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OHLANDT, GREELEY, RUGGIERO & PERLE, LLP
ONE LANDMARK SQUARE, 10TH FLOOR
STAMFORD, CT 06901

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID BRUCE INGERMAN,
NEEL LEE CHAUHAN, and JEFFREY LEWIS KAUFMAN

Appeal 2017-010369
Application 12/231,110
Technology Center 3600

Before JOSEPH L. DIXON, DENISE M. POTHIER, and JOYCE CRAIG,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants¹ appeal under 35 U.S.C. § 134(a) from a rejection of claims 1–3, 5, 8–10, 12, 15–18, and 20–25. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The claims are directed to an online universal credit application. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method implemented by a computer, comprising:

presenting, by said computer, via an exchange of communications with a first device over a communications network, a first interface through which a creditor using said first device communicates with said computer, and in response to communications received from said creditor via said first interface, said computer performs actions of (i) accessing a credit application template to create a customized credit application customized by a creditor, said credit application being configured to dynamically respond to how a credit applicant fills out the credit application with conditional questions, so as to maximize a chance that the credit applicant can obtain an automated approval (ii) selecting a preexisting question for inclusion in said customized credit application, (iii) editing said preexisting question in said customized credit application, (iv) including a question other than said preexisting question in said customized credit application, and (v) storing said customized credit application in a memory;

presenting, by said computer, via an exchange of communications with a second device over said communications network, a second interface through which a credit applicant using said second device communicates with said computer, and in response to communications received from said credit

¹ Appellants indicated that Dun & Bradstreet, Inc. is the real party in interest. (App. Br. 2).

applicant via said second interface, said computer performs actions of (i) accessing said customized credit application from said memory, and (ii) providing information required by said customized credit application;

transmitting to a credit evaluation service provider, via said communications network, said credit application after said credit application has been completed by said credit applicant;

evaluating, by said computer, said information, to yield a credit report regarding said credit applicant;

receiving from said credit evaluation service provider, via said communications network, said credit application with at least one of data regarding credit status of said credit applicant, and an automated credit score, viewing, by the creditor, on a display of said first device, data entered by said credit applicant in said credit application alongside information that said credit evaluation service provider has accumulated about credit status of said credit applicant, and accessing said credit report; and

automatically applying to said credit application, as received from said credit evaluation service provider, decision rules to determine whether credit is to be extended to said credit applicant, wherein:

said evaluating comprises accessing a database to obtain supplemental information regarding said credit applicant, and

said credit report includes said supplemental information.

App. Br. 25–26 (Claims Appendix).

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Walker	US 2002/0107765 A1	Aug. 8, 2002
Rudy et al.	US 2003/0125990 A1	July 3, 2003

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Nelson et al.	US 2004/0030649 A1	Feb. 12, 2004
Jepsen et al.	US 2004/0088246 A1	May 6, 2004
Cash et al.	US 2006/0267999 A1	Nov. 30, 2006
Bird et al.	US 2007/0011083 A1	Jan. 11, 2007
Jenich et al.	US 2008/0109349 A1	May 8, 2008
Colabucci	US 2009/0144188 A1	June 4, 2009
Novak et al.	US 8,489,497 B1	July 16, 2013

REJECTIONS

The Examiner made the following rejections:

Claims 1–3, 5, 8–10, 12, 15–18, and 20–25 stand rejected under 35 U.S.C. § 101. The claimed invention is directed to non-statutory subject matter because the claim(s) as a whole, considering all claim elements both individually and in combination, do not amount to significantly more than an abstract idea.

Claims 1–3, 5, 8–10, 12, 15–18, and 20–25 stand rejected under 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 1, 5, 8, 12, 15–18, and 20–25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jepsen in view of Colabucci, Cash, Walker, and Bird, and further in view of Novak.

Claims 2, 3, 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jepsen in view of Colabucci, Cash, Walker, and Bird, and further in view of Novak, as applied to claims 1, 8 and 15 above, and further in view of Nelson.²

² Claims 4 and 11 were rejected by the Examiner, but claims 4, 6, 7, and 11 are canceled.

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Claims 1, 5, 8, 12, 15–18, and 20–25 stand further rejected under 35 U.S.C. § 103(a) as being unpatentable over Jepsen in view of Colabucci, Cash, Walker, and Bird, and further in view of Novak and further in view of Rudy.

Claims 2, 3, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jepsen in view of Colabucci, Cash, Walker, and Bird, and further in view of Novak, as applied to claims 1, 8 and 15 above, and further in view of Nelson.

ANALYSIS

35 U.S.C. § 101

An invention is patent-eligible if it claims 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: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012) (brackets in original) (citing *Diamond v. Diehr*, 450 U.S. 175, 185 (1981)).

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*. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217–18 (2014) (citing *Mayo*, 566 U.S. at 75–77). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 218–19 (“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

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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, 192 (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 187; *see also id.* at 192 (“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

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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 (internal quotation marks 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.* (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. USPTO’s January 7, 2019 Memorandum, 84 Fed. Reg. 50, 2019 Revised Patent Subject Matter Eligibility Guidance (“2019 Guidance”). Under that 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 (“Prong Two”) (see MPEP § 2106.05(a)–(c), (e)–(h)) (9th ed. 2018).

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 are 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.

With respect to independent claims 1, 8, and 15, Appellants present arguments directed to independent claim 1. Because we find the limitations to be similar for the three independent claims, we will address independent claim 1 as the illustrative claim and the same line of reasoning applies to independent claims 8 and 15 and their respective dependent claims.

With respect to illustrative independent claim 1, Appellants contend the Examiner erred because the “formation of a dynamically generated customized credit application based upon comments from the applicant is not abstract.” (App. Br. 6; *see also* App. Br. 14).

We agree with Appellants that the Examiner’s patent eligibility rejection errs in the conclusion regarding the abstract idea and the Examiner’s corresponding analysis based thereon did not show that the claimed invention was not directed to patent eligible subject matter.

The Examiner maintains the abstract idea is:

The claim(s) is/are directed to the abstract idea of **fundamental economic practice**, in particular accessing credit application template to create customizing credit application, selecting editing and including question in the credit application, providing accessing transmitting the credit application, credit application being based on how a credit applicant fills out questions, viewing data entered alongside accumulated information [] applying decision rules on whether to extend credit to said credit applicant, [and] obtain[ing] supplemental information regarding said applicant. This concept is similar to the types of concepts court have found to be abstract ideas (for example: comparing new and stored information and using rules to identify options (SmartGene: 17 see Section IV.B.4.); creating a contractual relationship (buySAFE: 14 see Section IV.C.3.); processing information through a clearinghouse (Dealertrack: 16

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see Section IV.B.3.) *it is noted that these examples are intended to be illustrative and not limiting*)

(Final Act. 2; Ans. 2).

Under the 2019 Guidance, judicial exceptions include certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human interactions such as a fundamental economic practice, or mental processes). We find the Examiner has not shown the claimed invention is directed to a fundamental economic practice as described in the 2019 Guidance. Moreover, we find the Examiner's analysis based on the Examiner's statement of the abstract idea does not support the Examiner's conclusion of a lack of patent eligible subject matter.

As a result, on the record before us, the invention as recited in illustrative independent claim 1 is not directed to a fundamental economic practice under the 2019 Guidance.

Additionally, if claim one were directed to a fundamental economic practice or a mental process, the claimed invention, as a whole, integrates the judicial exception into a practical application.

If a claim recites a judicial exception, in Prong Two we determine whether the recited judicial exception is integrated into a practical application of that exception by: (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application. If the recited judicial exception is integrated into a practical application, the claim is not *directed to* the judicial exception.

Here, claim 1 recites the additional elements of "a computer," "a communications network", "dynamically respond to how a credit applicant

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fills out the credit application” step, an “evaluating” step, a “receiving” step, a “evaluating” step, a “transmitting” step, and an “automatically applying” step. Considering the claim as a whole, interaction of all the steps using the communication network and the computer applies or uses the abstract idea in a meaningful way such that the claim as a whole is more than a drafting effort designed to monopolize the exception. Thus, the abstract idea is integrated into a practical application.

As a result, we cannot sustain the Examiner’s conclusion of a lack of patent eligible subject matter of independent claims 1, 8 and 15 and their dependent claims based upon the Examiner’s same deficient factual findings in the Final Action and the Examiner’s Answer.

35 U.S.C. § 112, second paragraph

With respect to the indefiniteness rejection, the Examiner includes the rejection in the Examiner’s Answer indicates that “The 112 2nd paragraph rejection is maintained.” (Ans. 3–4; 23). The Examiner finds that the claim language “so as to maximize a chance that the credit applicant can obtain an automated approval” is not clear and this phrase “so as to” is meant to limit the metes and bounds of the claim. (Ans. 3).

Appellants do not substantively respond to the Examiner’s rejection and contend:

“This rejection is not significant with respect to this Appeal. In the after final amendment filed on November 2, 2016 (*not entered on other grounds*) an amendment to the independent claims proposes deleting the words “so as” and changing the words “can obtain” to “obtains”. Upon resolution of the issues presented herein, the Applicant has no objection to amending the independent claims in this manner to overcome this rejection.”

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(App. Br. 16).

We agree with the Examiner that the language is not sufficiently definite so as to clearly define the metes and bounds of the claimed invention, and Appellants have not provided an argument thereto. Therefore, we summarily affirm the Examiner's rejection of the claims based upon indefiniteness.

35 U.S.C. § 103

With respect to independent claims 1, 8, and 15, Appellants do not set forth separate arguments for patentability with respect to claims 1, 8, and 15, and Appellants address independent claim 1 as the representative claim for the group. (App. Br. 18). Therefore, we select independent claim 1 as the representative claim and will address Appellants' arguments thereto. *See* 37 C.F.R. § 41.37(c)(1)(iv). We do not consider arguments that Appellants could have made but chose not to make in the Brief so we deem any such arguments as waived. 37 C.F.R. § 41.37(c)(1)(iv).

Appellants contend that:

Claim 1 recites the technological solution of accessing a credit application template to create a customized credit application, which is customized by a creditor, wherein the credit application is configured to dynamically respond to how a credit applicant fills out the credit application with conditional questions, so as to maximize a chance that the credit applicant can obtain an automated approval.

(Reply Br. 7; *see also* App. Br. 19). Appellants further contend:

None of the prior art teaches or suggests this approach. In addition to all of the benefits discussed below, claim 1 has the advantage, discussed in paragraph [0031] of permitting a credit applicant to, in certain cases, enter a smaller amount of detailed information. As stated in paragraph [0031]: "For example, a

smaller company may be required to fill out a bank and trade section, whereas a larger company may not be required to do so.”

(App. Br. 19). Appellants argue “claim 1 not only provides the creditor with the ability to see, on a display, both the data entered by the credit applicant and the data accumulated by the credit evaluation service provider.” (App. Br. 19).

Appellants argue that the Examiner has applied four separate obviousness rejections with six and seven references, and consequently the Examiner’s rejection must be based upon hindsight reconstruction. (App. Br. 17, 23–24). Appellants further rely upon there Specification at page 31 regarding permitting a credit applicant to enter a smaller amount of detailed information, but the Examiner points out this level of detail is not found in the claim language. (App. Br. 19; Reply Br. 7; Ans. 24).

The Examiner finds that the express language of independent claim 1 does not support Appellants’ argument because the proffered distinctions are not recited in the claims. (Ans. 23–24). Appellants’ argument fails because it is not commensurate with the scope of the claim. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (“[A]ppellant’s arguments fail from the outset because . . . they are not based on limitations appearing in the claims.”). *See In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998) (“[The] proffered facts . . . are not commensurate with the claim scope and are therefore unpersuasive.”). As a result, Appellants’ arguments do not show error in the Examiner’s factual findings or conclusion of obviousness of representative independent 1.

Appellants also argue that Jepsen cannot be characterized as being customized for a lender. (App. Br. 21). But the Examiner identifies how Jepsen teaches this aspect of the disclosed invention and also finds that this

disputed language (“for the lender”) is not even recited in independent claim 1. (Ans. 24 (citing Jepsen ¶¶ 16, 43, 45–46, 57).

Appellants also argue that claim 1 provides a series of significant advantages not disclosed or even remotely suggested by the prior art. (App. Br. 20; Reply Br. 7). Appellants argue that the prior art references do not automatically apply rules to the credit application (App. Br. 19–20; Reply Br. 8), but the Examiner identifies portions of the Jepsen and Cash references for this limitation. (Ans. 24–25). Therefore, this argument is not persuasive of error, and the Examiner further finds that automating a manual activity broadly is not a patentable distinction. (Ans. 25). We agree with the Examiner.

In the Reply Brief, Appellants argue the Examiner relied upon hindsight in the obviousness rejection and the reliance upon paragraph 31 of the Specification. (Reply Br. 7). But Appellants’ argument goes beyond the express claim language, emphasizing the aspect of how a credit applicant fills out the application.

Finally, Appellants argue that Jepsen does not teach or suggest the emphasized limitations (App. Br. 21–22; Reply Br. 7–8), but Appellants do not address the other five or six references that the Examiner uses in combinations to supplement Jepsen’s teachings for many of the disputed claim limitations. As a result, we find Appellants’ general argument does not show error in the Examiner’s factual findings or conclusion of obviousness of representative independent claim 1.

CONCLUSIONS

The Examiner did not err in rejecting claims 1–3, 5, 8–10, 12, 15–18, and 20–25 based upon indefiniteness under 35 U.S.C. § 112, second

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paragraph; the Examiner did not err in rejecting claims 1–3, 5, 8–10, 12, 15–18, and 20–25 based upon obviousness under 35 U.S.C. § 103; but the Examiner erred in rejecting claims 1–3, 5, 8–10, 12, 15–18, and 20–25 based upon a lack of patent eligible subject matter.

DECISION

For the above reasons, we sustain the Examiner’s indefiniteness rejection of claims 1–3, 5, 8–10, 12, 15–18, and 20–25 under 35 U.S.C. § 112, second paragraph, and we sustain the Examiner’s obviousness rejection of claims 1–3, 5, 8–10, 12, 15–18, and 20–25 under 35 U.S.C. § 103, but we reverse the Examiner’s patent eligibility rejection of claims 1–3, 5, 8–10, 12, 15–18, and 20–25 under 35 U.S.C. § 101.

Because we affirm at least one ground of rejection with respect to each claim on appeal, the Examiner’s decision to reject claims 1–3, 5, 8–10, 12, 15–18, and 20–25 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