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OBERLY, VAN HONG

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* HOWARD W. LUTNICK, COLIN SIMS, JESSE  
JORDAN, CHRISTOPHER BLOSSER, and SIDDHANT  
MOHALANOBISH

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Appeal 2017-010681  
Application 13/936,757<sup>1</sup>  
Technology Center 2100

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Before JAMES R. HUGHES, ERIC S. FRAHM, and  
MATTHEW J. McNEILL, *Administrative Patent Judges*.

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 14–35, which are all 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 CFPH, LLC. App. Br. 3.

<sup>2</sup> Claims 1–13 have been canceled.

*Appellants' Invention*

Appellants' application relates to generating a menu for a merchant. Spec. ¶ 106. For example, a user may select one or more items for inclusion in the menu (e.g., a small pizza), and may then select options to include for each item (e.g., pizza toppings). *See* Spec. ¶¶ 107–108. Claim 14, reproduced below, is illustrative of the claimed subject matter:

14. An apparatus comprising:

a computing device; and

a non-transitory machine readable medium having stored thereon a plurality of instructions that when executed by the computing device cause the apparatus to:

present a plurality of goods that may be selected for inclusion in a menu of deliverable goods for a first merchant;

receive a first selection of a subset of the plurality of goods from a first user;

present a plurality of pieces of information that may be selected to include in the menu as a modifier to a good in the subset of the plurality of goods;

receive a second selection of a subset of the plurality of pieces of information from a second user;

present an interface through which an edit may be made to at least one of a piece of information of the subset of the plurality of pieces of information and the good in the subset of the plurality of goods;

receive the edit to at least one of the piece of information from a third user;

receive a request for the menu of deliverable goods;

in response to receiving the request, present the menu of deliverable goods based on the good, the piece of information and the edit.

### *The Examiner's Rejections*

Claims 14–35 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.<sup>3</sup>

Claims 14–27, 29, and 31–35 stand rejected under 35 U.S.C. § 102(e) (pre-AIA) as being anticipated by Woycik (US 2007/0265935 A1; Nov. 15, 2007).

Claims 28 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Woycik and Bailey (US 2007/0038727 A1; Feb. 15, 2007).

## ANALYSIS

### *Patent-Ineligible Subject Matter*

The Examiner finds claims 14–35 are directed to the abstract idea of generating menus on a computer, similarly to the claims in *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229 (Fed. Cir. 2016). Ans. 2–9. The Examiner further finds the claims do not recite elements amounting to significantly more than the abstract idea. *Id.* Appellants contend the Examiner has not established a prima facie case that the claims are directed to an abstract idea and that the claimed limitations, taken individually and in combination, do

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<sup>3</sup> The § 101 rejection was entered as a new grounds of rejection in the Answer with Technology Center Director approval. Ans. 2–9, 13.

not amount to significantly more than the abstract idea. *See* Reply Br. 3–7. We are not persuaded by Appellants’ arguments.

Appellants specifically address independent claim 14, but do not separately argue the remaining claims with respect to the § 101 rejection. *See* Reply Br. 3–7. Therefore, we select claim 14 as representative in our analysis below. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355. Assuming that a claim nominally falls within one of the statutory categories of machine, manufacture, process, or composition of matter, the first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* For example, abstract ideas include, but are not limited to, fundamental economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Id.* at 2355–57. If the claim is directed to a judicial exception, such as an abstract idea, the second step is to determine whether additional elements in the claim “transform the nature of

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the claim’ into a patent-eligible application.” *Id.* at 2355 (quoting *Mayo*, 132 S. Ct. at 1297). This second step is described as “a search for an “inventive concept”—*i.e.*, an element or combination of elements that is ‘significantly more than . . . the [ineligible concept] itself.” *Id.* at 2355 (alteration in original) (quoting *Mayo*, 132 S. Ct. at 1294).

### A Prima Facie Case of Patent-Ineligibility

At the outset, we note Appellants contend the Examiner failed to carry the burden of establishing a prima facie case with respect to finding the claims patent-ineligible. Reply Br. 3, 5. We disagree with Appellants.

The Federal Circuit has repeatedly explained that “the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). As outlined in *Jung*:

PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies 35 U.S.C. § 132, in “notify[ing] the applicant . . . [by] stating the reasons for [its] rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.”

*In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (quoting 35 U.S.C. § 132). The PTO violates § 132 “when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990). But if the PTO “adequately explain[s] the shortcomings it perceives . . . . [T]he burden shifts to the applicant to rebut the prima facie case with evidence and/or argument.” *Hyatt*, 492 F.3d at 1370.

The Examiner’s rejection under § 101 satisfies § 132 because it reflects the *Alice* analytical framework by identifying an abstract idea and finding the claims do not amount to significantly more than the abstract idea itself (*see* Ans. 2–9), thus apprising Appellants of the reasons for the § 101 rejection under that framework. As discussed in more detail below, Appellants recognize the Examiner’s *Alice* analysis and present arguments regarding each step. *See* Reply Br. 3–7. Appellants do not respond by alleging a failure to understand the rejection. *See id.*

#### *Alice* Step One

“The first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016). “The abstract idea exception prevents patenting a result where ‘it matters not by what process or machinery the result is accomplished.’” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 113 (1853)). “We therefore look to whether the claims . . . focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *McRO*, 837 F.3d at 1314 (citing *Enfish*, 822 F.3d at 1336).

Claim 14 recites a number of functions for presenting and editing a menu. However, claim 14 is not focused on any “improvement in computer capabilities” or “a specific means or method that improves the relevant technology.” Rather, the fact that claim 14 recites performing the claimed

functions on “a computing device” whereby a user is presented with “an interface” merely shows the use of a computer as a tool, and does not show a specific technological improvement. Aside from the use of a generic computing device, the functions of claim 14, for example, “present a plurality of goods that may be selected for inclusion in a menu” and “receive a first selection of a subset of the plurality of goods,” could be performed by people designing a menu with pencil and paper. Accordingly, we find claim 14, as a whole, is directed to an abstract idea, which the Examiner fairly characterizes as generating menus on a computer. Ans. 2.

We are not persuaded by Appellants’ argument that “the claims are clearly not simply generating menus on a computer” and that “[t]he Examiner reduces the claims to a gist that ignores most of the limitations.” Reply Br. 4. All of the claimed functions in claim 14 relate to presenting or receiving information in the service of generating or presenting a menu. Moreover, in summarizing the claimed subject matter, Appellants point to paragraphs 106–122 of the Specification (App. Br. 3–4), which describe “templates [that] may be used to generate a menu for a merchant.” Spec. ¶ 106. Accordingly, although claim 14 recites a multitude of functions, the overall claimed functionality is directed to the idea of generating menus on a computer. As further detailed below, the Federal Circuit has found claims relating to similar ideas to be abstract.

Instead of using a fixed definition of an abstract idea and analyzing how claims fit (or do not fit) within the definition, “the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen — what prior cases were about, and which way they were decided.” *Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (citing *Elec. Power Grp., LLC v.*

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*Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016)). In this case, the Examiner has cited *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229 (Fed. Cir. 2016) as an analogous case (Ans. 2). In *Apple*, the Federal Circuit noted that although the claimed invention could be described at varying levels of abstraction, including, “generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location,” the claims were directed to an abstract idea. 842 F.3d at 1240. Specifically, the court found:

They do not claim a particular way of programming or designing the software to create menus that have these features, but instead merely claim the resulting systems. Essentially, the claims are directed to certain functionality—here, the ability to generate menus with certain features. Alternatively, the claims are not directed to a specific improvement in the way computers operate.

842 F.3d at 1241. We find the same reasoning applies with respect to claim 14. That is, claim 14 recites certain menu generating functionality without reciting any particular programming of a computer that defines how the computer achieves the claimed functionality.

As noted above, generating menus on a computer, as recited in claim 14, involves no more than presenting and receiving information to and from users. Accordingly, we find claim 14 is also analogous to other cases where the Federal Circuit has found claims involving no more than data collection, manipulation, and/or display to be directed to abstract ideas. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (“gathering and analyzing information of a specified content, then displaying the results”), *OIP Technologies, Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (offer-based price optimization), *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir.

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2015) (tailoring information presented to a user based on particular information), *Versata Development Group, Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1333 (Fed. Cir. 2015) (“determining a price, using organizational and product group hierarchies”), *Digitech Image Technologies, LLC v. Electronics for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014) (employing “mathematical algorithms to manipulate existing information to generate additional information”), and *Accenture Global Services, GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–46 (Fed. Cir. 2013) (generating tasks based on rules in response to events).

#### *Alice* Step Two

The second step in the *Alice* analysis requires a search for an “inventive concept” that “must be significantly more than the abstract idea itself, and cannot simply be an instruction to implement or apply the abstract idea on a computer.” *Bascom Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349 (Fed. Cir. 2016). There must be more than “computer functions [that] are ‘well-understood, routine, conventional activit[ies]’ previously known to the industry.” *Alice*, 134 S. Ct. at 2359 (second alteration in original) (quoting *Mayo*, 132 S. Ct. at 1294).

Here, we find claim 14 does no more than apply an abstract idea on a generic computing device. Claim 14 recites functionality for presenting and receiving information to and from users but does not define any particular software or hardware for achieving this functionality other than a conventional “computing device” and “interface.” We note that under the second step of *Alice* we must consider not only individual limitations, but also the ordered combination of limitations, in assessing whether a claim provides significantly more than an abstract idea. *Bascom*, 827 F.3d at

1349. However, in contrast to *Bascom*, where the court found an inventive concept “in the non-conventional and non-generic arrangement of known, conventional pieces” (*id.* at 1350), the limitations of claim 14 simply define a piece-by-piece functionality for editing and presenting a menu that amounts to no more than the sum of its parts. That is, whereas in *Bascom* the claimed invention defined a new way of filtering content on the Internet (*see id.*), claim 14 in the present case does not define a new way of generating a menu. Rather, claim 14 simply implements a conventional way for people to collaboratively generate a menu on a generic computing device.

We are not persuaded by Appellants’ argument that “the ability of implementation to occur using conventional or generic computer components is not determinative of whether a claim adds significantly more to an abstract idea.” Reply Br. 6. We agree that the mere use of conventional or generic computer components does not disqualify a claim from being patent eligible. *Bascom*, 827 F.3d at 1350 (“The inventive concept inquiry requires more than recognizing that each claim element, by itself, was known in the art.”). However, as noted above, even considering the ordered combination of limitations in claim 14, we find claim 14 does not provide significantly more than the abstract idea of generating menus on a computer.

We are also not persuaded by Appellants’ argument that the Federal Circuit’s decision in *Trading Technologies International, Inc. v. CQG, Inc.*, 675 F. App’x 1001 (Fed. Cir. 2017) (non-precedential), requires a finding of patent eligibility in this case. *See* Reply Br. 6. In *Trading Technologies*, the Federal Circuit accepted the lower court findings, with respect to step two of *Alice*, that the claims provided “an inventive concept that allows traders to

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more efficiently and accurately place trades using this electronic trading system.” 675 F. App’x at 1004. In further discussing the lower court’s opinion, the Federal Circuit noted “[t]he court distinguished this system from the routine or conventional use of computers or the Internet, and concluded that the specific structure and concordant functionality of the graphical user interface are removed from abstract ideas, as compared to conventional computer implementations of known procedures.” *Id.*

Accordingly, the distinguishing feature under *Alice* step two for the claims in *Trading Technologies* was an advance in efficiency as compared to other computer processes. However, simply using a computer to gain efficiency over a manual process is not sufficient to distinguish a claim from a patent-ineligible abstract idea. *See OIP Technologies*, 788 F.3d at 1363 (“[R]elying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.”). As mentioned above, claim 14 is directed to functionality that, aside from the use of a generic computing device, can be performed by people. Claim 14 does not recite any “specific structure and concordant functionality of the graphical user interface [that] are removed from abstract ideas.” *Trading Techs.*, 675 F. App’x at 1004.

For at least the reasons above, we are not persuaded of Examiner error in the rejection of independent claim 14 as being directed to patent-ineligible subject matter under § 101. We thus sustain the § 101 rejection of claim 14, and also independent claim 35 and dependent claims 15–34 not specifically argued separately.

*Anticipation*

Appellants contend Woycik fails to disclose the following claim 14 limitations<sup>4</sup>:

present a plurality of goods that may be selected for inclusion in a menu of deliverable goods for a first merchant; receive a first selection of a subset of the plurality of goods from a first user; present a plurality of pieces of information that may be selected to include in the menu as a modifier to a good in the subset of the plurality of goods; receive a second selection of a subset of the plurality of pieces of information from a second user.

We are not persuaded by Appellants' arguments.

Woycik describes a computer-based system for ordering goods and services that includes an administrative tool application with a menu editor.

Woycik, Abstract. Woycik describes the menu editor functionality as follows:

Selecting "Menu Editor" 220 launches the menu editor shown in the screen 250 depicted in FIG. 11. The menu editor enables the administrator to create and edit the screens or menus that customers see. The main menu in the menu editor lists all menus and submenus 254 created for the client interface.

Woycik, ¶ 98. As an example of editing menus and submenus using the menu editor, Woycik provides the following:

For example, the top menu in the self-order application may ask the customer to select a food category such as sandwiches, drinks, or sides. *When selected, the sandwiches button activates a menu containing a number of sandwiches from which to choose. . . . Each button on the sandwich menu then activates a corresponding menu to allow the customer to choose or modify ingredients for the particular sandwich chosen. When*

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<sup>4</sup> Appellants cite claim 1 for these limitations (App. Br. 6, 9); however, claim 1 has been canceled and the recited limitations can be found in claim 14.

the administrator has finished configuring the button attributes and which menu to activate on the button, the administrator is brought back to the edit screen 420 of FIG. 20. *Individual buttons can also be enabled or disabled on this screen (button 424). This allows, for example, a button for a food item or option to be setup and then temporarily disabled in the event that the item or option becomes unavailable.* When the administrator has completed editing the buttons for a particular menu, the process returns (OK button 434) to the menu editor (FIG. 11). After creating and editing all necessary menus, the administrator selects the Main Menu button 252 on the menu editor screen 250 and is returned to the main menu 212 shown in FIG. 10.

Woycik, ¶ 110. Here, Woycik describes an administrator creating a menu listing a number of sandwiches, where each sandwich item is associated with a submenu listing a number of ingredients for the sandwich. *See id.* Further, as quoted above, Woycik describes editing this arrangement of menu and submenus such that, for each menu, an administrator can disable one or more items listed. *See id.*

We find that one of ordinary skill in the art would have understood that Woycik discloses the claim 14 limitations “present a plurality of goods that may be selected for inclusion in a menu of deliverable goods for a first merchant; receive a first selection of a subset of the plurality of goods from a first user” by describing an administrator editing a list of food items whereby one or more items can be disabled. *See id.* In other words, by disabling certain items in a list of items, the administrator is selecting “a subset of the plurality of goods,” where the “goods . . . may be selected for inclusion in a menu of deliverable goods,” as recited in claim 14. We also find the same description in Woycik discloses the claim 14 limitations “present a plurality of pieces of information that may be selected to include in the menu as a modifier to a good in the subset of the plurality of goods;

receive a second selection of a subset of the plurality of pieces of information from a second user.” That is, Woycik describes “editing all necessary menus,” where the menus include not only a sandwich menu, but also submenus for the ingredient options for each sandwich. *Id.* Accordingly, by allowing an administrator to disable options in an ingredient submenu for a sandwich, Woycik discloses selecting “a subset of the plurality of pieces of information,” where the “pieces of information . . . may be selected to include in the menu as a modifier to a good,” as recited in claim 14.

We are, therefore, not persuaded of error in the Examiner’s anticipation rejection of claim 14, and claims 15–27, 29, and 31–35 not specifically argued separately.

#### *Obviousness*

Appellants present no specific arguments regarding the obviousness rejection of claims 28 and 30. Rather, Appellants rely on the same arguments discussed above regarding claim 14. *See* App. Br. 12. Thus, for the same reasons already discussed, we sustain the Examiner’s obviousness rejection of claims 28 and 30.

#### CONCLUSIONS

Under 35 U.S.C. § 101, the Examiner did not err in rejecting claims 14–35.

Under 35 U.S.C. § 102(e) (pre-AIA), the Examiner did not err in rejecting claims 14–27, 29, and 31–35.

Under 35 U.S.C. § 103(a), the Examiner did not err in rejecting claims 28 and 30.

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DECISION

We affirm the Examiner's decision to reject claims 14–35.

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. § 41.50(f).

AFFIRMED