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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MICHAEL J. AMATO

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Appeal 2018-000683  
Application 14/450,996<sup>1</sup>  
Technology Center 3600

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

McNEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 24–43, 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> Appellant is the Applicant, the United States Postal Service, which, according to the Appeal Brief, is the real party in interest. App. Br. 3.

<sup>2</sup> Claims 1–23 were canceled by preliminary amendment on August 4, 2014.

STATEMENT OF THE CASE

*Introduction*

Appellant's application relates to filtering out mail items that a recipient may not want to receive. Spec. 1:13–15. Claim 24, reproduced below, is illustrative of the claimed subject matter:

24. A computer-implemented method, comprising:

obtaining, using at least one processor, from a physical mail item addressed to a recipient, information identifying the physical mail item;

determining, using the at least one processor, whether the identified physical mail item represents an unwanted physical mail item based on one or more delivery preferences of the recipient;

when the identified physical mail item represents an unwanted physical mail item, transmitting, using the at least one processor, a notification identifying the unwanted physical mail item to a recipient device;

receiving, using the at least one processor, a response to the notification from the recipient device, the response comprising instructions from the recipient for handling the unwanted physical mail item; and

storing, in a database, a flag in association with the delivery preferences, the flag indicating whether to deliver the unwanted physical mail item based on the instructions from the recipient.

*The Examiner's Rejection*<sup>3</sup>

Claims 24–43 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

ANALYSIS

An invention is patent eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and

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<sup>3</sup> The Examiner has withdrawn the non-statutory double patenting rejection of claims 24–43. Ans. 2.

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mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 192 (1981)); “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores” (*id.* at 184 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 176; *see also id.* at 192 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must 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. at 221 (quotation marks omitted). “A claim that recites an abstract idea must include ‘additional features’ to

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ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance* (“Memorandum”). Under that guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activities 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, do we 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.

#### *Alice* Step One

The Examiner determines that the claims are directed to “determining what to do with an unwanted physical mail item” and concludes that this is

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an abstract idea in the category of certain methods of organizing human activity. Final Act. 5.

Appellant argues the steps in the method of claim 24 do not recite a concept in the category of certain methods of organizing human activity similar to concepts found to be abstract by the courts. *See* App. Br. 12–14.<sup>4</sup> Specifically, Appellant argues the “claims do not recite financial or commercial transactions and are not ‘directed to’ the performance of financial or commercial transactions.” App. Br. 14.

As noted above, under the *2019 Revised Patent Subject Matter Eligibility Guidance*, we first consider whether the claim recites any judicial exception, then consider whether the claim recites any additional elements that integrate the judicial exception into a practical application. *See* Memorandum.

First, we agree with the Examiner that claim 24 is directed to a judicial exception, specifically an abstract idea in the category of certain methods of organizing human activity. In particular, claim 24 recites commercial or legal interactions that include business relations. For example, claim 24 recites “obtaining . . . from a physical mail item addressed to a recipient, information identifying the physical mail item,” “determining . . . whether the identified physical mail item represents an unwanted physical mail,” “transmitting . . . a notification identifying the unwanted physical mail item,” “receiving . . . a response to the notification . . . , the response comprising instructions from the recipient for handling the unwanted physical mail item,” and “storing . . . a flag in association with the

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<sup>4</sup> Appellant does not provide separate arguments for other claims. *See* App. Br. 11–19. Accordingly, we treat claim 24 as representative of all claims in our analysis.

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delivery preferences, the flag indicating whether to deliver the unwanted physical mail item based on the instructions from the recipient.” The recited steps manage business relations with a recipient by corresponding with the recipient to determine how to handle unwanted mail.

The Federal Circuit, in *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307 (Fed. Cir. 2016), found a similar concept to that embodied by claim 24 to be an abstract idea. In *Intellectual Ventures I*, some of the claims at issue related to “systems and methods for receiving, screening, and distributing email,” including a claim to “[a] post office for receiving and redistributing email” with “a rule engine coupled to receive an e-mail message . . . to selectively apply the business rules to the e-mail message to determine . . . a set of actions to be applied to the e-mail message.” *Id.* at 1316–17. The court analogized the claims to “a corporate mailroom” that “receive[s] correspondence, keep[s] business rules defining actions to be taken regarding correspondence based on attributes of the correspondence, appl[ies] those business rules to correspondence, and take[s] certain actions based on the application of business rules.” *Id.* at 1317. The court thus concluded that the claimed systems and methods were “abstract ideas, ‘fundamental . . . practice[s] long prevalent in our system’ and ‘method[s] of organizing human activity.’” *Id.* at 1318 (quoting *Alice*, 573 U.S. at 219–220). Claim 24 presents an even closer analogy to the corporate mailroom concept discussed in *Intellectual Ventures I* because the method of claim 24 relates to physical mail, not email.

Appellant argues, in the Reply Brief, that claim 24 is like the patent eligible claim at issue in *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016). *See* Reply Br. 4–7. We disagree. In *McRO*, the Federal Circuit distinguished the claim from cases where the “computer-

automated process and the prior method were carried out in the same way” and found that the claim was “directed to a patentable, technological improvement over the existing, manual 3-D animation techniques.” *Id.* at 1314, 1316. Here, however, the method of claim 24 is remarkably similar to the “corporate mailroom” concept identified by the court in *Intellectual Ventures I* and does not exhibit any technological improvement over that concept other than the use of computer components for automation.

Next, we consider whether claim 24 integrates the judicial exception into a practical application. We conclude that it does not because claim 24 does not apply the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that it is more than a drafting effort designed to monopolize the exception. *See Alice*, 573 U.S. at 221–24 (citing *Mayo*, 566 U.S. at 78–85). Specifically, claim 24 recites the use of the additional elements of “at least one processor,” “a recipient device,” and “a database” in implementing the judicial exception. The Specification provides “[t]he processes disclosed herein are not inherently related to any particular computer or other apparatus, and may be implemented by a suitable combination of hardware, software, and/or firmware.” Spec. 20:3–5.

Accordingly, the recited “processor,” “device,” and “database” do not provide an improvement in technology, an application with a particular machine, a transformation of a particular article to a different state or thing, or any other meaningful limits to the judicial exception. *See* MPEP § 2106.05(a)–(c), (e). Rather, the additional elements utilize generic computer components as tools to perform the judicial exception, which does not impose a meaningful limit on the judicial exception. *See* MPEP § 2106.05(f); *see also Alice*, 573 U.S. at 223 (“if [the] recitation of a

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computer amounts to a mere instruction to implement an abstract idea on a computer that addition cannot impart patent eligibility” (quotations and internal citations omitted)).

Thus, Appellant has not persuaded us of Examiner error with respect to *Alice* step one.

### *Alice* Step Two

The Examiner determines that the claims contain no additional elements, considered individually or in combination, that amount to significantly more than the judicial exception recited in the claims. *See* Final Act. 5.

Appellant argues “the pending claims improve the methods and systems of, for example, delivering mail items based on the preferences specified by a recipient by reducing the amount of effort spent by the recipient in disposing of unwanted mail items” and “reducing the cost associated with sending unwanted mail items by a sender based on the preferences specified by a recipient.” App. Br. 17. Here, Appellant’s argument focuses on the intended result of the claimed method, and not any specific means for achieving that result that improves the relevant technology, and is therefore not persuasive. *Cf. DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014) (“[T]he claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.”).

Appellant argues the Examiner’s finding that the claims recite allowable (i.e., novel and non-obvious) subject matter contradicts the Examiner’s finding that the additional elements in the claims recite well-understood, routine, and conventional activities. App. Br. 17–18. This

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argument is also not persuasive. Although the second step of the *Alice* framework is described as a search for an “inventive concept,” 573 U.S. at 217, the analysis is not an evaluation of novelty or non-obviousness. A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent ineligible. *See Mayo*, 566 U.S. at 90; *see also Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (“[A] claim for a *new* abstract idea is still an abstract idea. The search for a § 101 inventive concept is thus distinct from demonstrating § 102 novelty.”).

Appellant argues claim 24 “confine[s] the idea of handling unwanted physical mail item[s] to a specific application” and the additional elements are not merely “instructions to implement the idea on a computer.” App. Br. 18. We disagree because, as mentioned above, Appellant’s Specification provides that “[t]he processes disclosed herein are not inherently related to any particular computer or other apparatus, and may be implemented by a suitable combination of hardware, software, and/or firmware.” Spec. 20:3–5.

Appellant argues “[t]he pending claims also do not preempt the entire field of handling unwanted mail items, but instead recite a specific way to do so.” App. Br. 18. This argument is not persuasive of Examine error. Preemption is indeed the concern that drives the exclusionary principle of judicial exceptions to patent-eligible subject matter. *Alice*, 573 U.S. at 216. However, preemption is not a separate test of patent eligibility, but is inherently addressed within the *Alice* framework. *See Ariosa Diagnostics, Inc., v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“While

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preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”).

For these reasons, we agree with the Examiner that the claims to not recite an “inventive concept” under *Alice* step two that renders the claims patent eligible. We, therefore, sustain the patent-ineligible subject matter rejection of claim 24, and claims 25–43 not specifically argued separately.

#### DECISION

We affirm the decision of the Examiner rejecting claims 24–43.

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