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EXAMINER
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* AARON P. SEREBOFF, MICHAEL L. KAESSNER,  
and CHRISTOPHER D. NEWMAN

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Appeal 2018-006036  
Application 13/959,263  
Technology Center 2400

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Before MAHSHID D. SAADAT, ST. JOHN COURTENAY III, and  
JAMES R. HUGHES, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

## STATEMENT OF CASE

### *Introduction*

Appellants' Specification describes systems and methods for "providing an exchange of profile information by using anonymous identifiers." Spec. ¶ 4.

### *Representative Claim*

Representative claim 1 under appeal reads as follows;

1. An apparatus comprising:
  - at least one processor; and
  - at least one memory including computer program code for one or more programs,
    - the at least one memory and the computer program code configured to, with the at least one processor, cause the apparatus to perform at least the following,
      - select one of a plurality of device identifiers which are associated to a user registered with a profile exchange service, wherein the plurality of device identifiers correspond to the apparatus;
      - cause, at least in part, a transmission of the selected device identifier to another device separate from the apparatus,
        - wherein the plurality of device identifiers are correlated with one or more user profiles associated to the registered user, wherein the one or more user profiles are stored on a database separate from the apparatus;
        - providing access to one of the one or more user profiles based, at least in part, on registration of the apparatus with the profile exchange service and one or more access rights determined by the selected device identifier,
          - wherein access is provided based on registration status of the apparatus;
          - storing the one of the one or more user profiles on the another device; and

presenting the one or more user profiles to another user of the another device via an application based on the storing.

*Rejections on Appeal*

Claims 1–20 stand rejected under 35 U.S.C. § 101 for being directed to patent-ineligible subject matter. *See* Final Act. 7–9.

Claims 1, 2, 4–10, and 12–18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Schroeder (US 2007/0105531 A1; Pub. May 10, 2007) and Nathan (US 2008/0120558 A1; Pub. May 22, 2008). *See* Final Act. 9–16.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Schroeder, Nathan, and Terry (US 6,681,108 B1; Iss. Jan. 20, 2004). *See* Final Act. 17.

Claims 3, 11, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Schroeder, Nathan, Ribaldo (US 2007/0030824 A1; Pub. Feb. 8, 2007), and Konomi (*Snap-On Filters for Mobile Information Appliances*, Proceedings of the Fifth Asia Pacific Conference on Computer Human Interaction, 2002, pp. 357–368). *See* Final Act. 17–19.

Claim 20 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Schroeder, Nathan, and Taylor (US 8,438,631 B1; Iss. May 7, 2013). *See* Final Act. 19.

Claims 1, 2, 4–10, and 12–18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Schroeder and Ribaldo (US 2007/0030824 A1; Pub. Feb. 8, 2007). *See* Final Act. 20–29.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Schroeder, Ribaldo, and Terry. *See* Final Act. 30.

Claims 3, 11, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Schroeder, Ribaldo, and Konomi. *See* Final Act. 30–31.

Claim 20 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Schroeder, Ribaudó, and Taylor. *See* Final Act. 31–32.

Claims 1, 9, and 16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Terry, Schroeder, and Nathan. *See* Final Act. 32–38.

Claims 1, 9, and 16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Terry, Schroeder, and Ribaudó. *See* Final Act. 38–43.

Claims 1, 9, and 16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Coffing (US 2008/0064374 A1; Pub. Mar. 13, 2008), Schroeder, and Nathan. *See* Final Act. 43–48.

Claims 1, 9, and 16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Coffing, Schroeder, and Ribaudó. *See* Final Act. 49–53.

## ANALYSIS

### *REJECTION UNDER 35 U.S.C. § 101*

Appellants argue the pending claims as a group. Br. 7–14. As permitted by 37 C.F.R. § 41.37, we decide the appeal based on claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner determines that the claims are directed to “a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more” and “do not include additional elements that are sufficient to amount to significantly more than the judicial exception.” Final Act. 7. The Examiner adds that:

[C]laim 1 does not include limitations that are “significantly” more than the abstract idea because the claims do not include an improvement to another technology or technical field, an improvement to the functioning of the computer itself, or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment. The

limitations are merely instructions to implement the abstract idea on computer and require no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known in the industry.

*Id.* The Examiner further finds that the recited features are directed to receiving and transmitting data which are well-understood, routine, and conventional. Ans. 8. According to the Examiner, the claims' additional elements merely "recite conventional activities in the relevant field of art" and "utilize generic computing components with respect to the abstract idea." *Id.* Based on these determinations, the Examiner concludes that the claims are ineligible under § 101. *Id.*

Appellants argue that the claimed invention is not directed to an abstract idea. Br. 7–14. According to Appellants, the claims are directed "to improving a computer-related technology, particularly in the area of exchange of user profile information," which are further directed "to improving this area of computer-technology by solving a technical problem and achieving technical advantages as discussed at paragraphs [0032] and [0033] of the published application." Br. 8. Appellants also contend that "the claims amount to significantly more than the [judicial] exception." Br. 10.

#### *Principles of Law*

Section 101 of the Patent Act provides that "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" is patent eligible. 35 U.S.C. § 101. But the Supreme Court has long recognized an implicit exception to this section: "Laws of nature, natural phenomena, and abstract ideas are not patentable."

*Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014) (quoting *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). To determine whether a claim falls within one of these excluded categories, the Court has set out a two-part framework. The framework requires us first to consider whether the claim is “directed to one of those patent-ineligible concepts.” *Alice*, 573 U.S. at 217. If so, we then examine “the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 573 U.S. at 217 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78, 79 (2012)). That is, we examine the claims for an “inventive concept,” “an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 573 U.S. at 217–18 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

In January 2019, the USPTO published revised guidance on the application of § 101. *See 2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“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 activities such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) §§ 2106.05(a)–(c), (e)–(h) (9th ed. Rev. 08.2017, Jan. 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, and 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.

*See* Guidance, 84 Fed. Reg. at 56.

#### *Discussion*

Claim 1 is directed to an abstract idea because the claim recites a method of organizing human activities, one of the abstract idea groupings listed in the 2019 Eligibility Guidance. *See* 2019 Eligibility Guidance, 84 Fed. Reg. at 52, 53 (listing “[c]ertain methods of organizing human [activities] such as a fundamental economic practice” as one of the “enumerated groupings of abstract ideas”).

The claimed apparatus provides “an exchange of profile information by using anonymous identifiers.” Spec. ¶ 4. Claim 1 recites an apparatus comprising a processor, memory, and a program code stored therein to perform the recited functions. Br. 31 (Claims App’x.). The claimed system is further programmed to “select one of a plurality of device identifiers which are associated to a user registered with a profile exchange service, wherein the plurality of device identifiers correspond to the apparatus” such that “the plurality of device identifiers are correlated with one or more user profiles associated to the registered user, wherein the one or more user profiles are stored on a database separate from the apparatus” based on

“providing access to one of the one or more user profiles based, at least in part, on registration of the apparatus with the profile exchange service and one or more access rights determined by the selected device identifier.”

Claims App’x. That is, the claimed apparatus performs functions or method steps that relate to managing interaction between people having user profiles.

To determine whether a claim recites an abstract idea, we (1) identify the claim’s specific limitations that recite an abstract idea, and (2) determine whether the identified limitations fall within certain subject matter groupings, namely (a) mathematical concepts<sup>1</sup>; (b) certain methods of organizing human activity<sup>2</sup>; or (c) mental processes.<sup>3</sup>

Here, apart from the processor, memory and the computer code configured to cause the apparatus to perform the recited functions, every limitation of claim 1 recites an abstract idea, namely organizing human activity, or managing interaction or business relationship between people by providing access to the user profiles by other users who have registered with a profile exchange service. This exchange of user profile does not require a

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<sup>1</sup> Mathematical concepts include mathematical relationships, mathematical formulas or equations, and mathematical calculations. *See* Guidance, 84 Fed. Reg. at 52.

<sup>2</sup> Certain methods of organizing human activity include fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions). *See* Guidance, 84 Fed. Reg. at 52.

<sup>3</sup> Mental processes are concepts performed in the human mind including an observation, evaluation, judgment, or opinion. *See* Guidance, 84 Fed. Reg. at 52.

machine, let alone a particular machine, to implement—fits squarely within the human activity organization category of the agency’s guidelines. *See* Guidance, 84 Fed. Reg. at 52 (listing exemplary methods of organizing human activity including (1) commercial interactions, and (2) managing interactions between people including following rules or instructions).

Although claim 1 recites an abstract idea based on these methods of organizing human activity, we nevertheless must still determine whether the abstract idea is integrated into a practical application, namely whether the claim applies, relies on, or uses the abstract idea in a manner that imposes a meaningful limit on the abstract idea, such that the claim is more than a drafting effort designed to monopolize the abstract idea. *See* Guidance, 84 Fed. Reg. at 54–55. We therefore (1) identify whether there are any additional recited elements beyond the abstract idea, and (2) evaluate those elements individually and collectively to determine whether they integrate the exception into a practical application. *See id.*

Here, the processor, memory and the computer code configured to cause the apparatus to perform the recited functions as well as storing the user profile on the other device and presenting the profile to another user are the only recited elements beyond the abstract idea, but these additional elements do not integrate the abstract idea into a practical application when reading claim 1 as a whole. Therefore, we are not persuaded that the claimed invention improves the computer or its components’ functionality or efficiency, or otherwise changes the way those devices function. In another words, the claimed invention here merely uses generic computing components to select a device identifier related to one or more user profiles and to provide access to those profiles—a generic computer implementation

that is not only directed to fundamental human activity organization and mental processes, but also does not improve a display mechanism as was the case in *McRO, Inc. v. Bandai Namco Games America, Inc.*, 837 F.3d 1299 (Fed. Cir. 2016).

Furthermore, the remaining elements recited in claim 1 do not integrate these abstract ideas into a practical application. In addition to the steps discussed above, claim 1 recites “a profile exchange service” and “storing the one of the one or more user profiles on the another device.” The written description discloses that the recited service and storage encompass generic components such as a general-purpose computer. *See, e.g.*, Spec. ¶¶ 97–100 (“Although computer system 1500 is depicted with respect to a particular device or equipment, it is contemplated that other devices or equipment (e.g., network elements, servers, etc.) within FIG. 15 can deploy the illustrated hardware and components of system 1500.”). Simply programming a general-purpose computer to perform abstract ideas does not integrate those ideas into a practical application. *See* 2019 Eligibility Guidance, 84 Fed. Reg. at 55 (identifying “merely includ[ing] instructions to implement an abstract idea on a computer” as an example of when an abstract idea has not been integrated into a practical application).

Thus, the claims do not integrate the judicial exception into a practical application. The claims do not (1) improve the functioning of a computer or other technology, (2) are not applied with any particular machine (except for a generic computer), (3) do not effect a transformation of a particular article to a different state, and (4) are not applied in any meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a

drafting effort designed to monopolize the exception. *See* MPEP §§ 2106.05(a)–(c), (e)–(h).

*Inventive Concept*

Because we determine claim 1 is “directed to” an abstract idea, we consider whether claim 1 recites an “inventive concept.” The Examiner determined claim 1 does not recite an inventive concept because the additional elements in the claim do not amount to “significantly more” than an abstract idea. *See* Final Act. 7.

We agree. The additional elements recited in the claim include the “a profile exchange service” and “storing [and presenting] the one of the one or more user profiles on the another device.” The claim recites these elements at a high level of generality, and the written description indicates that these elements are generic computer components. *See, e.g.*, Spec. ¶¶ 97–100. Using generic computer components to perform abstract ideas does not provide the necessary inventive concept. *See Alice*, 573 U.S. at 223 (“[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.”). Thus, these elements, taken individually or together, do not amount to “significantly more” than the abstract ideas themselves.

Appellants contend various elements recited in the claim provide the necessary “inventive concept.” Br. 10–12. However, these elements form part of the recited abstract ideas and thus are not “additional elements” that “‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 78); *see also* 2019 Eligibility Guidance, 84 Fed. Reg. at 55 n.24 (“USPTO guidance uses the term ‘additional elements’ to refer to claim features, limitations, and/or steps

that are recited in the claim *beyond the identified judicial exception.*” (Emphasis added)).

We are not persuaded by Appellants’ arguments the claims amount to significantly more than the exception. *See* Br. 10–11. Appellants’ claims can be distinguished from patent-eligible claims such as those in *McRO, Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), and *Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)), that are directed to “a specific means or method that improves the relevant technology” (*McRO*, 837 F.3d at 1314), “a specific improvement to the way computers operate” (*Enfish*, 822 F.3d at 1336), or “solving a technology-based problem” (*BASCOM*, 827 F.3d at 1349-52).

#### *Conclusion*

For at least the above reasons, we agree with the Examiner that claim 1 is “directed to” an abstract idea and does not recite an “inventive concept.” Accordingly, we sustain the Examiner’s rejection of claim 1 and the remaining claims which fail to include additional elements that add significantly more to the abstract idea, under 35 U.S.C. § 101.

#### *REJECTIONS UNDER 35 U.S.C. § 103*

In rejecting claim 1, the Examiner finds Schroeder discloses all the recited elements of the claim but not “providing access to one of the one or more user profiles based, at least in part, on registration of the apparatus with the profile exchange service and one or more access rights determined by the selected device identifier,” for which the Examiner relies on Paragraphs 103–108 of Nathan. *See* Final Act. 9–12. The Examiner further finds the combination would have been obvious to one of ordinary skill in

the art because a user's virtual identity may share a plurality of attributes with another device. *See* Final Act. 12–13.

Appellants contend the Examiner's rejection is in error because characterizing the virtual identity platform of Schroeder as the recited "another device" is inconsistent with the reference disclosure. Br. 17. Appellants argue Figure 4A of Schroeder describes "a necessary intermediary to permit A-Party to communicate with B-Party in the manner intended by the Schroeder system; that is, to permit A-Party to choose a virtual identity to be presented to B-Party without revealing A-Party's primary identity." Br. 17–18. Additionally, Appellants argue that the Examiner's reliance on Nathan's method of managing a virtual avatar fails to provide the missing element of Schroeder. Br. 19.<sup>4</sup>

In response, the Examiner finds that the broadest reasonable interpretation of the disputed claim limitation contradicts with Appellants' assertion that "there can never be a case or scenario where maintenance of the stored data in a memory of a device may be enumerated or accessed." Ans. 4 (citing Schroeder ¶ 33). The Examiner further explains that the disclosed communications services provide the recited communications and transmission to another device. Ans. 6–7 (citing Schroeder ¶ 24). With respect to Nathan, the Examiner focuses on providing access rights and providing information related to social events within the context of an avatar or virtual identity. Ans. 8 (citing Nathan ¶ 103).

Based on a review of Schroeder, we are persuaded by Appellants' contention that the Examiner has not explained how the virtual identity

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<sup>4</sup> We do not address Appellants' other contentions because this contention is dispositive of the issue on appeal.

platform, which is an intermediary to permit access, meets the claimed “another device.” As further pointed out by Appellants (Br. 17–18), the platform 150, rather than accessing a user profile, only acts as an intermediary to permit A-Party to choose a virtual identity to be presented to B-Party without revealing A-Party’s primary identity. In other words, the Examiner has not explained how the teachings of Schroeder, in combination with Nathan, relates to any user profile to be accessed and transmitted to another device based on a determined access right, as recited in claim 1.

*Conclusion*

Therefore, Appellants’ arguments have persuaded us of error in the Examiner’s position with respect to the rejection of independent claim 1 and independent claims 9 and 16, which recite similar limitations. The Examiner has not identified any teachings in the other applied prior art that would make up for the above-mentioned deficiency. We, therefore, do not sustain any of the 35 U.S.C. § 103 rejections of claims 1, 9, and 16, as well as claims 2–8, 10–15 and 17–20 dependent therefrom.

DECISION

We affirm the Examiner’s rejection of claims 1–20 under 35 U.S.C. § 101.

We reverse the Examiner’s rejections of claims 1–20 under 35 U.S.C. § 103.

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

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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