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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* WAYNE NUNZIATA

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Appeal 2018-004652  
Application 14/254,641  
Technology Center 3600

Before ALLEN R. MacDONALD, MICHAEL J. ENGLE, and IFTIKHAR AHMED, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1, 4–9, 12–16, 19, and 20. App. Br. 2. Appellant has cancelled claims 2, 3, 10, 11, 17, and 18. App. Br. 17–20. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

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<sup>1</sup> Appellant indicates the real party in interest is Colonial Surety Company. App. Br. 2.

*Illustrative Claims*

Illustrative claim 1 under appeal read as follows (emphasis, formatting, and bracketed material added):

1. A computer-implemented method for ***aggregating attributes of a surety bond*** in a remote computer bond processing system, the method comprising the steps of:

[A.] authenticating a user by the remote computer bond processing system;

[B.] identifying, by the remote computer bond processing system, a surety bond associated with the user;

[C.] providing, by the remote computer bond processing system, a graphical user interface (GUI) comprising one or more menu items corresponding to one or more surety bond ***attributes associated with the identified surety bond***,

[(i)] wherein said surety bond attributes comprise at least one of the following attributes:

- [(a)] principal entity's profile,
- [(b)] one or more credit scores,
- [(c)] financial report representative of principal entity's financial stability,
- [(d)] bank average balance chart,
- [(e)] bank line of credit report,
- [(f)] union information related to the principal entity,
- [(g)] bid spread analysis report and

[(ii)] wherein each of the one or more menu items corresponds to one of the one or more surety bond attributes utilized by the remote computer bond processing system for ***evaluation of the identified surety bond***;

[D.] receiving, by the remote computer bond processing system, a user request to obtain information related to at least one of the one or more surety bond attributes via at least one of the one or more menu items provided by the GUI;

[E.] generating, by the remote computer bond processing system, said requested information related to the one or more surety bond attributes; and

[F.] displaying, by the GUI, said generated information in response to the received user request.

### *Rejection<sup>2</sup>*

The Examiner rejected claims 1, 4–9, 12–16, 19, and 20 under 35 U.S.C. § 101 “because the claimed invention is directed to a judicial exception (i.e. law of nature, a natural phenomenon or an abstract idea) without ‘significantly more’” (Final Act. 6.), i.e., because the claimed invention is directed to patent-ineligible subject matter.

We select independent claim 1 as representative. Separate patentability is not argued for claims 4–9, 12–16, 19, and 20. Except for our ultimate decision, we do not discuss the § 101 rejection of claims 4–9, 12–16, 19, and 20 further herein.

### *Issue on Appeal*

Did the Examiner err in rejecting claim 1 as being directed to patent-ineligible subject matter?

### ANALYSIS<sup>3</sup>

We have reviewed the Examiner’s rejection in light of Appellant’s Appeal Brief and Reply Brief arguments that the Examiner has erred.

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<sup>2</sup> All citations to the “Final Action” are to the Final Action mailed on March 15, 2017.

<sup>3</sup> Any MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) citations herein are to MPEP 9<sup>th</sup> Edition, Rev. 08.2017 (Jan. 2018).

A. *Section 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. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 192 (1981)); “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores” (*id.* 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 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.* (citation omitted) (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 (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.* (alterations in original) (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.*

B. *USPTO § 101 Guidance*

The United States Patent and Trademark Office (USPTO) recently published revised guidance on the application of § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (“2019 Memorandum”). Under that guidance, we first look to whether the claim recites:

- (1) (*see* 2019 Memorandum Step 2A – Prong One) 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) (*see* 2019 Memorandum Step 2A – Prong Two) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).<sup>4</sup>

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* 2019 Memorandum Step 2B.

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<sup>4</sup> We acknowledge that some of these considerations may be properly evaluated under Step 2 of *Alice* (Step 2B of Office guidance). Solely for purposes of maintaining consistent treatment within the Office, we evaluate it under Step 1 of *Alice* (Step 2A of Office guidance). *See* 2019 Guidance.

C. Examiner's § 101 Rejection - Alice/Mayo - Steps 1 and 2

C.1. 2019 Memorandum Step 2A – Prong One

Applying step 1 of the *Alice/Mayo* analysis (labeled as Step 2A in the Final Action (Final Act. 6–7)), the Examiner determines:

[T]he claims are directed to an abstract idea. [T]he abstract idea is a method and system for aggregating attributes of a surety bond. The abstract idea is performed by

*authenticating* a user[,]  
*identifying* a surety bond associated with the user,  
*providing* one or more menu items corresponding to one or more surety bond attributes associated with the identified surety bond, . . . , and wherein each of the one or more menu items corresponds to one of the one or more surety bond attributes ***for evaluation of the identified surety bond***,  
*receiving* a user request to obtain information related to at least one of the one or more surety bond attributes via at least one of the one or more menu items;  
*generating* said requested information related to the one or more surety bond attributes; and  
*displaying*, said generated information in response to the received user request.

. . .

[T]he claims recite [] “an idea of itself.” An idea of itself describes a concept, plan or scheme, as well as ***mental processes that can be performed in the human mind or by a human using pen and paper***. It is maintained that aggregated information is related to concepts of collecting and comparing known information found to be abstract in *Classen Immunotherapies Inc., v. Biogen IDEC*[], 659 F.3d 1057[] (Fed. Cir. 2011).

Final Act. 6–7 (emphasis and formatting added).

C.2. 2019 Memorandum Step 2A – Prong Two

Further applying step 1 of the *Alice/Mayo* analysis, the Examiner concludes claim 1 is directed to an abstract idea.

The Applicant’s limitations [are] similar to [those in the] Classen[] court[’s] conclusion in that “methods that simply collect and compare data, without applying data in step of overall method, may fail to traverse Section 101 eligibility ‘filter,’ and since claim at issue, which simply invites reader to determine content of existing knowledge *without* [a] *step of putting that knowledge to practical use*, is directed solely to [an] abstract principle.”

Moreover, the Applicant’s claims including the steps for aggregating attributes of [a] surety bond, are similar to concepts described as abstract in *Electric Power Group, LLC v. Alstom*[], 830 F.3d 1350 (Fed Cir. 2016)]. Here, as in the *Electric Power* Court[’s] decision], the claims are clearly focused on the combination of abstract-idea processes, which in this case apply certain aspects related to the aggregation of abstract characteristics of surety bonds using generic computer functions. Thus “the advance they purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and *not any particular assertedly inventive technology for performing those functions.*” Thus, as previously indicated, they are therefore directed to an abstract idea.

Final Act. 7 (emphasis added, parallel citation omitted).

C.3. 2019 Memorandum Step 2B

Further applying step 2 of the *Alice/Mayo* analysis (labeled as Step 2B in the Final Action (Final Act. 7–8)), the Examiner concludes:

The computer element being described is (a) a remote computer bond processing system having (b) a graphical user interface (“GUI”). The Examiner maintains that the [A]pplicant’s claim does not describe claim element(s) that provide an improvement to another technology either individually or as an ordered combination as a whole. It is noted

that an improvement in computer-related technology is not limited to the operation of the computer itself or a computer related network, per se, but may be claimed a specific set of rules (e.g., mathematical relationships). For example, a claim that purports to be an improvement to computer-related technology may include a specific teaching in the specification about how the claimed invention improves a computer or other technology, as opposed to providing details which fail to describe the manner in which the invention accomplishes the alleged improvement (see *Affinity Labs of Texas v. DirectTV, LLC*, 838 F.3d 1253 (Fed. Cir. 2016)). Here, the claimed attributes are merely stored and accessed and ***do not effectively transform anything***. Under the broadest reasonable interpretation, they ***set forth terms and conditions of a surety bond contract or agreement*** which are provided within a technological environment without significantly more.

Final Act. 7–8 (emphasis added, Examiner’s brackets modified, parallel citation omitted).

Additionally, the Examiner determines:

[The] invention typified by the Appellant’s representative claim is properly viewed as at least a method of aggregating attributes of a surety bond it their display upon request ***by an old and well known graphical user interface***, which can be achieved in any type of computer system or programming or processing environment, requiring no specific[] computer equipment, tools or processing capabilities, and since invention thus does not solve [a] “technical problem,” but applies an abstract idea to a technical environment.

Ans. 7 (emphasis added).

D. *Appellant's § 101 Arguments & Panel's Analysis*

D.1. *Step 2A, Prong 1*

D.1.a.

Appellant contends claim 1 satisfies Step One of Mayo. App. Br. 8.

Appellant particularly contends:

[T]he pending claims are not directed to an abstract idea at least because the claimed subject matter should not be considered as falling within any category of an abstract idea set forth in *Alice Corp.* (e.g., fundamental economic practice, “certain methods of organizing human activities,” “an idea of itself,” or mathematical relationships/formulas). The Examiner asserts that independent claims 1, 9 and 16 are directed to an abstract idea, and that the claims do not include additional elements to apply to the computing system beyond the abstract idea. However, Applicant respectfully points out that in making such a conclusion, *the Examiner over-generalizes and mischaracterizes the subject matter as presently claimed.*

To this point, the Examiner characterizes the subject matter of the claims as an “abstract idea of collecting and comparing known information”. However, *the Examiner's characterization over-simplifies the contents of the present application and ignores explicit claim limitations* and thus is improper. For instance, independent claims 1, 9 and 16 recite a step of “*providing . . . a graphical user interface (GUI) comprising . . . menu items corresponding to . . . surety bond attributes . . . , wherein said surety bond attributes comprise at least one of the following attributes: principal entity's profile, one or more credit scores, financial report representative of principal entity's financial stability, bank average balance chart, bank line of credit report, union information related to the principal entity, bid spread analysis report . . .*” and “*generating . . . requested information related to the one or more surety bond attributes*”.

App. Br. 9 (emphasis added).

D.1.b.

Claim 1 recites the following limitations:

- [A.] authenticating a user . . . ;
- [B.] identifying . . . a surety bond associated with the user;
- [C.] providing . . . one or more . . . items corresponding to one or more surety bond attributes associated with the identified surety bond,
  - [(i)] wherein said surety bond attributes comprise at least one of the following attributes:
    - [(a)] principal entity's profile,
    - [(b)] one or more credit scores,
    - [(c)] financial report representative of principal entity's financial stability,
    - [(d)] bank average balance chart,
    - [(e)] bank line of credit report,
    - [(f)] union information related to the principal entity,
    - [(g)] bid spread analysis report and
  - [(ii)] wherein each of the one or more . . . items corresponds to one of the one or more surety bond attributes utilized . . . for evaluation of the identified surety bond;
- [D.] receiving . . . a user request to obtain information related to at least one of the one or more surety bond attributes via at least one of the one or more menu items provided by the GUI;
- [E.] generating . . . said requested information related to the one or more surety bond attributes; and
- [F.] displaying . . . said generated information in response to the received user request.

In short, claim 1 recites a method of processing data related to collecting surety bond information associated with a user and evaluating an identified surety bond based on the collected surety bond information. That is, we

conclude that Appellant's claimed process is mitigating the risk of negative events in commercial transactions.

Appellant acknowledges that as to surety bonds:

By the term surety bond is generally meant a bond issued by an insurance or other company as surety on behalf of a principal whereby the surety legally binds itself to an obligee for an amount of money guaranteed to the obligee for the faithful performance of a contract or other act of the principal. The bonds can include bid bonds, contract, court and subdivision bonds, performance bonds, customs bonds, notary bonds, liquor license bonds, license and permit bonds, small business administration bonds, bail bonds, supersedeas bonds or other bonds required in litigation, etc.

When a contractor, builder or supplier etc. wishes to bid on a construction project or submit a bid in connection with a governmental purchase of equipment or supplies the entity seeking bid typically requires that for a bidder to be considered for the job a bid bond must be submitted with the bid. Many municipalities have their own bid form and others use a format approved of by the American Institute of Architects. In the typical bid bond the principal is the entity who is submitting the bid. The surety is typically insurance or bonding company who pursuant to the bond is "held and firmly bound" to the entity seeking the bid for a predetermined sum, usually some percentage of the bid amount. In the event the bid is accepted the bond becomes effective and protects the entity awarding the contract by assuring the entity of faithful performance of the contract as well as prompt payment of labor and materials furnished in performing the contract. In addition, the bond protects the bid seeking entity from the failure of the winning bidder from ultimately entering into the contract that is being awarded by paying the difference between the winning bid and the amount that the entity would have to pay to another party to complete the project because of the default.

Spec. 1–2. By Appellant's acknowledgement, we conclude using a surety bonds was a known fundamental economic practice to manage risk in

commercial transactions. Thus, like the concept of mitigating settlement risk in *Alice*, and the concept of hedging against risk in *Bilski*, the concept of using a surety bond in a commercial transaction recited in Appellant’s claims “is a fundamental economic practice long prevalent in our system of commerce.” *Alice*, 573 U.S. at 219 (citations and internal quotation marks omitted).

Accordingly, we conclude that claim 1 recites a fundamental economic practice, which is one of certain methods of organizing human activity identified in the 2019 Memorandum, and thus an abstract idea.

D.1.c.

Contrary to Appellant’s assertions *supra* that “the Examiner over-generalizes and mischaracterizes the subject matter as presently claimed” and “the Examiner’s characterization over-simplifies the contents of the present application” (App. Br. 9), we determine that the Examiner’s analysis at page 6–7 of the Final Action explicitly recites at length the actual language of Appellant’s independent claim 1 nearly identically to our recitation in section D.1.b *supra*. Further, we determine that the Examiner correctly points out that Appellant’s claimed steps for aggregating attributes of a surety bond, are similar to concepts described as abstract in *Electric Power Group*. Final Act. 7.

Additionally, Appellant asserts that “the Examiner’s characterization . . . ignores explicit claim limitations,” “[f]or instance, independent claim[] 1 [recites] a step of ‘providing . . . *a graphical user interface (GUI)* . . . .’” App. Br. 9 (emphasis added). However, Appellant’s argument overlooks that the argued “graphical user interface” specifics of claim 1 are not part of the *Mayo* Step One judicial exception analysis, or the Step 2A, Prong 1

judicial exception analysis under the 2019 Memorandum. Rather, these specifics are part of determining whether, in addition to the judicial exception, the claim includes an inventive concept or a practical application. *Alice*, 573 U.S. at 217 (“First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. If so, we then ask, ‘[w]hat else is there in the claims before us?’” (citations omitted)). We address this argument *infra*.

Lastly, as to Appellant’s assertion that “the Examiner’s characterization . . . ignores explicit claim limitations,” “[f]or instance, independent claim[] 1 [reciting] a step of ‘providing . . . *items corresponding to . . . surety bond attributes . . .*, wherein said surety bond attributes *comprise at least one of the following attributes:* principal entity’s profile, one or more credit scores, financial report representative of principal entity’s financial stability, bank average balance chart, bank line of credit report, union information related to the principal entity, bid spread analysis report . . . .” App. Br. 9 (emphasis added). Appellant’s argument overlooks that the Examiner explicitly recited “one or more . . . items corresponding to one or more surety bond attributes associated with the identified surety bond” in addressing claim 1. Final Act. 6. Essentially, Appellant’s argument is one contending that after the Examiner determined the “items corresponding to one or more surety bond attributes associated with the identified surety bond” were abstract, the Examiner erred by not also listing each claimed item by name. We are unpersuaded by this argument. Rather, we determine that an objective observer would understand that the Examiner’s determination as to the “items corresponding

to one or more surety bond attributes” is inclusive of the individually named items.

D.2. *Step 2A, Prong 2*

D.2.a.

Appellant contends “[the claims] clearly relate to improvements to the technology field of *analytical bond processing systems*” (App. Br. 11 (emphasis added)) and “advantageously improve[] and simplif[y] the bond obtainment process by enabling the principal entities to make informed business decisions that could *improve their company’s financial profile*” (App. Br. 12 (emphasis added)). Appellant particularly contends:

It will be appreciated by one having skill in the art that the disclosed bond processing system as a whole is directed to *solving a problem of aggregating relevant information related to user’s surety bond bid*, in the context of underwriting decisions. Based on these aspects, the claims require actions in the real world that are more than an abstract idea, yet the Examiner improperly fails to address those limitations.

App. Br. 9 (emphasis added).

Applicant respectfully submits that at least, “providing . . . a graphical user interface (GUI) comprising . . . menu items corresponding to . . . surety bond attributes . . . , wherein said surety bond attributes comprise at least one of the following attributes: principal entity’s profile, one or more credit scores, financial report representative of principal entity’s financial stability, bank average balance chart, bank line of credit report, union information related to the principal entity, bid spread analysis report . . . ” and “generating . . . requested information related to the one or more surety bond attributes” *encompass a technological process that is not a “fundamental economic practice” that has been around for decades.*

App. Br. 10 (emphasis added).

This consideration has also been referred to as the search for a technological solution to a technological problem. *See Amdocs (Isr.), Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1300 (Fed. Cir. 2016) (“[T]his claim entails an unconventional technological solution . . . to a technological problem . . .”). As discussed *supra*, we conclude that “Appellant’s claimed process is solving the problem of mitigating the risk of negative events in commercial transactions” which is a business problem and not a technological problem. We do not agree with Appellant that “analytical bond processing,” “improv[ing a] company’s financial profile,” or “aggregating relevant information related to user’s surety bond bid” are either a “technological field” or a “technological problem” or a “technological solution.” Rather, we determine that these are directed to the field of business/commerce and its problems and solutions. Appellant’s argument is not persuasive.

D.2.b.

Appellant also contends:

[The claimed] process cannot be performed “mentally with paper and pen” (due at least to the necessity to collect information in *real-time* from various data sources associated with a third party service (e.g., a credit rating institution), which *can only be accomplished using a computer*) and thus is not merely directed to a mental process.

App. Br. 9 (emphasis added).

Appellant’s argument is not persuasive. It is well established that merely using a computer to accomplish real-time processing is not sufficient to provide an inventive concept in the realm of application of the information-based abstract ideas. *Elec. Power Grp.*, 830 F.3d at 1356 (“The claims in this case specify what information in the power-grid field it is

desirable to gather, analyze, and display, including in ‘real time’; but they do not include any requirement for performing the claimed functions of gathering, analyzing, and displaying in real time by use of anything but entirely conventional, generic technology.”).

D.2.c.

We agree with the Examiner that as to the steps of claim 1 “the advance they purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions.” Final Act. 7. In view of Appellant’s Specification, and consistent with the Examiner’s determinations, we conclude that claim 1 does not integrate the judicial exception into a practical application. We determine claim 1 does not recite:

- (i) an improvement to the functioning of a computer;
- (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.

See MPEP §§ 2106.05(a)–(c), (e)–(h). We agree with the Examiner that claim 1 is *directed to* a judicial exception.

D.3. *Step 2B*

As noted above, the Examiner cites to *Affinity* and determines:

The computer element being described is (a) a remote computer bond processing system having (b) a graphical user interface (“GUI”). The Examiner maintains that the [A]pplicant’s claim does not describe claim element(s) that provide an improvement to another technology either individually or as an ordered combination as a whole.

Final Act. 7–8 (emphasis added). The Examiner also determines that a graphical user interface is “old and well know.” Ans. 7.

Appellant asserts “the emphasized features of providing GUI menu items corresponding to surety bond attributes and generating requested information related to one or more surety attributes ***do more than merely recite an abstract idea.***” App. Br. 10 (emphasis added).

We disagree with Appellant’s assertion. The Examiner cites to *Affinity* to support the Step 2B “GUI” portion of the rejection. Final Act. 8. Our review of *Affinity* finds the decision specifically states:

While the inventions in [*TLI* and *Ultramercial*] involved tangible components, ***the components were conventional and were used in conventional ways. The same is true in this case***, as the claimed cellular telephone is used to receive wireless signals, ***the claimed graphical user interface is used to display a menu of options to the user***, and the claimed broadcasting system is used as the source of streaming content.

*Affinity*, 838 F.3d at 1261. Although claim 1 recites “more” under step two of the *Alice/Mayo* analysis, we conclude the “more” is not patentably significant. Rather, the case law shows this “more” to be the epitome of a well-understood, routine, conventional element/combination previously known in the industry.

Because claim 1, in addition to the abstract idea, recites only a well-understood, routine, conventional element/combination previously known in the industry, we conclude the case law shows there is no genuine issue of material fact regarding step two of the Examiner's *Alice/Mayo* analysis. Therefore, we are unpersuaded by Appellant's argument that further evidence is required. In view of Appellant's Specification, and consistent with the Examiner's determinations, we determine the claims do not recite:

- (vi) a specific limitation other than what is well-understood, routine, conventional activity in the field or unconventional steps that confine the claim to a particular useful application.

See MPEP § 2106.05(d).

#### D.4. *Appellant's Prima Facie Case Arguments & Panel's Analysis*

##### D.4.a.

Appellant contends the Examiner fails to make out a prima facie case that the claims are unpatentable under 35 U.S.C. § 101. App. Br. 12.

The examiner bears the burden of presenting a prima facie case that Applicant's claims are unpatentable under 35 U.S.C. §101. *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); MPEP §2106(III). ***This burden is relatively high.*** A prima facie case of patent-ineligibility must establish that it is more likely than not that the claims fail to define patentable subject matter under § 101. MPEP § 2106(III). ***This burden, therefore, requires more than establishing a reasonable likelihood that the claims fail to meet the § 101 standard.***

App. Br. 12 (emphasis added).

The examiner has not analyzed and explained why the claims do not meet Part II of Mayo and hence has not established more likely than not that the claims fail the § 101 test. Indeed, the

examiner's analysis is inadequate to support the legal conclusion that Applicant's claims add nothing of substance to what the examiner has determined to be the abstract idea. The problem with the examiner's § 101 rejection is that it is ***not rooted in claim construction and does not account for all of the limitations in the claims.***

App. Br. 12–13 (emphasis added).

D.4.b.

Appellant's argument is not persuasive. First we find no basis for Appellant's asserted "high" prima facie burden. Second, beyond general assertions by Appellant of Examiner error, we do not find in this argument asserted particular claim limitations that Appellant believes were overlooked. As discussed *supra*, we determine that the Examiner's § 101 rejection analysis recites at length the actual language of Appellant's independent claim 1. Contrary to Appellant's assertions, we determine that the Examiner's rejection is well rooted in the claim construction and accounts for the claim limitations.

As this court has repeatedly noted, "the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production." *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). The Patent and Trademark Office ("PTO") satisfies its initial burden of production by "adequately explain[ing] the shortcomings it perceives so that the applicant is properly notified and able to respond." *Hyatt*, 492 F.3d at 1370. In other words, the PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies 35 U.S.C. § 132, in "notify[ing] the applicant . . . [by] stating the reasons for [its] rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application." 35 U.S.C. § 132. ***That section "is violated when a rejection is so***

*uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” Chester v. Miller, 906 F.2d 1574, 1578 (Fed. Cir. 1990).*

*In re Jung, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (emphasis added).*

“Section 132 merely ensures that an applicant at least be informed of the broad statutory basis for the rejection of his claims, so that he may determine what the issues are on which he can or should produce evidence.” *Chester*, 906 F.2d at 1578 (internal citation omitted). As discussed above, *all that is required of the office to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of § 132.* As the statute itself instructs, the examiner must “notify the applicant,” “stating the reasons for such rejection,” “together with such information and references as may be useful in judging the propriety of continuing prosecution of his application.” 35 U.S.C. § 132.

*In re Jung, 637 F.3d at 1363 (emphasis added).*

## CONCLUSIONS

(1) The Examiner has not erred in rejecting claims 1, 4–9, 12–16, 19, and 20 under 35 U.S.C. § 101, as being directed to patent-ineligible subject matter.

(2) Claims 1, 4–9, 12–16, 19, and 20 are not patentable.

## DECISION

The Examiner’s rejection of claims 1, 4–9, 12–16, 19, and 20 under 35 U.S.C. § 101, as being directed to patent-ineligible subject matter, is **affirmed**.

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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