 79, 78). In other words, the second step is to “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.’” *Id.* (citing *Mayo*, 566 U.S. at 72–73).

In this case, the Examiner has determined, and I agree, that the claims are directed to an abstract idea of “receiving from a user search parameters or criteria associated with offers or promotions and providing a display of relevant offers associated with the parameters or criteria [via an offers application installed on a user device for operation over the Internet],” which is considered as a “fundamental economic practice” as well as certain methods of organizing human activities under *Alice* step 1. Final Act. 2. Making relevant merchant offers or promotions (e.g., discounts, rebates, or coupons) readily available for customers, via an offers application installed on a user device for operation over the Internet, is a fundamental business practice, like: (1) risk hedging in *Bilski*; (2) intermediated settlement in *Alice*, 134 S. Ct. at 2356–57; (3) verifying credit card transactions in *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011); (4) guaranteeing transactions in *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1354 (Fed. Cir. 2014); (5) distributing products over the Internet in *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014); (6) determining a price of a product offered to a purchasing organization in *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306 (Fed. Cir. 2015); and (7) pricing a product for sale in *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359 (Fed. Cir. 2015). Making relevant merchant offers or promotions (e.g., discounts, rebates, or coupons) readily available for customers, via an offers application installed on a user device for operation over the Internet, is also a building block of a market economy and, as such,

is an “abstract idea” beyond the scope of 35 U.S.C. § 101. *See Alice*, 134 S. Ct. at 2356.

With respect to the second step of the *Alice* inquiry, I am not persuaded that “the claims are directed to a specific improvement to the way computers operate,” as Appellants argue. App. Br. 6; Reply Br. 6–7. Instead, the steps/functions recited in Appellants’ claim 18, including, for example: “installing an offers application on a user device . . . to handle offers intents”; “launching the offers application;” “receiving . . . an action related to offers . . . [and] a parameter related to offers”; and then “performing . . . the action based on the parameter” do not appear to include any “inventive concept” or add anything “significantly more” to transform the abstract concept into a patent-eligible application. *Alice*, 134 S. Ct. at 2357. For example, the term “offers intent” is described by Appellants’ Specification as “a uniform resource identifier (URI) in a webpage or other content (including in a native application by a third party)” and such an “offers intent” is necessary for the merchants to offer their discounts or coupons online. Spec. ¶¶ 90–92. Like an “offers intent,” an offer application is necessarily installed on a user device (i.e., mobile phone) to allow merchants to inform a customer of offers of discounts or coupons and to allow the customer to handle these offers of discounts or coupons. For these reasons, I am not persuaded that Appellants’ claims contain any “inventive concept” because these claims fail to: (1) provide “a solution . . . necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks” as required by *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014); (2) provide any particular practical application as required by *BASCOM*

Global Internet Servs., Inc. v. AT&T Mobility LLC, 827 F.3d 1341, 1352, 1350 (Fed. Cir. 2016); or (3) entail an unconventional technological solution to a technological problem as required by *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.* 841 F.3d 1288, 1300 (Fed. Cir. 2016). Instead, I agree with the Examiner that the additional elements recited in Appellants' claim 18 (e.g., data processing apparatus, processor, and user device) do not transform the abstract idea into a patent eligible invention. As our reviewing court has observed, "after *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible." *DDR*, 773 F.3d at 1256 (citing *Alice*, 134 S. Ct. at 2358).

Because Appellants' claim 18 is directed to a patent-ineligible abstract concept and does not recite something "significantly more" under the second prong of the *Alice* analysis, I would sustain the Examiner's rejection of claims 18–28 under 35 U.S.C. § 101.