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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YEHOANATAN AUMANN

Appeal 2018-008838
Application 12/590,895
Technology Center 2100

Before HUNG H. BUI, GREGG. I. ANDERSON,
and MICHAEL M. BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–5, 7–17, 19–29, and 31–37, which are all of the pending claims. *See* Final Act. 1 *and* Appeal Br. 32–39 (Claims App’x). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use “Appellant” to refer to the “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Thomson Reuters Global Resources as the real party in interest. Appeal Br. 1.

Introduction

According to Appellant, the

invention relates to processes, software and systems for use in delivery of services related to the financial services sector as well as systems for use in other areas, such as other professional services and in technical research and education sectors. More particularly, the present invention relates to a system that identifies key terms, phrases, images, graphics, or sections for redaction from documents, such as reports, articles and other documents related to financial concerns, technical research, professional services, industries, and companies, to be presented in conjunction with an offer to purchase or otherwise obtain such documents such as via an online service.

Spec. ¶ 1.

Claim 1 is illustrative:

1. A computer-implemented method comprising:
 - (a) associating an original electronic document with an offering;
 - (b) identifying a set of content type information to redact from the original document, the set of content type information being identified for redaction based at least in part on a weighted combination of criteria other than location of the content type information within the original electronic document;
 - (c) generating a redacted version of the original document by redacting the set of content type information from the original electronic document;
 - (d) receiving a request for a set of information related to the original document and identifying a set of responsive information;
 - (e) in response to the request, transmitting the redacted version of the original document and a set of offers comprising offers respectively associated with at least one portion of the set of content type information redacted from the original

document, whereby less than all of the set of content type information redacted from the original document is un-redacted based on a selection of one or more offers from the set of offers; and,

(f) presenting the offering, the offering representing a proposed transaction for obtaining at least a part of the redacted set of content type information from the original electronic document.

Appeal Br. 32 (Claims App'x).

The Rejections at Issue

All pending claims stand rejected under 35 U.S.C. § 101 (as directed to an abstract idea, without reciting significantly more), § 112, first paragraph (as failing to comply with the enablement requirement), and § 103(a) (as being unpatentable in view of *Matichuk* (US 2007/0094594 A1; Apr. 26, 2007) and *Baird* (US 7,475,242 B2; Jan. 6, 2009)). Final Act. 2–12.

ANALYSIS

A. *The § 101 Rejection*

For the § 101 rejection, Appellant argues all claims together based on claim 1, making it representative for all pending claims for this rejection. Appeal Br. 8–16; 37 C.F.R. § 41.37(c)(1)(iv)

§ 101 General Legal Framework and the USPTO Guidance

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, 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. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (internal quotation marks and citation omitted).

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” in *Diamond v. Diehr*, 450 U.S. 175, 191 (1981).

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 (internal citation omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (alterations in original) (quoting *Mayo*,

566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

In early 2019, the PTO published revised guidance on the application of § 101. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50–57 (Jan. 7, 2019) (“Guidance”). Under the Guidance, we first look, in step one of the *Alice/Mayo* analysis, 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) (“prong one”); and
- (2) additional elements that integrate the judicial exception into a practical application (“prong two”) (*see* MPEP § 2106.05(a)–(c), (e)–(h)).²

See 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 to whether the claim adds “significantly more” under step two of the *Alice/Mayo* analysis, i.e., whether the claim:

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

See Guidance, 84 Fed. Reg. at 56.

The Examiner’s Determinations

The Examiner determines claim 1 is directed to the abstract idea of “associating and presenting an offer associated with redaction.” Non-Final Act. 2; *see also* Ans. 12. The Examiner explains that “[i]n addition to being

² All references to the MPEP are to the 9th Ed, Rev. 08.2017 (Jan. 2018).

a classic business method of associating and presentation of an offer, the claim[] simply describes a process for filtering data via redaction,” which is a concept “not meaningfully different than those concepts found by the courts to be abstract.” *Id.* (citing multiple cases, including *Electric Power Group*³). The Examiner additionally determines that, beyond the claim elements reciting the abstract idea, the additional claim elements, “when considered both individually and as a combination[,] do not amount to significantly more than the abstract idea because the limitations are merely instructions to implement the abstract idea on a computer and require no more than a generic computer to perform generic computer functions.” Non-Final Act. 3.

Appellant’s Contentions

Appellant contends the Examiner’s identified idea “is an overbroad and improper abstraction of the claimed limitations.” Appeal Br. 9.

Appellant contends “[c]laim 1 is not merely directed towards an abstract idea, but rather is an improvement to another technology or technical field and does comprise meaningful limitations beyond generally linking the user of an abstract idea to a particular technological environment, and the claims were not properly considered as a whole.” Appeal Br. 9.

Appellant further contends the invention solves a unique problem “that did not exist prior to the advent of computers” and “is not analogous or in any way similar to the claims at issue in cases where the claimed subject matter was found to be directed towards an abstract idea.” Appeal Br. 10 (citing multiple cases, including *Electric Power Group*). Appellant contends claim 1 is, instead, analogous to the patent-eligible claims at issue in

³ *Electric Power Group v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016)

Amdocs,⁴ *Enfish*,⁵ *BASCOM*,⁶ *McRO*,⁷ *Finjan*,⁸ and *Core Wireless*.⁹ Appeal Br. 10–11; Reply Br. 4–5.

Appellant yet further contends, pursuant to step two of the *Alice/Mayo* framework, that claim 1 recites significantly more than any abstract idea, because it recites “specific improvements to a computer.” Appeal Br. 12 (citing *Amdocs* and *BASCOM*); *see also id.* at 12–16 (also contending *McRO*, *DDR Holdings*,¹⁰ *Enfish*, *Diamond v. Diehr*, and *Alice* compel a determination that claim 1 recites “significantly more” under step two of *Alice/Mayo*). Appellant also contends the Examiner fails to provide evidence that the additional limitations beyond the recited abstract idea were well-understood, routine, and conventional, as required by *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018). Reply Br. 3–4. Appellant furthermore contends claim 1 “does not pre-empt the entire field of data processing or redaction” and “involves steps that are clearly separate from any abstract idea.” Appeal Br. 16 (also contending “the claimed process does not fall under any of the three exceptions to patentability, i.e., ‘laws of nature, physical phenomena, and abstract ideas’” (citing *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980))).

⁴ *Amdocs (Israel) Limited v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016).

⁵ *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016).

⁶ *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016).

⁷ *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016).

⁸ *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, 880 F.3d 1356 (Fed. Cir. 2018).

⁹ *Finjan, Inc. v. Blue Coat Systems, Inc.*, 879 F.3d 1299 (Fed. Cir. 2018).

¹⁰ *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014).

Our Analysis

Alice/Mayo Step One, Guidance Step 2A, Prong One

We begin our analysis under prong one of step 2A by determining whether, under the broadest reasonable interpretation, the claims recite a patent-ineligible concept, i.e., here, an abstract idea. In doing so, we keep in mind it is necessary to analyze the limitations in a way that is specifically “[tethered [to] the language of the claim[].” *Enfish*, 822 F.3d at 1337.

The first step of Appellant’s claim 1 recites “associating an original []¹¹ document with an offering.” A person can mentally perform such an association between a document and an offering, for example by simply deciding a particular document is to be offered for sale. The second step of “identifying” also encompasses a mental process (“identifying a set of content type information to redact from the original document”) as well as a mathematical concept (“the set of content type information being identified for redaction based at least in part on a weighted combination of criteria other than location of the content type information within the original [] document”). As recited, this step encompasses activities a person can perform using pen and paper. For example, in deciding to redact a subset of information related to customers (a type of content), a person can place more weight on redacting financial information than on redacting information that identifies customer names.

The third step, “generating a redacted version of the original document by redacting the set of content type information from the original [] document,” also recites functionality that requires no technology. For

¹¹ In performing our analysis of claim 1 under step 2A prong 1, we redact “electronic” from “electronic document.”

example, a person can redact the identified information from an original document using a black marker. The fourth step, “receiving a request for a set of information related to the original document and identifying a set of responsive information,” also describes a routine human activity that does not involve technology—it is routine for a person to receive and respond to such requests from other people. The final two steps, which recite transmitting the redacted version of the document along with “a set of offers” for un-redacting redacted information, similarly describe activity a person can implement without using technology.

In view of the foregoing, Appellant does not persuade us of error in the Examiner’s determination that the foregoing limitations, collectively, describe (recite) an idea for “associating and presenting an offer associated with redaction” (Non-Final Act. 2). We also disagree with Appellant’s contention that it “is an overbroad and improper abstraction of the claimed limitations” (Appeal Br. 9) and “and the claims were not properly considered as a whole” (*id.*)—this idea reflects the limitations recited in each of claim 1’s six steps. In accordance with the Guidance, because the limitations of claim 1 recite an idea that encompasses a combination of mental processes, certain methods of organizing human activity, and a mathematical concept, claim 1 recites an abstract idea. *See* Guidance, 84 Fed. Reg. at 52; *RecogniCorp, LLC v. Nintendo Co. LTD.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“Adding one abstract idea . . . to another abstract idea . . . does not render the claim non-abstract.”). Thus, Appellant’s argument that “the claimed process does not fall under any of the three exceptions to patentability, i.e., ‘laws of nature, physical phenomena, and abstract ideas’” (Appeal Br. 16) is unpersuasive.

Because claim 1 recites an abstract idea, we next proceed to prong two of step 2A of the Guidance, to determine whether claim 1 integrates the recited idea into a practical application). *See* Guidance, 84 Fed. Reg. at 54.

Alice/Mayo Step One, Guidance Step 2A, Prong Two

To determine whether this judicial exception is integrated into a practical application, we identify whether there are “*any additional elements recited in the claim beyond the judicial exception(s)*” and evaluate those elements to determine whether they integrate the judicial exception into a practical application. Guidance, 84 Fed. Reg. at 54–55 (emphasis added); *see also* MPEP § 2106.05(a)–(c), (e)–(h).

Here, the additional limitations in claim 1 beyond those that describe the abstract idea are the recitations for an “electronic” original document and that the method be “computer-implemented.” These high-level limitations simply require “computerizing” implementation of the recited abstract idea. Claim 1 does not recite any technological improvement to a computer or to an electronic document, it merely requires using generic technology for its conventional purposes to carry out the recited abstract idea. Thus, claim 1 does not improve the functioning of a computer or any other technology or technical field, and neither does it apply the judicial exception with any particular machine. *See* MPEP § 2106.05(a)–(b). Claim 1 also does not effect a particular transformation of any recited articles, which are used for their ordinary purposes, nor does it add any other meaningful (technological) limitations beyond “linking the use” of the method to generically recited technology; thus, the technological limitations amount to no more than instructions to implement the abstract idea using general computer-related technology. *See* MPEP § 2106.05(c), (e)–(f); *see also id.* at (g)–(h) (use of

well-known limitations beyond the judicially excepted matter constitutes “insignificant extra-solution activity” (g) and claim limitations “merely indicating a field of use or technological environment in which to apply a judicial exception do not amount to significantly more” (h)). Thus, we conclude claim 1 does *not* integrate the recited judicial exception into a practical application and, accordingly, claim 1 is “directed to” its recited judicial exception of a certain method of organizing human activity. Guidance, 84 Fed. Reg. at 53.

In view of the foregoing, Appellant’s contention that claim 1 solves a unique problem “that did not exist prior to the advent of computers” (Appeal Br. 10) is unpersuasive. The contention that claim 1 “is not analogous or in any way similar to the claims at issue in cases where the claimed subject matter was found to be directed towards an abstract idea” because analogous to the patent-eligible claims at issue in *Amdocs*, *Enfish*, *BASCOM*, and *McRO* (*id.* at 10–11) is also unpersuasive, for reasons we next discuss.

Unlike Appellant’s claim 1, the claim at issue in *Amdocs* had a technology focus—it “entail[ed] an unconventional technological solution (enhancing data in a distributed fashion) to a technological problem (massive record flows which previously required massive databases).” 841 F.3d at 1300 (determining the claim term “to enhance” was a specific technological limitation, construed as meaning “to apply a number of field enhancements in a distributed fashion”). From a technological perspective, whereas Appellant’s claim 1 requires only that the method be “computer-implemented” and a document be “electronic,” the *Amdocs* claims were “tied to a specific structure of various components (network devices, gatherers, ISMs, a central event manager, a central database, a user interface

server, and terminals or clients)” such that the components were “purposefully arrange[d] . . . in a distributed architecture to achieve a technological solution to a technological problem specific to computer networks.” *Id.*

Enfish is also inapposite to Appellant’s claim 1. The claims at issue in *Enfish* were “specifically directed to a self-referential table for a computer database,” which was “a specific improvement to the way computers operate,” rather than an abstract idea implemented on a computer. *Enfish*, 822 F.3d at 1336–37. By contrast, Appellant’s claim 1 is not directed to an improvement in the way computers or networks operate, but instead recites only generic computing technology that is used for its ordinary purposes.

The patent at issue in *BASCOM* described a particular arrangement of Internet server filtering software that enables individually customizable filtering at a remote ISP server by taking advantage of the technical ability of the ISP server to identify individual accounts and associate a request for Internet content with a specific individual account. *See BASCOM*, 827 F.3d at 1343–45. The Federal Circuit recognized that *BASCOM*’s installation of an Internet content filter at a particular network location is “a technical improvement over prior art ways of filtering such content” that provided the advantage of allowing the Internet content filter to have “both the benefits of a filter on a local computer and the benefits of a filter on the ISP server” and “give[s] users the ability to customize filtering for their individual network accounts.” *BASCOM*, 827 F.3d at 1350, 1352. There is no evidence in the record to support the contention that Appellant’s claimed system provides a similar technical solution through an unconventional arrangement of technological components in a manner similar to *BASCOM*.

The claim at issue in *McRO*, which “focused on a specific asserted improvement in computer animation, i.e., the automatic use of rules of a particular type,” also is not analogous to Appellant’s claim 1. *McRO*, 837 F.3d at 1314; *see also id.* at 1313 (explaining the claimed rules were “limiting in that they define morph weight sets as a function of the timing of phoneme sub-sequences”). The *McRO* claim “require[d] that the rules be rendered in a specific way: as a relationship between sub-sequences of phonemes, timing, and the weight to which each phoneme is expressed visually at a particular timing (as represented by the morph weight set),” such that it was directed to a technological improvement. *See id.* at 1315–16 (quoting *id.* at 15). Appellant’s claim 1 includes no such technological focus or limitations.

The claim at issue in *Finjan* was “directed to a method of providing computer security by scanning a downloadable and attaching the results of that scan to the downloadable itself in the form of a ‘security profile.’” *Finjan*, 879 F.3d at 1303. All recited steps of the claim at issue in *Finjan* included limitations that processed “a Downloadable” in order to provide a technological improvement in the use of security technology on the web for handling suspicious code in the Downloadable. *Id.* Appellant’s claim 1, by comparison, simply recites generic technology components for implementing the recited abstract idea.

Claim 1 also is inapposite to the claims at issue in *Core Wireless*, in which the recited claim limitations focused on specific user interface functionality, and the court concluded the claims were “directed to an improved user interface.” *Core Wireless*, 880 F.3d at 1362. Whereas the *Core Wireless* “claims recite[d] a specific improvement over prior systems,”

Appellant’s claim 1 recites no specific user interface limitations, much less specific any specific interface limitations that purport to improve a conventional interface. *Id.* at 1363. Although the Specification describes embodiments that “provide[] a Graphical User Interface (GUI)” (*see* Spec. ¶¶ 6, 41–45), claim 1 includes no limitations that describe (recite) a user interface improvement. Regardless that claim 1 may implicitly require a user interface, e.g., as part of the “presenting” step (or explicitly, as in the generic requirements for employing “a graphical user interface” as in dependent claims 11, 23, and 36), the inclusion of generic interface requirements does not amount to an improvement in user interfaces, as in *Core Wireless*.

Accordingly, because the recited judicial exception is not integrated into a practical application, the Examiner did not err in determining claim 1 is directed to an abstract idea. Thus, we proceed to step two of the *Alice/ Mayo* analysis (step 2B of the Guidance).

Alice/Mayo Step Two; Guidance Step 2B

In step two of the *Alice/Mayo* analysis, we consider whether there are additional limitations that, individually or as an ordered combination, ensure the claims amount to “significantly more” than the abstract idea. *Alice*, 573 U.S. at 217–18 (citing *Mayo*, 566 U.S. at 72–73, 77–79). As stated in the Guidance, many of the considerations to determine whether the claims amount to “significantly more” under step two of the *Alice* framework are already considered as part of determining whether the judicial exception has been integrated into a practical application. Guidance, 84 Fed. Reg. at 56. Thus, at this point of our analysis, we determine if claim 1 adds a specific limitation, or combination of limitations, that is not well-understood, routine, conventional activity in the field; or whether, in addition to the recited

judicial exception, they recite only well-understood, routine, conventional activities at a high level of generality. *Id.*

Here, beyond the limitations describing the abstract idea, claim 1 does not recite any limitations (or combination of limitations) that are not well-understood, routine, and conventional. The Examiner finds, and we agree, that the additional limitations constitute use of technology that was well known to those of ordinary skill prior to the invention. Non-Final Act. 3.; *see also* Ans. 4–6. The disclosure in Appellant’s Specification of the claimed technological features is at a generic level. *See, e.g.*, Spec. ¶¶ 1, 6–14, 23–24, 41–42. There is no discussion of any special functionality or considerations for a technological aspect of any technological component recited in the independent claims. Thus, Appellant’s contention that claim 1 recites “specific improvements to a computer” (Appeal Br. 12) is unpersuasive.

Appellant’s contention that *Amdocs*, *Enfish*, *BASCOM*, and *McRO* compel a determination that claim 1 recites significantly more than the recited judicial exception under step two of the *Alice/Mayo* framework is unpersuasive for the same reasons discussed above for the analysis under prong two of step 2A of the guidance. *DDR Holdings*, *Diamond v. Diehr*, and *Alice* are similarly inapposite to Appellant’s claim 1.

The patent-eligible claim at issue in *DDR Holdings* recited limitations for providing a composite web page based on a link activation occurring at a remote computer, thereby addressing “a challenge particular to the Internet.” *DDR Holdings*, 773 F.3d at 1257–58 (“We caution, however, that not all claims purporting to address Internet-centric challenges are eligible for patent.”). *Diamond v. Diehr* is not germane to the *Alice/Mayo* step two

analysis—as discussed above, the claims at issue in that case were *not* directed to an abstract idea, rather they were directed to a non-abstract directed to a patent-eligible process for molding rubber products. *Alice* also does not support Appellant’s argument—just as the *Alice* “claims at issue amount[ed] to ‘nothing significantly more’ than an instruction to apply the abstract idea . . . using some unspecified, generic computer” (*Alice*, 573 U.S. at 225–26), claim 1’s recitation of “[a] computer-implemented method” and “[a]n original electronic document” constitutes simply instructions to apply the abstract idea using generic computer technology.

Appellant’s reliance on *Berkheimer* is also misplaced. The exemplary claim limitation at issue in *Berkheimer* was “storing a reconciled object structure in the archive without substantial redundancy,” which the court found was “directed to [an] arguably unconventional inventive concept described in the specification.” 881 F.3d at 1370. There was *no* evidence in the record that this limitation described well-understood, routine, and conventional technology. *Id.* at 1368. The court held there was a “genuine issue of material fact” and that “fact questions created by the specification’s disclosure” precluded summary judgment of invalidity under step two of the *Alice/Mayo* framework. *Id.* Here, however, as discussed above, the only limitations *not* reciting a part of the abstract idea are “computer-implemented” and “electronic.” The Examiner made a finding in the record that Appellant’s Specification demonstrates that this type of automation for redacting is well-understood, routine and conventional. Ans. 13 (citing Spec. ¶ 33). Thus, *Berkheimer* is inapposite, because the record before supports the finding that, beyond the abstract idea, claim 1 recites only well-understood, routine, and conventional technology.

Preemption

Appellant’s contention that claim 1 is patent eligible because it “does not pre-empt the entire field of data processing or redaction” (Appeal Br. 16) is also unpersuasive. “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *FairWarning IP*, 839 F.3d at 1098 (quoting *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015)); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”). Further, “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the [*Alice*/*Mayo*] framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa*, 788 F.3d at 1379.

Conclusion of Our § 101 Analysis

Accordingly, we sustain the § 101 rejection of claims 1–5, 7–17, 19–29, and 31–37. In doing so, as consistent with our discussion above, we adopt the Examiner’s findings and reasons as set forth in the Non-Final Office Action and as set forth in the Answer.

The § 112 Enablement Rejection

In rejecting claims 1–5, 7–17, 19–29, and 31–37 under the first paragraph of 35 U.S.C. § 112 as failing to comply with the enablement requirement, the Examiner points to paragraphs 31–32 of the Specification which, after paragraphs 24–30 explain a variety of redaction criteria, state:

Other criteria for redaction include the following. The system may be configured to redact text with a specific structure or pattern. For example, a sentence mentioning two com-

panies or two consecutive sentences in which the second sentence somewhat negates the first sentence or the first sentence in each paragraph. Also, a counting routine may be used in which, for example, **every other or every third word, or the first word of every sentence is redacted**. In another variation, the system may use an example-based method in which the redaction routine considers examples of patterns or other schemes and generalizes automatically to make redaction determinations.

In addition, it is understood that the redaction system may use any and all combinations of the above, including weighted combinations. The applications of some or all of the above criteria and any weighting associated with such criteria may be predetermined or may be based on an initial interrogation of the document by the system, e.g., the system makes an initial pass at the document to determine the existence of certain patterns, terms, structures, verb-phases, nouns, adjectives, tables, graphs, formulas or equations, and numbers.

Non-Final Act. 3–4 (emphasis by the Examiner).

The Examiner finds that in view of these two paragraphs, because the described “criteria include[] an **infinite any and all combination of criteria** [sic],” the claim requirement of “criteria other than location of the content type information,” as recited “is **therefore contradictory** as **any and all combinations are used** according to the [S]pecification.” *Id.* at 4.

Appellant contends the Examiner errs, because the “Examiner seeks to include the phrases ‘all combinations of the above’ and ‘all of the above criteria’ while completely ignoring the terms immediately preceding these phrases – ‘may use any and’ and ‘applications of some or’ respectively.” Appeal Br. 18 (citing Spec. ¶ 32) (additionally contending the “Examiner’s rejection fails to consider other portions of Appellant’s [S]pecification which provide criteria other than location criteria used to identify the set of content type information”). Appellant’s argument is persuasive. In view of the

Specification discussion of the various alternative redaction criteria, artisans of ordinary skill would have understood how to implement (make and use), without undue experimentation, a method that identifies types of content to redact using “criteria other than location of the content type information,” as recited. *See* Spec. ¶¶ 24–34.

The Examiner additionally finds “weighted is not described in the [S]pecification to enable one of ordinary skill to make or use the invention,” and that “instead paragraph 32 only recites that [weighting] can be used but [the Specification is] lacking any description or detail regarding how [a] weighted combination is determined.” Non-Final Act. 4 (further explaining that “[f]or this reason both the location and weighted language will be ignored in the claims”). Appellant contends the Examiner errs, because “a person having ordinary skill in the relevant art, namely machine intelligence and computer science, could determine the appropriate weight to apply to the claimed combination of criteria to arrive at a desired result.” Appeal Br. 19. We agree. The use of weighted criteria is well-known, basic principle. “A patent need not teach, and preferably omits, what is well known in the art.” *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1534 (Fed. Cir. 1987); *see also In re Buchner*, 929 F. 2d 660, 661 (Fed. Cir. 1991).

Accordingly, we do not sustain the § 112, first paragraph rejection of claims 1–5, 7–17, 19–29, and 31–37.

The § 103 Rejection

In rejecting the independent claims under § 103, the Examiner gives no patentable weight to the “a weighted combination of criteria other than location of the content type information within the original electronic document,” as recited. *See* Final Act. 5. Appellants contend the Examiner

errs because the “Examiner has disregarded key claim limitations.” Appeal Br. 20. We agree. Because there is no finding in the record that the cited prior art teaches these claim limitations that are recited in each of the independent claims, we do not sustain the § 103 rejection of claims 1–5, 7–17, 19–29, and 31–37.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1–5, 7–17, 19–29, 31–37	101	Nonstatutory Subject Matter	1–5, 7–17, 19–29, 31–37	
1–5, 7–17, 19–29, 31–37	112, first paragraph	Enablement		1–5, 7–17, 19–29, 31–37
1–5, 7–17, 19–29, 31–37	103	Matichuk, Baird		1–5, 7–17, 19–29, 31–37
Overall Outcome			1–5, 7–17, 19–29, 31–37	

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