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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAUL M. ENGLISH, DEREK M. YOUNG,
JEFF A. RAGO, LINCOLN D. JACKSON, PAUL D. SCHWENK,
and GIORGOS C. ZACHARIA

Appeal 2018-002862
Application 14/210,807
Technology Center 2100

Before MAHSHID D. SAADAT, ALLEN R. MacDONALD, and
JOHN P. PINKERTON, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Examiner's
Final Rejection of claims 1–7. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellants, the real party in interest is Kayak Software Corporation. App. Br. 2.

STATEMENT OF THE CASE

Appellants' invention relates to a travel search engine and to sharing search results with users. Spec. ¶2. Exemplary claim 1 under appeal reads as follows:

1. A computer program product comprising a computer readable storage medium having computer program instructions and data embodied thereon for displaying on a display device shared search results in a user interface, the computer program instruction and data to configure a processor to perform operations comprising:

presenting on the display device in a first portion of the user interface, a set of search results from a search session to a first user, each search result in the set including a user interface control to share the search result with another user; and

responsive to a request from the first user to share a selected search result from the set of search results with a second user, presenting the selected search result on the display device in a second portion of the user interface separate from the first portion, while removing the selected search result from the set of search results displayed in the first portion of the user interface.

REFERENCES and REJECTIONS

Claims 1–7 stand rejected under 35 U.S.C. § 101 as not being directed to patent-eligible subject matter. *See* Final Act. 2.

Claims 1–7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Deljo (US 2007/0112606 A1; published May 17, 2007) (“Deljo”). *See* Final Act. 2–4.

PRINCIPLES OF LAW

Patent-Eligible Subject Matter

The Supreme Court has set forth “a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012)). According to this framework, a determination is made to consider whether the claims at issue are directed to one of those concepts (i.e., laws of nature, natural phenomena, and abstract ideas). *See id.* If so, a further determination must be made to consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. *Id.* “The question of whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact.” *Berkheim v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018).

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990). Under 35 U.S.C. § 102, the prior art reference “must not only disclose all elements of the claim within the four corners of the document, but must also

disclose those elements arranged as in the claim.” *Net MoneyIn, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (citation and internal quotation marks omitted). “Thus, it is not enough that the prior art reference discloses part of the claimed invention, which an ordinary artisan might supplement to make the whole, or that it includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention.” *Id.* at 1371.

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments that the Examiner erred. We are not persuaded the Examiner erred in rejecting the claims under 35 U.S.C. § 101 for being directed to patent-ineligible subject matter, and we adopt as our own the findings and reasons set forth by the Examiner. *See* Final Act. 2; *see also* Ans. 2–3. We, however, are persuaded the Examiner erred in rejecting the claims under 35 U.S.C. § 102(b) as anticipated by Deljo. We highlight and address specific findings and arguments for emphasis as follows.

Rejection Under 35 U.S.C. § 101

Independent claim 1 recites a computer readable storage medium having computer program instructions and data embodied thereon for displaying on a display device shared search results in a user interface, and is, therefore, directed to one of the four statutory categories of patentability enumerated by 35 U.S.C. § 101 (process, machine, manufacture, or composition of matter). Applying the first part of the *Alice* analysis, the Examiner finds the claims are directed to an abstract idea under an idea “of itself”. *See* Ans. 2. As found by the Examiner, the claims present steps for

displaying search results on a user interface for a searching user, presenting options to only show a portion of the results based on the selection, and sharing the selected search results (*e.g.*, travel itineraries) with a third-party. *See id.* As further found by the Examiner, the basic steps of gathering information for display, analyzing the information, and displaying the information based on user filtration to users are broadly covered under *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016) (collecting information, analyzing the collected information, and displaying certain results of the collection and analysis) and *Intellectual Ventures I LLC v. Capital One Financial Corp.*, 850 F.3d 1332 (Fed. Cir. 2017) (collecting, displaying, and manipulating data). *See* Ans. 2–3. Applying the second part of the *Alice* analysis, the Examiner finds the claims do not include additional elements that are sufficient to amount to significantly more than the abstract idea. *See* Final Act. 2. As found by the Examiner, the claims do not: provide any solution to a technical challenge; provide a combination of features that are significantly more than the abstract idea in any non-conventional manner; or provide any new improvement in functionality to an underlying travel search system. *See* Ans. 3. As further found by the Examiner, the claim elements are well-known and conventional elements for performing routine and conventional functions. *See id.* Further, the Examiner has indicated that, in addition to independent claim 1, the dependent claims have been carefully reviewed but merely recite additional features of the abstract idea and do not recite additional elements that are significantly more than the abstract idea. *See id.*

Beginning with the first step of the *Alice* analysis, we must determine “whether the claims at issue are directed to one of those patent-ineligible

concepts,” including abstract ideas. *Alice*, 134 S. Ct. at 2355. In performing this determination, we ask whether the focus of the claims is on a specific asserted improvement in computer capabilities or, instead, on a process that qualifies as an “abstract idea” for which computers are invoked merely as a tool. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016) (citing *Alice*, 134 S. Ct. at 2358–59).

Appellants argue the Examiner fails to address the actual limitations of independent claim 1 (*e.g.*, “first portion of the user interface,” “second portion of the user interface separate from the first portion”), does not even attempt to suggest what “idea” the claim is believed to be directed to, fails to specify what claim limitations are believed to correspond to any purported “categories,” and fails to consider claim 1 as a whole in assessing whether claim 1 recites patent-eligible subject matter. *See* App. Br. 3–6. Appellants further argue claim 1 is rooted in Internet-based computing technology (*i.e.*, online search engines), addresses a problem specifically arising from this computing technology (*i.e.*, sharing online travel search results between two users seeking to travel together but searching for travel options from different computers), and recites specific interactions with the user interface used to present and browse the travel search results (*i.e.*, presenting travel search results in one portion of the user interface while presenting travel search results to be shared with another user in another portion of the user interface), and thus, the claims are similar to the claims at issue in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014). *See* App. Br. 6–10. Appellants also argue claim 1 is similar to the claims found patent-eligible in *Trading Technologies International Inc. v. CQG, Inc.*, 675 Fed. Appx. 1001 (Fed. Cir. 2017), as claim 1 analogously recites

specific user interface features and associated functionality for improving collaboration between users of online travel search engines. *See* App. Br. 13–14.

We are not persuaded by Appellants’ arguments. Considering the recited elements of the claims in light of Appellants’ Specification, we agree with the Examiner’s findings that the claims are directed to a computer program product comprising a computer-readable storage medium having computer program instructions and data embodied thereon for displaying search results (*e.g.*, travel itineraries) on a user interface for a searching user, presenting a portion of the results based on a selection, and sharing the selected search results with a third-party. *See* Ans. 2. We further agree with the Examiner that the recited steps can be performed mentally, and thus, the claims are directed to “an idea of itself,” one of the four types of abstract ideas set forth in *Alice*. *See id*; *see also Alice*, 134 S. Ct at 2355 (“[a]n idea of itself is not patentable”). Although the claims recite that the steps are performed on a user interface of a display device, such a recitation does not necessarily mean that the recited steps are not mental steps, as “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 134 S. Ct at 2358. Based on the recited elements, the claims are directed to collecting search result information, analyzing the collected information, and displaying the analyzed information, which is an idea of itself and which is similar to abstract ideas previously identified by courts. *See Electric Power Grp*, 830 F.3d at 1353–54 (claims focus on the abstract idea of collecting information, analyzing it, and displaying certain results of the collection and analysis); *see also Intellectual Ventures*, 850 F.3d at 1327 (affirming that the

invention is drawn to the abstract idea of “creating an index and using that index to search for and retrieve data”).

Further, we disagree with Appellants’ argument that the Examiner has failed to set forth a *prima facie* case that claim 1 is patent ineligible. As described above, the Examiner has characterized claim 1 and analogized it to previous court cases holding that a claim is patent ineligible for being directed to an abstract idea. *See* Ans. 2–3. As this point, the Examiner has shifted the burden to Appellants to persuasively establish that claim 1 is not directed to an abstract idea. Although Appellants identify claim elements, such as “first portion of the user interface” and “second portion of the user interface separate from the first portion,” Appellants fail to persuasively establish how the recited claim elements demonstrate that claim 1 is not directed to an abstract idea.

Appellants’ argument that claim 1 is similar to the claims in *DDR Holdings*, is also not persuasive because Appellants provide no persuasive analysis or explanation as to why the claims are similar to the claims at issue in *DDR Holdings*. More specifically, the scope of claim 1 is not commensurate with the argued improvement of sharing travel search results between two users searching for travel itineraries from different computers. In fact, claim 1 merely recites removing a presented search result from a first portion of a user interface corresponding to a display device and presenting the search result in a second portion of the user interface in response to a request to share the search result with an additional user. Claim 1 fails to recite any details regarding the specifics of sharing the search result with the other user or displaying the shared search result in another user interface corresponding to another display device. In contrast, in *DDR Holdings*, the

court determined that the claims at issue require “that a ‘data store’ hold ‘visually perceptive elements’ (or ‘look and feel elements’) that ‘visually . . . correspond’ to a host page” and further require “that the data store must store ‘look and feel’ descriptions for multiple hosts,” “that each link must be associated with a particular merchant’s product catalog,” and “that the merchant, system operator, and host website be ‘third parties with respect to one another.’” *DDR Holdings*, 773 F.3d at 1250. Thus, the court determined that the claims included sufficiently detailed elements that established the claims were necessarily rooted in computer technology and addressed the Internet-centric problem of how to provide user access to computer-implemented applications over the Internet. *DDR Holdings*, 773 F.3d at 1257.

Further, Appellants’ argument that claim 1 is similar to the claims in *Trading Technologies* is also not persuasive. As previously described, the scope of claim 1 is not commensurate with the argued improvement of collaboration between users of online travel search engines, as claim 1 lacks specific features and associated functionality for the argued improvement. More specifically, claim 1 merely recites removing the search result from the first portion of the user interface and presenting the search result in the second portion of the user interface in response to a request to share the search result. Such claim recitations merely describe displaying information within a graphical user interface in response to a request, and do not sufficiently describe how collaboration between users is improved by displaying search results within different user interfaces of multiple display devices. In contrast, in *Trading Technologies*, the court determined that the claims did not “simply claim displaying information on a graphical user

interface,” but rather “require[d] a specific, structured graphical user interface with a prescribed functionality directly related to the graphical user interface’s structure,” and it was the specifically structured graphical user interface with prescribed functionality that “addressed . . . and [resolved] a specifically identified problem in the prior state of the art.” *Trading Technologies*, 675 Fed. Appx at 1004.

Because we conclude that the claims are directed to an abstract idea, we turn to the next step of the *Alice* analysis. In step two, as previously discussed, we consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether the additional elements “‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78).

In that regard, Appellants argue claim 1 is similar to the claims found patent-eligible in *Amdocs Ltd. v. Opnet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016) because claim 1 recites specific structures and functions for achieving the goal of sharing, with another user, search results provided by a search session. *See* App. Br. 10–11. Appellants further argue claim 1 is also similar to claims found patent-eligible in *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016) because claim 1 amounts to significantly more than the alleged abstract idea of “sharing user results in a user interface,” as its explicitly recited combination and arrangement of claim features is non-conventional and non-generic, and thus, transforms claim 1 into a patent-eligible application of the abstract idea. *See* App. Br. 11–12.

We are not persuaded that the Examiner erred. Considering the recited elements of the claims in light of Appellants’ Specification, we agree

with the Examiner’s findings that the claimed elements (*i.e.*, presenting search results on a first portion of a user interface, removing a selected search result from the first portion of the user interface in response to a request from a user, and presenting the selected search result in a second portion of the user interface in response to the request from the user) are well-known and conventional elements for performing routine and conventional functions performed by conventional graphical user interfaces. *See Ans. 3.* Evidence supporting the Examiner’s finding is found in the *Deljo* reference, further discussed below, which discloses removing a selected itinerary from a displayed list of itineraries (*i.e.*, the claimed “first portion of [a] user interface”) and presenting the selected itinerary in a flight details window (*i.e.*, the claimed “second portion of the user interface”) in response to a request from a user. *See e.g.*, *Deljo* ¶¶ 22–24. Therefore, considering the elements of the claims both individually and in combination, we conclude there are no additional elements that transform the nature of the claims into a patent-eligible application. *See Alice*, 134 S. Ct. at 2355.

Further, we disagree with Appellants’ contention that claim 1 is directed to a specific combination of features in a specific arrangement for sharing search results between users, similar to the claims at issue in *Amdocs*, rather than an abstract idea. Contrary to Appellants’ argument, claim 1 does not recite specific structures and functions for achieving the argued goal of sharing search results with another user during a search session. As previously described, claim 1 merely recites the structures “first portion of the user interface” and “second portion of the user interface,” and merely recites removing a search result from the first portion of the user interface and presenting it in the second portion of the user interface in

response to a request to share the search result. Further, claim 1 fails to recite any details regarding the specifics of sharing the search result with the other user or displaying the shared search result in another user interface corresponding to another display device. In contrast, in *Amdocs*, the patent claims recited that the network accounting records were “enhance[d],” where the court construed “enhance” as being dependent upon a distributed architecture disclosed in the patent. *See Amdocs*, 841 F.3d at 1300. Thus, claim 1 fails to recite Appellants’ argued inventive concept.

Further, Appellants’ argument that claim 1 is similar to the claims in *BASCOM* is also not persuasive. Contrary to Appellants’ argument, claim 1 does not recite a non-conventional and non-generic combination and arrangement of claim features. As previously described, claim 1 fails to recite any specific structures or other details regarding the specifics of sharing the search result with the other user or displaying the shared search result in another user interface corresponding to another display device. In contrast, in *BASCOM*, the patent claims respectively recited a “content filtering system for filtering content retrieved from an Internet computer network,” and “ISP server for filtering content,” where the patent described the installation of a filtering tool at a specific location, remote from end-users, with customizable filtering features specific to each end user. *See BASCOM*, 827 F.3d at 1348–50. Thus, claim 1 fails to recite Appellants’ argued inventive concept.

We have considered Appellants’ other arguments (*see e.g.*, Reply Br. 2–8) and they are also not persuasive. Therefore, we are not persuaded the Examiner erred in finding claims 1–7 reciting patent-ineligible subject

matter. Accordingly, we sustain the rejection of claims 1–7 under 35 U.S.C. 101.

Rejection Under 35 U.S.C. § 102(b)

Appellants contend Deljo fails to disclose “responsive to a request from the first user to share a selected search result from the set of search results with a second user, presenting the selected search result on the display device in a second portion of the user interface separate from the first portion, while removing the selected search result from the set of search results displayed in the first portion of the user interface,” as recited in claim 1. *See* App. Br. 15. As argued by Appellants, Deljo discloses a system that groups and displays travel itineraries. *See id.* Although Deljo discloses that itinerary information can be shared by selecting a “Send via Email” link or “Send via IM” link, according to Appellants, Deljo does not explain what is presented when a user clicks either of the aforementioned links. *See* App. Br. 16. As further argued by Appellants, Deljo also discloses that a presentation of a selected itinerary in a flight details window occurs in response to selecting a “return times” link, not in response to selecting the “Send via Email” link or the “Send via IM” link. *See id.* Thus, even assuming without conceding that Deljo’s list of collapsible itineraries and flight details window could be construed as the respectively claimed “first portion of the user interface” and “second portion of user interface,” Appellants argue Deljo fails to disclose that an itinerary is removed from the list of collapsible itineraries and displayed within the flight details window in response to a request to share the itinerary. *See* App. Br. 17–18; *see also* Reply Br. 8–12.

We are persuaded by Appellants' contentions. Although we agree with the Examiner that Deljo discloses removing a selected itinerary from a displayed list of itineraries (*i.e.*, the claimed "first portion of [a] user interface") and presenting the selected itinerary in a flight details window (*i.e.*, the claimed "second portion of the user interface"), we are persuaded by Appellants' argument that the Examiner has not shown Deljo discloses removing the selected itinerary from the displayed list and presenting the selected itinerary in the flight details window in response to a user requesting to share the selected itinerary by either selecting the "Send via Email" link or the "Send via IM" link. Therefore, on this record, we do not sustain the rejection of claim 1 under 35 U.S.C. § 102(b), nor of claims 2–7 which depend from claim 1.

DECISION

We affirm the Examiner's rejection of claims 1–7 under 35 U.S.C. § 101.

We reverse the Examiner's rejection of claims 1–7 under 35 U.S.C. § 102(b).

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