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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ADAM HIATT, JOHN PAUL SHAY,
YANN SCHWERMER, and BEN YACO

Appeal 2018-002512
Application 14/206,569
Technology Center 3600

Before STEFAN STAICOVICI, BENJAMIN D. M. WOOD, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s decision in the Final Office Action (dated January 25, 2017, hereinafter “Final Act.”) rejecting claims 1–13, 15–28, and 30–32.² We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Reso Holdings, Inc. is identified as the real party in interest in Appellant’s Appeal Brief (filed July 24, 2017, hereinafter “Appeal Br.”). Appeal Br. 2.

² Claims 14 and 29 are canceled. *See* Appeal Br. 42, 49 (Claims App.).

SUMMARY OF DECISION

We AFFIRM and enter a NEW GROUND of REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

INVENTION

Appellant's invention is directed "to a system and method for automated reservation management." Spec. para. 1.

Claims 1 and 16 are independent. Claim 16 is illustrative of the claimed invention and is reproduced below (with reference indicators added in brackets):

16. A method for facilitating booking of service events based on a previous vendor location, the method being implemented in a computer system comprising one or more physical processors executing one or more computer program instructions which, when executed, perform the method, the method comprising:

[i] receiving, at the one or more physical processors, a user request for a service event of a first service event type for a user;

[ii] determining, by the one or more physical processors, a location of a previous vendor that provided a previous service event for the user;

[iii] selecting, by the one or more physical processors, based on the location of the previous vendor, a vendor to provide a first service event of the first service event type for the user such that the selected vendor is at a location within a predetermined proximity threshold from the location of the previous vendor;

[iv] determining, by the one or more physical processors, scheduling information for the first service event based on a first calendar associated with the user and a second calendar associated with the selected vendor, wherein the scheduling information comprises at least one of a date for the first service event or a time for the first service event;

- [v] determining, by the one or more physical processors, a reservation for the first service event with the selected vendor based on the scheduling information;
- [vi] providing, by the one or more physical processors, to the user, a request to accept the reservation;
- [vii] responsive to the user accepting the reservation:
- [viii] adding, by the one or more physical processors, information about the reservation to the first calendar;
- [ix] associating, by the one or more physical processors, first payment information with the reservation for execution of payment upon completion of the first service event; and
- [x] adding, by the one or more physical processors, information about the reservation to the second calendar;
- [xi] receiving, by the one or more physical processors, from the vendor, an indication that the first service event is completed;
- [xii] executing, by the one or more physical processors, payment for the first service event based on the completeness indication and the first payment information;
- [xiii] obtaining, by the one or more physical processors, an indication from the user that the first service event should be automatically re-booked;
- [xiv] predicting, by the one or more physical processors, at least one of a next date or a next time at which the re-book the first service event responsive to the obtained indication from the user that the first service event should be automatically re-booked; and
- [xv] determining, by the one or more physical processors, a second reservation for the re-booked first service event based on at least one of the predicted next date or the predicted next time.

REJECTIONS

- I. The Examiner rejects claims 1–13, 15–28, and 30–32 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

- II. The Examiner provisionally rejects claims 1–13, 15–28, and 30–32 on the ground of non-statutory double patenting as being unpatentable over claims 1–20 and 31–34 of copending US Application No. 14/206,502.
- III. The Examiner rejects claims 1, 4–9, 12, 16, 19–24, 27, and 32 under 35 U.S.C. § 103 as being unpatentable over Norton,³ Katz,⁴ Niessen,⁵ and Behrens.⁶
- IV. The Examiner rejects claims 2, 3, 17, and 18 under 35 U.S.C. § 103 as being unpatentable over Norton, Katz, Niessen, Behrens, and Hirka.⁷
- V. The Examiner rejects claims 10, 11, 13, 25, 26, and 28 under 35 U.S.C. § 103 as being unpatentable over Norton, Katz, Niessen, Behrens, and Tavakoli.⁸
- VI. The Examiner rejects claims 15 and 30 under 35 U.S.C. § 103 as being unpatentable over Norton, Katz, Niessen, Behrens, Hirka, and Giordano.⁹
- VII. The Examiner rejects claim 31 under 35 U.S.C. § 103 as being unpatentable over Norton, Katz, Niessen, Behrens, and Srimuang.¹⁰

³ Norton et al., US 2014/0108121 A1, published Apr. 17, 2014.

⁴ Katz, US 2007/0083400 A1, published Apr. 12, 2007.

⁵ Niessen et al., US 2008/0154654 A1, published June 26, 2008.

⁶ Behrens et al., US 2010/0191552 A1, published July 29, 2010.

⁷ Hirka et al., US 2011/0127324 A1, published June 2, 2011.

⁸ Tavakoli et al., US 2014/0052613 A1, published Feb. 20, 2014.

⁹ Giordano et al., US 2002/0152123 A1, published Oct. 17, 2002.

¹⁰ Srimuang, US 2003/0061087 A1, published Mar. 27, 2003.

ANALYSIS

Rejection I

Section 101 states, “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. However, the Supreme Court has “long held that this provision contains an important implicit exception: “[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*. See *Alice*, 573 U.S. 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.” *Id.* 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, 679 (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

Appeal 2018-002512
Application 14/206,569

(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))).

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 (quotation marks 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.* ((alteration in the original) 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 has published revised guidance on the application of § 101. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (hereinafter “2019 Guidance”). Under Step 2A of 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)).

Appeal 2018-002512
Application 14/206,569

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look, in Step 2B, to whether the claim:

(3) adds a specific limitation beyond the judicial exception that is 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.

Appellant does not present separate arguments for the patentability of independent claims 1 and 16. *See* Appeal Br. 9–26. Therefore, the following analysis applies equally to both independent claims 1 and 16.

Claims 1 and 16

Step 1 – Statutory Category

We first determine whether independent claims 1 and 16 recite one or more of the enumerated statutory classes of subject matter, i.e., process, machine, manufacture, or composition of matter, eligible for patenting under 35 U.S.C. § 101. Here, independent claims 1 and 16 recite a service booking system (i.e., a “machine”) and a service booking method (i.e., a “process”), respectively. *See* Appeal Br. 38, 44 (Claims App.). Thus, we agree with Appellant that independent claims 1 and 16 recite recognized statutory categories under 35 U.S.C. § 101. *See id.* at 9.

Step 2A, Prong 1 – Recitation of Judicial Exception

We next look to whether independent claims 1 and 16 recite any judicial exceptions, including certain groupings of abstract ideas, i.e.,

Appeal 2018-002512
Application 14/206,569

mathematical concepts, certain methods of organizing human activity, or mental processes.

In determining that independent claims 1 and 16 are directed to a judicial exception to patent eligibility, the Examiner determines that the claims recite “the abstract idea of booking service events for a user based on various criteria including a previous time and location . . . which is a method of organizing human activities (because it purports to manage and plan the future undertakings and calendar scheduling of persons) involving basic economic principles (e.g., scheduling services, executing payment transaction[s]).” Final Act. 4–5. The Examiner explains that claims 1 and 16 are similar to the claims held ineligible in *In re Maucorps*, 609 F. 2d 481 (CCPA 1979), *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1371 (Fed. Cir. 2015), and *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016). *Id.* at 5.

In response, Appellant asserts that “the Examiner has not analyzed the claims’ character as a whole, and has made a high level abstraction of the claims, untethered from their actual language.” Appeal Br. 10 (citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016)). According to Appellant, “[t]he character of the claims, as a whole, is not directed to, nor recites, excluded subject matter, but is instead directed to a concept inextricably tied to *computer technology* and distinct from the types of concepts found to be abstract.” *Id.* (emphasis added).

We agree with the Examiner that independent claims 1 and 16 “merely describe[] abstract efforts to *plan human activities and commercial*

Appeal 2018-002512
Application 14/206,569

relationships with service providers.” Ans. 4 (emphasis added).^{11, 12} Such a description is consistent with The 2019 Guidance, which describes “[c]ertain methods of organizing human activity” in terms of “commercial or legal interactions.” 2019 Guidance 52; *see also* October 2019 Update: Subject Matter Eligibility (“2019 Update”) 4–5. The 2019 Update further describes “commercial or legal interactions” to include “subject matter relating to agreements in the form of contracts, legal obligations, advertising, marketing or sales activities or behaviors, and business relations.” 2019 Update at 5. Here, booking (scheduling) a vendor to perform a service event, paying the vendor for performing the service event, and re-booking the vendor for a future date/time, as per independent claims 1 and 16, requires forming a commercial interaction in terms of, at least, business relations between the user and the vendor, which in turn require at least contracts and legal obligations. As such, the Examiner is correct that “event scheduling and management . . . is an abstract commercial endeavor that seeks to organize future activities of human beings.” Ans. 6.

We further note that absent the use of the claimed “physical processors,” i.e., computer, the Examiner is correct that “[t]here is no reason . . . why a human could not *mentally* manage service events in the manner recited.” Ans. 5 (emphasis added). A claim recites a mental process when

¹¹ Examiner’s Answer, dated Nov. 9, 2017.

¹² Although we appreciate that independent claim 1 is drawn to a system, as claims 1 and 16 recite similar limitations, “the basic character of a process claim drawn to an abstract idea is not changed by claiming only its performance by computers, or by claiming the process embodied in program instructions on a computer readable medium.” *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375–76 (Fed. Cir. 2011) (citing *In re Abele*, 684 F.2d 902 (CCPA 1982)).

Appeal 2018-002512
Application 14/206,569

the claim encompasses acts people can perform using their minds or pen and paper. *See, e.g., CyberSource*, 654 F.3d at 1372–73 (determining that a claim whose “steps can be performed in the human mind, or by a human using a pen and paper” is directed to an unpatentable mental process). This is true even if the claim recites that a generic computer component, i.e., “physical processors,” performs the acts. *See, e.g., Versata Development Group, Inc. v. SAP America, Inc.*, 793 F.3d 1306, 1335 (Fed. Cir. 2015) (“[C]ourts have examined claims that required the use of a computer and still found that the underlying, patent-ineligible invention could be performed via pen and paper or in a person’s mind.”); *see also* 2019 Guidance 52 n.14 (“If a claim, under its broadest reasonable interpretation, covers performance in the mind but for the recitation of generic computer components, then it is still in the mental processes category unless the claim cannot practically be performed in the mind.”).

Accordingly, we do not agree with Appellant’s position that “the subjective approach [of a user] that would be used mentally is different than the claimed method” because it is based on “the user’s prior experiences rather than an automatic selection by a computer.” Reply Br. 8.¹³ For example, a person (i.e., user) can book (i.e., schedule) a service event with a vendor by performing the recited steps of claim 16 as follows: (a) manually using a map to select a vendor located in proximity to the location of a previous vendor (limitations [i]–[iii] of claim 16); (b) mentally coordinating user and vendor calendars to determine a first reservation date and/or time (limitations [iv]–[viii] and [x] of claim 16); manually paying the vendor upon performing the service event (limitations [ix], [xi], and [xii] of claim

¹³ Appellant’s Reply Brief, filed Jan. 9, 2018.

16); and mentally predicting a future date/time when to re-book the vendor to perform the service event (limitations [xiii]–[xv] of claim 16).¹⁴ Thus, the Examiner is correct that “a person can easily compare their personal calendar and the calendar of the service provider and predict a need for re-booking a reservation, as well as payment schedule.” Ans. 5; Reply Br. 7; *see also Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (explaining that the Federal Circuit has “treated analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category” and determining that the claims at issue involve such steps).

As such, we have considered each of the specific limitations of independent claim 1 and 16, and each claim represents mere instructions that customers (users) can perform using their minds or pen and paper to book a vendor to perform a service event based on the calendars of the vendor and the user, pay the vendor for the service, and re-book the vendor to perform the same service at a future date and/or time. Appellant does not present any persuasive argument or evidence that the steps of claim 1 and 16 cannot be performed practically in the human mind using pen (or pencil) and paper.

Accordingly, for the foregoing reasons, because we determine that independent claims 1 and 16 recite certain methods of organizing human activity and mental processes that can be performed practically in the human mind using pen (or pencil) and paper, we conclude that claims 1 and 16 recite an abstract idea, and, thus, we proceed to Prong 2 of Step 2A.

¹⁴ We note claim 1 includes similar limitations and, thus, the system of claim 1 can perform the recited steps. *See also* footnote 13.

Step 2A, Prong 2 – Integrated Into a Practical Application

If a claim recites a judicial exception, then, in *Prong 2*, we determine whether the recited judicial exception is integrated into a practical application of that exception by: (a) identifying whether there are any additional elements recited in the claim *beyond the judicial exception(s)*; and (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application. *See* 2019 Guidance 54–55. This evaluation requires an additional element or a combination of additional elements in the claim to apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the exception. *See id.* at 54.

Appellant contends that “the character of the claims as a whole, in light of the Specification, is directed to various features and functionality afforded by a comprehensive computer platform that provides a *technical solution* for managing a list of service events . . . for a user.” Appeal Br. 11 (emphasis added). According to Appellant, the functionality of automatically selecting a vendor located in proximity to the location of a previous vendor, as per limitation [iii] of claim 16, and predicting a future date and/or time to re-book the vendor, as per limitation [xiv] of claim 16, “represents a technological improvement in *computer intelligence* by providing the ability to identify vendors of interest and re-booking times/dates even if not specified by the user.” *Id.* at 12–13 (emphasis added). Appellant further asserts that claims 1 and 16 are distinguishable

Appeal 2018-002512
Application 14/206,569

from the claims in *In re Maucorps, Intellectual Ventures I LLC*, and *Fairwarning IP, LLC*. *Id.* at 11–16. In addition, Appellant contends that claims 1 and 16 are patent-eligible under *McRO, Inc. v. Bandai Namco Games Amer. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016) and *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014). *Id.* at 16–21; Reply Br. 7–9.

We are not persuaded by Appellant’s arguments regarding the claims in *In re Maucorps, Intellectual Ventures I LLC*, and *Fairwarning IP, LLC* because we discern nothing in either of claims 1 or 16 that improves functionality of a computer, i.e., “computer intelligence.” The Specification makes clear that the “physical processors” recited in claims 1 and 16 are generic computing components, which do not invoke particular hardware or software and are described by their function, i.e., “processors that are configured to execute computer program components.” *See Spec. paras.* 145–146, 151 (“processor 102 may include one or more of a digital processor, an analog processor, a digital circuit designed to process information, an analog circuit designed to process information, a state machine, and/or other mechanisms for electronically processing information.”).

In particular, we note that the “technological improvement in computer intelligence” that Appellant alludes to, namely, limitations [iii] and [iv] of claim 16, in fact, recite a result without specifying a way of achieving the result. *See SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1167 (Fed. Cir. 2018) (Eligible “claims . . . transform[ed] a claim from one claiming only a result to one claiming a way of achieving it.”). At most, claims 1 and 16 improve the user (customer) experience, and, thus, the recited features are not problems that are unique or limited to computer

Appeal 2018-002512
Application 14/206,569

environments. *See* Spec. para. 3–4 (the claimed invention overcomes drawbacks of conventional reservation tools). In other words, although each of claims 1 and 16 is implemented using a computer and specific computer operations and structures, these specifics of the claimed invention find direct analogs in a manual implementation, as discussed *supra*. *See Trading Techs. Int’l, Inc. v. IBG LLC*, 921 F. 3d 1084, 1090 (Fed. Cir. 2019) (“This invention makes the *trader* faster and more efficient, not the computer. This is not a technical solution to a technical problem.”).

We also do not agree with Appellant’s reliance on *McRO* and *DDR Holdings*. In contrast to *McRO*, Appellant does not identify specific rules that act in the same way as the specific rules enabling the computer in *McRO* to generate the result of a sequence of animated characters. *McRO*, 837 F.3d at 1313–16. In other words, here, we have none of the claimed specificity of technological improvement the Federal Circuit found present in the invention of *McRO*. As to *DDR Holdings*, the claims involved web-page displays with “at least one active link associated with a commerce object associated with a buying opportunity of a selected one of a plurality of merchants.” *DDR Holdings*, 773 F. 3d at 1249. Here, as discussed *supra*, the problem of booking (scheduling) a vendor to perform a service event, paying the vendor for performing the service event, and re-booking the vendor for a future date/time, as per independent claims 1 and 16, does not specifically arise from a technology, such as computers or computer networks. Hence, neither *McRO* nor *DDR Holdings* applies here because as the Examiner correctly notes, “[t]he claims only manipulate abstract data elements” and “do not present improvements to another technological field or the functioning of the computer itself.” Ans. 5.

As such, for the foregoing reasons, claims 1 and 16 use the ordinary capabilities of a computer to *automate* what can be done by a user (customer). This is not enough to integrate the underlying abstract idea into a practical application, as “relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.” *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015). We agree with the Examiner that the recited “claims merely use computers in a routine fashion to implement the abstract process.” Ans. 6 (citing *Smart Systems Innovations v. Chicago Transit Authority*, 873 F.3d 1364, 1372–73 (Fed. Cir. 2017)) (“The claims are not directed to a combined order of specific rules that improve any technological process, but rather invoke computers in the collection and arrangement of data. Claims with such character do not escape the abstract idea exception under Alice step one.”); *see also* Reply Br. 6.

Thus, we determine that the recited “additional element[s] merely recite[] the words ‘apply if (or an equivalent) with the judicial exception, or merely includes instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea.’” 2019 Guidance 55. Accordingly, Appellant’s claims 1 and 16:

- (1) do not improve the functioning of a computer or other technology;
 - (2) are not applied with any particular machine;
 - (3) do not affect a transformation of a particular article to a different state;
 - (4) do not add more than insignificant extra-solution activity; and
 - (5) are not applied in any meaningful way beyond generally linking the use of the judicial exception to a particular technological environment.
- See* MPEP § 2106.05(a)–(c), (f), (g).

Lastly, Appellant argues that claims 1 and 16 “do not tie up an idea of booking service events.” *See* Reply Br. 3; Appeal Br. 17. We are not persuaded by such an argument because although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). “Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo*[/*Alice*] framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Id.*

In conclusion, we are not persuaded of error in the Examiner’s determination that claims 1 and 16 are directed to an abstract idea, and we find that the claimed additional elements do not integrate the abstract idea into a practical application.

Step 2B – Well-Understood, Routine, Conventional Activity

Having determined that claims 1 and 16 recite a judicial exception, and do not integrate that exception into a practical application, under *Step 2B* we consider whether the claim adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field. *See* 2019 Guidance 56.

The Examiner finds that “[t]he claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because there are no meaningful limitations that transform the exception into a patent eligible application.” Final Act. 5. According to the Examiner, “[l]ooking at the limitations as an ordered combination adds nothing that is not already present when looking at the elements taken individually.” *Id.*

Appeal 2018-002512
Application 14/206,569

In response, Appellant argues that similar to the claims in *Bascom Global Internet Serv., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), “the instant claims recite significantly more than an alleged abstract idea,” i.e., “booking service events for a user.” Appeal Br. 21–22. According to Appellant, “the ordered combination of features” constitutes “a technological improvement in computer intelligence to be able to identify vendors of interest and re-booking times/dates even if not specified by the user.” *Id.* at 22 (citing limitations from claim 1 that correspond to limitations [iii] and [xiv] from claim 16). Appellant further contends that like the claims in *Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F. 3d 1288, 1291, 1300–01 (Fed. Cir. 2016), “the instant claims are tied to the particular architecture described in the instant [S]pecification,” namely, “the architecture of computer system 100 and the architecture of its interaction with client computing devices 30 and vendor computing devices 40.” Appeal Br. 23–24. Thus, Appellant asserts that the features recited by each of independent claims 1 and 16 “individually or in combination, do not comprise well-understood, routine, and conventional activities of a computer previously known to the industry for at least the reason that the foregoing features recited by the claims are not a mere conventional use of traditional computer functionality.” *Id.* at 26 (emphasis omitted).

We are not persuaded that the Examiner erred in determining that the elements of claims 1 and 16, considered both individually and as an ordered combination, do not amount to significantly more than the abstract idea itself. Ans. 7. As discussed *supra*, booking (scheduling) a vendor to perform a service event, paying the vendor for performing the service event, and re-booking the vendor for a future date/time, as per independent claims 1 and 16, “do not present improvements to another technological field or the

Appeal 2018-002512
Application 14/206,569

functioning of the computer itself.” *Id.* Rather, such features represent “implement[ing] the abstract service event planning functionality on a generic processor.” *Id.*

We further agree with the Examiner that neither *Bascom* nor *Amdocs* “controls the analysis of Appellant’s claims, as the arguments do not establish that the [claimed] invention contains similar non-conventional elements.” *Id.* at 8. The Examiner is correct that “[n]o particular network architecture is claimed,” and moreover, “[t]he only element other than the abstract idea in the claims is the generic processor on which it is executed, which is used for routine and conventional activities (e.g., storing, retrieving, transmitting data).” *Id.* In particular, Appellant’s Specification describes computer system 100 as “a server, a desktop computer, a laptop computer, a personal digital assistant, smart phone, and/or any other computing device”; client computing device 30 as “a desktop computer, a laptop computer, a handheld computer, a tablet computing platform, a Netbook, a Smartphone, a gaming console, and/or other computing platforms”; and vendor computing device 40 as “a desktop computer, a laptop computer, a handheld computer, a tablet computing platform, a Netbook, a Smartphone, a gaming console, and/or other computing platforms.” Spec. paras. 144–146. As such, we do not agree with Appellant that “the claimed network architecture is unconventional at least in that it includes an improved computer that communicates with both a vendor’s computer system and a user’s computer system” because communication between computer systems is a conventional use of computer networks. Reply Br. 10.

Furthermore, the features Appellant refers to as unconventional (*see* Appeal Br. 22¹⁵, 25–26¹⁶) merely recite the identified judicial exception discussed above; these limitations are not “additional elements individually and in combination” that may “provide an inventive concept” amounting to “significantly more than the exception itself.” 2019 Guidance 55–56. Accordingly, claims 1 and 16 fail to add a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field, and, thus, fail to indicate the presence of an inventive concept. Therefore, we conclude that none of the limitations of claims 1 and 16, viewed “both individually and as an ordered combination,” amount to significantly more than the judicial exception in order to sufficiently transform the nature of the claims into patent-eligible subject matter. *See Alice*, 134 S.Ct. at 2355 (internal quotations omitted) (quoting *Mayo*, 132 S.Ct. at 1297).

Accordingly, for the foregoing reasons, we sustain the rejection of claims 1 and 16 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

Claims 2–13, 15, 17–28, and 30–32

Appellant argues that “the rejection of dependent claims 2-13, 15, 17-28, and 30-32 under § 101 . . . is improper because the Examiner improperly rejects the dependent claims without individually addressing each and every one of their recited features.” Appeal Br. 27; Reply Br. 10. Appellant

¹⁵ Citing limitations from claim 1 that are similar to limitations [iii] and [iv] of claim 16.

¹⁶ Citing limitations from claim 1 that are similar to limitations [ii], [iii], and [xi]–[xv] of claim 16.

Appeal 2018-002512
Application 14/206,569

explains that “the Examiner has not provided an explanation as to why *each* claim is unpatentable sufficient to establish a *prima facie* case with respect to the subject-matter eligibility analysis.” *Id.* (emphasis added). According to Appellant, “[e]very claim must be examined individually’ and ‘the eligibility of each claim should be evaluated as a whole.” *Id.* at 28 (emphasis omitted).

Although we appreciate that the Examiner has not written a separate rejection for each dependent claims, nonetheless, the Examiner did consider *each* claim when finding that “[t]he limitations of the dependent claims merely set forth further refinements of the abstract idea (e.g., making and paying for a second service event-claim 2, designating payment information-claim 3, etc.)” Final Act. 5.

Hence, adding narrowing limitations, as per dependent claims 2–13, 15, 17–28, and 30–32, that are themselves abstract, does not suffice to transform the claimed abstract idea into patent-eligible subject matter, and, thus, add *nothing beyond* the abstract idea set forth in independent claims 1 and 16, from which these claims depend, respectively. Therefore, we agree with the Examiner that “the limitations of the dependent claims merely further refine aspects of the abstract idea without adding significantly more.” Ans. 8. Accordingly, dependent claims 2–13, 15, 17–28, and 30–32 fail to survive Step 2A, Prong 2, and, for the same reasons, fail to survive Step 2B.

As Appellant provides no substantive explanation as to why any of dependent claims 2–13, 15, 17–28, and 30–32 recites something significantly more than the abstract idea recited in their respective independent claims, dependent claims 2–13, 15, 17–28, and 30–32 are likewise patent-ineligible.

Rejection II

We do not reach the merits of the Examiner’s *provisional* double patenting rejection because it would be premature to do so at this time, consistent with the holding of *Ex Parte Moncla*, 95 USPQ2d 1884, 1885 (BPAI 2010) (precedential). Moreover, Appellant represents that a terminal disclaimer will be provided when the application underlying this appeal is in condition for allowance. *See* Amendment 22 (“Applicant will consider filing a Terminal Disclaimer once all remaining rejections are withdrawn.”).¹⁷

Rejection III

Claims 1 and 16

Appellant does not present separate arguments for the patentability of independent claims 1 and 16. *See* Appeal Br. 28–33. Therefore, the following analysis applies equally to both independent claims 1 and 16.

Appellant argues that the Examiner arrived at the rejection by employing impermissible hindsight in “selectively picking and choosing from among the . . . disclosures of Norton, Katz, Niessen, and Behrens.” Appeal Br. 28; Reply Br. 11.

We are not persuaded by Appellant’s argument because the Examiner has provided a sufficient reasoning with rational underpinning to combine the teachings of Norton, Katz, Niessen, and Behrens. *See* Final Act. 7–8; *see also In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds [require] some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”) (*cited with*

¹⁷ Appellant’s Amendment, filed Oct. 28, 2016.

Appeal 2018-002512
Application 14/206,569

approval in KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007)). In particular, the Examiner determined that it would have been obvious for a person of ordinary skill in the art to modify the system and process of Norton with (1) Katz “to ensure payment only occurs for actually provided services”; (2) Niessen “to determine potential services from nearby vendors on past similar services the user has already purchased”; and (3) Behrens “to make the system more intelligent when determining the user’s future service needs.” *See* Final Act. 7–8. Appellant has not persuasively argued that the Examiner’s conclusion lacks rational underpinning.

Appellant also argues that the Examiner’s reliance on Niessen to disclose “selecting a vendor (to provide a first service event of the first service event type for the user) at a location within a predetermined proximity threshold from the location of the previous vendor” is misplaced. Appeal Br. 29 (citing Niessen, paras. 87, 103, 104). Rather, Appellant contends, Niessen “relate[s] to a concentric circles algorithm used to identify consumers ---not vendors--- to whom targeted offers may be made.” *Id.*

We are not persuaded by Appellant’s arguments because we agree with the Examiner that Niessen discloses competing merchants, i.e., vendors, located in proximity to each other, and a customer, i.e., user, having the option of selecting between first and second companies (vendors) that provide a similar service, wherein the second company is located in proximity to the first company. Ans. 9 (citing Niessen, paras. 87, 103). We also do not agree with Appellant’s argument that nothing in Niessen “teaches or motivates one” to combine its teachings with Norton’s “user selection” search results (*see* Reply Br. 12) because such an argument appears to be holding the Examiner to the old TSM standard; such a standard is not required. *KSR*, 550 U.S. at 415.

Appellant further contends that Behrens fails to disclose determining a second reservation based on a predicted date or time determined in response to a user indicating that the service should be automatically re-booked. *See* Appeal Br. 32–33 (citing Behrens, paras. 91, 112–114, 230). According to Appellant, “Behrens generally relate[s] to optimizations used to increase the *likelihood* that an appointment offered in an appointment availability placement will be booked by a user” based upon “referenc[ing] historical usage patterns and tracking, and even offering services if some amount of time has passed since a user last booked a recurring service.” *Id.* at 33; Reply Br. 13–15.

We are not persuaded by Appellant’s arguments because nonobviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. [Each reference] must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole.” *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). In this case, Norton discloses determining a second reservation based on a date or time determined in response to a user indicating that the service should be automatically re-booked. *See* Norton, paras. 57, 72 (recurrence rules 508 determine the date or time of the second reservation). Behrens discloses determining a particular date or time to provide an appointment to a user based on the user’s historical information, such as the user’s pattern of booking appointments at particular times or the amount of time passed since the user last booked a recurrent service. *See* Behrens, paras. 91, 112, 113. In other words, based on a user’s historical information of booking an appointment, Behrens *predicts* when to book a future appointment. Thus, we agree with the Examiner that the combined teachings of Norton and

Appeal 2018-002512
Application 14/206,569

Behrens disclose “determin[ing] the second reservation for the re-booked first service event is based on at least one of the *predicted* next date or the *predicted* next time.” Final Act. 8 (emphasis added). Moreover, the Examiner is correct that Appellant does not adequately explain why Behrens’ disclosure of booking a future appointment based on the amount of time passed since the user last booked a recurrent service does not constitute *predicting* when to book a future appointment. Ans. 10.

In conclusion, for the foregoing reasons, we sustain the rejection under 35 U.S.C. § 103 of claims 1 and 16 as unpatentable over Norton, Katz, Niessen, and Behrens.

Claims 4–6, 8, 9, 12, 19–21, 23, 24, 27, and 32

In regards to the rejection of claims 8, 9, 12, 23, 24, 27, and 32, Appellant relies on the same unpersuasive arguments discussed above in the rejection of claims 1 and 16, from which these claims depend, respectively. *See* Appeal Br. 33–34.

In particular to the rejection of claims 4–6 and 19–21, in addition to reciting the limitations of dependent claim 4 (*see id.* at 34), Appellant makes the same arguments discussed above regarding the teachings of Niessen. *See id.* at 35; Reply Br. 12–13. We are not persuaded by Appellant’s argument for the same reasons discussed above in the rejection of claims 1 and 16. Moreover, we note that merely pointing out what a claim recites will not be considered an argument for separate patentability of the claim. *See In re Lovin*, 99 USPQ2d 1373, 1379 (Fed. Cir. 2011) (holding that the Board had reasonably interpreted 37 C.F.R. § 41.37(c)(1)(vii) as requiring “more substantive arguments in an appeal brief than a mere recitation of the

Appeal 2018-002512
Application 14/206,569

claim elements and a naked assertion that the corresponding elements were not found in the prior art”).

Accordingly, for the foregoing reasons, we sustain the rejection under 35 U.S.C. § 103 of claims 4–6, 8, 9, 12, 19–21, 23, 24, 27, and 32 as unpatentable over Norton, Katz, Niessen, and Behrens.

Claims 7 and 22

The Examiner finds that paragraphs 112–114 and 125 of Behrens disclose the limitations of claims 7 and 22. *See* Final Act. 9–11.

In response, Appellant recites the limitations of claim 7 (*see* Appeal Br. 35–36), and argues that “none of the relied-upon passages of Behrens teach the *particular* claimed manner by which scheduling information is determined.” *Id.* at 36 (emphasis added).¹⁸ Thus, According to Appellant, claims 7 and 22 “set forth a particular manner by which scheduling information is determined.” *Id.*

We appreciate that Behrens discloses determining, i.e., predicting, a future particular date or time to provide an appointment to a user based on the user’s historical information, such as, the user’s pattern of booking appointments at particular times or the amount of time passed since the user last booked a recurrent service and updating historical usage tracking. *See* Behrens, paras. 112, 113, 125. However, we could not find any portion of Behrens, and the Examiner has not pointed to any portion, that discloses determining scheduling information based on a time interval between service events, wherein the time interval is based upon first and second amounts of

¹⁸ We note that claims 7 and 22 recite similar limitations. *Compare* Appeal Br. 41 *with*, Appeal Br. 48.

Appeal 2018-002512
Application 14/206,569

time between previous successive service events. The Examiner has not sufficiently explained how employing Behrens' updating of historical usage results in the specific scheduling procedure of claims 7 and 22. In particular, the Examiner's response that Appellant's arguments "rely on the same reasoning" is insufficient to explain how Behrens' disclosure of scheduling an appointment based on "the amount of time since a user has booked a service that is identified as recurring" is the same as scheduling an appointment based on a time interval between successive service events.
Ans. 10.

Accordingly, for the foregoing reasons, we do not sustain the rejection of claims 7 and 22 over the combined teachings of Norton, Katz, Niessen, and Behrens.

Rejections IV–VII

Appellant relies on the arguments discussed *supra* in the rejection of claims 1 and 16. *See* Appeal Br. 34. Therefore, for the same reasons discussed above, we also sustain Rejections IV–VIII.

NEW GROUND OF REJECTION

Claims 7 and 22 are rejected under 35 U.S.C. § 103 as being unpatentable over Norton, Katz, Niessen, Behrens, and Elwell.¹⁹

We adopt the Examiner's findings regarding the disclosures of Norton, Katz, Niessen, and Behrens, and reasoning to combine their teachings, as pertaining to the rejection of claims 1 and 16, from which claims 7 and 22 depend. *See* Final Act. 6–9. However, we do not adopt the

¹⁹ Elwell et al., US 8,930,820 B1, issued Jan. 6, 2015.

Examiner’s findings regarding the disclosure of Behrens and reasoning to combine the teachings of Norton, Katz, Niessen, and Behrens as pertaining to the rejection of claims 7 and 22. *See id.* at 9–10 (citing Behrens, paras. 112–114, 125).

Nonetheless, Elwell discloses identifying the date or time of two or more events or transactions between a user and a vendor and determining a frequency of events or transactions (determine first and second amounts of time) as a time difference between the events or transactions. *See* Elwell, col. 4, l. 60–col. 5, l. 2; col. 5, l. 59–col. 6, l. 2. Elwell further discloses calculating the frequency as an *average* time difference between the events or transactions (time interval based on first and second amounts of time)²⁰ and scheduling a recurring event or transaction by adding the frequency to the date or time of the last event or transaction (determining scheduling information). *See id.*, col. 5, l. 67–col. 6, l. 7, col. 6, ll. 36–46, Abstract. Thus, it would have been obvious for a person of ordinary skill in the art to employ Elwell’s scheduling procedure in the process and system of Norton, as modified by Katz, Niessen, and Behrens, in order to “identify periodic or recurring dates based on previously attended events” or transactions. *See id.*, col. 6, ll. 38–40.

DECISION SUMMARY:

In summary:

Claims	35 U.S.C. §	Reference(s)/	Affirmed	Reversed	New
Rejected		Basis			Ground

²⁰ Appellant’s Specification likewise describes the “time interval” as an “*average* number of days between . . . service events.” Spec. para. 57 (emphasis added).

Appeal 2018-002512
 Application 14/206,569

1–13, 15–28, 30–32	101	Patent-ineligible subject matter	1–13, 15–28, 30–32		
1, 4–9, 12, 16, 19–24, 27, 32	103	Norton, Katz, Niessen, Behrens	1, 4–6, 8, 9, 12, 16, 19–21, 23, 24, 27, 32	7, 22	
2, 3, 17, 18	103	Norton, Katz, Niessen, Behrens, Hirka	2, 3, 17, 18		
10, 11, 13, 25, 26, 28	103	Norton, Katz, Niessen, Behrens, Tavakoli	10, 11, 13, 25, 26, 28		
15, 30	103	Norton, Katz, Niessen, Behrens, Hirka, Giordano	15, 30		
31	103	Norton, Katz, Niessen, Behrens, Srimuang	31		
7, 22	103	Norton, Katz, Niessen, Behrens, Elwell			7, 22
Overall outcome			1–13, 15–28, 30–32	7, 22	7, 22

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both,

Appeal 2018-002512
Application 14/206,569

and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. . . .

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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. § 1.136(a)(1)(iv).

AFFIRMED; 37 C.F.R. § 41.50(b)