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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NANCY ELLEN KHO, JUDY J. PIPER, and
MARY ELLEN ZURKO

Appeal 2018-004281
Application 12/634,485
Technology Center 3600

Before JOSEPH L. DIXON, KEVIN F. TURNER, and JOHN A. EVANS,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 1–14 and 16–21. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The claims are directed to providing schedule related information to external entities enabling providers of products and services to make offers to potential consumers. (Spec. ¶ 1.) Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method for providing schedule related information to external entities, the method comprising:

storing schedule data of a user on a server, said schedule data corresponding to a computerized calendar service and including a number of events that said user has placed on an electronic calendar, wherein each said event calls for a number of products or services that will be purchased by said user in connection with that event;

selectively exposing, with electronic access to said computerized calendar service, at least a portion of said schedule data stored by said server to an entity other than said user via electronic communication to said entity; and

enabling said entity to electronically communicate an offer based on said schedule data to said user to provide a number of said products or services in connection with a corresponding event on said user's electronic calendar.

REFERENCES

No prior art is relied upon by the Examiner in rejecting the claims on appeal.

REJECTION

The Examiner made the following rejection:

Claims 1–14 and 16–21 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more.

ANALYSIS

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. 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. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012) (brackets in original) (citing *Diamond v. Diehr*, 450 U.S. 175, 185 (1981)).

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*. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217–18 (2014) (citing *Mayo*, 566 U.S. at 75–77). In accordance with that framework, we first determine what concept the claim is “directed to.” See *Alice*, 573 U.S. at 218–19 (“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” (*Diehr*, 450 U.S. at 191); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 183 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1853))); 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 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 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 (internal quotation marks 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 § 101. USPTO, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (January 7, 2019) (“Revised Guidance”). 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) (“Prong One”); and
- (2) additional elements that integrate the judicial exception into a practical application (“Prong Two”) (*see* MPEP § 2106.05(a)–(c), (e)–(h)) (9th ed. 2018).

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 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 Revised Guidance.

Claims 1–14 and 16–21: Ineligible Subject Matter

Appellants present arguments to claims 1–14 and 16–21 as a group. (App Br. 11.) Appellants’ specifically address independent claim 20 which is more specific than independent claim 1. Because Appellants have not presented separate arguments for patentability, we select independent claim 1 as the representative claim for the group and will address Appellants’ arguments thereto. (*Id.*) Thus, we address in detail the appeal of the § 101 rejection of independent claim 1 with which the § 101 rejection of claims 1–14 and 16–21 stand or fall. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2017); *In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986).

Revised Guidance Step 1

Step 1 of the Revised Guidance asks 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. *See Revised Guidance.* Claim 1 recites “[a] method for providing schedule related information to external entities.” Appellants do not argue the Examiner erred in concluding claim 1 falls within the four statutory categories of patentable subject matter. (App. Br. 11.) We agree with the Examiner’s conclusion because claim 1 falls within the process category.

Revised Guidance Step 2A(i) (“Prong One”)

Under Step 2A(i) of the Revised Guidance, we determine whether the claims recite 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). *See* Revised Guidance.

The Examiner maintains that independent claim 1 is directed to communicating offers based on calendar information, which falls into the category of (ii) a method of organizing human activities and (iii) an idea of itself. (Final Act. 5.) The Examiner further maintains the “steps of storing data, exposing a calendar to a different entity and presenting an offer are a textbook case of automating a process that can or has been previously performed by a person.” (*Id.* at 4.)

We refine the Examiner’s determination of the abstract idea to identify that claim 1 recites the following limitations in the *method for providing schedule related information to external entities*, the method comprising:

storing schedule data of a user on a server, said schedule data corresponding to a computerized calendar service and including a number of events that said user has placed on an electronic calendar, wherein each said event calls for a number of products or services that will be purchased by said user in connection with that event;

selectively exposing, with electronic access to said computerized calendar service, at least a portion of said schedule data stored by said server to an entity other than said user via electronic communication to said entity; and

enabling said entity to electronically communicate an offer based on said schedule data to said user to provide a

number of said products or services in connection with a corresponding event on said user's electronic calendar.

App. Br. 18 (Claims App'x) (emphasis added). These limitations, under their broadest reasonable interpretation, recite a method of providing schedule related information to external entities. We additionally note the claimed method provides no details of the system or server.

We find the italicized language of independent claim 1 sets forth a method of providing schedule related information to external entities and allowing entities to communicate an offer based on the schedule data. The claimed invention retrieves this additional information and uses the information. This is similar to the claims in *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1344–45 (Fed. Cir. 2018) (concluding that “[s]tanding alone, the act of providing someone an additional set of information without disrupting the ongoing provision of an initial set of information is an abstract idea,” and observing that the district court “pointed to the nontechnical human activity of passing a note to a person who is in the middle of a meeting or conversation as further illustrating the basic, longstanding practice that is the focus of the [patent-ineligible] claimed invention”).

Accordingly, we conclude claim 1 recites a method of managing personal behavior or relationships or interactions between people, which is one of the certain methods of human activities identified in the Revised Guidance, and thus, an abstract idea. Revised Guidance 52.

Claim 1 recites various limitations consistent with this characterization, and the Specification further supports this characterization:

By allowing users (120) to publish their trip information along with information about desired services, businesses may

be able to better target potential customers by creating specialized deals and packaged services to specific individuals. In addition, the user (120) does not need to spend a great amount of time searching for acceptable rates and services.

(Spec. ¶ 32.)

The Specification further discloses a generic “server” with little detail regarding the interface between the stored calendar information and the entities accessing and using the calendar information. (Spec. ¶¶ 30, 51.)

From this high level of description in the Specification, we find Appellants’ Specification merely identifies a generic computer processor that performs the function of exposing calendar database information and interacting with a user to provide offers for future travel plans without any substantive details thereof.

Under the Revised Guidance, judicial exceptions include certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes). We find the Examiner has shown the claimed invention is directed to organizing human activity as described in the Revised Guidance. Moreover, we find the Examiner’s analysis based on the Examiner’s statement of the abstract idea supports the Examiner’s conclusion of a lack of patent-eligible subject matter.

As a result, on the record before us, the invention as recited in representative independent claim 1 is directed to certain methods of organizing human activity such as a commercial or legal interactions and managing personal behavior and, thus, is directed to an abstract idea.

Revised Guidance Step 2A(ii) (“Prong Two”)

Under the Revised Guidance, if a claim recites a judicial exception, in Step 2A(ii) 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. If the recited judicial exception is integrated into a practical application, the claim is not *directed to* the judicial exception.

We find the steps of “storing schedule data of a user on a server, said schedule data corresponding to a computerized calendar service and including a number of events that said user has placed on an electronic calendar” to be directed to insignificant extra-solution activity. The court also guides that data gathering is a classic example of insignificant extra-solution activity. This step simply gathers data for other method steps and is, thus, insignificant extra-solution activity. *See, e.g., CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011) (“We have held that mere ‘[data-gathering] step[s] cannot make an otherwise nonstatutory claim statutory’” (alterations in original) (quoting *In re Grams*, 888 F.2d 835, 840 (Fed. Cir. 1989)).); *see also* Revised Guidance, 84 Fed. Reg. at 55 (Identifying “add[ing] insignificant extra-solution activity to the” abstract idea as an example of when an abstract idea has not been integrated into a practical application.).

We find that Appellants did not dispute any additional limitations in the claimed invention with respect to the abstract idea (*see generally* App. Br. 13–17), and the Examiner made specific findings and conclusions in the

Examiner's Answer with regards to these additional elements as they relate to Step 2B of the *Alice* analysis. (*See generally* Ans. 3–5.)

The Examiner maintains that:

Appellant[s] also appear[] to be confusing the 2B elements with those of the abstract idea. In the instant application, the elements that can be considered significantly more include a server, electronic calendar, computer readable medium, computerized calendar service, processor and memory. None of these elements alone or in combination with the limitations, perform any type of transformation or improve the functioning of the compeer [sic] itself. In fact these elements perform as they are normally designed to.

(*See id.* at 3–4.)

Considering the claim as a whole, interaction of all the steps using the available data at an unspecified location “on a server” and “computerized calendar” does not apply or use the abstract idea in a meaningful way such that the claim as a whole is more than a drafting effort designed to monopolize the exception. Thus, we determine that the abstract idea is not integrated into a practical application.

As a result, on the record before us, the invention as recited in representative independent claim 1 is additionally directed to certain methods of organizing human activity such as a commercial or legal interactions and managing personal behavior and, thus, is directed to an abstract idea.

Appellants contend:

[I]n one aspect of the claimed subject matter, a user's electronic calendar is modified by a vendor, when permitted by the user, to include a customized offer for a product or service that the user needs for an upcoming event on the electronic calendar. In this way, the functionality of the electronic calendar is augmented and improved for the user. The calendar becomes,

not just a repository for recording appointments, but also a marketplace for receiving customized offers to meet specific needs at those events.

(App. Br. 12.) Although we agree with Appellants that independent claim 20 also recites “making an entry on a date on a calendar view of said electronic calendar to indicate that an offer has been made by said entity for a product or service called for by an event scheduled on that date” there is no corresponding limitation in representative independent claim 1.¹ (*Id.* at 23 (Claims App’x).) Additionally, we find that the mere display to indicate that an offer has been made does not further limit the abstract idea and merely provides insignificant extra-solution activity addressed below with respect to *Step 2A(ii)* (“*Prong Two*”). See also *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F. 3d 1359, 1363 (Fed. Cir. 2015) (explaining that “relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible” (citing *Alice*, 573 U.S. at 224 (“use of a computer to create electronic records, track multiple transactions, and issue simultaneous instructions” is not an inventive concept)). See *Univ. of Fla. Research Found., Inc. v. General Elec. Co.*, No. 2018-1284, 2019 WL 921859, at *4 (Fed. Cir. Feb. 26, 2019) (noting that although the claimed invention may “result in life altering consequences . . . is laudable, [] it does not render [the claims] any less abstract”).

¹ Furthermore, we note that Appellants’ Summary of the Claimed Subject Matter generally indicates “Appellant[s]’ Specification, Fig. 4B” support, but we find no corresponding disclosure. Rather, we find Figure 4A and paragraph 46 disclose the “marking may be done through a variety of means including, but not limited to, bordering the date, bolding the date, and circling the date” and paragraph 50 the Specification discloses “a user may have the option to call a sales agent for the business making the offer.”

Therefore, as a matter of claim interpretation, Appellants' general argument to the disclosed invention is not commensurate in scope with the express language of representative independent claim 1 and is unpersuasive of the "claimed" invention being a practical application. Appellants' argument fails because it is not commensurate with the scope of the claim. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) ("[A]ppellant's arguments fail from the outset because . . . they are not based on limitations appearing in the claims."); *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998) ("[The] proffered facts . . . are not commensurate with the claim scope and are therefore unpersuasive.").

Appellants further contend:

the claimed subject matter is in the field of electronic calendars and improves the usefulness of the calendar to the user. However, the claimed subject matter also provides an improvement in the field of eCommerce, apart from calendaring. With the claimed subject matter, the vendors described above now have a new marketplace in which the opportunity exists to provide customized offers to potential customers who have already been identified as having a scheduled need for the offered product or service.

(App. Br. 13.) Additionally, Appellants contend:

the claimed subject matter is "[e]ffecting a transformation or reduction of a particular article to a different state or thing." Specifically, the claimed subject matter is altering the electronic calendar to create, as noted above, a new marketplace in which to offer and purchase products and services. The database of the electronic calendar is transformed to include and provide this additional functionality.

(*Id.*) Finally, Appellants argue that under *Enfish, LLC v. Microsoft Corp.* and *DDR Holdings v. Hotels.com* that Appellants' claimed subject matter

should be patent eligible improvements in computer technology.² (App. Br. 14–15; Reply Br. 7–9.)

We disagree with Appellants and find that Appellants’ claimed invention does not improve the technology involved, but uses technology to publish calendar information and communicate offers for future travel and services. The claimed invention at most uses existing technology to assist the prospective travelers to make more informed decisions. We find the technology of the claimed invention would be no different than providing a travel agent with information on upcoming travel plans and receiving offers for services meeting the requirements. Here, it is the mere availability of additional relevant information, the other entity’s use of this information, and the traveler’s selective use of whatever information/offers are available.

Furthermore, we find the claimed limitations to be directed to use of available information in the same manner as certain methods of organizing human activity such as managing personal behavior in combination with a commercial or legal interactions.

Revised Guidance Step 2B

Under the Revised Guidance, 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 is not “well-understood, routine, [and] conventional” in the field (*see* MPEP § 2106.05(d)); or

² *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016); *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014).

(4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

Here, the Examiner maintains:

The additional elements or combination of elements in the claims-(server, electronic calendar, computer readable medium, computerized calendar service, processor and memory) other than the abstract idea per se amounts to no more than the recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the pertinent industry.

(Final Act. 5.)

Appellants generally contend that under Step 2B of the *Alice* analysis:

Limitations that may be enough to qualify as “significantly more” when recited in a claim with a judicial exception include:

- *Improvements to another technology or technical field*
- Improvements to the functioning of the computer itself
- Applying the judicial exception with, or by use of, a particular machine
- *Effecting a transformation or reduction of a particular article to a different state or thing*
- *Adding a specific limitation other than what is well-understood, routine and conventional in the field, or adding unconventional steps that confine the claim to a particular useful application*
- Other meaningful limitations beyond generally linking the use of the judicial exception to a particular technological environment

(App. Br. 13.) Finally, Appellants contend that:

If a claim is novel and unobvious over the prior art, that claim must include “a specific limitation other than what is well-understood, routine and conventional in the field.” (Interim Guidance on Patent Subject Matter Eligibility, Fed. Reg. Vol. 79, No. 241, p. 74624) (emphasis added). Where this is the

case, this is evidence that the claim recites significantly more than a mere abstract idea under current USPTO Guidance.

(*Id.* at 15.)

We find that Appellants provide no specific argument with regard to any “specific limitation” or “activity” beyond the judicial exception that is not “well-understood, routine, and conventional” in the field. (*See generally* App. Br. 15–16; Reply Br. 5.) Additionally, Appellants contend that “Appellant[s] ha[ve] usefully transformed an electronic calendar application into an eCommerce marketplace.” (Reply Br. 10.)

We disagree with Appellants, as discussed above, and find Appellants’ argument is not commensurate in scope with the express language of representative independent claim 1 and is unpersuasive. At most, Appellants have posted information on travel plans and solicited offers from third parties using a generic computer, based upon the language of representative independent claim 1.

As shown above, the Specification provides a high-level description of the functions being performed by no more than generic computer hardware. (Final Act. 5–6.) As a result, Appellants have not provided specific arguments for subject matter eligibility, and have not shown that the Examiner erred in concluding a lack of subject matter eligibility.

As a result, we sustain the Examiner’s conclusion of a lack of patent-eligible subject matter of independent claims 1, and independent claims 12, and 20 and their dependent claims not argued separately.

Preemption.

The Examiner maintains that Appellants’ arguments are directed to a preemption. (Final Act. 4.)

Appellants contend the claims do not seek to preempt or monopolize a fundamental economic practice “present application, Appellant[s’] claims clearly do not prevent anyone from using any abstract idea.” (App. Br. 17; Reply Br. 11.)

While preemption may denote patent ineligibility, its absence does not demonstrate patent eligibility. *See FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016). For claims reciting a patent-ineligible concept, preemption concerns “are fully addressed and made moot” by an analysis under the *Mayo/Alice* framework. *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). We conduct such an analysis below. In response to Supreme Court and Federal Circuit opinions, the USPTO has issued updated guidance. We review this appeal within the framework of the Revised Guidance, which specifies and particularizes the *Mayo/Alice* framework. Therefore, Appellants’ argument is unpersuasive.

CONCLUSION

The Examiner did not err in rejecting claims 1–14 and 16–21 based on a lack of patent eligible subject matter under 35 U.S.C. § 101.

DECISION

For the above reasons, we sustain the Examiner’s patent eligibility rejection of claims 1–14 and 16–21 under 35 U.S.C. § 101.

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

AFFIRMED