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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ATUL ASTHANA, GARY P. MOUSSEAU, and
MIHAL LAZARIDIS

Appeal 2018-004140
Application 13/596,222
Technology Center 2400

Before JEAN R. HOMERE, NATHAN A. ENGELS, and
MELISSA A. HAAPALA, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE¹

Pursuant to 35 U.S.C. § 134(a), Appellant² appeals from the Examiner's decision to reject claims 1–20. Claims App. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

¹ We refer to the Specification, filed Aug. 28, 2012 (“Spec.”); Final Office Action, mailed Mar. 17, 2017 (“Final Act.”); Appeal Brief, filed Sept. 15, 2017 (“Appeal Br.”); Examiner’s Answer, mailed Jan. 12, 2018 (“Ans.”), and Reply Brief, filed Mar. 9, 2018 (“Reply Br.”). This appeal relates to Appeal 2013-009368 (previously decided on Sept. 24, 2015) (“Dec.”) in which we affirmed the Examiner’s anticipation rejection of claims 1–20. Dec. 5.

² 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 BlackBerry Limited. Appeal Br. 3.

II. CLAIMED SUBJECT MATTER

According to Appellant, the claimed subject matter relates to a method and system for controlling remote attachment processor (216) to process attachment (2008) received along with message (200A) by mobile communication device (214B) in a wireless network environment. Spec. 23:8–31, 49:17–30. Figure 6, reproduced below, is useful for understanding the claimed invention:

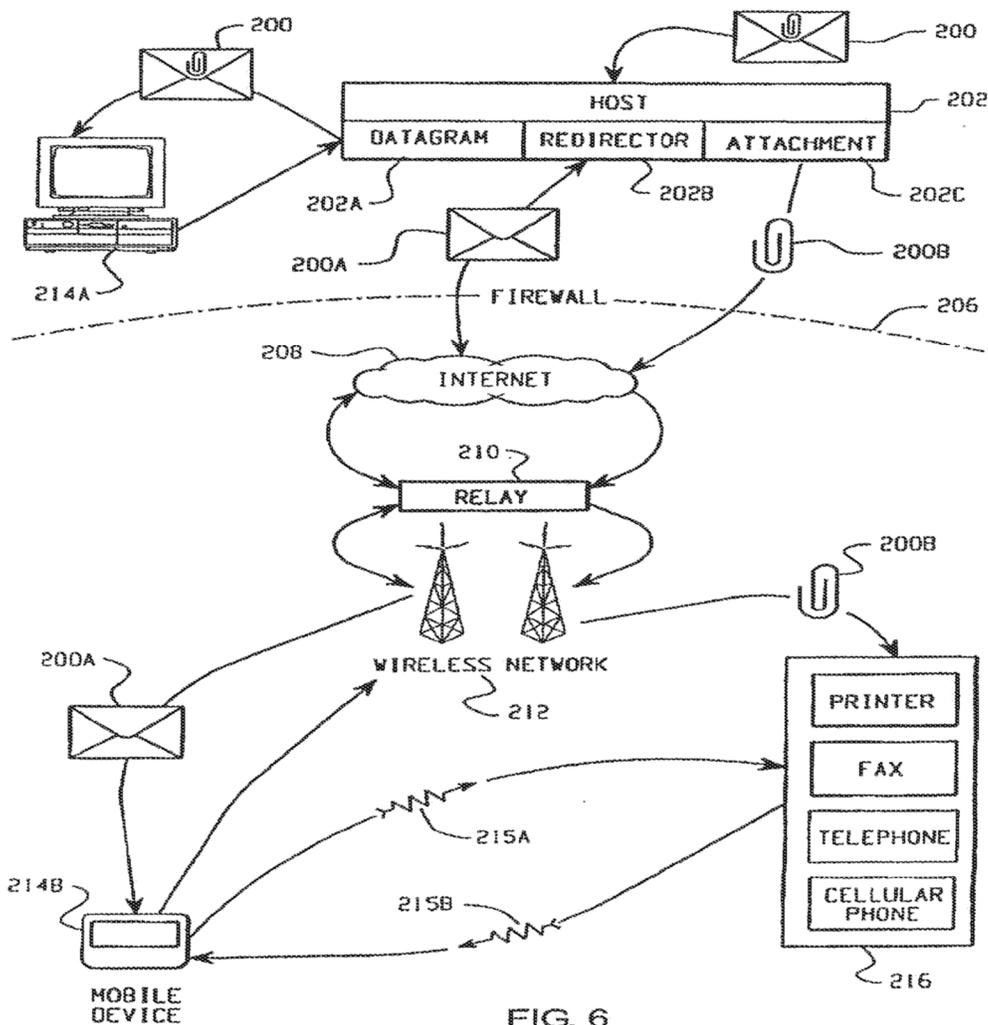


Figure 6 depicts an illustration of mobile device (214B) remotely controlling attachment processor (216) to process attachment (2008). *Id.* 7:11–12.

Claims 1 and 17 are independent. Claim 1, reproduced below with disputed limitation emphasized in *italics*, is illustrative of the claimed subject matter:

1. A method comprising:
 - receiving, by a mobile communication device, a message that included an attachment before being received by the mobile communication device;
 - determining a unique identifier of an attachment processor;
 - transmitting a request comprising the unique identifier to a directory service for service information related to using the attachment processor;*
 - receiving a response comprising the service information from the directory service;
 - creating, on the mobile communication device and based at least in part on the service information received from the directory service, an electronic message that includes a control file; and
 - transmitting, by the mobile communication device, the electronic message including the control file from the mobile communication device to the attachment processor via wireless communication;
 - the control file being configured to control the attachment processor to process the attachment, and
 - an operation of the attachment processor being at least one of started, stopped, or changed in accordance with instructions in the control file.

III. REFERENCES

The Examiner relies upon the following reference³

Name	Number	Filed	Published
Mousseau	US 6,438,585 B2	Jan. 16, 2001	Aug. 20, 2002

³ All reference citations are to the first named inventor only.

IV. REJECTIONS

The Examiner rejects claims 1–20 as follows:

1. Claim(s) 1–20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Mousseau. Final Act. 2–5.
2. Claims 1–20 are rejected under 35 U.S.C. § 101 as being directed to patent ineligible subject matter. Ans. 9–11.

V. ANALYSIS

1. Anticipation Rejection

Appellant argues the Examiner erred in finding that Mousseau anticipates independent claims 1 and 17. Appeal Br. 9–15. In particular, Appellant argues Mousseau does not describe “transmitting a request comprising a unique identifier to a directory service for service information related to using the attachment processor,” as recited in the claims. Appeal Br. 12. According to Appellant, Mousseau’s disclosure of the mobile device querying attachment displays within its local proximity, and receiving responses including electronic addresses of the displays does not describe the disputed limitations because the mobile device does not know the electronic address of the displays until after receiving the responses. *Id.* at 12–13 (citing Mousseau 16:1–14). Further, Appellant argues that even if Mousseau’s database of attachment displays were a directory service including display location, compatibility, and security, Mousseau does not describe querying the database with a unique identifier of attachment displays. *Id.* at 13. These arguments are persuasive.

The Examiner finds that Mousseau discloses a directory service residing in one or more attachment displays and/or a database of a host system. Ans. 6 (citing Mousseau 16:26–42). Mousseau discloses a preferred

embodiment wherein a mobile device, upon receiving a message with an attachment, queries attachment displayers within its vicinity to determine which one can process the attachment, sends to the host the location electronic address and type of attachment the identified attachment displayer can handle, and the host forwards the attachment to the attachment displayer for processing. Mousseau 15:66–16:25. Mousseau also discloses an alternative embodiment wherein a host system including a database of attachment displayers from which a mobile device user can select an attachment displayer based on its type and function. *Id.* at 16:26–42.

As an initial matter, we note that the Examiner relies upon two distinct embodiments of Mousseau to make the anticipation rejection.⁴ We agree with Appellant that because Mousseau’s preferred embodiment describes querying the attachment displayers to obtain the unique identifier of an attachment displayer capable of processing a received attachment, such querying would not include the unique identifier. We also agree with Appellant that, because the mobile device merely selects a desired attachment displayer from the database/directory service in Mousseau’s

⁴ In an anticipation rejection, “it is not enough that the prior art reference . . . includes multiple, distinct teachings that [an ordinary] artisan might somehow combine to achieve the claimed invention.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). Rather, the reference must “clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” *Id.* (quoting *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972)). Thus, while “[s]uch picking and choosing may be entirely proper in the making of a 103, obviousness rejection . . . it has no place in the making of a 102, anticipation rejection.” *Arkley*, 455 F.2d at 587–88.

alternative embodiment, Mousseau does not describe transmitting a request including a unique identifier of an attachment displayer to a directory service. Because Appellant has shown at least one reversible error in the Examiner's anticipation rejection of claims 1 and 17, we do not reach Appellant's remaining arguments.

Accordingly, we do not sustain the Examiner's anticipation rejection of independent claims 1 and 17, each of which includes the argued limitation. Likewise, we do not sustain the rejections of claims 2–16 and 18–20, which also recite the disputed limitation.

2. Patent Eligibility Rejection

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 U.S. 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) (quoting *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

In determining whether a claim falls within an excluded category, we are guided by the Court's two-step framework, described in *Mayo* and *Alice*. *Alice*, 573 U.S. 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, 67 (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” (*Diehr*, 450 U.S. at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 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 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 187; *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 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*); *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. “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 Office published revised guidance on the application of § 101. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50–57 (Jan. 7, 2019) (“2019 PEG”). Recently, the Office published an update to that guidance. *October 2019 Patent Eligibility Guidance Update*, 84 Fed. Reg. 55,942 (hereinafter “PEG Update”). Under the 2019 PEG and PEG Update (collectively referred to as “2019 Updated PEG”), 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* MPEP § 2106.05(a)–(c), (e)–(h)).⁵

⁵ All references to the MPEP are to 9th Ed., Rev. 08.2017 (Jan. 2018).

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See 2019 Updated PEG, 52, and 55–56. 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 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.

See 2019 Updated PEG 56.

We analyze the patent-eligibility rejection with the principles identified above in mind.

Examiner’s Findings and Conclusions

In the first part of the *Alice* inquiry, the Examiner determines that claims 1–20 are directed to the abstract idea of “routing email messages based on specific criteria rules (controls),” which does not improve computer technology. Ans. 10.

In the second part of the *Alice* inquiry, the Examiner determines the claims do not recite additional elements sufficient to amount to significantly more than the abstract idea. *Id.* According to the Examiner, the claimed subject matter fails to show an inventive concept because it operates on generic hardware according to conventional functionality to perform the abstract idea, and thereby does not transform the abstract idea into something significantly more than the abstract idea. *Id.* (citing *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307 (Fed. Cir. 2016)).

Appellant’s Arguments and Contentions

In the first part of the *Alice* inquiry, Appellant argues that the Examiner's prima facie case of patent ineligibility is in error because the Examiner has characterized the claim language at a high level of abstraction to which the Examiner subsequently misapplied the case law. Reply Br. 4–5. In particular, Appellant argues that unlike *Intellectual Ventures*, the claims are not directed to “determining whether file content identifiers match characteristics of other file content identifiers, and outputting an indication of the characteristic of the data file based on the determining.” *Id.* at 5. According to Appellant, the claimed subject matter is instead directed to controlling an outside device based on performed processing, and transcends the mere receiving, determining, and outputting of data as in *Intellectual Ventures*. *Id.* at 5–6. In particular, Appellant asserts the following:

[T]he present claims require, among other elements, receiving a message that previously contained an attachment, determining a unique identifier of an attachment processor, obtaining information related to using the attachment processor, creating a control file based on the received service information, and transmitting the control file to the attachment processor to start, stop, or change an operation of the attachment processor in processing the attachment previously attached to the received message. Thus, not only are the present claims not directed to the concept of routing messages according to rules, as alleged in the Examiner's Answer.

Id. at 5.

Further, Appellant argues that the claimed subject matter improves how message attachments are processed by remotely controlling a device performing such processing thereby improving the device itself as well as the larger technological area of message and attachment delivery and processing. *Id.* at 6 (citing *Enfish LLC v. Microsoft Corp.*, 822 F.3d 1327

(Fed. Cir. 2016)). Therefore, Appellant submits that the claimed subject matter provides a technical solution to a problem arising uniquely from the realm of computer technology. *Id.* at 7–8 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014)).

In the second part of the *Alice* inquiry, Appellant argues that the claims, taken as a whole and in an ordered combination amount to significantly more than the purported abstract idea. *Id.* at 8–9. According to Appellant, while the concept of routing electronic messages was known at the time of filing of the present application, in 2001, mobile electronic devices lacked a significant number of technological advances and capabilities present in modern smart devices. *Id.* at 9. Accordingly, Appellant submits claim 1 solves that problem by moving processing of the attachment from the end user’s device to a remotely-located device. *Id.* Furthermore, Appellant argues that the claimed subject matter does not preempt all ways of routing electronic messages or processing attachments, but instead recites a discrete implementation for controlling an attachment processor to process attachments under the control of the user device, and the claimed subject matter is a technical improvement in ways of handling electronic message attachments. *Id.* at 9–10 (citing *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)).

Our Review

Applying the guidance set forth in the 2019 Updated PEG and controlling case law, we determine whether the Examiner has erred in rejecting the claims as directed to patent ineligible subject matter.

In revised step 1 of 2019 PEG, we consider whether the claimed subject matter falls within the four statutory categories of patent-eligible

subject matter identified by 35 U.S.C. § 101: process, machine, manufacture, or composition of matter. Because independent claim 1 recites a “method” including a number of steps, claim 1 falls within the “process” category of patent-eligible subject matter. Because independent claim 17 recites a “system” including a processor for performing various functions, claim 17 falls within the “machine” category of patent-eligible subject matter.

In prong 1 of revised step 2A of the 2019 PEG, we determine whether any judicial exception to patent eligibility is recited in the claims. The guidance identifies three judicially-excepted groupings of abstract ideas: (1) mathematical concepts; (2) certain methods of organizing human activity, such as fundamental economic practices; and (3) mental processes. As noted by Appellant, independent claim 1 recites, *inter alia*, a method including the steps of “receiving a message that previously contained an attachment, determining a unique identifier of an attachment processor, obtaining information related to using the attachment processor, creating a control file based on the received service information, and transmitting the control file to the attachment processor to start, stop, or change an operation of the attachment processor in processing the attachment previously attached to the received message.” Reply Br. 5. In sum, the cited claims steps involve a mobile device, which:

- (1) upon receiving a message including an attachment, transmits to a directory service a request including the unique ID of an attachment processor capable of processing the attachment;

- (2) creates an electronic message that includes a control file and is based on service information received from the directory service;
- (3) transmits to the identified attachment processor the control file with instructions on how to process the attachment.

Therefore, claim 1 recites a mobile device routing to an identified attachment processor an attachment along with a control file containing instructions on how to process the attachment. Such a manipulation of the attachment relates to the pre-Internet activity of handling messages such that a party incapable of processing or understanding a received message looks up a competent party to which it routes the message along with instructions on how to process, translate or format the message at the behest of the requesting party. As drafted, these limitations, under their broadest reasonable interpretation, recite a mental process that can be performed in the human mind or using a pen and paper. *See, e.g., CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) (determining that a claim whose “steps can be performed in the human mind, or by a human using a pen and paper” is directed to an unpatentable mental process). Consequently, the claim recites the mental process of routing a message to an identified party for processing according to instructions provided by a requestor. We thus agree with the Examiner that the claimed subject matter is merely directed to routing received data [to an identified party] for processing and outputting the processed data as per received instructions consistent with *Intellectual Ventures*. Ans. 10.

Accordingly, independent claims 1 and 17 recite the judicial exception of a mental process.

Having determined that the claims recite a judicial exception, our analysis under the 2019 PEG turns now to determining whether there are “additional elements that integrate the judicial exception into a practical application.” *See* MPEP § 2106.05(a)–(c), (e)–(h).⁶ “Integration into a practical application” requires an additional element or a combination of additional elements in the claim to 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 exception. 84 Fed. Reg. at 53.

Appellant’s claims 1 and 17 recite computer-related limitations (e.g., mobile communication device, attachment processor). Appellant argues that “the present claims provide an improvement in the processing of message attachments and the remote control of a device performing such processing.” Reply Br. 6. “Therefore, a device that would otherwise receive an attachment which is useless to the device (e.g., incapable of display or

⁶ Specifically, we determine whether the claims recite:

- (i) an improvement to the functioning of a computer [(or a mobile device)];
- (ii) an improvement to another technology or technical field;
- (iii) an application of the abstract idea with, or by use of, a particular machine;
- (iv) a transformation or reduction of a particular article to a different state or thing; or
- (v) other meaningful limitations beyond generally linking the use of the abstract idea to a particular technological environment.

Id.

processing on the device), instead becomes capable of being processed under the control of the device, improving the device itself and improving the larger technological area of message and attachment delivery and processing.” *Id.*(citing Spec. ¶¶ 46, 47, 196–202).

We do not find the recited computer-related limitations are sufficient to integrate the judicial exception into a practical application. Although the claim nominally requires these steps to be performed by the mobile communication device and the attachment processor, this computer implementation of a mental process is insufficient to take the invention out of the realm of abstract ideas. *Versata Dev. Grp. v. SAP Am., Inc.*, 793 F.3d 1306, 1335 (Fed. Cir. 2015) (“Courts have examined claims that required the use of a computer and still found that the underlying, patent-ineligible invention could be performed via pen and paper or in a person’s mind.”); *Alice*, 573 U.S. at 223 (“Stating an abstract idea while adding the words ‘apply it with a computer’” is insufficient to confer eligibility.). Further, the Specification does not provide additional details about the mobile communication device and the attachment processor that would distinguish them from any generic processing devices that communicate with one another in a wireless computer network environment. Although we do not dispute that these processing and communications devices include specific instructions for performing the recited functions, Appellant has not explained persuasively how the derived content transforms the received attachment into a new state or thing. *See* MPEP § 2106.05(a). Rather, the claims merely adapt the mental process of routing a received message to an identified capable party for subsequent processing according to instructions provided by a requestor. *See Credit Acceptance Corp. v. Westlake Servs.*,

859 F.3d 1044, 1055 (Fed. Cir. 2017) (“Our prior cases have made clear that mere automation of manual processes using generic computers does not constitute a patentable improvement in computer technology.”); *see also Bancorp Services, L.L.C. v. Sun Life Assurance Co. of Canada (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (A computer “employed only for its most basic function . . . does not impose meaningful limits on the scope of those claims.”).

Further, Appellant’s identified improvements are to the abstract idea itself, not improvements to a technology or computer functionality. That is, the cited claim limitations do not improve the functionality of the processing devices by performing operations to route a message to another party for processing according to instructions provided by a requestor, nor do they achieve an improved technological result in conventional industry practice. *See McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1316 (Fed. Cir. 2016). Thus, we do not agree with Appellant that the claims recite an additional element reflecting an improvement in the functioning of a computer, or an improvement to other technology or technical field. *See DDR Holdings* 773 F.3d at 1258–59.

Nor do the claims recite an additional element that implements the abstract idea with a particular machine or manufacture that is integral to the claim. Instead, the claim limitations only recite additional elements that add insignificant extra-solution activity to the judicial exception. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011). Prior to the Internet, such activities were widely practiced, and became computerized to facilitate the routing of messages to an identified party for subsequent translation according to the instructions provided by the

requesting party. *See OIP Technologies, Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1364 (Fed. Cir. 2015).

Because the claimed subject matter outlined above does not (1) provide any technical solution to a technical problem as required by *DDR Holdings*;⁷ (2) provide any particular practical application as required by *BASCOM*; or (3) entail an unconventional technological solution to a technological problem as required by *Amdocs*,⁸ we agree with the Examiner’s determination that Appellant’s claims 1 and 17 are directed to an abstract idea that is not integrated into a practical application.

Alice/Mayo—Step 2B (Inventive Concept)

Turning to step 2B of the 2019 PEG, we look to whether the claim: (a) recites a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field; or (b) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. 84 Fed. Reg. 56; *see Alice*, 573 U.S. at 217 (“[W]e consider the elements of each claim both individually and ‘as an ordered combination’” to determine whether the claim includes “significantly more” than the ineligible concept); *see also BASCOM*, 827 F.3d at 1350 (“[A]n inventive

⁷ The Federal Circuit found *DDR*’s claims are patent-eligible under 35 U.S.C. § 101 because *DDR*’s claims: (1) do not merely recite “the performance of some business practice known from the pre-Internet world” previously disclosed in *Bilski* and *Alice*; but instead (2) provide a technical solution to a technical problem unique to the Internet, i.e., a “solution . . . necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” *DDR Holdings*, 773 F.3d at 1257.

⁸ *See Amdocs Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016).

concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.”).

We discern no additional element or combination of elements recited in Appellant’s independent claims 1 and 17 that contain any “inventive concept” or add anything “significantly more” to transform the abstract concept into a patent-eligible application. *Alice*, 573 U.S. at 221. We are not persuaded by Appellant’s remarks, noted above, alleging the claims are directed to a non-routine and unconventional system because it entails instructing a remote computing device to process an attachment. Appellant has failed to establish on this record how the processing of an attachment by a remote computing device according to received instructions is distinguished from the conventional processing of data routed to an identified party as per the instructions provided by a requesting party. We agree with the Examiner that using generic processing and communication devices to collect, analyze, process data and displaying the result in the manner suggested is a routine and conventional approach to data management. Ans. 10.

As noted above, Appellant does not direct our attention to any portion of the Specification indicating that the claimed processing and communication devices perform anything other than well-understood, routine, and conventional functions, such as receiving, analyzing, processing, and displaying data. *See Elec. Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016) (“Nothing in the claims, understood in light of the [S]pecification, requires anything other than off-the-shelf, conventional computer, network, and display technology for gathering, sending, and presenting the desired information.”); *see also Alice*,

573 U.S. at 224–26 (receiving, storing, sending information over networks insufficient to add an inventive concept); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (“That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive.”). Instead, Appellant’s claimed subject matter simply uses generic computer components (computer system) to perform the abstract idea of routing a message to another party for processing according to instructions provided by a requestor. As noted above, the use of a generic computer does not alone transform an otherwise abstract idea into patent-eligible subject matter. As our reviewing court has observed, “after *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.” *DDR*, 773 F.3d at 1256 (citing *Alice*, 573 U.S. at 223).

Because the discussed claim elements only recite generic computer functions that are well-understood, routine, and conventional, individually and in combination, the claim is devoid of an inventive concept. *See Alice*, 573 U.S. at 217. “[T]he ‘inventive concept’ [under the second part of the *Mayo/Alice* test] cannot be the abstract idea itself” and “*Berkheimer* . . . leave[s] untouched the numerous cases from [the Federal Circuit] 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). “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.” *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018). We, therefore, agree with the Examiner that the

computer functions recited in the claims were, in fact, generic, and are met by numerous precedent establishing that using a generic computer to expedite and automate processes traditionally performed manually, or that are otherwise abstract, is a well-understood, routine, and conventional use of such computers. Final Act. 4–5; *see also, e.g., Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d at 1321 (utilizing an intermediary computer to forward information); *Bancorp Services, L.L.C.*, 687 F.3d at 1278 (“The computer required by some of Bancorp’s claims is employed only for its most basic function, the performance of repetitive calculations, and as such does not impose meaningful limits on the scope of those claims.”).

Therefore, we conclude that claim 1’s elements, both individually and as an ordered combination, do not provide an inventive concept. *See* 84 Fed. Reg. 56; *see also Berkheimer*, 881 F.3d at 1370 (“The limitations amount to no more than performing the abstract idea of parsing and comparing data with conventional computer components.”); *Bancorp*, 687 F.3d at 1278 (“[T]he use of a computer in an otherwise patent-ineligible process for no more than its most basic function—making calculations or computations—fails to circumvent the prohibition against patenting abstract ideas and mental processes.”).

To the extent Appellant argues the claims necessarily contain an “inventive concept” based on their alleged novelty or non-obviousness over the cited references, Appellant misapprehends the controlling precedent. Although the second part in the *Alice/Mayo* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but, rather, a search for “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 217–218 (quoting *Mayo*, 566 U.S. 72–73). A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90.

In many cases, “relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.” *OIP Techs.*, 788 F.3d at 1363 (citing *Alice*, 573 U.S. at 224) (“[U]se of a computer to create electronic records, track multiple transactions, and issue simultaneous instructions” is not an inventive concept.); *see also, e.g., Intellectual Ventures I LLC v. Capital One Bank*, 792 F.3d at 1370 (“[M]erely adding computer functionality to increase the speed or efficiency of the process does not confer patent eligibility on an otherwise abstract idea.”). Therefore, the functions recited in independent claims 1 and 17 do not add meaningful limitations beyond generally linking the abstract idea to the particular technological environment. *See Ans. 10.*

Appellant’s arguments asserting that the claims do not block others from using the abstraction do not persuade us that the claims are directed to patent eligible material. Pre-emption is not a separate test for eligibility.

To be clear, the proper focus is not preemption *per se*, for some measure of preemption is intrinsic in the statutory right granted with every patent to exclude competitors, for a limited time, from practicing the claimed invention. *See* 35 U.S.C. § 154. Rather, the animating concern is that claims should not be coextensive with a natural law, natural phenomenon, or abstract idea; a patent-eligible claim must include one or more substantive limitations that, in the words of the Supreme Court, add “significantly more” to the basic principle, with the result that the claim covers significantly *less*. *See Mayo*[, 566 U.S. at 72–73]. Thus, broad claims do not necessarily raise § 101

preemption concerns, and seemingly narrower claims are not necessarily exempt.

CLS Bank Int'l v. Alice Corp. Pty. Ltd., 717 F.3d 1269, 1281 (Fed. Cir. 2013) (Lourie, J., concurring), *aff'd*, 573 U.S. 208; *see also Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”). Because we find the claimed subject matter covers patent-ineligible subject matter, the pre-emption concern is necessarily addressed. “Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, . . . preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics*, 788 F.3d at 1379.

Because Appellant’s claims 1 and 17 are directed to a patent-ineligible abstract concept and do not recite something “significantly more” under the second prong of the *Alice* analysis, we sustain the Examiner’s rejection of independent claims 1 and 17 under 35 U.S.C. § 101.

Appellant does not present additional arguments for dependent claims 2–16 and 18–20. Accordingly, for the same reasons as set forth for independent claims 1 and 17, we sustain the Examiner’s 35 U.S.C. § 101 rejection of dependent claims 2–16 and 18–20.

VI. CONCLUSION

We reverse the Examiner’s anticipation rejection of claims 1–20 under 35 U.S.C. § 102. However, we affirm the Examiner’s patent eligibility rejection of claims 1–20 under 35 U.S.C. § 101.

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Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-20	101	Eligibility	1-20	
1-20	102	Mousseau		1-20
Overall Outcome			1-20	

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

AFFIRMED