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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BARRY APPELMAN and MUHAMMAD MOHSIN HUSSAIN

Appeal 2018-002033
Application 13/766,781
Technology Center 2400

Before JOHN A. EVANS, NORMAN H. BEAMER,
and SCOTT B. HOWARD, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's Non-Final Rejection of claims 50, 51, 53–57, 60–65, 67, 69–74, 76–83, and 85–96. Claims 1–49, 52, 58, 59, 66, 68, 75, and 84 are cancelled. We have jurisdiction over the pending rejected claims under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Facebook, Inc. (Appeal Br. 2.)

THE INVENTION

Appellant's disclosed and claimed invention is directed to reconfiguring an electronic message to effect an enhanced notification.

(Abstract.)

Independent claim 50, reproduced below, is illustrative of the subject matter on appeal:

50. A method comprising:

identifying, using one or more processors, content of a first electronic message intended for a recipient;

using the one or more processors and based on the content of the first electronic message, providing a first notification of the first electronic message via a first delivery mechanism, wherein the first delivery mechanism for the first notification is different than a second delivery mechanism for the first electronic message;

identifying content of a second electronic message intended for the recipient to determine that the content of the second electronic message is related to the content of the first electronic message; and

using the one or more processors and based on determining that the content of the second electronic message is related to the content of the first electronic message, replacing the first notification of the first electronic message with a second notification that indicates the second electronic message.

REJECTIONS

The Examiner rejected claims 50, 51, 53–57, 60–65, 67, 69–74, 76–83, and 85–96 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. (Non-Final Act. 2–3.)

The Examiner rejected claims 74–79, 82, and 83 under 35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), second paragraph, as indefinite. (Non-Final Act. 3–4.)²

The Examiner rejected claims 50, 51, 55, 62, 63, 71–74, 81, 85–87, and 91 under 35 U.S.C. § 102, as anticipated by Klein (US. 6,701,346 B1, issued Mar. 2, 2004). (Non-Final Act. 5–7.)

The Examiner rejected claims 54, 56, 57, 60, 61, 67, 69, 70, 76–80, 88–90, and 93–96 under 35 U.S.C. § 103, as being unpatentable over Klein and Horvitz (US 2002/0087649 A1, pub. July 4, 2002). (Non-Final Act. 8–11.)

The Examiner rejected claims 53, 64, 82, 83, and 92 under 35 U.S.C. § 103, as being unpatentable over Klein and Malik (US 2003/0229668 A1, pub. Dec. 11, 2003). (Non-Final Act. 12.)

The Examiner rejected claim 65 under 35 U.S.C. § 103, as being unpatentable over Klein, Malik, and Horvitz. (Non-Final Act. 12–13.)

ISSUES ON APPEAL

Appellant’s arguments present the following dispositive issues:³

Issue One: Whether the Examiner erred in concluding claims 50, 51, 53–57, 60–65, 67, 69–74, 76–83, and 85–96 are directed to patent-ineligible subject matter. (Appeal Br. 25–35.)

² Appellant does not address this rejection at this time. (Appeal Br. 35–36.) Therefore, this rejection is summarily affirmed.

³ Rather than reiterate the arguments of Appellant and the positions of the Examiner, we refer to the Appeal Brief (filed July 21, 2017); the Reply Brief (filed Dec. 18, 2017); the Non-Final Office Action (mailed Feb. 24, 2017); and the Examiner’s Answer (mailed Oct. 18, 2017) for the respective details.

Issue Three: Whether Klein discloses the independent claim 50 limitation, “wherein the first delivery mechanism for the first notification is different than a second delivery mechanism for the first electronic message,” and the commensurate limitations of independent claims 62, 71, 81, and 91. (Appeal Br. 18–19.)

ANALYSIS

Issue One — Eligibility

The Examiner concludes claims 50, 51, 53–57, 60–65, 67, 69–74, 76–83, and 85–96 are patent-ineligible under 35 U.S.C. § 101 because the claims are directed to the abstract idea of “[c]omparing new and stored information and using rules to identify options,” and “[r]eceiving, screening and distributing e-mail.” (Non-Final Act. 2.) The Examiner further concludes that there is nothing in the claims that is significantly more than this abstract idea, given that the additional elements are “generic computer components that perform their basic functions,” which “merely implement the abstract idea on a computer.” (Non-Final Act. 3.)

Appellant argues the Examiner’s characterization of the claimed subject matter is “untethered from the elements of the independent claims.” (Non-Final Act. 26 (citing *Enfish, LLC, v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016).) Appellant submits the “claims are directed to a method for replacing a first notification for a first message with a second notification for a second message based on identifying that content from a second electronic message is related to content from a first electronic message.” (Non-Final Act. 27.) Appellant further argues the claimed subject matter is similar to that of *Enfish* in that it “is directed toward a specific improvement to computer technology.” (Non-Final Act. 31.) In particular, Appellant

submits that the claimed subject matter “obviates the need for a user to access and review multiple notifications for related electronic messages, and thus provides a more efficient communication system.” (*Id.*)

In addition, Appellant argues “the claims at issue in this case include ordered combinations of steps that, when performed together, recite a non-conventional and non-generic implementation of removing redundant notifications for corresponding electronic messages.” (Non-Final Act. 33 (citing *BASCOM Global Internet v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016).) Appellant further argues the claims here fall under the authorities holding that claims are in fact patent eligible if they improve an existing technological process, even if implemented on a generic computer. (Non-Final Act. 35 (citing *McRo, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016).) For the reasons set forth below, we are not persuaded the Examiner erred.

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S. C. § 101. Here, independent claims 50, 71, and 81 and their dependent claims relate to a method, independent claim 62 and its dependent claims relate to a non-transitory computer-readable storage medium; and independent claim 91 and its dependent claims relate to a system — *i.e.*, a process, manufacture, or machine, respectively. However, the Supreme Court has long held that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (quoting *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 598–99 (2013)). The “abstract ideas” category embodies the

longstanding rule that an idea, by itself, is not patentable. *Alice*, 573 U.S. at 216–217.

In *Alice*, the Supreme Court sets forth an analytical “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 217. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* 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 v. Kappos*, 561 U.S. 593, 611 (2010); mathematical concepts (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and 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, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1853))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

If the claims are directed to a patent-ineligible concept, the second step in the *Alice/Mayo* analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” 573 U.S. at 217 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 79, 78 (2012)). In other words, the second step is to “search for an ‘inventive concept’ — *i.e.*, 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.’” 573 U.S. at 217–218 (quoting *Mayo*, 566 U.S. at 72–73.) A claim that recites an abstract idea must include additional features to ensure that the claim is more than a drafting effort designed to monopolize the abstract idea. 573 U.S. at 221. A transformation into a patent-eligible application requires more than simply stating the abstract idea while adding the words “apply it.” *Id.*

Further to the *Alice/Mayo* analytical framework, after the mailing of the Answer and the filing of the Briefs in this case, the USPTO published revised guidance on the application of Section 101. *See 2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (hereinafter “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, 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 Revised Guidance.

In evaluating the claims at issue, we consider claim 50 as representative, consistent with how Appellant and the Examiner analyze the claims. *See 37 C.F.R. § 41.37(c)(1)(iv)(2016)*. Omitting the portions of the claim invoking use of generic technology (which are discussed separately below), the remaining limitations of claim 50 elaborate on a method of receiving, screening and distributing email, via the steps of: (i) “identifying . . . content of a first . . . message intended for a recipient”; (ii) “based on the content of the first . . . message, providing a first notification of the first . . . message via a first delivery mechanism, wherein the first delivery mechanism for the first notification is different than a second delivery mechanism for the first . . . message”; (iii) “identifying content of a second . . . message intended for the recipient to determine that the content of the second . . . message is related to the content of the first . . . message”; and (iv) “based on determining that the content of the second . . . message is related to the content of the first . . . message, replacing the first notification of the first . . . message with a second notification that indicates the second . . . message.” (Appeal Br. 37.)⁴

⁴ The Examiner appropriately paraphrased these elements: “Identifying content of a message, provide a notification of the message (stored information), identify a second message (new information), and determine they are related then replacing the first notification with the second notification.” (Non-Final Act. 2.)

Apart from the use of generic technology (discussed further below), each of these limitations describes steps taken for receiving, screening and distributing email: (i) identify a received message; (ii) provide a notification of the message, using a different delivery mechanism than was used for the message; (iii) identify a second message, determining if it is related; (iv) if related, replace the first notification with a second notification that indicates the second message.

As stated in the Revised Guidance, methods of organizing human activity considered an abstract idea include “commercial . . . interactions (including . . . marketing or sales activities or behaviors; business relations) [and] managing personal behavior or relationships or interactions between people (including . . . following rules or instructions).” (Revised Guidance, 84 Fed. Reg. at 52). The claim 50 subject matter of receiving, screening and distributing email, which can be of a business or personal nature, falls under this description. *See, e.g., Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1316 (Fed. Cir. 2016) (receiving, screening, and distributing email). In particular; the Specification provides examples of the subject matter of the inventions that encompass both business and personal uses: e.g., an “auction alert” and a “birthday reminder.” (Spec. Fig. 10, 15:3–19.)

In *Symantec*, the Federal Circuit affirmed the District Court’s use of an analogy in concluding ineligibility of the claimed subject matter:

The . . . patent’s abstract describes the invention as “[a] system, method and various software products . . . for automatic deferral and review of e-mail messages and other data objects in a networked computer system, by applying business rules to the messages as they are processed by post offices.” . . . Claim 1 also describes the patented system as a “post office”—albeit an electronic one. . . . The district court held that “the asserted

claims of the . . . patent are directed to human-practicable concepts, which could be implemented in, for example, a brick-and-mortar post office.”

We agree, and think the district court’s analogy to a corporate mailroom is also useful. Such mailrooms receive correspondence, keep business rules defining actions to be taken regarding correspondence based on attributes of the correspondence, apply those business rules to correspondence, and take certain actions based on the application of business rules. Those actions include gating the message for further review, as in claim 1, and also releasing, deleting, returning, or forwarding the message, as described elsewhere in the . . . patent. . . .

838 F.3d at 1317.

Similarly, the method of receiving, screening and distributing email encompassed by claim 50 is analogous to the use of a “While You Were Out” slip (illustrated below) to notify a recipient of a message or telephone call, with the further embellishment that a follow-up call would trigger another slip that would replace the first.

The image shows a pink 'While You Were Out' slip form. At the top, it has fields for 'To', 'Date', and 'Time'. Below these is the title 'WHILE YOU WERE OUT' in bold. Underneath are fields for 'Name', 'Address', and 'Phone'. A table with two columns and four rows is present, with the following text in each cell: (1,1) TELEPHONED, (1,2) PLEASE CALL, (2,1) CALLED TO SEE YOU, (2,2) WILL CALL AGAIN, (3,1) WANTS TO SEE YOU, (3,2) URGENT, (4,1) RETURNED YOUR CALL, (4,2) empty. Below the table is a 'MESSAGE' section with three lines of text. At the bottom, there is an 'OPERATOR' field.

Set forth above is an example of a “While You Were Out” slip.

Therefore, we agree with the Examiner that the subject matter of claim 50 recites an abstract idea, as do the remaining claims.

Further pursuant to the Revised Guidance, we consider whether there are additional elements set forth in claim 50 that integrate the judicial exception into a practical application. Revised Guidance, 84 Fed. Reg. at 54–55. Here, the abstract idea of claim 50 is carried out using “one or more processors” and “delivery mechanisms,” such as “a fixed or mobile communication device, whether wired or wireless, and/or a software application, such as, for example, a messaging application or a browser.” (Appeal Br. 37; Spec. 5.) These additional elements do not integrate the judicial exception into a practical application. Rather, unlike *Enfish*, on which Appellant relies, there is no improvement to technology, but rather application of preexisting technology to implement the abstract idea. “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Mayo*, 566 U.S. at 77.

Nor does the subject matter of claim 50 contain additional elements that implement the judicial exception with a “particular machine,” because the claims do not specify any details in regard to the email delivery environment. *See* MPEP § 2106.05 (b). Further, the method does not transform matter; at best it transforms information. *See* MPEP § 2106.05(c). Nor does claim 50 have any other meaningful limitations (MPEP § 2106.05 (e)), or any of the other considerations set forth in the Revised Guidance regarding a determination of whether additional elements integrate the judicial exception into a practical application. *See* Revised Guidance, 84 Fed. Reg. at 55. Accordingly, we conclude that the subject matter of claim 50 (and the remaining claims) is directed to commercial interactions and managing personal behavior or relationships or interactions between people, which are examples of the certain methods of organizing human

activity, and thus an abstract idea, and the additional elements recited therein do not integrate the abstract idea into a practical application.

Turning to the second step of the *Alice* inquiry, we consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” 573 U.S. at 217 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 79, 78 (2012)). We do not agree with Appellant that additional elements of claim 50, whether individually or in combination, add “significantly more” to the basic abstract idea encompassed by the claim sufficient to transform the claimed abstract idea into a patent-eligible application. *Alice*, 573 U.S. at 223 (“[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.”). As discussed above, Appellant submits that the claimed subject matter “obviates the need for a user to access and review multiple notifications for related electronic messages, and thus provides a more efficient communication system.” (Non-Final Act. 31.) However, other than using generic technology — processors and delivery mechanisms — these improvements are elaborations on the basic abstract idea itself. “It is clear from *Mayo* that the ‘inventive concept’ cannot be the abstract idea itself.” *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 890 F.3d 1354, 1359 (Fed. Cir. 2018). Moreover, “[p]atent law does not protect claims to an ‘asserted advance in the realm of abstract ideas . . . no matter how groundbreaking the advance.’” 890 F.3d at 1359 (Fed. Cir. 2018).

Appellant’s reliance on *BASCOM* is unavailing. (Appeal Br. 32–33.) There, the court held eligible claims directed to a technology-based solution

to filter Internet content that overcame existing problems with other Internet filtering systems by making a known filtering solution—namely a “one-size-fits-all” filter at an Internet Service Provider (ISP)—more dynamic and efficient via individualized filtering at the ISP. *BASCOM*, 827 F.3d at 1351. Notably, this customizable filtering solution improved the computer system’s performance and, therefore, was patent-eligible. *See id.* But unlike the filtering system improvements in *BASCOM* that added significantly more to the abstract idea in that case, the claimed invention here uses generic computing components to implement an abstract idea as noted previously.

Nor is this invention analogous to that which the court held eligible in *McRO*, despite Appellant’s arguments to the contrary (Appeal Br. 35). There, the claimed process used a combined order of specific rules that rendered information in a specific format that was applied to create a sequence of synchronized, animated characters. *McRO*, 837 F.3d at 1315. Notably, the recited process *automatically animated characters* using particular information and techniques—an improvement over manual three-dimensional animation techniques that was not directed to an abstract idea. *Id.* at 1316.

But unlike the claimed invention in *McRO* that improved how the physical display operated to produce better quality images, the claimed invention here merely uses generic computing components to receive, screen and distribute email. *See SAP Am. v. InvestPic, LLC*, 898 F.3d 1161, 1167 (Fed. Cir. 2018) (distinguishing *McRO*).

The record supports the Examiner’s finding that the additional elements — processors and delivery mechanisms — are well-understood, routine, conventional, and specified at a high level of generality. Revised

Guidance, 84 Fed. Reg. at 56. There is no reference to “processors” in the Specification, including the original claims. Rather, there is reference to a “message enhancement service,” which is Specification explains:

[T]he message enhancement service . . . may include various mechanisms for delivering voice and/or non-voice data. The various mechanisms may include, for example, any applications, protocols, devices, or networks used to facilitate communication of electronic data. [T]he message enhancement service . . . also may include or be included in a general-purpose or a special-purpose computer, a local area network, and/or a wide area network. The response to and execution of instructions received by the message enhancement service . . . or any of [its] components (collectively the system services), may be controlled by, for example, a program, a piece of code, an instruction, a device, a computer system, or a combination thereof, for independently or collectively instructing the system services to interact and operate as described herein.

(Spec. 7–8.) The Specification further states that “delivery mechanism” encompasses “a fixed or mobile communication device, whether wired or wireless, and/or a software application, such as, for example, a messaging application or a browser.” (Spec. 5.) Nothing regarding any aspect of the “ordered combination” of the claim elements provide significantly more than the abstract idea that claim 50 is directed to.

Accordingly, we sustain the Examiner’s 35 U.S.C. § 101 rejection of claim 50. Appellant provides no arguments that would differentiate the remaining claims from claim 50. Thus, the foregoing analysis of claim 50 is exemplary of that for claims 51, 53–57, 60–65, 67, 69–74, 76–83, and 85–96. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2016). Therefore, we also sustain the Examiner’s 35 U.S.C. § 101 rejection of those claims.

Issue Two — Anticipation

Appellant argues, *inter alia*, that Klein does not disclose the claim 50 requirement, “wherein the first delivery mechanism for the first notification is different than a second delivery mechanism for the first electronic message.” (Appeal Br. 18–19.) The Examiner relies on the disclosure in Klein of a “computer system [that] may send messages to or receive messages from any accessible device, including through a wireless network or wired network such as the Internet.” (Klein 4:13–16.) From that, the Examiner finds that “[the] ‘first delivery mechanism’ could be wired and ‘second delivery mechanism’ could be ‘wireless’ and vice versa.” (Non-Final Act. 5.)

We agree with Appellant. Although Klein discloses that messages can be sent either over a wired or wireless network (which, as discussed above, are examples of delivery mechanisms), the Examiner does not point to anything in Klein disclosing that an electronic message is delivered using one mechanism and the corresponding notification is delivered using a different mechanism.

Accordingly, the Examiner has not made out a *prima facie* case of obviousness, and we do not sustain the Examiner’s anticipation rejection of claim 50, nor of claims 62, 71, 81, and 91, which have a commensurate limitations. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

We also do not sustain the Examiner’s anticipation and obviousness rejections of the dependent claims, because the Examiner does not rely on any of the other cited references as teaching or suggesting the limitation at issue.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed
50, 51, 53–57, 60–65, 67, 69–74, 76–83, 85–96	101	Eligibility	50, 51, 53–57, 60–65, 67, 69–74, 76–83, 85–96	
74–79, 82, 83	112	Written Description	74–79, 82, 83	
50, 51, 55, 62, 63, 71–74, 81, 85–87, 91	102	Klein		50, 51, 55, 62, 63, 71–74, 81, 85–87, 91
54, 56, 57, 60, 61, 67, 69, 70, 76–80, 88–90, 93–96	103	Klein, Horvitz		54, 56, 57, 60, 61, 67, 69, 70, 76–80, 88–90, 93–96
53, 64, 82, 83, 92	103	Klein, Malik		53, 64, 82, 83, 92
65	103	Klein, Malik, Horvitz		65
Overall Outcome			50, 51, 53–57, 60–65, 67, 69–74, 76–83, 85–96	

TIME PERIOD FOR RESPONSE

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