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UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
_____

Ex parte THOMAS C. NARATIL and MARIANNE FREER
_____

Appeal 2018-003878
Application 10/931,300
Technology Center 3600
_____

Before ANTON W. FETTING, NINA L. MEDLOCK, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant[1] appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 92–130. An oral hearing was held on December 5, 2019. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED INVENTION

The claimed invention "relates to a system and method for managing funds" and, more specifically, "to a system and method for sweeping client funds between accounts" (Spec. ¶ 1).

Claims 92, 105, and 118 are the independent claims on appeal. Claim 92, reproduced below with bracketed notations added, is illustrative of the claimed subject matter:

> 92.   A computerized method for maintaining a first account based on a withdrawal limit for a cycle of a predetermined period, the method being implemented on a computer system that includes one or more physical processors executing one or more computer program instructions which, when executed, perform the method, comprising:
>
> [(a)] maintaining, via the computer system, the first account, wherein the first account is associated with the withdrawal limit, the withdrawal limit comprising a total number of withdrawals allowable from the first account within the cycle of the predetermined period;

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[1] We use the term "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Our decision references Appellant's Appeal Brief ("Appeal Br.") filed September 12, 2017 and Reply Brief ("Reply Br.") filed February 27, 2018, and the Examiner's Answer ("Ans.") mailed December 28, 2017 and Non-Final Office Action ("Non-Final Act.") mailed April 21, 2017. Appellant identifies UBS Business Solutions AG as the real party in interest. Appeal Br. 2.

[(b)] monitoring, via the computer system, a number of withdrawals associated with the first account within a first cycle of the predetermined period;

[(c)] sweeping, via the computer system, a balance in the first account into a second account when the number of withdrawals associated with the first account within the first cycle is at least equal to the withdrawal limit;

[(d)] receiving, via the computer system, during the first cycle, a withdrawal request comprising a withdrawal amount;

[(e)] effecting, via the computer system, a withdrawal of a first withdrawal amount of the withdrawal amount from a third account when a balance of the third account satisfies a threshold amount, wherein the withdrawal of the first withdrawal amount from the third account does not cause a resulting balance in the third account to be less than the threshold amount;

[(f)] effecting, via the computer system, a withdrawal of a second withdrawal amount of the withdrawal amount from the first account when the balance of the third account satisfies the threshold amount, the first withdrawal amount is less than the withdrawal amount, and the number of withdrawals associated with the first account within the first cycle is less than the withdrawal limit;

[(g)] effecting, via the computer system, a withdrawal of the second withdrawal amount from the second account when the balance of the third account satisfies the threshold amount, the first withdrawal amount is less than the withdrawal amount, and the number of withdrawals associated with the first account within the first cycle is at least equal to the withdrawal limit;

[(h)] effecting, via the computer system, a withdrawal of the withdrawal amount from at least one of the first account or the second account when the balance in the third account does not satisfy the threshold amount; and

[(i)] sweeping, via the computer system, a balance in the second account into the first account when a second cycle subsequent to the first cycle begins.

REJECTION

Claims 92–130 are rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.

ANALYSIS

Appellant argues the pending claims as a group (Appeal Br. 7–20). We select independent claim 92 as representative. The remaining claims stand or fall with claim 92. *See* 37 C.F.R. §41.37(c)(1)(iv).

Under 35 U.S.C. § 101, an invention is patent eligible if it claims a "new and useful process, machine, manufacture, or composition of matter." 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: "[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).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), "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.*, 573 U.S. at 217. The first step in that analysis is to "determine whether the claims at issue are directed to one of those patent-ineligible concepts." *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered "individually and 'as an ordered combination'" to determine whether there are additional elements that "'transform the nature of the claim' into a patent-eligible application." *Id.* (quoting *Mayo*, 566 U.S. at 79, 78). This is "a search for an 'inventive concept' — *i.e.*, 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.'" *Id.* at 217–18 (alteration in original).

In rejecting the pending claims under 35 U.S.C. § 101, the Examiner determined that independent claims 92, 105, and 118 are directed to "maintaining a first account based on a withdrawal limit for a cycle of a predetermined period," which the Examiner concluded is "similar to the commercial practices that have been found by the courts to be abstract ideas" (Non-Final Act. 7–9). The Examiner further determined that independent claims 92, 105, and 118 do not include "limitations that are 'significantly more' than the abstract idea" (*id.* at 4–5) and that dependent claims 93–104, 106–117, and 119–130 "do not remedy the deficiencies of the independent claims" (*id.* at 11).

After Appellant's briefs were filed, and the Examiner's Answer mailed, the U.S. Patent and Trademark Office (the "USPTO") published revised guidance on January 7, 2019 for use by USPTO personnel in evaluating subject matter eligibility under 35 U.S.C. § 101. 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50, 57 (Jan. 7, 2019) (the "2019 Revised Guidance"). That guidance revised the USPTO's examination procedure with respect to the first step of the *Mayo/Alice* framework by (1) "[p]roviding groupings of subject matter that [are] considered an abstract idea"; and (2) clarifying that a claim is not "directed to" a judicial exception if the judicial exception is integrated into a practical application of that exception. *Id.* at 50. The 2019 Revised

5

Guidance, by its terms, applies to all applications, and to all patents resulting from applications, filed before, on, or after January 7, 2019. *Id.*[2]

Step One of the Mayo/Alice Framework (*2019 Revised Guidance*, *Step 2A*)

The first step in the *Mayo*/*Alice* framework, as mentioned above, is to determine whether the claims at issue are "directed to" a patent-ineligible concept, e.g., an abstract idea. *Alice Corp.*, 573 U.S. at 217. This first step, as set forth in the 2019 Revised Guidance (i.e., Step 2A), is a two-prong test; in Step 2A, Prong One, we look to whether the claim recites a judicial exception, e.g., one of the following three groupings of abstract ideas: (1) mathematical concepts; (2) certain methods of organizing human activity, e.g., fundamental economic principles or practices, commercial or legal interactions; and (3) mental processes. 2019 Revised Guidance, 84 Fed. Reg. at 54. If so, we next consider whether the claim includes additional elements, beyond the judicial exception, that "integrate the [judicial] exception into a practical application," i.e., that 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 judicial exception ("Step 2A, Prong Two"). *Id.* at 54–55. Only if the claim (1) recites a judicial exception and (2) does not integrate

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[2] The 2019 Revised Guidance supersedes MANUAL OF PATENT EXAMINING PROCEDURE ("MPEP") § 2106.04(II) and also supersedes all versions of the USPTO's "Eligibility Quick Reference Sheet Identifying Abstract Ideas." *See* 2019 Revised Guidance, 84 Fed. Reg. at 51 ("Eligibility-related guidance issued prior to the Ninth Edition, R-08.2017, of the MPEP (published Jan. 2018) should not be relied upon."). Accordingly, Appellant's arguments challenging the sufficiency of the Examiner's rejection will not be addressed to the extent those arguments are based on now superseded USPTO guidance.

that exception into a practical application do we conclude that the claim is "directed to" the judicial exception, e.g., an abstract idea.

We are not persuaded, as an initial matter, that the Examiner overgeneralized the claims as directed to "maintaining a first account based on a withdrawal limit for a cycle of a predetermined period" or that the Examiner otherwise failed to consider the claims as a whole (Appeal Br. 7; *see also id.* at 14–15; Reply Br. 5–6). Instead, Examiner's characterization of claim 92 is, in our view, fully consistent with the Specification, as described below, including the claim language. That the claims include more words than the phrase the Examiner used to articulate the abstract idea, and that the Examiner, thus, articulates the abstract idea at a higher level of abstraction than would Appellant is an insufficient basis to persuasively argue that the claim language has been mischaracterized or that the Examiner has failed to consider the claims as a whole. *Cf. Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016) ("An abstract idea can generally be described at different levels of abstraction. As the Board has done, the claimed abstract idea could be described as generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location. It could be described in other ways, including, as indicated in the specification, taking orders from restaurant customers on a computer.").

We also do not agree with Appellant that the Examiner erred in determining that claim 92 is directed to an abstract idea (Appeal Br. 18–20). The Federal Circuit has explained that "the 'directed to' inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether 'their character as a whole is directed to excluded subject matter.'"

Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1335 (Fed. Cir. 2016)
(quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346
(Fed. Cir. 2015)). It asks whether the focus of the claims is on a specific
improvement in relevant technology or on a process that itself qualifies as an
"abstract idea" for which computers are invoked merely as a tool. *See id.*
at 1335–36. Here, the Specification (including the claim language) makes
clear that the claims focus on an abstract idea, and not on any improvement
to technology and/or a technical field.

The Specification is titled "METHOD AND SYSTEM FOR FUNDS
MANAGEMENT," and describes, in the Background section, that certain
types of financial accounts are insured; the Federal Deposit Insurance
Corporation, for example, offers insurance that may be applied to various
types of accounts, and provides coverage based on ownership and the
amount of insurance provided to each owner, e.g., up to $100,000 for each
single ownership account and up to $200,000 for each joint ownership
account (Spec. ¶ 2). Some insured accounts also may be subject to
additional restrictions, i.e., restrictions beyond the cap on insurance coverage
(*id.* ¶ 3). For example, a money market deposit account ("MMDA") may
limit the number of withdrawals that may be made within an account cycle
(e.g., within one month); a negotiable order of withdrawal ("NOW")
account, on the other hand, may require that a certain percentage of funds be
retained at all times (*id.*). The Specification describes that these restrictions
may lead to undesirable effects; for example, "the constraint on number of
withdrawals within each month on an MMDA account may limit what the
owner of the MMDA account can do and how the owner should handle
transactions related to the MMDA account" (*id.*). Similarly, "[t]he

requirement of retaining [a] certain percentage of funds in an NOW account may significantly reduce the amount of flexible fund[s] that an institution (where the NOW account resides) can use to invest on a daily basis" (*id.*).

The claimed invention provides a system and method for managing client funds by sweeping funds between multiple accounts maintained by an owner at the same financial institution (*id.* ¶ 4). The Specification, thus, discloses that in one embodiment, at least three accounts may be set up in relation to a client for sweep purposes (*id.* ¶ 7). A first account may correspond to a MMDA account, subject to a withdrawal limit during each account cycle; a second account may correspond to an NOW account; and the total balance in the MMDA and the NOW accounts may be insured up to a cap amount (*id.*). To ensure that the total balance in the first and the second account does not exceed the cap, a third account is established such that when the total balance in the first and the second account reaches the cap, a deposit is made to the third account; then when there is a positive balance exceeding a threshold in the third account, a withdrawal is made from the third account before making a withdrawal from the first or the second account — ensuring at the same time that the limit on the number of withdrawals made from the MMDA is respected (*id.*).

Consistent with this disclosure, claim 92 recites a method for maintaining a first account based on a withdrawal limit for a cycle of a predetermined period comprising: (1) maintaining a first account with a limit on the number of withdrawals that can be made within each account cycle, i.e., "maintaining, via the computer system, the first account, wherein the first account is associated with the withdrawal limit, the withdrawal limit comprising a total number of withdrawals allowable from the first account

within the cycle of the predetermined period" (step (a)); (2) monitoring the number of withdrawals from the first account within a first cycle, i.e., "monitoring, via the computer system, a number of withdrawals associated with the first account within a first cycle of the predetermined period" (step (b); (3) sweeping the funds from the first account into a second account when the withdrawal limit is reached, i.e., "sweeping, via the computer system, a balance in the first account into a second account when the number of withdrawals associated with the first account within the first cycle is at least equal to the withdrawal limit" (step (c)); (4) receiving a withdrawal request for a withdrawal amount and withdrawing a first portion of the withdrawal amount from a third account if the balance in the third account satisfies a threshold amount and the withdrawal will not cause the third account balance to drop below the threshold amount, i.e.,

> receiving, via the computer system, during the first cycle, a withdrawal request comprising a withdrawal amount; [and]
>> effecting, via the computer system, a withdrawal of a first withdrawal amount of the withdrawal amount from a third account when a balance of the third account satisfies a threshold amount, wherein the withdrawal of the first withdrawal amount from the third account does not cause a resulting balance in the third account to be less than the threshold amount

(steps (d) and (e)); (5) if the balance in the third account satisfies a threshold amount and the full amount of the withdrawal request has not been withdrawn, withdrawing a second portion of the withdrawal amount from the first account if the number of withdrawals from the first account is less than the withdrawal limit; otherwise, if the number of withdrawals from the first account is at least equal to the withdrawal limit, withdrawing the second portion of the withdrawal amount from the second account, i.e.,

> effecting, via the computer system, a withdrawal of a second withdrawal amount of the withdrawal amount from the first account when the balance of the third account satisfies the threshold amount, the first withdrawal amount is less than the withdrawal amount, and the number of withdrawals associated with the first account within the first cycle is less than the withdrawal limit; [and]
>
> effecting, via the computer system, a withdrawal of the second withdrawal amount from the second account when the balance of the third account satisfies the threshold amount, the first withdrawal amount is less than the withdrawal amount, and the number of withdrawals associated with the first account within the first cycle is at least equal to the withdrawal limit

(steps (f) and (g)); (6) withdrawing the withdrawal amount from the first account or the second account when the balance in the third account does not satisfy the threshold amount, i.e., "effecting, via the computer system, a withdrawal of the withdrawal amount from at least one of the first account or the second account when the balance in the third account does not satisfy the threshold amount" (step (h)); and (7) "sweeping, via the computer system, a balance in the second account into the first account when a second cycle subsequent to the first cycle begins" (step (i)).

These limitations, when given their broadest reasonable interpretation, recite transferring funds between multiple financial accounts and controlling withdrawals from the respective accounts in accordance with particular rules so as to maintain compliance with restrictions (e.g., relating to the number of permissible withdrawals, a required balance, an insurance cap) associated with the accounts. Simply put, claim 92 recites effecting funds transfers between, and withdrawals from, multiple financial accounts while complying with associated account restrictions, i.e., a fundamental economic

11

practice, which is a method of organizing human activity and, therefore, an abstract idea. *See* 2019 Revised Guidance, 84 Fed. Reg. at 52.

Having concluded that claim 92 recites a judicial exception, i.e., an abstract idea (Step 2A, Prong 1), we next consider whether the claim recites additional elements that integrate the judicial exception into a practical application (Step 2A, Prong 2).

The only additional elements recited in claim 92, beyond the abstract idea, are "a computer system that includes one or more physical processors" — elements that, as the Examiner observed, are disclosed in the Specification as generic computer components (Non-Final Act. 9; *see also, e.g.*, Spec. ¶¶ 110–117). We find no indication in the Specification that the operations recited in claim 92 require any specialized computer hardware or other inventive computer components, i.e., a particular machine, invoke any assertedly inventive programming, or that the claimed invention is implemented using other than generic computer components to perform generic computer functions. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) ("[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.").

We also find no indication in the Specification that the claimed invention effects a transformation or reduction of a particular article to a different state or thing. Nor do we find anything of record, short of attorney argument, that attributes an improvement in technology and/or a technical field to the claimed invention or that otherwise indicates that the claimed

invention integrates the abstract idea into a "practical application," as that phrase is used in the 2019 Revised Guidance.[3]

Appellant asserts that the pending claims "recite a particular ordered combination to provide a particular useful application that improves another technology or technical field (e.g., banking computer systems for managing multiple accounts of a single entity)" (Appeal Br. 18–19). And Appellant argues that the claims are not directed to an abstract idea because, like the claim at issue in *McRO, Inc. v. Bandai Namco Games America, Inc.*, 837 F.3d 1299 (Fed. Cir. 2016), the present claims "recite a particular technical solution that uses specific 'rules in a process specifically designed to achieve an improved technological result in conventional industry practice' (e.g., the banking industry practice)" (*id.* at 19; *see also id.* at 7–9).

Although Appellant ostensibly suggests otherwise (*see, e.g.*, *id.* at 15; Reply Br. 3–4), the Federal Circuit did not premise its determination that the claims in *McRO* were patent eligible merely on the specificity of the claimed animation scheme or on the fact that the claimed process was not the same as that previously used by human animators.[4] Instead, the court determined

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[3] The 2019 Revised Guidance references MPEP § 2106.05(a)–(c) and (e) in describing the considerations that are indicative that an additional element or combination of elements integrates the judicial exception, e.g., the abstract idea, into a practical application. 2019 Revised Guidance, 84 Fed. Reg. at 55. If the recited judicial exception is integrated into a practical application, as determined under one or more of these MPEP sections, the claim is not "directed to" the judicial exception.

[4] The court in *McRO* rejected the defendants' argument that the subject claims simply use a computer as a tool to automate conventional activity, noting, "Defendants provided no evidence that the process previously used by animators is the same as the process required by the claims," and further that "[t]he computer here is employed to perform a distinct process to

that the claim there at issue was patent eligible because, when considered as a whole, the claim was directed to a technological improvement over existing, manual 3-D animation techniques and used limited rules in a process specifically designed to achieve an improved technological result in conventional industry practice. *See McRO*, 837 F.3d at 1316. In particular, the Federal Circuit found that the claimed rules allow computers to produce accurate and realistic lip synchronization and facial expressions in animated characters that previously could only be produced by human animators. *Id.* at 1313.

Referencing steps (c) and (e) through (i), as recited in claim 92, Appellant argues here that the "'sweeping' and 'withdrawal' operations" improve "a banking system's ability to handle multiple accounts of a single entity and maintain compliance of such accounts" (Appeal Br. 19; *see also id.* at 8; Reply Br. 9–10). But, we are not persuaded that the pending claims, thus, provide a technological improvement comparable to that in *McRO*. Nor, contrary to Appellant's assertions (*id.* at 8–9; *see also id.* at 18–19; Reply Br. 9–10), do we agree that improving a bank's ability to handle multiple accounts of a single entity is a technological improvement analogous to the use of a particular configuration of inertial sensors to more accurately and efficiently measure the relative position and orientation of an

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automate a task previously performed by humans." *McRO*, 837 F.3d at 1314. But, we find nothing in *McRO* to support Appellant's argument that "a patent examiner cannot properly reject a claim under Section 101 if the examiner does not provide any evidence that at least a non-computer implemented version of a computer-implemented process required by the claims was a well-understood, routine, conventional activity" (*see, e.g.*, Appeal Br. 12).

object on a moving platform, as in *Thales Visionix Inc. v. United States*, 850 F.3d 1343 (Fed. Cir. 2017). Improving a bank's ability to handle a single entity's multiple accounts may well improve a business process. But, we are not persuaded that it achieves an improved technological result.

Appellant also misapprehends the controlling precedent to the extent Appellant maintains that claim 92 is not directed to an abstract idea because "no single prior art reference or system discloses any of the claims" (*id.* at 20). Neither a finding of novelty nor a non-obviousness determination automatically leads to the conclusion that the claimed subject matter is patent eligible. "Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry." *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent ineligible. *See Mayo*, 566 U.S. at 90; *see also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) ("The 'novelty' of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.").

We conclude, for the reasons outlined above, that claim 92 recites a method of organizing human activity, i.e., an abstract idea, and that the additional elements recited in the claim are no more than a generic components used as tools to perform the recited abstract idea. As such, they not integrate the abstract idea into a practical application. *See Alice Corp.*, 573 U.S. at 223–24 ("[W]holly generic computer implementation is not generally the sort of 'additional featur[e]' that provides any 'practical assurance that the process is more than a drafting effort designed to

monopolize the [abstract idea] itself.'") (quoting *Mayo*, 566 U.S. at 77).
Accordingly, we agree with the Examiner that claim 92 is directed to an
abstract idea.

Step Two of the Mayo/Alice Framework (2019 Revised Guidance, Step 2B)

Having determined under step one of the *Mayo/Alice* framework that
claim 92 is directed to an abstract idea, we next consider under Step 2B of
the 2019 Revised Guidance, the second step of the *Mayo/Alice* framework,
whether claim 92 includes additional elements or a combination of elements
that provides an "inventive concept," i.e., whether an additional element or
combination of elements adds specific limitations beyond the judicial
exception that are not "well-understood, routine, conventional activity" in
the field (which is indicative that an inventive concept is present) or simply
appends well-understood, routine, conventional activities previously known
to the industry to the judicial exception. 2019 Revised Guidance, 84 Fed.
Reg. at 56.

Appellant asserts here that the section 101 rejection cannot be
sustained because the Examiner has failed to provide "any explanation
supported by any evidence with regard to how the claimed invention <u>as a</u>
<u>whole</u> is a well-understood, routine, conventional activity" (Appeal Br. 7–8).
Specifically referencing steps (c) and (e) through (i), as recited in claim 92,
Appellant, thus, maintains that the rejection is improper because the
Examiner does not provide any evidence that "that at least a non-computer-
implemented version of a computer-implemented process required by the
claims was a well-understood, routine, conventional activity" (*id.* at 15–16;
see also id. at 18–20, Reply Br. 3–4).

That argument is not persuasive at least because "the relevant inquiry is not whether the claimed invention as a whole is unconventional or non-routine," *BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018), i.e., whether the claimed process merely automates "some well-known, routine, conventional activity that would otherwise be the same as the claimed process" (Appeal Br. 20). Instead, the question under step two of the *Mayo/Alice* framework (i.e., step 2B) is whether the claim includes additional elements, i.e., elements other than the abstract idea itself, that "'transform the nature of the claim' into a patent-eligible application." *Alice Corp.*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 79, 78).

Appellant references steps (c) and (e) through (i), as recited in claim 92. Yet, these steps are part of the abstract idea itself; they are not additional elements to be considered when determining whether claim 92 includes additional elements or a combination of elements that is sufficient to amount to significantly more than the judicial exception.

It could not be clearer from *Alice*, as described above, that under step two of the *Mayo/Alice* framework, the elements of each claim are considered both individually and "as an ordered combination" to determine whether the additional elements, i.e., the elements *other* than the abstract idea itself, "transform the nature of the claim" into a patent-eligible application. *Alice Corp.*, 573 U.S. at 217; *see also Mayo*, 566 U.S. at 72–73 (requiring that "a process that focuses upon the use of a natural law also contain *other* elements or a combination of elements, sometimes referred to as an 'inventive concept,' sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the natural law itself")

(emphasis added). In other words, the inventive concept under step two of

the *Mayo/Alice* framework cannot be the abstract idea itself:

> It is clear from *Mayo* that the "inventive concept" cannot be the
> abstract idea itself, and *Berkheimer . . .* leave[s] untouched the
> numerous cases from this court which have held claims ineligible
> because the only alleged "inventive concept" is the abstract idea.

Berkheimer v. HP, Inc., 890 F.3d 1369, 1374 (Fed. Cir. 2018) (Moore, J.,

concurring); *see also BSG Tech*, 899 F.3d at 1290 ("It has been clear since

Alice that a claimed invention's use of the ineligible concept to which it is

directed cannot supply the inventive concept that renders the invention

'significantly more' than that ineligible concept.") (citation omitted).

The Examiner determined here, and we agree, that the only claim

elements beyond the abstract idea are "a computer system that includes one

or more physical processors," i.e., generic computer components used to

perform generic computer functions (Non-Final Act. 9) — a determination

amply supported by, and fully consistent with the Specification (*see, e.g.*,

Spec. ¶¶ 110–117).[5] Appellant cannot reasonably contend, nor does

Appellant, that the operation of these components is not well-understood,

routine, or conventional, where, as here, there is nothing in the Specification

to indicate that the operations recited in claim 92 require any specialized

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[5] The Office's April 19, 2018 Memorandum to the Examining Corps from
Deputy Commissioner for Patent Examination Policy, Robert W. Bahr,
entitled, "Changes in Examination Procedure Pertaining to Subject Matter
Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP,
Inc.*)," available at https://www.uspto.gov/sites/default/files/documents/
memo-berkheimer-20180419.PDF, expressly directs that an examiner may
support the position that an additional element (or combination of elements)
is well-understood, routine or conventional with "[a] citation to an express
statement in the specification . . . that demonstrates the well-understood,
routine, conventional nature of the additional element(s)" (*id.* at 3).

hardware or inventive computer components, invoke any assertedly inventive software, or that the claimed invention is implemented using other than generic computer components to perform generic computer functions, e.g., receiving, transmitting, and processing information.

We are not persuaded, on the present record, that the Examiner erred in rejecting independent claim 92 under 35 U.S.C. § 101. Therefore, we sustain the Examiner's rejection of independent claim 92, and claims 93–130, which fall with claim 92.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
92–130	101	Eligibility	92–130	

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