



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/861,241	08/23/2010	Yoelle Maarek Smadja	12729-864 (Y06461US00)	1657
123510	7590	06/16/2020	EXAMINER	
Cooper Legal Group LLC 6505 Rockside Road Suite 330 Independence, OH 44131			MACASIANO, MARILYN G	
			ART UNIT	PAPER NUMBER
			3688	
			NOTIFICATION DATE	DELIVERY MODE
			06/16/2020	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@cooperlegalgroup.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YOELLE MAAREK SMADJA, ANDREI BRODER, VANJA
JOSIFOVSKI, and MELISSA B. STEIN

Appeal 2018-007215
Application 12/861,241
Technology Center 3600

BEFORE DEBRA K. STEPHENS, GENE E. BRANCH, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1, 2, 4–18, 20–25, 27, and 28 (*see* Final Act. 1). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Yahoo Holdings, Inc. (Appeal Br. 2).

CLAIMED SUBJECT MATTER

The claims are directed to a method and system for using email receipts for targeted advertising. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A computer implemented method, comprising:

identifying a plurality of commercial emails for a plurality of users, the plurality of commercial emails stored in a plurality of email mailboxes in an email store;

parsing the commercial emails to extract data identifying one or more parameters of a commercial transaction included in email bodies of the commercial emails;

categorizing, using at least one processor, each of the plurality of users in to one or more commercial behavior categories based on the data identifying one or more parameters of the commercial transaction included in the email bodies of the commercial emails, wherein each commercial behavior category identifies a commercial behavior of a respective user;

determining a privacy selection associated with each of the plurality of users, wherein the privacy selection indicates whether the system may extract personal information from the commercial emails associated with the user;

generating, using at least one processor, a user profile for each of the plurality of users that contains the one or more commercial behavior categories for the respective user;

associating at least one user profile for at least one user of the plurality of users with an anonymous identifier in response to determining that the privacy selection of the at least one user indicates that personal information may not be extracted from the commercial emails associated with the at least one user; and

selecting, using at least one processor, a targeted advertisement for display to a user from the plurality of users using the user profile for that respective user and based at least on the one or more commercial behavior categories of the user.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Rawat	US 2002/0174185A1	Nov. 21, 2002
Sheldon	US 6,708,205 B2	Mar. 16, 2004
Gross	US 2005/0044153 A1	Feb. 24, 2005
Yang	US 2006/0085504 A1	Apr. 20, 2006
Reardon	US 7,873,572 B2	Jan. 18, 2011
Minnis	US 8,719,105 B2	May 6, 2014

REJECTIONS²

Claims 1, 2, 4–18, 20–25, 27, and 28 are rejected under 35 U.S.C. § 101 because the claimed invention is not directed to patent-eligible subject matter (Final Act. 3–8).

Claims 1, 2, 4–18, 20–25, 27, and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sheldon, Reardon, and Minnis (*id.* at 9–33).

We have considered only those arguments that Appellant actually raised in the Briefs. Arguments Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived (*See* 37 C.F.R. § 41.37(c)(1)(iv)).

² The separate and additional rejection of claim 18 under 35 U.S.C. § 101 as not being directed to patent-eligible subject matter (Final Act. 8) has been withdrawn by the Examiner (Ans. 3).

OPINION

35 U.S.C. § 101: Claims 1, 2, 4–18, 20–25, 27, and 28

Appellant argues their invention as recited in claims 1, 2, 4–18, 20–25, 27, and 28, is directed to patent-eligible subject matter (Appeal Br. 5).

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 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 (*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 id.* 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 184 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 2019 Revised Section 101 Guidance

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 (“2019 Guidance”))).³ “All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance” (*id.* at 51); *see also* October 2019 Patent Eligibility Guidance Update, U.S. Patent and Trademark Office, 1 (October 19, 2019), https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf (“October 2019 Update”))).

Under the 2019 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

³ 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 “October 2019 Update”) (available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf)).

(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)) (“Step 2A, Prong Two”).⁴

(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, and 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).

Appellant argues all pending claims as a group (*see* Appeal Br. 15). Accordingly, we address all pending claims as a group and select independent claim 1 as representative of the claimed subject matter (*see* 37 C.F.R. § 41.37(c)(1)(iv)).

⁴ 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 practical application. *See* 2019 Revised Guidance - Section III(A)(2), 84 Fed. Reg. 54–55.

ANALYSIS

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). We determine that independent claims 1, 18, and 27 recite a method, a user classifier, and system, respectively. As such, the claims are directed to statutory classes of invention within 35 U.S.C. § 101, i.e., processes, machines, and manufactures.

STEP 2A, Prong 1

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

We agree with the Examiner’s determination that the claims are “directed to the abstract idea of classifying users according to commercial emails, for targeting advertising” (Final Act. 3) and specifically, that the claims as a whole are directed to the abstract idea of a commercial interaction, namely advertising activities, which are categorized as certain methods of organizing human activity, because the claims recite “selecting . . . a targeted advertisement for display to a user” (Appeal Br., claim 1) (*See* 2019 Guidance, 84 Fed. Reg. at 52). We further determine the claims as a whole are directed to allow advertisers to “better assess the effectiveness of their advertisements, and . . . better learn what products and services are

being purchased by consumers” (Spec. ¶ 2) — commercial interactions, and specifically, advertising (2019 Guidance, 84 Fed. Reg. at 52).

An inspection of the claims supports the Examiner’s determination.

In particular, representative claim 1 recites:

[a] identifying a plurality of commercial emails for a plurality of users, the plurality of commercial emails stored in a plurality of email mailboxes in an email store;

[b] parsing the commercial emails to extract data identifying one or more parameters of a commercial transaction included in email bodies of the commercial emails;

[c] categorizing, using at least one processor, each of the plurality of users in to one or more commercial behavior categories based on the data identifying one or more parameters of the commercial transaction included in the email bodies of the commercial emails, wherein each commercial behavior category identifies a commercial behavior of a respective user;

[d] determining a privacy selection associated with each of the plurality of users, wherein the privacy selection indicates whether the system may extract personal information from the commercial emails associated with the user;

[e] generating, using at least one processor, a user profile for each of the plurality of users that contains the one or more commercial behavior categories for the respective user;

[f] associating at least one user profile for at least one user of the plurality of users with an anonymous identifier in response to determining that the privacy selection of the at least one user indicates that personal information may not be extracted from the commercial emails associated with the at least one user; and

[g] selecting, using at least one processor, a targeted advertisement for display to a user from the plurality of users using the user profile for that respective user and based at least on the one or more commercial behavior categories of the user.

(bracketed labels added). Those limitations describe “targeting advertising,” i.e., certain methods of organizing human activity, and particularly

commercial interactions (Final Act. 5). Limitations [a], [b], and [c] recite steps for “identifying . . . commercial emails”; “parsing the commercial emails . . . identifying . . . parameters of a commercial transaction”; “categorizing . . . each . . . user in to one or more commercial behavior categories based on . . . parameters of the commercial transaction” (Claim 1). Determining categories of users based on past purchases to optimize targeted advertising is a fundamental and well-known aspect of commercial interaction and specifically, advertising. Thus, these steps involve commercial interactions (e.g., an advertising activity).

Limitation [d] recites a step for allowing a user to opt out of the extraction of personal information from their email messages — “determining a privacy selection associated with each . . . user” (Claim 1). Providing the capability to opt out of advertising activities is another fundamental and well-known aspect of commercial interaction and particularly, advertising. Thus, this step also describes a commercial interaction. Limitations [e], [f], and [g] recite steps for “generating . . . a user profile for each . . . user[s containing the] commercial behavior categor[y]”; “associating [a] user profile for [the] user . . . with an anonymous identifier”; and “selecting . . . a targeted advertisement for display to a user . . . based [on the] commercial behavior categories of the user.” Associating identifiers with users and displaying targeted advertisements based on identified categories are fundamental and well-known aspects of advertising. Thus, these steps also describe a commercial interaction.

As such, as correctly recognized by the Examiner, the claims recite a commercial interaction, and more specifically, a type of advertising activity,

which is identified as a method of organizing human activity according to the 2019 Guidance (2019 Guidance, 84 Fed. Reg. at 52). Therefore, we determine the claims recite an abstract idea.

STEP 2A Prong 2

Next, we determine whether the claims are directed to the abstract concept itself or whether the claims are instead directed to some technological implementation or application of, or improvement to, the recited concept, i.e., integrated into a practical application (*see, e.g., Alice*, 573 U.S. at 223, discussing *Diehr*, 450 U.S. at 175; October 2019 Update 10).

Appellant argues that “[t]he rejected claims are directed to a specific improvement in computer capabilities, and are therefore not directed to any abstract idea” (Reply Br. 2). Appellant further argues “the instant claims provide for steps that require the use of computer technology to implement, and thus *improves the technology for online advertisement selection* by categorizing user data extracted from emails” (Reply Br. 7). According to Appellant, “the instant application reduces reliance on the use of pixels or beacons, which enables avoiding the labor-intensive activities and targeting limitations associated with the use of pixels or beacons to determine conversion, and *improves the accuracy of selecting targeted advertisements while reducing noise*” (*id.* at 4, 6, 7 (emphasis added)). Moreover, the Specification describes in the Background, “further techniques are desired for measuring conversions and/or for otherwise assessing what products and services that consumers are purchasing” (Spec. ¶ 3).

We are not persuaded the claims improve the functioning of a computer, or any other technology or technical field (*see* 2019 Guidance, 84 Fed. Reg. at 55). Rather, we determine the claims improve methods for advertising. We agree with the Examiner that “[t]he claims amount to nothing more than an abstract idea that uses [a] computer as a tool” (Ans. 4). The 2019 Guidance states that an element that “merely includes instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea” is an example which the courts have identified as not being integrated into a practical application (84 Fed. Reg. at 55). Although Appellant contends the rejected claims are directed to reducing reliance on the use of pixels or beacons (Reply Br. 7), neither the claims nor the Specification provides any technical details as to how the steps are performed on the pixels or beacons. Thus, we are not persuaded the claims recite additional elements that amount to significantly more than the judicial exception.

Next, Appellant argues “[t]he instant claims . . . address a business challenge (providing targeted advertisements) that is particular to the Internet” and “the claims in the instant application are related to a problem specifically arising in the realm of the Internet” (Reply Br. 9). However, the 2019 Guidance provides that an element that “does no more than generally link . . . to a particular technological environment or field of use” does not integrate the exception into a practical application (84 Fed. Reg. at 55). The MPEP elaborates on this statement to emphasize that generally linking an abstract idea to the Internet fails to integrate the abstract idea into a practical application (MPEP § 2106.05(h), citing *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014) (citation omitted) (“Narrowing the abstract

idea of using advertising as a currency to the Internet is an ‘attempt[] to limit the use’ of the abstract idea ‘to a particular technological environment,’ which is insufficient to save a claim”). Furthermore, our reviewing Court has held that “merely limiting the field of use of the abstract idea to a particular . . . environment does not render the claims any less abstract.” *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1259 (Fed. Cir. 2016). We, therefore, conclude the claims recite mere instructions to implement the abstract idea on a computer (i.e., the claimed “at least one processor”), and further, merely use a computer as a tool to perform the abstract idea (2019 Guidance, 84 Fed. Reg. at 55; MPEP § 2106.05(f)).

Therefore, although the solution uses technology—e.g., software and processors are used to improve the accuracy of selecting targeted advertisements while reducing noise—the claims do not recite an improvement to the *computer* or the *technology* itself.

The October 2019 Patent Eligibility Guidance Update states in the Step 2A Prong 2 analysis, to “analyze the ‘improvements’ consideration by evaluating the specification and the claims to ensure that a *technical explanation* of the asserted improvement is present in the specification, and that the claim reflects the asserted improvement” (October 2019 Patent Update). In the instant application, the Specification does not contain any technical explanation of the asserted improvements of “technology for online advertisement selection by categorizing user data extracted from emails” (*see* Reply Br. 7). Rather, the Specification merely describes the general communications that occur between an email database and various processor-implemented components (e.g., a “parsing engine”). For example, the process of transmitting advertisements to user devices is described as

being “carried out over one or more networks using well-known network communication protocols” (Spec ¶ 91). Other portions of the Specification and Figures similarly describe how the communications generally occur between the various entities (*see generally*, Specification). However, nowhere does Specification provide any *technical explanation* of the asserted improvements to the technology.

Appellant contends the claims recites “categorizing the user data extracted from the emails and selecting a targeted advertisement based on the classified user data” and thus, “the pending claims recite improvements in a computer device analyzing large amounts of data (e.g., data extracted from emails) while also reducing the amount of electronic noise processed by the computer device” (Appeal Br. 5). Neither the Specification nor the claims provide any technical explanation as to the asserted improvements to the technology (*see generally*, Specification). Indeed, the claims are not directed to an improvement in the functioning of the computer itself; rather, the claims are directed toward improving which advertisements will be displayed based on the commercial behavior categories of the user, which are determined based on e-mails and their content.

Accordingly, the claims do not recite a specific asserted improvement in computer technological implementation and particularly, fail to recite additional elements that integrate the judicial exception into a practical application.

STEP 2B

Next, we determine whether the claims include additional elements that provide significantly more than the recited judicial exception, thereby

providing an inventive concept (*Alice*, 573 U.S. at 218–219 (quoting *Mayo*, 566 U.S. at 72–73)).

We agree with the Examiner’s determination that “[t]he claims do[] not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional elements when considered both individually and as an ordered combination do not amount to significantly more than the abstract idea” (Final Act. 5). We further agree with the Examiner’s explanation that “[g]eneric computer components recited as performing generic computer functions that are well-understood, routine and conventional activities amount to no more than implementing the abstract idea with a computerized system” (*id.*).

Appellant argues that “the instant claims provide for a non-conventional and non-generic arrangement of features related to the technological field of targeted advertisement selection using email” (Reply Br. 11). We are not persuaded. “A claim for a new abstract idea is still an abstract idea” (*Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151). Neither the individual features of the claims themselves nor the combination of elements are anything other than well-understood, routine, or conventional activities. Specifically, Appellant’s Specification describes, for example, the method of claim 1, user classifier of claim 18, and the system of claim 27 are described in Figure 14 and in the Specification as being able to be “implemented using well known servers/computers” (Spec. ¶ 102). The elements of Figure 14 are also described as well-understood, routine, and conventional (e.g., one or more processors 1404, memory 1406, a communication device 1402, and one or more input/output (I/O) devices 1422) (Spec. ¶¶ 103–110). For example, in Appellant’s Specification, the

computer is described as “any commercially available and well known computer capable of performing the functions described herein, such as computers available from International Business Machines, Apple, Sun, HP, Dell, Cray, etc.” (Spec. ¶ 103). The mobile computer or computing device is described as “a Palm® device, a RIM Blackberry® device, a personal digital assistant (PDA), a laptop computer, a notebook computer, etc.), a smart phone, or other type of computing device” (*id.* ¶ 36). Moreover, the process of transmitting advertisements to user devices is described as being “carried out over one or more networks using well-known network communication protocols” such as “IEEE 802.11 wireless LAN (WLAN) wireless links, Worldwide Interoperability for Microwave Access (Wi-MAX) links, cellular network links, wireless personal area network (PAN) links (e.g., Bluetooth™ links), Ethernet links, USB links, etc.” (Spec ¶¶ 36, 91). Other portions of the Specification and Figures similarly describe how the communications generally occur between the various entities (*see generally*, Specification). None of these descriptions provide any additional technical detail.

According to the *Berkheimer* Memorandum,

[a] specification demonstrates the well-understood, routine, conventional nature of additional elements when it describes the additional elements as well-understood or routine or conventional (or an equivalent term), as a commercially available product, or in a manner that indicates that the additional elements are sufficiently well-known that the specification does not need to describe the particulars of such additional elements to satisfy 35 U.S.C. § 112(a)

(Robert W. Bahr, Memorandum on *Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (Berkheimer v. HP, Inc.)*, 1, 3, (April 19, 2018)).

As stated above with regards to Step 2A, Prong 1, the overall process described in the claims is nothing other than a long-standing economic process (i.e., determining categories of users based on past purchases in order to optimize targeted advertising and subsequently delivering that advertising to a user). Accordingly, the steps described in the claims are “well-understood, routine, and conventional”. Further, the individual elements described in the claims are also well-understood, routine, and conventional. “An abstract idea does not move into section 101 eligibility territory by ‘merely requir[ing] generic computer implementation’” (*buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1354 (Fed. Cir. 2014) (citation omitted)).

Therefore, we conclude that the claims fail to recite additional elements that amount to significantly more than the judicial exception. Accordingly, the Examiner did not err in concluding the invention as recited is directed to non-statutory subject matter. Therefore, the Examiner did not err in rejecting claims 1, 2, 4–18, 20–25, 27, and 28 under 35 U.S.C. § 101 as not being directed to statutory subject matter.

35 U.S.C. § 103(a): Claims 1, 2, 4–18, 20–25, 27, and 28

Appellant contends their invention as recited in claims 1, 2, 4–18, 20–25, 27, and 28, is not obvious over Sheldon, Reardon, and Minnis (Appeal Br. 19). The issue presented by the arguments is whether the combination of Sheldon, Reardon, and Minnis teaches or suggests

determining a privacy selection associated with each of the plurality of users, wherein the privacy selection indicates whether the system may extract personal information from the commercial emails

and

categorizing, using at least one processor, each of the plurality of users in to one or more commercial behavior categories based on the data identifying one or more parameters of the commercial transaction included in the email bodies of the commercial emails, wherein each commercial behavior category identifies a commercial behavior of a respective user,

as recited in claim 1.

ANALYSIS

“determining a privacy selection associated with each of the plurality of users, wherein the privacy selection indicates whether the system may extract personal information from the commercial emails”

Appellant contends the Examiner erred in finding the combination of Sheldon, Reardon, and Minnis teaches, suggests, or otherwise renders obvious “determining a privacy selection *associated with each of the plurality of users, wherein the privacy selection indicates whether the system may extract personal information from the commercial emails*” as recited in claim 1 (Appeal Br., claim 1 (emphasis added)).

Appellant argues “[w]hile Sheldon describes certain email privacy settings based on the source of the emails, these privacy settings have no control or relation to whether personal information may be extracted from emails” (Appeal Br. 22). We find Appellant’s argument persuasive.

The Examiner relies on column 21, lines 28–46 and (Final Act. 10) and column 17, lines 25–29 (Ans. 8) of Sheldon to teach this feature. We agree with Appellant that “Sheldon’s disclosed privacy selection deals with the receiving and routing of emails” (Appeal Br. 22). In particular, we agree with Appellant that “[t]he determination of a privacy selection for extracting personal information from an email is a different technological feature from determining a privacy selection for receiving and routing emails” (*id.*). Thus, Sheldon does not disclose the claimed feature.

Accordingly, we are persuaded the Examiner has not shown the combination of Sheldon, Reardon, and Minnis teaches, suggests, or otherwise renders obvious the limitation as recited in claim 1 and claims 2, 4–18, 20–25, 27, and 28, not separately argued. Therefore, we reverse the rejection of claims 1, 2, 4–18, 20–25, 27, and 28 under 35 U.S.C. § 103(a) for obviousness over Sheldon, Reardon, and Minnis.

Because we agree with at least one of the arguments advanced by Appellant, we need not reach the merits of Appellant’s other arguments. It follows that Appellant has persuaded us the combined teachings of Sheldon, Reardon, and Minnis fail to render claims 1, 2, 4–18, 20–25, 27, and 28 obvious.

CONCLUSION

Because we have affirmed at least one ground of rejection for each claim on appeal, we affirm the Examiner's decision to reject the claims.
37 C.F.R. § 41.50(a)(1).

More specifically,

The rejection of claims 1, 2, 4–18, 20–25, 27, and 28 under 35 U.S.C. § 101 as not being directed to patent-eligible subject matter is affirmed.

The rejection of claims 1, 2, 4–18, 20–25, 27, and 28 under 35 U.S.C. § 103 as being unpatentable over Sheldon, Reardon, and Minnis is reversed.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2, 4–18, 20–25, 27, 28	101	Eligibility	1, 2, 4–18, 20–25, 27, 28	
1, 2, 4–18, 20–25, 27, 28	103	Sheldon, Reardon, Minnis		1, 2, 4–18, 20–25, 27, 28
Overall Outcome:			1, 2, 4–18, 20–25, 27, 28	

TIME PERIOD FOR RESPONSE

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

AFFIRMED