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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM VAN HARLOW, PAUL P. O'CONNELL,
DAVID R. NGUYEN, STACI DUBOVIK, and
ERIC H. SAGALYN

Appeal 2018-001145
Application 13/900,978
Technology Center 3600

Before ELENI MANTIS MERCADER, JOYCE CRAIG, and
ALEX S. YAP, *Administrative Patent Judges*.

CRAIG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–18, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellants, the real party in interest is Putnam Investments. App. Br. 2.

INVENTION

Appellants' invention relates to a lifetime income analysis tool.

Abstract. Claim 10 is representative and reads as follows:

10. A method of performing retirement planning analysis comprising

providing selective information relating to an individual's retirement using a client-based application, and allowing users to customize and visualize their retirement plan to determine viability and estimate expected future monthly income needed to cover a broad range of health care costs in retirement utilizing a plurality of LIAT factors, the client-base application formats the selective information for transmission as requests using a request handler to generate proper shared keys or public certificates; and

receiving and processing the requests from the client-based application using a server-based application to retrieve and store retirement plan information, the server-based web-service includes the request handler having routines to process the requests useable by a third-party service platform, the request handler includes a verify module that determines if the requests include the proper shared keys or public certificates.

REJECTION

Claims 1–18 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to a judicial exception, without significantly more. Final Act. 2 (referencing previous office action (“Non-Final Act.” dated Dec. 14, 2015)).

ANALYSIS

Section 101 of the Patent Act provides that “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” is patent eligible. 35 U.S.C. § 101. But the

Supreme Court has long recognized an implicit exception to this section: “Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). To determine whether a claim falls within one of these excluded categories, the Court has set out a two-part framework. The framework requires us first to consider whether the claim is “directed to one of those patent-ineligible concepts.” *Alice*, 573 U.S. at 217. If so, we then examine “the elements of [the] 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*, 573 U.S. at 217 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78, 79 (2012)). That is, we examine the claim for an “inventive concept,” “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*, 573 U.S. at 217–18 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

The Patent Office recently revised its guidance about this framework. *See* 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Revised Guidance”). Under the Revised Guidance, to decide whether a claim is directed to an abstract idea, we evaluate whether the claim (1) recites subject matter that falls within one of the abstract idea groupings identified in the Revised Guidance and (2) fails to integrate the recited abstract idea into a practical application. *See* Revised Guidance, 84 Fed. Reg. at 51, 54. If the claim is directed to an abstract idea, as noted above, we then determine whether the claim has an inventive concept. The

Revised Guidance explains that when making this determination, we should consider whether the additional claim elements add “a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field” or “simply append[] well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality.” Revised Guidance, 84 Fed. Reg. at 56.

With these principles in mind, we turn to the § 101 rejection.

Abstract Idea

Appellants argue claims 1–18 as a group. *See* App. Br. 5. We select independent claim 10 as representative of the group. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner determined that claims 1–18 recite fundamental commercial practices of providing retirement calculation tools to allow users to incorporate income and healthcare costs in evaluating retirement options. *See* Non-Final Act. 3. The Examiner concluded the claims recite a method of organizing human activity, which is an abstract idea identified in the Revised Guidance. *See* Non-Final Act. 3; Revised Guidance, 84 Fed. Reg. at 52. For the reasons explained below, we agree with the Examiner that claim 1 recites commercial interactions, which are a method of organizing human activity, and thus an abstract idea.

Claim 10 recites a method that includes:

“providing selective information relating to an individual’s retirement . . . and allowing users to customize and visualize their retirement plan to determine viability and estimate expected future monthly income needed to cover a broad range of health care costs in retirement utilizing a plurality of LIAT factors . . .”; and “receiving and processing the requests . . .”

Providing selective information related to an individual's retirement and allowing the individual to customize and visualize their retirement plan are steps that would be taken during commercial interactions when organizing human activity. Here, the election and customization of information takes place in the context of using "a lifetime income analysis tool (LIAT)."

Spec. 3. We thus determine that independent claim 10 recites commercial interactions, one of the certain methods of organizing human activity identified in the Revised Guidance. *See Revised Guidance*, 84 Fed. Reg. at 52. Claim 10, therefore, recites an abstract idea. Independent claim 1 recites similar limitations, and we conclude claim 1 also recites commercial interactions, which is a certain methods of organizing human activity, and thus an abstract idea.

Because we determine that claim 10 recites an abstract idea, we next consider whether claim 10 integrates the abstract idea into a practical application. *See Revised Guidance*, 84 Fed. Reg. at 51. In doing so, we consider whether there are any additional elements beyond the abstract idea that, individually or in combination, "integrate the [abstract idea] into a practical application, using one or more of the considerations laid out by the Supreme Court and the Federal Circuit." *Revised Guidance*, 84 Fed. Reg. at 54–55.

Outside of the elements that make up the abstract idea, claim 10 recites the following additional elements: "using a client-based application," "the client-base² application formats the selective information for

² In the event of further prosecution, we leave it to the Examiner to determine whether the claim term "client-base application" lacks antecedent basis and is therefore indefinite under 35 U.S.C. § 112, second paragraph.

transmission as requests using a request handler to generate proper shared keys or public certificates,” “using a server-based application to retrieve and store retirement plan information,” and “the server-based web-service³ includes the request handler having routines to process the requests useable by a third-party service platform, the request handler includes a verify module that determines if the requests include the proper shared keys or public certificates.” App. Br. 11 (Claims App’x).

The written description indicates that this system encompasses generic computer components. For example, the written description describes that a user “can interact with LIAT thru *any web-based client application 10 that leverages HTML, CSS, and JavaScript, such as a web browser.*” Spec. 9 (emphasis added); *see also* Spec. 11; Fig. 4. The written description also describes that the server provides the results of its LIAT analysis to the user via the user interface 60 of Figure 4, and that server 40 uses generic computer components such as memory and a database. *See* Spec. 10, Fig. 3. In addition, the recited “request handler” and “shared keys” are described at a high level, without describing any particulars. Spec. 9. Given these disclosures, we determine that the recited method uses generic computer components as a tool to perform an abstract idea.

Appellants contend that the claim limitation “the server-based web-service includes the request handler having routines to process the requests useable by a third-party service platform, the request handler includes a verify module that determines if the requests include the proper shared keys

³ In the event of further prosecution, we leave it to the Examiner to determine whether the claim term “server-based web-service” lacks antecedent basis and is therefore indefinite under 35 U.S.C. § 112, second paragraph.

or public certificates” is directed to providing efficient ways to protect and retrieve relevant financial information in a client-server network. App. Br. 8.

We are not persuaded by Appellants’ argument. As discussed above, the Specification does not describe the request handler in detail or provide any particulars about the allegedly efficient way “to protect and retrieve relevant financial information in a client-server network.” *Id.*; See Spec. 9, Fig. 2. Appellants have not persuasively explained how the recited request handler improves the functioning of a computer or other technology or technical field, or otherwise meaningfully limits the judicial exception. We agree with the Examiner that the claimed invention is directed to solving a business problem, but the additional elements are not a technological solution to a technological problem, or a solution to the problem introduced by the technology itself. Final Act. 3–4.

We thus determine that claim 10 does not integrate the recited abstract idea into a practical application. See *Alice*, 573 U.S. at 223–24 (“[W]holly generic computer implementation is not generally the sort of ‘additional featur[e]’ that provides any ‘practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.’” (quoting *Mayo*, 566 U.S. at 77)); see also Revised Guidance, 84 Fed. Reg. at 55 (explaining that merely using a computer as a tool to perform an abstract idea may show that an abstract idea has not been integrated into a practical application).

For these reasons, we conclude claim 10 is not integrated into a practical application and is directed to a judicial exception.

Inventive Concept

Finally, we consider whether claim 10 has an “inventive concept.” That is, we examine “the elements of [the] 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*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 78, 79). Under the Revised Guidance, we evaluate whether the additional claim elements add “a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field” or “simply append[] well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality.” Revised Guidance, 84 Fed. Reg. at 56.

The Examiner determined that the additional elements recited in claim 10 execute in a manner “routinely and conventionally expected of these elements” at least because “a module (software) and a processor are used to calculate the data and process the data.” Non-Final Act. 4. In response, Appellants contend the Examiner erred because the claim limitations “the server-based web-service includes the request handler having routines to process the requests useable by a third-party service platform, the request handler includes a verify module that determines if the requests include the proper shared keys or public certificates” are not merely generic computer steps or functions, instead provide a novel way to protect financial data in client-server network. Non-Final Act. 8–9.

We are not persuaded that the Examiner erred. As discussed above, the written description indicates that the claimed invention uses generic computer components to perform generic computer functions, such as

providing information, receiving and processing requests, and determining whether requests include proper shared keys or public certificates. *See, e.g.*, Spec. ¶¶ 9–11. The written description provides few details about how the system performs these functions and generally describes the functions in a result-oriented manner. *See, e.g.*, Spec. ¶¶ 9–11. As a result, the written description adequately supports the Examiner’s determination the disputed, additional element recited in claim 10 perform well-understood, routine and conventional activities. *Cf. Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986) (explaining that “a patent need not teach, and preferably omits, what is well known in the art”); *see also* Robert W. Bahr, Memorandum on Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*), 3 (Apr. 19, 2018), available at <https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF> (explaining that a specification that describes additional elements “in a manner that indicates that the additional elements are sufficiently well-known that the specification does not need to describe the particulars of such additional elements to satisfy 35 U.S.C. § 112(a)” can show that the elements are well understood, routine, and conventional).

For these reasons, claim 10 “simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality.” Revised Guidance, 84 Fed. Reg. at 56. We thus determine that claim 10 does not contain an inventive concept.

Conclusion

For at least the above reasons, we determine that representative claim 10 is directed to a method of organizing human activity and does not have an

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inventive concept. We therefore sustain the Examiner's rejection of claim 10 under § 101. We also sustain the Examiner's § 101 rejection of grouped independent claim 1 and grouped dependent claims 2–9 and 11–18.

DECISION

We affirm the decision of the Examiner rejecting claims 1–18.

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED