



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/911,418	06/06/2013	Jeffrey G. Cox JR.	133412.00009	5794
54975	7590	10/01/2019	EXAMINER	
HOLLAND & KNIGHT LLP 10 ST. JAMES AVENUE BOSTON, MA 02116-3889			LEE, JENNIFER V	
			ART UNIT	PAPER NUMBER
			3625	
			NOTIFICATION DATE	DELIVERY MODE
			10/01/2019	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocketing@hklaw.com
toni.sousa@hklaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEFFREY G. COX, JR.¹

Appeal 2017-011655
Application 13/911,418
Technology Center 3600

Before HUNG H. BUI, JON M. JURGOVAN, and
MICHAEL M. BARRY, *Administrative Patent Judges*.

JURGOVAN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant seeks review under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–25. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.²

¹ We use the word “Appellant” to refer to “applicant(s)” as defined in 37 C.F.R. § 1.42. According to Appellant, the real party in interest is VERITREAD, LLC. App. Br. 3.

² Our Decision refers to the Specification (“Spec.”) filed June 6, 2013, the Final Office Action (“Final Act.”) mailed March 1, 2016, the Appeal Brief (“App. Br.”) filed January 17, 2017, and the Examiner’s Answer (“Ans.”) mailed June 22, 2017.

CLAIMED SUBJECT MATTER

The claims relate to using a computer to define a shipping inquiry for shipping heavy equipment from a starting location to a destination location. Spec. Abstract. The claims obtain logistics criterion such as equipment characteristics (e.g., weight and dimensions) from a database, determine whether the characteristic is beyond a threshold, and assign weights to the characteristic based on this determination for use in generating the shipping cost estimate. *Id.* ¶ 46. The claims identify logistics criterion to the user, including a permit and vehicle needed to transport the heavy equipment. *Id.* The user selects options to submit the shipping inquiry to a single preferred provider for the shipping services, or a group of service providers for competitive bidding. *Id.* ¶ 4.

Claim 1, reproduced below, is representative of the claimed invention:

1. A computer-implemented method for submitting a shipping inquiry, the method comprising:
 - defining a shipping inquiry for moving a specific piece of equipment from a starting location to a destination location;
 - obtaining, from a database, a plurality of characteristics of the specific piece of equipment to obtain at least one logistics criterion for the specific piece of equipment, wherein the at least one logistics criterion defines one or more characteristics for the specific piece of equipment based upon, at least in part, at least one of a defined manufacturer and model for a construction vehicle;
 - identifying the at least one logistics criterion to a user, wherein identifying the at least one logistics criterion to the user includes providing to the user at least one of a particular permit and a particular vehicle required to ship the construction vehicle, wherein providing to the user at least one of the particular permit and the particular vehicle required to ship the specific piece of equipment includes providing a link, wherein the link, when selected, provides one or more instructions

associated with at least one of the particular permit and the particular vehicle required to ship the specific piece of equipment;

determining whether at least one characteristic of the plurality of characteristics of the specific piece of equipment is beyond a threshold, wherein the threshold includes at least one of a physical weight threshold and a physical dimension threshold of the specific piece of equipment;

if the at least one characteristic is not beyond the threshold, assigning a lower weighted value to the at least one characteristic of the plurality of characteristics of the specific piece of equipment based upon the determination that the at least one characteristic is not beyond the threshold;

if the at least one characteristic is beyond the threshold, assigning a higher weighted value to the at least one characteristic of the plurality of characteristics of the specific piece of equipment based upon the determination that the at least one characteristic is beyond the threshold, wherein the higher weight and the lower weight³ are different multiplying factors indicative of a level of shipping complexity associated with the at least one characteristic;

calculating a shipping estimate for the shipping inquiry based upon which weight is assigned to the at least one characteristic; and

selecting one of a plurality of shipping inquiry submission options, wherein the plurality of shipping inquiry submission options includes:

at least one direct submission option that submits the shipping inquiry to a single preferred service provider, requesting that the single preferred service provider fulfill the shipping inquiry; and

at least one bid submission option that submits the shipping inquiry to a predefined group of service providers, requesting that one or more members of the predefined group of service providers submit competitive bids for fulfilling the shipping inquiry.

³ The Examiner is advised to consider whether the recited “*higher weight*” and “*lower weight*” have proper antecedent basis.

App. Br. 25–26 (Claims Appendix).

REJECTION

Claims 1–25 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter. Final Act. 5–6.⁴

ANALYSIS

Patent eligibility is a question of law that is reviewable *de novo*. *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012). Accordingly, we make our § 101 determinations concerning patent eligibility under this standard.

Patentable subject matter is defined by 35 U.S.C. § 101, as follows:

[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.

In interpreting this statute, the Supreme Court emphasizes that patent protection should not preempt “the basic tools of scientific and technological work.” *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (“*Benson*”); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012) (“*Mayo*”); *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208 (2014) (“*Alice*”). The rationale is that patents directed to basic building blocks of technology would not “promote the [p]rogress of [s]cience” under the U.S.

⁴ The Examiner’s rejection of claims 1–25 under 35 U.S.C. § 103 was withdrawn contingent on the filing of an appeal in the Advisory Action mailed July 25, 2016. However, the Examiner’s rejection under 35 U.S.C. § 101 was maintained in the Advisory Action.

Constitution, Article I, Section 8, Clause 8, but instead would impede it. Accordingly, laws of nature, natural phenomena, and abstract ideas, are not patent-eligible subject matter. *Thales Visionix Inc. v. U.S.*, 850 F.3d 1343, 1346 (Fed. Cir. 2017) (citing *Alice*, 573 U.S. 208 (2014)).

The Supreme Court set forth a two-part test for subject matter eligibility in *Alice* (573 U.S. 208 (2014)). The first step is to determine whether the claim is directed to a patent-ineligible concept. *Id.* (citing *Mayo*, 566 U.S. at 76–77). If so, then the eligibility analysis proceeds to the second step of the *Alice/Mayo* test in which we “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. 208 (2014) (quoting *Mayo*, 566 U.S. at 72, 79). There is no need to proceed to the second step, however, if the first step of the *Alice/Mayo* test yields a determination that the claim is directed to patent eligible subject matter.

The Patent Office has recently revised its guidance for how to apply the *Alice/Mayo* test in the *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50–57 (January 7, 2019) (“the *Revised Guidance*”). 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, mental processes, or certain methods of organizing human activity such as a fundamental economic practice or managing personal behavior or relationships or interactions between people); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* Manual of Patent Examining Procedure (“MPEP”) § 2106.05(a)–(c), (e)–(h)). 84 Fed. Reg. at 51–52, 55.

A claim that integrates a judicial exception into a practical application applies, relies on, or uses the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception. 84 Fed. Reg. at 54. When the judicial exception is so integrated, then the claim is not directed to a judicial exception and is patent-eligible under § 101. 84 Fed. Reg. at 54. Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then evaluate whether the claim provides an inventive concept. 84 Fed. Reg. at 56; *Alice*, 573 U.S. 208 (2014). Evaluation of the inventive concept involves consideration of 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. 84 Fed. Reg. at 56.

Step 1 of the Revised Guidance

As an initial matter, we consider whether claims 1–25 fall under one of the statutory categories of invention enumerated under 35 U.S.C. §§ 100 and 101. Claims 1–7 recite “*computer-implemented methods*” which constitute “processes” under 35 U.S.C. §§ 100 and 101. Claims 8–14 recite a “*computer program product*” which constitute “articles of manufacture” under 35 U.S.C. § 101. Claims 15–20 recite a “*computing system*” which constitute “apparatuses” under 35 U.S.C. § 101. Accordingly, each of

claims 1–25 fall within one of the statutory categories of invention. The patent eligibility inquiry does not end here, however, as we must proceed to apply the *Alice/Mayo* test and *Revised Guidance* to determine whether the claims are patent eligible.

Alice/Mayo—Step 1 (Abstract Idea)

Independent claims 1, 8, and 15 recite similar limitations. Appellant’s arguments address claim 1 as representative of all of the claims. App. Br. 15. We likewise select claim 1 as representative of the claims and examine it to determine whether it recites a judicial exception to patentability. 37 C.F.R. § 41.37(c)(1)(iv); 84 Fed. Reg. 54.

Step 2A—Prong 1 of the *Revised Guidance* (Does the Claim Recite a Judicial Exception?)

Turning to *Step 2A, Prong 1 of the Revised Guidance*, we agree with the Examiner that claim 1 recites “*submitting a shipping inquiry.*”⁵ Final Act. 4; Ans. 6. The *Revised Guidance* lists “certain methods of organizing human activity” as one category of judicial exception to patent eligibility. 84 Fed. Reg. 52. One subcategory listed under “certain methods of organizing human activity” is “fundamental economic practices.” *Id.* The Examiner finds that submitting a shipping inquiry is a fundamental economic practice. Final Act. 6. For reasons explained below, we agree that submitting a shipping inquiry may be considered a fundamental economic practice. We further determine the claim falls within the subcategory of a

⁵ Although the claim recites other abstract ideas like calculating a shipping estimate and selecting shipping inquiry submission options, as claimed, these are part of the more general abstract idea of submitting a shipping inquiry, so we do not analyze these abstract ideas separately.

commercial transaction because it involves steps preparatory to conducting a transaction for shipping special equipment such as a construction vehicle. 84 Fed. Reg. 52. In summary, claim 1 recites performing steps preparatory to “*submitting a shipping inquiry*” which is a judicial exception categorized as “certain methods of organizing human activity.” *Id.*

Cases decided by our reviewing court support our conclusion that claim 1 recites a judicial exception. For example, *Trading Technologies Int’l, Inc. v. IBG LLC*, 921 F.3d 1084, 1094–95 (Fed. Cir. 2019) affirmed the Board’s determination that claims of a certain patent were directed to the abstract idea of receiving user input to send a trade order. *Trading Technologies* is, of course, analogous to this case because “*submitting a shipping inquiry*” bears similarity to sending a trade order in that case. *OIP Technologies, Inc. v. Amazon.com, Inc.*, 788 F.3d 1359 (Fed. Cir. 2015) is also similar to the facts of this case. In *OIP*, the claims at issue recited the abstract idea of price optimization using different test offers. Transmitting electronic messages including test offers in *OIP* is similar to the recited “*submitting a shipping inquiry*” in this case. The claim can be further viewed as reciting steps that are part of a shipping transaction, and case law supports such a claim is abstract. *Smart Systems Innovations, LLC v. Chicago Transit Authority*, 873 F.3d 1364 (Fed. Cir. 2017) (claims reciting use of bankcard to pay for public transportation determined to be abstract).

Furthermore, the prior art cited by the Examiner provides evidence that “*submitting a shipping inquiry*” is a fundamental economic practice and a commercial transaction. For instance, Barni (US 6,920,429 B1, issued July 19, 2005) indicates it was known for customers to navigate a freight forwarder’s or carrier’s web site to obtain shipping and rate information.

Barni 1:42–52. Kornacki (US 2002/0007353 A1, published January 17, 2002) states “[v]irtually all businesses and individuals require products or goods to be shipped from one place to another at some time.” Kornacki ¶ 2. Kornacki further states “[i]n addition to the problem of estimating the size or class of the freight, is the issue of how to figure out the costs of carrying a particular shipment from point A to point B or the price to the shipper for having the freight shipped from point A to point B.” *Id.* ¶ 4. Hence, there is evidence in the record to support the Examiner’s determination that “*submitting a shipping inquiry*” is a fundamental economic practice. The same evidence also supports that the claims recite a commercial transaction.

Thus, we determine that claim 1 recites a “certain method of organizing human activity,” which is an abstract idea constituting a judicial exception to patent eligibility under the *Revised Guidelines*. 84 Fed. Reg. 54.

Step 2A—Prong 2 (Integration into Practical Application)

Under *Step 2A, Prong 2 of the Revised Guidance*, we consider whether claim 1 recites additional elements, or combinations thereof, that integrate the judicial exception into a practical application. *See Revised Guidance*, 84 Fed. Reg. at 54–55 (“Prong Two”). The claim recites a “*computer-implemented method*” in the preamble, although a computer is nowhere mentioned in the body of the claim. “Generally, [a] preamble does not limit the claims.” *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1346 (Fed. Cir. 2002) (citation omitted). Although there are circumstances in which a preamble may limit a claim, Appellant has not shown that such a circumstance applies here. *See Georgetown Rail Equipment Company v. Holland L.P.*, 867 F.3d 1229, 1236 (Fed. Cir. 2017)

(citing *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002)). We further note that “the PTO is obligated to give claims their broadest reasonable interpretation during examination.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). This principle requires us to read out the preamble limitation in this case where there has been no showing that it is limiting when considering whether the claims are patent-eligible under § 101.

Claim 1 recites a “*database*” in conjunction with the “*obtaining*” step. Claim 1 also recites a “*link*” in the “*identifying*” step. Assuming the “*database*” and “*link*” embody hardware or some other technical feature (*see* Spec. ¶¶ 46, 60, Figures 1 [60] and 4), they are the only physical elements recited in the claim that potentially could provide a tie to a practical application of the recited judicial exception. The remaining elements of the claim are data gathering steps (the claimed “*defining*,” “*obtaining*,” and “*identifying*,” and “*selecting*”), and data manipulation steps (the claimed “*determining*,” “*assigning*,” and “*calculating*”). Data gathering and manipulation steps are generally insufficient to constitute a practical application. *TLI Communications*, 823 F.3d 612–13 (Fed. Cir. 2016); *CyberSource v. Retail Decisions*, 654 F.3d 1366, 1370 (Fed. Cir. 2011); *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015). With the exception of the “*obtaining*” and “*identifying*” steps, which use the “*database*” and “*link*,” respectively, none of the remaining steps as claimed requires the use of a computer or database or anything else that could physically tie the claim to a practical application.

One of the factors identified as important to determining whether additional elements of a claim apply the judicial exception to a practical

application is whether they constitute an improvement in the underlying technology. 84 Fed. Reg. 55. In this case, the additional element recited in claim 1 is a generic “*database*” that does not do not improve the functioning of a computer, or define an improvement to another technology or technical field. Likewise, use of a “*link*” to receive or send information over a network is insufficient to define an improvement. *BuySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (“That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive.”).

In the Answer, the Examiner indicated that the § 103 rejection was withdrawn in view of Appellant’s amendment dated May 31, 2016. Ans. 2. This leads us to consider whether the claims recite some improvement that applies in the § 101 analysis. The amendment revised the claim to add the “*identifying*” step, which indicates to a user logistics criteria indicating a permit and vehicle required to ship a specific piece of equipment (a construction vehicle) along with associated instructions. The Examiner may have assumed that this step was “*computer-implemented*” and that the provision of this information by a computer was not disclosed in the cited references. Nonetheless, such permits and instructions existed in paper form, and of course vehicles were needed in the prior art to transport construction vehicles to a job site. Although the supposed computerization of information related to these features may have been satisfactory to the Examiner to demonstrate non-obviousness in view of the cited prior art, it is unavailing in the § 101 analysis because mere automation of manual processes or increasing the speed of a process, where these purported improvements come solely from the capabilities of a general-purpose

computer, are not sufficient to show an improvement in computer-functionality for purposes of § 101. *FairWarning IP, LLC v. Iatric Sys.*, 839 F.3d 1089, 1095 (Fed. Cir. 2016); *Credit Acceptance Corp. v. Westlake Services*, 859 F.3d 1044, 1055 (Fed. Cir. 2017).

Furthermore, claim 1 does not recite an additional element that implements the judicial exception with, or uses the judicial exception in conjunction with, a particular machine or manufacture that is integral to the claim. 84 Fed. Reg. 55. As noted, the claim recites a generic, general-purpose “*database*” and “*link*,” and not a particular machine. No showing has been made that these additional elements provide some capability beyond what would normally be expected of a database or link to provide. Consequently, the additional elements of claim 1 do not constitute a particular machine to which the judicial exception could be applied.

The additional elements of claim 1 do not effect a transformation or reduction of a particular article to a different state or thing. 84 Fed. Reg. 55. Rather, the additional elements operate on shipping information, not on an article, and the end result is information or data, not a transformed or reduced article.

Claim 1 further does not recite any additional element that applies or uses the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception. 84 Fed. Reg. 55. Rather, the only arguably technical elements in the claim are the “*database*” and “*link*,” which in this case are insufficient to integrate the judicial exception into a practical application.

We also note that even if the remaining claim steps were tied to an additional element, they would add insignificant extra-solution activity because they are not connected to the judicial exception of “*submitting a shipping inquiry*.” 84 Fed. Reg. 55. For example, in claim 1, “*identifying . . . [a] logistics criterion*” that includes a permit, a vehicle required to ship a construction vehicle, and associated instructions, is not necessarily connected to the “*shipping inquiry*” as the claim is recited. Accordingly, under broadest reasonable interpretation of the claim as recited, the permit, required transportation vehicle, and instructions may be entirely ancillary to “*submitting a shipping inquiry*.” Likewise, “*calculating a shipping estimate for the shipping inquiry*” is not necessarily linked to “*submitting a shipping inquiry*.” Consequently, the noted features of the claim merely add insignificant extra-solution activity to the judicial exception of “*submitting a shipping inquiry*.” MPEP 2106.05(g); *CyberSource v. Retail Decisions, Inc.*, 654 F.3d 1366, 1371 (Fed. Cir. 2011) (citing *Parker v. Flook*, 437 U.S. 584, 590 (1978)).

Although the preamble of claim 1 recites a “*computer-implemented method for submitting a shipping inquiry*,” the claim does not recite that the shipping inquiry is sent to a service provider. The claim only requires selection of an option in the “*selecting*” step for how the “*submitting*” is to be performed (single provider versus competitive bidding), and the shipping inquiry may never be communicated to a service provider as the claim is recited. Thus, the claim merely recites steps preparatory to actually “*submitting a shipping inquiry*” which is an intended use that is insufficient to constitute a practical application of the abstract idea recited therein. *Bilski v. Kappos*, 561 U.S. 593, 612 (2010); *Parker v. Flook*, 437 U.S. 584, 594

(1978). Moreover, case law establishes competitive bidding, as recited in the “*selecting*” step, is abstract. *In re Schrader*, 22 F.3d 290 (Fed. Cir. 1994).

Accordingly, we determine that claim 1 does not recite an additional element sufficient to amount to a practical application of the judicial exception. We conclude, therefore, that the claim is directed to a judicial exception.

Alice/Mayo—Step 2 (Significantly More)
Step 2B—(Inventive Concept)

We now examine whether claim 1 contains an inventive concept sufficient to transform the judicial exception into patent-eligible subject matter. *See Alice*, 573 U.S. 208 (2014); *Mayo*, 566 U.S. at 72, 79. Here, we consider whether an additional element, or combination of elements, of the claim recites more than well-understood, routine, conventional activity in the field defining an inventive concept. 84 Fed. Reg. 56.

Claim 1 can be viewed as an amalgamation of independent features. The “*defining*” and “*selecting*” steps relate to preparing a shipping inquiry for transmission to a shipping service provider. The Examiner found these features disclosed by Barni. Final Act. 7–8. The “*determining*,” “*assigning*,” and “*calculating*” steps relate to producing a “*shipping estimate*” that is not necessarily tied to the “*shipping inquiry*.” The Examiner relied on Kornacki to disclose this feature. *Id.* at 9–11. The “*obtaining*” step concerns information retrieval regarding a specific piece of equipment (a construction vehicle), including manufacturer and model. The Examiner found this step disclosed by Damji (US 2003/0200111 A1, published October 23, 2003). *Id.* at 12. The “*selecting*” step includes an

option for competitive bidding, which the Examiner found disclosed in Tangklilisan (WO 00/46718, published August 10, 2000). *Id.* at 13–14. As mentioned, the Examiner withdrew the § 103 rejection only after amendment of the claims to include the “*identifying*” step that provides a user a permit and vehicle needed to ship a specific piece of equipment (construction vehicle), and a “*link*” to instructions for the permit and shipping vehicle.

Thus, with the exception of the “*identifying*” step, the Examiner has shown that each of the claimed elements is disclosed in the prior art. As we have noted, the “*identifying*” step is unavailing in the § 101 analysis, because the preamble has not been shown to be limiting so that none of the steps need be “*computer-implemented*” but instead could be performed manually or in the human mind. Even if we assume the preamble is limiting, this only would require one of the recited steps to be “*computer-implemented*,” and that step need not be the “*identifying*” which could be performed manually or in the human mind. Further, even if we assume the “*identifying*” is performed by a computer, the mere automation of manual processes, or increasing the speed of a manual process, where these purported improvements come solely from the capabilities of a general-purpose computer, is not sufficient to show an improvement in computer-functionality for purposes of § 101. *See FairWarning and Credit Acceptance, supra.*

We further note that the background section of the Specification refers to shipping estimation systems and e-commerce websites with shipping estimation tools. Spec. ¶ 2. The background section indicates the problem to be solved by the invention is the complexity of calculating shipping costs when numerous things need to be considered, such as size, weight,

disassembly time, reassembly time, permits, and shipping vehicle requirements. *Id.* In the claim, however, only two things are considered—weight and dimension of the construction vehicle—in “*calculating a shipping estimate.*” Appellant has not shown “*calculating a shipping estimate*” is computationally difficult for a human to carry out based on the weight and dimension alone, which the Examiner indicates was known in the art. *See* Final Act. 11 (citing Kornacki ¶¶ 63, 64, 67–80).

Moreover, Appellant has not demonstrated that claim 1 contains an “inventive concept” tied to solving the problem of computational complexity that is something more than computers would normally be expected to provide, or that a human could not reasonably carry out the necessary computations. Computers are well-known for use in receiving, processing and storing data, and performing complex calculations. *See Alice*, 573 U.S. at 226 (nearly every computer is capable of performing basic calculation, storage, and transmission functions); *Flook*, 437 U.S. at 594 (recomputing or readjusting alarm limit values does not provide inventive concept); *Bancorp Services v. Sun Life*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (basic function of computer is performance of repetitive [complex] calculations). In any case, the “*determining,*” “*assigning,*” and “*calculating*” steps to determine a “*shipping estimate*” are not necessarily tied to the judicial exception of “*submitting a shipping inquiry*” and thus are incapable of transforming it into patent-eligible subject matter.

Accordingly, we conclude the additional elements of claim 1 are insufficient to constitute an inventive concept that could transform the judicial exception into patent-eligible subject matter. Instead, claim 1, representative of all claims, is directed to a judicial exception, and the

additional elements of the claims do not amount to significantly more than that judicial exception. As such, the claims as recited are patent-ineligible.

Appellant's Additional Arguments

Appellant argues the Examiner should not have concluded the claimed concept was abstract unless it is similar to a concept courts previously identified as an abstract idea, and that it is appropriate to compare the claim in question to claims found to be directed to an abstract idea in a previous court decision. App. Br. 17. Section 101 rejections are reviewable *de novo*, however, and we have shown above that case law supports the conclusion that the claims here recite abstract ideas. *See Trading Technologies, OIP, and BuySAFE, supra.*

Appellant argues the claim does not recite “agreements in the form of contracts, legal obligations, and business relations.” App. Br. 17–18. As discussed previously, the judicial exception recited in the claims is an abstract idea in the category of “certain methods of organizing human activity” in the subcategories of “fundamental economic practices” and “commercial transactions.” *See* 84 Fed. Reg. 52; MPEP § 2106.04(a)(2) I and II.

In connection with the Examiner’s finding that the claims recite a “fundamental economic practice,” Appellant argues the Examiner has not shown that “*submitting a shipping inquiry*” is “fundamental” meaning foundational or basic, when the claims are considered as a whole. App. Br. 18. We note there is evidence in the record to support the Examiner’s finding that the claims recite a “fundamental economic practice.” *See* Barni 1:42–52; Kornacki ¶¶ 2, 4. Appellant’s argument does not refute that evidence. Arguments of counsel cannot take the place of factually supported

objective evidence. *In re Huang*, 100 F.3d 135, 139–40 (Fed. Cir. 1996); *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997).

Appellant argues even if “*submitting a shipping inquiry*” were to be reasonably interpreted as a fundamental economic practice, there is no *per se* rule that all methods of this kind are abstract ideas that are judicially recognized exceptions, and the Examiner has not provided precedent to support such a conclusion. We previously noted that the record supports the Examiner’s conclusion that the claims recite a fundamental economic practice. *See* Barni 1:42–52; Kornacki ¶¶ 2, 4; *Trading Technologies, OIP, and BuySAFE, supra*.

Appellant argues that the claimed steps of “*identifying*,” “*providing*,” “*assigning*,” and “*selecting*” do not fall within the categories of computer functions that are recognized as well-understood, routine, and conventional by the *July 2015 Update: Subject Matter Eligibility*, and that the Examiner’s findings were conclusory on this matter. App. Br. 19; *see also* MPEP § 2106.05(d) II. As we have indicated, receiving, storing and transmitting data are well-known functions of a computer, and computers are known to simplify computational tasks. *See Alice, Flook, and Bancorp, supra*.

Appellant argues even if the claims recite generic computer components, they are able to perform non-generic functions that can amount to significantly more than an abstract idea and thus qualify as patent-eligible subject matter. App. Br. 20. Although this may be true in theory, Appellant has not demonstrated these claims perform non-generic functions for the reasons explained.

Appellant next argues that the claimed solution is necessarily rooted in computer technology under *DDR Holdings LLC v. Hotels.com LP*, 773

F.3d 1245 (Fed. Cir. 2014). We do not agree that Appellant has shown these claims are necessarily rooted in computer technology, especially considering that the only mention of computer components is in the non-limiting preambles of the claims.

Appellant argues the claims improve an existing technological process by providing a versatile, customizable shipping estimation tool where calculation of shipping costs is complicated and numerous things need to be considered, citing for support *Bascom Global Internet Services Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016). The claims do not mention anything about versatility or customizability, or what needs to be considered in calculating shipping costs beyond weight and dimensions that makes the computation more difficult. Limitations not appearing in the claims cannot be relied upon for patentability. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Appellant also has not shown the claims provide a technical solution to a technical problem, as opposed to a business solution to a business problem. *See Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229 (Fed. Cir. 2016).

Appellant argues that an inventive concept can be found in the non-generic arrangement of known, conventional pieces. App. Br. 22. Appellant does not indicate what non-generic arrangement or combination of features is recited in the claims allegedly provides such an inventive concept. For reasons explained, many of the recited features appear to have no relation to one another other than, perhaps, they are steps or functions performed to prepare for the same shipping transaction. For example, the “*identifying . . . [a] logistics criterion*” and “*calculating a shipping estimate for the shipping inquiry*” are not used in “*submitting a shipping inquiry*” in the claims.

Appellant argues the Examiner only analyzed the “*assigning a higher weighted value*” and not the “*assigning a lower weighted value*” in the claims. App. Br. 22–23. The “*assigning*” steps are conditional and mutually exclusive possibilities, so under the principle of broadest reasonable interpretation, the Examiner only needed to analyze one of the two possibilities. In any case, analysis of “*assigning a lower weighted value*” would be similar.

Appellant contends the claims include different techniques from what shipping estimation websites have done before, citing for support *McRO Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016). Again, the preamble of the claims has not been shown to be limiting, so any such different techniques are not technical ones performed by a computer or other technical device. The only technical features in the claims are the “*database*” and “*link*” which are recited generically at a high level of generality, which is insufficient to transform the judicial exception into patent-eligible subject matter.

DECISION

We affirm the Examiner’s rejection of claims 1–25 under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.

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