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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KENTON ABEL

Appeal 2018-002666
Application 13/049,873
Technology Center 3600

Before ADAM J. PYONIN, MICHAEL J. ENGLE, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

PYONIN, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's rejection. An oral hearing was held on February 11, 2020. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as the inventor, Kenton Abel. Appeal Br. 3.

STATEMENT OF THE CASE

Introduction

The Application is directed to generating a mailer that “allows for a user to send and receive physical letters and/or goods to another user without divulging personal information.” Spec. ¶ 5. Claims 1–3 are pending.

Appeal Br. 5. Claim 1, the sole independent claim, is reproduced below for reference (emphasis, bracketed lettering, and some formatting added):

1. A method for generating a mailer, comprising:
 - a) a system comprising a computer open to receiving electronic communications from a plurality of sending users and a plurality of receiving users, b) a database within the system for storing personal information of each of the plurality of receiving users, wherein the personal information comprises a physical mailing address,
 - c) receiving an electronic communication from a sending user for initiating a mailer demand for a receiving user,
 - d) performing in any order, using the computer system:
 - i) sending user inputting sufficient information to uniquely identify a receiving user;
 - ii) checking for permissions in the database for the initiated mailer demand to use the receiving user’s physical mailing address;
 - iii) sending user inputting sufficient information to generate a mailer;
 - e) combining sending user’s information with receiving user’s physical mailing address to form a completed mailer demand,
 - f) physically generating the mailer according to the mailer demand,
 - g) physically delivering the mailer to a postal authority with sufficient postage for delivery of the mailer to the receiving user,
 - [h)] *wherein each receiving user controls one or more permissions for each sending user to utilize the receiving user’s*

personal information prior to the sending user initiating the mailer demand,

[i] wherein the sending user is not notified of the receiving user's personal information to which the sending user has not been given permission by the receiving user.

Response to Notification of Non-Compliant Appeal Brief, filed March 9, 2017.

References and Rejections

Claims 1–3 are rejected under 35 U.S.C. § 101 as being patent ineligible. Final Act. 9.

Claims 1–3 are rejected under 35 U.S.C. § 103 as being unpatentable over Storch². Final Act. 19.

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellant's arguments. Arguments Appellant could have made but chose not to make are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). We discuss each of the rejections, in turn.

Patent Eligibility

The Examiner determines the claims are patent ineligible under 35 U.S.C. § 101, because the claims are directed to an abstract idea and do not “recite additional elements that amount to ‘significantly more’ than the abstract idea itself.” Final Act. 14 (emphasis omitted); *see also Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 217 (2014) (describing the two-step

² Storch et al., US 2007/0124212 A1; May 31, 2007 (“Storch”).

framework “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts”).

In 2019, the U.S. Patent and Trademark Office (USPTO) published revised guidance on the application of § 101 (“Guidance”). *See* 2019 Revised Patent Subject Matter Eligibility Guidance Notice, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Notice”); *see also* USPTO, October 2019 Update: Subject Matter Eligibility (“October Update”) (available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf). “All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.” Notice at 51; *see also* October Update at 1.

Under the 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) (“Step 2A, Prong One”); and
- (2) additional elements that integrate the judicial exception into a practical application (see MPEP § 2106.05(a)–(c), (e)–(h) (9th ed. Rev. 08.2017, Jan. 2018)) (“Step 2A, Prong Two”).

Notice, 84 Fed. Reg. at 52–55. Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, does the Office then look, under 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.

Notice, 84 Fed. Reg. at 52–56

We are not persuaded the Examiner’s eligibility rejection is in error. We adopt the Examiner’s findings and conclusions as our own, to the extent consistent with our analysis herein. We add the following primarily for emphasis and clarification with respect to the Guidance.

A. Step 2A, Prong One

Pursuant to Step 2A, Prong One of the Guidance, we agree with the Examiner that claim 1 recites an abstract idea, and describes “generating [a] mailer defined by a set of rules for controlling the sender’s access to the receiver’s mailing address.” *See* Final Act. 10; *see also* Abstract. Claim 1 recites steps c), d)i), and d)iii) for communicating information to request a mailer (e.g., a letter or postcard), and steps d)ii) and e) for using the information to create the mailer. Claim 1 further recites steps f) and g) for physically generating and delivering the mailer. These limitations, for requesting, creating, and delivering a mailer, reasonably can be characterized as reciting “fundamental economic principles or practices,” “commercial or legal interactions” (such as creating the “agreements in the form of contracts; legal obligations” of a mailer), and “managing personal behavior or relationships or interactions between people” (such as following rules or instructions), which are “[c]ertain methods of organizing human activity.” Notice, 84 Fed. Reg. at 52; October Update at 5; *see also Secured Mail Sols. LLC v. Universal Wilde, Inc.*, 873 F.3d 905, 911 (Fed. Cir. 2017) (“[T]he claims embrace the abstract idea of using a marking affixed to the outside of a mail object to communicate information about the mail object, i.e., the sender, recipient, and contents of the mail object.”).

Claim 1 further recites wherein clauses [h)] and [i]): “wherein each receiving user controls one or more permissions for each sending user to utilize the receiving user’s personal information prior to the sending user initiating the mailer demand,” and “wherein the sending user is not notified of the receiving user’s personal information to which the sending user has not been given permission by the receiving user.” These limitations, regarding a user’s control over personal information shared with another user, reasonably can be characterized as reciting “managing personal behavior or relationships or interactions between people” (such as social activities and following rules or instructions), which are “[c]ertain methods of organizing human activity.” Notice, 84 Fed. Reg. at 52; October Update at 6.

Additionally, limitations c), d)i), d)ii), d)iii), e), [h)], and [i)] relate to communicating and reviewing information, and reasonably can be characterized as “[m]ental processes” that entail steps of “observation, evaluation, judgment, opinion.” Notice, 84 Fed. Reg. at 52; *see also* October Update at 8.³

Appellant argues the “invention is not found in the prior art and is not a fundamental economic practice,” as “[t]he method of personal control of information in the generation of mailer is not a fundamental economic practice long prevalent in our system of commerce.” Appeal Br. 14

³ Separately, we note that in one case—although the Supreme Court later reversed because the USPS was not a party able to seek review under the relevant statute—the Federal Circuit “agree[d] with the Board” that “relaying mailing address data” was an “abstract idea.” *Return Mail, Inc. v. United States Postal Serv.*, 868 F.3d 1350, 1368 (Fed. Cir. 2017), *rev’d*, 139 S. Ct. 1853 (2019).

(quotations omitted). We are not persuaded the Examiner errs in determining claim 1 recites a judicial exception. *See* Ans. 4, 5. Appellant does not respond to the Examiner’s citation of *Secured Mail* (Ans. 5), which held that the claimed “communicating information about a mail object” was an abstract process, and we see no reason why the claimed control over personal information relating to a mail object would yield a different eligibility result. *Secured Mail*, 873 F.3d at 911; *see also* October Update at 5 (“[F]undamental economic principles or practices, . . . describe subject matter relating to the economy and commerce,” and include “using a marking affixed to the outside of a mail object to communicate information about the mail object, i.e., the sender, recipient, and contents of the mail object.”). Further, as discussed above, we determine the limitations, including wherein clauses [h)] and [i)], recite the “managing personal behavior or relationships or interactions between people” sub-category of the judicial exception of certain methods of organizing human activity, as well as mental processes. Notice, 84 Fed. Reg. at 52.

Accordingly, we conclude the claims recite a judicial exception under Prong One of the Guidance. *See id.* at 54.

B. Step 2A, Prong Two

Appellant argues the Examiner’s rejection is in error, because “the claims are narrow in scope, directed to a new way of generat[ing] mail.” Appeal Br. 13. Appellant further argues “the claims are particularly directed to certain operations that can only occur on computer systems, and are not mere computer implementations of normal human activities.” *Id.* at 15.

We are not persuaded the Examiner’s rejection is in error under Prong Two of Step 2A of the Guidance. *See* Final Act. 3; October Update at 13. That the claims are narrow or use computer systems is insufficient to remove them from the realm of patent ineligibility. *See Alice*, 573 U.S. at 223 (“[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.”); *BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1287 (Fed. Cir. 2018) (“[A] claim is not patent eligible merely because it applies an abstract idea in a narrow way.”). The features relied on by Appellant, such as wherein clauses [h)] and [i)], are part of the judicial exception discussed above in Prong One, and do not comprise additional elements, individually or in combination, that integrate the exception into a practical application. *See* Ans. 3.

Claim 1 recites, as additional elements, computer- and database-related limitations a) and b), which the Examiner finds “amount to no more than: mere instructions to implement the idea on a computer.” Final Act. 14 (emphasis omitted). We agree. *See* Spec. ¶ 2. Other than the recitation of “electronic,” the recited method steps, such as checking a database (limitation d)ii)), could be performed by a human using pen and paper. *See* Ans. 5; *Secured Mail Sols.*, 873 F.3d at 910 (“No special rules or details of the computers, databases, printers, or scanners are recited.”). Thus, the recited hardware limitations a) and b) “merely use[] a computer as a tool to perform an abstract idea.” Notice, 84 Fed. Reg. at 55.

Claim 1 further recites physical steps f) and g): “physically generating the mailer according to the mailer demand,” and “physically delivering the mailer to a postal authority with sufficient postage for delivery of the mailer to the receiving user.” These steps describe the physical

creation and delivery of a mailer. Even if considered as additional elements rather than part of the abstract idea, the limitations do no more than link the underlying abstract idea to a field of use (i.e., the field of sending mail rather than, for example, an email) or add insignificant extra-solution activity to the judicial exception (i.e., sending the intended mail). *See* Notice, 84 Fed. Reg. at 55.

Accordingly, we determine the additional elements of claim 1, individually and in combination, do not integrate the judicial exception into a practical application. *See* Notice, 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).

C. Step 2B

Pursuant to Step 2B of the Guidance, we agree with the Examiner that the additional elements, individually and in combination, recite “conventional steps for generating a mailer (postcard).” Final Act. 14. The Examiner’s determination is reasonable in view of the record before us. *See* Spec. ¶ 7 (“Systems also currently exist for sending goods from an electronic command.”); Spec. ¶¶ 2–6, 10, 22; *see also 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 required by the method claims.”); *Secured Mail Sols.*, 873 F.3d at 912 (“Some of the claim elements, such as submitting a mail object to a mail carrier or affixing information to a mail object, are routine to persons that have mailed a letter.”). Thus, we find independent claim 1’s

claim elements, individually and as an ordered combination, do not provide significantly more than the recited judicial exception.

We agree with the Examiner that independent claim 1 is patent ineligible. Appellant does not present additional substantive arguments for the remaining claims. *See* Appeal Br. 13–15. Accordingly, we do not find the Examiner’s 35 U.S.C. § 101 rejection of claims 1–3 is in error.

Obviousness

The Examiner finds Storch teaches all limitations of independent claim 1, other than limitation [h)], which recites “wherein each receiving user controls one or more permissions for each sending user to utilize the receiving user’s personal information prior to the sending user initiating the mailer demand.” Ans. 7. Storch, however, discloses a receiving user can “deny permission to deliver the gift through a response to the e-mail request and by failing to respond to the e-mail request within a predetermined time period (such as within ten days, for example).” Storch ¶ 39. The Examiner finds “[i]t would have been obvious to allow the receiving user to respond prior to initiat[ing] the whole mail demand to save time and work request process so that the sending user does not have to wait 10 days for a ‘no’ response to the request which is insufficient.” Ans. 7 (emphasis omitted).⁴

Appellant argues the Examiner’s rejection is in error:

The Office’s reasoning does not qualify as a sufficient reason to combine Storch with the missing elements. Following the teaching of Storch, a receiving user cannot know a sending user

⁴ In the event of further prosecution, the Examiner may wish to determine whether the Specification provides sufficient written description support for the “prior to” claim recitation.

will be initiating a mailer demand and has no way of granting approval prior to such a demand. The Office has not established how a person of ordinary skill in the art would modify Storch to allow a receiving user to grant permissions prior to a mailing demand.

Appeal Br. 18. Appellant also argues that the Examiner relies solely on hindsight to modify Storch. *Id.*; Reply Br. 5.

We are persuaded the Examiner errs. We agree with Appellant that the Examiner fails to provide sufficient rationale for why or how a person of ordinary skill in the art would have been motivated to modify Storch absent hindsight. As such, we find the Examiner does not provide articulated reasoning sufficient to support the conclusion of obviousness. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

We do not sustain the Examiner's obviousness rejection of independent claim 1, or of claims 2 and 3 which depend therefrom.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Basis/Reference(s)	Affirmed	Reversed
1-3	101	Eligibility	1-3	
1-3	103	Storch		1-3
Overall Outcome			1-3	

Appeal 2018-002666
Application 13/049,873

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED