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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL JOHN O'REIRDAN and
MICHAEL KEMP

Appeal 2018-001614
Application 13/893,414¹
Technology Center 2400

Before ERIC S. FRAHM, CATHERINE SHIANG, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

FRAHM, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1, 2, 5–15, 18–20, and 24–27, which are all the claims pending in this application.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellants, the real party in interest is Comcast Communications, LLC. App. Br. 2.

² Claims 3, 4, 16, 17, and 21–23 have been canceled. Dependent claims 6, 7, 9, 12, 18, 26, and 27 have been indicated by the Examiner as being allowable if rewritten in independent form including all of the limitations of their base claims and any intervening claims. Final Act. 2.

STATEMENT OF THE CASE

Introduction

Appellants' disclosed and claimed invention relates to filtering data, and more specifically to a method (claim 1) and apparatus (claim 13) "for aggregating contact information and verifying whether data should be delivered to one or more recipients based on one or more criteria." *See* Spec. ¶ 2; Abstract. The criteria can be a routing identifier (claim 1) or routing information (claim 13) that contains sender and recipient identifiers. For example, electronic mail can be filtered by blacklisting certain unwanted messages (i.e., spam) based on a sender's Internet Protocol (IP) address. Spec. ¶¶ 3, 4; claim 1. In other embodiments, blacklisting "may be performed on the 'from' and 'to' fields as a couplet or pair." Spec. ¶ 8; claim 13. Claims 1 and 13, reproduced below with bracketed lettering and emphases added to disputed portions of the claims, are illustrative of the claimed subject matter:

1. A method implemented by one or more computing devices, comprising:

receiving, by the one or more computing devices and from a sender, a communication comprising a sender identifier and a recipient identifier;

routing, by the one or more computing devices, the communication based on a result of comparing the sender identifier and recipient identifier of the communication to a plurality of routing identifiers, wherein each routing identifier of the plurality of routing identifiers comprises a sender identifier and a recipient identifier; and

[A] *granting, by the one or more computing devices, access privileges to the sender to edit a sender identifier of a routing identifier, of the plurality of routing identifiers, that indicates the sender.*

13. An apparatus comprising:
at least one processor; and
a computer-readable medium, storing computer-executable instructions that, when executed by the at least one processor, cause the apparatus to:
extract routing information from a received communication, the routing information indicating a sender and an intended recipient;
compare the routing information to a plurality of sender identifier and recipient identifier pairs;
route the communication based on a result of the comparing;
receive new identification information from the sender;
[B] *determine that the sender has access privileges to edit a pair from the plurality of sender identifier and recipient identifier pairs that indicates the sender; and*
[C] *update the sender identifier of the pair based on the new identification information and based on the access privileges of the sender.*

The Examiner's Rejections

Claims 1, 2, 5–15, 18–20, and 24–27 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 2–4.

Claims 1–20 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1–16 of US Patent No. 8,463,938. Final Act. 4–6. In view of the terminal disclaimer filed July 14, 2017, the double-patenting rejection has been withdrawn. Ans. 8; *see also* App. Br. 9. Therefore, this rejection is not before us on appeal.

Claims 1, 2, 5, 8, 10, 11, 13–15, 19, 20, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pickup (US 2003/0212791 A1; Nov. 13, 2003) and Schlieben (US 2003/0096605 A1; May 22, 2003). Final Act. 6–11.

ANALYSIS

Patent-Ineligible Subject Matter

In *Alice*, the Supreme Court reiterated the two-step framework set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), for determining whether claimed subject matter is judicially excepted from patent eligibility under § 101. *Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014). Assuming that a claim nominally falls within one of the statutory categories of machine, manufacture, process, or composition of matter, the first step in the analysis is to determine if the claim is directed to a law of nature, a natural phenomenon, or an abstract idea (judicial exceptions). *Alice*, 134 S. Ct. at 2355. For example, abstract ideas include, but are not limited to, fundamental economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Id.* at 2355–57. If the claim is directed to a judicial exception, such as an abstract idea, the second step is to determine whether additional elements in the claim “transform the nature of the claim’ into a patent-eligible application.” *Id.* at 2355 (quoting *Mayo*, 132 S. Ct. at 1297). This second step is described as “a search for an “inventive concept””—*i.e.*, an element or combination of elements that is ‘. . . significantly more than . . . the [ineligible concept] itself.’” *Id.* at 2355 (alteration in original) (quoting *Mayo*, 132 S. Ct. at 1294).

Alice Step One

“The first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish, LLC v. Microsoft Corp.*,

822 F.3d 1327, 1335–36 (2016). “The abstract idea exception prevents patenting a result where ‘it matters not by what process or machinery the result is accomplished.’” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 113 (1853)). “We therefore look to whether the claims . . . focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *McRO*, 837 F.3d at 1314.

The Examiner determines, and we agree, that the claims are directed to the abstract ideas of comparing new and stored information and using rules to identify options (*see* Final Act. 4; Ans. 2), as well as granting access privileges (Ans. 17–18). We find no specific improvement to computer capabilities in the claims, and Appellants disclose a “generic computing device 200 that can be used to implement the various features” of the invention, and “may be any type of computing device” (Spec. ¶ 21).

Appellants contend the Examiner has oversimplified claims 1 and 13, and that the claims are directed to an improvement in computer functionality, and not just the abstract idea of comparing new and stored information and using rules to identify options (App. Br. 7–9; Reply Br. 4–5). Appellants contend that the receiving, routing, and granting steps of method claim 1, and commensurate limitations of claim 13, are significantly more than the alleged abstract idea of comparing new and stored information and using rules to identify options (App. Br. 9). Appellants also contend (Reply Br. 4–5) the claims are drawn to more than just the abstract idea of granting access privileges, because claims 1 and 13 (i) recite routing a

communication, and (ii) “specif[y] what type of privileges are granted and what data can be edited” (Reply Br. 5).

We are not persuaded by Appellants’ arguments. The focus of claims 1 and 13 is on (i) comparing new and stored information and using rules to identify options; and (ii) granting access privileges (to edit data). We find this idea to be abstract.

The focus of claims 1 and 13 is not on a technical improvement. The mere recitation of “one or more computing devices” for the “receiving,” “routing,” and “granting” steps in claim 1 does not embody an improvement in computer capabilities as in *Enfish*. See *Enfish*, 822 F.3d at 1336 (“[T]he plain focus of the claims is on an improvement to computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity.”). Rather, the focus of claim 1 is on granting access privileges to edit data. And the recitation of an “apparatus” having “at least one processor” and “a computer-readable medium” storing instructions to “extract,” “compare,” and “receive” information in order to route a communication and update information similarly does not embody an improvement in computer capabilities. Indeed, neither claim 1 nor claim 13 recites how any specific technology is implemented to perform the method steps.

Our determination that claims 1 and 13 are directed to an abstract idea is supported by comparison with other cases where the Federal Circuit has decided claims relating to the information collection, analysis/comparison, editing, and display, to be directed to abstract ideas, for example: *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (collection and analysis of information); *Classen Immunotherapies, Inc. v.*

Biogen IDEC, 659 F.3d 1057 (Fed. Cir. 2011) (collecting and comparing known information); *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015) (tailoring information presented to a user based on particular information), and *Accenture Global Services, GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–46 (Fed. Cir. 2013) (generating tasks based on rules in response to events).

Notably, Appellants do not rebut or otherwise address the Examiner’s accurate comparison (*see* Ans. 4) of the claims on appeal to *Electric Power Group* or *Classen Immunotherapies* with evidence or argument. *See generally* Reply Br. 4–5 (addressing the patent-ineligibility rejection).

Alice Step Two

The second step in the *Alice* analysis requires a search for an “inventive concept” that “must be significantly more than the abstract idea itself, and cannot simply be an instruction to implement or apply the abstract idea on a computer.” *Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349 (Fed. Cir. 2016). There must be more than “computer functions [that] are ‘well-understood, routine, conventional activit[ies]’ previously known to the industry.” *Alice*, 134 S. Ct. at 2359 (second alteration in original) (quoting *Mayo*, 132 S. Ct. at 1294). However, “an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.” *Bascom*, 827 F.3d at 1350.

Because the claims recite a method using “one or more computing devices” (claim 1), and an apparatus including “at least one processor” and “a computer-readable medium” storing instructions to perform the method (claim 13), without providing a specific asserted improvement in computer capabilities, we find the claims merely utilize generic machinery and do not

improve the relevant technology (i.e., computing devices). Appellants' Specification supports our finding that the claims only recite generic computing devices for implementing the invention. For example, Figure 1 is described as "a network computing environment" which simply consists of two computing devices (110 and 140) on a network 130 which can be "any type of network" (Spec. ¶ 18), and "Figure 2 illustrates a simplified, generic computing device 200 that can be used to implement the various features" of the invention, and "may be any type of computing device" (Spec. ¶ 21).

Appellants have not shown the claims in this case require an arguably inventive set of components or methods, or invoke any assertedly inventive programming. *See Elec. Power*, 830 F.3d at 1355. Appellants have not identified what it is about claims 1 and 13 that allegedly amounts to more than a conventional arrangement of limitations for performing the abstract ideas identified above. Rather, Appellants' argument for the second step of the *Alice* analysis is, in essence, a conclusory assertion that the claims are non-conventional.

Summary

We are, therefore, not persuaded the Examiner erred in rejecting as patent-ineligible claims 1 and 13, and claims 2, 5–12, 14, 15, 18–20, and 24–27 not specifically argued separately.

Obviousness

The Examiner finds the combination of Pickup and Schlieben discloses all the limitations of claim 1, including "granting . . . access privileges to the sender to edit a sender identifier of a routing identifier . . . that indicates the sender" (limitation A, claim 1). Specifically, the Examiner finds that Pickup teaches granting access privileges to a sender to *add a*

sender identifier indicating the sender (Final Act. 7 citing Pickup ¶ 62), and Pickup fails to explicitly teach, but Schlieben teaches, granting access privileges to the sender to *edit* a sender identifier (Final Act. 7 citing Schlieben ¶¶ 472–474; Ans. 9–11 citing Schlieben ¶¶ 304, 474).

However, we do not agree with the Examiner that either (i) Pickup’s whitelisting procedure, described as identifying a sender’s email address as being on the whitelist prior to forwarding emails (¶¶ 58, 59, 61, 62); or (ii) Schlieben’s alias management procedure (¶¶ 472–474) for determining if a sender’s address is on a whitelist (permitting communication) or blacklist (barring communication) (Ans. 11 citing Schlieben ¶ 122) teaches or suggests “granting . . . access privileges to the sender to edit a sender identifier of a routing identifier . . . that indicates the sender” as set forth in claim 1 (limitation A, claim 1).

Thus, we agree with Appellants’ contention (App. Br. 3–6) that neither Pickup nor Schlieben, alone or in combination, teach or suggest “granting . . . access privileges to the sender to edit a sender identifier of a routing identifier . . . that indicates the sender” (limitation A, claim 1) as recited in independent claim 1. We thus, find the Examiner has failed to show the combination of Pickup and Schlieben teaches or suggests the disputed limitation A of claim 1.

With regard to claim 13, the Examiner finds that Pickup teaches (i) determining a sender has access privileges to *add* one of the sender and recipient identifier pairs that indicates the sender (limitation B, claim 13); and (ii) updating the sender identifier of the pair based in part on the access privileges (limitation C, claim 13) (*see* Final Act. 9 citing Pickup ¶¶ 58, 61, 62). The Examiner relies on Schlieben as teaching *editing* the sender

identifier (Final Act. 9 citing Schlieben ¶¶ 472–474). However, even if Schlieben teaches *granting* access privileges to edit the sender identifier, neither Pickup nor the combination with Schlieben teaches or suggests *determining* a sender has access privileges to edit one of the sender and recipient identifier *pairs* that indicates the sender as set forth in claim 13 (limitation B1, claim 13). More importantly, we do not agree with the Examiner (Ans. 13–14 citing Pickup ¶¶ 58, 59) that Pickup discloses sender and recipient identifier *pairs* as claimed, because Pickup only describes checking the sender’s email address against a whitelist, and is silent about “a plurality of sender identifier and recipient identifier pairs” and/or editing one of these “pairs” as recited in claim 13.

Thus, we agree with Appellants’ contention (App. Br. 6–7) that neither Pickup nor Schlieben alone or in combination teach or suggest (i) *determining* a sender has access privileges to edit one of the sender and recipient identifier *pairs* that indicates the sender (limitation B, claim 13); and (ii) updating the sender identifier of the *pair* based in part on the access privileges (limitation C, claim 13). We, therefore, find the Examiner has failed to show the combination of Pickup and Schlieben teaches or suggests the disputed limitations B and C of claim 13.

We also agree with Appellants’ contention that the Examiner’s articulated reasoning, determining that the combination of Pickup and Schlieben teaches or suggests the disputed limitations, “interprets the claim features in one way when citing to Pickup, and in a different and contradictory way when citing to Schlieben” (Reply Br. 2; *see also* Reply 2–3 (discussing the Examiner’s reliance on Pickup and Schlieben for different

features of the claims in opposing ways, e.g., as to the unauthorized “sender” and “routing” limitations)).

We are, therefore, constrained by the record to find the Examiner erred in rejecting as obvious (i) independent claim 1, as well as claims 2, 5, 8, 10, 11, 24, and 25 depending therefrom; and (ii) independent claim 13, as well as claims 14, 15, 19, and 20 depending therefrom.

DECISION

For the above reasons, we affirm the Examiner’s decision to reject claims 1, 2, 5–15, 18–20, and 24–27, because at least one ground of rejection has been affirmed for each claim. *See* 37 C.F.R. § 41.50(a)(1) (“The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically 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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED