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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RONALD B. BAKER and TARA L. SIMS

Appeal 2018-007668
Application 15/335,072
Technology Center 2400

Before JOHN A. EVANS, JAMES W. DEJMEK and
MICHAEL M. BARRY, *Administrative Patent Judges*.

EVANS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ seek our review under 35 U.S.C. § 134(a) of the Examiner’s final rejection of Claims 21–40. App. Br. 6. Appellants have canceled claims 1–20. App. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.²

¹ Appellants state the real party in interest is IBM Corporation. App. Br. 1.

² Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed March 6, 2018, “App. Br.”), the Reply Brief (filed July 16, 2018, “Reply Br.”), the Examiner’s Answer (mailed May 31, 2018, “Ans.”), the Final Action (mailed October 25, 2017, “Final Act.”), and

STATEMENT OF THE CASE

The claims relate to negotiated delivery and rejection of electronic mail (“email”), such that the email is delivered to a recipient only under certain enumerated conditions. Spec. ¶ 21.

Invention

Claims 21, 28, and 35 are independent. An understanding of the invention can be derived from a reading of Claim 21, which is reproduced below:

21. A computer-implemented method performed within an electronic mail server, comprising:

sending, responsive to receiving an electronic mail from a sender client system, acceptance criteria for a recipient of the electronic mail to the sender client system;

receiving, from the sender client system and in response to the acceptance criteria, acceptance criteria values;

rejecting the electronic mail upon a determination that the acceptance criteria values are non-compliant with the acceptance criteria; and

providing, to the sender client system, a reason as to non-compliance of the electronic mail.

Rejections

1. Claims 21–40 stand rejected under the doctrine of non-statutory, obviousness-type double patenting. Final Act. 4.

the Specification (filed October 26, 2016, “Spec.”) for their respective details.

2. Claims 21–40 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter without significantly more. Final Act. 4–8.

ANALYSIS

We have reviewed the rejections of Claims 21–40 in light of Appellants’ arguments that the Examiner erred. We have considered in this decision only those arguments Appellants actually raised in the Briefs. Any other arguments which Appellants could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2017). We are not persuaded that Appellants identify reversible error. Upon consideration of the arguments presented in the Appeal Brief and Reply Brief, we agree with the Examiner that all the pending claims are unpatentable. We adopt as our own the findings and reasons set forth in the rejection from which this appeal is taken and in the Examiner’s Answer, to the extent consistent with our analysis below. We provide the following explanation to highlight and address specific arguments and findings primarily for emphasis. We consider Appellants’ arguments *seriatim*, as they are presented in the Appeal Brief, pages 6–20.

CLAIMS 21–40: NON-STATUTORY, OBVIOUSNESS-TYPE DOUBLE PATENTING

Appellants do not contest this ground of rejection. *See generally* App. Br. 6–20. Because Appellants present no arguments directed to this rejection, it is summarily affirmed. *See* 37 C.F.R. § 41.37(c)(1)(iv) (explaining that in situations such as this “[a]ny arguments or authorities not included in the appeal brief will be refused consideration by the Board for

purposes of the present appeal”); MPEP § 1205.02 (9th ed. March 2014) (“[T]he Board may summarily sustain any grounds of rejections not argued.”).

CLAIMS 21–40: INELIGIBLE SUBJECT MATTER

Appellants assert that in addressing the § 101 rejection, “claims 28 and 35 stand or fall together with independent claim 21; and claims 23–27, 29–34, and 36–40 stand or fall together with dependent claim 22.”

App. Br. 6. Thus, we address in detail the appeal of the § 101 rejection of independent Claim 21 and dependent Claim 22, with which the § 101 rejection of Claims 23–40 stand or fall. *See* 37 C.F.R. § 41.37(c)(1)(iv); *In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986).

Prima Facie Case.

Appellants contend the Examiner fails to make a prima facie case that dependent Claim 22 recites patent-ineligible subject matter. App. Br. 18–19; Reply Br. 9.

We conclude the Examiner did initially set forth a prima facie case of patent ineligibility, i.e., the Examiner’s reasons are sufficient to set forth the basis for the rejection so as to put the patent applicant on notice of the reasons why the applicant is not entitled to a patent. *Cf. In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). For example, in the Answer, the Examiner explains that the additional elements of dependent claim 22 (and dependent claims 23–27) do not recite significantly more than the identified abstract idea because they merely specify the type of data gathered and analyzed. Ans. 8.

Preemption.

Appellants contend the claims do not seek to preempt or monopolize a fundamental economic practice. App. Br. 15–16; Reply Br. 7–8.

While preemption may denote patent ineligibility, its absence does not demonstrate patent eligibility. *See FairWarning, IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016). For claims reciting a patent-ineligible concept, preemption concerns “are fully addressed and made moot” by an analysis under the *Mayo/Alice* framework. *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). We conduct such an analysis below. In response to Supreme Court and Federal Circuit opinions, the USPTO has issued updated guidance. We review this appeal within the framework of the Revised Guidance, which specifies and particularizes the *Mayo/Alice* framework.

Improper and Inconsistent Examination.

In the briefings, Appellants argue the Examiner’s office actions are inconsistent with one another and that the Examiner has applied various USPTO examination guidance documents improperly. *See, e.g.*, App. Br. 8, 10–12, 16. The Director of the United States Patent and Trademark Office, not the Board, supervises examination and examiners. If an examiner has erred procedurally, the remedy lies exclusively in petitioning the Director for supervisory review. The Director has not delegated this supervisory authority to the Board.

35 U.S.C. § 101

Section 101 provides that a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new

and useful improvement thereof.” 35 U.S.C. § 101. The Supreme Court has long recognized, however, that § 101 implicitly excludes “[l]aws of nature, natural phenomena, and abstract ideas” from the realm of patent-eligible subject matter, as monopolization of these “basic tools of scientific and technological work” would stifle the very innovation that the patent system aims to promote. *Alice Corp. Pty. Ltd. 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)); *see also Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S.66, 72–78 (2012); *Diamond v. Diehr*, 450 U.S.175, 185 (1981).

Under the mandatory 2019 Revised Guidance,³ we reconsider whether Appellants’ claims recite:

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 reach the issue of whether the claim:

3. adds a specific limitation beyond the judicial exception that is not **“well-understood, routine, conventional”** in the field (*see* MPEP

³ USPTO, 2019 Revised Patent Subject Matter Eligibility Guidance, 84(4) Fed. Reg. 50–57 (January 7, 2019) (“Revised Guidance,” “Rev. Guid.”).

§ 2106.05(d)); or simply appends well-understood, routine, conventional activities previously known to the industry, **specified at a high level of generality**, to the judicial exception.

A. Judicial Exceptions.

The Revised Guidance extracts and synthesizes key concepts identified by the courts as abstract ideas to explain that the abstract idea exception includes the following groupings of subject matter, when recited as such in a claim limitation(s) (that is, when recited on their own or *per se*): (a) mathematical concepts,⁴ i.e., mathematical relationships, mathematical formulas, equations,⁵ and mathematical calculations;⁶ (b) certain methods of organizing human activity—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

⁴ *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“The concept of hedging . . . reduced to a mathematical formula . . . is an unpatentable abstract idea.”).

⁵ *Diehr*, 450 U.S. at 191 (“A mathematical formula as such is not accorded the protection of our patent laws”); *Parker v. Flook*, 437 U.S. 584, 594 (1978) (“[T]he discovery of [a mathematical formula] cannot support a patent unless there is some other inventive concept in its application.”).

⁶ *SAP America, Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1163 (Fed. Cir. 2018) (holding that claims to a “series of mathematical calculations based on selected information” are directed to abstract ideas).

instructions)⁷; and (c) mental processes⁸—concepts performed in the human mind (including observation, evaluation, judgment, opinion).⁹

The preamble of Claim 21 recites: “A computer-implemented method performed within an electronic mail server.” The limitations of the body of Claim 21 are analyzed in Table I as they correspond to abstract ideas as set forth in the Revised Guidance.

Table I

Claim 21	Revised Guidance, p. 52
[a] ¹⁰ sending, responsive to receiving an electronic mail from a sender client system, acceptance criteria for	“mere data gathering.” Additional element adds insignificant extra-

⁷ *Alice*, 573 U.S. at 219–20 (concluding that use of a third party to mediate settlement risk is a “fundamental economic practice” and thus an abstract idea); see Rev. Guid. 52 n.13 (for a more extensive listing of “certain methods of organizing human activity” that have been found to be abstract ideas).

⁸ If a claim, under its broadest reasonable interpretation, covers performance in the mind but for the recitation of generic computer components, then it is still in the mental processes category unless the claim cannot practically be performed in the mind. See Rev. Guid. 52 n.14; see *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1318 (Fed. Cir. 2016) (“[W]ith the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper.”).

⁹ *Mayo*, 566 U.S. at 71 (“[M]ental processes[] and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work” (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972))).

¹⁰ Indicia, e.g., “[a],” added to facilitate discussion.

a recipient of the electronic mail to the sender client system;	solution activity to the judicial exception. Rev. Guid. 55 & n.31.
[b] receiving, from the sender client system and in response to the acceptance criteria, acceptance criteria values;	“mere data gathering.” Additional element adds insignificant extra-solution activity to the judicial exception. Rev. Guid. 55 & n.31.
[c] rejecting the electronic mail upon a determination that the acceptance criteria values are non-compliant with the acceptance criteria;	(c) Mental processes—concepts performed in the human mind (including an observation, evaluation, judgment, opinion). Rev. Guid. 52.
[d] providing, to the sender client system, a reason as to non-compliance of the electronic mail.	“mere data gathering.” Additional element adds insignificant extra-solution activity to the judicial exception. Rev. Guid. 55 & n.31.

The claim limitations cover performance of the limitations in the mind but for the recitation of generic computer components. That is, other than client systems and an email server, nothing in the claim elements precludes the steps from practically being performed in the human mind. The mere nominal recitation of generic computer network elements does not take the claim limitations out of the mental processes grouping. As the Examiner finds, filtering out non-compliant mail, as recited in Claim 21, “simply compares the acceptance criteria defined by the recipient with the acceptance criteria values provided by the sender” and “involves mental processes” similar to ones found abstract by the courts. Ans. 3–4.

For example, the Examiner notes in the Answer that Claim 21 recites steps similar to the old and well-known practices of a corporate mailroom,

which the Federal Circuit mentions in finding a similarly claimed invention abstract. *See* Ans. 5. Similar to Claim 21, a corporate mailroom “receive[s] correspondence, keep[s] business rules defining actions to be taken regarding correspondence based on attributes of the correspondence, appl[ies] those business rules to correspondence, and take[s] certain actions based on the application of business rules.” *Intellectual Ventures I*, 838 F.3d at 1317.

Additionally, as the Examiner points out, the Federal Circuit has found that the concept of “filtering content is an abstract idea because it is a longstanding, well-known method of organizing human behavior, similar to concepts previously found to be abstract.” Ans. 6 (citing *BASCOM Global Internet Servs. v. AT&T Mobility*, 827 F.3d 1341, 1348 (Fed Cir. 2016)).

Therefore, we conclude Claim 21 recites a mental process and/or a method of organizing human activity, which the Revised Guidance identifies as types of abstract ideas. In view of the above, we disagree with Appellants that the Examiner has overgeneralized the claim, has not considered the claim as a whole, and has not explained why the problem Appellants’ invention purports to solve is not unique to the Internet. *See* App. Br. 8, 16; Reply Br. 3–5.

B. Integration of the judicial exception into a practical application.

Where, as here, we determine the claim recites a judicial exception, we look to determine the presence of additional elements that integrate the judicial exception into a practical application. The Revised Guidance is “designed to more accurately and consistently identify claims that recite a practical application of a judicial exception [] and thus are not ‘directed to’ a

judicial exception.” Rev. Guid. 53. The Revised Guidance identifies several exemplary considerations for when a claim may recite an additional element (or combination of elements) such that the judicial exception has been integrated into a practical application, which we address below. *See* Rev. Guid. 55.

Appellants contend Claim 21 is not “directed to” the abstract idea identified by the Office, but instead is “necessarily rooted in computer technology and used to overcome problems specifically arising in the realm of computer networks and email servers,” similar to the claims found patent eligible in *DDR Holdings, LLC v. Hotels.com L.P.*, 773 F.3d 1245 (Fed. Cir. 2014). App. Br. 9; *see also* Reply Br.2–3. Appellants further contend the claim recites more than the abstract idea identified by the Office because the claim is “tied to a machine” and includes “additional limitations that are directed to an improvement to an existing technological process.” App. Br. 7–9; Reply Br. 6–7. More specifically, Appellants assert Claim 21 recites a technological improvement that “address[es] the significant problem of unwanted emails referred to as ‘junk email’ or ‘spam’” by allowing the receiver of the email to customize the types of emails being received and the sender to update/modify acceptance criteria upon receiving a reason for noncompliance. App. Br. 18 (citing *McRO, Inc. v. Bandai Namco Games Am.*, 837 F.3d 1299 (Fed. Cir. 2016)).

For the reasons which follow, the foregoing arguments are unpersuasive, and we conclude that Appellants’ claims do not integrate the judicial exception into **a practical application**. *See* MPEP §§ 2106.05(a)-(c) and (e)-(h). We address these “practical application” MPEP sections

seriatim:

MPEP § 2106.05(a) “Improvements to the Functioning of a Computer or To Any Other Technology or Technical Field.”

“In determining patent eligibility, examiners should consider whether the claim ‘purport(s) to improve the functioning of the computer itself’” or “‘any other technology or technical field.’” MPEP § 2106.05(a).

Although Claim 21 recites various computing elements, Appellants present no persuasive evidence that practicing the claim results in an improvement to the functioning of the computer. The claim is silent regarding specific limitations directed to an improved computer system, processor, memory, network, database, or Internet.

The purported improvements advanced by Appellants—allowing someone to customize the types of mail being received and update or modify acceptance criteria (*see* App. Br. 18; Reply Br. 8)—are not technological, but instead are the use of generic computer technology adapted to “computerize” well-known solutions to age-old practices in conventional mail delivery. For example, a recipient of unwanted mail may ask to be removed from the sender’s mailing list; in response to which, the sender complies and removes the recipient’s name and address from the mailing list.

MPEP § 2106.05(b) Particular Machine.

At the outset, we note that the *Bilski* machine-or-transformation test is only applicable to the method (process) claims on appeal. This section of the MPEP guides: “When determining whether a claim recites significantly more than a judicial exception, examiners should consider whether the judicial exception is applied with, or by use of, a particular machine.”

MPEP § 2106.05(b); *see also Bilski*, 561 U.S. at 604 (2010) (“[T]he machine-or-transformation test is a useful and important clue, and investigative tool” for determining whether a claim is patent eligible under § 101).

MPEP § 2106.05(b) provides further guidance regarding what constitutes a particular machine:

[A]s described in MPEP §2106.05(f), additional elements that invoke computers or other machinery merely as a tool to perform an existing process will generally not amount to significantly more than a judicial exception. *See, e.g., Versata Development Group v. SAP America*, 793 F.3d 1306, 1335 (Fed. Cir. 2015) (explaining that in order for a machine to add significantly more, it must “play a significant part in permitting the claimed method to be performed, rather than function solely as an obvious mechanism for permitting a solution to be achieved more quickly”).

We find Claim 21 is *silent* regarding specific limitations directed to *improving* a computer system, processor, memory, network, database, or the Internet, nor do Appellants direct our attention to such specific limitations. “[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 573 U.S. at 223; *see also BASCOM*, 827 F.3d at 1348 (“An abstract idea on ‘an Internet computer network’ or on a generic computer is still an abstract idea”). Applying this reasoning here, we conclude Claim 21 is not directed to a particular machine, but rather merely implements an abstract idea using generic computer components. Thus, we conclude Claim 21 fails to satisfy the “tied to a particular machine” prong of the *Bilski* machine-or-transformation test.

MPEP § 2106.05(c) Particular Transformation.

This section of the MPEP guides: “Another consideration when determining whether a claim recites significantly more is whether the claim effects a transformation or reduction of a particular article to a different state or thing.” “[T]ransformation and reduction of an article ‘to a different state or thing’ is the clue to patentability of a process claim that does not include particular machines.” *Bilski*, 561 U.S. at 658 (quoting *Benson*, 409 U.S. at 70).

Claim 21 determines certain electronic data (that is, that acceptance criteria values are noncompliant with acceptance criteria). This determination of data is not a transformation or reduction of an article into a different state or thing constituting patent-eligible subject matter. “The mere manipulation or reorganization of data . . . does not satisfy the transformation prong.” *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011). Applying this guidance here, we conclude Claim 21 fails to satisfy the transformation prong of the *Bilski* machine-or-transformation test.

MPEP § 2106.05(e) Other Meaningful Limitations.

This section of the MPEP guides:

Diamond v. Diehr provides an example of a claim that recited meaningful limitations beyond generally linking the use of the judicial exception to a particular technological environment. 450 U.S. 175 (1981). In *Diehr*, the claim was directed to the use of the Arrhenius equation (an abstract idea or law of nature) in an automated process for operating a rubber-molding press. 450 U.S. at 177-78. The Court evaluated additional elements such as the steps of installing rubber in a press, closing the mold, constantly measuring the temperature in the mold, and

automatically opening the press at the proper time, and found them to be meaningful because they sufficiently limited the use of the mathematical equation to the practical application of molding rubber products. 450 U.S. at 184. In contrast, the claims in *Alice Corp. v. CLS Bank International* did not meaningfully limit the abstract idea of mitigating settlement risk. 573 U.S. ___, 134 S. Ct. 2347, 110 USPQ2d 1976 (2014). In particular, the Court concluded that the additional elements such as the data processing system and communications controllers recited in the system claims did not meaningfully limit the abstract idea because they merely linked the use of the abstract idea to a particular technological environment (i.e., “implementation via computers”) or were well-understood, routine, conventional activity.

MPEP § 2106.05(e).

“[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. Similarly as for *Alice*, we find that “[t]aking the claim elements separately, the function performed by the computer at each step of the process is ‘[p]urely conventional.’” *Id.* “In short, each step does no more than require a generic computer to perform generic computer functions.” *Id.*

We agree with the Examiner’s conclusion that claim 21 does not add meaningful limitations beyond generally linking the use of the judicial exception to a particular technological environment. *See* Final Act. 5, 7; Ans. 7–8. As the Examiner finds, “the claim does not set forth ‘limited rules’ used ‘in a process specifically designed to achieve an improved technological result in conventional industry practice.’” Ans. 7–8. “Rather, the claim is solely directed to collecting information, analyzing, and displaying the result of the analysis.” Ans. 8.

MPEP § 2106.05(f) Mere Instructions To Apply An Exception.

Contrary to Appellants' assertion that Claim 21 is necessarily rooted in computer technology, the claim does nothing more than invoke generic computer components merely as a tool in which the computer instructions apply the judicial exception.

MPEP § 2106.05(g) Insignificant Extra-Solution Activity.

Claim 21's "sending" and "receiving" steps are merely data gathering steps that amount to insignificant extra-solution activity that is insufficient to confer patent eligibility. Rev. Guid. 55 & n.31. Claim 21's "providing" step also recites insignificant extra-solution activity. As the Examiner finds (Ans. 4–5, 7–8), providing a reason as to non-compliance of the email is nothing more than the display or presentation of results, which is an example of insignificant extra-solution activity. *See* Rev. Guid. 55 & n.31.

MPEP § 2106.05(h) Field of Use and Technological Environment.

[T]he Supreme Court has stated that, even if a claim does not wholly pre-empt an abstract idea, it still will not be limited meaningfully if it contains only insignificant or token pre- or post-solution activity—such as identifying a relevant audience, a category of use, field of use, or technological environment.

Ultramercial, Inc. v. Hulu, LLC, 722 F.3d 1335, 1346 (Fed. Cir. 2013).

Claim 21's additional recitations of an electronic mail server, a sender client system, and electronic mail fail to recite a practical application because these additional elements do no more than generally link the use of a judicial exception to a particular technological environment or field of use, that is, a computer network.

In sum, Claim 21 fails to recite a practical application where the additional elements do more than generally link the use of a judicial

exception to a particular technological environment or field of use.
Rev. Guid. 55. Claim 21’s mere application of an abstract idea in a particular field is insufficient to integrate the judicial exception into a practical application. *See* Rev. Guid. n.32. In view of the foregoing, we conclude the claim is directed to a judicial exception, namely an abstract idea.

C. Well-understood, routine, conventional; specified at a high level of generality.

Because Claim 21 recites a judicial exception and does not integrate that exception into a practical application, we must then reach the issue of whether the claim adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field.

Rev. Guid. 56.

The Examiner finds

[t]he additional element(s) or combination of elements in the claim(s) other than the abstract idea per se amount(s) to no more than: (i) mere instructions to implement the idea on a computer, and/or (ii) recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the pertinent industry.

Final Act. 5; *see also* Final Act. 7.

We agree with the Examiner, as Appellants describe their invention in a manner consistent with its being “well-understood, routine, [and] conventional,” such that their invention requires no more than a general-purpose computer executing computer program instructions. Spec. ¶ 17; *see also* Spec. ¶¶ 13–19 (describing possible embodiments of the

invention at a high level in terms of well-known, commonplace, and generic computing elements). Consistent with Appellants' Specification, Claim 21's various computer and network elements fail to go beyond that which is well-understood, routine, and conventional. It is indicative of the absence of an inventive concept where the claims simply append well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. Rev. Guid. 56. And as discussed above, we agree with the Examiner that the steps of Claim 21 are recited at a high level of generality such that they do not set forth "limited rules" sufficient to confer patent eligibility.

Therefore, we conclude that Claim 21, viewed "both individually and as an ordered combination," does not recite significantly more than the judicial exception to transform the claim into patent-eligible subject matter. *See Alice*, 573 U.S. at 217 (internal quotations omitted) (quoting *Mayo*, 566 U.S. at 79).

Dependent Claim 22 recites "receiving, from the sender client system, a modified acceptance criteria value; and sending the electronic mail to the recipient responsive to a determination that the acceptance criteria values comply with the acceptance criteria." As discussed above, we disagree with Appellants that the Examiner failed to set forth a prima facie case of patent ineligibility for Claim 22. Moreover, Claim 22 recites a limitation that merely adds further manipulation of data and, at most, reflects the well-known and conventional concept of correcting one's error or mistake. Although it may narrow the scope of the claim, limiting an abstract idea to a particular field of use or adding token post-solution components does not

convert an otherwise ineligible concept into an inventive one. *See* Rev. Guid. 55 & nn.31–32.

Accordingly, we conclude that dependent Claim 22, viewing its limitations “both individually and as an ordered combination,” does not recite significantly more than the judicial exception to transform the claim into patent-eligible subject matter. *See Alice*, 573 U.S. at 217 (internal quotations omitted) (quoting *Mayo*, 566 U.S. at 79).

In view of the foregoing, we sustain the rejection of Claims 21–40 under 35 U.S.C. § 101.

DECISION

We affirm the rejection of Claims 21–40 under the doctrine of non-statutory, obviousness-type double patenting.

We affirm the rejection of Claims 21–40 under 35 U.S.C. § 101.

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. § 41.50(f).

AFFIRMED