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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* JOHN ROBERT SHAPIRO, JOE MICHAEL ANDOLINA,  
and JAKUB MATEUSZ BURKOT

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Appeal 2017-011492  
Application 13/618,457<sup>1</sup>  
Technology Center 2400

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Before ROBERT E. NAPPI, DAVID M. KOHUT, and LYNNE E. PETTIGREW,  
*Administrative Patent Judges.*

NAPPI, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–21 and 23.<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 Adobe Systems Incorporated. App. Br. 2.

<sup>2</sup> Claim 22 was previously cancelled.

## INVENTION

Appellants' invention relates to a computer-implemented system and method for modifying electronic content shared between multiple clients. Spec. ¶ 15; Abstract.

## CLAIMED SUBJECT MATTER

Claims 1, 11, and 16 are independent. Independent claims 11 and 16 recite limitations similar to claim 1. App. Br. 20, 23, Claims App'x. Appellants argue claims 1–21 and 23 as a group. App. Br. 5–16. We select claim 1 as representative, and claims 2–21 and 23 stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv). Claim 1 is reproduced below.

1. A method of restricting modifications to electronic content accessed by multiple clients, the method comprising:
  - accessing, by a processor, electronic content;
  - providing, to each of multiple clients and via a data network, a graphical user interface capable of displaying a portion of the electronic content and receiving, from a respective client, an input indicating a modification to the electronic content; and
  - controlling, by the processor, a plurality of modifications to the electronic content via a data network, wherein controlling the modifications to the electronic content comprises:
    - providing, by the processor and via the data network, a first interface and a displayed first portion of the electronic content to a first client;
    - limiting access, in the first interface, to the displayed first portion of the electronic content to the first client for a first time period;
    - during the first time period, restricting, by the processor, a first modification of the first portion of the electronic content by the first client, wherein restricting the first

modification comprises modifying, by the processor and via the data network, the first interface to enable access to only a first subset of the plurality of modifications by the first client;

responsive to the first client providing an input indicating one of the first subset of modifications during the first time period:

providing, by the processor and via the data network, a second interface and a displayed second portion of the electronic content to a second client,

limiting, in the second interface, access by the second client to the displayed second portion of the electronic content for a second time period, and

during the second time period, restricting, by the processor, a second modification to the second portion of the electronic content by the second client, wherein restricting the second modification comprises modifying, by the processor and via the data network, the second interface to enable access to only a second subset of the plurality of modifications by the second client, wherein restrictions to the second subset of modifications are dependent upon the restrictions to the first subset of modifications.

#### REJECTION AT ISSUE

The Examiner rejected claims 1–21 and 23 under 35 U.S.C. § 101 as patent-ineligible subject matter.<sup>3</sup>

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<sup>3</sup> Throughout this Decision we refer to the Appeal Brief filed March 31, 2017; Reply Brief filed September 13, 2017; Final Rejection dated November 2, 2016; and the Examiner’s Answer dated July 14, 2017.

## ISSUE

Appellants argue, on pages 5–16 of the Appeal Brief and pages 2–7 of the Reply Brief, the Examiner’s rejection of claims 1–21 and 23 is in error. These arguments present us with the following dispositive issue:

Did the Examiner err in rejecting claim 1 as being directed to patent-ineligible subject matter, specifically, (1) did the Examiner err in determining that claim 1 is directed to an abstract idea, and (2) did the Examiner err in determining that claim 1 does not recite additional limitations amounting to significantly more than the claimed abstract idea?

## ANALYSIS

We have reviewed Appellants’ arguments in the Appeal Brief and the Reply Brief, the Examiner’s rejections, and the Examiner’s response to Appellants’ arguments. Appellants’ arguments have not persuaded us of error in the Examiner’s rejections of claims 1–21 and 23.

The Examiner performs a two-step analysis to determine patent eligibility as set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 32 S. Ct. 1289, 1296–97 (2012), and reiterated in *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347, 2355 (2014). In the first step, the Examiner determines if the claims are directed to a patent ineligible concept, such as an abstract idea. *Alice*, 134 S. Ct. at 2355. If the claims are directed to an abstract idea, then the Examiner proceeds to the second step. In the second step, the Examiner considers whether the claims, individually and as an ordered combination, recite an inventive concept—an element or combination of elements sufficient to ensure the claims amount to “significantly more” than the abstract

idea and transform the nature of the claims into a patent-eligible concept. *Id.* We address each step in turn.

### Step 1

The Examiner determines that claim 1 is directed to the abstract idea of a game with rules, i.e., a method of organizing human activity. Final Act. 2, 4; Ans. 6–11. The Examiner determines the game can be performed without a computer by providing users with a drawing implement and paper. Final Act. 4; Ans. 5. Further, the Examiner determines the act of providing access to a certain portion of the content is comparable to folding the paper so the current user cannot see the previous user’s input. Final Act. 4; Ans. 7–8. The Examiner determines limiting access to the content for a certain time period is comparable to setting a time limit for each user to expedite gameplay. Ans. 9–10. Thus, the Examiner determines each limitation in claim 1 is drawn to a game with a set of rules. The Examiner further determines that the claim scope is similar to the concepts identified as abstract ideas in *In re Smith*, 815 F.3d 816 (Fed. Cir. 2016), and *Planet Bingo, LLC v. VKGS LLC*, 576 F. App’x 1005 (Fed. Cir. 2014). Final Act. 4–5; Ans. 2–3, 6, 11–13 (quoting *In re Smith*, in which the court concluded “that the rejected claims, describing a set of rules for a game, are drawn to an abstract idea”). The Examiner points out that *Planet Bingo* is favorably cited in *In re Smith*. Ans. 13. In *Planet Bingo*, methods of managing a game of bingo, where computers facilitate human gameplay, were determined to be abstract ideas. *Planet Bingo*, 576 F. App’x at 1007–08. Like the claims in *Planet Bingo*, the Examiner determines that claim 1 relates “to utilizing computers to facilitate human gameplay.” Ans. 13.

Appellants argue the Examiner failed to establish a prima facie case of patent-ineligibility, because the Examiner did not identify a factually similar precedential court decision. App. Br. 6–9. Appellants argue that *Smith* is not

factually similar because the claims at issue in *Smith* were directed to financial obligations where the claims at issue in this application are directed towards controlling access to collaboratively edited electronic content. App. Br. 8; Reply Br. 2–3. Further, Appellants argue that *Planet Bingo* is not precedential nor factually similar, aside from the data retrieval feature. App. Br. 9; Reply Br. 3–4.

We do not agree that the Examiner failed to establish claim 1 is directed to an abstract idea because there is insufficient similarity between the facts here and those of *In re Smith* and *Planet Bingo*. The claims in *In re Smith* were drawn to a method of conducting a game, involving financial obligations, with a set of rules. *In re Smith*, 815 F.3d at 817–818. The court in *In re Smith*, concluding that the claims were directed to an abstract idea involving a fundamental economic practice, relied on *Planet Bingo* as persuasive authority. *In re Smith*, 815 F.3d at 816 (citing *Planet Bingo*, 576 F. App'x at 1007–1008). *Planet Bingo* did not involve a financial obligation; rather, the court in *Planet Bingo* determined that managing a game via a computer was a method of organizing human activity and an abstract idea. *Planet Bingo*, 576 F. App'x at 1008.

Like the claims in both *In re Smith* and *Planet Bingo*, claim 1 is directed to the concept of a game with rules. Furthermore, like the claims in *Planet Bingo*, claim 1 is directed to managing the game using a computer. As such, we determine claim 1 is directed to managing a game with a set of rules, which is a method of organizing human activity. Accordingly, we agree with the Examiner's determination that claim 1 is directed to an abstract idea. Final Act. 4.

Step 2

Under the second step of the *Alice* framework, the Examiner determines claim 1 does not recite additional limitations amounting to significantly more than the claimed abstract idea to transform the nature of the claim into a patent-eligible concept, because the additional limitations merely implement the abstract idea using a computer network in conjunction with common user interface techniques. Final Act. 5. Specifically, the Examiner determines that the claimed invention uses technology to implement the game and does not improve the operation or efficiency of a computer or groups of computers nor does it implement a solution to a problem in the software arts. Ans. 15–16. The Examiner further determines that the claim elements, individually and in an ordered combination, are well known and conventional in the art and provide no technological improvement. Ans. 18–19; *see* Final Act 8.

Appellants argue claim 1 amounts to significantly more than an abstract idea in a technological environment because it improves the technical field of electronic communications by “controlling modifications to [] electronic content [over] a data network.” App. Br. 12–15. Appellants additionally argue that the non-obviousness of the claims establishes that the claims have limitations that amount to significantly more than the abstract idea. App. Br. 13–14; Reply Br. 6–7. Further, Appellants argue the Examiner did not address the claim elements as an ordered combination and has thus failed to articulate a rationale as to why the claims lack significantly more. App. Br. 15–16.

Appellants’ arguments are not persuasive. We fail to see any requirements in claim 1 for controlling modifications to electronic content over a data network by use of anything but well known and conventional computers and network interfaces. “[T]he use of generic computer elements like a microprocessor or user

interface do not alone transform an otherwise abstract idea into patent eligible subject matter.” *FairWarning IP v. Iatric Sys. Inc.*, 839 F.3d 1089, 1096 (Fed. Cir. 2016) (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014)). Further, an accompanying art rejection is not a requirement for a patent ineligible subject matter rejection. The *Alice* framework does not ask whether an additional feature is novel, but rather asks whether the implementation of the abstract idea involves “more than [the] performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347–48 (Fed. Cir. 2014) (quoting *Alice*, 134 S. Ct. at 2359). The Examiner addressed the claim elements individually and in an ordered combination in both the Final Rejection and the Examiner’s Answer, concluding that the interface, network, and processor claim elements, and actions performed therefrom, are well known and conventional in the art and provide no technological improvement separate from implementing the abstract idea. Ans. 18–19; see Final Act 3–4, 7–8. We agree. Accordingly, when the limitations of claim 1 are considered, individually and as an ordered combination, they amount to nothing more than an attempt to patent the abstract idea embodied in the steps of the claim. See Final Act. 5; Ans. 18–19. The additional limitations of claim 1 fail to transform the nature of the claim into patent eligible subject matter.

For the above reasons, Appellants have not apprised us of error in the Examiner’s determination that claim 1 is directed to patent-ineligible subject matter. Claims 2–21 and 23 stand or fall with claim 1. See 37 C.F.R. § 41.37(c)(1)(iv). Accordingly, we are not persuaded of error and sustain the Examiner’s rejection of claims 1–21 and 23.

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DECISION

The Examiner's rejection of claims 1–21 and 23 is affirmed.

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