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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* RYAN PATRICK PHELAN and  
MANFRED TSEN-SHU JU

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Appeal 2017-007122  
Application 13/358,440<sup>1</sup>  
Technology Center 3600

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Before LARRY J. HUME, JENNIFER L. MCKEOWN, and  
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 1–9, which are all claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> According to Appellants, the real party in interest is BLUEHORNET NETWORKS, Inc. App. Br. 3.

## STATEMENT OF THE CASE<sup>2</sup>

### *The Invention*

Appellants' disclosed embodiments and claimed invention "relate[] to electronic messaging systems for use on the internet. More particularly, the present invention relates to a system and related tools for quickly creating email marketing campaigns from predefined templates for particular types of email marketing campaigns." Spec. ¶ 2.

### *Exemplary Claim*

Claim 1, reproduced below, is representative of the subject matter on appeal (*emphases* added to contested prior-art limitations):

1. A computerized email message system with email strategy template for use on a network including a server with a processor and a memory, comprising:

a database stored in a non-transitory computer-readable media within the server memory having subscriber profile data where each subscriber record includes an email address, *a subscriber demographic*, and status information for that subscriber's subscriber email or internet behaviors, the database comprises stored therein *a plurality of email strategy templates* for an email marketing campaign, the plurality of email strategy templates comprising:

a definition of a plurality of email strategies and their different objectives, *a depiction of the customer persona* that a particular strategy is

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<sup>2</sup> Our decision relies upon Appellants' Corrected Appeal Brief ("Br.," filed Aug. 25, 2016); Examiner's Answer ("Ans.," mailed Dec. 30, 2016); Final Office Action ("Final Act.," mailed July 10, 2015); and the original Specification ("Spec.," filed Jan. 25, 2012). We note Appellants did not file a Reply Brief in response to the factual findings and legal conclusions in the Examiner's Answer.

targeted towards and how it is applicable *based on a comparative measure of customer lifetime value and relevancy of program*, and a schematic overview of the email strategies showing *a pre-defined sequence of email messages and exit paths of the program*;

a predefined segment of the subscriber profile database that defines an initial audience for at least one mail marketing campaign;

a first email template with a default title and default content;

a second email template with a default title and default content;

an email sending rule that sets a delay between sending emails based on the first and the second email templates;

a software module containing program code which when executed by the processor in the server *causes the server to present a plurality of email strategies to solicit a response for at least one of the email strategies, and receive an input to at least one of the email strategies*, and to perform operations of utilizing marketer user input, the subscriber profile data in the database, and at least one email strategy template to create a rule for sending messages to selected subscribers with particular status information for that subscriber's email or internet behaviors within the subscriber profile data stored in the database; and

an email campaign manager containing program code which when executed by the processor in the server causes the server to perform operations of sending a personalized message to at least one selected subscriber over the network based on the marketer user created rule whereby the selected subscriber receives the sent personalized message as a result of having particular status information for that subscriber's email or internet behaviors.

*Prior Art*

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Schadt et al. ("Schadt") US 2007/0260523 A1 Nov. 8, 2007

*Rejections on Appeal*<sup>3</sup>

R1. Claims 1–9 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 9.

R2. Claims 1–9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schadt. Final Act. 14.

CLAIM GROUPING

Based on Appellants' arguments (Br. 11–18), we decide the appeal of patent-ineligible subject matter Rejection R1 of claims 1–9 on the basis of representative claim 1; and we also decide the appeal of anticipation Rejection R2 of claims 1–9 on the basis of representative claim 1.<sup>4</sup>

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<sup>3</sup> We note the Examiner has withdrawn the rejection of claims 1–8 as being indefinite under 35 U.S.C. § 112, second paragraph, and has also withdrawn the objection to claim 1. Ans. 2.

<sup>4</sup> "Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(iv). In addition, when Appellants do not separately argue the patentability of dependent claims, the claims stand or fall with the claims from which they depend. *In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986).

## ISSUES AND ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellants. To the extent Appellants have not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. 37 C.F.R. § 41.37(c)(1)(iv).

We disagree with Appellants' arguments with respect to claims 1–9 and, unless otherwise noted, we incorporate by reference herein and adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons and rebuttals set forth in the Examiner's Answer in response to Appellants' arguments. We highlight and address specific findings and arguments regarding claim 1 for emphasis as follows.

1. § 101 Rejection R1 of Claims 1–9

Issue 1

Appellants argue (Br. 11–14) the Examiner's rejection of claim 1 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter is in error. These contentions present us with the following issue:

Under our governing case law concerning 35 U.S.C. § 101, did the Examiner err in concluding claim 1 is directed to a judicial exception, i.e., an abstract idea, without significantly more, and thus is patent-ineligible under § 101?

Analysis

*Alice Framework*

Section 101 provides that anyone who "invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" may obtain a patent. 35 U.S.C. § 101. The Supreme Court has repeatedly emphasized that patent protection should not extend to claims that monopolize "the basic tools of scientific and technological work." *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012); *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014). Accordingly, laws of nature, natural phenomena, and abstract ideas are not patent-eligible subject matter. *Id.*

The Supreme Court's two-part *Alice* framework guides us in distinguishing between patent claims that impermissibly claim the "building blocks of human ingenuity" and those that "integrate the building blocks into something more." *Id.* (internal quotation marks, citation, and bracketing omitted). First, we "determine whether the claims at issue are directed to [a] patent-ineligible concept[]." *Id.* at 2355. If so, we "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." *Id.* at 2357 (quoting *Mayo*, 566 U.S. at 72, 79). While the two steps of the *Alice* framework are related, the "Supreme Court's formulation makes clear that the first-stage filter is a meaningful one, sometimes ending the § 101 inquiry." *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). We note the Supreme Court "has not established a definitive rule to determine what constitutes an 'abstract idea'" for the purposes of step one.

*Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016) (citing *Alice*, 134 S. Ct at 2357).

However, our reviewing court has held claims ineligible as directed to an abstract idea when they merely collect electronic information, display information, or embody mental processes that could be performed by humans. *Elec. Power Grp.*, 830 F.3d at 1353–54 (collecting cases). At the same time, "all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas." *Mayo*, 566 U.S. at 71. Abstract ideas may include, but are not limited to, fundamental economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Alice* 134 S. Ct. at 2355–57. Under this guidance, we must therefore ensure at step one that we articulate what the claims are directed to with enough specificity to ensure the step one inquiry is meaningful. *Id.* at 2354 ("[W]e tread carefully in construing this exclusionary principle lest it swallow all of patent law.").

Under the "abstract idea" step we must evaluate "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, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (internal citation omitted). If the claims are not directed to a patent-ineligible concept, the inquiry ends. See *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1262 (Fed. Cir. 2017). If the claims are directed to a patent-ineligible concept, we proceed to the "inventive concept" step. For that second step we must "look with more specificity at what the claim elements add, in order to determine 'whether they identify an "inventive concept" in the application

of the ineligible subject matter' to which the claim is directed." *Affinity Labs*, 838 F.3d at 1258 (quoting *Elec. Power Grp.*, 830 F.3d at 1353).

*Alice Step 1 — Abstract Idea*

The Examiner concludes:

[T]he claims are essentially directed to comparing new and stored information and using rules to identify options (comparing receiving marketer user input and input regarding an email strategy (i.e., new information) and subscriber profile data and email strategy template (i.e., stored information) and use rules to send messages to selected subscribers (i.e., using rules to identify options). This concept was found to be an abstract idea by the Courts. [citing *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 F. App'x 950 (Fed. Cir. 2014) (nonprecedential)]. Also, the concept of sending emails based on using different email strategies, subscriber profile data, and particular status information is similar to using categories to organize, store and transmit information which was found to be an abstract idea in the *Cyberfone* court decision.

Final Act. 11 (citation omitted).

Appellants quote claim 1 and highlights several limitations in bold font. *See* App. Br. 11–24. Appellants then contend, "[a]s pointed out below, the *Schadt et al.* reference fails to teach many of the elements recited in Claim 1 . . . . [and] submits that all the elements that are not taught by the *Schadt et al.* reference either individually considered or considered in combination forms the additional element or elements that amount to significantly more than the judicial exception." App. Br. 12.

Appellants further argue:

Simply put, the elements not taught by the *Schadt et al.* reference (see argument D. below) does [sic] add specific limitations other than what is well-understood, routine and

convention in the field. Appellant has not been shown all the elements by the Examiner. If they are so routine and conventional, the Examiner should have produced art that showed the elements [sic] not taught by the Schadt et al. reference. In the absence of such a showing, the Final Office Action provides nothing more than conclusory statements that the claims are directed to non-statutory subject matter because they are considered by the Examiner to be directed toward an abstract idea.

While the Final Office Action identifies a particular abstract idea it has not demonstrated how this abstract idea is embodied in the pending claims.

App. Br. 13.

Under the "abstract idea" step we must evaluate "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*, 838 F.3d at 1257 (citation omitted).

Turning to the claimed invention, claim 1 recites: "[a] computerized email message system with email strategy template for use on a network including a server with a processor and a memory." Claim 1 (preamble).

System claim 1 also requires:

- (a) "a database" that stores, among other data, "subscriber profile data" [and] "a plurality of email strategy templates for an email marketing campaign";
- (b) "a software module containing program code" that carries out various functions; and
- (c) "an email campaign manager containing program code" that carries out additional functions.

In the Answer, the Examiner concludes:

Appellants' concept of managing email strategy templates and email messages using rules as part of an email campaign is similar to the abstract ideas of filtering emails and receiving and distributing email messages based on specified criteria (i.e., rules) in *Intellectual Ventures I LLC., v. Symantec Corp.*, (F.3d, 120 U.S.P.Q.2d 1353 (Fed. Cir. 2016)). The abstract idea of managing what emails to send using a template and rules is not meaningfully different than filtering emails and distributing emails based on rules. Therefore, Appellants' claims are directed to an abstract idea identified by the courts.

Ans. 5.

Under step one, we agree with the Examiner that the inventions claimed in each of independent claims 1 and 9 are directed to the abstract ideas of "comparing new and stored information and using rules to identify options (comparing receiving marketer user input and input regarding an email strategy (i.e., new information) and subscriber profile data and email strategy template (i.e., stored information)" and using "rules to send messages to selected subscribers (i.e., using rules to identify options)." Final Act. 11.

As the Specification describes, "[t]he present invention relates to electronic messaging systems for use on the internet. More particularly, the present invention relates to a system and related tools for quickly creating email marketing campaigns from predefined templates for particular types of email marketing campaigns." Spec. ¶ 2.

Further, the Abstract discloses:

A email message system with email strategy template for use on a network is disclosed. The email message system includes a

database having subscriber profile data. Each subscriber record includes an email address, a subscriber demographic, and status information for that subscriber's actions with prior emails or other events. The database further has an email strategy template for an email marketing campaign. The email strategy template has several components such as a predefined segment of the subscriber profile data that defines an initial audience for the email marketing campaign. In addition, the email strategy template includes a first and second email template with each having a default title and default content. *The email strategy template also includes an email sending rule that sets a delay between sending emails based on the first and the second email templates. The email message system also is operatively configured to utilize marketer user input, the subscriber profile data in the database, and the email strategy template to create a rule for sending messages to selected subscribers with particular status information for that subscriber's actions with prior emails within the subscriber profile data stored in the database.* The email message system further includes an email campaign manager *which sends a personalized message to at least one selected subscriber over the network based on the marketer user created rule.* As a result, the selected subscriber receives the sent personalized message as a result of having particular status information for that subscriber's actions with prior emails.

Abstract (emphasis added).

We find this type of activity, i.e., comparing data, and using rules to identify options, for example, includes longstanding conduct that existed well before the advent of computers and the Internet and, notwithstanding the implication of email, could be carried out by a human with pen and paper. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011) ("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*.").<sup>5</sup>

Our reviewing court has previously held other patent claims ineligible for reciting similar abstract concepts. For example, while the Supreme Court has enhanced the § 101 analysis since *CyberSource* in cases like *Mayo* and *Alice*, the Federal Circuit continues to "treat[ ] analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category." *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146–47 (Fed. Cir. 2016) (alteration in original) (quoting *Elec. Power Grp.*, 830 F.3d at 1354).

In addition, our reviewing court has concluded that abstract ideas include the concepts of collecting data, recognizing certain data within the collected data set, and storing the data in memory. *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347 (Fed. Cir. 2014). Additionally, the collection of information and analysis of information (e.g., recognizing certain data within the dataset) are also abstract ideas. *Elec. Power Grp.*, 830 F.3d at 1353–54 (collecting information and "analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, [are] essentially mental processes within the abstract-idea category"). Similarly, "collecting, displaying, and manipulating data" is an abstract idea. *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017).

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<sup>5</sup> *CyberSource* further guides that "a method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101." *CyberSource*, 654 F.3d at 1373.

Further, a process that employs mathematical algorithms to manipulate existing information to generate additional information is abstract. *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014). Also, more recently, our reviewing court has also concluded that acts of parsing, comparing, storing, and editing data are abstract ideas. *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1367 (Fed. Cir. 2018).

Further, in *Intellectual Ventures I*, similar in key respects to the claims before us on appeal, tailoring content based on information about the user has also been determined as being directed to an abstract idea and, thus, patent-ineligible.

At step one of the *Alice* framework, it is often useful to determine the breadth of the claims in order to determine whether the claims extend to cover a "fundamental . . . practice long prevalent in our system . . . ." *Alice*, 134 S. Ct. at 2356. As noted, the claim relates to customizing information based on (1) information known about the user and (2) navigation data . . . . [T]ailoring is "a fundamental . . . practice long prevalent in our system . . . ." *Id.* There is no dispute that newspaper inserts had often been tailored based on information known about the customer—for example, a newspaper might advertise based on the customer's location. Providing this minimal tailoring—e.g., providing different newspaper inserts based upon the location of the individual—is an abstract idea.

*Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369 (Fed. Cir. 2015).

Therefore, in agreement with the Examiner, we conclude claim 1 involves nothing more than identifying, collecting, storing, comparing, and

generating data, without any particular inventive technology — an abstract idea. *See Elec. Power Grp.*, 830 F.3d at 1354.<sup>6</sup>

Accordingly, on this record, and under step one of *Alice*, we agree with the Examiner's conclusion the claims are directed to an abstract idea.

*Alice Step 2 —Inventive Concept*

If the claims are directed to a patent-ineligible concept, as we conclude above, we proceed to the "inventive concept" step. For that step we must "look with more specificity at what the claim elements add, in order to determine 'whether they identify an "inventive concept" in the application of the ineligible subject matter' to which the claim is directed." *Affinity Labs*, 838 F.3d at 1258 (quoting *Elec. Power Grp.*, 830 F.3d at 1353).

In applying step two of the *Alice* analysis, our reviewing court guides we must "determine whether the claims do significantly more than simply describe [the] abstract method" and thus transform the abstract idea into patent-eligible subject matter. *Ultramarcial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014). We look to see whether there are any "additional features" in the claims that constitute an "inventive concept," thereby rendering the claims eligible for patenting even if they are directed to an abstract idea. *Alice*, 134 S. Ct. at 2357. Those "additional features" must be more than "well-understood, routine, conventional activity." *Mayo*, 566 U.S. at 79.

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<sup>6</sup> Merely automating previously manual processes by using computers does not qualify as an eligibility-rejection-defeating improvement. *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044 (Fed. Cir. 2017).

Evaluating representative claim 1 under step 2 of the *Alice* analysis, we agree with the Examiner that it lacks an inventive concept that transforms the abstract idea of comparing new and stored information, and using rules to identify options, into a patent-eligible application of that abstract idea. For example, the Examiner concludes:

The limitations describing what the plurality of email strategy templates contain . . . "a definition . . . a schematic overview" as well as "a predefined segment", "a first email template", "a second email template" and "an email sending rule" are associated with mere data gathering and not considered significantly more. The limitation of using a rule to send a message is addressed above. *The additional elements or combination of elements in the claims other than the abstract idea per se amounts to no more than mere instructions to implement the idea on a computer and recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the pertinent industry.* For example, claims 1 and 9 recite a database containing templates, a server to display data, receive input and send messages based on received input. These are interpreted as recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known in email software/applications.

Ans. 12 (emphasis added).

We note the patent-eligibility inquiry may contain underlying issues of fact. *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325 (Fed. Cir. 2016). In particular, "[t]he question of whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact." *Berkheimer*, 881 F.3d at 1368.

As evidence of the conventional nature of the claimed components and processes, we note Appellants' Specification in paragraphs 36 through 40. For example:

**[0036]** Referring to FIGs 1 and 2, email strategy templates 108 are a component of an email marketing system 106. An email marketing system is a specialized computing machine operating on a network that allows users to create and send email messages to subscribers. Because the email marketing system provides services to others over a network, the computing machine 106 is most likely to be a specially programmed server, which allows multiple clients to access its features and capabilities. The computing machine/server 106 typically includes a memory 202, read only memory 204, a secondary storage device 206, a system BUS 207, a processor 208 (central processing unit, or CPU), a communication interface 209, an input device 210, a display device 212, and an output device 214. The memory may include random access memory (RAM) or similar types of memory.

**[0037]** Software applications, stored in the memory 202 or secondary storage 206 for execution by a processor 208 are operatively configured to perform the operations of the exemplary system. The software applications may correspond with a single module 216 or any number of modules. Modules 216 are program code or instructions for controlling a computer processor to perform a particular method to implement the features or operations of the system. The modules 216 may also be implemented using program products or a combination of software and specialized hardware components. In addition, the modules 216 may be executed on multiple processors for processing a large number of transactions, if necessary or desired. Other data structures and tools may also be stored in memory, such as a database 110 to store and organize information, and a database management system 218 to modify, extract and search for information within the database. The program modules 216 may access the database via queries in order to obtain operating information stored therein, such as the variables stored or configured for running email strategy

template programs 108 or for creating program reports for user 102 viewing.

**[0038]** The secondary storage device 206 may include a hard disk drive, floppy disk drive, CD-ROM drive, DVD-ROM drive, or other types of non-volatile data storage, and may correspond with the various equipment and modules 216 shown in the figures. The processor may execute the software applications or programs either stored in memory 204 or secondary storage 206 or received from the Internet 104 or other network.

Spec. ¶¶ 36–38.

We agree with the Examiner that the claim limitations may be broadly but reasonably construed as reciting conventional computer components and techniques, particularly in light of Appellants' Specification, as quoted above.<sup>7</sup>

With respect to the Step 2 analysis, we agree with the Examiner because, as in *Alice*, the recitation of either a "computerized email message system with email strategy template for use on a network including a server with a processor and a memory" using a "database," a "software module," and an "email campaign manager containing program code" (claim 1); or a "method for managing email marketing messages for use on a network

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<sup>7</sup> During prosecution, claims must be given their broadest reasonable interpretation when reading claim language in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Under this standard, we interpret claim terms using "the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

performed by a server having a processor and memory operating under the control of program code within a software module" that includes steps of "storing subscriber profile data," "storing a library of email strategy templates in a database," "utilizing business user input," and "sending a personalized message" (claim 9) are simply not enough to transform the patent-ineligible abstract idea here into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2357 ("[C]laims, which merely require generic computer implementation, fail to transform [an] abstract idea into a patent-eligible invention.").<sup>8</sup>

Accordingly, based upon the findings above, on this record, we are not persuaded of error in the Examiner's conclusion that the appealed claims are directed to patent-ineligible subject matter. Therefore, we sustain the Examiner's § 101 rejection of independent claim 1, and grouped claims 2–9, not argued separately, and which fall therewith. *See Claim Grouping, supra*.

2. § 102(b) Rejection R2 of Claims 1–9

Issue 2

Appellants argue (Br. 14–18) the Examiner's rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Schadt is in error. These contentions present us with the following issue:

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<sup>8</sup> Appellants merely allege, without more, "Applicant submits that the claims contain an inventive concept (i.e. step 2B of the test). In other words, the pending claims include recitations that amount to significantly more than the basic idea itself. The claims provide a specific, concrete and meaningful application that represents an improvement in the field of email marketing." App. Br.14. "[L]imiting an abstract idea to one field of use," however, does not impart patent eligibility. *See Bilski v. Kappos*, 561 U.S. 593, 612 (2010); *see also Parker v. Flook*, 437 U.S. 584, 589–90 (1978); *Affinity Labs*, 838 F.3d at 1259.

Did the Examiner err in finding the cited prior art discloses "[a] computerized email message system with email strategy template for use on a network including a server with a processor and a memory" that includes, *inter alia*, storing data in a database, i.e., "a subscriber demographic," "a plurality of email strategy templates," and "a depiction of the customer persona," and which carries out "a comparative measure of customer lifetime value and relevancy of program," and which shows "a pre-defined sequence of email messages and exit paths of the program," while presenting "a plurality of email strategies to solicit a response for at least one of the email strategies, and receive an input to at least one of the email strategies," as recited in claim 1?

Analysis

Appellants contend:

Simply put, the Schadt et al. reference fails to teach many of the above elements that are recited in claim 1. For example, there is no teaching of a subscriber demographic in the Schadt et al. reference. The word "demographic" does not appear, based on a search of the Schadt et al. reference at the USPTO website. In addition, there is no teaching of any "exit path" much less " . . . a pre-defined sequence of email messages and exit paths of the program . . . " Again, the word "exit" does not seem to appear in the Schadt et al. reference.

Furthermore, there is no teaching of causing " . . . the server to present a plurality of email strategies to solicit a response for at least one of the email strategies, and receive an input to at least one of the email strategies . . . "

App. Br. 15.

The Examiner makes various findings of fact in the Answer, and responds to each of Appellants' arguments while referencing previously-

provided mappings of the claim limitations to the Schadt reference.

Ans. 5–13. We incorporate the Examiner's findings herein by reference and adopt them as our own. Appellants do not file a Reply Brief to rebut the Examiner's findings in the Answer.

Therefore, based upon the findings above, on this record, we are not persuaded of error in the Examiner's reliance on the cited prior art to disclose the disputed limitations of claim 1, nor do we find error in the Examiner's resulting finding of anticipation. Therefore, we sustain the Examiner's anticipation rejection of independent claim 1, and grouped claims 2–9 which fall therewith. *See Claim Grouping, supra.*

#### CONCLUSIONS

(1) The Examiner did not err with respect to patent-ineligible subject matter Rejection R1 of claims 1–9 under 35 U.S.C. § 101, and we sustain the rejection.

(2) The Examiner did not err with respect to anticipation Rejection R2 of claims 1–9 under 35 U.S.C. § 102(b) over the cited prior art of record, and we sustain the rejection.

#### DECISION

We affirm the Examiner's decision rejecting claims 1–9.

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