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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 SUMEET GUPTA and MILI SHARMA

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Appeal 2019-000666
Application 14/152,443
Technology Center 2400

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Before BRADLEY W. BAUMEISTER, BARBARA A. BENOIT,
and MICHAEL M. BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant[1] appeals under 35 U.S.C. § 134(a) from a Final Office
Action rejecting all of the pending claims, viz., claims 1, 2, 4–9, 11–15, and
17–23.[2] *See* Final Act. 1[3] *and* App. Br. 27–33 (Claims App'x). We have
jurisdiction under 35 U.S.C. § 6(b). We affirm.

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[1] We use "Appellant" to refer to the "applicant" as defined in 37 C.F.R.
§ 1.42. Appellant identifies Adobe Systems Incorporated as the real party in
interest. App. Br. 1.
[2] We refer herein to the Specification ("Spec.") and Drawing Figures
("Figs.") filed January 10, 2014, the Final Office Action ("Final Act.")
mailed December 26, 2017, the Appeal Brief ("App. Br.") filed June 20,
2018, the Answer ("Ans.") mailed September 7, 2018, and the Reply Brief
("Reply Br.") filed November 1, 2018.

Introduction

Appellant describes that "[e]mbodiments of the present invention generally relate to web conferencing and, more particularly, to a method and apparatus for managing activities in a web conference." Spec. ¶ 1.

Claim 1 is representative:

1.   A computer implemented method comprising:

[1] determining, by at least one processor and prior to initiating a web conference comprising a plurality of participants, a pre-defined interactive conference activity corresponding to a user-provided segmentation rule for segmenting participants into groups in response to participant interactions with the pre-defined interactive conference activity during the web conference;

[2] upon initiating the web conference comprising the plurality of participants associated with a plurality of participant devices, providing the pre-defined interactive conference activity to each participant device of the plurality of participant devices via a computer network;

[3] detecting, via each participant device, an interaction with the pre-defined interactive conference activity;

[4] applying the user-provided segmentation rule to the interaction with the pre-defined interactive conference activity detected via each participant device to generate a plurality of groups within the web conference from plurality of participants; and

[5] providing a first conference activity to participant devices in a first group of the plurality of groups and a second conference activity to participant devices in a second group of the plurality of groups, wherein the first conference activity is different from the second conference activity.

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[3] We note the Examiner's lists of pending and rejected claims on the Office Action Summary are incorrect. We treat this error as harmless, and address the Claim Rejections as set forth on pages 4–15.

App. Br. 27 (Claims App'x) (bracketed reference numbers added).

Cited Prior Art

Name	Reference	Date
Haveliwala	US 2007/0300165 A1	Dec. 27, 2007
Clavel et al.	US 2014/0173467 A1	June 19, 2014
Colby et al.	US 2015/0236866 A1	Aug. 20, 2015

Rejections

The Examiner rejected claims 1, 2, 4–9, 11–15, and 17–23 under

35 U.S.C. § 101 as directed to an abstract idea, without reciting significantly

more. Final Act. 4–6.[4]

The Examiner rejected claims 1, 2, 5–9, 13–15, and 18–23 under

35 U.S.C. § 103 as unpatentable over Colby and Haveliwala. *Id.* at 6–13.

The Examiner rejected claims 4, 11, 12, and 17 under § 103 as

unpatentable over Colby, Haveliwala, and Clavel. *Id.* at 13–15.

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[4] The Final Office Action omits dependent claims 4, 11, 12, and 17 from the
list of claims rejected under § 101. This is a harmless ministerial error.
Those claims stood rejected in the previous (non-final) office action mailed
May 17, 2017, they were discussed as standing rejected in Final Office
Action's Response to Arguments, and the Examiner's Answer (p. 3)
correctly identifies them as standing rejected under § 101. We also note
Appellant wrongly identifies which claims stand rejected under § 101 in the
Appeal Brief (*see* p. 9 (identifying claims 1–6, 8–23, and 25–34)) and
otherwise treats all pending claims as standing rejected under § 101 in the
Appeal Brief and Reply Brief.

ANALYSIS

A.   The § 101 Rejection

1.   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. 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. 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, such as "molding rubber products" (*Diamond v. Diehr*, 450 U.S. 175, 191

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(1981)); "tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores" (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 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 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 also 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 (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.* (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.*

After the docketing of this Appeal, 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"); USPTO October 2019 Update: Subject Matter Eligibility (Oct. 17, 2019). Under the 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 interactions 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)).[5]

See Guidance, 84 Fed. Reg. at 52, 55–56.

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, does the office 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 Guidance, 84 Fed. Reg. at 56.

2.   *Analysis*

For the § 101 rejection, Appellant argues claims 1, 2, 5–9, 13–15, and 18–23 together as a group. App. Br. 10–20. We select claim 1 as representative. 37 C.F.R. § 41.37(c)(1)(iv). We are not persuaded the

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[5] All references to the MPEP are to Rev. 08.2017 (Jan. 2018).

Examiner erred in the § 101 rejection. As consistent with our discussion below, which primarily is for emphasis and clarification with respect to the Guidance, we adopt the Examiner's eligibility findings and conclusions as our own.

(i)   Guidance Step 2A, Prong One

For our prong-one analysis, we put aside the limitations: (1) of "computer implemented," (2) that the recited "conference" is a "web conference," (3) for performing the first step "by at least one processor," and (4) for interacting with participant "devices" (that are reached "via a computer network") (i.e., for the second and fifth "providing" steps, we consider the functionality of interacting with participants rather than with participant devices). We consider these limitations (individually and in combination) in our prong two and *Alice/Mayo* step two (Guidance step 2B) analyses below. Setting aside those limitations, claim 1 recites:

> [1] determining . . . prior to initiating a [] conference comprising a plurality of participants, a pre-defined interactive conference activity corresponding to a user-provided segmentation rule for segmenting participants into groups in response to participant interactions with the pre-defined interactive conference activity during the [] conference;
>
> [2] upon initiating the [] conference comprising the plurality of participant[s], providing the pre-defined interactive conference activity to each participant . . .;
>
> [3] detecting, via each participant [], an interaction with the pre-defined interactive conference activity;
>
> [4] applying the user-provided segmentation rule to the interaction with the pre-defined interactive conference activity detected via each participant [] to generate a plurality of groups within the [] conference from plurality of participants; and

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[5] providing a first conference activity to participant[s] [] in a first group of the plurality of groups and a second conference activity to participant[s] [] in a second group of the plurality of groups, wherein the first conference activity is different from the second conference activity.

Collectively, the foregoing limitations of claim 1 describe (recite) the idea of organizing and running an interactive conference, in which participants are divided into groups for separate activities during the conference.

The functions recited by these limitations reasonably can be characterized as encompassing mental processes and certain methods of organizing human activity. Using the example of a person setting up and running an interactive presentation to a group, the first step's requirement of pre-establishing "a pre-defined interactive conference activity corresponding to a user-provided segmentation rule" encompasses the presenter selecting or creating presentation exhibits that will involve interaction between the presenter and the participants (an "interactive conference activity"). The requirement for the presentation to "correspond[] to a user-provided segmentation rule for segmenting participants into groups in response to participant interactions with the pre-defined interactive conference activity" encompasses an interactive presentation that divides participants into groups, such as based on answers during a Q&A session. For example, this recited segmentation encompasses grouping participants together based on responses that distinguish two sub-groups of participants by job category. A person can first create a plan for conducting an interactive presentation using only pen and paper.

The second step describes the presenter following rules or instructions for giving the interactive presentation. This step reasonably can be

characterized as a certain method of organizing human activity that encompass managing interactions among people. In particular, the second step's recitation of providing the pre-defined interactive activity to participants encompasses teaching and following rules or instructions. The Guidance expressly recognizes these certain methods of organizing human as constituting abstract ideas. Guidance, 84 Fed. Reg. 52.

The third limitation's step of "detecting via each participant . . . , an interaction with the conference activity" reasonably can be characterized as the mental process of observing the participants' interactive participation. The Guidance expressly recognizes mental observations as constituting abstract ideas.

The limitations in the remaining steps similarly encompass mental processes and methods of organizing human activity. Applying a segmentation rule to generate sub-groups based on having perceived the interaction from each participant is a mental process (the fourth step) and interacting separately with two participant sub-groups, such as by asking managers to respond to one question and subordinates to respond to another, constitutes organizing human activity (the fifth step).

Thus, each of claim 1's steps for organizing and running an interactive conference, in which participants are divided into sub-groups for separate activities during the conference, recite abstract ideas that encompass mental processes and/or certain methods of organizing human activity. As the Guidance explains, such recitations of certain methods of organizing human activity and/or mental processes reasonably can be characterized as abstract ideas. *See* Guidance, 84 Fed. Reg. at 52, *id.* at nn. 13 (citing cases explaining examples of abstract ideas in the category of certain methods of

organizing human activity such as managing human behavior or interactions), 14–15 (citing cases explaining examples of abstract mental process limitations). For example, in giving the presentation as described above, the presenter engages in "observation and evaluation," which, as the Guidance explains, are in the category of abstract mental processes. Memorandum, 84 Fed. Reg. at 52. Such an interactive presentation also includes "managing personal behavior or relationships or interactions between people" which, as the Guidance explains, are in the category of certain methods of organizing human activity. *Id.* "Adding one abstract idea . . . to another abstract idea . . . does not render the claim non-abstract." *RecogniCorp, LLC v. Nintendo Co. LTD.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017); *see also FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (patent-ineligible claims were directed to a combination of abstract ideas).

Accordingly, claim 1 recites a judicial exception in the form of an abstract idea, and our analysis proceeds to prong two under the Guidance.

(ii)   Guidance Step 2A, Prong Two

To determine whether the 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 elements in claim 1 are that (1) the method is "computer-implemented" (with the first step being performed "by at least one processor") and (2) performing the conference as a "web" conference

using the "devices" of the participants (with the second step adding that the interactive activity is provided to the devices "via a computer network").

Claim 1 does not, however, recite any improvement to a computing device, processor, network, or web technology. Instead, as the Examiner finds, and we agree, claim 1 simply uses basic technology for carrying out the abstract idea in a computerized environment. *See* Final Act. 6; Ans. 5, 7–12. Relying on a "processor" to "perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible." *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015).

We disagree with Appellant that claim 1 is patent-eligible because it is analogous to the claims at issue in *Enfish*. Appeal Br. 11. 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." *Enfish*, 822 F.3d at 1336–37. Appellant's claim 1 is not directed to a specific improvement in how computers operate, rather it uses routine computer technology to carry out the recited abstract idea.

Appellant's contentions based on the claims at issue in cases such as *Amdocs*,[6] *McRO*,[7] *DDR Holdings*,[8] and various other cases are similarly unpersuasive. *See* App. Br. 17–19; Reply Br. 8–13. For example, 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

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[6] *Amdocs (Israel) Limited v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016).
[7] *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016).
[8] *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014).

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 recites "computer-implemented," "at least one processor," "a computer network," and that the conference is a "web" conference that interacts with participant "devices," 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.* Claim 1, on the other hand, uses generic technology components simply to automate a process that otherwise may be performed without technology.

Similarly, 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. 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. Thus, claim 1 is also unlike the patent-eligible claim at issue in *DDR Holdings*, which 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.").

Thus, we determine 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 involving mental processes and/or certain methods of organizing human activity. Guidance, 84 Fed. Reg. at 53. We, therefore, proceed to step 2B under the Guidance.

*(iii)   Guidance Step 2B (*Alice/Mayo *Step Two)*

In step 2B under the Guidance, 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

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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 additional 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. Final Act. 5; Ans. 8–10.

The technology recited in claim 1 is at a generic level. The Specification describes the underlying "web conference" technology as well known, and introduces the invention in the context of a need for using such technology to "manage activities" and improve the "experience" for the conference participants and host. Spec. ¶ 2; *see also id.* ¶¶ 54–58 (describing variations of underlying technology for implementing the invention in a non-limiting manner). Neither Appellant's Specification nor the record sufficiently discusses any special functionality or considerations for a technological aspect of any technological component recited in the independent claims. Thus, Appellant's contentions that claim 1 "improve[s]

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computing systems implementing online web conferences (Appeal Br. 11
(emphasis omitted)) and includes "a technical improvement to automation"
(Reply Br. 11) are unpersuasive.

We have considered and found unpersuasive Appellant's arguments,
such as Appellant's contention that claim 1, "**as a whole** presents a
technological improvement in the field of executing context-relevant actions
relative to a current state of a user." App. Br. 6. As per our discussion
above, we discern no "technological improvement" to any field (i.e., putting
aside whether "the field of executing context-relevant actions relative to a
current state of a user" fairly characterizes the claimed invention).

We disagree that claim 1 includes an "inventive concept" similar to
the claims of *BASCOM*.[9] *See* Appeal Br. 16–17. 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. The present record contains

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

insufficient evidence to support the contention that Appellant's claimed system provides a similar technical solution through an unconventional arrangement of technological components as was the case in *BASCOM*.

Appellant's reliance on *Berkheimer* is also misplaced. *See* App. Br. 16–17, 20–21; Reply Br. 7, 14–16. 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, as discussed above, the only limitations *not* reciting a part of the abstract idea are that the method is "computer implemented," that the conference" is "a web conference," that the first step is performed "by at least one processor," and that interaction with participants is with "devices" ("via a computer network"). The remaining limitations describe the recited abstract idea. There is no genuine dispute of material fact as to whether the technological aspects, which are recited at a generic level, are well-understood, routine and conventional. *See, e.g.*, Spec. ¶ 2. Thus, because the record before supports the finding that, beyond the abstract idea, claim 1 recites only well-understood, routine, and conventional technology, *Berkheimer* is inapposite.

(iv)   § 101 Conclusion

Accordingly, we sustain the § 101 rejection of claims 1, 2, 5–9, 13–15, and 18–23.

B. The § 103 Rejections

In rejecting claim 1, the Examiner finds Colby teaches all limitations except for the requirement that a "conference" is a "web conference." Final Act. 7–8 (citing Colby ¶¶ 197, 199, 202, 212–14, 368, Figs. 3, 8); *see also id.* at 8–9 (relying on Haveliwala for teaching a "web conference" (citing Haveliwala ¶¶ 2, 40, Fig. 4)). In particular, the Examiner finds Colby's disclosure of an Independent Study Module and Group Entrance Examination used for assigning students to groups for interaction during subsequent collaborative learning teaches the disputed limitations of (1) "upon initiating the [] conference comprising the plurality of participants associated with a plurality of participant devices, providing the pre-defined interactive conference activity to each participant device of the plurality of participant devices via a computer network," and (2) "providing a first conference activity to participant devices in a first group of the plurality of groups and a second conference activity to participant devices in a second group of the plurality of groups, wherein the first conference activity is different from the second conference activity," as recited. Final Act. 7–8 (citing Colby ¶¶ 212–13, Fig. 3).

Appellant contends the Examiner errs, because "setting up and administering an entrance examination that allows a student to *begin* a course of study with other students is fundamentally different than the recited limitations." Appeal Br. 23; *see also id.* at 24–25. The Examiner responds that

> Appellant goes against the <u>explicit</u> language of *Colby* by
> incorrectly referring to the <u>group entrance</u> examination as a
> <u>course entrance</u> examination. As can be plainly read from
> *Colby* ¶ 0213, the group entrance exam is to ensure a level of
> understanding "<u>to interact with other students</u>" rather than
> admittance into the course at all. Independent study is not a
> being excluded from the course, but merely from the later social
> challenges that are within the course.

Ans. 15; *see also id.* at 13–16.

> Appellant replies that

> one of ordinary skill in the art would not read a test that *pre-
> dates and precludes any interactivity with other students* as
> reading on an interactive conference activity provided during a
> [] conference and applying user-provided segmentation rules to
> interaction with the pre-defined conference activity to generate
> a plurality of groups within the [] conference (as more particu-
> larly recited in the claims).

Id. at 18; *see also id.* at 16–17.

On the record before us, Appellant's argument is persuasive. We
agree with Appellant that the relied-upon disclosure of Colby teaches that an
individual is not a participant in a conference unless and until that individual
passes the group entrance exam. *See* Colby ¶¶ 212–13; Fig. 3. Accordingly,
because the disputed limitations require "providing the pre-defined
interactive conference activity to each participant" at the start of the
conference (i.e., "upon initiating" it), on the record before us, we agree the
Examiner errs by mapping the group entrance exam of Colby to claim 1's
pre-defined conference activity.

Accordingly, based upon the positions taken by the Examiner and arguments presented by Appellant,[10] we do not sustain the § 103 rejection of claim 1. For the same reason, we do not sustain the rejection of independent claims 8 and 14, both of which include limitations that are commensurate with the disputed limitations of claim 1 and for which the Examiner relies upon the same disclosure from Colby. *See* App. Br. 29, 31; Final Act. 11. We also, accordingly, do not sustain the § 103 rejections of the dependent claims 2, 4–7, 9, 11–13, 15, and 17–23.

DECISION

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1, 2, 4–9, 11–15, 17–23	101	Nonstatutory Subject Matter	1, 2, 4–9, 11–15, 17–23	
1, 2, 5–9, 18–23	103	Colby, Haveliwala		1, 2, 5–9, 13–15, 18–23
4, 11, 12, 17	103	Colby, Haveliwala, Clavel		4, 11, 12, 17
Overall Outcome			1, 2, 4–9, 11–15, 17–23	

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[10] We note Haveliwala discloses automated assignment of conference participants to different "breakout rooms" in the context of web conferences. Haveliwala ¶ 63, Fig. 5. However, the Examiner did not rely on this teaching in formulating the obviousness rejection, so we do not reach any determinations as to whether this additional teaching overcomes the deficiencies in the Examiner's reasoning noted above. *See Ex Parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (explaining that the Board reviews the appealed rejections for error based upon the issues identified by Appellants, and in light of the arguments and evidence produced thereon). In the event of further prosecution, the Examiner should consider if Haveliwala teaches or suggests the disputed limitations.

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)(1)(iv).

<u>AFFIRMED</u>