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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EDWIN W. PETERS, SHERRY L. PLATEK,
NITTY T. PULIKAN, BALAJI RANGANATHAN, LIVIU RODEAN,
BALASUBRAMANIAN SIVASUBRAMANIAN,
and ERIC WOODS

Appeal 2019-002741
Application 13/838,731
Technology Center 2100

Before ST. JOHN COURTENAY III, ERIC S. FRAHM, and
CATHERINE SHIANG, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from a final rejection of claims 28–47. Claims 1–27 are canceled. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). According to Appellant, the real party in interest is IBM Corporation. *See* Appeal Br. 1.

STATEMENT OF THE CASE

Introduction

Embodiments of Appellant’s invention relate generally to “note taking within a virtual meeting.” Spec. ¶ 1.

References

The prior art relied upon by the Examiner as evidence:

Name	Reference	Date
Kansal	US 2009/0119246 A1	May 7, 2009
Agapi et al.	US 2009/0271438 A1	Oct. 29, 2009
Yoshida et al.	US 2007/0013945 A1	Jan. 18, 2007
Bingaman et al.	US 2006/0233334 A1	Oct. 19, 2006
Moran et al.	6,018,346	Jan. 25, 2000

Rejections

- A. Claims 38–47 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. *See* Final Act. 2.
- B. Claims 28–47 are rejected under 35 U.S.C. § 101, as being directed to a judicial exception, without significantly more. *See* Final Act. 5.
- C. Claims 28–47 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting (OTDP) as being unpatentable over claims 21–30 of copending Application No. 14/523,250. *See* Final Act. 7. (corresponding to PTAB Appeal 2019-002736)
- D. Claims 28–30, 33, 34, 37–40, 43, 44, and 47 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Kansal in view of

- Agapi et al. (“Agapi”). *See* Final Act. 8.
- E. Claims 31, 32, 41, and 42 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Kansal, Agapi, and Yoshida et al. (“Yoshida”). *See* Final Act. 18.
- F. Claims 35 and 45 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Kansal, Agapi, and Bingaman et al. (“Bingaman”). *See* Final Act. 20.
- G. Claims 36 and 46 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Kansal, Agapi, and Moran et al. (“Moran”). *See* Final Act. 22.

Prior Decision

PTAB Appeal 2016-008341, Application No. 13/838,731, decided May 1, 2017. Examiner affirmed.

Related Appeals

This appeal is related to PTAB Appeal 2016-008464, stemming from co-pending Application No. 14/523,250. (Appeal Br. 1). The instant appeal and Appeal 2016-008464 have the same assignee (IBM Corporation), and are filed by the same inventive entity (Peters et al.).

This appeal is related to PTAB Appeal 2019-002736, stemming from co-pending Application No. 14/523,250. The instant appeal and Appeal 2019-002736 have the same assignee (IBM Corporation), and are filed by the same inventive entity (Peters et al.).

This appeal is also related to PTAB Appeal 2016-004945 (Application No. 14/216,682) (Notice of Allowance mailed Dec. 10, 2019) and PTAB Appeal 2016-004920 (Application No. 13/839,038) (Notice of Allowance

mailed Dec. 12, 2019). These appeals also have the same assignee (IBM Corporation), and are filed by the same inventive entity (Peters et al.).

Issues on Appeal

Did the Examiner err in rejecting claims 38–47 under 35 U.S.C. § 101, as being directed to non-statutory subject matter?

Did the Examiner err in rejecting claims 28–47 under 35 U.S.C. § 101, as being directed to a judicial exception, without significantly more?

Did the Examiner err in rejecting claims 28–47 under 35 U.S.C. § 103, as being obvious over the combined teachings and suggestions of the cited references?

ANALYSIS

We reproduce *infra* independent claim 28 in Table One. We have considered all of Appellant’s arguments and any evidence presented. We highlight and address specific findings and arguments for emphasis in our analysis below.

Rejection A of Claims 38–47 under § 101

Independent claim 38 recites, in pertinent part: “A computer program product, the computer program product comprising a **computer-readable storage medium** having program code stored therein, the program code, which when executed by a computer hardware system, causes the computer hardware system to perform:” (emphasis added).

Appellant cites to paragraph 12 of the Specification in support, and contends that claims 38–47 are directed to statutory subject matter under 35 U.S.C. § 101. (Appeal Br. 10). We have reviewed Appellant’s arguments and find them unpersuasive, for the following reasons:

On page 10 of the principal Brief, we find the support Appellant points to in the Specification (¶ 12) is dispositive to our analysis, (reproduced in pertinent part):

[0011] . . . aspects of the present invention may take the form of *a computer program product embodied in one or more computer-readable medium(s) having computer-readable program code embodied, e.g., stored, thereon.*

[0012] Any combination of one or more computer-readable medium(s) may be utilized. The computer-readable medium may be a computer-readable signal medium or a computer-readable storage medium. *The phrase "computer-readable storage medium" means a non-transitory storage medium. A computer-readable storage medium may be, for example, but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, or device, or any suitable combination of the foregoing.*

(Emphasis added).

To the extent Appellant’s Specification (¶ 12) describes “[t]he phrase ‘computer-readable storage medium’ means a non-transitory storage medium,” and thus is a limiting definition that disclaims all transitory (signal) computer-readable storage mediums, we find this purported “definition” is **directly contravened** by the sentence which immediately follows: “*A computer-readable storage medium may be, for example, but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, or device, or any suitable combination of the foregoing.*” (Spec. ¶ 12) (emphasis added). (See also Final Act. 2, citing Spec. ¶¶ 12–13).

We find at least “optical, electromagnetic, [and] infrared” mediums

include optical, electromagnetic, and infrared **signal** mediums. (*Id.*). We further note the open-ended “*may be, for example, but not limited to*” exemplary language in paragraph 12 of the Specification. (*Id.*).

Regarding the “computer-readable storage medium” recited in claim 38, we find PTAB precedential opinion *Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013) is directly on point and controlling. Under *Mewherter*, the scope of a “computer readable storage medium” was held to encompass transitory media such as signals or carrier waves, where, as here, the Specification does not expressly disclaim transitory forms. Moreover, to the extent the scope of the “computer-readable storage medium” of claim 38 broadly covers both statutory and non-statutory (transitory signal) embodiments, “[t]he four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007).

Applying this guidance here, we find Appellant’s Specification does not provide a definition that clearly and unequivocally disclaims the claim term “computer-readable storage medium” from encompassing transitory signals.² (Claim 38). Therefore, on this record, we are not persuaded the

² See *Openwave Sys., Inc. v. Apple Inc.*, 808 F.3d 509, 513–14 (Fed. Cir. 2015); *Omega Eng’g., Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323–26 (Fed. Cir. 2003) (Ambiguous language cannot support disavowal). See also *Omega*, 334 F.3d at 1324; *Schindler Elevator Corp. v. Otis Elevator Co.*, 593 F.3d 1275, 1285 (Fed. Cir. 2010).

Examiner’s reading is overly broad or unreasonable.³ (Final Act. 2–5). Although Appellant points to a different panel’s contrary decision on essentially the same issue in co-pending Appeal No. 2018-002660, we note the Board decision in that case is not precedential, and, therefore, is not binding upon this panel. *See* Reply Br. 2–3.

Accordingly, we sustain the Examiner’s rejection A under 35 U.S.C. § 101 of claims 38–47, as being directed to **non-statutory subject matter**.

Rejection B under 35 U.S.C. § 101

Principles of Law

A. Section 101

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 U.S. 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 Court’s two-part framework, described in *Mayo* and *Alice*. *Alice*, 573 U.S. 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

³ Because “applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citation omitted).

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, 67 (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 (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 (1853))); 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 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 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, 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.*

B. USPTO § 101 Guidance

The U. S. Patent and Trademark Office (USPTO) published revised guidance on the application of § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (“2019 Memorandum”).⁴ Under that guidance, we first look to whether the claim recites:

(1) (*see* 2019 Memorandum Step 2A – Prong One) any judicial

⁴ The Office issued a further memorandum on October 17, 2019 (the “October 2019 Memorandum”) clarifying guidance of the January 2019 Memorandum in response to received public comments. *See* https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf. Moreover, “[a]ll USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.” January 2019 Memorandum at 51; *see also* October 2019 Memorandum at 1.

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) (*see* 2019 Memorandum Step 2A – Prong Two) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).⁵

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 2019 Memorandum Step 2B.

Because there is no single definition of an “abstract idea” under *Alice* step 1, the PTO has recently synthesized, for purposes of clarity, predictability, and consistency, key concepts identified by the courts as abstract ideas to explain that the “abstract idea” exception includes the following three groupings:

⁵ This evaluation is performed by (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception, and (b) evaluating those additional elements individually and in combination to determine whether the claim as a whole integrates the exception into a practical application. *See* 2019 Memorandum - Section III(A)(2).

1. Mathematical concepts—mathematical relationships, mathematical formulas or equations, mathematical calculations;
2. Mental processes— concepts performed in the human mind (including an observation, evaluation, judgment, opinion); and
3. Certain methods of organizing human activity—fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions).

See 2019 Memorandum, 84 Fed. Reg. at 52.

According to the 2019 Memorandum, “[c]laims that do not recite [subject] matter that falls within these enumerated groupings of abstract ideas should not be treated as reciting abstract ideas,” except in rare circumstances. Even if the claims recite any one of these three groupings of abstract ideas, these claims are still not “directed to” a judicial exception (abstract idea), and thus are patent eligible, if “the claim as a whole integrates the recited judicial exception into a practical application of that exception.” *See* 2019 Memorandum, 84 Fed. Reg. at 53.

For example, limitations that **are** indicative of *integration into a practical application* include:

1. Improvements to the functioning of a computer, or to any other technology or technical field — *see* MPEP § 2106.05(a);
2. Applying the judicial exception with, or by use of, a particular machine — *see* MPEP § 2106.05(b);
3. Effecting a transformation or reduction of a particular article to a different state or thing — *see* MPEP

- § 2106.05(c); and
4. Applying or using the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception — *see* MPEP § 2106.05(e).

In contrast, limitations that are **not** indicative of *integration into a practical application* include:

1. Adding the words “apply it” (or an equivalent) with the judicial exception, or merely include instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea — *see* MPEP § 2106.05(f);
2. Adding insignificant extra-solution activity to the judicial exception — *see* MPEP § 2106.05(g); and
3. Generally linking the use of the judicial exception to a particular technological environment or field of use — *see* MPEP § 2106.05(h).

See 2019 Memorandum, 84 Fed. Reg. at 54–55 (“Prong Two”).

2019 Memorandum, Step 2A, Prong One⁶
The Judicial Exception

Under the 2019 Memorandum, we begin our analysis by first considering whether the claims recite any judicial exceptions, including certain groupings of abstract ideas, in particular: (a) mathematical concepts, (b) mental steps, and (c) certain methods of organizing human activities.

⁶ Throughout this opinion, we give the claim limitations the broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

The Examiner concludes the claims are “directed to an abstract idea as the claims describe an abstract idea of analyzing and organizing information.” Final Act. 5.

We apply the Director’s 2019 Memorandum *de novo*. In Table One below, we identify in *italics* the specific claim limitations that we conclude recite an abstract idea. We also identify in **bold** the additional (non-abstract) claim elements that we find are generic computer components:

TABLE ONE

Independent Claim 28	2019 Memorandum
[a] A computer hardware system , comprising: ⁷	
[b] a hardware processor configured to initiate the following executable operations:	
[c] receiving a first meeting user notes from a first participant of a virtual meeting;	Receiving a first meeting user notes from a first participant of a virtual meeting is insignificant extra-resolution activity (i.e., data gathering). <i>See</i> 2019 Memorandum, 55 n.31; <i>see also</i> MPEP § 2106.05(g).
[d] receiving a second meeting user notes from a	Receiving a second meeting user notes from a second participant of

⁷ A computer hardware system falls under the statutory subject matter class of a machine. *See* 35 U.S.C. § 101 (“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”).

Independent Claim 28	2019 Memorandum
<p>second participant of the virtual meeting;</p>	<p>the virtual meeting is insignificant extra-solution activity (i.e., data gathering). <i>See</i> 2019 Memorandum, 55 n.31; <i>see also</i> MPEP § 2106.05(g).</p>
<p>[e] <i>analyzing text of the first and second meeting user notes to identify key elements therein;</i></p>	<p>Abstract Idea: <i>analyzing text of the first and second meeting user notes to identify key elements therein</i> is a method of organizing human activity (managing interactions between people) that can be performed as a mental process. <i>See</i> 2019 Memorandum 52.</p>
<p>[f] <i>cross-referencing the analysis of the text of first and second meeting user notes to identify a common key element in the analysis thereof that is common to both the first and second meeting user notes;</i> and</p>	<p>Abstract Idea: <i>cross-referencing the analysis of the text of first and second meeting user notes to identify a common key element in the analysis thereof that is common to both the first and second meeting user notes</i> is a method of organizing human activity (managing interactions between people) that can be performed as a mental process. <i>See</i> 2019 Memorandum 52.</p>
<p>[g] <i>generating consolidated system notes that include the common key element, wherein the identifying of a key element includes establishing that each key element meets a predetermined threshold of</i></p>	<p>Abstract idea: <i>generating consolidated system notes that include the common key element, wherein the identifying of a key element includes establishing that each key element meets a predetermined threshold of significance</i> is a method of</p>

Independent Claim 28	2019 Memorandum
<i>significant.</i> ⁸	organizing human activity (managing interactions between people) that can be performed as a mental process. See 2019 Memorandum 52.

Abstract Idea

After considering representative system claim 28 as a whole, we conclude that the *italicized* functions shown in Table One above **recite** a method of organizing human activity, i.e., *managing interactions between people* by analyzing meeting notes. Further, we conclude the *italicized* steps could also be performed alternatively as mental processes.⁹ See 2019 Memorandum, 84 Fed. Reg. at 52. See also “*Intellectual Ventures I LLC v.*

⁸ It appears that the claim term “significant” was intended to be “significance.”

⁹ If a method can be performed by human thought alone, or by a human using pen and paper, it is merely an abstract idea and is not patent eligible under § 101. See *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011); “That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson.*” *CyberSource*, 654 F.3d at 1375. See also *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146–47 (Fed. Cir. 2016). Moreover, “[u]sing a computer to accelerate an ineligible mental process does not make that process patent-eligible.” *Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266, 1279 (Fed. Cir. 2012); see also *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (“[R]elying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.”).

Symantec Corp., 838 F.3d 1307, 1318 (Fed. Cir. 2016) (“[W]ith the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper.”) 2019 Memorandum, 84 Fed. Reg. at 52 n.14 (emphasis omitted).

“An abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). Merely combining several abstract ideas does not render the combination any less abstract. *See RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“Adding one abstract idea (math) to another abstract idea . . . does not render the claim non-abstract.”); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (determining the pending claims were directed to a combination of abstract ideas).

Because we conclude all claims 28–47 on appeal recite an abstract idea, as identified above, under *Step 2A, Prong One*, we proceed to *Step 2A, Prong Two*.

2019 Memorandum, Step 2A, Prong Two
Integration of the Judicial Exception into a Practical Application

Pursuant to the 2019 Memorandum, we consider whether there are additional elements set forth in the claims that integrate the judicial exception into a practical application. *See* 2019 Memorandum, 84 Fed. Reg. at 54–55.

Additional Generic Computer Limitations

As emphasized in **bold** in Table One, *supra*, we note the additional generic computer components recited in claim 1: “A computer hardware

system” and “a hardware processor.” We further note the supporting exemplary, non-limiting descriptions of generic computer components in the Specification, for example, the Specification ¶ 53:

In one aspect, system 300 is implemented as a computer or other programmable data processing apparatus that is suitable for storing and/or executing program code. It should be appreciated, however, that system 300 can be implemented in the form of *any system including a processor and memory that is capable of performing and/or initiating the functions and/or operations described within this specification*. Further, system 300 can be implemented in *any of a variety of different form factors including, but not limited to, a portable device such as a mobile communication device, a tablet computing and/or communication device, a laptop computing device, a desktop computing device, a server, or the like*.

Spec. ¶ 53 (emphasis added).

We emphasize that *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016), guides: “[t]he abstract idea exception prevents patenting a *result* where ‘it matters not by what process or machinery the result is accomplished.’” 837 F.3d at 1312 (*quoting O’Reilly v. Morse*, 56 U.S. 62, 113 (1854)) (emphasis added). *See supra* Table One.

MPEP § 2106.05(a)

*Improvements to the Functioning of a Computer or
to Any Other Technology or Technical Field*

Appellant reproduces the record and cites to several case authorities. *See* Appeal Br. 12. Appellant argues: “In this instance, the Examiner overgeneralizes the claimed invention as being directed to ‘analyzing and organizing information.’” Appeal Br. 13.

However, as discussed above, we conclude that the *italicized* functions shown in Table One **recite** a method of organizing human activity that can be performed alternatively as a mental process.

Appellant advances a nominal argument that the “claims include additional limitations that are directed to an *improvement* to an existing technological process.” Appeal Br. 17. However, we find no antecedent argument to an improvement to an existing technological process in the Brief. *Id.*

As indicated above, we apply the Director’s 2019 Memorandum *de novo*. Although the Reply Brief was filed on Feb. 19, 2019, after the Director’s 2019 Memorandum was issued, Appellant advances no substantive, persuasive arguments regarding any purported improvement to the functioning of a computer or to any other technology or technical field, as set forth under MPEP § 2106.05(a). Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

MPEP §§ 2106.05(c), 2106.05(e)

Appellant advances no arguments that any of the method claims on appeal are tied to a particular machine, or transform an article to a different state or thing. *See* MPEP § 2106.05(c). Nor does Appellant advance further substantive, persuasive arguments as to any particular “meaningful” claim limitations, such as those of the types addressed under MPEP § 2106.05(e), that impose meaningful limits on the judicial exception.¹⁰

¹⁰ *See* 2019 Memorandum, 84 Fed. Reg. 55, citing MPEP § 2106.05(e): “[A]pply[ing] or us[ing] the judicial exception in some other *meaningful* way beyond generally linking the use of the judicial exception to a particular

MPEP § 2106.05(f)

*Merely including instructions to implement
an abstract idea on a computer, or
Merely using a computer as a tool
to perform an abstract idea*

We conclude Appellant’s claimed invention merely implements the abstract idea using *instructions* executed on generic computer components, as depicted in **bold** type in Table One, and as supported in our reproduction of the Specification, paragraph 53, *supra*. Thus, we conclude Appellant’s claims merely use a programmed computer as a tool to perform an abstract idea.

MPEP § 2106.05(g)

*Adding insignificant extra-solution activity
to the judicial exception*

As mapped in the right column of Table One, *supra*, we conclude that representative independent claim 28 recites extra or post-solution activities that courts have determined to be insufficient to transform judicially excepted subject matter into a patent-eligible application. *See* MPEP § 2106.05(g); 84 Fed. Reg. at 55 n.31.

MPEP § 2106.05(h)

*Generally linking the use of the judicial exception to a particular
technological environment or field of use*

The Supreme Court guides: “the prohibition against patenting abstract

technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception.” (emphasis added).

ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or [by] adding ‘insignificant postsolution activity.’” *Bilski*, 561 U.S. at 610–12, (quoting *Diehr*, 450 U.S. at 191–92).

Appellant argues there is a lack of preemption:

Even assuming, for sake of argument, that the claimed invention is directed to the abstract idea of “analyzing and organizing information,” like the patent at issue in BASCOM, Appellants are not looking to monopolize (or preempt) the alleged abstract idea. Rather, Appellants’ claims include additional limitations that are directed to an improvement to an existing technological process, as already argued above. Thus, the facts of the present application are consistent with BASCOM.

Appeal Br. 17.

Our reviewing court provides applicable guidance: “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015).

Nor do claims 28–47 on appeal present any other issues as set forth in the 2019 Memorandum regarding a determination of whether the additional generic elements integrate the judicial exception into a practical application. *See* 2019 Memorandum, 84 Fed. Reg. at 55.

Thus, under *Step 2A, Prong Two* (MPEP §§ 2106.05(a)–(c) and (e)–(h)), we conclude claims 28–47 do not integrate the judicial exception into a practical application. Therefore, we proceed to *Step 2B, The Inventive Concept*.

The Inventive Concept – Step 2B

Under the 2019 Memorandum, 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 a specific limitation beyond the judicial exception that is 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.

BASCOM

We note the Federal Circuit held in *BASCOM* that the claimed Internet content filtering, which featured an implementation “versatile enough that it could be adapted to many different users’ preferences while also installed remotely in a single location,” expressed an inventive concept in “the non-conventional and non-generic arrangement of known, conventional pieces.” *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016).

Although Appellant cites *BASCOM* as a case authority in support (Appeal Br. 16–17), we do not find a substantive argument analogizing the claims on appeal to the subject claim considered by the *BASCOM* court. In particular, Appellant has not persuasively shown an unconventional, non-generic *arrangement* regarding the non-abstract limitations of generic computer components in any of the claims on appeal, as was held by the court in *BASCOM*. *See* 2019 Memorandum, 84 Fed. Reg. at 52. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Further, regarding the use of the recited generic computer components identified above in Table One, the Supreme Court has held that “the mere

recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 573 U.S. at 223. Our reviewing court provides additional guidance: *See FairWarning*, 839 F.3d at 1096 (“[T]he use of generic computer elements like a microprocessor or user interface do not alone transform an otherwise abstract idea into patent-eligible subject matter.”); *OIP Techs*, 788 F.3d at 1363 (claims reciting, *inter alia*, sending messages over a network, gathering statistics, using a computerized system to automatically determine an estimated outcome, and presenting offers to potential customers found to merely recite “‘well-understood, routine conventional activit[ies],’ either by requiring conventional computer activities or routine data-gathering steps”).

This reasoning is applicable here. Therefore, on the record before us, Appellant has not shown that the claims on appeal add a specific limitation beyond the judicial exception that is not well-understood, routine, and conventional, when the claim limitations are considered both individually and as an ordered combination. *See* MPEP § 2106.05(d).

In light of the foregoing, we conclude, under the 2019 Memorandum, that each of Appellant’s claims 28–47, considered as a whole, is directed to a patent-ineligible abstract idea that is not integrated into a practical application, and does not include an inventive concept.¹¹ Therefore, we sustain the Examiner’s Rejection B under 35 U.S.C. § 101 of claims 28–47.

¹¹ Regarding Rejection B, we consider claims 28–47 as a group and consider independent claim 28 as the representative claim. *See* 37 C.F.R. § 41.37(c)(1)(iv). For the reasons discussed above, grouped claims 29–47 fall with representative claim 28 under 35 U.S.C. § 101 Rejection B.

Provisional Non-statutory OTDP Rejection C of Claims 28–47

Regarding provisional OTDP rejection C, Appellant indicates that they “will make a determination as to the filing of a Terminal Disclaimer upon indication of allowable subject matter.” (Appeal Br. 3, n.1).

Because Appellant advances no arguments on appeal traversing the non-statutory OTDP rejection, we *pro forma* sustain the Examiner’s provisional rejection C of claims 28–47, on the ground of non-statutory obviousness-type double patenting. (See Final Act. 7–8).

Rejection D of Independent Claim 28 under § 103

Representative Independent Claim 28

28. A computer hardware system, comprising:

a hardware processor configured to initiate the following executable operations:

receiving a first meeting user notes from a first participant of a virtual meeting;

receiving a second meeting user notes from a second participant of the virtual meeting;

[L] *analyzing text of the first and second meeting user notes to identify key elements therein;*

cross-referencing the analysis of the text of first and second meeting user notes to identify a common key element in the analysis thereof that is common to both the first and second meeting user notes; and

generating consolidated system notes that include the common key element, wherein

the identifying of a key element includes establishing that each key element meets a predetermined threshold of significance.

Appeal Br. 30, “CLAIMS APPENDIX.” (Bracketed lettering added and disputed limitations “L” emphasized).

Issues: Under 35 U.S.C. § 103, we focus our analysis on the following argued limitations that we find are dispositive regarding Rejection D of claims 28–30, 33, 34, 37–40, 43, 44, and 47:

Did the Examiner err by finding that Agapi (when combined with Kansal) teaches or suggests the disputed, dispositive limitations (“L”):

“analyzing text of the first and second meeting user notes to identify key elements therein;

cross-referencing the analysis of the text of first and second meeting user notes to identify a common key element in the analysis thereof that is common to both the first and second meeting user notes; and

generating consolidated system notes that include the common key element, wherein

the identifying of a key element includes establishing that each key element meets a predetermined threshold of significant,”

within the meaning of representative claim 28?¹² (see Final Act. 9–10)

(emphasis added).

Appellant contests limitations “L” of claim 28, by first contending, *inter alia:*

[T]he Examiner has not specifically identified those teachings within Agapi being relied upon by the Examiner and mapped those teachings to the limitations at issue. Rather, the Examiner generally refers to paragraphs [0008] and [0057] of Agapi *without explanation*.

Appeal Br. 19 (emphasis added).

Secondly, Appellant contends the Examiner’s obviousness analysis represents:

no more than the Examiner repeating the limitations at issue as the “rational underpinning.” In essence, the Examiner is merely arguing that it would have been obvious to include “X” for the

¹² We give the contested claim limitations the broadest reasonable interpretation consistent with the Specification. See *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

purpose of having “X.” This is not a rational underpinning — it is *circular reasoning*.

Appeal Br. 22 (emphasis added).

Regarding the first contention, and based upon our review of the record, we agree with Appellant that the Examiner’s mapping of the disputed limitations is unclear, because the Examiner supports the rejection with a grouping of citations, without providing a clear mapping of the individual claim terms to the corresponding specific feature(s) found in Agapi. *See* Final Act. 9–10.

We note the Board is a reviewing body that does not perform initial examination. To show obviousness (or anticipation), the Examiner must provide a clear mapping of each claim limitation to the corresponding specific feature found in the reference, which the Examiner must identify with particularity.¹³

In our review of the Answer, we find Examiner’s responses are duplicative and insufficient to establish a prima facie case of obviousness. The Examiner merely reproduces, verbatim, a number of portions of Agapi being relied upon, without further clarifying how the “cross-referencing” and the “identifying” limitations “L” are taught or suggested by Agapi. *See* Ans. 11–12 (emphasis added).

Appellant also contends Agapi does not store an identified topic keyword “as part of the generation of consolidated system notes.” Appeal

¹³ *See* 37 C.F.R. § 1.104(c)(2) (“When a reference is complex or shows or describes inventions other than that claimed by the applicant, *the particular part relied on must be designated as nearly as practicable*. The pertinence of each reference, if not apparent, *must be clearly explained* and each rejected claim specified.” (emphasis added)).

Br. 20; Reply Br. 6. We find the Examiner does not clearly explain in the Final Action or the Answer how Agapi teaches or at least suggests the disputed limitation of “*generating consolidated system notes that include the common key element.*” Claim 28 (emphasis added).

The prima facie burden has therefore not been met, and the rejection does not adhere to the minimal requirements of 35 U.S.C. § 132(a), “when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990).

Regarding Appellant’s second contention, we also agree with Appellant that the Examiner has not provided a rational underpinning to explain why a skilled artisan would have been led to modify the teachings of Kansal with those of Agapi to teach or suggest the invention of claim 28.

In the Final Office Action (10–11), we find the Examiner simply concludes, without any explanation or justification, that a “skilled artisan would have been motivated to improve[] Kansal” solely for the purpose of implementing the disputed limitations “L”. Final Act. 10–11 (reciting limitations “L”, verbatim).

However, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l., Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).¹⁴

Therefore, we find some degree of speculation would be required to

¹⁴ See *In re NuVasive, Inc.*, 842 F.3d 1376, 1383 (Fed. Cir. 2016) (“[C]onclusory statements’ alone are insufficient and, instead, the finding

affirm the Examiner on this record. We decline to engage in speculation. “A rejection . . . must rest on a factual basis” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). “The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *Id.*

Accordingly, for essentially the same reasons argued by Appellant in the Briefs, as further discussed above, we are constrained on this record to reverse the Examiner’s § 103 Rejection D of independent claim 28. Because the other independent claim 38 recites the disputed limitations “L” using similar language of commensurate scope, we also reverse the Examiner’s rejection of independent claim 28.

Because we have reversed the rejection of each independent claim on appeal, we also reverse the Examiner’s obviousness Rejection D for each associated dependent claim on appeal.

Accordingly, we reverse the Examiner’s obviousness Rejection D of claims 28–30, 33, 34, 37–40, 43, 44, and 47 on appeal.

*Rejections E, F, and G of Dependent Claims 31, 32,
35, 36, 41, 42, 45, and 46 under § 103*

In light of our reversal of the rejection of independent claims 28 and 38 under Rejection D, *supra*, we also reverse obviousness Rejections E, F,

must be supported by a ‘reasoned explanation.’” (internal citation omitted)); *see also In re Chaganti*, 554 F. App’x. 917, 922 (Fed. Cir. 2014) (“It is not enough to say that . . . to do so would ‘have been obvious to one of ordinary skill.’ Such circular reasoning is not sufficient—more is needed to sustain an obviousness rejection.”).

and G under § 103 of claims 31, 32, 35, 36, 41, 42, 45, and 46, which variously and ultimately depend from claims 28 and 38. On this record, the Examiner has not shown how the additionally cited secondary references overcome the aforementioned deficiencies, as discussed above regarding independent claim 28.

CONCLUSIONS

We conclude that claims 38–47, rejected under 35 U.S.C. § 101, are directed to non-statutory subject matter.

Under the Director’s 2019 Memorandum, as governed by relevant case law, we conclude that all claims 28–47, rejected under 35 U.S.C. § 101, are directed to patent-ineligible subject matter.

We *pro forma* sustain the Examiner’s provisional OTDP rejection of claims 28–47.

The Examiner erred in rejecting claims 28–47 as being obvious under 35 U.S.C. § 103, over the cited combinations of references.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
38-47	101	Non-statutory subject matter	38-47	
28-47	101	Eligibility (Judicial Exception)	28-47	
28-47		Provisional Non-statutory OTDP	28-47	
28-30, 33, 34, 37-40, 43, 44, 47	103	Kansal, Agapi		28-30, 33, 34, 37-40, 43, 44, 47
31, 32, 41, 42	103	Kansal, Agapi, Yoshida		31, 32, 41, 42
35, 45	103	Kansal, Agapi, Bingaman		35, 45
36, 46	103	Kansal, Agapi, Moran		36, 46
Overall Outcome			28-47	

FINALITY AND RESPONSE

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner’s decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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. § 41.50(f).

AFFIRMED