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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN T. WALSH,
YOURI MATIOUNINE, and JOSEPH L. BERKOWITZ

Appeal 2017-009635
Application 11/668,359¹
Technology Center 3600

Before ERIC B. CHEN, MATTHEW R. CLEMENTS, and
SCOTT E. BAIN, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–14, 16, and 20–32. Claims 15, 17–19, and 33–37 are canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellants identify the real party in interest as “New York Life Insurance Company.” App. Br. 2.

STATEMENT OF THE CASE

Appellants' invention is an insurance product with customizable distributions, e.g., by amount and/or duration. Spec., Abst. The benefits are distributed upon the death of the insured and/or the occurrence of a secondary triggering event, e.g., a specified age of the beneficiary. *Id.*

Claims 1, 16, and 20 are independent. Claim 1 is reproduced below and the representative claim for the sole rejection on appeal. *See* 37 C.F.R. § 41.37(c)(1)(iv) (representative claims); App. Br. 5 (grouping of claims).

1. A computerized method for establishing triggering events for an event-driven processing device, the method comprising:

electronically receiving, by the event-driven processing device coupled to a communication module, benefit information that is transmitted from a user interface to the communication module over a communication infrastructure, the benefit information including a schedule for providing a plurality of benefits;

electronically computing, by the event-driven processing device accessing a connection to a premium calculator, a cost to a party acquiring the income protection insurance for providing the plurality of benefits;

electronically detecting, by the event-driven processing device accessing a connection to a triggering events database, one or more triggering events that determine a start date for distributing a first benefit of the plurality of benefits, wherein at least one of the one or more triggering events that determine the start date for distributing a first benefit of the plurality of benefits is a death;

distributing, by the event-driven processing device, at least a portion of the first benefit;

electronically detecting, by the event-driven processing device accessing a connection to a triggering events database, one or more triggering events that determines a start date for distributing one or more second benefits of the plurality of benefits, wherein at least one of the one or more triggering events that determines the start date for distributing the one or more second benefits is an event uncertain to occur specified prior to a start of coverage; and

distributing, by the event-driven processing device, at least a portion of the one or more second benefits.

App. Br. 13 (Claims Appx.).

THE REJECTION

Claims 1–14, 16, and 20–32 stand rejected under 35 U.S.C. § 101 as directed to a judicial exception of statutory subject matter. Final Act. 2–4.

PRINCIPLES OF LAW

The Supreme Court has long held that “[l]aws 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 *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). The “abstract ideas” category embodies the longstanding rule that an idea, by itself, is not patentable. *Alice Corp.*, 134 S. Ct. at 2354–55 (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)).

In *Alice*, the Supreme Court set forth an analytical “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355. 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.* There is no definitive rule to determine what constitutes an “abstract idea.” Rather, the Federal Circuit has explained that “both [it] and the Supreme Court have found it sufficient to compare claims at issue to those claims already found to be directed to an abstract idea in previous cases.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016); *see also Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (explaining that, in determining whether claims are patent-eligible under § 101, “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”). The Federal Circuit also noted 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.” *Amdocs*, 841 F.3d at 1294 n.2 (internal citation omitted).

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 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 79, 78 (2012)). 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.* (quoting *Mayo*, 566 U.S. at 73). Mere use

of computers, even in conjunction with other hardware, does not alone transform an abstract idea to significantly more. *See, e.g., Content Extraction & Transmission LLC v. Wells Fargo Bank*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (patent-ineligible claims requiring a computer and scanner); *CLS Bank Int'l v. Alice Corp. Pty.*, 717 F.3d 1269, 1286 (Fed. Cir. 2013) (“[S]imply appending generic computer functionality to lend speed or efficiency . . . does not meaningfully limit claim scope for purposes of patent eligibility.”), *aff'd by Alice*. We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or instead are directed to a result or effect that itself is the abstract idea and merely invokes generic processes and machinery. *See Smart Sys. Innovations, LLC v. Chicago Transit Auth.*, 873 F.3d 1364, 1371 (Fed. Cir. 2017).

EXAMINER’S FINDINGS

The Examiner finds claim 1 is directed to “providing an income protection insurance to a designated beneficiary” (Final Act. 2; *see also* Ans. 2) and implements the following concepts:

establishing triggering events, receiving benefit information, computing a cost to a party acquiring the income protection insurance for providing the plurality of benefits, detecting one or more triggering events to determine start date for distributing a first benefit, distributing at least a portion of the benefit, detecting one or more triggering events that determines a start date for one or more second benefits, distributing at least a portion of the one or more second benefits.

Final Act. 2; *see also* Ans. 6. The Examiner finds these concepts are analogous to the judicially-recognized abstract ideas of: creating a contractual relationship, as in *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350 (Fed. Cir. 2014); mitigating risk, as in *Bilski v. Kappos*, 561 U.S. 593 (2010) and *Alice*; managing an insurance policy, as in *Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Canada (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012).

Final Act. 2; Ans. 3, 6.

The Examiner finds the remaining claim requirements are “generic computer functions (i.e., defining criteria/variables, receiving information, computing costs, detecting a predefined event, distributing/transferring funds in response to the predefined event).” Final Act. 3; *see also* Ans. 4 (“the claims recite the additional limitations of a computerized method performing the method steps, electronically receiving, computing, detecting information by an event-driven processing device, the event-driven processing device accessing a connection to a triggering events database, a computer program product comprising non-transitory computer readable media[,] and one or more computer programs of computer readable instructions executable by the computer system to perform the method steps.”). The Examiner finds these functions “do not add meaningful limitations” (Final Act. 3), but rather constitute a computerized method, processing device, database, and computer system “recited at a high level of generality and . . . performing generic computer functions” (Ans. 4).

STEP ONE (ABSTRACT IDEAS)

Appellants argue claim 1 “do[es] not recite a basic concept that is similar to any abstract idea previously identified by the courts,” but rather recites “an event-driven processing device that interacts with database triggering events and generates decisions to respond to the changes.” App. Br. 7. Appellants describe the claimed invention as a “technical improvement” to “event-driven systems with regard to listening and filtering specific events, making proactive decisions, and how to react to database triggering events.” *Id.* at 6. Appellants contend that “[t]his technical improvement allows information to be propagated in near-real-time throughout a highly distributed environment, and enable a system to proactively respond to various risk events.” *Id.* Thus, Appellants conclude, “the claimed methods and computer program product are necessarily rooted in computer technology to overcome a problem specifically arising in event-driven systems.”

Appellants’ argument is not persuasive. We agree with the Examiner that claim 1 is directed to the idea of “providing an income protection insurance to a designated beneficiary,” which is like the abstract ideas identified in *Bancorp* (managing a life insurance policy), *buySafe* (creating a contractual relationship), and *Bilski* (risk hedging). Ans. 3, 6. The recited technical details merely implement the abstract idea via generic computer technology, which is not sufficient to render an idea non-abstract. Ans. 2–4, 5–7 (Examiner’s findings); *see also Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344 (Fed. Cir. 2013) (“akin to

stating the abstract idea . . . and adding the words: ‘apply it’ on a computer.” *CLS Bank*, 717 F.3d at 1291 . . . (citing *Mayo*, 132 S. Ct. at 1294).” (internal bracketing omitted)).

Appellants also argue that the claimed method processes the insurance tasks with “near-real-time” and “highly distributed” means of collecting, filtering, and responding to information. App. Br. 6 (“listening[,] . . . filtering[, and] making . . . decisions . . . in near-real-time throughout a highly distributed environment”). This argument is not persuasive because it is not commensurate with the claims, which do not recite propagating information in near-real-time in a highly distributed environment or proactively responding to various risk events.

STEP TWO (INVENTIVE CONCEPT)

Turning to the second step of the *Alice/Mayo* framework, Appellants argue the claimed method “builds responses around database triggering events within an event-driven architecture,” which “allows information to be propagated throughout a distributed environment, and . . . is [thus] necessarily rooted in computer technology, similar to the additional elements in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014)].” App. Br. 10.

In *DDR*, however, the claims were determined to be patent-eligible because they recited an *unconventional process* in the realm of computer technology. 773 F.3d at 1258 (“[T]he claims . . . specify how interactions with the Internet are manipulated to yield . . . a result that overrides the routine and conventional sequence of events ordinarily triggered by the click

of a hyperlink.”); *see also Bascom*, 827 F.3d at 1350 (The patent-eligible claim, though directed to the abstract idea of filtering, unconventionally located the filter tool.”). The *DDR* court emphasized that the claims did not “recite a commonplace business method aimed at processing business information, applying a known business process to the particular technological environment . . . , or creating or altering contractual relations using generic computer functions and conventional network operations.” *Id.*

Unlike the *DDR* claims, Appellants’ claim 1 “broadly and generically claim[s] use of [generic hardware and conventional computer functions] to perform an abstract business practice.” *Id.* (internal quotation marks and citation omitted); *see also* Spec. ¶¶ 4–11 (confirming that only business problems, not technical problems and solutions, are addressed by Appellants’ invention). This is consistent with the Specification, the vast majority of which describes business aspects of the methods illustrated in Figures 1 and 2. Spec. *passim*. The Specification devotes only four of its ninety-three paragraphs to describing system 300 on which the disclosed methods may be implemented, and these four paragraphs merely state that the system may include a client, server, user interface, communication module, processor, various databases, communication infrastructure, and various calculators. Spec. ¶¶ 86–89. These four paragraphs do not describe anything unconventional, much less how to “build responses around database triggering events within an event-driven architecture,” as Appellants characterize their invention (App. Br. 10).

CONCLUSION

Having applied the two-part test of *Mayo* and *Alice*, as described herein, we find no error in the Examiner's determination that claim 1 is drawn to an abstract idea and does not add an inventive concept.

DECISION

For the foregoing reasons, we affirm the Examiner's decision rejecting claims 1–14, 16, and 20–32.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED