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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* THOMAS H. GONSER, DONALD G. PETERSON,  
DOUG RYBACKI, AARON MICHAEL WALD, and  
RYAN RUSSELL THOMAS

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Appeal 2017-010403  
Application 13/838,754  
Technology Center 3600

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Before KALYAN K. DESHPANDE, JOHNNY A. KUMAR, and  
JOYCE CRAIG, *Administrative Patent Judges*.

CRAIG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants<sup>1</sup> appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 3, 4, 6–9, 11, 13, 14, 16, and 21–29, which are all of the claims pending in this application.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> According to Appellants, the real party in interest is DocuSign, Inc. App. Br. 2.

<sup>2</sup> Claims 2, 5, 10, 12, 15, and 17–20 have been canceled. *See* Amendment entered May 18, 2015.

## INVENTION

Appellants' invention relates to formula calculation and payment authorization with electronic signatures. Abstract. Claim 1 is illustrative and reads as follows:

1. A method executed by an electronic signature service (ESS) computing device that is configured to securely store an electronic signature document and at least one indication of a corresponding signature to the document, the method comprising:

associating a payment form with the electronic signature document, the payment form associated with a payment processor separate from the ESS computing device, and the payment form configured to obtain payment data from a user;

transmitting an initiation of an electronic signature request to a client device associated with the user, the electronic signature request including a presentation of the electronic signature document, the payment form, and an electronic signature field to the user for signature, the payment form including a payment amount determined based on an evaluation of an expression that includes at least one operator and a reference to a field included in the payment form, the payment amount of the payment form configured to be dynamically determined responsive to the client device associated with the user initiating the electronic signature request;

receiving a user signature for the electronic signature field from the client device associated with the user;

receiving payment data from the client device associated with the user via the payment form; and

transmitting at least a portion of the payment data and the received user signature of the electronic signature field to the payment processor associated with the payment form as authorization for the payment processor execute a payment authorization process based on the payment data received via the payment form.

### REJECTIONS<sup>3</sup>

Claims 1, 3, 4, 6–9, 11, 13, 14, 16, and 21–29 stand rejected under 35 U.S.C. § 101 as directed to patent ineligible subject matter because the claimed invention is directed to a judicial exception, without significantly more. Final Act. 8–10.

Claims 1, 3, 4, 6–9, 11, 13, 14, 16, and 21–29 stand rejected under pre-AIA 35 U.S.C. § 102(b) as anticipated by Leong et al. (US 7,167,844 B1; issued Jan. 23, 2007) (“Leong”). Ans. 3–9.

### PRINCIPLES OF LAW

#### A. 35 U.S.C. § 101

“Whether a claim is drawn to patent-eligible subject matter is an issue of law that we review de novo.” *SiRF Tech., Inc. v. Int’l Trade Comm’n*, 601 F.3d 1319, 1331 (Fed. Cir. 2010) (citation omitted).

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101.<sup>4</sup> 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)).

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<sup>3</sup> In the Answer, the Examiner withdrew the rejection of claims 1, 3, 4, 6–9, 11, 13, 14, 16, and 21–29 under 35 U.S.C. § 103(a). Ans. 9.

<sup>4</sup> This threshold analysis of whether a claim is directed to one of the four statutory categories of invention, i.e., a process, machine, manufacture, or composition of matter, is referred to as “*Step 1*” in the patent-eligibility inquiry under § 101.

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*, 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 “[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.”).

However, the Federal Circuit has held claims ineligible as directed to an abstract idea when they merely collect electronic information, display information, or embody mental processes that could be performed by humans. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016) (collecting cases). At the same time, “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. Abstract ideas may include, but are not limited to, fundamental economic practices, methods of organizing human activities, and mathematical formulas or relationships. *Alice*, 573 U.S. at 217–21. Under this guidance, we must therefore ensure at step one that we articulate what the claims are directed to with enough specificity to ensure the step one inquiry is meaningful. *Id.* at 217 (“[W]e tread carefully in construing this exclusionary principle lest it swallow all of patent law.”).

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 (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.* (alteration 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.*

#### B. USPTO Revised Guidance

The PTO recently published revised guidance in the Federal Register concerning the application of § 101. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (January 7, 2019) (hereinafter “Revised Guidance”) (<https://www.govinfo.gov/content/pkg/FR-2019-01-07/pdf/2018-28282.pdf>).

Under the Revised 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);<sup>5</sup> and

(2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).<sup>6</sup>

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<sup>5</sup> Referred to as “*Revised Step 2A, Prong 1*” in the Guidance (hereinafter “*Step 2A(i)*”).

<sup>6</sup> Referred to as “*Revised Step 2A, Prong 2*” in the Guidance (hereinafter “*Step 2A(ii)*”).

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.<sup>7</sup>

*See* Revised Guidance.

*Step 2A(i) – Abstract Idea*

Informed by our judicial precedent, the recent Revised Guidance extracts and synthesizes key concepts identified by the courts as abstract ideas to explain that the abstract idea exception includes the following groupings of subject matter, when recited as such in a claim limitation:

(a) Mathematical concepts—mathematical relationships, mathematical formulas or equations, mathematical calculations;

(b) Certain methods of organizing human activity — fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions); and

(c) Mental processes—concepts performed in the human mind (including an observation, evaluation, judgment, opinion).

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<sup>7</sup> Items (3) and (4) continue to be collectively referred to as “*Step 2B*” of the Supreme Court’s two-step framework, described in *Mayo* and *Alice*.

Under the Revised Guidance, if the claim does not recite a judicial exception (a law of nature, natural phenomenon, or subject matter within the enumerated groupings of abstract ideas above), then the claim is patent-eligible at *Step 2A(i)*. This determination concludes the eligibility analysis, except in situations identified in the Revised Guidance.<sup>8</sup>

However, if the claim recites a judicial exception (i.e., an abstract idea enumerated above, a law of nature, or a natural phenomenon), the claim requires further analysis for a practical application of the judicial exception in *Step 2A(ii)*.

*Step 2A(ii) – Practical Application*

If a claim recites a judicial exception in *Step 2A(i)*, we determine whether the recited judicial exception is integrated into a practical application of that exception in *Step 2A(ii)* 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.<sup>9</sup>

If the recited judicial exception is integrated into a practical application as determined under one or more of the cited MPEP sections,

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<sup>8</sup> In the rare circumstance in which an examiner believes a claim limitation that does not fall within the enumerated groupings of abstract ideas should nonetheless be treated as reciting an abstract idea, the procedure described in the Guidance for analyzing the claim should be followed. *See* Guidance, Section III.C.

<sup>9</sup> *See* MPEP § 2106.05(a)–(c), (e)–(h). Citations to the MPEP herein refer to revision [R-08.2017].

then the claim is not directed to the judicial exception, and the patent-eligibility inquiry ends. If not, then analysis proceeds to *Step 2B*.

*Step 2B – “Inventive Concept” or “Significantly More”*

Under the Revised Guidance, it is possible that a claim that does not “integrate” a recited judicial exception into a practical application under *Step 2A(ii)* is nonetheless patent eligible. For example, the claim may recite additional elements that render the claim patent eligible even though a judicial exception is recited in a separate claim element.<sup>10</sup> The Federal Circuit has held claims eligible at the second step of the *Alice/Mayo* test (USPTO *Step 2B*) because the additional elements recited in the claims provided “significantly more” than the recited judicial exception (e.g., because the additional elements were unconventional in combination).<sup>11</sup> Therefore, if a claim has been determined to be directed to a judicial exception under *Revised Step 2A*, we must evaluate the additional elements individually and in combination under *Step 2B* to determine whether they provide an inventive concept (i.e., whether the additional elements amount to significantly more than the exception itself).<sup>12</sup>

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<sup>10</sup> See, e.g., *Diehr*, 450 U.S. at 187.

<sup>11</sup> See, e.g., *Amdocs, Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1300, 1304 (Fed. Cir. 2016); *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349–52 (Fed. Cir. 2016); *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257–59 (Fed. Cir. 2014).

<sup>12</sup> 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).

Under the Revised Guidance, we must consider in *Step 2B* whether an additional element or combination of elements: (1) “Adds a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field, which is indicative that an inventive concept may be present;” or (2) “simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception, which is indicative that an inventive concept may not be present.” *See Revised Guidance, III.B.*<sup>13</sup>

The analysis in *Step 2B* further determines whether an additional element or combination of elements:

(a) Adds a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field, which is indicative that an inventive concept may be present; or

(b) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception, which is indicative that an inventive concept may not be present.

Revised Guidance; *see also Berkheimer Memo.*

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<sup>13</sup> In accordance with existing *Step 2B* guidance, an Examiner’s conclusion that an additional element (or combination of elements) is well understood, routine, conventional activity must be supported with a factual determination. For more information concerning evaluation of well-understood, routine, conventional activity, *see* MPEP § 2106.05(d), as modified by the USPTO *Berkheimer* Memorandum (USPTO Commissioner for Patents Memorandum dated Apr. 9, 2018, “Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*)” (hereinafter “*Berkheimer Memo*”).

If the Examiner or the Board determines under *Step 2B* that the element (or combination of elements) amounts to significantly more than the exception itself, the claim is eligible, thereby concluding the eligibility analysis.

However, if a determination is made that the element and combination of elements does not amount to significantly more than the exception itself, the claim is ineligible under *Step 2B*, and the claim should be rejected for lack of subject matter eligibility.

#### ANALYSIS

*Rejection of Claims 1, 3, 4, 6–9, 11, 13, 14, 16, and 21–29 under § 101*

*Did the Examiner Make a Prima Facie Case?*

Appellants contend the Examiner failed to establish a prima facie case of patent ineligibility because the Examiner failed to provide “any explanation as to why the claims are allegedly directed to nothing more than ‘method steps to collect and process electronic signature during a financial transaction,’ which the Examiner deems is similar to abstract ideas involving a fundamental economic practice, an ideal itself, or methods of organizing human activity.” App. Br. 15 (emphasis omitted).

We disagree. The Final Office Action adequately explains the § 101 rejection. *See* Final Act. 8–10. The Examiner applies the *Alice* analytical framework and apprise Appellants of the reasons for the § 101 rejection under that framework. Appellants have not responded by alleging a failure to understand the rejection. To the contrary, Appellants clearly identify the abstract idea identified by the Examiner. *See* App. Br. 15. Accordingly, we

are not persuaded that the Examiner has failed to set forth a prima facie case of patent ineligibility.

*Step 2A(i): Does the Claim Recite a Judicial Exception?*

The Examiner concluded that claim 1 is directed to “method steps to collect and process an electronic signature during a financial transaction, which is similar to the abstract idea examples of a fundamental economic practice,” an idea of itself, and certain methods of organizing human activity. Final Act. 9 (citing *buySAFE, Inc. v. Google, Inc.*, 765 F.3d. 1350 (Fed. Cir. 2014)).

The Specification provides context as to what the claimed invention is directed to. In this case, the Specification discloses that the invention discloses techniques for electronic signature processes. Abstract.

Claim 1 recites, in pertinent part, the steps of:

*associating a payment form with the electronic signature document, [the payment form associated with a payment processor separate from the ESS computing device, and] the payment form configured to obtain payment data from a user;*

*transmitting an initiation of an electronic signature request to a [client device associated with the] user, the electronic signature request including a presentation of the electronic signature document, the payment form, and an electronic signature field to the user for signature, the payment form including a payment amount determined based on an evaluation of an expression that includes at least one operator and a reference to a field included in the payment form, the payment amount of the payment form configured to be dynamically determined responsive to the [client device associated with the] user initiating the electronic signature request;*

*receiving a user signature for the electronic signature field from the client device associated with the user;*

*receiving payment data from the [client device associated with the] user via the payment form; and*

*transmitting at least a portion of the payment data and the received user signature of the electronic signature field to the payment processor associated with the payment form as authorization for the payment processor execute a payment authorization process based on the payment data received via the payment form.*

Claims App'x (brackets added).

This type of activity, i.e., associating forms, requesting an electronic signature, receiving an electronic signature and payment data, and transmitting payment data and the electronic signature to a payment processor, as recited in the limitations above, includes longstanding conduct that would ordinarily occur when collecting and processing an electronic signature and payment data during a financial transaction. *See* Final Act. 7. For example, associating forms and initiating an electronic signature request to a client are operations that generally occur before any payment is processed in a financial transaction, whether initiated person-to-person, on paper, or using a computer. Further, receiving an electronic signature and payment data from the client and sending that information to the payment processor would also occur before the financial transaction would typically conclude.

Thus, under *Step 2A(i)*, we agree with the Examiner that the method recited in claim 1 is a fundamental economic practice because the claims recite concepts relating to the economy and commerce, such as agreements between people in the form of contracts, legal obligations, and business relations. *See* Final Act. 9.

We conclude claim 1, as a whole, under our Revised Guidance, recites a judicial exception of certain methods of organizing human activity, i.e., a fundamental economic principle or practice, and thus an abstract idea. Independent claims 11 and 16 recite similar limitations, and we also conclude those claims are directed to a judicial exception of certain methods of organizing human activity, i.e., a fundamental economic principle or practice, and thus an abstract idea.

*Step 2A(ii): Judicial Exception Integrated into a Practical Application?*

If the claims are directed to a patent-ineligible concept, as we conclude above, we determine whether the recited judicial exception is integrated into a “practical application” (*Step 2A(ii)*) 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.

Appellants contend “the present claims provide a specific solution to a technology-centric (e.g., cloud-computing-centric or Internet-centric) problem rooted in computer technology” because they involve “coordinating electronic presentation of a document for application of an electronic signature and dynamically determining payment terms based on data within the electronic documents and responsive to computerized operations occurring remotely on a client device.” App. Br. 21–22.

We are not persuaded. None of the limitations integrates the fundamental economic practice of requesting and providing funds transfer into a practical application as determined under one or more of the MPEP sections cited above. The claim as a whole merely uses instructions to

implement the abstract idea on a computer or, alternatively, merely uses a computer as a tool to perform the abstract idea.

Thus, on this record, Appellants have not shown under the guidance of MPEP § 2106.05(a) (“Improvements to the Functioning of a Computer or to Any Other Technology or Technical Field”) or § 2106.05(e) (“Other Meaningful Limitations”) that the claims are directed to the practical application of the identified judicial exception. Nor do Appellants advance any arguments in the Brief(s) that are directed to the *Bilski* machine-or-transformation test, which would only be applicable to the method (process) claims on appeal. See MPEP § 2106.05(b) (Particular Machine) and § 2106.05(c) (Particular Transformation).

Therefore, we conclude the recited abstract idea is not integrated into a practical application, and thus the claim is directed to the judicial exception.

*Step 2B – “Inventive Concept”*

If the claims are directed to a patent-ineligible concept, as we conclude above, we proceed to the “inventive concept” step. In Step 2B, we consider whether an additional element (or combination of elements) adds a limitation that is not well-understood, routine, conventional (“WURC”) activity in the field or whether the additional elements simply append WURC activities previously known to the industry, specified at a high level of generality, to the judicial exception. Revised Guidance. The Examiner's finding that an additional element (or combination of elements) is WURC activity must be supported with a factual determination. Revised Guidance (citing MPEP § 2106.05(d), as modified by the *Berkheimer* Memorandum).

As evidence of the conventional nature of the recited “ESS computing device” in claim 1, the Specification describes “that one or more general purpose or special purpose computing systems/devices may be used to implement the ESS 110.” Spec. ¶ 40. The Specification also describes the “client device” recited in claim 1 as including “personal computers, laptop computers, smart phones, personal digital assistants, tablet computers, and the like.” Spec. ¶ 49. With regard to the “payment processor separate from the ESS computing device,” recited in claim 1, the Specification provides examples of a “payment processor,” such as “PayPal, a credit card network, a bank, debit card, electronic funds transfer, wire transfer, automated clearing house (ACH), or the like.” Spec. ¶ 10.

The Specification further describes the “computer-readable non-transitory medium” in claim 11 by way of examples: “a hard disk; a memory; a computer network or cellular wireless network or other data transmission medium; or a portable media article to be read by an appropriate drive or via an appropriate connection, such as a DVD or flash memory device).” Spec. ¶ 54. The Specification describes the “computing system” and “hardware processor” recited in system claim 16 in general terms, without providing particulars. *See* Spec. ¶¶ 41 (“computing system”), 54 (“hardware processor”).

Thus, because the Specification describes the additional elements in general terms, without describing the particulars, we conclude the claim limitations may be broadly but reasonably construed as reciting well-understood, routine, and conventional computer components and

techniques.<sup>14</sup> The Specification describes the elements in a manner that indicates the additional elements are sufficiently well-known that the specification does not need to describe the particulars in order to satisfy 35 U.S.C. § 112(a). *See Berkheimer* Memo § III.A.1.

Appellants argue that the recitations, when viewed as an ordered combination, amount to significantly more than the allegedly routine and generic functions listed by the Examiner, and provide a specific solution to a technology-centric (e.g., cloud-computing-centric or Internet-centric) problem rooted in computer technology. App. Br. 21. Appellants, however, have not persuaded us that the combination of additional elements amounts to a non-conventional and non-generic arrangement that provides a technical improvement in the art. App. Br. 21–22; *see BASCOM Glob. Internet Servs. Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350–51 (Fed. Cir. 2016) (holding that the combination of additional elements reciting generic computer network or Internet components, amounted to significantly more because the arrangement of the additional elements provided a technical improvement in the art). In particular, Appellants’ argument relies not only on additional elements, but also on limitations that are part of the recited abstract idea. *See* App. Br. 22.

Thus, with respect to the *Step 2B* analysis, we conclude, similar to *Alice*, the recitation of a method for collecting and processing an electronic signature and payment data during a financial transaction that includes the additional limitations discussed above is simply not enough to transform the

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<sup>14</sup> Claim terms are to be given their broadest reasonable interpretation, as understood by those of ordinary skill in the art and taking into account whatever enlightenment may be had from the Specification. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

patent-ineligible abstract idea here into a patent-eligible invention under *Step 2B*. See *Alice*, 573 U.S. at 221 (“[C]laims, which merely require generic computer implementation, fail to transform [an] abstract idea into a patent-eligible invention.”). We conclude the claims fail *Step 2B* because claim 1, in essence, recites various computer-based elements along with no more than mere instructions to implement the identified abstract idea using the computer-based elements.

Accordingly, because the claims are directed to an abstract idea, without significantly more, we sustain the Examiner’s § 101 rejection of independent claims 1, 11, and 16, and grouped claims 3, 4, 6–9, 13, 14, and 21–29, not argued separately, and which fall therewith. See App. Br. 14.

*Rejection of Claims 1, 3, 4, 6–9, 11, 13, 14, 16, and 21–29 under § 102(b)*

Appellants contend the Examiner erred in rejecting the claims as anticipated by Leong because Leong, fails to disclose the “associating,” “transmitting an initiation,” “receiving payment data,” and “transmitting at least a portion” steps recited in claim 1. Reply Br. 3.

With regard to the “transmitting an initiation” step, Appellants argue the Examiner first mapped “the electronic form detailing the negotiation of the trade terms” from Leong claim 1 to the recited “payment form” (Ans. 3, citing Leong 23:56–24:5, claim 1), and then improperly also mapped a “shopping cart that totals the items” to the recited “payment form” (Ans. 4, citing Leong 204:16–53). Reply Br. 4.

We agree with Appellants that the Examiner erred. The rigorous requirements of anticipation require a clear mapping of each claim limitation to the corresponding feature(s) found in the reference, which the Examiner

must identify with particularity. We agree with Appellants that the Examiner did not map the limitations recited in claim 1 with sufficient clarity. For example, regarding the “payment form” element, the Examiner first found Leong discloses “associating a payment form with the electronic signature document, the payment form associated with a payment processor separate from the ESS computing device, and the payment form configured to obtain payment data from a user.” Ans. 3 (citing Leong col. 23:56–col. 24:5, claim 1). The Examiner did not map the recited “payment form” to any particular disclosure in Leong. Then, in the following limitation, “transmitting an initiation of an electronic signature request . . .,” limitation of claim 1, the Examiner cited to column 21, lines 51–56, Figure 26, and claim 1 of Leong as disclosing the recited “transmitting an initiation of an electronic signature request to a client device associated with the user, the electronic signature request including a presentation of the electronic signature document, the payment form, and an electronic signature field to the user for signature.” Ans. 4. Again, the Examiner did not explicitly map the recited “payment form” to a particular disclosure in Leong. The Examiner also cited Leong’s disclosure of a shopping cart in eCommerce implementation (Leong col. 204:16-53) as disclosing “the payment form including a payment amount determined based on an evaluation of an expression that includes at least one operator and a reference to a field included in the payment form, the payment amount of the payment form configured to be dynamically determined responsive to the client device associated with the user initiating the electronic signature request.” Ans. 4.

Thus, on the record before us, we agree with Appellants that the Examiner has not identified with sufficient particularity which features of Leong disclose the “payment form” element in the disputed limitations.

For these reasons, on the record before us, we are persuaded that the Examiner erred in finding that Leong discloses all of the disputed limitations of claim 1.

Accordingly, we reverse the Examiner’s § 102(b) rejection of independent claim 1, as well as the Examiner’s § 102(b) rejection of independent claims 11 and 16, not argued separately. Reply Br. 7. We also reverse the Examiner’s rejection of dependent claims 3, 4, 6–9, 13, 14, and 21–29, which stand or fall with the independent claims from which those claims depend.

#### DECISION

We affirm the decision of the Examiner rejecting claims 1, 3, 4, 6–9, 11, 13, 14, 16, and 21–29 under 35 U.S.C. § 101.

We reverse the decision of the Examiner rejecting claims 1, 3, 4, 6–9, 11, 13, 14, 16, and 21–29 under 35 U.S.C. § 102(b).

Because we affirm at least one ground of rejection with respect to each claim on appeal, the Examiner’s decision rejecting claims 1, 3, 4, 6–9, 11, 13, 14, 16, and 21–29 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