UNITED STATES PATENT AND TRADEMARK OFFICE

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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 DAVID W. VICTOR

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Appeal 2017-007214
Application 13/424,049
Technology Center 2100

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Before ALLEN R. MacDONALD, IRVIN E. BRANCH, and
NABEEL U. KHAN, *Administrative Patent Judges*.

KHAN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Final Rejection
of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

BACKGROUND

THE INVENTION

According to Appellant, "[t]he present invention relates to a computer program product, system, and method for inviting participants in an online document sharing community to accept terms of a non-disclosure agreement (NDA) to access a document." Spec. ¶ 1.

Exemplary independent claim 1 is reproduced below.

> 1. A computer program product for implementing an online document sharing community in a network environment including a plurality of participant computers operated by participants in the online document sharing community and a storage system, wherein the computer program product is implemented in a nontransitory computer readable storage medium having a computer program that when executed performs operations, the operations comprising:
>
> generating, by a manager implementing the online document sharing community, document information in a database identifying documents in the storage system and owners of the documents, wherein at least one of the documents includes content comprising content subject to protection under intellectual property laws;
>
> in response to processing a request to create a group of invitees to one of the documents for which there is document information in the database, performing, by the manager, operations comprising:
>
> generating, in the database, group information for a group created by the owner of the document indicating at least one document associated with the owner and a plurality of invitees, wherein each invitee comprises one of the participants in the online document sharing community operating an invitee computer comprising one of the participant computers;
>
> generating a join message including a description of the document that does not include all the content of the document, a non-disclosure agreement (NDA) requesting the invitee to

accept terms of the NDA in order to access all of the content of the document, and code embedded in the join message implementing an accept graphical element that when selected causes the invitee computer to transmit an acceptance message indicating acceptance of the terms of the NDA;

sending the join message to at least one invitee computer for each of the invitees;

in response to receiving the acceptance message from one of the invitee computers operated by one of the invitees, indicating in the document information in the database the invitee that has accepted the terms of the NDA, wherein content of the document is only provided to the at least one invitee computer of at least one invitee that has accepted the NDA; and

providing access to the content of the document to the at least one invitee computer operated by at least one of the invitees that have received the join message and accepted the NDA.

REFERENCES AND REJECTIONS

1.   Claims 1–20 stand rejected under 35 U.S.C. § 101 as being directed to patent ineligible subject matter. Final Act. 2–5.

2.   Claim 1–3, 5, 8–9, 11, 14–16, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Woollcombe (US 2010/0211887 A1, published, Aug. 19, 2010), Chanpman (US 7,584,250 B1, published Sept. 1, 2009), Britton (US 2008/0300933 A1, published Dec. 4, 2008) and van Os (US 2009/0228322 A1, published Sept. 10, 2009). Final Act. 5–24.

3.   Claims 4, 10, and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Woollcombe, Chapman, Britton, van Os, and Chebiyyam (US 2012/0191792 A1, published July 26, 2012). Final Act. 25–30.

4.   Claims 6, 12 and 19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Woollcombe, Chapman, Britton, van Os, and Nguyen (US 2005/0033615 A1, published Feb. 10, 2005). Final Act. 31–33.

5.   Claims 7, 13 and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Woollcombe, Chapman, Britton, van Os, Nguyen, and Farrell (US 2008/0250332 A1, published Oct. 9, 2008). Final Act. 33–35.

DISCUSSION

REJECTION UNDER 35 U.S.C. § 101

Relevant Case Law

A patent may be obtained for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." 35 U.S.C. § 101. The Supreme Court has held that this provision contains an important implicit exception for certain patent ineligible concepts: laws of nature, natural phenomena, and abstract ideas. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014); *see also Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012). To determine patentable subject matter, the Supreme Court has set forth a two part test: (1) whether the claims are directed to a patent-ineligible concept and, if so, (2) whether, when the claim elements are considered "individually and 'as an ordered combination,'" there is an inventive concept present, *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 (brackets in original) (quoting *Mayo*, 132 S. Ct. at 1294).

Findings and Contentions

Under the first prong of the two-step framework laid out in *Alice/Mayo* the Examiner finds "[t]he claim(s) is/are directed to the abstract idea of requiring the agreement to an NDA in order to view a document subject to protection under Intellectual Property laws (i.e. a Basic Legal Concept)." Final Act. 3. The Examiner further finds, under the second prong of the *Alice/Mayo* framework, that the additional elements amount to no more than generic computer structure performing functions that are well-understood, routine and conventional and do not transform the abstract idea into a patent eligible application that is significantly more than the abstract idea. Final Act. 3.

Appellant argues that the claims recite "numerous database related operations" (App. Br. 10) that "provide specific and detailed requirements concerning how a database is updated and join messages generated, the database further updated and access to the document provided in response to receiving the acceptance message generated from the join message" (App. Br. 11). The claimed database elements, structures, and operations, according to Appellant, provide "a sufficient level of detail to avoid a finding of 'abstractness.'" App. Br. 12 (citing *Enfish v. Microsoft*, 822 F.3d 1327, 1337–38 (Fed. Cir. 2016)). Similarly, Appellant argues that the claimed database elements, structures, and operations "comprise significantly more than an abstract idea of 'requiring the agreement to an NDA.'" App. Br. 13; *see also* App. Br. 14. Finally, Appellant also points out that the use of four references in the Examiner's obviousness rejection "illustrates the claims provide a combination of numerous elements that is

more than a simple generic operation, such as accepting an agreement."
App. Br. 11.

Analysis

We are unpersuaded by Appellant's arguments. Instead, we agree with and adopt the Examiner's findings and concur with the Examiner's conclusion as set forth in the Answer and in the Action from which this appeal was taken. Final Act. 2–5; Ans. 3–12. We provide the following for emphasis.

Turning to the first prong of the *Alice/Mayo* framework we agree with the Examiner that the claims are directed to an abstract idea. Referring, for example, to claim 1, the steps of generating document information in a database, generating group information, generating and sending a join message requesting invitees in the group to accept an NDA, updating the document information indicating that invitees have accepted the NDA, and providing access to the document to the invitees who have accepted the NDA, are all steps directed to providing an NDA to invitees so that those invitees can access a protected document. The claimed document information and group information simply keeps track of information regarding the document (such as its owner) and the group of invitees who need to be sent an NDA for acceptance and those invitees from the group who have accepted the NDA. Thus, we agree with the Examiner that the claims are directed to the abstract idea of requiring the agreement to an NDA in order to view a document. *See buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (finding claims relating to creating a contractual relationship to be directed to an abstract idea).

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Turning to the second prong of the *Alice/Mayo* framework we agree with the Examiner that the database elements, structures and operations that Appellants emphasize, such as "generating . . . document information," "generating . . . group information," "generating a join message . . . [with] code embedded in the join message implementing an accept graphical element," "indicating in the document information in the database the invitee that has accepted the terms of the NDA," are not enough to transform the claim to something significantly more than the abstract idea. The document information and group information are elements directed to record keeping in a database. The claimed database itself is used in its well-understood and conventional manner. The claimed graphical elements are also used in a well-known and conventional manner to provide invitees a way of indicating that they have accepted the NDA. These database and interface elements are generic computer components and have been held to not satisfy the inventive concept requirement of the second prong of the *Alice/Mayo* framework. *See Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324–25 (Fed. Cir. 2016).

Appellant's argument that the use of four references in the Examiner's obviousness rejection "illustrates the claims provide a combination of numerous elements that is more than a simple generic operation, such as accepting an agreement" (App. Br. 11) is unpersuasive. As explained above, the elements that Appellant emphasizes are generic computer elements and are not enough to transform the claims to something significantly more than the abstract idea of requiring the acceptance of an NDA to view protected documents. Appellant has not provided any authority for the contention that the number of prior art references used in a rejection under 35 U.S.C.

§ 103(a) bears relevance to the analysis under 35 U.S.C. § 101, nor do we know of any.

Conclusion

Appellant argues claims 1–20 as a group. *See* App. Br. 10–14. We, therefore, sustain the Examiner's rejection of claims 1–20 under 35 U.S.C. § 101 for the aforementioned reasons.

REJECTION UNDER 35 U.S.C. § 103(A)

We have reviewed the Examiner's rejections in light of Appellant's arguments that the Examiner has erred. We disagree with Appellant's arguments, and adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken (Final Act. 5–35); and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief (Ans. 3–29), and concur with the conclusions reached by the Examiner. We emphasize the following.

Claim 1

The Examiner finds Woollcombe discloses an online document sharing community having a computer program that generates document information for a document protected under intellectual property laws, generating group information, generating a join message including a description of the document but not all the content of the document, sending the join message to an invitee, indicating in the document information that an invitee has accepted the terms of the NDA, and providing access to the content of the document to the invitees that accept the terms of the NDA. Final Act. 6–7.

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The Examiner acknowledges, however, that Woollcombe does not send the join message to multiple invitees (Final Act. 10, 15), does not include the NDA along with the join message (Final Act. 18), and does not include an accept graphical element with the join message (Final Act. 19). Instead, Woollcombe sends an email invite message to one invitee, and rather than including the NDA and accept graphical elements with the email, sends a link to a webpage that includes the NDA and an accept graphical element (*see* Woollcombe Figs. 9, 11). The Examiner relies on Chapman as teaching sending a join message to multiple invitees (Final Act. 15), on Britton as teaching sending an NDA along with the join message (Final Act. 18), and on van Os as teaching a join message that includes an accept graphical element (Final Act. 18–19).

Appellant makes a series of arguments that largely attack the references individually and do not account for the Examiner's rejection as a whole. For, example, referring to Woollcombe, Appellant argues Woollcombe "does not teach the claimed database driven technique . . . including generating the group information, generating the join message with embedded code that when selected transmits an acceptance message, and sending the join message to multiple of the invitees in the group." App. Br. 15–16. Instead, according to Appellant, "Woolcombe [sic] mentions sending an email to one user with a username and password, not a join message to multiple invitees in the group having code which allows the invitee to transmit an acceptance message to accept the terms of the NDA . . . ." App. Br. 16. Appellant continues "with Woolcombe [sic] a single user is invited with a username and password to be used to log in to

an NDA gallery, at which point they will be prompted to accept the NDA."
App. Br. 16.

Referring to Chapman, Appellant argues "sending an email to a co-inventor in response to creating an invention disclosure does not teach or suggest the claim requirements of in response to processing a request to create a group of invitees, generating the group information, generating the join message with embedded code that when selected transmits an acceptance message, and sending the join message to multiple of the invitees in the group." App. Br. 16.

Appellant contends the "message described in Britton is not a message including an active mechanism . . . to accept the NDA and drive a database to indicate . . . the invitee as accepting the NDA to allow the invitee accepting the NDA to access the content of the document. Instead, the message includes information confirming whether they accepted an NDA to attend a sourcing event, not to accept the NDA in order to access all the content of the document." App. Br. 16–17.

Finally, as to van Os, Appellant argues "[a]lthough the cited van Os discusses having an accept or decline button for a calendar invite, there is no teaching of the claim requirements that accepting causes the transmission of an accept message that triggers a series of events as claimed, including indicating in the document information the invitee that has accepted the terms for the NDA." App. Br. 17.

Appellant's arguments are unpersuasive of Examiner error. As far as Appellant's argument that the references do not teach a database driven technique, we note that the Examiner finds Woollcombe teaches that the agreement (i.e. document information) and the identity of the users that have

entered into the agreement, are stored in computer memory. We find this
sufficient to suggest storing such information in a database. Further, the
Examiner also finds Chapman discloses an employee database that stores the
names of the inventor and co-inventors that are part of the group of invitees
to the invention disclosure. Ans. 19 (citing Chapman 6:33–42). Thus,
Chapman, in combination with Woollcombe, also teaches or suggests the
use of a database to track the information necessary for requiring the
acceptance of an NDA to gain access to protected documents.

We agree with the Examiner that Woollcombe's email invitation
teaches or suggests the claimed join message. Appellant's argument that
Woollcombe sends the email to one invitee rather than multiple invitees
attacks Woollcombe individually and fails to address the Examiner's finding
regarding Chapman, which the Examiner relies upon as teaching sending a
join message to multiple invitees. *See* Final Act. 15. Appellant's argument
that Woollcombe's email does not include code for an accept graphical
element fails to address the Examiner's finding regarding van Os as teaching
sending an invitation that includes an accept graphical element. *See* Final
Act. 18–19. Appellant's argument that Chapman does not teach generating
group information, or a join message with embedded code is addressed by
the Examiner's finding regarding Woollcombe (relied upon as teaching
generating group information) and van Os (relied upon for teaching code for
an accept graphical element). Appellant's argument that Britton's message
does not include an active element is, as explained above, addressed by van
Os, which is relied upon as teaching code for an accept graphical element.
And finally, Appellant's argument that van Os's accept graphical element
does not cause the transmission of an accept message that triggers indicating

in document information that the invitee has accepted the terms of the NDA is addressed by the Examiner's finding regarding Woollcombe, which is relied upon as teaching sending an email with a link to a webpage where the invitee can accept the terms of an NDA to gain access to the content of a protected document. Final Act. 6.

Accordingly, we sustain the Examiner's rejection of independent claim 1 and of claims 8 and 14 which were argued together as a group. *See* App. Br. 18. We also sustain the Examiner's rejection of dependent claims 2, 5, 7, 11, 13, 15, 18, and 20 for which Appellant makes no arguments for separate patentability. *See* App. Br. 18, 20, 21.

Claim 3

Claim 3 depends from claim 1 and recites "indicating the invitee as a member of the group in response to receiving the accept message from the invitee computer agreeing to the NDA."

Appellant argues "indicating that a work is available through a gallery does not teach indicating an invitee as a member of the group in response to receiving the accept message transmitted from a join message sent to the invitees." App. Br. 18.

We are unpersuaded of Examiner error. The Examiner finds that Woollcombe teaches or suggests the limitations of claim 3 by disclosing that "[t]he identities of the first and the second user, such as their names or social security numbers, or some other user identity indication may be stored in computer memory as an indication or indications that the first and the second user have entered into the agreement." Ans. 25 (citing Woollcombe ¶¶ 29–30). We agree with the Examiner that by storing the identities of the parties who have entered into an agreement and accept the terms of the

NDA, Woollcombe teaches or suggests indicating the invitee is a member of the group with access to the protected document in response to receiving the accept message.

Accordingly, we sustain the Examiner's rejection of claim 3 and of claims 9 and 16, which were argued together with claim 3 as a group, under 35 U.S.C. § 103(a). *See* App. Br. 18–19.

Claim 4

Claim 4 depends from claim 1 and recites "wherein the group information indicates whether an NDA is required to access the document, wherein the NDA is included in the join message in response to the group information indicating that the NDA is required, and wherein the join message does not include the NDA in response to the group information not indicating that the NDA is required."

Appellant argues "[t]he cited para. 47 discusses how a user may indicate a document as not accessible, open access or pro access, where the open access or Pro Members access options indicate the accessibility of the document on a web site, or gallery. However, the cited para. 47 does not recite that indication of access to the document, such as whether an NDA is required, controls whether an NDA is included in the join message or not." App. Br. 19.

The Examiner finds Woollcombe discloses that a "first user (i.e. owner) selecting 'no access' results in an NDA being required because that first user intends to create a legal relationship with a second user (i.e. invitee). Moreover, a first user (i.e. owner) selecting 'open access' or 'pro members access' results in no NDA being required." Ans. 27–29. The Examiner further finds that Britton also teaches the limitations of claim 4 by

disclosing that "[t]he invitation process may include confirming that each supplier has signed a Non-Disclosure Agreement (NDA). If no agreement has been signed by one or more suppliers, then a non-disclosure agreement should be sent along with the invitation." Ans. 29.

We agree with the Examiner that by selecting "no access" Woollcombe indicates that an NDA is required and that therefore an NDA should be displayed to the user for acceptance. Woollcombe's teachings combined with Britton teaching that an NDA will be sent with the join message if an NDA has not been signed by the invitee (i.e. an NDA is required) teaches or suggests the limitations of claim 4. Similarly, we agree that by teaching that no NDA is required when a user selects "open access," Woollcombe teaches or suggests "wherein the join message does not include the NDA in response to the group information not indicating that the NDA is required."

Accordingly, we sustain the Examiner's rejection of claim 4 and of claims 10 and 17, which were argued together as a group, under 35 U.S.C. § 103(a). *See* App. Br. 19.

Claim 6

Claim 6 depends from claim 1 and recites "indicating in the document information a number of times the NDA for the document was accepted by the at least one invitee computer; and indicating in the document information a number of times the NDA for the document was declined by the at least one invitee computer."

The Examiner finds Nguyen, combined with the other prior art references, teaches of suggests the limitations of claim 6. Final Act. 31–33. In particular, the Examiner finds "the display of the total number of invitees

who have registered (i.e. accepted) and declined an invitation teaches the concept of storing the total number of acceptances and declines to an invitation." Final Act. 33; *see also* Nguyen ¶ 66.

The Appellant argues "The cited para. 100 mentions inviting guests to an event, and an RSVP status display area displays a max number of attendees for the event, the total number invited, and the total number of invitees that have accepted to the event. Applicant submits that indicating invitees that have accepted an event does not teach or suggest indicating a number of times the NDA for a document was accepted by the at least one invitee." App. Br. 20.

We are unpersuaded by Appellant's argument. Nguyen teaches keeping track of the number of invitees that have accepted an invitation to an event and the number that have declined. *See* Nguyen ¶ 100. Combined with the teachings of Woollcombe, Chapman, Britton, and van OS, we agree with the Examiner that Nguyen teaches "indicating . . . a number of times the NDA for the document was accepted . . . and indicating . . . a number of times the NDA for the document was declined . . ." as required by claim 6.

Accordingly, we sustain the Examiner's rejection of claim 6 and of claims 12 and 19, which were argued together as a group, under 35 U.S.C. § 103(a).

DECISION

The Examiner's rejection of claims 1–20 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejection of claims 1–20 under 35 U.S.C. § 103(a) 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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED