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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GLENN R. CUTLER

Appeal 2018-000013
Application 13/652,462
Technology Center 3600

Before CARLA M. KRIVAK, CARL W. WHITEHEAD JR. and KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

WHITEHEAD JR., *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant is appealing the final rejection of claims 1–3, 6, 7 and 11–21 under 35 U.S.C. § 134(a). Appeal Brief 12–14. We have jurisdiction under 35 U.S.C. § 6(b) (2012).

We affirm.

Introduction

The invention is directed to "a system, a method, and a device for scheduling, selecting, and delivering greeting cards and postcards." Specification ¶ 18.

Illustrative Claim

1. A method for selecting and inscribing a greeting card, which comprises:

providing a greeting card database for describing a set of greeting cards, said greeting card database having a greeting card record corresponding to a greeting card in said set of greeting cards, a greeting card field describing an attribute of each of said greeting cards, and a greeting card tuple related to said greeting card record and said greeting card field and storing a greeting card datum describing said greeting card;

providing a sender database for storing preferences of a set of senders, said sender database having a sender record corresponding to a sender in said set of senders, a first sender field describing a greeting card preference of each of said senders, a second sender field describing a message preference of each of said senders, a first sender tuple related to said sender record and said first sender field and storing a first sender datum describing said greeting card preference of said sender, a second sender tuple related to said sender record and said second sender field and storing a second sender datum describing said message preference of said sender;

determining by computer said greeting card from said set of greeting cards by matching said greeting card datum of said greeting card and said greeting card preference of said sender;

providing a message database for storing a set of messages, said message database having a sender record related to said sender, a message field storing a set of messages that can be printed on said greeting card, a message tuple field being related to said sender record and said message field and storing a message, a message attribute field storing an attribute of said message, and message attribute tuple being related to said message, said message attribute tuple storing a message attribute of said message;

determining by computer said message from said set of messages by matching said message attribute with said message preference of said sender;

printing said message on said greeting card;

providing a calendar database for describing a set of dates, said calendar database having a sender record related to said sender, and an event field storing a set of dates, and a date tuple related to said record and said event field, said date tuple storing a date; said date tuple being further related to said greeting card; and

sending said greeting card to said recipient at a predetermined time before said date without prompting from said sender.

Rejections on Appeal[1]

Claims 1–3, 6, 7 and 11–21 stand rejected under 35 U.S.C. §112(b) or (for pre-AIA) 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor, a joint inventor, or (for pre-AIA) the applicant regards as the invention. Final Action 3.

Claims 1–3, 6, 7 and 11–21 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to nonstatutory subject matter. Final Action 4–5.

ANALYSIS

Rather than reiterate the arguments of Appellant and the Examiner, we refer to the Appeal Brief (filed April 11, 2016), the Reply Brief (filed September 28, 2017), the Final Action (mailed June 11, 2015) and the Answer (mailed July 28, 2017) for the respective details.

35 U.S.C. §112 rejection

The Examiner finds:

[1] The Examiner's 35 U.S.C. § 103(a) rejections of claims 1–3, 6, 7 and 11–21 were withdrawn in the Answer. Answer 2.

> Line 25 of claim 1 recites, "determining by computer. . ." it is unclear if the computer recited in line 25 of claim 1 is the same computer as recited in line 16 of claim 1 or if it is a different computer than the computer recited in line 16 of claim 1. Claims 2–3, 6, 7, and 11–21 do not remedy the deficiencies of claim 1, and are thereby considered to be indefinite. Appropriate correction is required.
>
> For examination purposes the examiner will interpret line 25 of claim 1 to recite, "determining by computer. . ."

Appellant "requests remand of the application to resolve the Section 112 issues, if the Board reverses the other Section 101 rejections." Reply Brief 2. Appellant fails to argue the merits of the 35 U.S.C. §112(b) rejection of claims 1–3, 6, 7 and 11–21. Therefore, we sustain the Examiner's 35 U.S.C. §112(b) rejection of claims 1–3, 6, 7 and 11–21. *See Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) ("If an appellant fails to present arguments on a particular issue — or, more broadly, on a particular rejection — the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection. *See, e.g., Hyatt v. Dudas*, 551 F.3d 1307, 1313–14 (Fed. Cir. 2008) (the Board may treat arguments appellant failed to make for a given ground of rejection as waived)").

35 U.S.C. §101 rejection

The Examiner determines the claims are patent ineligible under 35 U.S.C. § 101 because the claims are directed to an abstract idea of organizing human activity, and do not include additional elements that are sufficient to amount to significantly more than the abstract idea. Final Action 4; *see also Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 217 (2014) (Describing the two-step framework "for distinguishing patents that

claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.").

After the mailing of the Answer and the filing of the Briefs in this case, the USPTO published revised guidance on the application of § 101. 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (hereinafter "Memorandum"). Under the Memorandum, the Office first looks 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); and
> (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, does the Office 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.

See Memorandum.

Appellant argues the Examiner erred for various reasons. Appeal Brief 12-14. We are persuaded the Examiner erred. Claim 1 recites a "method for selecting and inscribing a greeting card," provides "a greeting card database for describing a set of greeting cards," provides "a sender database for storing preferences of a set of senders," provides "a database for storing a set of messages" for printing on the card; etc. However as stated in the Memorandum, only *certain* methods of organizing human activity are

considered abstract ideas. Accordingly, we find a method for selecting and inscribing a greeting card is not an abstract idea when evaluated under the Memorandum because the invention is inscribing and printing greeting cards and therefore is not a fundamental economic practice, a mental process, a commercial or legal interaction or managing personal behavior between people. *See Alice*, 573 U.S. at 217 ("At the same time, we tread carefully in construing this exclusionary principle lest it swallow all of patent law.").

Subsequently, we do not sustain the Examiner's determination that claims 1–3, 6, 7 and 11–21 are not patent eligible.

DECISION

The Examiner's 35 U.S.C. §112(b) rejection of claims 1–3, 6, 7 and 11–21 is affirmed.

The Examiner's nonstatutory subject matter rejection of claims 1–3, 6, 7 and 11–21 is reversed.

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). *See* 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED