UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte FRANCIS KURUPACHERIL
and FREDERICK P. BLOCK

_____

Appeal 2018-005780
Application 15/226,083[1]
Technology Center 2400

_____

Before ADAM J. PYONIN, NABEEL U. KHAN, and
DAVID J. CUTITTA II, *Administrative Patent Judges*.

CUTITTA, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the
Examiner's decision rejecting claims 1–20, all the claims pending in the
application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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STATEMENT OF THE CASE

Invention

Appellants' invention relates to "providing means to share context information using a presence and IM client application" thereby allowing a user to "join an ongoing communication session based on displayed context information associated with the communication session, which may be of interest or benefit to the user." Spec. ¶¶ 31, 32.[2]

Exemplary Claim

Claims 1 and 7 are independent. Claim 1 is exemplary and is reproduced below with bracketed material added.

> 1.   A method implemented in a second user terminal, the method comprising:
>
> [a] receiving a preference for desired context information;
>
> [b]   receiving   presence   information   and   context information about a communication session involving a first user terminal;
>
> [c] displaying the presence information and the context information on a display of the second user terminal when the preference matches the context information;
>
> [d] receiving an input in response to the displaying; and
>
> [e] transmitting, to the first user terminal and in response to the input, a request to join the communication session.

Appeal Br. 32.

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[2] Our Decision refers to: (1) Appellants' Specification filed August 2, 2016 ("Spec."); (2) the Final Rejection mailed April 24, 2017 ("Final Act."); (3) the Advisory Action mailed November 24, 2017 ("Final Act."); (4) the Appeal Brief filed December 29, 2017 ("Appeal Br."); (5) the Examiner's Answer mailed April 6, 2018 ("Ans."); and (6) the Reply Brief filed May 15, 2018 ("Reply Br.").

REFERENCE AND REJECTIONS

Claims 1–20 stand rejected under 35 U.S.C. § 101 as being directed to a judicial exception without adding significantly more.. *See* Final Act. 3–5.

Claims 1–6 stand rejected under 35 U.S.C. § 101 as being directed to software per se. *See* Final Act. 4.

Claims 1, 4, and 7 stand rejected on the ground of obviousness-type double patenting over claims 1, 3, and 7 of US Patent No. 9,450,898. *Id.* at 5–7.

Claim 16 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. *See* Advisory Act. 2.

Claims 1–20 stand rejected under pre-AIA 35 U.S.C. § 102(b) as being anticipated by Boyer et al. (US 2007/0230681; pub. Oct. 4, 2007) ("Boyer"). *See* Final Act. 7–11.

Our review in this appeal is limited to the above rejections and the issues raised by Appellants. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv)(2017).

DISCUSSION

Rejections Under 35 U.S.C. § 101

Standard for Patent Eligibility

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 water-proof 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 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 176; *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 (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.*

USPTO January 7, 2019 Revised Section 101 Memorandum

The USPTO recently published revised guidance on the application of § 101. *See* 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019 ("Memorandum"). Under the Memorandum 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); and

(2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

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, and conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

Findings, Contentions, and Analysis

Appellants argue the claims as a group. *See* Appeal Br. 13–16. We select independent claim 1 as exemplary of Appellants' arguments for the group. *See* 37 C.F.R. § 41.37(c)(1)(iv)(2016).

The Examiner determines claim 1 is "directed to user invitations to join collaborative sessions based on presence and context information" and "[t]his is similar to several concepts which have been held to constitute an abstract idea." Final Act. 4. The Examiner also determines "[t]he claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because there are no additional claimed

elements that are more than generic computing functions performed by generic computers." *Id.*

Appellants present several arguments against the § 101 rejection. We do not find Appellants' arguments persuasive, as discussed below. Applying the guidance set forth in the Memorandum, we are not persuaded of Examiner error. We adopt the nomenclature for the steps used in the Memorandum.

STEP 1

Section 101 provides that "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." 35 U.S.C. § 101. Initially, we determine that independent claim 1 recites "[a] method." Appeal Br. 32. As such, claim 1 is directed to a statutory class of invention within 35 U.S.C. § 101, i.e., a process.

STEP 2A Prong 1

Under Step 2A, Prong 1 of the Memorandum, we must determine whether claim 1, being directed to a statutory class of invention, nonetheless falls within a judicial exception.

Appellants argue that claim 1 is not abstract because the claim is "directed to sharing presence information and context information and screening initiation of communication sessions based on that presence information and context information." Appeal Br. 14. The Examiner responds that "[c]ustomizing the displaying of the presence and context

information based on the user defined preferences is the crux of the claimed invention" and observes that "[t]he claim language fails to explicitly or implicitly disclose the screening initiation of communication sessions." Ans. 15 (emphasis omitted).

We agree with the Examiner's determination that the claim recites an abstract idea. As an initial matter, we agree with the Examiner that "'the screening initiation of communication sessions,'" acting as the basis of Appellants' argument, is not recited in the claim. Ans. 15. Claim 1 recites a "method" performing the steps of: [a] "receiving a preference for desired context information"; [b] "receiving presence information and context information"; [c] "displaying the presence information and the context information"; [d] "receiving an input in response to the displaying"; and [e] "transmitting . . . a request to join the communication session." *See* Appeal Br. 32. The Specification, likewise, describes that Appellants' invention seeks to address the problem that known methods "do not support features to allow a user to request to join a contact involved in a current communication session (e.g., for a discussion, meeting, or presentation) or share communication session related information that may be of interest or benefit to the user." Spec. ¶ 7.

Thus, Appellants' claim recites the abstract idea of generating "user invitations to join collaborative sessions based on presence and context information." Final Act. 4. Apart from extra-solution activity and generic hardware (as discussed below), the claimed invention is analogous to pre-Internet transactions between humans in which a third-party requests to join a meeting between a first and second person based on context information shown to the third-party when the context information is determined as

matching a preference of the third-party. As such, claim 1 reasonably can be interpreted as being directed to organizing human activity, "such as managing relationships or transactions between people" or entities. MPEP § 2106.04(a)(2) (Part I). This concept of managing transactions between people is similar to other types of "organizing human activity" that have been found to be abstract ideas by the Supreme Court and the Federal Circuit. *See, e.g., FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (collecting and analyzing information and notifying a user based on the analysis); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (transaction performance guarantee); and *Planet Bingo, LLC v. VKGS LLC*, 576 F. App'x 1005, 1007 (Fed. Cir. 2014) (managing a game of bingo). From this we conclude that claim 1 recites a method of organizing human activity, as provided for in the Memorandum.

STEP 2A Prong 2

Next, we determine whether the claim is directed to the abstract concept itself or whether it is instead directed to some technological implementation or application of, or improvement to, this concept, i.e., is integrated into a practical application. *See, e.g., Alice*, 573 U.S. at 223, discussing *Diehr*, 450 U.S. at 175.

Applying step 2 of the *Alice/M*ayo analysis, the Examiner determines the "defined invention recites an abstract idea, which implements generic general purpose components and functions, for directing the generic general purpose components to implement the abstract idea by performing basic functions of the generic general purpose components, which are well

understood, routine, and conventional activities previously known in the industry." Final Act. 4.

Appellants argue "because 'the plain focus of the claims is on an improvement to computer functionality itself, not on' the abstract idea asserted by the Office Action, the claims are not directed to an abstract idea." Appeal Br. 15 (citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016)).

This argument is unpersuasive because Appellants' claim 1 is unlike the claims in *Enfish*. In *Enfish*, our reviewing court relied on the distinction made in *Alice* between computer-functionality improvements and uses of existing computers as tools in aid of processes focused on "abstract ideas" (in *Alice*, as in so many other § 101 cases, the abstract ideas being the creation and manipulation of legal obligations or the organizing of human activity). *Enfish*, 822 F.3d at 1335–36; *see also Alice*, 573 U.S. at 222–25. In *Enfish*, the § 101 challenge was found persuasive because the claims at issue focused, not on asserted advances in uses to which existing computer capabilities could be put, but on a specific improvement—a particular database technique—in how computers could carry out one of their basic functions of storage and retrieval of data. *Enfish*, 822 F.3d at 1335–36.

Here, Appellants' claim 1 does not purport to improve the functioning of the computer itself. Nor does claim 1 effect an improvement in any other technology or technical field. The mere introduction of a computer or generic computer technology into the claim need not alter the abstract idea analysis. *See Alice*, 573 U.S. at 223–24. "[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea [] on a generic computer." *Alice*, 573 U.S. at 225. We

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determine claim 1 does not. Viewed as a whole, Appellants' claim simply recites the abstract idea of generating "user invitations to join collaborative sessions based on presence and context information." Final Act. 4. To be sure, the claim recites doing so by causing a second user terminal to: 1) receive a preference and "presence information and context information about a communication session involving a first user terminal"; and 2) transmit "a request to join the communication session." Appeal Br. 32. But these elements "merely use[] a computer as a tool to perform an abstract idea," or recite no more than an extra-solution activity for receiving the presence information and a preference for desired context information and the generic computer activities necessary to process these activities. Memorandum, 84 Fed. Reg. at 55. Stated differently, claim 1 simply recites an abstract idea executed using generic computer technology, i.e., "a second user terminal." Appeal Br. 32.

Appellants further argue "'the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks' and is therefore patent eligible." Appeal Br. 14 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1258 (Fed. Cir. 2014) (finding an inventive concept in the modification of the conventional mechanics behind website display to produce a dual-source integrated hybrid display).

We disagree. The solution offered by Appellants' claim 1 is not rooted in any novel computer technology, as evidenced by the claim's failure to recite any hardware other than generic first and second "user terminal[s]." Appeal Br. 32. Rather than a solution rooted in computer technology, Appellants' invention, as claimed, seeks to transmit "user

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invitations to join collaborative sessions based on presence and context information." Final Act. 4. Rather than providing a technical solution by "improv[ing] speed by allowing a user 'to join communication sessions of interest without invitations,'" (Reply Br. 4) Appellants' claim 1 merely automates a pre-internet process using generic computer technology. *See* Ans. 15 ("Customizing the displaying of the presence and context information based on the user defined preferences is the crux of the claimed invention."). In view of Appellants' Specification, and consistent with the Examiner's determinations, we determine claim 1 does not recite a technological improvement and thus does not integrate the judicial exception into a practical application.

Claim 1 is not directed to a specific asserted improvement in computer technological implementation or otherwise integrated into a practical application and thus is ***directed to*** a judicial exception.

STEP 2B

Next, we determine whether the claim includes additional elements that provide significantly more than the recited judicial exception, thereby providing an inventive concept. *Alice*, 573 U.S. at 217–18 (quoting *Mayo*, 566 U.S. at 72–73).

The Examiner determines "[t]he claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because there are no additional claimed elements that are more than generic computing functions performed by generic computers." Final Act. 4.

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Appellants argue claim 1 "base[s] communication session initiation on a condition and allow users to automatically join communication sessions that they indicate a desire to join beforehand, thus providing significantly more than the alleged abstract idea." Appeal Br. 16.

We find Appellants' argument unpersuasive because at least one feature relied upon in the argument, i.e., "automatically join communication sessions," is not recited in the claim. *Id.* As previously discussed, claim 1 recites an abstract idea including "receiving a preference," receiving "presence information and context information" and "receiving an input." Appeal Br. 32. Other than the abstract idea, claim 1 recites "displaying . . . information on a display of the second user terminal" and "transmitting, to the first user terminal and in response to the input, a request to join the communication session." *Id.* Considered both separately and as an ordered combination, the additional steps of Appellants' claim 1 add nothing inventive to the claim. The sequence of data reception–analysis–modification, and transmission or display is generic and conventional or otherwise held to be abstract. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (sequence of receiving, selecting, offering for exchange, display, allowing access, and receiving payment recited an abstraction), *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (sequence of data retrieval, analysis, modification, generation, display, and transmission), *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (sequence of processing, routing, controlling, and monitoring). The ordering of the steps is therefore ordinary and conventional.

Because Appellants' representative claim 1 is directed to a patent-ineligible abstract concept and does not recite something "significantly more" under the *Alice* analysis, we sustain the Examiner's rejection of this claim under 35 U.S.C. § 101 as being directed to non-patentable subject matter in light of *Alice* and its progeny. The rejection of claims 2–20, which are not argued separately, is sustained for the same reasons.

Software Per Se Rejection

The Examiner additionally rejects method claims 1–6 under 35 U.S.C. § 101 as software *per se*. *See* Final Act. 4. Specifically, the Examiner determines that method claims 1–6, "in light of the specification, encompasses non-statutory subject matter since such reads on (encompasses) software, program, or their equivalent per se'; and, which also could be embodied on a carrier wave." *Id.*

Appellants do not provide arguments disputing this rejection. *See generally* Appeal Br. 13–16.

Despite Appellants' lack of argument, we reverse *sua sponte* the Examiner's rejection of method claims 1–6 under 35 U.S.C. § 101 as software *per se*. Unlike machines, manufactures and compositions of matter, methods or processes need not recite a physical or tangible form. *See Digitech Image Techs., LLC v. Electronics for Imaging, Inc.*, 758 F.3d 1344, 1348 (Fed. Cir. 2014) ("For all categories except process claims, the eligible subject matter must exist in some physical or tangible form.").

Rejection Under 35 U.S.C. § 112

The Examiner rejects claim 16 under 35 U.S.C. § 112, second paragraph, as indefinite. *See* Advisory Act. 2. Appellants do not provide arguments disputing the rejection. *See* Appeal Br. 17. We, therefore, summarily affirm the rejection. *See Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir. 2008) ("When the appellant fails to contest a ground of rejection to the Board, . . . the Board may treat any argument with respect to that ground of rejection as waived.").

Rejection Under 35 U.S.C. § 102(b)

The Examiner finds Boyer's discussion of "**presenting** self-service or a chat" if the expected wait time in a queue for a resource exceeds a predetermined time interval discloses "displaying the presence information and the context information on a display of the second user terminal when the preference matches the context information," as recited in claim 1. *See* Final Act. 8 (citing Boyer ¶¶ 49, 66, 6, 31).

Appellants argue Boyer does not disclose "displaying . . . when the preference matches the context information," as claimed because "Boyer does not condition presenting the service options on whether a preference for desired context information matches the context information about a communication session involving a first user terminal." Appeal Br. 23–24. Appellants further argue that Appellants made the same argument in two previous Amendments and "[w]hile maintaining the rejections, neither the Final Office Action nor the Advisory Action addressed that argument." Appeal Br. 24, n.6.

In response, the Examiner relies on Boyer's "**presenting** self-service or a chat" while additionally finding that "the presenting of service options inherently includes displaying presence information and context information." Ans. 17 (emphasis omitted) (citing Boyer Figs. 2, 7, 8, Abstract, ¶¶ 49, 66, 6, 31).

Because the Examiner does not sufficiently explain how Boyer's self-service or chat options are displayed when the preference *matches* the context information, we cannot sustain the rejection. "Anticipation requires that all of the claim elements and their limitations are shown in a single prior art reference." *In re Skvorecz*, 580 F.3d 1262, 1266 (Fed. Cir. 2009). Here, the Examiner fails to demonstrate that Boyer discloses every limitation of claim 1.

We are, therefore, constrained by the record to find the Examiner errs in rejecting: (1) independent claim 1; (2) independent claim 7, which recites commensurate limitations; and (3) dependent claims 2–6 and 8–20 for similar reasons and we do not sustain the anticipation rejection of claims 1–20 for this reason.

Obviousness-type Double Patenting Rejection

The Examiner rejects claims 1, 4, and 7 on the ground of obviousness-type double patenting over claims 1, 3, and 7 of U.S. Patent No. 9,450,898. *See* Final Act. 5–7.

As to this rejection, because our decision is dispositive with respect to patentability because claims 1–20 on appeal do not recite patent-eligible subject matter under § 101, we need not reach the question of whether claims 1, 4, and 7 are properly rejected on the ground of obviousness-type

double patenting. *See Ex parte Gutta*, No. 2008-4366, 93 USPQ2d 1025, 1036 (BPAI 2009) (precedential) (declining to reach prior art rejections because the decision regarding patentability under §§101 was dispositive); *In re Comiskey*, 554 F.3d 967, 973 (Fed. Cir. 2009) (declining to reach obviousness rejection on appeal after concluding many claims were nonstatutory under § 101); *In re Bilski*, 545 F.3d 943, 951 (Fed. Cir. 2008) (en banc) n.1 (noting that § 101 is a threshold requirement and that Examiner may reject claims solely on that basis); *In re Rice*, 132 F.2d 140, 141 (CCPA 1942) (finding it unnecessary to reach rejection based on prior art after concluding claims were directed to nonstatutory subject matter).

Accordingly, we decline to reach the Examiner's obviousness-type double patenting rejection of claims 1, 4, and 7.

DECISION

We affirm the Examiner's decision to reject claims 1–20 under 35 U.S.C. § 101.

We affirm the Examiner's decision to reject claim 16 under 35 U.S.C. § 112, 2nd paragraph.

We reverse the Examiner's decision to reject claims 1–20 under 35 U.S.C. § 102(b).

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