UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/871,505	09/30/2015	Martin Joseph Marcel Dubeau	36302-0012002	1541

26231   7590   01/02/2020
FISH & RICHARDSON P.C. (DA)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER
NORMAN, SAMICA L

ART UNIT	PAPER NUMBER
3697	

NOTIFICATION DATE	DELIVERY MODE
01/02/2020	ELECTRONIC

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

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

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

PATDOCTC@fr.com

UNITED STATES PATENT AND TRADEMARK OFFICE
_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD
_____

Ex parte MARTIN JOSEPH MARCEL DUBEAU and JAKUB DANIELAK
_____

Appeal 2019-002145
Application 14/871,505
Technology Center 3600
_____

Before CATHERINE SHIANG, JASON J. CHUNG, and
JOYCE CRAIG, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals the Final Rejection
of claims 1–13. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

INVENTION

The invention relates to "combining electronic life insurance policy
accounts and self-directed investment accounts." Spec. ¶ 2. Claim 1 is
illustrative of the invention and is reproduced below:

---

[1] We use the word "Appellant" to refer to "applicant" as defined in
37 C.F.R. § 1.42. According to Appellant, Toronto-Dominion Bank is the
real party in interest. Appeal Br. 1.

1.   A system comprising:

a life insurance platform including at least one processor *that executes operations to maintain a life insurance policy for a plurality of users, each life insurance policy associated with a cash value that is backed by investment assets, each life insurance policy associated with a first customer identifier associated with a user profile of a particular user*;

a user-directed investment account platform including at least one processor *that executes operations to maintain a plurality of user-directed investment accounts, wherein each of the user-directed investment accounts is associated with a second customer identifier associated with a user profile of a particular user, wherein the user-directed investment account platform and life insurance platform link particular life insurance policies and particular user-directed investment accounts based on a correspondence between the first customer identifier and the second customer identifier associated with a common user profile, wherein a particular user-directed investment account associated with a first user profile is initially funded with an associated margin account, wherein the margin account is based at least in part on a cash value of the corresponding life insurance policy associated with the first user profile*;

wherein at least one of the life insurance platform and the user-directed investment account platform further includes at least one processor that *executes operations to*:

determine a delta of the value of the investment assets backing the cash value of the life insurance policy associated with the first user profile; *and*

modify the value of the associated margin account based on the determined delta;

wherein the user-directed investment account platform further includes at least one processor that *executes operations to*:

monitor the user-directed investment account platform for changes to the associated margin account;

identify the modified value of the associated margin account associated with the first user profile;

2

> *store the modified value of the associated margin account associated with the first user profile*; *and*
>
> *automatically update the user-directed investment account associated with the first user profile based on the modified value of the margin account associated with the first user profile, wherein updating the user-directed investment account based on the modified value of the margin account comprises automatically and without user input, initiating an automatic investment within the user-directed investment account in response to and based on the identification of the modified value of the associated margin account*; *and*
>
> *wherein the user-directed investment account platform further* includes at least one processor that *executes operations operable to*:
>
>> *provide* a web-based interface for providing *information related to particular user-directed investment accounts, wherein* the web-based interface *presents account details of the user-directed investment account associated with a particular user profile*;
>>
>> *access the life insurance platform to identify information related to at least one life insurance policy associated with the particular user profile*; *and*
>>
>> *present*, via the web-based interface, *at least a portion of the identified information related to the life insurance policies associated with the particular user profile with the account details of the user-directed investment account.*

Appeal Br. 14–15 (Claims Appendix) (emphases added)

REJECTION

Claims 1–13 stand rejected under 35 U.S.C. § 101 as being directed to patent ineligible subject matter. Final Act. 2–3.

ANALYSIS

I. *Claims 1–11 and 31–49 Rejected Under 35 U.S.C. § 101*

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

4

(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).

"[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 is 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 Appellant's Arguments*

The Examiner concludes the present claims recite certain methods of organizing human activity. Final Act. 3; Ans. 4. The Examiner also determines the present claims do not amount to significantly more than an abstract idea itself because the abstract idea is implemented using additional

elements that are well-understood, routine, and conventional. Ans. 9–10 (citing *Alice Corp.,* 134 S. Ct. at 2359, 110 USPQ2d at 1984 (creating and maintaining "shadow accounts"); *Ultramercial*, 772 F.3d at 716, 112 USPQ2d at 1755 (updating an activity log)).

Appellant argues, similar to *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016) and *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299, 1308–14 (Fed. Cir. 2016), the present claims recite an improvement in user-directed life insurance platforms and user-directed investment platforms, which previously existed separately and without connection to one another. Appeal Br. 5–10 (citing Spec. ¶¶ 50, 56); Reply Br. 3–5.

Appellant argues, similar to *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), that the present claims recite automatic investment within the investment platform based on the determined change of the margin account associated with a linked life insurance policy, which is an improvement over prior art solutions and results in an inventive concept. Appeal Br. 10–11.

Appellant argues the Examiner fails to support the finding that the abstract idea is implemented using additional elements that are well-understood, routine, and conventional previously known to the industry. *Id.* at 11–12 (citing USPTO Commissioner for Patents Memorandum dated Apr. 9, 2018, "Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision" (*Berkheimer v. HP, Inc.*)). We disagree with Appellant.

C.   Discussion

1.   Step 2A, Prong 1

The emphasized portions of claim 1,[2] reproduced above (*see supra* at 2–3), recite fundamental economic principles or practices (including insurance) because the claims recite user-directed life insurance platforms and user-directed investment platforms, which previously existed separately and without connection to one another. *See also* Appeal Br. 8 (Appellant characterizes the present claims as reciting user-directed life insurance platforms and user-directed investment platforms, which previously existed separately and without connection to one another). According to the Memorandum, fundamental economic principles or practices fall into the category of certain methods of organizing human activity. *See* Memorandum; *see also* Final Act. 3; Ans. 4 (the Examiner concludes the present claims recite certain methods of organizing human activity). Moreover, those certain methods of organizing human activity are a type of an abstract idea. *See* Memorandum.

Because the present claims recite fundamental economic principles or practices, 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. In particular, we disagree with Appellant's argument that,

---

[2] Appellant does not argue claims 2–13 separately. Appeal. Br. 5–12. We, therefore, group claims 1–13 together and refer to those claims as the "present claims."

similar to *Enfish* and *McRO*, the present claims recite an improvement in user-directed life insurance platforms and user-directed investment platforms, which previously existed separately and without connection to one another. Appeal Br. 5–10 (citing Spec. ¶¶ 50, 56); Reply Br. 3–5.

Appellant does not identify persuasively how the Specification sets forth an improvement in technology. The USPTO October 2019 Patent Eligibility Guidance Update ("Update") addresses how we consider any evidence that is presented to us. The Update states:

> [d]uring examination, the examiner should analyze the "improvements" consideration by evaluating the specification and the claims to ensure that a technical explanation of the asserted improvement is present in the specification, and that the claim reflects the asserted improvement. Generally, examiners are not expected to make a qualitative judgment on the merits of the asserted improvement. *If the examiner concludes the disclosed invention does not improve technology, the burden shifts to applicant to provide persuasive arguments supported by any necessary evidence to demonstrate that one of ordinary skill in the art would understand that the disclosed invention improves technology.* Any such evidence submitted under 37 C.F.R. § 1.132 must establish what the specification would convey to one of ordinary skill in the art and cannot be used to supplement the specification. For example, in response to a rejection under 35 U.S.C. § 101, an applicant could submit a declaration under § 1.132 providing testimony on how one of ordinary skill in the art would interpret the disclosed invention as improving technology and the underlying factual basis for that conclusion.

Update, 13 (emphasis added).

In this case, the Examiner concludes the present claims do not recite an improvement to technology. Final Act. 4–5; Ans. 5–7. Consequently, we focus only on any evidence Appellant cites pursuant to the Update. Here, although Appellant identifies paragraphs 50 and 56 of the Specification,

those paragraphs merely discuss seamless linking of accounts from a user-directed life insurance platform with a user-directed investment platform that results in a combined set of data to users so that the user is unaware that their interface is presenting information from two distinct systems (i.e., certain methods of organizing human activity, which is an abstract idea as discussed *supra*), not an improvement to technology. Appeal Br. 5–10 (citing Spec. ¶¶ 50, 56); Reply Br. 3–5. Paragraphs 50 and 56 of the Specification are unlike the technological improvements in *Enfish*.

In *Enfish*, the Federal Circuit considered how the present invention was superior to the technology in the prior art. That is, the court considered "the specification's emphasis that 'the present invention comprises a flexible, self-referential table that stores data,'" "[t]he specification also teaches that the self-referential table functions differently than conventional database structures," "traditional databases, such as 'those that follow the relational model and those that follow the object oriented model' are inferior to the claimed invention." *Enfish, LLC v. Microsoft Corp.*, 822 F.3d at 1337 (interior citations omitted). Moreover, "'[t]he structural requirements of current databases require a programmer to predefine a structure and subsequent [data] entry must conform to that structure,' the 'database of the present invention does not require a programmer to preconfigure a structure to which a user must adapt data entry.'" *Id.* Then, the court determined the claims "achieve[d] other benefits over conventional databases, such as increased flexibility, faster search times, and smaller memory requirements." Unlike the claims of *Enfish,* the present claims do not recite "a specific improvement to the way computers operate, embodied in the self-referential table." *Id.* at 1336.

Similar to the *Enfish* argument, Appellant does not identify persuasively how paragraphs 50 and 56 of the Specification sets forth an improvement in technology. Moreover, the subject claim considered by the *McRO* court concerned a method for automatically animating lip synchronization and facial expressions. *McRO*, 837 F.3d at 1303. The *McRO* court concluded the subject claims did not recite an abstract idea because the computer animation improved the prior art through the use of rules, rather than artists, to set morph weights and transitions between phonemes. *Id.* at 1308. Thus, the claimed invention in *McRO* allowed for computer performance of animation steps that previously had to be performed by human animators. *Id.* at 1309. The subject claims in *McRO* used "limited rules in a process specifically designed to achieve an improved technological result" over "existing, manual 3-D animation techniques." *Id.* at 1316 (emphasis added). And unlike the claims of *McRO*, the present claims do not recite rules for lip sync and facial expression animation or an improvement in computer technology.

Instead, the present claims recite an abstract idea as discussed *supra*, in § I.C.1. or at best, improving an abstract idea—not a technological improvement. The Specification indicates the additional elements (i.e., "processor" and "web-based interface") recited in the present claims are merely generic computer components used to implement the abstract idea. Spec. ¶¶ 7, 40. Further, the generic computer components individually and in combination, does not integrate the judicial exception into a practical application.

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 other 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 additional elements that are well-understood, routine, and conventional. Ans. 9–10 (citing *Alice Corp.,* 134 S. Ct. at 2359, 110 USPQ2d at 1984 (creating and maintaining "shadow accounts"); *Ultramercial*, 772 F.3d at 716, 112 USPQ2d at 1755 (updating an activity log)). The Specification also supports the Examiner's determination in this regard because it explains that "processor" and "web-based interface" are generic components. Spec. ¶¶ 7, 40. Appellant's Specification indicates these elements were well-understood, routine, and conventional components because it describes them at a high level of generality and in a manner that indicates that they are sufficiently well-known. *Id.* Moreover, the additional elements recited in the present claims, analyzed individually or in combination, do not result in the claim, as a whole, amounting to significantly more than the judicial exception.

We, therefore, disagree with Appellant's argument that the Examiner fails to support the finding the abstract idea is implemented on additional elements that are well-understood, routine, and conventional previously

known to the industry. Appeal Br. 11–12.

We also disagree with Appellant's argument that, similar to *BASCOM*, the present claims recite automatic investment within the investment platform based on the determined change of the margin account associated with a linked life insurance policy, which is an improvement over prior art and results in an inventive concept. Appeal Br. 10–11.
Significantly, we note that Appellant does not argue how the present claims provide a non-conventional and non-generic arrangement of known, conventional pieces when considered as an ordered combination.

In *BASCOM*, however, the claims were directed to "a filter implementation versatile enough that it could be adapted to many different users' preferences while also installed remotely in a single location."
BASCOM, 827 F.3d at 1348–51. The inventive concept was "the installation of a filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each end user" that "gives the filtering tool both the benefits of a filter on a local computer and the benefits of a filter on the ISP server." *Id.* at 1350. Thus, when considered as an ordered combination, the court concluded the claims provided "an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces." *Id.*

Here, the present claims recite an abstract idea using generic components as discussed *supra*, in §§ I.C.1. and I.C.2. or at best, improving an abstract idea—not an inventive concept for the reasons discussed in § I.C.2.

Appellant does not argue claims 2–13 separately, but asserts the § 101 rejection of those claims should be withdrawn for at least the same reasons

13

as argued for independent claim 1. Appeal. Br. 5–12. Accordingly, we sustain the Examiner's rejection of: (1) independent claim 1; and (2) dependent claims 2–13 under 35 U.S.C. § 101.

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

CONCLUSION

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–13	101	Eligibility	1–13	

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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED