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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YOGESH CHUNILAL RATHOD

Appeal 2018-005033
Application 15/053,889
Technology Center 3600

Before JOHN A. EVANS, JASON J. CHUNG, and
SCOTT E. BAIN, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals the Final Rejection of claims 1, 2, 7–9, and 13–15.² We have jurisdiction under 35 U.S.C. § 6(b). An Oral Hearing was conducted on February 24, 2020.³

We reverse.

INVENTION

The invention relates to a method and system of distributing messages to “followers” in a network environment. Abstract. Claim 1 is illustrative of the invention and is reproduced below:

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. According to Appellant, OnePatent Software Ltd. is the real party in interest. Appeal Br. 4.

² Claims 3–6 and 10–12 are cancelled. Appeal Br. 35–36.

³ The Transcript (“Tr.”) from this Oral Hearing was mailed on March 17, 2020.

1. A method of message distribution, comprising:
 - receiving, from a first computing device of a first user, a selection of a plurality of endpoints for receiving messages, wherein the first user is one of a plurality of users who are followers of a second user;*
 - storing the selection of the plurality of endpoints in a storage;*
 - receiving, from a second computing device of the second user, a message for distribution to one or more unspecified recipients;*
 - identifying, by a computer processor, the followers of the second user as recipients of the message;*
 - identifying, in the storage, the plurality of endpoints selected by the first user; and*
 - sending the message to the followers of the second user, including the first user, wherein the sending includes sending the message to each of the plurality of endpoints selected by the first user.*

Appeal Br. 35 (Claims Appendix) (emphases added).

REJECTIONS

Claims 1, 2, 7–9, and 13–15 stand rejected under 35 U.S.C. § 101 as being directed to patent ineligible subject matter. Final Act. 3–8.

Claims 1, 2, 7–9, 14, and 15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Hull (US 2011/0289574 A1; published Nov. 24, 2011; continuation of application No. 10/863,926 filed on June 8, 2004). Final Act. 8–14.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Hull and Tingo (US 2007/0105536 A1; published May 10, 2007; filed Nov. 7, 2005). Final Act. 14–16.

ANALYSIS

I. Claims 1, 2, 7–9, and 13–15 Rejected Under 35 U.S.C. § 101

A. Principles of Law

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. *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 Court’s two-part 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, 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 waterproof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 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 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.* (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 Section 101 Guidance

In January 2019, the U.S. Patent and Trademark Office (USPTO) published revised guidance on the application of § 101. 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“2019 Revised Guidance”).⁴ “All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.” *Id.* at 51; *see also* October 2019 Update at 1.

Under the 2019 Revised Guidance and the October 2019 Update, 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) (“Step 2A, Prong One”); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h) (9th ed. Rev. 08.2017, Jan. 2018)) (“Step 2A, Prong Two”).⁵

⁴ In response to received public comments, the Office issued further guidance on October 17, 2019, clarifying the 2019 Revised Guidance. USPTO, *October 2019 Update: Subject Matter Eligibility* (the “Update”) (available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf).

⁵ This evaluation is performed by (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception, and (b) evaluating those additional elements individually and in combination to determine whether the claim as a whole integrates the exception into a

2019 Revised Guidance, 84 Fed. Reg. at 52–55.

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look, under Step 2B, 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.

2019 Revised Guidance, 84 Fed. Reg. at 52–56.

C. The Examiner’s Conclusions and Appellant’s Arguments

The Examiner determines the present claims recite certain methods of organizing human activity. Final Act. 4, 6; Ans. 4, 9–10.

Appellant argues the present claims recite an improvement in computer-related technology; that is, the present claims recite user-to-user communication system enables communication between users of a computer network, while providing the advantage that had typically been found only in broadcast communications systems, namely that the sender does not need to specify the recipient or recipients of a message while implementing a “follower” relationship between the sender and the recipient, based on recipient preferences. Appeal Br. 8–11 (citing *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1308–14 (Fed. Cir. 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016)); Reply Br. 8–9.

practical application. *See* 2019 Revised Guidance - Section III(A)(2), 84 Fed. Reg. 54–55.

D. Discussion

1. Step 2A, Prong 1

Patent eligibility under 35 U.S.C. § 101 is a question of law that is reviewable *de novo*. *See Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012). We conclude the emphasized portions of claim 1,⁶ reproduced above (*see supra* at 2), recite managing personal behavior or relationships or interactions between people (including social activities) because the present claims require interactions between two people (i.e., a user and an agent). That is, the present claims recite managing personal behavior or relationships or interactions between people (including social activities) because they require user-to-user communication on a computer network. According to the Memorandum, managing personal behavior or relationships or interactions between people (including social activities) fall into the category of certain methods of organizing human activity. *See* Memorandum, 84 Fed. Reg. at 52. Moreover, those certain methods of organizing human activity are a type of abstract idea. *See id.*

Because the present claims recite managing personal behavior or relationships or interactions between people (including social activities), which fall into the category of certain methods of organizing human activity (i.e., an abstract idea), we proceed to prong 2.

2. Step 2A, Prong 2

We agree with Appellant’s argument that the present claims recite an improvement in computer-related technology. Specifically, in our view, the present claims recite a particular user-to-user communication system and

⁶ Because the independent claims recite similar features, throughout this Decision, we refer to claims 1, 2, 7–9, and 13–15 as the “present claims.”

method that enables communication between users of a computer network. As described in the Specification, the claimed invention provides the advantage that had typically been found only in broadcast communications systems, namely (as the claims recite) that the sender does not need to specify the recipient or recipients of a message while implementing a “follower” relationship between the sender and the recipient, based on recipient preferences. Appeal Br. 8–11 (citing *McRO*, 837 F.3d at 1308–14; *Enfish*, 822 F.3d 1327); Reply Br. 8–9. We consider this to be an integration of the foregoing abstract idea into a practical application, because technologically, the network recited in the present claims is reversed so that recipients direct the messages. Tr. 8: 10–10:10.

Because the present claims recite an abstract idea that is integrated into a practical application, we need not proceed to Step 2B. Independent claims 9, 14, and 15 recite similar features as independent claim 1. Accordingly, we do not sustain the Examiner’s rejection of: (1) independent claims 1, 9, 14, and 15; and (2) dependent claims 2, 7, 8, and 13 under 35 U.S.C. § 101.

II. Claims 1, 2, 7–9, and 13–15 Rejected Under 35 U.S.C. § 103

The Examiner finds Hull discloses a public blog, which the Examiner maps to the limitation “receiving, from a second computing device of the second user, a message for distribution to one or more unspecified recipients” recited in claim 1. Final Act. 9–10 (citing Hull, 16); Ans. 13, 17–19. The Examiner finds Hull discloses sending blog alerts over email, instant message, or short messaging service, which the Examiner maps to the limitation “sending the message to the followers of the second user, including the first user, wherein the sending includes sending the message to

each of the plurality of endpoints selected by the first user” recited in claim 1. Final Act. 11–12 (citing Hull, 31); Ans. 13–20.

Appellant argues the Examiner erred because the Examiner finds Hull discloses a blog (i.e., the Examiner maps Hull’s blog to the claimed “messages”) is available for public view, but Hull’s blog is not sent using “each of the plurality of endpoints selected by the first user.” Appeal Br. 19, 21–22, 30–31; Reply Br. 15–20. Rather, Appellant argues, blog alerts are sent over email, instant message, or short messaging service. Appeal Br. 19, 21–22, 30–31; Reply Br. 15–20. We are persuaded by Appellant’s argument.

As an initial matter, we note that claim 1 recites “receiving, from a second computing device of the second user, *a message* for distribution to one or more unspecified recipients” (emphasis added) and “sending *the message* to the followers of the second user, including the first user, wherein the sending includes sending *the message* to each of the plurality of endpoints selected by the first user” (emphases added). The emphasized text “the message” has antecedence to “a message.” Therefore, we construe “the message” to be the same message as the recited “a message.” Accordingly, we agree with Appellant that the Examiner’s findings are inconsistent with one another. Appeal Br. 19, 21–22, 30–31; Reply Br. 15–20.

In particular, the Examiner initially finds Hull’s public blog discloses “a message” as recited in claim 1. Final Act. 9–10 (citing Hull, 16); Ans. 13, 17–19. The Examiner then finds Hull’s blog alerts transmitted over email, instant message, or short messaging service, discloses “sending the message to each of the plurality of endpoints selected by the first user,” as recited in claim 1. Final Act. 11–12 (citing Hull, 31); Ans. 13–20. As

Appellant argues, these findings are inconsistent. Namely, the Examiner initially finds Hull's public blog discloses "a message" then finds Hull's blog *alert* also discloses "the [same] message." For the foregoing reasons, we disagree.⁷

Independent claims 9, 14, and 15 recite similar features as independent claim 1. Accordingly, we do not sustain the Examiner's rejection of: (1) independent claims 1, 9, 14, and 15; and (2) dependent claims 2, 7, 8, and 13 under 35 U.S.C. §§ 102(e) and 103(a).

III. Other Considerations

Because we are reversing all pending rejections, in the event of further prosecution, we direct the Examiner's attention to the filing submitted on March 24, 2016 titled "Suggestion for an Interference" pursuant to 37 C.F.R. § 41.202.

⁷ In the event of further prosecution, the Examiner should consider whether independent claims 1, 9, 14, and 15 are unpatentable under 35 U.S.C. § 103(a) over Hull. Although the Board is authorized to enter a new ground of rejection under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* Manual of Patent Examining Procedure (MPEP) § 1213.02.

CONCLUSION

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2, 7-9, 13-15	101	Eligibility		1, 2, 7-9, 13-15
1, 2, 7-9, 14, 15	102(e)	Hull		1, 2, 7-9, 14, 15
13	103(a)	Hull, Tingo		13
Overall Outcome				1, 2, 7-9, 13-15

REVERSED