



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

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
13/340,870 12/30/2011 Alison Page 095163-0810763 7793

23370 7590 05/02/2019
KILPATRICK TOWNSEND & STOCKTON LLP
Mailstop: IP Docketing - 22
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

EXAMINER

ROSS, SCOTT M

ART UNIT PAPER NUMBER

3623

NOTIFICATION DATE DELIVERY MODE

05/02/2019

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):

ipefiling@kilpatricktownsend.com
KTSDocketing2@kilpatrick.foundationip.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALISON PAGE, PHILIP CLAS,
and STEPHANIE DE BODINAT¹

Appeal 2018-002310
Application 13/340,870
Technology Center 3600

Before JASON V. MORGAN, ERIC B. CHEN, and
IRVIN E. BRANCH, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the non-final rejection of claims 1–4, 7, 8, 13–15, and 17–21. Claims 5, 6, 9–12, 16, and 22–34 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellants' invention relates to a retail system that retrieves user information from the device, determines the location of the user based on the

¹ According to Appellants the real party in interest is Adidas AG. (App. Br. 3.)

user information, and transmits a list of specials based on the user location.
(Abstract.)

Claim 1 is exemplary, with disputed limitations in italics:

1. A method comprising:

[i] retrieving user information from a device;

[ii] determining, by a server device, a location of a user based on the retrieved user information;

[iii] comparing, by the server device, the user information and the location of the user with one or more conditions for accessing specials of a collection of specials stored in a data storage device, the one or more conditions including at least a particular geographic location;

[iv] compiling, by the server device, a list of available specials unique to the location of the user by determining which of the specials of the collection of specials satisfy the one or more conditions necessary for accessing the respective specials;

[v] transmitting the list of available specials to the device, the list of available specials including a list of customizable products;

[vi] transmitting, to the device, a list of customizable features available for the one or more customizable products, the list of customizable features unique to the location of the user, wherein the list of customizable features include customizable design features of the products and customizable functional features of the products;

[vii] receiving, at the server device, a selection of one or more customizable products from the list of customizable products and a selection of customization features available for the one or more customizable products;

[viii] storing, in the data storage device, information indicating the selection of the one or more customizable products as customized based on the selection of customization features; and

manufacturing the one or more customizable products as customized based on the selection of customization features by printing at least one customized element such that the at least one

customized element is incorporated into the selected one or more customizable products.

Claims 1–4, 7, 8, 13–15, and 17–21 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.

Claims 1, 7, 8, 13–15, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Fields et al. (US 2013/0346117 A1, published Dec. 26, 2013) (“Fields”) and Paul et al. (US 2011/0004524 A1, Jan. 6, 2011) (“Paul”).

Claims 2–4, 17, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Fields and Weiss et al. (US 2011/0099047 A1, published Apr. 28, 2011) (“Weiss”).²

ANALYSIS

§ 101 Rejection

We are persuaded by Appellants’ arguments (App. Br. 18) that the Examiner has not satisfied the proper burden for making a prima facie case for patent ineligibility under 35 U.S.C. § 101.

The Examiner determined that the steps of independent claims 1, 13, and 18 are “simply the organization and comparison of data which can be performed mentally and is an idea of itself,” which “is similar to other concepts that have been identified as abstract by the courts, such as using categories to organize, store and transmit information in *Cyberfone*, or comparing new and stored information and using rules to identify options in

² Appellants do not present any arguments with respect to the rejection of claims 2–4, 17, 20, and 21 under 35 U.S.C. §103(a). Thus, any such arguments are deemed to be waived.

SmartGene.” (Non-Final Act. 4; *see also* Ans. 6.) Likewise, the Examiner determined that:

[s]imilar to the claims at issue in *Electric Power Group*, the pending claims receive data (e.g., user information, location, etc.), analyze that data (e.g., comparing the user information and location with one or more conditions for accessing specials, etc.) and update information based on the analyzed data (e.g., compiling a list of available specials, transmitting the list of available specials; list of customizable features, etc.).

(Ans. 7.) We agree that the Examiner has not satisfied the proper burden for a prima facie case.

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 mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (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 (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 191 (“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.* at 191 (citing *Benson* and *Flook*); *see also, 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 (citation omitted). “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].’” *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 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019). 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 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) (9th ed. 2019)).

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 84 Fed. Reg. at 56.

*Are the claims at issue directed
to a patent-ineligible concept?*

Step One

Claim 1 is a method claim having several steps, which falls within the “process” category of 35 U.S.C. § 101. Likewise, claim 13 is a system claim which falls within the “manufacture” category of 35 U.S.C. § 101, and claim 18 is a computer readable medium claim, which also falls within the “manufacture” category of 35 U.S.C. § 101. Although claims 1, 13, and 18 fall within the statutory categories, we must still determine whether the claim is directed to a judicial exception, namely an abstract idea. *See Alice*, 573 U.S. at 217–18. Thus, we must determine whether the claims recite a judicial exception, and fail to integrate the exception into a practical application. *See* 84 Fed. Reg. at 54–55. If both elements are satisfied, the claim is directed to a judicial exception under the first step of the *Alice/Mayo* test. *See id.*

Step 2A—Prong One

Independent claim 1 is a method claim, which recites, in part, the following: “[i] retrieving user information” and “[iv] compiling . . . a list of available specials.” Such method steps of claim 1 are directed to a patent-ineligible abstract idea of commercial interactions, such as a collecting information. *See, e.g., Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350,

1353 (Fed. Cir. 2016) (“collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.”).

Independent claim 1 further recites: “[ii] determining . . . a location of a user,” “[iii] comparing . . . the user information and the location of the user,” and “[viii] storing . . . information indicating the selection of the one or more customizable products as customized.” Such method steps of claim 1 are directed to a patent-ineligible abstract idea of commercial interactions, such as analyzing and storing information. *See, e.g., Elec. Power Grp.*, 830 F.3d at 1354 (“[t]he advance they purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions.”); *Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (“collecting data, . . . recognizing certain data within the collected data set, and . . . storing that recognized data in a memory” is an abstract idea).

Moreover, independent claim 1 recites: “[v] transmitting the list of available specials,” “[vi] transmitting . . . a list of customizable features available for the one or more customizable products,” and “[vii] receiving . . . a selection of one or more customizable products.” This method step is directed to a patent-ineligible abstract idea of commercial interactions, such as routing information. *See Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1337 (2017) (“The claim requires the functional results of . . . ‘routing,’ . . . but does not sufficiently describe how to achieve these results in a non-abstract way”).

Claims 13 and 18 recite limitations similar to those discussed with respect to claim 1. Thus, claims 13 and 18 are also directed to a judicial exception.

Step 2A—Prong Two

Because claims 1, 13, and 18 are directed to an abstract idea, we next determine if the claim recites additional elements that integrate the judicial exception into a practical application.

In the “Background of the Invention” section, Appellants’ Specification discloses conventional retail shopping, in which the user is limited by the retailer’s catalog, as follows:

People often use the interactive capabilities of such devices to search or products or retail locations. Traditionally, these devices access a retail location’s general or mobile website, *where the user then has to navigate the site in order to identify retail location information and/or search through a catalog of products to determine which of those products are available for purchase in her location.*

(Spec. ¶ 4 (emphasis added).)

In the “Background of the Invention” section, Appellants’ Specification discloses the following needs:

It may be desirable to provide a location-based user interface that automatically provides a list of retail locations that are in the predefined radius of a user’s device and/or a list of products that are available in the predefined radius of the device, based on location information obtained from the device, to improve the efficiency of identifying and locating such items and locations. *It may also be desirable to provide customization features through such a user interface that are accessible only in certain locations, dates, and/or times based on information obtained from the user’s device. Customized sporting products, such as customized sporting apparel and customized sporting*

equipment, can provide significant benefits when undertaking a wide variety of activities. For example, customized sporting items can help people adapt to different environmental conditions. For some activities, customized sporting items can contribute to, and even enhance, performance. For example, customizing the size of a sporting item to an individual user, e.g. to the specific size, weight or body measurements of an athlete, results in a sporting item that has an optimal fit for this particular athlete thereby leading to an improved usability during a sports activity and hence to improved performance of the athlete.

(*Id.* ¶ 5 (emphases added).)

In one embodiment, Appellants' Specification discloses the following solution for the need of customization:

In other exemplary embodiments, specials for a college may be stored in the data storage device 150, which may vary depending on whether the user is an alumni, current student, member of one of the college sports teams, academic teams, or other criteria. If the system server 120 determines that the user is located at the college through any of the location methods described above, the system server 120 may access a list of alumnae, registered students, team rosters, club rosters, or other lists associated with various college affiliations, which may be stored on the data storage device 150 or other storage location. If the user's name or other identifying information corresponds to one or more of the various lists, the system server 120 may locate specials for the specific college affiliations stored on the data storage device 150, which are then added to the list of available specials.

(*Id.* ¶ 80.)

With respect to the claimed hardware components, system claim 1 recites “[i] *retrieving user information from a device,*” “[ii] *determining, by a server device, a location of a user based on the retrieved user information,*” “[iv] *compiling, by the server device, a list of available specials unique to the location of the user by determining which of the*

specials of the collection of specials satisfy the one or more conditions necessary for accessing the respective specials,” and “[vi] transmitting, to the device, a list of customizable features available for the one or more customizable products, the list of customizable features unique to the location of the user” (emphases added).

Thus, the claimed user “device” and the claimed “server device” functionally cooperate, such that the server device provides to the user “a list of customizable features available for the one or more customizable products, the list of customizable features unique to the location of the user.” Because independent claims 1, 13, and 18 overcome a problem in providing customizable features to users, “the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks,” and accordingly, the claims are not directed to an abstract idea. *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1258–59 (Fed. Cir. 2014).

Thus, independent claims 1, 13, and 18 recite additional elements that integrate the judicial exception into a practical application.

Accordingly, we are persuaded by Appellants’ arguments that:

Claim 1 thus provide a specific technological solution to a problem that arises in the field of product presentation to remote users. Specifically, the claimed limitations show how a product server system can analyze remote device information to determine user location, compare the location to one or more conditions for accessing specials, and compile a unique collection of specials and customization features from a data storage device based on the analyzed location.

(App. Br. 16.)

Thus, we do not sustain the rejection of independent claims 1, 13, and 18 under 35 U.S.C. § 101. Claims 2–4, 7, 8, 14, 15, 17, and 19–21 depend

from independent claim 1. We do not sustain the rejection of claims 2–4, 7, 8, 14, 15, 17, and 19–21 under 35 U.S.C. § 101 for the same reasons discussed with respect to independent claims 1, 13, and 18.

§ 103 Rejection—Fields and Paul

We are unpersuaded by Appellants’ arguments (App. Br. 19; *see also* Reply Br. 5) that the combination of Fields and Paul would not have rendered obvious independent claim 1, which includes the limitation “manufacturing the one or more customizable products as customized based on the selection of customization features by printing at least one customized element such that the at least one customized element is incorporated into the selected one or more customizable products.”

The Examiner found that the personalized custom designed products of Paul, for example, printing text or images to a product, correspond to the limitation “manufacturing the one or more customizable products as customized based on the selection of customization features by printing at least one customized element such that the at least one customized element is incorporated into the selected one or more customizable products.”

(Ans. 29–30; *see also* Non-Final Act. 10.) We agree with the Examiner’s findings.

Paul relates to “[c]omputer based systems . . . [that] allow designing (e.g., customization) of consumer products, such as articles of footwear, apparel, athletic equipment, etc.” (Abstract.) In particular, Paul explains that “[a]ny desired type of footwear design data may be controlled, altered, or customized by a user of systems and methods according to this invention, such as . . . pictorial or other graphical data that may be printed or otherwise

provided on the shoe.” (¶ 33.) Moreover, Paul explains that “[s]ome of the custom designs may be afforded a special status or prize” and “[t]he selected design may win prizes, entry to events, chances to meet a celebrity or famous athlete, or the custom-designed footwear may be manufactured and sold.” (¶ 83.) Because Paul explains that footwear custom designs can be printed, Paul teaches the limitation “manufacturing the one or more customizable products as customized based on the selection of customization features by printing at least one customized element such that the at least one customized element is incorporated into the selected one or more customizable products.”

Appellants argue that “Paul does not disclose, teach, or suggest manufacturing customizable products by printing at least one customized element such that the at least one customized element is incorporated into the selected customizable products.” (App. Br. 19 (emphasis omitted).) Contrary to Appellants’ arguments, Paul explains that “[a]ny desired type of footwear design data may be controlled, altered, or customized by a user of systems and methods according to this invention, such as . . . pictorial or other graphical data that may be printed or otherwise provided on the shoe.” (¶ 33.)

Appellants further argue that “Weiss discusses electronically capturing consumer location data for analyzing consumer behavior and makes passing references to servers with printers, but no reference to 3D printing materials, much less products in the manner claimed.” (Reply Br. 5.) However, the Examiner cited to Paul, rather than Weiss, for teaching the limitation “customization features by printing at least one customized

element such that the at least one customized element is incorporated into the selected one or more customizable products.” (Ans. 29–30.)

Thus, we agree with the Examiner that the combination of Fields and Paul would have rendered obvious independent claim 1, which includes the limitation “manufacturing the one or more customizable products as customized based on the selection of customization features by printing at least one customized element such that the at least one customized element is incorporated into the selected one or more customizable products.”

Accordingly, we sustain the rejection of independent claim 1 under 35 U.S.C. § 103(a). Claims 7 and 8 depend from claim 1, and Appellants have not presented any additional substantive arguments with respect to these claims. Therefore, we sustain the rejection of claims 7 and 8 under 35 U.S.C. § 103(a), for the same reasons discussed with respect to independent claim 1.

Independent claims 13 and 18 recite limitations similar to those discussed with respect to independent claim 1, and Appellants have not presented any additional substantive arguments with respect to these claims. Accordingly, we sustain the rejection of claims 13 and 18, as well as dependent claims 14, 15, 17, and 19 for the same reasons discussed with respect to claim 1.

DECISION

The Examiner’s decision rejecting claims 1–4, 7, 8, 13–15, and 17–21 under 35 U.S.C. § 101 is reversed.

The Examiner’s decision rejecting claims 1–4, 7, 8, 13–15, and 17–21 under 35 U.S.C. § 103(a) is affirmed.

Appeal 2018-002310
Application 13/340,870

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