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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAYANTH SAIMANI and ANSHU VERMA

Appeal 2018-003107
Application 13/956,188¹
Technology Center 3600

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

PINKERTON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–3, 5, 6, 8–10, 12, 13, 15–17, 19, and 20, which constitute all the claims pending in this application. Claims 4, 7, 11, 14, 18, and 21 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ The real party in interest identified by Appellants is Intuit Inc. App. Br. 4.

STATEMENT OF THE CASE

Introduction

Appellants' described and claimed invention relates to monitoring a method for configuring a business management application (BMA) for managing financial aspects of a business entity. *See Spec.* ¶ 2.²

Claim 1 is representative and reads as follows:

1. A method for configuring a business management application (BMA) for managing financial aspects of a business entity, comprising:

obtaining a business name of an unconfigured user of the BMA, wherein the unconfigured user is associated with the business entity;

retrieving, by a computer processor, a search result from an Internet search engine using the business name as a search keyword;

translating, by the computer processor, the search result from a first language into a second language;

analyzing, by the computer processor, the search result to identify a business type of the unconfigured user by:

determining that the search result includes a hyperlink to a page of an online social network used by the unconfigured user,

in response to determining that the search result includes the hyperlink to the page of the online social network, retrieving, utilizing an application programming interface that is associated with the online social network, content from a field of structured data of the page based on a pre-determined format of the structured data, wherein

² Our Decision refers to the Final Office Action mailed November 4, 2016 ("Final Act."), Appellants' Amended Appeal Brief filed July 12, 2017 ("App. Br."), the Examiner's Answer mailed November 2, 2017, and the original Specification filed July 31, 2013 ("Spec.").

the retrieved content include the business type of the unconfigured user, and

extracting the business type from the retrieved content; and

generating, by the computer processor, a configuration setting enabling a module of the BMA based on the business type, wherein the configuration setting is used by the BMA to generate a customized result specific to the business type;

presenting, in response to generating the configuration setting, a message confirming the module is enabled.

App. Br. 20 (Claims App'x).

Rejection on Appeal

Claims 1–3, 5, 6, 8–10, 12, 13, 15–17, 19, and 20 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

ANALYSIS

Applicable Law

Section 101 of the Patent Act provides that “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” is patent eligible. 35 U.S.C. § 101. But the Supreme Court has long recognized an implicit exception to this section: “Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). To determine whether a claim falls within one of these excluded categories, the Court has set out a two-part framework. The framework requires us first to consider whether the claim is “directed to one of those patent-ineligible

concepts.” *Alice*, 573 U.S. at 217. If so, we then examine “the elements of [the] 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.” *Alice*, 573 U.S. at 217 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78, 79 (2012)). That is, we examine the claim for an “inventive concept,” “an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 573 U.S. at 217–18 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

The Office recently published revised guidance on the application of 35 U.S.C. § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50–57 (“Revised Guidance”). Under the Revised Guidance, we first look to whether the claim recites: any judicial exceptions, including certain groupings of abstract ideas (*i.e.*, mathematical concepts, certain methods of organizing human activity such as fundamental economic practices, or mental processes); and additional elements that integrate the judicial exception into a practical application. *See* Revised Guidance 54–55. Only if a claim recites a judicial exception and does not integrate that exception into a practical application, do we then look to whether the claim adds a specific limitation beyond the judicial exception that are not “well-understood, routine, conventional” in the field. *See* Revised Guidance 56.

Appellants’ Arguments

Appellants argue the claims do not describe a concept of organizing, storing, and transmitting ideas. *See* App. Br. 11–12. Instead, as argued by

Appellants, the claims describe using a search engine to retrieve a hyperlink to a page on an online social network and then extract from the retrieved online social network page a business type which is then used to configure a business management application. *See* App. Br. 12. Appellants additionally argue that the Examiner's reliance on *Cyberfone Systems, LLC v. CNN Interactive Group, Inc.*, 558 F. App'x 988 (Fed. Cir. 2014) is not proper because the *Cyberfone* decision is a non-precedential decision, and the facts of the present appeal do not match the facts at issue in *Cyberfone*. *See* App. Br. 11–13. Appellants further argue the Examiner ignores the character of independent claim 1 as a whole, and that claim 1 is directed toward an improvement with respect to specific computer functionality, similar to the claims in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). App. Br. 13. As argued by Appellants, the claims describe a software improvement to a computer's configurability and therefore falls within the holding from *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016). *See* App. Br. 13–14.

Appellants further argue claim 1 includes an inventive concept sufficient to transform any alleged abstract idea found in the claims into patent-eligible subject matter. *See* App. Br. 14. More specifically, Appellants argue claim 1 provides a claimed solution rooted in computer technology to overcome a technical problem of configuring a business management application (BMA), similar to the claims in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014). *See* App. Br. 15–16. Appellants additionally argue, even assuming *arguendo* that the individual elements of claim 1 constitute routine and conventional functions performed by a computer, that the combination of the aforementioned

elements fall within the holding of *Bascom Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), where an inventive concept was found in a non-conventional and non-generic arrangement of known and conventional elements. *See* App. Br. 16–17.³

Step One of Alice

Prong 1: Whether Claims Recite an Abstract Idea

The Examiner found claim 1 recites the steps of obtaining a business name of an unconfigured user of a BMA, using the business name to retrieve, translate, and analyze a search result to identify a business type, generating a configuration setting using the business type and presenting a message based on the generated configuration setting. *See* Final Act. 3; *see also* Ans. 8. As found by the Examiner, the aforementioned steps describe a concept which relates to one of the concepts identified as abstract ideas by the courts, such as using categories to organize, store and transmit information. *See* Final Act. 3 (citing *Cyberfone*, 558 F. App'x at 988); *see also* Ans. 8. The Examiner further found independent claims 8 and 15 recite limitations substantially similar to claim 1, and, thus, were found to be directed to abstract ideas based on the same reasoning regarding claim 1. *See* Final Act. 4.

Upon review of the Examiner's findings in support of rejection of the aforementioned claims under 35 U.S.C. § 101, we conclude the Examiner's findings are not sufficient to establish that the claims recite an abstract idea that falls within one of the three enumerated categories of abstract ideas (*i.e.*,

³ Appellants also proffer additional arguments that claims 5, 12, and 19 are separately patent-eligible. *See* App. Br. 17–18. We conclude it is not necessary to reach these arguments in order to resolve the appeal in light of Appellants' patent-eligibility arguments regarding claim 1.

mathematical concepts, certain methods of organizing human activity, or mental processes). However, we note that claim 1 recites “configuring a business management application (BMA) for **managing financial aspects of a business entity**,” and that claims 8 and 15 recite similar elements. App. Br. 20–21, 23 (emphasis added). Thus, we conclude claims 1, 8, and 15 recite a fundamental economic practice, which falls within the “certain methods of organizing human activity” category of abstract ideas enumerated in the Revised Guidance. Further, claim 1 also recites, *inter alia*, “obtaining a business name of an unconfigured user of [a] BMA, wherein the unconfigured user is associated with the business entity,” “generating . . . a configuration setting . . . based on the business type, wherein the configuration setting is used by the BMA to generate a customized result specific to the business type,” and “presenting, in response to generating the configuration setting, a message,” and claims 8 and 15 recite similar elements. App. Br. 20–21, 23. Thus, we also conclude claims 1, 8, and 15 recite a method of managing interactions between people, which also falls within the “certain methods of organizing human activity” category of abstract ideas enumerated in the Revised Guidance. Therefore, we conclude that claims 1–3, 5, 6, 8–10, 12, 13, 15–17, 19, and 20 recite an abstract idea.

Prong 2: Whether Claims Integrate an Abstract
Idea into a Practical Application

The Examiner found claim 1 recites the additional limitations of an Internet search engine and a computer processor. *See* Final Act. 3; *see also* Ans. 8. As found by the Examiner, both the Internet search engine and computer processor are recited at high levels of generality, and, thus, are

generic computer components performing well-known and routine functions, which do not amount to significantly more than the identified abstract idea, when viewed individually or in combination. *See* Final Act. 3–4; *see also* Ans. 8–9. The Examiner further found claims 8 and 15 recite limitations substantially similar to claim 1, and, thus, were found not to amount to significantly more than the identified abstract idea based on the same reasoning regarding claim 1. *See* Final Act. 4.

We are, however, persuaded by Appellants’ argument that claim 1 represents an improvement to the functioning of a computer. More specifically, we conclude that claim 1 causes a computer to automatically generate a business type based on a received business name by:

- (a) retrieving a search result from an Internet search engine using the received business name as a search keyword;
- (b) determining that the search result includes a hyperlink to a page of an online social network;
- (c) retrieving content from a field of structured data of the page based on a pre-determined format of the structured data; and
- (d) extracting the business type from the retrieved content.

In this regard, we agree with Appellants that claim 1 provides a claimed solution rooted in computer technology to overcome a technical problem of configuring a business management application (BMA), similar to the claims found eligible in *DDR Holdings*. App. Br. 15–16. Thus, while claim 1 recites an abstract idea, we conclude claim 1 is not directed to the recited abstract idea, and instead is directed to a practical application of the recited abstract idea. We further conclude that claims 8 and 15 are also not directed to the recited abstract idea, and instead are directed to practical applications of the recited abstract idea, for similar reasons.

Appeal 2018-003107
Application 13/956,188

In light of the above, we conclude that claims 1–3, 5, 6, 8–10, 12, 13, 15–17, 19, and 20 integrate the recited abstract idea into a practical application. Accordingly, we do not sustain the rejection of the aforementioned claims under 35 U.S.C. § 101.

DECISION

We reverse the Examiner’s rejection of claims 1–3, 5, 6, 8–10, 12, 13, 15–17, 19, and 20 under 35 U.S.C. § 101.

REVERSED