



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/844,316	03/15/2013	Richard Christopher Dunne	23_003	1703
23400	7590	03/21/2019	EXAMINER	
POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			BRINDLEY, BENJAMIN S	
			ART UNIT	PAPER NUMBER
			3697	
			NOTIFICATION DATE	DELIVERY MODE
			03/21/2019	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailbox@poszlaw.com
dposz@poszlaw.com
tvarndell@poszlaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD CHRISTOPHER DUNNE and
THOMAS RICHARD KMAK

Appeal 2018-002126
Application 13/844,316¹
Technology Center 3600

Before JEAN R. HOMERE, CARL W. WHITEHEAD JR., and
ADAM J. PYONIN, *Administrative Patent Judges*.

PYONIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The identified real party in interest is BDELLIUM, INC. Appeal Brief 4.

STATEMENT OF THE CASE

Introduction

The Application is directed to a system and method for aiding design of defined contribution retirement plans. Specification 2; Abstract.² Claims 1, 4–73, and 112 are pending. Appeal Brief 6. Claim 1, the sole independent claim, is reproduced below for reference:

1. A method, implemented over a network comprising a processor-based input device, a processor-based analysis device, and a database which stores information as data, of evaluating a plurality of plan designs, each such plan design consisting of a plurality of parameters that would govern operation of a retirement plan, the method comprising the steps of:

transferring, over the network, by the processor-based input device, to the processor-based analysis device, input data related to future retirement income of a plurality of eligible participants eligible to participate in the selected retirement plan;

transferring by the processor-based analysis device to the database the input data, and storing the input data in the database;

using data stored in the database, undertaking processing steps, by the processor-based analysis device, that determine, for each eligible participant in the plurality of eligible participants, a target retirement expenditure that is an amount of money a respective eligible participant desires to be able to spend during a specified retirement period;

storing the plurality of target retirement expenditures in the database;

undertaking processing steps, by the processor-based analysis device, that produce a plurality of plan design assessments by performing an evaluation cycle for each of the plurality of plan designs, the evaluation cycle including:

using data stored in the database, undertaking processing steps, by the processor-based analysis device, that determine, for each eligible participant in the plurality of eligible participants

² All Specification references herein are to the Substitute Specification filed August 13, 2013.

and for a selected plan design from the plurality of plan designs, a fundable retirement expenditure that is an amount of money a respective eligible participant can actually afford to spend during the same specified retirement period;

storing the plurality of fundable retirement expenditures in the database;

using data stored in the database, undertaking processing steps, by the processor-based analysis device, that determine, for each eligible participant in the plurality of eligible participants and for the selected plan design, a retirement security assessment that is a measurement of a relationship between a respective eligible participant's fundable retirement expenditure determined for the selected plan design given the selected plan design's parameters, and the respective eligible participant's target retirement expenditure;

storing the plurality of retirement security assessments in the database;

using data stored in the database, undertaking processing steps, by the processor-based analysis device, that determine, for each eligible participant in the plurality of eligible participants and for the selected plan design, an employer cost assessment that is an analysis of the cost to an employer of implementing the selected plan design, given the selected plan design's parameters, in respect of each of the plurality of eligible participants;

storing the plurality of employer cost assessments in the database;

using data stored in the database, undertaking processing steps, by the processor-based analysis device, that determine, for each eligible participant in the plurality of eligible participants and for the selected plan design, a participant cost assessments that is an analysis of the cost to an eligible participant of participating under the selected plan design, given the selected plan design's parameters;

storing the plurality of participant cost assessments in the database;

using data stored in the database, undertaking processing steps, by the processor-based analysis device, that produce a plan design assessment for the selected plan design, the plan design assessment being an aggregated analysis of the respective

retirement security assessments, employer cost assessments and participant cost assessments of the plurality of eligible participants with respect to the selected plan design; and
storing the plurality of plan design assessment in the database;
using data stored in the database, undertaking processing steps, by the processor-based analysis device, that produce an impact analysis that compares the plurality of plan design assessments of the plurality of plan designs;
storing the impact analysis in the database; and
outputting by the processor-based analysis device an indicator to select a particular plan design when the impact analysis indicates that the particular plan design is preferable to other plan designs in view of the retirement plan's retirement security objectives and cost constraints.

*Rejection*³

Claims 1, 4–73, and 112 stand rejected under 35 U.S.C. § 101 as being patent ineligible. Final Action 2–5.

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments. Arguments Appellants could have made but chose not to make are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). We adopt the Examiner's findings and conclusions as our own, and we add the following primarily for emphasis.

The Examiner determines claim 1 is directed to patent ineligible subject matter under 35 U.S.C. § 101, "because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon,

³ The Examiner has withdrawn the obviousness rejection of the pending claims. *See* Answer 2.

or an abstract idea) without significantly more.” Answer 6; *see also Alice Corp. 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 (“Guidance”). *See* USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Memorandum”). Pursuant to the Guidance “Step 2A,” the office first looks to whether the claim recites:

- (1) Prong One: 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) Prong Two: 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 (pursuant to the Guidance “Step 2B”) 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.

A. *Step 2A*

Prong One

Appellants argue the Examiner errs in determining claim 1 recites an abstract concept, because “the claimed embodiments are in fact not directed to activities that can be characterized as an abstract idea directed to a fundamental economic practice.” Appeal Brief 18. Appellants contend, instead, “independent claim 1 describes a method of evaluating a plurality of plan designs” (Appeal Brief 13), and “[i]n the [A]ppellant[s]’ August 28, 2015 response, the [A]ppellant[s] further stated that ‘defined contribution plan design and evaluation of plan parameters are not old and well established principles’” (Appeal Brief 18). Appellants further contend claim 1 does not fall in the category of “a method of organizing human activity,” because “the claimed method which is directed to evaluating retirement plan designs cannot reasonably be interpreted as directed to satisfying or avoiding a legal obligation [and] is not directed in any way to advertising, marketing, or sales activities and behaviors.” Appeal Brief 24.

Claim 1 recites, *inter alia*, a method of evaluating a plurality of plan designs, each such plan design consisting of a plurality of parameters that would govern operation of a retirement plan. Further, the recited the method comprises the steps of transferring input data related to future retirement income of a plurality of eligible participants eligible to participate in the selected retirement plan, transferring the input data, and storing the input data in the database, determining for each eligible participant in the plurality of eligible participants, a target retirement expenditure that is an amount of money a respective eligible participant desires to be able to spend during a specified retirement period, storing the plurality of target retirement

expenditures, and producing a plurality of plan design assessments by performing an evaluation cycle for each of the plurality of plan designs. The claim further requires the process includes determining, for each eligible participant in the plurality of eligible participants and for a selected plan design from the plurality of plan designs, a fundable retirement expenditure that is an amount of money a respective eligible participant can actually afford to spend during the same specified retirement period, storing the plurality of fundable retirement expenditures, determining, for each eligible participant in the plurality of eligible participants and for the selected plan design, a retirement security assessment that is a measurement of a relationship between a respective eligible participant's fundable retirement expenditure determined for the selected plan design given the selected plan design's parameters, and the respective eligible participant's target retirement expenditure, storing the plurality of retirement security assessments, determining, for each eligible participant in the plurality of eligible participants and for the selected plan design, an employer cost assessment that is an analysis of the cost to an employer of implementing the selected plan design, given the selected plan design's parameters, in respect of each of the plurality of eligible participants, storing the plurality of employer cost assessments, determining, for each eligible participant in the plurality of eligible participants and for the selected plan design, a participant cost assessments that is an analysis of the cost to an eligible participant of participating under the selected plan design, given the selected plan design's parameters, storing the plurality of participant cost assessments, using data stored in the database, undertaking processing steps, by the processor-based analysis device, that produce a plan design

assessment for the selected plan design, the plan design assessment being an aggregated analysis of the respective retirement security assessments, employer cost assessments and participant cost assessments of the plurality of eligible participants with respect to the selected plan design, and storing the plurality of plan design assessment in the database. Moreover, the claim recites producing an impact analysis that compares the plurality of plan design assessments of the plurality of plan designs, storing the impact analysis, and outputting an indicator to select a particular plan design when the impact analysis indicates that the particular plan design is preferable to other plan designs in view of the retirement plan's retirement security objectives and cost constraints.

Pursuant to the Guidance, we are not persuaded the Examiner errs in determining claim 1 recites the “management of a defined contribution plan, evaluation and selection of defined contribution plan features and provisions, and managing business relations which is a fundamental economic practice,” and is thus the abstract concept of “certain methods of organizing human activity.” Answer 3.⁴ As acknowledged by Appellants, the above cited limitations of independent claim 1 recite “detailed steps for evaluating plan design parameters governing operation of a selected retirement plan” (Appeal Brief 19), and include data processing steps to transfer, determine, store, and output data in order to indicate a preferable

⁴ We note the Examiner additionally determines the claims recite “an idea of itself.” See Answer 6. The Guidance, however, no longer includes this category of abstract concepts. See Memorandum, Section I (Groupings of Abstract Ideas), 84 Fed. Reg. at 52. For purposes of clarity, predictability, and consistency, we limit our analysis to the Guidance. See Memorandum, 84 Fed. Reg. at 50.

retirement plan design. These steps follow rules or instructions to structure a retirement program (i.e., a form of business relations or agreements); thus, the claim limitations are “[c]ertain methods of organizing human activity.” Memorandum, Section I (Groupings of Abstract Ideas), 84 Fed. Reg. at 52–53. We further note the claim recitations of “performing an evaluation cycle for each of the plurality of plan designs” and “produc[ing] an impact analysis” are steps of evaluation and judgement, and thus recite the abstract concept of “[m]ental processes.” *Id.*

We find Appellants’ arguments to the contrary unpersuasive. First, we note Appellants’ arguments improperly refer to documents filed with the Office before initiation of this appeal. *See, e.g.*, Appeal Brief 18–19; *see also* MPEP § 1205.02 (“Thus, the brief should not incorporate or reference previous responses.”). Second, Appellants misstate the relevant law by arguing a fundamental economic practice must be “old and well established” (Appeal Brief 18) or must be “so pervasive, and so difficult to replace, that its absence would cause some critical aspect of society to cease to function” (Reply Brief 9). “[A] claim for a *new* abstract idea is still an abstract idea.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (“We do not agree with Ultramercial that the addition of merely novel or non-routine components to the claimed idea necessarily turns an abstraction into something concrete.”). Here, claim 1 recites an abstract concept because it includes limitations that “fall[] within the subject matter groupings of abstract ideas enumerated in Section I of the 2019 Revised Patent Subject Matter Eligibility Guidance,” as discussed above. Memorandum, Section III(A)(1) (Prong One: Evaluate Whether the Claim

Recites a Judicial Exception), 84 Fed. Reg. at 54. Third, Appellants' argument regarding preemption does not show Examiner error (*see* Appeal Brief 24), as any questions on preemption in the instant case have been resolved by the analysis herein, the Final Action, and the Examiner's Answer. *See* Answer 5; *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (“[W]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Alice* framework, as they are in this case, preemption concerns are fully addressed and made moot.”).

Accordingly, claim 1 “recites a judicial exception” pursuant to Step 2A, Prong One of the Guidance. Memorandum, 84 Fed. Reg. at 54.

Prong Two

We are also not persuaded the Examiner's rejection is in error pursuant to Step 2A, Prong Two of the Guidance. Appellants present no evidence showing that “the pending claims provide a technologically unique solution” because the “networked, distributed, execution of the steps of independent claim 1 means that the time required to complete all of the necessary determinations is not discernably longer for a retirement plan with an exceptionally large number of eligible participants, compared to one with relatively few eligible participants.” Reply Brief 16; *see also* Final Action 47. Nor do Appellants show such features would integrate the judicial exception into a practical application. Rather, we agree with the Examiner that claim 1 does not provide a technological improvement, as the recited network components “provide a generically computer-implemented solution to a business-related or economic problem.” Answer 5; *see also* Answer 10;

Appeal Brief 23 (“the concrete processing steps described above related to evaluating plan design parameters to maximize savings by participants in a selected retirement plan”). The claim recites the mental steps/organizing human activity of evaluating retirement plan designs; the recited network and computers “do[] no more than generally link the use of a judicial exception to a particular technological environment.” Memorandum, 84 Fed. Reg. at 55; *see also* Answer 5–6, 10; *Alice*, 573 U.S. at 226 (“Nearly every computer will include a ‘communications controller’ and ‘data storage unit’ capable of performing the basic calculation, storage, and transmission functions,” so that “none of the hardware recited by the system claims ‘offers a meaningful limitation beyond generally linking “the use of the [method] to a particular technological environment,” that is, implementation via computers.’” (alteration in original) (citation omitted))).

Accordingly, we determine claim 1 does not integrate the judicial exception into a practical application. *See* Memorandum, 84 Fed. Reg. at 54. As the “claim recites a judicial exception and fails to integrate the exception into a practical application” (*id.* at 51), “the claim is directed to the judicial exception” (*id.* at 54).

B. Step 2B

We agree with the Examiner that the claimed elements and combination of elements do not amount to significantly more than the judicial exception itself. *See* Answer 5–6, 8–10; Memorandum, Section III(B) (Step 2B), 84 Fed. Reg. at 56. The claimed additional elements only recite generic components and steps that are well-understood, routine, and conventional. *See* Final Action 4–5; Specification ¶¶ 3–20, 34,

Appeal 2018-002126
Application 13/844,316

59–62; *Alice*, 573 U.S. at 226; *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (“That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive.”); *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018) (“It has been clear since *Alice* that a claimed invention’s use of the ineligible concept to which it is directed cannot supply the inventive concept that renders the invention ‘significantly more’ than that ineligible concept.”).

Accordingly, we agree with the Examiner that claim 1 is patent ineligible. *See* Answer 6.

CONCLUSION

We sustain the Examiner’s rejection of independent claim 1. Appellants advance no further argument on the remaining dependent claims. *See* Appeal Brief 30. Accordingly, we sustain the Examiner’s rejections of all pending claims for the same reasons discussed above.

DECISION

The Examiner’s decision rejecting claims 1, 4–73, and 112 is affirmed.

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