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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/010,863	08/27/2013	Andre B. Black	CAM920115011US2_8150-0395	2248
73109	7590	09/13/2019	EXAMINER	
Cuenot, Forsythe & Kim, LLC			UDDIN, MOHAMMED R	
20283 State Road 7			ART UNIT	
Ste. 300			PAPER NUMBER	
Boca Raton, FL 33498			2167	
			NOTIFICATION DATE	
			DELIVERY MODE	
			09/13/2019	
			ELECTRONIC	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANDRE B. BLACK, SUDHAKAR CHALIMADUGU,
DAVID F. CHEUNG, RUBY L. KENNEDY,
YUCHUN LEE, and PATRICK MARTIN

Appeal 2017-010226
Application 14/010,863¹
Technology Center 3600

Before JAMES T. MOORE, MEREDITH C. PETRAVICK, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The real party in interest is IBM Corporation. App. Br. 1.

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134(a) of the final rejection of claims 1–9, 14–22, and 27. App. Br. 2.

Appellant canceled claims 10–13 and 23–26. *Id.*

We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION²

We AFFIRM.

THE INVENTION

The invention relates to producing a visual representation of a marketing campaign targeted to certain customers. *See Spec.* 1:12–2:21. The visual representation can be a flow chart that is linked to a spreadsheet. *Id.* at 2:1–2. Figure 13 is reproduced below.

² Our decision will make reference to Appellant’s Appeal Brief (“App. Br.,” filed Jan. 30, 2017), Appellant’s Reply Brief (“Reply Br.” filed July 31, 2017), the Final Office Action (“Final Act.,” mailed Aug. 30, 2016), and the Examiner’s Answer (“Ans.,” mailed May 31, 2017).

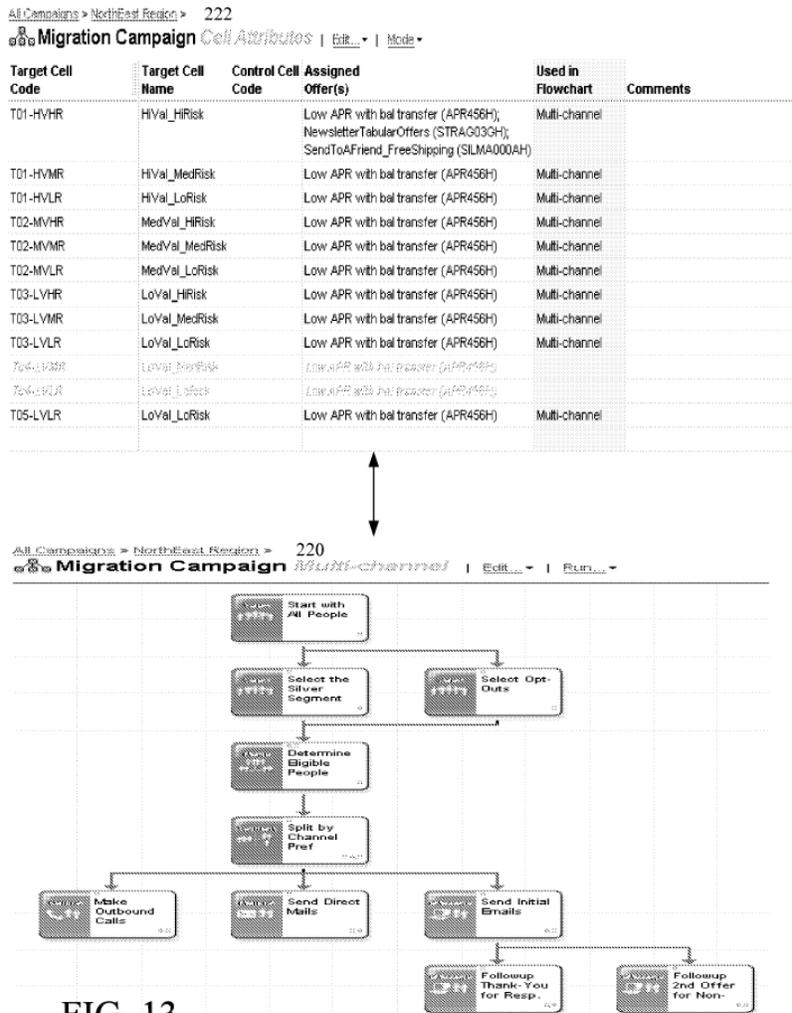


FIG. 13

“F[igure] 13 is a diagram depicting a target group spreadsheet and a campaign flowchart.” *Id.* at 3:15–16.

Claim 1, reproduced below, is illustrative of the claimed subject matter on appeal.

1. A computer-implemented method for target group management, comprising:

producing a computer data table including one or more group entries corresponding to one or more defined contact group entities with each of the entries having a first set of group attributes; and

producing a visual representation of a marketing

campaign, wherein the representation including one or more instances of defined contact group entities, the one or more instances having a second set of group attributes, and the representation linked to the table according to the second set of group attributes.

THE EVIDENCE

The Examiner relies upon the following as evidence of unpatentability:

Good US 2002/0120462 A1 Aug. 29, 2002

Psych US 2004/0093259 A1 May 13, 2004

THE REJECTIONS³

The Examiner rejected claims 1–9, 14–22, and 27 under 35 U.S.C. § 101 as being directed to non-statutory subject matter and under 35 U.S.C. § 103(a) as being unpatentable over Psych and Good.

ANALYSIS

35 U.S.C. § 101

An invention is patent eligible if it is a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[I]aws of nature, natural phenomena, and abstract

³ The Final Office Action includes a nonstatutory obviousness-type double patenting rejection of claims 1–9, 14–22, and 27. Final Act. 3–8. Appellant file a terminal disclaimer on July 31, 2017, which approved and entered the same day. The rejection is deemed moot.

ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a

mathematical formula.” *Diehr*, 450 U.S. at 176; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson and Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must 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.” *Alice*, 573 U.S. at 221 (citation omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (alterations in original) (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of § 101. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed.

Reg. 50 (Jan. 7, 2019) (“2019 Guidance”).⁴ Under the 2019 Guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity, such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP §§ 2106.05(a)–(c), (e)–(h)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

- (3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or
- (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See 2019 Guidance.

⁴ Appellant refers to prior USPTO guidance in its briefs. *See, e.g.*, App. Br. 13. Subsequently, the Office issued the 2019 Guidance. 2019 Guidance, 51 (“Eligibility-related guidance issued prior to the Ninth Edition, R–08.2017, of the MPEP (published Jan. 2018) should not be relied upon.”). Accordingly, our analysis will not address the sufficiency of the Examiner’s rejection against the earlier guidance and will comport with the 2019 Guidance.

For the reasons discussed below, we determine that the Examiner did not err in determining that claims 1–9, 14–22, and 27 are patent ineligible under 35 U.S.C. § 101.

Independent Claims 1, 14, and 27

Appellant argues independent claims 1, 14, and 27 as a group. App. Br. 9. We take independent claim 1 as representative, and claims 14 and 27 stand or fall with claim 1.

Judicial Exception

The Examiner determined that claim 1 is directed to “producing a visual representation from a table of defined group[s] of contact[s] for [a] marketing campaign” and that “[p]roducing a visual representation for a target contact group without significantly doing nothing more is nothing but an abstract idea.” Final Act. 2–3; *see also* Ans. 2–3. The Examiner determined that this is nothing more than collecting information, analyzing it, and displaying certain results of the collection and analysis. Ans. 6–7 (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016)).

Appellant broadly argues that the Examiner overgeneralizes the claims and broadly asserts that the claims are directed to more than producing a visual representation from a table of defined groups of contacts for a marketing campaign. App. Br. 12. Appellant, however, provides no explanation as to what is the alleged “more.” *See id.* at 10–12.

Claim 1 recites a method having two steps. The first step is “producing a . . . data table including one or more group entries corresponding to one or more defined contact group entities with each of the entries having a first set of group attributes.” App. Br., Claims App. This

first step recites nothing more than collecting information — a table having one or more group entries, defined as corresponding to one or more defined contact group entities, and having a first set of group attributes. The second step is “producing a visual representation of a marketing campaign, wherein the representation including one or more instances of defined contact group entities, the one or more instances having a second set of group attributes, and the representation linked to the table according to the second set of group attributes.” *Id.* The Specification describes that the second set of group attributes is linked to the table by correspondence to the first set of group attributes. *See* Spec. 1:20–2:2. As for the producing of a visual representation, the Specification describes a technical marketer (e.g., a user) producing a flow chart for the market campaign. *See id.* at 16:3–17. The second step is nothing more than a user analyzing information in their mind and creating a display of the information.

Given the above, we agree with the Examiner that claim 1 recites a method of producing a visual representation of a marketing campaign using information from a table of defined group entities. We also agree that the claimed steps reproduced above is a mental process involving nothing more than the collection, analysis, and display of information. Mental processes, without more, have been found to be an abstract idea. *See* 2019 Guidance, 52.

Court have found similar claims that recite information collection, analysis, and display, including when limited to particular content, without more, to be ineligible. *See, e.g., Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1349 (Fed. Cir. 2015); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); and

CyberSource Corp. v. Retail Decisions, Inc., 654 F.3d 1366, 1370 (Fed. Cir. 2011); *see also SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1167 (Fed. Cir. 2018) (“Contrary to InvestPic’s suggestion, it does not matter to this conclusion whether the information here is information about real investments. As many cases make clear, even if a process of collecting and analyzing information is ‘limited to particular content’ or a particular ‘source,’ that limitation does not make the collection and analysis other than abstract.” (quoting *Elec. Power Grp.*, 830 F.3d at 1353, 1355); *Affinity Labs of Tex., LLC v. Amazon.com Inc.*, 838 F.3d 1266, 1271 (Fed. Cir. 2016) (“[T]ailoring 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.”) (citing *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369 (Fed. Cir. 2015)); *Morsa v. Facebook, Inc.*, 77 F.Supp.3d 1007, 1013 (C.D. Cal. 2014), *aff’d*, 622 F.App’x 915 (Fed. Cir. 2015) (“The concept of gathering information about one’s intended market and attempting to customize the information then provided is as old as the saying, ‘know your audience.’” (quoting *OpenTV, Inc. v. Netflix Inc.*, 76 F.Supp.3d 886, 893 (N.D. Cal. 2014))).

*Additional Elements that
Integrate the Judicial Exception into a Practical Application*

In addition to the abstract idea, claim 1 recites that the method is “computer-implemented” and that the data table is a “computer data table.” App. Br., Claims App. The Specification describes using a general purpose microprocessor and processors of any kind of digital computer to implement the invention and does not describe any technological improvement to the

computers. *See* Spec. 35:29–31; *see also id.* at 34:21–35:18 (describing conventional computing components performing conventional activities). These additional claim elements do not recite an improvement to the functioning of a computer or otherwise reflect an integration into a practical application. *See* 2019 Guidance, 54–55. Rather, the additional elements merely recite the use of a computer as a tool to perform the recited method. The recitation of a result-oriented solution, that lacks any details as to how the computer performs the recited steps, is the equivalent of the words “apply it.” *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1341–42 (Fed. Cir. 2017) (citing *Elec. Power Grp.*, 830 F.3d at 1356 (cautioning against claims “so result focused, so functional, as to effectively cover any solution to an identified problem”))).

The additional elements do not integrate the judicial exception into a practical application. *See* 2019 Guidance, 53.

Well-Understood, Routine, Conventional

Claim 1 fails to add specific elements beyond the judicial exception that are not well-understood, routine, and conventional in the field. Claim 1’s recitations that the method is “computer-implemented” and that the data table is a “computer data table” simply append well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. *See Intellectual Ventures I*, 792 F.3d at 1368 (citing *Alice*, 573 U.S. at 225) (holding that instructing one to apply an abstract idea while reciting no more than generic computer elements that perform generic computer tasks does not make the abstract idea patent eligible); *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014) (holding that “each of those eleven steps merely instructs

the practitioner to implement the abstract idea ‘with routine, conventional activit[ies],’ which is insufficient to transform the patent-ineligible abstract idea into patent-eligible subject matter” (alteration in original)).

Appellant does not argue that claim 1 recites additional elements that add significantly more to the abstract idea. *See* App. Br. 16–17; Reply Br. 5.

For the reasons discussed above, we determine that the Examiner did not err in determining claim 1 is patent ineligible under 35 U.S.C. § 101. We sustain the rejection of claim 1, with claims 14 and 27 falling therewith. *Dependent Claims 2–9 and 15–22*

Appellant argues dependent claims 2–9 and 15–22 as a group. App. Br. 9. We select claim 2 as representative.

Claim 2 depends from claim 6 and recites, “wherein the second set of group attributes correspond to the first set of group attributes, and the table and the flowchart representing promotions assigned to contact group entities in a marketing campaign.” App. Br., Claims App. Claim 6 depends from claim 1 and recites, “wherein the table is a spreadsheet, and the visual representation is flowchart.” *Id.*

In addition to the argument raised with respect to claim 1, which are not persuasive for the reasons above, Appellant broadly asserts that “the dependent claims add additional elements that recite substantially more than the alleged abstract idea” and argues that “[t]he Examiner’s analysis is silent with regards to the dependent claims.” App. Br. 16–17; Reply Br. 5. Appellant, however, does not point out specifically what element or elements of claim 2 it alleges add significantly more to the abstract idea. As can be seen from reproduced claims 2 and 6, above, the claims further define the method and add a degree of particularity to the method, but do not make

the method any less abstract. *Ulramercial*, 772 F.3d at 714–15. Claim 2 does not recite any additional elements that add significantly more to the abstract idea.

We, thus, are not persuaded by Appellant that dependent claim 2 adds additional elements that recite substantially more than the abstract idea. The rejection of claims 2–9 and 15–22 under 35 U.S.C. § 101 is affirmed.

For the reasons discussed above, we determine that claims 1–9, 14–22, and 27 are patent ineligible under 35 U.S.C. § 101.

35 U.S.C. § 103

Appellant argues that the prior art, in particular Pych, does not disclose the first step of claim 1’s method — “producing a computer data table including one or more group entries corresponding to one or more defined contact group entities with each of the entries having a first set of group attributes.” *See* App. Br. 17–24; Reply Br. 5–9. Independent claims 14 and 27 recite corresponding limitations.

Initially, we note that the Specification contains a definition of the claim term “group” — “[a]s used herein, groups refer to collections of contacts, typically individuals or other entities, whereas target groups refer to groups of entities that are intended recipients for specific marketing communications, e.g., promotions.” Spec. 5:6–8. We apply this definition in our analysis. *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (The presumption that claim terms are given their ordinary and customary meaning is overcome where the patentee, acting as its own lexicographer, has clearly set forth a definition of the term different from its customary and ordinary meaning.).

The rejection and the Answer point to multiple tables and databases in Psych to explain how Psych teaches the claimed first step of producing the claimed computer data table. *See, e.g.*, Final Act. 9–10 (citing Psych ¶ 129, Figs. 7A–7L, 8A–8B), Ans. 12–13 (citing Psych ¶¶ 129, 132, Figs. 8A–8B, 9). These explanations, however, do not sufficiently show which of Psych’s tables or databases teaches the claimed data table. The rejection does not rely upon Good to teach this limitation. *See* Final Act. 10–11.

First, the rejection and the Answer seem to equate the database depicted in Psych’s Figure 8B to the claimed computer data table. *See, e.g.*, Ans. 12–13. The Answer points to Psych’s disclosure of a query for a campaign, which includes selecting two contact groups — (I) people over the age of 35 and having an income greater than \$25,000 and (II) anyone with an income greater than \$45,000 (Psych ¶ 129, Fig. 8A) and states:

That means computer data table 8B is created with three different group of contact entities, individual with income > 35 (A-E, G and H), individual with income > 45 (G, H) and individual with income < 35 (J, K), with different set of attribute, such as age, income. Therefore, with *examiner broadest reasonable interpretation* and it is clearly understood by one of ordinary skill in the art, that a computer data table is created in claimed invention is same as computer data table of Psych.

Ans. 12–13.

As Appellant points out, however, the query depicted in Figure 8A and described in paragraph 129 is not used to create the Figure 8B database, but is applied to the Figure 8B database. Reply Br. 7. Psych states: “The query process illustrated in FIG. 8A may be run against the database of FIG. 8B, in order to select individuals.” Psych ¶ 130 (emphasis omitted). The Figure 8B database contains “possible contacts for a marketing campaign”

(*id.*) and is not a database having one or more group entries produced by Figure 8A query.

Second, the Answer seems to equate the promotion history table depicted in Pych's Figure 9 to the claimed computer data table. Ans. 13. Although the Figure 9 promotion history table is produced by applying the Figure 8A query to the Figure 8B database, the Figure 9 promotion history table also does not have group entries. The Figure 9 promotion history table has an offer cell identification key column 90, a customer name or identification key column 92, and extract date column 94 (Pych ¶ 133), but not the claimed group entries. *See* Reply Br. 8.

Finally, in addressing the second step of the method of claim 1, the rejection and Answer point to Pych's behavior group table depicted in Figure 19. Final Act. 10; Ans. 16–17. The second step includes the limitation that “the representation linked to the table according to the second set of group attributes,” and “the table” refer back to the computer data table. App. Br., Claims App. Figure 19's behavior group table, however, also does not have the claimed group entries. *See* Pych ¶ 190, Fig. 19. We note that the reliance on Figure 19 is also inconsistent with the reliance on Figures 8A or 9 for the claimed first step.

“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). To establish a *prima facie* case of obviousness, the Examiner must show that each and every limitation of the claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art or the inferences and creative steps a person of ordinary skill in the art would have

employed. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007); *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Here, the Examiner has not met the burden of demonstrating how the prior art teaches all of the limitations of claim 1.

Accordingly, we reverse the rejection of independent claims 1, 14, and 27, and claims 2–9 and 15–22, dependent thereon, under 35 U.S.C. § 103(a) as being unpatentable over Pych and Good. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.”).

DECISION

We sustain the rejection of claims 1–9, 14–22, and 27 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. We do not sustain the rejection of claims 1–9, 14–22, and 27 under 35 U.S.C. § 103(a) over Pych and Good.

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. § 1.136(a)(1)(iv).

AFFIRMED