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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DANIEL R. SWANSON

Appeal 2017-007326
Application 12/567,029
Technology Center 3600

Before ST. JOHN COURTENAY III, LARRY J. HUME, and
JOYCE CRAIG, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from a Final rejection of claims 7–12, 28, and 31–36. Claims 1–6, 13–27, 29, and 30 are cancelled. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We Affirm.

STATEMENT OF THE CASE

Introduction

Appellant’s invention generally relates to “self-directed individual customer segmentation and customer rewards.” Title.

¹ According to Appellant, the real party in interest is the inventor, Daniel R. Swanson. App. Br. 7.

Exemplary Claim

7. A computer executed method comprising:

gathering a plurality of responses comprising personality preference responses of at least one individual to predefined personality determination questions, an aspirational goal of the at least one individual, and at least one preference or rating for an individual product or service from the at least one individual using a computer with at least one processor and a network connection;

comparing and matching, using the computer, the plurality of responses of the at least one individual to a first segment of multiple unknown persons of a plurality of segments of multiple unknown persons who share similar responses, wherein the first segment includes multiple preference responses from the multiple unknown persons, wherein the multiple unknown persons are unknown to the at least one individual;

presenting, using the computer, to the at least one individual a plurality of system-defined user-selectable segments, each of the segments including a corresponding presented percentage match of unknown persons in each of the plurality of system-defined user-selectable segments that share a similar preference or rating for the individual product or service and have similar personality preference responses as the at least one individual wherein each segment represents multiple preference responses by multiple unknown persons, wherein the multiple unknown persons' individual identities and system identities are hidden from the at least one individual;

gathering, using the computer, from the at least one individual at least one selection of a system-defined user-selectable segment from the plurality of system-defined user-selectable segments;

identifying, using the computer, at least one product or at least one service-available for purchase by the at least one individual based on the selection of the system-defined user-selectable segment;

offering, using the computer, to the at least one individual the at least one product or the at least one service for purchase, in response to identifying the at least one product; and

automatically providing a discount, reward, or incentive for the at least one product or the at least one service as a function of the at least one selection of the system-defined user-selectable segment and the plurality of gathered responses of the at least one individual including the aspirational goal of the at least one individual, via at least one output apparatus communicatively coupled to the computer.
(contested limitation emphasized).

App. Br. 240–241. (Claims Appendix) (emphasis added).

Rejections

- A. Claim 33 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Final Act. 2.
- B. Claim 33 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Final Act. 3.
- C. Claims 7–12, 28, and 31–36 are rejected under 35 U.S.C. § 101, as being directed to a judicial exception, without significantly more. Final Act. 4.
- D. Claims 7–10, 31, and 36 are rejected under 35 U.S.C. § 103(a), as obvious over the combined teachings and suggestions of Monteforte et al. (US 2010/0262449 A1; published Oct. 14, 2010) (“Monteforte”), Buchanan et al. (US 2011/0107265 A1; published May 5, 2011) (“Buchanan”), and Andra et al. (US 2009/0319436 A1; published Dec. 24, 2009) (“Andra”). Final Act. 6.²
- E. Claim 11 is rejected under 35 U.S.C. § 103(a), as obvious over the combined teachings and suggestions of Monteforte, Buchanan, Andra,

² We include claim 36 under rejection D, as rejected by the Examiner on page 11 of the Final Action, but inadvertently omitted from the heading of rejection D, as presented on page 6 of the Final Action.

- and Silverbrook et al. (US 2008/0091532 A1; published April 17, 2008) (“Silverbrook”). Final Act. 11.
- F. Claim 12 is rejected under 35 U.S.C. § 103(a), as obvious over the combined teachings and suggestions of Monteforte, Buchanan, Andra, and Guo et al. (US 2009/0006188 A1; published Jan. 1, 2009) (“Guo”). Final Act. 12.
- G. Claim 28 is rejected under 35 U.S.C. § 103(a), as obvious over the combined teachings and suggestions of Monteforte, Buchanan, Andra, Sholtis et al. (US 8,041,580 B1; iss. Oct.18, 2011) (“Sholtis”) and Sue (US 2009/0006465 A1; published Jan. 1, 2009). Final Act. 13.
- H. Claims 32–34 are rejected under 35 U.S.C. § 103(a), as obvious over the combined teachings and suggestions of Monteforte, Buchanan, Andra, Payne et al. (US 5,715,314; iss. Feb. 3, 1998) (“Payne”) and Sheehan (US 2007/0011099 A1; published Jan. 11, 2007). Final Act. 15.
- I. Claim 35 is rejected under 35 U.S.C. § 103(a), as obvious over the combined teachings and suggestions of Monteforte, Buchanan, Andra, Payne and Kirkpatrick et al. (US 2001/0042022 A1; published Nov. 15, 2001) (“Kirkpatrick”). Final Act. 19.

Rejection A of Claim 33 under 35 U.S.C. § 112, first paragraph

Issue: Under § 112, first paragraph, did the Examiner err in finding that claim 33 fails to comply with the written description requirement?

The Examiner finds the Specification fails to define the claim terms “specialized payment network” that includes a “dedicated individual segmentation system payment network.” The Examiner finds these claim

terms are not supported by Appellant’s original Specification. Final Act. 2–3.

Appellant contends the Specification reasonably conveys possession of the claimed invention. App. Br. 103, citing Spec. ¶100 and Fig. 14. Appellant further urges that the “Point of Sale” System (Spec. ¶ 54) conveys possession of the claimed term “specialized payment network” that includes a “dedicated individual segmentation system payment network” as recited in claim 33. App. Br. 105–106.

Our reviewing court guides the written description “must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (*en banc*) (citation and quotations omitted). The test is whether the disclosure “conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* “[A]ctual ‘possession’ or reduction to practice outside of the specification is not enough. Rather . . . it is the specification itself that must demonstrate possession.” *Id.* at 1352; *see also PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306–07 (Fed. Cir. 2008) (emphasis added) (explaining that § 112, ¶ 1 “requires that the written description *actually* or *inherently* disclose the claim element”).

We find Appellant’s “Point of Sale” System, as described in the Specification (¶ 54), shows that Appellant had possession of a “specialized payment network” that includes a “dedicated individual segmentation system payment network,” at the time the application was filed. Furthermore, we find the described “Individual Segmentation System,” which updates individual and segment records, shows possession of the

disputed claim terms. Spec. ¶ 100. Therefore, we are constrained on this record to reverse the Examiner's rejection A of claim 33, under 35 U.S.C. § 112, first paragraph, for lack of written description.

Rejection B of Claim 33 under 35 U.S.C. § 112, second paragraph.

Issue: Under § 112, second paragraph, did the Examiner err in concluding that claim 33 is indefinite?

The Examiner concludes claim 33 fails to “specify how or why the network is specialized.” The Examiner also finds such network is “nothing more than the [I]nternet.” Final Act. 3.

35 U.S.C. § 112, second paragraph, requires: “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” As guided by the Manual of Patent Examining Procedure (MPEP), a rejection based on the failure to claim the subject matter which the applicant regards as the invention “is appropriate only where an inventor has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims.” MPEP § 2172(I). “Agreement, or lack thereof, between the claims and the specification is properly considered only with respect to the first paragraph of 112; it is irrelevant to compliance with the second paragraph of that section.” *In re Ehrreich*, 590 F.2d 902, 906 (CCPA 1979).

We conclude the Examiner's interpretation of the subject claim relates to the breadth of the claim. However, see, e.g., *In re Miller*, 441 F.2d 689, 693 (CCPA 1971) (“Breadth is not . . . indefiniteness.”).

Accordingly, we reverse the Examiner's rejection B of claim 33 under 35 U.S.C. § 112, second paragraph.

Rejection C of Claims 7–12, 28, and 31–36 under 35 U.S.C. § 101

Issue: Did the Examiner err in rejecting claims 7–12, 28, and 31–36 under 35 U.S.C. § 101, as being directed to a judicial exception, without significantly more?

We have considered all of Appellant’s arguments and any evidence presented. We highlight and address specific findings and arguments for emphasis in our analysis below.

Mayo/Alice Analysis

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). The Supreme Court in *Alice* reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 82–84 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355.

The first step in that analysis is to determine whether the claims at issue are directed to one of those patent-ineligible concepts, such as an *abstract idea*. 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. *Id.* at 2355–57.

If the “acts” of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. *See Gottschalk v. Benson*, 409 U.S. 63, 71–72 (1972). “Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.” *In re Ferguson*, 558 F.3d 1359, 1363 (Fed. Cir. 2009) (quoting *Benson*, 409 U.S. at 67). Moreover, if a method can be performed by human thought alone, or by a human using pen and paper, it is merely an abstract idea and is not patent eligible under § 101. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011).

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).

Otherwise, the inquiry proceeds to the second step in which the elements of the claims are considered “individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79, 78). We consider the question of whether the claims are directed to a *specific improvement* in the capabilities of the computing devices, or, instead, “a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

We, therefore, decide under step two, whether the claims: (a) set forth an *inventive concept* that provides a specific means or method that *improves* the relevant technology, or (b) are directed to a result or effect that itself is

the abstract idea, in which the claims merely invoke generic processes and machinery. *See Enfish*, 822 F.3d at 1336.

The Examiner's Rejection C under 35 U.S.C. § 101

Regarding the first step of the *Alice/Mayo* analysis, the Examiner concludes that claims 7–12, 28, and 31–36, which are directed to the concept of sending targeted ads (i.e., offers) to users based on their preferences and personality traits, are directed to a judicial exception, i.e., an abstract idea, because the claims are directed to a “fundamental economic practice.” Final Act. 4.³

Regarding the second step of the *Mayo/Alice* analysis, the Examiner concludes the claims do not include additional elements that amount to significantly more than the judicial exception, because:

[T]he claims fail to effect an improvement to another technology or technical field, do not amount to an improvement to the functioning of the computer itself, and do not move beyond a general link of the use of an abstract idea to a particular technological environment.

The claims merely amount to the application or instructions to apply the abstract idea (i.e. sending targeted ads to users based on their preferences and personality traits) on a computer, and is considered to amount to nothing more than requiring a generic computer system (e.g. a computer system comprising generic elements, such as a memory and a processor, for receiving data entries corresponding to user activity, matching the data entry with segments of users with similar traits, enabling the user to choose a segment that they like, and presenting the ad to the user based on the probabilistic match) to merely carry out the abstract idea itself. As such, the

³ “Patent eligibility under § 101 presents an issue of law.” *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1340–41 (Fed. Cir. 2013).

claims, when considered as a whole, are nothing more than the instruction to implement the abstract idea (i.e. sending targeted ads to users based on their preferences and personality traits) in a particular, albeit well-understood, routine and conventional technological environment.

Final Act. 5–6.⁴

For the aforementioned reasons, the Examiner concludes that all claims 7–12, 28, and 31–36 on appeal are not patent eligible under 35 U.S.C. § 101.

Mayo/Alice Analysis — Step 1

Regarding *Alice* Step 1, Appellant contends:

This claim is not directed to a law of nature, natural phenomena, or an abstract idea, because, as described in more detail below, this claim is not directed to the subject matter of any of the only three types of claims that the Court has positively identified as being within the implicit exception to subject matter eligibility: (1) an idea or algorithm of itself, (2) a mathematical formula, or a (3) a fundamental economic practice.

App. Br. 126–128.

In response, the Examiner explains the basis for the rejection:

The invention is nothing more than a means for sending targeted ads to users based on their preferences and personality traits, which includes the steps of: gathering user responses, comparing those responses with segments of users who share

⁴ 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 v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018).

similar responses, enabling the user to select a segment of their choosing, noting user's selection, providing a targeted ad for a product or service to the user based on their selection, and enabling the user to purchase the advertised product or service.

Ans. 5–6.

The Examiner additionally explains:

Federal Circuit has held that "customizing information based on ... information known about the user" is an abstract idea. *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369 (Fed. Cir. 2015). The court in the *Intellectual Ventures I* case explained that tailoring of content based on information about the user—such as where the user lives or what time of day the user views the content—is an abstract idea that is as old as providing different newspaper inserts for different neighborhoods. *Id.*

...

Accordingly, the Federal Circuit has treated collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas. See, e.g., *Internet Patents*, 790 F.3d at 1349; *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011).

Ans. 7–8, (emphasis omitted).

The Examiner further explains:

Here, the claims are clearly focused on the combination of those abstract processes. The advance they purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not an inventive technology for performing those functions. They are therefore directed to an abstract idea.

More particularly, a large portion of the claims is devoted to enumerating types of information and information sources available within the user environment.

Ans. 8–9 (emphasis omitted).

In determining whether claims are patent-eligible under Section 101, our reviewing court guides: “the decisional mechanism courts now apply 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) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016). The Federal Circuit also guides that “examiners are to continue to determine if the claim recites (i.e., sets forth or describes) a concept that is similar to concepts previously found abstract by the courts.” *Id.* at 1294 n.2.

Data gathering is a classic example of insignificant extra-solution activity. *See, e.g., In re Bilski*, 545 F.3d 943, 963 (Fed. Cir. 2008) (en banc), *aff’d sub nom, Bilski v. Kappos*, 561 U.S. 593 (2010). The Federal Circuit 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); *see also Smart Sys. Innovations, LLC v. Chicago Transit Auth.*, 873 F.3d 1364, 1372 (Fed. Cir. 2017) (concluding “claims directed to the collection, storage, and recognition of data are directed to an abstract idea”); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (the collection of information and analysis of information are abstract ideas).

Additionally, the collection of information and analysis of information (e.g., gathering, comparing and matching responses) are also abstract ideas. *Elec. Power*, 830 F.3d at 1353. 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); *see also*

Am., Inc. v. InvestPic, LLC, 890 F.3d 1016, 1021 (Fed. Cir. 2018) (“merely presenting the results of abstract processes of collecting and analyzing information . . . is abstract as an ancillary part of such collection and analysis”) (quotations omitted).

Moreover, our reviewing court recently has concluded that acts of parsing, comparing, storing, and editing data are abstract ideas. *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1366 (Fed. Cir. 2018). “[M]erely selecting information, by content or source, for collection [and] analysis . . . does nothing significant to differentiate a process from ordinary mental processes” *Elec. Power Grp.*, 830 F.3d at 1355. Data gathering, such as receiving and analyzing (or identifying data), by itself, does not transform an otherwise-abstract process or system of information collection and analysis. *See id.*

Therefore, on this record, we conclude Appellant’s claims 7–12, 28, and 31–36 are directed to an abstract idea of a fundamental economic activity, which is similar to the abstract ideas identified by our reviewing courts, as discussed above.

Mayo/Alice Analysis – Step 2

Because we conclude the claims on appeal are directed to an abstract idea for essentially the same reasons articulated by the Examiner (Final Act. 4, Ans. 2–10), we now turn to the second part of the *Alice/Mayo* analysis. We analyze the claims to determine if there are additional limitations that individually, or as an ordered combination, ensure the claims amount to “significantly more” than the abstract idea. *Alice*, 134 S. Ct. at 2357 (internal quotations and citation omitted).

Regarding *Alice* Step 2, Appellant argues that the claims amount to “‘significantly more’ than an abstract idea.” App. Br. 130–165. Although Appellant’s arguments are voluminous, they are mere attorney arguments that point to no technological improvement. We do not find such arguments persuasive.

Appellant’s sole independent claim 7 is directed to a computer executed method that performs the steps of the method using generic computer components: i.e., “a computer with at least one processor and a network connection.” We find the claims on appeal are *silent* regarding specific limitations directed to an *improved* computer system, processor, memory, network, database, or Internet. Therefore, we find Appellant’s claimed invention does not provide a solution “necessarily rooted in *computer technology* in order to overcome a problem specifically arising in the realm of computer networks,” as considered by the court in *DDR Holdings LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014) (emphasis added).

Further, regarding the use of the recited generic computers, the Supreme Court held “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 134 S. Ct. at 2358; *see also* *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016) (“An abstract idea on ‘an Internet computer network’ or on a generic computer is still an abstract idea”). On this record, we are of the view that Appellant’s claims do not operate the recited generic computer components in an unconventional manner to achieve an improvement in computer functionality.

Our reviewing court provides additional guidance: *See FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1096 (Fed. Cir. 2016) (“[T]he use of generic computer elements like a microprocessor or user interface do not alone transform an otherwise abstract idea into patent-eligible subject matter.”); *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (claims reciting, *inter alia*, sending messages over a network, gathering statistics, using a computerized system to automatically determine an estimated outcome, and presenting offers to potential customers found to merely recite “well-understood, routine conventional activities” by either requiring conventional computer activities or routine data-gathering steps) (internal citation omitted); *see also Elec. Power Grp.*, 830 F.3d at 1355 (“We have repeatedly held that such invocations of computers and networks that are not even arguably inventive are ‘insufficient to pass the test of an inventive concept in the application’ of an abstract idea” (quoting *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1353, 1355 (Fed. Cir. 2014))); *Intellectual Ventures I LLC v. Capital One Financial Corp.*, 850 F.3d 1332, 1341 (Fed. Cir. 2017) (“Rather, the claims recite both a generic computer element—a processor—and a series of generic computer ‘components’ that merely restate their individual functions That is to say, they merely describe the functions of the abstract idea itself, without particularity. This is simply not enough under step two”).

The Supreme Court additionally guides that the “prohibition against patenting abstract ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or [by] adding ‘insignificant postsolution activity.’” *Bilski*, 561 U.S. at 610–11 (quoting *Diehr*, 450 U.S. at 191–92).

Because we find Appellant has not established that claims 7–12, 28, and 31–36 are directed to an *improvement* in the recited generic *computer* and network, we conclude that none of the claim limitations, viewed both individually and as an ordered combination, amount to significantly more than the judicial exception in order to sufficiently transform the nature of the claims into patent-eligible subject matter.

In light of the foregoing, we conclude, under the *Mayo/Alice* analysis, that each of Appellant’s claims 7–12, 28, and 31–36, considered as a whole, is directed to a *patent-ineligible abstract idea* (under *step one*), and under *step two*, does not recite something *significantly more* to transform the nature of the claim into a patent-eligible application.

Accordingly, for the reasons discussed above, we sustain the Examiner’s rejection C under 35 U.S.C. § 101, of claims 7–12, 28, and 31–36, as being directed to a judicial exception, without significantly more.⁵

Rejection D of Claims 7–10, 31, and 36 under 35 U.S.C. § 103(a)

Appellant contends Andra does not teach or suggest the “comparing limitation” as recited in independent claim 7:

comparing and matching, using the computer, the plurality of responses of the at least one individual to a first segment of multiple unknown persons of a plurality of segments of multiple unknown persons who share similar responses, wherein the first segment includes multiple preference responses from the multiple unknown persons, wherein the multiple unknown persons are unknown to the at least one individual.

⁵ To the extent Appellant has not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

App. Br. 180.

The Examiner finds Andra's described method teaches this disputed limitation. Ans. 8–9, citing Andra, Figs. 3, 5, 6, ¶¶ 73–79, 84–87 and 90.

Appellant, in particular, argues that the claimed *user anonymity* is not taught or suggested in the cited sections of Andra. App. Br. 183. Appellant specifically contends this disputed limitation is not taught or suggested by Andra because:

Andra matches a user to specific named individuals based on opinions so that the users can meet and communicate. The current claims recite "unknown persons" and "wherein the first segment includes multiple preference responses from the multiple unknown persons, wherein the multiple unknown persons are unknown to the at least one individual." Andra matches named individuals (non-anonymous) to other named individuals. "The user match field 512 may illustrate 'Jane Smith, Tom Green, Charles Brown' in the first row, 'Mia White, Alfred Chang, Joe Gibbs and Charles Brown' in the second row, 'Dan O'Neil, Lisa Hans' in the third row, and 'Derek O'Brain' in the fourth row." These individuals cannot be said to be anonymous as claimed and the rejection violates the broadest reasonable interpretation of the claim language because the individuals of Andra are clearly not unknown to other individuals in a segment in which they have chosen to be a part.

App. Br. 184.

We are persuaded by Appellant's arguments because Andra does not teach or suggest responses of "unknown persons." *See* claim 7: "wherein the first segment includes multiple preference responses from the *multiple unknown persons*, wherein the *multiple unknown persons* are unknown to the at least one individual." (Emphasis added).

Therefore, based upon this record, for essentially the same reasons argued by Appellant (App. Br. 184), we are persuaded of at least one error in

the Examiner's reliance on the disclosure of the cited prior art to teach or suggest the disputed limitations of independent claim 7, such that we find error in the Examiner's resulting legal conclusion of obviousness. Therefore, we are constrained on this record to reverse the Examiner's obviousness rejection D of sole independent claim 7. For the same reason, we also reverse rejection D of associated dependent claims 8–10, 31, and 36.

Remaining Dependent Claims rejected under Rejections E–I

Regarding the remaining rejected dependent claims on appeal, we also reverse rejection E of claim 11, rejection F of claim 12, rejection G of claim 28, rejection H of claims 32–34, and rejection I of claim 35. On this record, the Examiner has not established that the additionally cited secondary references overcome or cure the aforementioned deficiencies of the base combination of Monteforte, Andra, and Buchanan, as relied upon by the Examiner to reject independent claim 7.

CONCLUSIONS

The Examiner erred in rejecting claim 33 under 35 U.S.C. § 112, first paragraph (written description).

The Examiner erred in rejecting claim 33 under 35 U.S.C. § 112, second paragraph, for indefiniteness.

The Examiner did not err in rejecting claims 7–12, 28, and 31–36 under 35 U.S.C. § 101, as being directed to a judicial exception, without significantly more.

The Examiner erred in rejecting claims 7–12, 28, and 31–36 under 35 U.S.C. § 103(a).

DECISION

We reverse the Examiner’s decision rejecting claim 33 under 35 U.S.C. § 112, first paragraph (written description).

We reverse the Examiner’s decision rejecting claim 33 under 35 U.S.C. § 112, second paragraph.

We affirm the Examiner’s decision rejecting claims 7–12, 28, and 31–36 under 35 U.S.C. § 101.

We reverse the Examiner’s decision rejecting claims 7–12, 28, and 31–36 under 35 U.S.C. § 103(a).

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner’s decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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