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SINGH, RUPANGINI

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* AL MAHAFZAH

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Appeal 2018-003556  
Application 13/758,545  
Technology Center 3600

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Before JOHN A. JEFFERY, JENNIFER L. McKEOWN, and  
LINZY T. McCARTNEY, *Administrative Patent Judges*.

McKEOWN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 1, 2, 6–9, 12–16, 19, and 20. Claims 3, 4, 10, 11, 17, and 18 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> According to Appellant, the real party in interest is HSC Acquisition, LLC dba HealthSTAR Communications. App. Br. 2.

## STATEMENT OF THE CASE

Appellant's disclosed and claimed invention "relates to the field of promotional events. More particularly, the present invention relates to a system and method for certifying attendance at a promotional event." Spec.

¶ 1.

Claim 1 is illustrative of the claimed invention and reads as follows:

1. A method for certifying attendance at a healthcare promotional event, the method comprising the steps of:

a computer retrieving data indicative of a healthcare professional's pre-registration for the healthcare promotional event;

a computer prompting for a signature, wherein the signature confirms the healthcare professional's attendance at the healthcare promotional event;

a computer receiving an image representative of the signature via an interface;

a computer converting the image representative of the signature to binary code;

a computer storing the binary code representative of the signature to memory;

a computer prompting for a response to a presented certification statement;

a computer certifying the healthcare professional's attendance at the healthcare promotional event responsive to receiving a response to the certification statement and responsive to receiving the image representative of the signature; and

a computer transmitting data representative of the response to the certification statement in association with the binary code representative of the signature.

## THE REJECTIONS

The Examiner rejected claims 1, 2, 5–10, 12–17, 19, and 20 under 35 U.S.C. § 101 as directed to patent ineligible subject matter. Final Act. 4–12.

The Examiner rejected claims 1, 2, 5–9, 12–16, 19, and 20 under 35 U.S.C. § 101 as unpatentable over White et al. (US 2010/0049562 A1, published Feb. 25, 2010), Atsushi et al. (JP 2007272563(A), published Oct. 18, 2007), Terue (JP 20070128400(A), published May 24, 2007), Smith et al. (US 2011/0246219 A1, Oct. 6, 2011), and Jegou et al. (US 2011/0164822 A1, published July 7, 2011). Final Act. 10–27.

## ANALYSIS

### THE § 101 REJECTION

#### *Claims 1, 2, 5–9, 12–16, 19, and 20*

Based on the record before us, we are not persuaded that the Examiner erred in rejecting claims 1, 2, 5–9, 12–16, 19, and 20 as directed to patent ineligible subject matter.

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement

risk.”); *see also* *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. (15 How.) 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 176; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula

to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (citation omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of section 101. USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Memorandum”). Under that guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (see MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) § 2106.05(a)-(c), (e)-(h) (9th ed. 2018)).

*See* Memorandum 52, 55–56. Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

- (3) adds a specific limitation beyond the judicial exception that are not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or
- (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

*See* Memorandum 56.

*Examiner’s Findings and Conclusion*

Under step one of the *Alice* test, the Examiner determines that the claimed invention is directed to the abstract idea of “certifying attendance at an event.” Final Act. 6. The Examiner explains that “certifying attendance at an event is a method of organizing human activity, such as a concept relating to interpersonal and intrapersonal activities, such as managing relationships or transactions between people, social activities and human behavior.” Final Act. 6.

Under step two of the *Alice* test, the Examiner determines that the additional limitations do not add significantly more to the abstract idea. Final Act. 7–8. The Examiner finds that the claimed steps of “retrieving, prompting, receiving via an interface, converting, storing, certifying, transmitting, enabling, and modifying information” as required by the claimed invention are “are well-understood, routine, and conventional activit[ies] previously known to the industry.” Final Act. 7. The Examiner also finds that “converting an image representative of a signature to a binary code is a generic and well-understood, routine and conventional activity.” Final Act. 7.

*Appellant's Contentions*

Appellant argues that the claimed invention is not directed to an abstract idea. App. Br. 11. According to Appellant, “the claims require a fundamental change to data that cannot be performed in a human mind.” App. Br. 11–13. Appellant particularly points to converting the image of the signature to binary code” “goes beyond merely manipulating, reorganizing or collecting data, but rather generates new data (i.e., the binary code, as recited in claim 1), thereby fundamentally altering the original data (i.e., the data corresponding to the image, as recited in claim 1) and improving the operation of the computer.” App. Br. 12; App. Br. 15–18. Appellant also contends that the claimed invention is not directed to a method of organizing human activity. App. Br. 13–14.

Under step two of the *Alice* test, Appellant argues that the claimed invention amounts to significantly more than the alleged abstract idea. App. Br. 15–19. Appellant further argues that “the Final Action fails to provide sufficient rational to support a conclusion that the functions performed by the computer of claim 1 are well understood, routine, [and] conventional functions. . . .” App. Br. 18.

*Analysis – Revised Step 1*

In step one we consider whether the claimed subject matter falls within the four statutory categories of patentable subject matter identified by 35 U.S.C. § 101: process, machine, manufacture, or composition of matter. The claimed invention here recites a process including a number of a steps. Accordingly, the claimed invention falls within the process category.

*Analysis – Revised Step 2A*

Under the Memorandum, in prong one of step 2A we look to whether the claims recite a judicial exception. The claims include “retrieving data indicative of a healthcare professional’s pre-registration for the healthcare promotional event,” “prompting for a signature, wherein the signature confirms the healthcare professional’s attendance at the healthcare promotional event,” “receiving an image representative of the signature,” “prompting for a response to a presented certification statement,” and “certifying the healthcare professional’s attendance at the healthcare promotional event responsive to receiving a response to the certification statement and responsive to receiving the image representative of the signature.” As the Examiner explains, as a whole, these claimed steps gather information to be used to certify attendance of an individual at an event. Final Act. 6. Certifying attendance at an event relates to managing personal behavior, i.e. the person’s attendance or presence at the event. As such, the claimed invention recites a method of organizing human activity, which is an abstract idea. *See Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 115 USPQ2d 1636 (Fed. Cir. 2015) (finding ineligible claims directed to managing a person’s spending or budgeting). *See also* Final Act 6–7 (finding that “the abstract idea of certifying attendance at an event is a method of organizing human activity, such as a concept relating to interpersonal and intrapersonal activities, such as managing relationships or transactions between people, social activities and human behavior.”).

Under prong two of revised step 2A, 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.

In addition to the abstract idea discussed above, the claimed invention recites “a computer,” “an interface,” “converting the image representative of the signature to binary code,” “storing the binary code representative of the signature to memory” and “transmitting data representative of the response to the certification statement in association with the binary code representative of the signature.” As the Examiner identifies, these additional limitations “are generic computer components that perform functions (i.e., retrieving, processing, converting, storing, transmitting and outputting data) that are well-understood, routine, and conventional activities previously known to the industry. . . .” App. Br. 7 (citations omitted).

Appellant, however, asserts that these additional limitations improve the functioning or performance of the computer. App. Br. 12; App. Br. 15. Namely, Appellant contend that the claimed “convert[ing] the image of the signature to binary code [] reduce[s] memory requirements for storing the signature and [] reduce[s] network bandwidth requirements for transmitting the signature” (Spec. ¶ 32), therefore, “improving the performance of the computer.” App. Br. 12; *see also* App. Br. 15–16.

We disagree. As the Examiner points out, “nothing in the claims recites an improvement to the functioning of a computer itself, or an ‘innovation in computer technology. . . .’” Ans. 14. For example, the claims generally provide for converting the image, without any specific details of how the conversion is performed. *Compare Enfish, LLC v.*

*Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016) (claims at issue are “directed to a *specific* implementation of a solution to a problem in the software arts” (emphasis added)). As such, the broadly claimed process of converting data from one form to another is not a technological improvement sufficient to render the claimed invention eligible. *See, e.g., Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014) (finding ineligible claims that take two data sets and organize this information into a new form and reasoning that using an algorithm “to manipulate existing information to generate additional information is not patent eligible.”); *see also Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343 (Fed. Cir. 2014); Ans. 14–15 (citations omitted).

We further determine that the claimed converting, storing, and transmitting steps are merely insignificant extra-solution activity. Namely, the claimed invention receives, processes, stores and transmits data – this is merely conventional data gathering and analysis. *See* MPEP § 2106.05(g); *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) at 1363 (collecting and analyzing data amounted to mere data gathering).

Moreover, the Specification describes the problem with manual prior art methods. Specifically, “[c]ertifying attendance manually using traditional paper records [] may be tedious and time consuming, as well as error prone.” Spec. 3. The claimed invention is directed to implementing this previously manual process through use of a computer. In other words, the claimed invention merely uses a computer as tool to implement the previously paper process of certifying attendance, which is a method of organizing human behavior – an abstract idea. As such, based on the record

before us, we determine that the claimed invention is not integrated into a practical application. *See, e.g.*, MPEP § 2106.05(f).

*Analysis – Step 2B*

We agree with the Examiner that the additional limitations are not sufficient to amount to significantly more than the abstract idea. *See* Final Act. 7. Namely, as the Examiner determines “(i.e., retrieving, processing, converting, storing, transmitting and outputting data) [] are well-understood, routine, and conventional activities previously known to the industry.” Final Act. 7 (citing *Alice Corp.*, 134 S. Ct. at 2360, *buySAFE, Inc. v. Google, Inc.*, 754 F.3d 1350, 1355, and USPTO’s July 2015. Update: Subject Matter Eligibility, page 7 (available at <https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf>)); *see also, e.g.*, *Content Extraction*, 776 F.3d at 1347 (discussing that data collection, recognition, and storage is well-known); Spec. ¶¶ 22, 39, and 42 (identifying a variety of computing devices, along with various memory, that may perform the claimed invention).

Appellants’ argument that the claimed receiving and processing data adds significantly more to the abstract idea is unpersuasive. *See* App. Br. 17. Instead, as discussed above, these steps are merely insignificant extra-solution activity. Namely, the claimed invention receives, processes, stores and transmits data – this is merely conventional data gathering and analysis. *See* MPEP § 2106.05(g); *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (*Fed. Cir. 2015*) at 1363 (collecting and analyzing data amounted to mere data gathering).

Accordingly, based on the record before us, we are not persuaded of error in the Examiner’s conclusion that the appealed claims are directed to

patent ineligible subject matter. Therefore, we affirm the Examiner's decision to reject claims 1, 2, 5–9, 12–16, 19, and 20 as directed to patent ineligible subject matter.

THE § 103 REJECTION BASED ON WHITE, ATSUSHI, TERUE, SMITH, AND  
JEGOU

*Claims 1, 2, 5–9, 12–16, 19, and 20*

Based on the record before us, we are not persuaded that the Examiner erred in finding that claims 1, 2, 5–9, 12–16, 19, and 20 are unpatentable over White, Atsushi, Terue, Smith, and Jegou.

Appellant contends that the Examiner erred in finding that Atsushi teaches two prompt steps and certifying attendance in response to each prompt. App. Br. 23–24. According to Appellant, “in Atsushi a single signature request is used to confirm the identity of the student and consequently the student's attendance to a given lecture” in contrast to the claimed invention “that certifies in response to two prompting steps.” App. Br. 24. Specifically, Appellant argues that claim requires the signature response to be *separate* and *different* from the certification response. App. Br. 25.

We disagree. As the Examiner points out, the claims do not recite that the prompting for a signature and prompting for a certification response or the received responses must be separate or different. Ans. 24–25. For example, the Specification generally describes providing prompts by displaying questions or statements “and corresponding options for responding, may be presented using checkboxes, buttons, radio buttons, audio or video recordings, *or in other suitable form.*” Spec. ¶ 27. Atsushi's

provided slip prompts the attendee to provide a signature and *also* prompts the attendee to respond to the certification statement. Atsushi ¶¶ 6, 17, 25 and Fig. 2. As such, based on the record before us, we are not persuaded of error in the Examiner’s determination that “under the broadest reasonable interpretation” Atsushi’s attendance slip/sheet [renders obvious] both “‘prompting for a signature’ and ‘prompting for a response to the certification statement.’” Ans. 25.

Accordingly, we affirm the Examiner’s decision to reject claims 1, 2, 5–9, 12–16, 19, and 20 as unpatentable over White, Atsushi, Terue, Smith, and Jegou.

#### DECISION

We affirmed the Examiner’s decision to reject claims 1, 2, 5–9, 12–16, 19, and 20.

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

AFFIRMED