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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JOJY DEVASIA and SARIKA KRISHNAN

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Appeal 2018-009139  
Application 13/737,605<sup>1</sup>  
Technology Center 3600

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Before JOHN A. EVANS, JASON J. CHUNG, and  
SCOTT E. BAIN, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 1–5, 8–13, and 16–18.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

INVENTION

The invention relates to a shopping-cart feedback tool. Spec. ¶ 1. Claim 1 is illustrative of the invention and is reproduced below with emphases discussed *infra* in § C.1.:

1. A system comprising:

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<sup>1</sup> According to Appellant, eBay Inc. is the real party in interest. App. Br. 2.

<sup>2</sup> According to the claims filed August 31, 2017, claims 6, 7, 14, 15, 19, and 20 have been cancelled.

one or more processors; and  
a memory storing instructions that, when executed by the one or more processors, cause the one or more processors to perform operations comprising:

*receiving, from a first user, item information associated with an item to add to an electronic shopping-cart of the first user;*

*adding the item to the electronic shopping-cart of the first user;*

*receiving a request to share the electronic shopping-cart of the first user with a second user;*

*sending shopping-cart information associated with the electronic shopping-cart of the first user to the second user in an electronic message that includes a link to cause display of a feedback user interface on a device of the second user;*

*receiving feedback from the second user via the feedback user interface displayed on the device of the second user, the feedback corresponding to the item in the electronic shopping-cart of the first user, the feedback including a recommendation for a further item;*

*sending the feedback and a button that, upon selection, swaps the item in the electronic shopping-cart of the first user with the further item recommended by the second user in response to receipt of the feedback that corresponds to the item in the electronic shopping-cart of the first user;*

*receiving a selection of the button from the first user;*

*in response to the selection of the button from the first user, swapping the item in the electronic shopping-cart of the first user with the further item recommended by the second user;*

*sending an electronic notification to the second user, upon the swapping of the item in the electronic shopping-cart of the first user with the further item recommended by the second user;*  
*and*

*causing display of the electronic shopping-cart of the first user on an electronic website.*

App. Br. 18 (Claims Appendix) (emphases added).

REJECTION AT ISSUE

Claims 1–5, 8–13, and 16–18 stand rejected under 35 U.S.C. § 101 as being directed to patent ineligible subject matter. Final Act. 2–6.

ANALYSIS

A. *Legal Principles*

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, i.e., the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes,

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such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. (15 How.) 252, 267–68 (1854))); 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 187; *see also id.* at 192 (“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).

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

The PTO recently published revised guidance on the application of § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance* (“Memorandum”). Under that guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

- (3) adds a specific limitation beyond the judicial exception that are not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or
- (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

*See* Memorandum.

#### *B. The Examiner’s Conclusions and Appellants’ Arguments*

The Examiner concludes the present claims recite certain methods of organizing human activity. Final Act. 3, 7. The Examiner also determines the present claims do not amount to significantly more than an abstract idea itself because the Examiner determines the abstract idea is implemented on generic components that are well-understood, routine, and conventional

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previously known to the industry. Ans. 3 (citing M.P.E.P. § 2106.05(d)(II) and case law from this section holding “receiving or transmitting data over a network” is well-understood, routine, and conventional); Final Act. 4, 6.

Appellants argue the Examiner fails to provide adequate evidence to support their finding that the abstract idea is implemented on generic components that are well-understood, routine, and conventional previously known to the industry. App. Br. 11–15; Reply Br. 2–6. Appellants argue the lack of prior art rejection is evidence that the present claims do not recite an abstract idea implemented on generic components that are well-understood, routine, and conventional. App. Br. 15–16 (citing *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)). Appellants argue, similar to *BASCOM*, the present claims recite a combination of non-conventional and non-generic arrangement of known, conventional elements, which results in an inventive concept. App. Br. 12–16; Reply Br. 4–6. We disagree with Appellants.

### *C. Discussion*

#### *1. Step 2A, Prong 1*

The emphasized portions of claim 1<sup>3</sup>, reproduced above (*see supra* at 2), recite commercial interactions (including sales activities). According to the Memorandum, commercial interactions (including sales activities) fall into the category of certain methods of organizing human activity. *See* Memorandum. Moreover, those certain methods of organizing human

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<sup>3</sup> Claim 1, reproduced above with emphases, recites similar features as independent claims 9 and 16. Appellants do not argue claims 2–5, 8–13, and 16–18 separately, but assert the § 101 rejection of those claims should be withdrawn for at least the same reasons as argued for independent claim 1. App. Br. 8–15. We, therefore, group claims 1–5, 8–13, and 16–18 together and refer to those claims as the “present claims.”

activity are a type of an abstract idea. *See id.*

Appellants do not proffer arguments pertaining to Step 2A, prong 1. Because the present claims recite commercial interactions, which fall into the category of certain methods of organizing human activity (i.e., an abstract idea), we proceed to prong 2.

### 2. *Step 2A, Prong 2*

The present claims do not integrate the abstract idea into a practical application because they do not impose any meaningful limits on practicing the abstract idea.

Additionally, “a claim for a *new* abstract idea is still an abstract idea.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (emphasis added). “[U]nder the *Mayo/Alice* framework, a claim directed to a newly discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the novelty of that discovery for the inventive concept necessary for patent eligibility . . . .” *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016) (citations omitted).

Appellants do not make any arguments pertaining to step 2A, prong 2. Because the present claims recite an abstract idea that is not integrated into a practical application, we proceed to Step 2B.

### 3. *Step 2B*

We agree with the Examiner’s determination that the abstract idea is implemented on generic components that are well-understood, routine, and conventional. Ans. 3 (citing M.P.E.P. § 2106.05(d)(II)); Final Act. 4, 6. The Specification supports the Examiner’s determination in this regard because it explains that “one or more processors” and “device” are generic components. Spec. ¶¶ 50–52, 61. Appellants’ Specification indicates these elements were well-understood, routine, and conventional components

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because it describes them at a high level of generality and in a manner that indicates that they are sufficiently well-known. *Id.*

We disagree with Appellants' argument that the Examiner fails to provide adequate evidence to support their finding that the abstract idea is implemented on generic components that are well-understood, routine, and conventional previously known to the industry. App. Br. 11–15; Reply Br. 2–6. Appellants had adequate notice of the Examiner's finding for the following reasons. Although the Examiner does not cite to a specific case name, the Examiner cites to M.P.E.P. § 2106.05(d)(II) and quotes the various cases listed in that M.P.E.P. section, which held “receiving or transmitting data over a network” is well-understood, routine, and conventional. Appellants reiterate the Examiner's finding by stating “Courts may have found ‘receiving and transmitting data over a network’ to be routine and conventional” (Reply Br. 2).

With regard to Appellants' argument that the lack of prior art rejection is evidence that the present claims do not recite an abstract idea implemented on generic components that are well-understood, routine, and conventional, (App. Br. 15–16), Appellants improperly conflate the requirements for eligible subject matter (§ 101) with the independent requirements of novelty (§ 102) and non-obviousness (§ 103). “The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diehr*, 450 U.S. at 188–89; *see also Genetic Techs.*, 818 F.3d at 1376 (stating that, “under the *Mayo/Alice* framework, a claim directed to a newly discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the

novelty of that discovery for the inventive concept necessary for patent eligibility”).

We disagree with Appellants’ argument that, similar to *BASCOM*, the present claims recite a combination of non-conventional and non-generic arrangement of known, conventional elements, which results in an inventive concept. App. Br. 12–16; Reply Br. 4–6. Instead, the present claims are directed to an abstract idea using generic components as discussed *supra*, in §§ C.1. and C.2. or at best, improving an abstract idea—not an inventive concept.

Appellants do not argue claims 2–5, 8–13, and 16–18 separately, but assert the § 101 rejection of those claims should be withdrawn for at least the same reasons as argued for independent claim 1. App. Br. 8–15. Based on our review of the dependent claims, these claims do not recite any additional features that would transform the abstract idea embodied in claims 1, 9, and 16 into an inventive concept. Accordingly, we sustain the Examiner’s rejection of: (1) independent claims 1, 9, and 16; and (2) dependent claims 2–5, 8, 10–13, 17, and 18 under 35 U.S.C. § 101.

We have only considered those arguments that Appellants actually raised in the Briefs. Arguments Appellants 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).

#### DECISION

We affirm the Examiner’s decision rejecting claims 1–5, 8–13, and 16–18 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)(1)(iv).

AFFIRMED