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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/909,488	02/02/2016	Adi Kidron	90149773	6633
146568	7590	06/30/2020	EXAMINER	
MICRO FOCUS LLC 500 Westover Drive #12603 Sanford, NC 27330			HOLZMACHER, DERICK J	
			ART UNIT	PAPER NUMBER
			3623	
			NOTIFICATION DATE	DELIVERY MODE
			06/30/2020	ELECTRONIC

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ADI KIDRON and
EITAN KATZ

Appeal 2019–004278
Application 14/909,488
Technology Center 3600

Before HUBERT C. LORIN, BIBHU R. MOHANTY, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant appeals from the Examiner’s Final decision to reject claims 1–18.¹ We have jurisdiction 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). Appellant identifies Entit Software LLC as the real party in interest. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The claimed subject matter relates to smartphones or other computing devices “[h]aving an abundance of communications applications installed” (Spec., para. 9). Claim 15, reproduced below with emphasis added, is illustrative of the claimed subject matter:

15. A method for message delivery, comprising:
- intercept*, by a processor of a computing device, *a first message sent from a sender* via a first communications application *and addressed for delivery to a receiver* via the first communications application;
 - selecting*, by the processor, *a communications application preferred by the receiver to deliver the first message to the receiver, including:*
 - obtaining past behaviors data of the receiver with respect to utilization of communications applications,*
 - identifying, from the past behaviors data, a relevant circumstance with respect to utilization of a communication application by the receiver, and*
 - counting occurrences that the receiver utilized the preferred communications application relative to other communications applications during the relevant circumstance;*
 - and*
 - transmitting*, by the processor, *the first message to the receiver* via the preferred communications application, wherein the first message is not transmitted to the receiver via the first communications application.

REFERENCE

The prior art relied upon by the Examiner is:

Name	Reference	Date
Luna	US 2013/0203433 A1	Aug. 8, 2013

REJECTIONS

Claims 1–18 are rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

Claims 1–18 are rejected under 35 U.S.C. § 102(a)(2) as being anticipated by Luna.

OPINION

The rejection of claims 1–18 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

The rejection of claims 1–18 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

The Appellant argues these claims as a group. *See* Appeal Br. 7–12. We select claim 15 as the representative claim for this group, and the remaining claims 1–14 and 16–18 stand or fall with claim 15. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Preliminary comment

Previous Office guidance on patent subject matter eligibility has been superseded by the 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019), hereinafter “2019 Revised 101 Guidance.” *See* 2019 Revised 101 Guidance, 84 Fed. Reg. at 51 (“Eligibility–related guidance issued prior to the Ninth Edition, R–08.2017, of the MPEP (published Jan. 2018) should not be relied upon.”). Accordingly, we will not address arguments on the sufficiency of the Examiner’s position relative prior guidance but rather our analysis that follows will comport with the 2019 Revised 101 Guidance. We will pay particular attention to the Examiner’s position taken in the Answer and Appellant’s arguments made in

the Reply Brief which are expressed in the context of the 2019 Revised 101 Guidance.

Introduction

35 U.S.C. § 101 provides that “[w]hoever 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.”

In that regard, claim 15 covers a “process” and is thus statutory subject matter for which a patent may be obtained.² This is not in dispute.

However, the 35 U.S.C. § 101 provision “contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

In that regard, notwithstanding claim 15 covers statutory subject matter, the Examiner has raised a question of patent eligibility on the ground that claim 15 is directed to an abstract idea.

Alice identifies a two-step framework for determining whether claimed subject matter is directed to an abstract idea. *Alice*, 573 U.S. at 217.

² This corresponds to Step 1 of the 2019 Revised 101 Guidance which requires determining whether “the claim is to a statutory category.” 84 Fed. Reg. at 53. *See also id.* at 53–54 (“consider[] whether the claimed subject matter falls within the four statutory categories of patentable subject matter identified by 35 U.S.C. 101.”).

Alice step one — the “directed to” inquiry

According to *Alice* step one, “[w]e must first determine whether the claims at issue are *directed to* a patent-ineligible concept.” *Id.* at 218 (emphasis added).

The Examiner determined, *inter alia*, that the claimed subject matter is directed to an abstract idea, “namely:

"intercept a first message sent from a sender via a first communications application and addressed for a planned delivery to a receiver via the first communications application" "in response to a determination that first is addressed for delivery to the receiver, select a communications application preferred by the receiver to deliver the first message to the receiver, including accessing past behaviors data of the receiver with respect to utilization of communications applications and identifying, in consideration of the past behaviors data, a preferred communications application of the receiver for delivering the first message to the receiver" "transmit the first message to the receiver via the preferred communications application instead of via the first communications application" are directed to receiving message data, accessing data based on past behaviors (e.g., responding to stimulus or situation such as time of day, day of the week, calendar date, presence at a location, attendance at a scheduled event), selecting a preferred communication app according to past user behavior and transmitting the current message to be delivered to the preferred communication app which is a practice similar to those found by the courts to be abstract.

Final Act. 16–17.

Appellant argues that the claims “are not directed to an abstract idea because the features recited in the claims relate to an improvement in computer-related technology.” Appeal Br. 9.

Accordingly, there is a dispute over whether claim 15 is directed to an abstract idea. Specifically, is claim 15 directed to

receiving message data, accessing data based on past behaviors (e.g., responding to stimulus or situation such as time of day, day of the week, calendar date, presence at a location, attendance at a scheduled event), selecting a preferred communication app according to past user behavior and transmitting the current message to be delivered to the preferred communication app

(Final Act. 17) or “an improvement in computer technology” (Appeal Br. 9)?

*Claim Construction*³

We consider the claim as a whole giving it the broadest reasonable construction as one of ordinary skill in the art would have interpreted it in light of the Specification at the time of filing.^{4,5,6}

Claim 15 recites 6 steps in total. They are:

1. “intercept[ing] . . . a first message sent from a sender . . . and addressed for delivery to a receiver . . . ;”
2. “selecting . . . a communications application preferred by the receiver to deliver the first message to the receiver, including”
3. “obtaining . . . data” A;

³ “[T]he important inquiry for a § 101 analysis is to look to the claim.” *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1345 (Fed. Cir. 2013). “In *Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can.*, 687 F.3d 1266, 1273 (Fed. Cir. 2012), the court observed that ‘claim construction is not an inviolable prerequisite to a validity determination under § 101.’ However, the threshold of § 101 must be crossed; an event often dependent on the scope and meaning of the claims.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1347–48 (Fed. Cir. 2015).

⁴ “In determining the eligibility of respondents’ claimed process for patent protection under § 101, their claims must be considered as a whole.” *Diamond v. Diehr*, 450 U.S. 175, 188 (1981).

⁵ “First, it is always important to look at the actual language of the claims. . . . Second, in considering the roles played by individual limitations, it is important to read the claims ‘in light of the [S]pecification.’” *Smart Sys. Innovations, LLC v. Chicago Transit Auth.*, 873 F.3d 1364, 1378 (Fed. Cir. 2017) (J. Linn, dissenting in part and concurring in part) (citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016)), among others.

⁶ See 2019 Revised 101 Guidance, 84 Fed. Reg. at 52, n. 14 (“*If a claim, under its broadest reasonable interpretation.*”) (emphasis added).

4. “identifying . . . circumstance” B from A; and,
5. “counting occurrences” C during B; and,
6. “transmitting . . . the first message to the receiver . . .”;

where the first step is conducted “via a first communications application” and the sixth step is conducted “via the preferred communications application, wherein the first message is not transmitted to the receiver via the first communications application” and

where

A is “past behaviors data of the receiver with respect to utilization of communications applications;”

B is “a relevant circumstance with respect to utilization of a communication application by the receiver;” and,

C is “occurrences that the receiver utilized the preferred communications application relative to other communications applications.”

Claim 15 employs “a processor of a computing device” (all steps); “a first communications application” (step 1) and, “a preferred communications application” (step 6).

Claim 15 is reasonably broadly construed as covering a scheme for selecting a preferred communications application by which to transmit an intercepted message to a receiver.

The Specification explains that there is an “abundance of communications applications installed on a smartphone or other computing device” giving a “user of the smartphone . . . flexibility . . . to quickly respond to messages sent by contacts in a format and manner that is presumably comfortable to the contacts.” Para. 9. However, “there are also

can be significant drawbacks.” Para. 10. “The smart phone user will thus invariably receive via communications applications messages that are not preferred to the user given the subject matter, timing, or other context factor.” *Id.* “To address these issues, . . . message delivery via receiver-preferred communications applications” is provided. Para. 11.

To provide said preferred delivery, the Specification describes using, *inter alia*, a selection engine; that is, “a combination of hardware and programming configured to select a preferred communications application for delivering the current message to the addressee user. The preferred application is selected according to past behaviors of the addressee user with respect to a plurality of communication applications.” Para. 26.

In an example, the selection engine 204 is configured to identify, from the past behaviors data, a relevant circumstance with respect to the addressee user's utilization of a communication application, and to consider of a count of occurrences that the addressee user utilized the preferred application relative to other communicate on applications during the relevant circumstance. In examples, the relevant circumstance is, or includes, a specific time, time period, date, or range of dates.

Para. 27. As shown in Figure 2, reproduced below, selection engine 204 is part of a preferred communications application system 102 that also includes current message engine 202, selection engine 204, whereby selection engine 204 may access data repository 208 used to store and retrieve data.

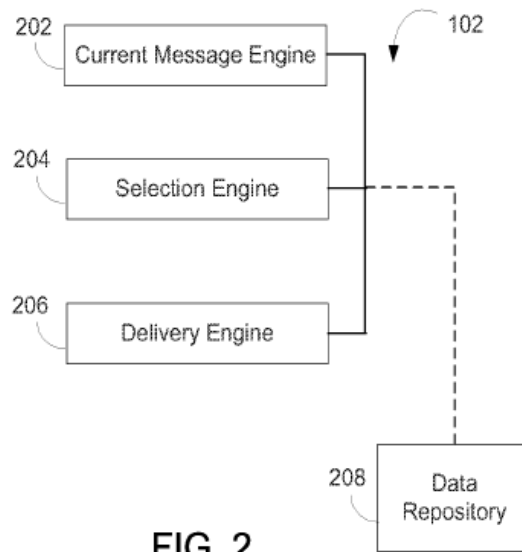


Figure 2 depicts an example of a system for message delivery per a preferred communications application 102 according to the Specification.

Given the method as claimed as reasonably broadly construed above and in light of the Specification’s description of the objective of the invention to provide preferred message delivery, we reasonably broadly construe claim 15 as being directed to message delivery via a selected receiver-preferred communications application.

*The Abstract Idea*⁷

Above, where we reproduce claim 15, we identify in italics the limitations we believe recite an abstract idea.⁸ Based on our claim

⁷ This corresponds to Step 2A of the 2019 Revised 101 Guidance. Step 2A determines “whether a claim is ‘directed to’ a judicial exception,” such as an abstract idea. Step 2A is a two prong inquiry.

⁸ This corresponds to Prong One (a) of Step 2A of the 2019 Revised 101 Guidance. “To determine whether a claim recites an abstract idea in Prong One, examiners are now to: (a) Identify the specific limitation(s) in the

construction analysis (above), we determine that the identified limitations describe a scheme for message delivery via a selected receiver-preferred communications application. Message delivery on behalf of a sender to a receiver *per se* is a commercial interaction. It has been ubiquitous in commercial and business circles for decades. A scheme for message delivery also is a manner for managing interactions between people, including following rules or instructions. A commercial interaction and managing interactions between people each falls within the enumerated “[c]ertain methods of organizing human activity” grouping of abstract ideas set forth in the 2019 Revised 101 Guidance.⁹

We note that Appellant includes a section in the Appeal Brief entitled, in part “Independent Claims 1, 11, and 15 recite features that are not directed to ... Certain Methods of Organizing Human Activity.” Appeal Br. 7. We have reviewed the section but have been unable to discern why Appellant

claim under examination (individually or in combination) that the Examiner believes recites an abstract idea.” 84 Fed. Reg. at 54.

⁹ This corresponds to Prong One [“Evaluate Whether the Claim Recites a Judicial Exception”] (b) of Step 2A of the 2019 Revised 101 Guidance. “To determine whether a claim recites an abstract idea in Prong One, examiners are now to: . . . (b) determine whether the identified limitation(s) falls within the subject matter groupings of abstract ideas enumerated in Section I of the [2019 Revised 101 Guidance].” 84 Fed. Reg. at 54. This case implicates subject matter grouping “(b):” “(b) 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).” *Id.* at 52.

believes the claimed subject matter is not directed to a certain method of organizing human activity.

*Technical Improvement*¹⁰ (*Appellant’s Argument*)

Our characterization of what the claim is directed to is similar to that of the Examiner, albeit the Examiner included several claim limitations to the characterization and, thus, characterized it at a lower level of abstraction. “An abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240, 1241 (Fed. Cir. 2016) (“The Board’s slight revision of its abstract idea analysis does not impact the patentability analysis.”).

We have reviewed the record and are unpersuaded as to error in our or the Examiner’s characterization of what claim 15 is directed to.

A principle argument Appellant makes is that the claimed subject matter is not directed to an abstract idea, but rather to an improvement in

¹⁰ This corresponds to Prong Two [“If the Claim Recites a Judicial Exception, Evaluate Whether the Judicial Exception Is Integrated Into a Practical Application”] of Step 2A of the 2019 Revised 101 Guidance. “A claim that integrates a judicial exception into a practical application will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” 84 Fed. Reg. at 54. One consideration, implicated here, that is “indicative that an additional element (or combination of elements) may have integrated the exception into a practical application” is if “[a]n additional element reflects an improvement in the functioning of a computer, or an improvement to other technology or technical field.” *Id.* at 55.

technology. *See* Appeal Br. 9–11. However, we do not find that the record adequately supports it.

Appellant argues that the independent claims “recite a set of rules for the computing device

to intercept a first message sent from a sender via a first communications application and addressed for a planned delivery to a receiver via the first communications application, select a communications application preferred by the receiver to deliver the first message to the receiver, and transmit the first message to the receiver via the preferred communications application instead of via the first communications application.

App Br. 10.

The argument is unpersuasive. While it is true that claim 15 recites “intercept[ing],” “selecting,” and, “transmitting” steps, we do not see these as rules resulting in technological improvements. The steps are recited at a broad functional level, absent technical detail explaining *how* the computing device effects the preferred message delivery. *Cf. Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1346 (Fed. Cir. 2018):

[T]he content data update instructions, which enable updating the displayed information, are recited only at the broadest, functional level, without explaining how that is accomplished, let alone providing a technical means for performing that function. Because the instructions discuss only broad functions and are not directed to any technological improvement for performing those functions, Interval Licensing's reliance on *McRO* is inapposite. In *McRO*, the claim limitations at issue were “limited rules” which “improved technological result[s].” 837 F.3d at 1316. *See SAP Am., Inc.*, 890 F.3d at 1021 (explaining that the claims in *McRO*, besides being directed to physical display improvements, also avoided abstraction by adequate specificity as to how to achieve the improvements).

Appellant argues that

According to the specification, selecting the receiver’s preferred communications application allows sending the message more efficiently and optimized, and thereby saving time and energy for the message delivery system (See *Specification*, at least paragraph [0015]).

Appeal Br. 10.

It is true paragraph 15 of the Specification describes “advantages of the [claimed method that] will cause customer satisfaction with the mobile computing devices, and with the optimized communications applications installed thereon, to increase.” Para. 15. But that alone provides little insight into the technology yielding said advantages. The technical details by which an improvement to technology is achieved is not discussed there. Rather, paragraph 15 of the Specification provides only non-technical *aspirations*, such as “optimiz[ing] the recipient user's utilization of his or her multiple communications applications according to personal preferences.” *Id.* Cf. *Trading Techs. Int’l, Inc. v. IBG LLC*, 921 F.3d 1378, 1384 (Fed. Cir. 2019) (“The claims are focused on providing information to traders in a way that helps them process information more quickly, ’556 patent at 2:26–39, not on improving computers or technology.”).

We have carefully reviewed the claim. Per our previous claim construction analysis, claim 15 is reasonably broadly construed as covering a scheme for selecting a preferred communications application by which to transmit an intercepted message to a receiver. We see no specific asserted improvement in computer capabilities recited in the claim.

The claim provides no additional structural details that would distinguish the recited “a processor of a computing device” (all steps); “a first communications application” (step 1) and, “a preferred communications

application” (step 6) from their generic counterparts.¹¹ See paragraph 9, where the Specification indicates the “computing device” can be “a smartphone or other computing device” and paragraph 25 where “a ‘communications application’ refers generally to a web application, software application, firmware application, or other programming that executes at, or is accessible at, a computing device and that enables communication between users of computing devices.”

With respect to the “intercept[ing],” “selecting,” and, “transmitting” steps, the Specification attributes no special meaning to any of these operations, individually or in combination, as claimed. In our view, consistent with the Specification, these are common computer processing functions that one of ordinary skill in the art at the time of the invention would have known generic computers were capable of performing and would have associated with generic computers. *Cf. OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015):

Beyond the abstract idea of offer-based price optimization, the claims merely recite “well-understood, routine conventional activit[ies],” either by requiring conventional computer activities or routine data-gathering steps. *Alice*, 134 S.Ct. at 2359 (quoting *Mayo*, 132 S.Ct. at 1294). . . . For example, claim 1 recites “sending a first set of electronic messages over a network to devices,” the devices being “programmed to communicate,” storing test results in a “machine-readable medium,” and “using a computerized system . . . to automatically determine” an estimated outcome and setting a price. Just as in *Alice*, “all of

¹¹ *Cf. Move, Inc. v. Real Estate Alliance Ltd.*, 721 F. App’x 950, 954 (Fed. Cir. 2018) (non-precedential) (“Claim 1 is aspirational in nature and devoid of any implementation details or technical description that would permit us to conclude that the claim as a whole is directed to something other than the abstract idea identified by the district court.”).

these computer functions are ‘well-understood, routine, conventional activit[ies]’ previously known to the industry.” *Alice*, 134 S.Ct. at 2359 (quoting *Mayo*, 132 S.Ct. at 1294) (alterations in original); *see also buySAFE[, Inc. v. Google, Inc.]*, 765 F.3d [1350,] 1355 [(Fed. Cir. 2014)] (“That a computer receives and sends the information over a network—with no further [S]pecification—is not even arguably inventive.”).

Accordingly, within the meaning of the 2019 Revised 101 Guidance, we find there is no integration of the abstract idea into a practical application.

The Reply Brief argues, *inter alia*, that “the claims recite a unique operation of the computing device for delivering the messages.” Reply Br. 5. As in the Appeal Brief, Appellant reiterates that the claim recites “intercept[ing],” “selecting,” and, “transmitting” steps, but points to no technical details by which to perform them. *See id.* (“Specifically, claim 1 recites ... [claim 1 is reproduced].” *See also* Reply Brief 6–8, where Appellant repeats the steps recited in the claim.

The difficulty with such an argument is that it points to the recited steps (“intercept[ing],” “selecting,” and, “transmitting”) themselves, the very subject matter that we, and the Examiner, have characterized as being an abstract idea. Rather than showing that these steps describe a technical improvement, the Appellant points to the steps’ result-based functional language without pointing to any means for achieving any purported technological improvement. The claimed invention the Appellant points to — that is, selecting receiver-preferred communications application for delivering a message — is described by the claim via a scheme (“intercept[ing],” “selecting,” and, “transmitting”) for selecting a preferred

communications application by which to transmit an intercepted message to a receiver.

By setting out what it is aspiring to accomplish without any means for achieving it, let alone any purported technological improvement, the claim is in effect presenting the invention in purely result-based functional language, strengthening our determination under *Alice* step one that the claim is directed to an abstract idea. *Cf. Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1337 (Fed. Cir. 2017) (“Claim 1 recites a method for routing information using result-based functional language. The claim requires the functional results of ‘converting,’ ‘routing,’ ‘controlling,’ ‘monitoring,’ and ‘accumulating records,’ but does not sufficiently describe how to achieve these results in a non-abstract way.”). *See also Uniloc USA v. LG Elecs. USA*, 957 F.3d 1303, 1308 (Fed. Cir. 2020):

The claims we held ineligible in *Two-Way Media* similarly failed to concretely capture any improvement in computer functionality. In *Two-Way Media*, the claims recited a method of transmitting packets of information over a communications network comprising: converting information into streams of digital packets; routing the streams to users; controlling the routing; and monitoring the reception of packets by the users. 874 F.3d at 1334. *Two-Way Media* argued that the claims solved data transmission problems, including load management and bottlenecking, but the claimed method was not directed to those improvements. *Id.* at 1336–37. We therefore held the claims ineligible because they merely recited a series of abstract steps (“converting,” “routing,” “controlling,” “monitoring,” and “accumulating records”) using “result-based functional language” without the means for achieving any purported technological improvement. *Id.* at 1337.

Appellant’s technical-improvement argument is unpersuasive as to error in the Examiner’s or our characterization of what the claim is directed

to because the disclosure Appellant directs us to (i.e., paragraph 15 of the Specification) fails to adequately support it for the subject matter as broadly as it is claimed. We are unable to point to any claim language suggestive of an improvement in technology. An argument that such an improvement exists is alone insufficient. *See generally In re Glass*, 474 F.2d 1015, 1019 (CCPA 1973); *see also In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974); and *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); and *In re Schulze*, 346 F.2d 600, 602 (CCPA 1965).

For the foregoing reasons, we unpersuaded that “the claims recite a unique operation of the computing device for delivering the messages” (Reply Br. 5) and that “the claims recite specific details for the computing device to perform.” (*id.* at 8).

We have considered Appellant’s other arguments challenging the Examiner’s determination under step one of the *Alice* framework and find them unpersuasive. For the foregoing reasons, the record supports the Examiner’s determination that claim 15 is directed to an abstract idea.

*Alice step two — Does the Claim Provide an Inventive Concept?*¹²

Step two is “a search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in

¹² This corresponds to Step 2B, of the 2019 Revised 101 Guidance, 84 Fed. Reg. at 56 “if a claim has been determined to be directed to a judicial exception under revised Step 2A, examiners should then evaluate the additional elements individually and in combination under Step 2B to determine whether they provide an inventive concept (*i.e.*, whether the additional elements amount to significantly more than the exception itself).”

practice amounts to significantly more than a patent upon the [ineligible concept] itself.” *Alice*, 573 U.S. at 217–18 (quoting *Mayo*, 566 U.S. at 73).

In that regard, the Examiner determined that

Claims 1-18 do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional elements when considered both individually and as an ordered combination do not amount to significantly more than the abstract idea. The additional elements of the "processor", "memory", "communication application(s)", "communication network" and "non-transitory computer readable medium" are generically-recited computer related elements that amount to a mere instruction to "apply it" (the abstract idea) on the computer-related elements (see MPEP § 2106.05 (f) Mere Instructions to Apply an Exception). ... There is no indication that the combination of elements improves the functioning of a computer or improves any other technology.

Final Act. 18–19. We agree.

We addressed the matter of whether there were any purported specific asserted improvements in computer capabilities in our analysis above under step one of the *Alice* framework. This is consistent with the case law. *See Ancora Techs., Inc. v. HTC Am., Inc.*, 908 F.3d 1343, 1347 (Fed. Cir. 2018) (“We have several times held claims to pass muster under *Alice* step one when sufficiently focused on such improvements.”). Such an argument can also challenge a determination under step two of the *Alice* framework. *See buySAFE*, 765 F.3d at 1354–55. “[R]ecent Federal Circuit jurisprudence has indicated that eligible subject matter can often be identified either at the first or the second step of the *Alice/Mayo* [framework].” *See* 2019 Revised 101 Guidance 53, n.17.

Be that as it may, we are unpersuaded that claim 15 presents an element or combination of elements indicative of a specific asserted

improvement in computer capabilities, thereby rendering the claimed subject matter sufficient to ensure that the patent in practice amounts to significantly more than a patent upon message delivery via a selected receiver-preferred communications application employing “a processor of a computing device” (all steps); “a first communications application” (step 1) and, “a preferred communications application” (step 6).

We have reviewed paragraph 15 of the Specification and, as explained above, we can find no suggestion of any improvements to the system as a result of performing the functions as broadly as they are recited.

We cited the Specification in our earlier discussion. It is intrinsic evidence that the claimed “a processor of a computing device” (all steps); “a first communications application” (step 1.) and, “a preferred communications application” (step 6.) as claimed are conventional. In doing so, we have followed “Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP Inc.*[], 881 F.3d 1360 (Fed. Cir. 2018)],” USPTO Memorandum, Robert W. Bahr, Deputy Commissioner For Patent Examination Policy, April 19, 2018 (the “Berkheimer Memo”).

The court in *Berkheimer* held that “[t]he patent eligibility inquiry may contain underlying issues of fact.” *See Berkheimer*, 881 F.3d at 1365 (quoting *Mortgage Grader, Inc. v. First Choice Loan Services Inc.*, 811 F.3d 1314, 1325 (Fed. Cir. 2016) (“The § 101 inquiry ‘*may* contain underlying factual issues.’”)). But the court also held that “[w]hen there is *no genuine issue of material fact* regarding whether the claim element or claimed combination is well-understood, routine, [and] conventional to a skilled artisan in the relevant field, this issue can be decided on summary judgment

as a matter of law.” *Berkheimer*, 881 F.3d at 1368 (emphasis added). This qualification has been subsequently reiterated.

If there is a genuine dispute of material fact, Rule 56 requires that summary judgment be denied. In *Berkheimer*, there was such a genuine dispute for claims 4–7, but not for claims 1–3 and 9.

....

[I]n accordance with *Alice*, we have repeatedly recognized the absence of a genuine dispute as to eligibility for the many claims that have been defended as involving an inventive concept based merely on the idea of using existing computers or the Internet to carry out conventional processes, with no alteration of computer functionality.

Berkheimer, 890 F.3d 1369, 1371–73 (Fed. Cir. 2018) (Order, On Petition for rehearing en banc, May 31, 2018 (J. Moore concurring)); *see also Aatrix Software, Inc. v. Green Shades Software, Inc.*, 890 F.3d 1354, 1368 (Fed. Cir. 2018) (Order On Petition for Rehearing En Banc) (Reyna, J., dissenting) (“A factual allegation or dispute should not automatically take the determination out of the court’s hands; rather, there needs to be justification for why additional evidence must be considered—the default being a legal determination.”).

Here, the Specification indisputably shows the recited “a processor of a computing device” (all steps); “a first communications application” (step 1.) and, “a preferred communications application” (step 6.) individually and in combination in the context as claimed was conventional at the time of filing. Accordingly, there is sufficient factual support for the well-understood, routine, or conventional nature of the claimed “a processor of a computing device” (all steps); “a first communications application” (step 1)

and, “a preferred communications application” (step 6), individually or in the combination as claimed.

According to Appellant, “the prior art documents cited in the Office Action do not teach or suggest at least the combination of features recited above. As such, these features constitute a non-conventional and non-generic arrangement and, thus, an improvement in the computer-related technology.” Appeal Br. 11–12. According to Appellant, based in part on *BASCOM Global Internet Services v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), “the combination of features recited in independent claims 1, 11, and 15 amounts to significantly more than the abstract idea alleged by the Examiner.” *Id.* at 12.

We reverse below the anticipation rejection. In that regard, claim limitations found to be novel (or nonobvious) can affect a patent-eligibility determination. *Cf. Ariosa Diagnostics, Inc., v. Sequenom, Inc.*, 788 F.3d 1371 (Fed. Cir. 2015) (“For process claims that encompass natural phenomenon, the process steps are the additional features that must be new and useful.”) Thus, novelty is a factor to be considered when determining “whether the claims contain an ‘inventive concept’ to ‘transform’ the claimed abstract idea into patent-eligible subject matter.” *Ultramercial, Inc. v. Hutu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014). “[N]ovelty in implementation of the idea is a factor to be considered only in the second step of the Alice analysis.” *Id.*

However, although “‘the § 101 patent-eligibility inquiry and, say, the § 102 novelty inquiry might sometimes overlap,’ . . . a claim for a new abstract idea is still an abstract idea.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (citation omitted) (quoting *Mayo*, 566 U.S. at

90). A finding of novelty (or nonobviousness) does not necessarily lead to the conclusion that subject matter is patentable eligible. “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2117 (2013).

Indeed, “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (emphasis added); see also *Mayo*, 132 S. Ct. at 1303–04 (rejecting “the Government’s invitation to substitute §§ 102, 103, and 112 inquiries for the better established inquiry under § 101”). Here, the jury’s general finding that Symantec did not prove by clear and convincing evidence that three particular prior art references do not disclose all the limitations of or render obvious the asserted claims does not resolve the question of whether the claims embody an inventive concept at the second step of Mayo/Alice.

Intellectual Ventures I LLC v. Symantec Corp., 838 F.3d 1307, 1315 (Fed. Cir. 2016).

The question in step two of the *Alice* framework is not whether an additional feature is novel but whether the implementation of the abstract idea involves “more than the performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1347–48 (quoting *Alice*, 134 S. Ct. at 2359).

In that regard, Appellant points, *inter alia*, to the selecting steps as a feature which the prior art does not teach. We agree for the reasons discussed below. But said selecting step is a feature of the abstract idea. As such, the selecting step does not add significantly more to the abstract idea.

In our view, Appellant has not shown this “novel” selecting transforms the abstract idea into patent-eligible subject matter. *Cf. Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1265 (Fed. Cir. 2016).

In arguing that the '379 patent contains an “inventive concept,” Affinity relies on this court’s recent decision in *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016). The patent in that case was directed to systems for filtering content on the Internet. The claims provided for individually customizable filtering on a remote Internet service provider server.

Addressing the “abstract idea” step, the court held that filtering content is an abstract idea, and that it remained an abstract idea even when placed in the context of an Internet computer network. *Id.* at 1348. The court deferred its discussion of the specific limitations of the claims until the second step of the analysis. *Id.* at 1349.

With respect to that step, the court held that the claims disclosed an “inventive concept,” consisting of “the installation of a filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each end user.” *Id.* at 1350. The invention took advantage of the ability of some Internet service providers to associate a request for Internet content with a specific individual account. Exploiting that capability, the invention was able to provide customized filtering by locating the filtering system on the Internet service provider’s server. The specificity of the technical solution provided by the claims in *BASCOM* stands in sharp contrast to the absence of any such specific technical solution in the claims of the '379 patent.

In applying the principles emerging from the developing body of law on abstract ideas under section 101, this court has noted that claims that are “so result-focused, so functional, as to effectively cover any solution to an identified problem” are frequently held ineligible under section 101. *Elec. Power Grp.*, op. at 1356. That is true in this case, as the claims are drafted in a way that would

effectively cover any wireless delivery of out-of-region broadcasting content to a cellular telephone via a network.

The only limitations on the breadth of the result-focused, functional claims in this case are (1) that the application used by the cellular telephone must be wirelessly downloadable, and (2) that the cellular telephone must have a graphical user interface display that allows the user to select the regional broadcasting channel. Those additional limitations describe purely conventional features of cellular telephones and the applications that enable them to perform particular functions. They therefore do not meaningfully limit the scope of the claims.

No other persuasive arguments having been presented, we conclude that no error has been committed in the determination under *Alice* step two that claim 1 does not include an element or combination of elements circumscribing the patent-ineligible concept it is directed to so as to transform the concept into an inventive application.

We have considered all of the Appellant’s arguments (including those made in the Reply Brief) and find them unpersuasive.

Accordingly, because we are not persuaded as to error in the determinations that representative claim 15, and claims 1–14 and 16–18 which stand or fall with claim 15, are directed to an abstract idea and do not present an “inventive concept,” we sustain the Examiner’s conclusion that they are directed to patent-ineligible subject matter for being judicially-excepted from 35 U.S.C. § 101. *Cf. LendingTree, LLC v. Zillow, Inc.*, 656 F. App’x 991, 997 (Fed. Cir. 2016) (“We have considered all of LendingTree’s remaining arguments and have found them unpersuasive. Accordingly, because the asserted claims of the patents in suit are directed to an abstract idea and do not present an ‘inventive concept,’ we hold that they are directed to ineligible subject matter under 35 U.S.C. § 101.”); *see, e.g., OIP Techs.*,

788 F.3d at 1364; *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016).

The rejection of claims 1–18 under 35 U.S.C. § 102(a)(2) as being anticipated by Luna.

All the claims call for consideration of “past behaviors data” of a receiver with respect to a plurality of communication applications in selecting a communications application preferred by the receiver to deliver a message.

The Examiner finds said consideration is described at “Fig. 1A; Fig. 1 F; Fig. 2A; Fig. 28; Figs. 3A-38; Fig. 5; Figs.10A; Fig. 108; Fig. 10C; ¶ [0074-0078]; ¶ [0136-0139]; ¶ [0140-0144]; ¶ [0194-0197].” Final Act. 23. Specifically, the Examiner states that “Luna notes the user profiles list the different users 191 and the tracked application types 192. The user behavior habits 193 can be tracked for different applications/application types. The application timing parameters 194 may be associated with the tracked behavior/habit 193.” *Id.* (repeating the disclosure at paragraph 75 of Luna).

Appellant disagrees. According to Appellant, “Luna's system allocates an optimized "bandwidth" in a wireless network for delivering messages to the user based on the user's past behavior.” Appeal Br. 14. “[C]ontrary to the assertion by the Examiner, Luna fails to teach, ‘in response to a determination that first message is addressed for delivery to the receiver, select a communications application preferred by the receiver to deliver the first message to the receiver,’” *Id.* (quoting claim 1). Appellant adds that “becoming aware of the mobile device’s radio states and deciding whether the mobile device’s radio needs to be activated are unrelated to the

mobile device's "past behaviors" data, as recited in claim 1 because the radio's state is not a past behavior of the mobile device.” Reply Br. 10.

We have reviewed Luna. The record supports Appellant’s position.

We do not see Luna describing, expressly or inherently, using “past behaviors data” of a receiver with respect to a plurality of communication applications in selecting a communications application preferred by the receiver to deliver a message. Rather, as Appellant indicates, Luna appears to disclose, for example, employing a user’s usage habits/behaviors in allocating resources to the user in a wireless network. *See, e.g.*, para. 357

In process 2312, the resource allocated to the user in the wireless network based on the user behavior is controlled with respect to the mobile usage. In general, the resource is allocated to the user for subsequent sessions of mobile usage, regardless of whether the subsequent sessions occur on a same device as when the user behavior was tracked for the user. In some instances, resource allocation to the user may be device specific, provided that the user has different usage habits/behaviors or detectable.[sic]/trackable patterns for different devices.

Furthermore, as Appellant argues, the “past behaviors data” as claimed refers to a receiver with respect to a plurality of communication applications. By contrast, Luna’s user’s usage habits/behaviors refer to the resources used with respect to a network. This is not the same thing.

There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). Because of the aforementioned differences, Luna does not anticipate the claimed subject matter.

CONCLUSION

The decision of the Examiner to reject claims 1–18 is affirmed.

More specifically:

The rejection of claims 1–18 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter is affirmed.

The rejection of claims 1–18 under 35 U.S.C. § 102(a)(2) as being anticipated by Luna is reversed.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–18	101	Eligibility	1–18	
1–18	102	Luna		1–18
Overall Outcome			1–18	

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED