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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MAXIMILIAN NICHOLAS BROODRYK

Appeal 2017-010982
Application 12/340,197¹
Technology Center 3600

Before MAHSHID D. SAADAT, JASON J. CHUNG, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 20, 22, and 25–37.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

INVENTION

The invention is directed to selling multiple insurance products. Spec.

¶ 2. Claim 20 is illustrative of the invention and is reproduced below:

20. A computer implemented method of selling an insurance product, the method comprising the steps of:

¹ According to Appellant, American International Group, Inc. is the real party in interest. Br. 1.

² Claims 1–19, 21, 23, and 24 are canceled. Br. 17–18.

using a web server to execute a computer software framework residing on a nontransitory computer readable medium, the web server arranged with a database of data pertaining to at least a first and a second insurance product;

receiving a first request comprising data pertaining to the first insurance product from a graphical user interface having a number of data fields displayed on a web page by the web server;

using the web server to process the first request. to determine data related to the first insurance product;

displaying a response comprising the data related to the first insurance product in a set of presentation data fields of the graphical user interface arranged in a presentation format;

receiving a second request comprising data pertaining to the second insurance product from the graphical user interface;

using the web server to process the second request to determine data related to the second insurance product; and

displaying a response comprising the data related to the second insurance product in the presentation data fields of the graphical user interface using the same presentation format;

displaying by the web server a quotation for at least one of the first and second insurance products, wherein the quotation is pre-underwritten subject to a set of eligibility criteria related to said associated insurance product;

displaying by the web server the set of eligibility criteria for at least one of the first and second insurance products;

only after receiving a confirmation from the user by the web server that the user meets the set of eligibility criterion for at least one of the first and second insurance products, allowing the user to pay the quotation to bind coverage for each confirmed insurance product.

App. Br. 17–18 (Claims Appendix).

REJECTIONS AT ISSUE

Claims 20, 22, and 25–37 stand rejected under 35 U.S.C. § 101 as being directed to patent ineligible subject matter. Final Act. 2–4.

Claims 20, 22, and 25–37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Solanki (US 7,860,734 B2; filed Oct. 2, 2003).
Final Act 4–12.

ANALYSIS

1. *Rejection Under 35 U.S.C. § 101*

a. *The Examiner’s Conclusions and Appellant’s Arguments*

The Examiner concludes that the present claims are directed to an abstract idea of a fundamental economic activity and a method of organizing human activity (i.e., the Examiner concludes this is a mental process). Final Act. 2.

In addition, the Examiner finds the present claims are not significantly more than any abstract idea because they implement instructions using generic components that are well-understood, routine, and conventional to the abstract idea. Final Act. 2–3.

Appellant argues the present claims are significantly more than any abstract idea because they satisfy the machine-or-transformation test. Br. 6, 9. And Appellant argues the present claims are significantly more than any abstract idea because the present claims recite a solution rooted in computer technology that satisfies persistent needs specifically arising in the field of insurance; in particular, by providing efficiency improving features that allow the provider to issue quotes for more than one insurance product through the same graphical user interface. *Id.* at 7–8, 10–11. We disagree with Appellant.

b. *Legal Principles*

Section 101 of the Patent Act provides “[w]hoever invents or discovers any new and useful process, machine, manufacture, or

composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. The Supreme Court has long held that this provision contains an implicit exception: “[l]aws 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, 589–90 (2013)). The Court has set forth a two-part inquiry to determine whether this exception applies.

First, we must “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Alice*, 134 S. Ct. at 2355. Second, if the claims are directed to one of those patent-ineligible concepts, we consider “the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 77–78 (2012)). Put differently, we must search the claims for an “inventive concept,” that is, “an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 134 S. Ct. at 2355 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

c. Discussion

i. Alice Step 1

On this record, we discern no error in the Examiner’s analysis and conclusion that the present claims are directed to an abstract idea of a fundamental economic activity and a method of organizing human activity

(i.e., a mental process). Final Act. 2. Moreover, we conclude the present claims are similar to the abstract idea of determining a price using organizational and product group hierarchies in *Versata Software, Inc., v. SAP America, Inc.*, 717 F.3d 1255 (Fed. Cir. 2013).

Appellant does not make any arguments pertaining to *Alice* step 1. Because the present claims are directed to an abstract idea, we proceed to step (2) of the *Alice*, two-part test.

ii. Alice Step 2

On this record, we discern no error in the Examiner's analysis and finding that present claims are not significantly more than any abstract idea because they implement generic components that are well-understood, routine, and conventional to the abstract idea. Final Act. 2–3. In particular, paragraphs 26, 34, 55, and 76 discuss the generic nature of the software and hardware components used to implement the abstract idea. Spec. ¶¶ 26, 34, 55, 76.

We, therefore, disagree with Appellant's argument that the present claims satisfy the machine-or-transformation test (Br. 6, 9) because the present claims recite an abstract idea similar to *Versata* that implements generic components as acknowledged in Appellant's Specification.

We also disagree with Appellant's argument that the present claims recite a solution rooted in computer technology that satisfies persistent needs specifically arising in the field of insurance; that is, by providing efficiency improving features that allow the provider to issue quotes for more than one insurance product through the same graphical user interface (*id.* at 7–8, 10–11). We disagree because we conclude the present claims are directed to a

solution to an abstract idea discussed *supra* that implements the abstract idea using generic components.

Moreover, we note that accelerating a mental process with a processor does not make claims patent eligible. *Bancorp Servs., LLC v. Sun Life Assurance Co.*, 687 F.3d 1266, 1279 (Fed. Cir. 2012) (“Using a computer to accelerate an ineligible mental process does not make that process patent-eligible.”).

Appellant does not argue separately claims 22, 25–27, and 29–37 with particularity, but asserts the rejections of those claims should be withdrawn for at least the same reasons as the rejection for claim 20 should be withdrawn. Br. 9, 11. Accordingly, we sustain the Examiner’s rejection of independent claims 20, 22, and 25–37 under 35 U.S.C. § 101.

2. *Rejection Under 35 U.S.C. § 103*

The Examiner finds Solanki teaches approving a user’s contract quotes prior to acceptance and execution of the contract, which the Examiner maps to the limitation

only after receiving a confirmation from the user by the web server that the user meets the set of eligibility criterion for at least one of the first and second insurance products, allowing the user to pay the quotation to bind coverage for each confirmed insurance product

as recited in claim 20 (and similarly recited in claim 28). Ans. 4 (citing Solanki, 2:65–3:8). Additionally, the Examiner finds a person having ordinary skill in the art at the time of the invention would have modified Solanki’s first request so that it could be repeated for a second request. Final Act. 6.

Appellant argues the Solanki fails to teach the user is allowed to pay for at least one of the first and second insurance products to bind coverage only after confirming that the user meets the associated eligibility requirements. Br. 13. In addition, Appellant argues a person having ordinary skill in the art at the time of the invention would not have been motivated to arrive at the method recited in claim 20. *Id.* at 13–14.

The cited portions of Solanki teach approving a user’s contract quotes prior to acceptance and execution of the contract, which teaches the limitation

only after receiving a confirmation from the user by the web server that the user meets the set of eligibility criterion for at least one of the first and second insurance products, allowing the user to pay the quotation to bind coverage for each confirmed insurance product

recited in claim 20 (and similarly recited in claim 28). Ans. 4 (citing Solanki, 2:65–3:8). Furthermore, we agree with the Examiner’s finding that a person having ordinary skill in the art at the time of the invention would have modified Solanki’s first request so that it could be repeated for a second request. Final Act. 6. The Examiner provides this new finding (citing Solanki, 2:65–3:8) in the Answer and Appellant does not rebut it because Appellant did not file a Reply Brief. *Compare* Final Act. 5–7, 12–13 (no citation to Solanki, 2:65–3:8) *with* Ans. 4 (citing Solanki, 2:65–3:8). And Appellant does not argue the specifics of why a person having ordinary skill in the art at the time of the invention would not have been motivated to arrive at the method recited in claim 20.

Moreover, in order to rebut a *prima facie* case of unpatentability, Appellant must distinctly and specifically point out the supposed Examiner

errors, and the specific distinctions believed to render the claims patentable over the applied references. *See* 37 C.F.R. § 41.37(c)(vii) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”); *see also In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”); *cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art.”).

In this case, Appellant does not articulate sufficiently a specific argument addressing any portions of Solanki. Instead, Appellant argues Solanki fails to teach or suggest a limitation without giving specifics as to what the cited portions of Solanki teach and why the cited portions of Solanki fail to teach the limitation. Also, Appellant provides conclusory allegations that a person having ordinary skill in the art at the time of the invention would not have been motivated to arrive at the method recited in claim 20 (App. Br. 13–14) rather than providing specific arguments. Therefore, we are not persuaded of Examiner error in rejecting claim 20 as obvious over Solanki.

Appellant does not argue separately claims 22, and 25–37 with particularity, but asserts the rejections of those claims should be withdrawn for at least the same reasons as the rejection for claim 20 should be withdrawn. Br. 14–15. Accordingly, we sustain the Examiner’s rejection of independent claims 20, 22, and 25–37 under 35 U.S.C. § 103.

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We have only considered those arguments that Appellant actually raised in the Briefs. Arguments Appellant could have made, but chose not to make, in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

We affirm the Examiner's decision rejecting claims 20, 22, and 25–37 under 35 U.S.C. § 101.

We affirm the Examiner's decision rejecting claims 20, 22, and 25–37 under 35 U.S.C. § 103(a).

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

AFFIRMED