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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* BENJAMIN DAVID FOLLIS

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Appeal 2019-005671  
Application 14/316,317  
Technology Center 3600

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Before JOHN A. EVANS, JASON J. CHUNG, and  
SCOTT B. HOWARD, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals the Final Rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

INVENTION

The claimed invention relates to electronic contracts. Spec. ¶ 1. More specifically, the content of an electronic contract may be altered with a clause specifying a jurisdiction based on a mapping received from a sender

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. According to Appellant, Adobe Inc. is the real party in interest. Appeal Br. 3.

or a signer. Spec. ¶¶ 3, 27–29. Claim 20 is illustrative of the invention and is reproduced below:

20. A computer-implemented system comprising:  
*one or more processors*; and  
*a non-transitory computer storage medium* storing computer-useable instructions that, when used by the one or more processors, cause the one or more processors to operations comprising:

- storing in *a database by a jurisdiction computer system*, a sender mapping received from *a sender device* and a signer mapping received from *a signer device*, the sender mapping associating a contract class to first one or more jurisdictions and the signer mapping associating the contract class to second one or more jurisdictions;
- analyzing, by the jurisdiction computer system, terms of a digital contract document to identify keywords in the terms, the digital contract document being sent by a sender to a signer for electronic signature or signed by the signer using the jurisdiction computer system;
- automatically determining, by the jurisdiction computer system, a contract class of the digital contract document and a jurisdiction specified in the terms of the digital contract document based on the identified keywords;
- automatically determining, by the jurisdiction computer system, using the sender mapping and the signer mapping from the database, the specified jurisdiction fails to match at least one of the first one or more jurisdictions and the second one or more jurisdictions associated with the determined contract class;
- automatically determining, by the jurisdiction computer system, a new jurisdiction based on the new jurisdiction matching both the sender mapping and the signer mapping for the contract class;
- based on the analyzing, altering, by the jurisdiction computer system, the terms of the digital contract document to include a clause specifying the new jurisdiction;

transmitting, by the jurisdiction computer system, a notification to at least one of the sender and the signer of the altering of the terms; and  
sending over *a network*, by the jurisdiction computer system, the digital contract document comprising the clause to the signer.

Appeal Br. 31–33 (Claims App.) (emphases added to indicate additional, i.e., non-abstract, elements).

### REJECTIONS

Claims 15–17 stand rejected under 35 U.S.C. § 112(b) as being indefinite for failing to point out and distinctly claim the subject matter which the inventor regards as the invention. Final Act. 2–3.

Claims 1–20 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 3–8.

### ANALYSIS

We have only considered those arguments that Appellant actually raised in the Briefs.<sup>2,3</sup> 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) (2019).

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<sup>2</sup> In the instant appeal, claims 1–19 are not argued separately from claim 20 in either of Appellant’s Briefs (Appeal Br. 10–26; Reply Br. 2–8), and will not be addressed separately.

<sup>3</sup> Appellant does not provide page numbers in the Reply Brief. We numbered the pages in the Reply Brief in consecutive order starting from page 1 on the first page up to page 8, with the “Remarks” commencing on page 2. We refer to those page numbers in our Decision.

*SECTION 112 REJECTION*

“Indefiniteness under 35 U.S.C. § 112[(b)] is an issue of claim construction and a question of law that we review de novo.” *Cordis Corp. v. Boston Sci. Corp.*, 561 F.3d 1319, 1331 (Fed. Cir. 2009) (citing *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1319 (Fed. Cir. 2008)).

We agree with the Examiner’s determination that “the method” lacks antecedent basis in claim 15. Final Act. 3.

However, we disagree as a matter of law with the Examiner’s indefiniteness rejection of claim 15 for the term “a jurisdiction service.” *Id.* Here, Appellant’s Specification provides that “[a] ‘jurisdiction service’ refers to an on-line service that is accessed via a network by senders and/or signers to provide the benefits described herein.” Spec. ¶ 15. In view of the description provided in paragraph 15 of the Specification, a skilled artisan would understand the metes and bounds of the claim language. *See id.* As long as those of ordinary skill in the art would understand that a jurisdiction service refers to an on-line service that is accessed via a network by senders and/or signers, 35 U.S.C. § 112(b) requires nothing more. *See Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986).

Although we conclude that the skilled artisan, upon reading the claims in light of the Specification, would be able to ascertain the scope of the claimed invention, specifically the term “a jurisdiction service” in claim 15, we sustain the Examiner’s rejection of claims 15–17 under 35 U.S.C. § 112(b), in view of the lack of antecedent basis for “the method” in claim 15.

*SECTION 101 REJECTION*

*A. Principles of Law*

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101.

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*. *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, 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 waterproof 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 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.* (citation omitted) (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.* (alterations in original) (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 Section 101 Guidance*

In January 2019, the U.S. Patent and Trademark Office (USPTO) published revised guidance on the application of § 101. 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“2019 Revised Guidance”).<sup>4</sup> “All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.” *Id.* at 51; *see also* Update at 1.

Under the 2019 Revised Guidance and the Update, 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) (“Step 2A, Prong One”); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h) (9th ed. Rev. 08.2017, Jan. 2018)) (“Step 2A, Prong Two”).<sup>5</sup>

2019 Revised Guidance, 84 Fed. Reg. at 52–55.

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<sup>4</sup> In response to received public comments, the Office issued further guidance on October 17, 2019, clarifying the 2019 Revised Guidance. USPTO, *October 2019 Update: Subject Matter Eligibility* (“Update”) (available at [https://www.uspto.gov/sites/default/files/documents/peg\\_oct\\_2019\\_update.pdf](https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf)).

<sup>5</sup> 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 Revised Guidance - Section III(A)(2), 84 Fed. Reg. at 54–55.



Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look, under Step 2B, 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.

2019 Revised Guidance, 84 Fed. Reg. at 52–56.

*C. The Examiner’s Rejection and Appellant’s Arguments*

The Examiner concludes that the claims recite mental processes. Final Act. 4–7; Ans. 4–6. The Examiner additionally concludes that the additional elements in the claims, considered individually and as a whole, do not integrate the abstract idea into a practical application, because they are generic components that do not provide an improvement to a technology or technical field or provide meaningful limitations. Final Act. 6–7; Ans. 6–7 (citing Spec. ¶ 43). The Examiner concludes that the additional elements do not offer significantly more than the abstract idea, because they amount to mere instructions to apply the exception using generic computer components. Final Act. 7–8; Ans. 8.

Appellant disagrees, arguing that the claims are not directed to an abstract idea, because they are specifically directed to a technical solution for “ensuring that a digital cont[r]act document being sent by a sender to a signer for electronic signature or signed by the signer includes a clause with an appropriate jurisdiction for its contract class.” Appeal Br. 13, 16, 17, 19;

*see also* Reply Br. 5–6. Appellant contends that the claims focus on mapping and how it improves the technology of electronic signatures (Appeal Br. 19), and recite a particular way to achieve the technical solution. *Id.* at 20–22; Reply Br. 2–5, 7–8 (citing *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016)). Furthermore, Appellant argues that the present claims allow computer performance of a function not previously performable, citing a lack of an anticipation or obviousness rejection.

Appeal Br. 21, 25; Reply Br. 4. Appellant additionally argues that the claim elements are not well-understood, routine, and conventional, but instead represent an unconventional technological approach to ensure that a digital contract document includes a particular clause, such as one with an appropriate jurisdiction. Appeal Br. 22–25 (citing *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016); *Amdocs (Isr.) Ltd. V. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016)). Appellant contends that the present claims additionally “do not foreclose alternative solutions.” Appeal Br. 25.

*D. Step 2A, Prong One*

Patent eligibility under 35 U.S.C. § 101 is a question of law that is reviewable *de novo*. *See Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012). Claim 20 requires storing a sender mapping and a signer mapping, the mappings associating a contract class to first and second one or more jurisdictions; analyzing terms of a digital contract document to identify keywords; determining a contract class of the digital contract document and a jurisdiction based on the identified keywords; determining, using the sender and signer mappings, the specified jurisdiction fails to match at least one of the first or second one or more jurisdictions; determining a new

jurisdiction; altering the terms of the digital contract document to include a clause specifying the new jurisdiction; transmitting a notification; and sending the digital contract document. We, therefore, conclude the non-emphasized portions of claim 20, reproduced above (*see supra* at 2–3), recite concepts relating to commercial or legal interactions or concepts that can be practically performed in the human mind with the assistance of using pen and paper. *See* 2019 Revised Guidance, 84 Fed. Reg. at 52 n.14.

The present claims recite concepts relating to commercial or legal interactions, which fall into the category of certain methods of organizing human activity. *See id.* Moreover, those certain methods of organizing human activity are a type of abstract idea. *See id.* Namely, the claims recite features such as, “storing . . . a sender mapping . . . and a signer mapping . . . , the sender mapping associating a contract class to first one or more jurisdictions and the signer mapping associating the contract class to second one or more jurisdictions;” “analyzing . . . terms of a digital contract document to identify keywords in the terms, the digital cont[r]act document being sent by a sender to a signer for electronic signature or signed by the signer”; “automatically determining . . . a contract class of the digital contract document and a jurisdiction specified in the terms of the digital contract document based on the identified keywords;” “automatically determining . . . using the sender mapping and the signer mapping . . . the specified jurisdiction fails to match at least one of the first one or more jurisdictions and the second one or more jurisdictions associated with the determined contract class;” “automatically determining . . . a new jurisdiction based on the new jurisdiction matching both the sender mapping and the signer mapping for the contract class;” “based on the analyzing,

altering . . . the terms of the digital contract document to include a clause specifying the new jurisdiction;” “transmitting . . . a notification to at least one of the sender and the signer of the altering of the terms;” and “sending . . . the digital contract document comprising the clause to the signer,” which recite agreements in the form of contracts, and therefore fall under certain methods of organizing human activity.

Further, the present claims recite concepts that can be performed in the mind or by using pen and paper, which are concepts performed in the human mind (including an observation, evaluation, judgment, opinion). Concepts performed in the human mind fall under the category of mental processes (i.e., an abstract idea). Namely, the claims require features such as, “[a] sender mapping associating a contract class to first one or more jurisdictions and the signer mapping associating the contract class to second one or more jurisdictions;” “analyzing . . . terms of a digital contract document to identify keywords in the terms, the digital cont[r]act document being sent by a sender to a signer”; “determining . . . a contract class of the digital contract document and a jurisdiction specified in the terms of the digital contract document based on the identified keywords;” “determining . . . using the sender mapping and the signer mapping . . . the specified jurisdiction fails to match at least one of the first one or more jurisdictions and the second one or more jurisdictions associated with the determined contract class;” “determining . . . a new jurisdiction based on the new jurisdiction matching both the sender mapping and the signer mapping for the contract class;” “based on the analyzing, altering . . . the terms of the digital contract document to include a clause specifying the new jurisdiction;” “transmitting . . . a notification to at least one of the sender and

the signer of the altering of the terms;” and “sending . . . the digital contract document comprising the clause to the signer,” which are all features that can be performed practically in the human mind with the assistance of using pen and paper, and, therefore, are abstract ideas. In particular, these claim features are similar to tasks that humans in the legal or contract-drafting profession have routinely and for many years performed mentally or with pen and paper. In other words, including jurisdiction-specific clauses in contracts has been routinely performed by humans.

We are therefore not persuaded by Appellant’s argument that the steps involved in the claims are not analogous to human mental work (Appeal Br. 14), for the reasons discussed above. Namely, humans have routinely included appropriate jurisdiction-specific clauses in contracts based on the mapping of the sender and the signer and the content of the contract, i.e., a contract class.

We must still determine whether the abstract idea is integrated into a practical application, namely, whether the claim applies, relies on, or uses the abstract idea in a manner that imposes a meaningful limit on the abstract idea, such that the claim is more than a drafting effort designed to monopolize the abstract idea. *See* 2019 Revised Guidance, 84 Fed. Reg. at 54–55. We therefore (1) identify whether there are any additional recited elements beyond the abstract idea, and (2) evaluate those elements both individually and collectively to determine whether they integrate the exception into a practical application. *See id.*

Accordingly, we proceed to Prong Two.

*E. Step 2A, Prong Two*

Here, the only elements in the claims beyond the abstract idea are

“one or more processors,” “a non-transitory computer storage medium,” “a database,” “a jurisdiction computer system,” “a sender device,” “a signer device,” and “a network.” *See* 2019 Revised Guidance, 84 Fed. Reg. at 52. The additional elements of 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 for the following reasons.

Appellant does not identify persuasively how the Specification sets forth an improvement in technology. The Update addresses how we consider evidence of improvement that is presented to us. The Update states

*the evaluation of Prong Two requires the use of the considerations (e.g. improving technology, effecting a particular treatment or prophylaxis, implementing with a particular machine, etc.) identified by the Supreme Court and the Federal Circuit, to ensure that the claim as a whole “integrates [the] judicial exception into a practical application [that] 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.*

Update at 11 (emphases added). The Update further states:

During 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.

*Id.* at 13 (emphasis added) (footnote omitted).

Here, the Examiner concludes that the additional elements, when considered individually or as an ordered combination, “do not recite an improvement to another technology or technical field, an improvement to the functioning of any computer itself, or provide meaningful limitations beyond generally linking an abstract idea . . . to a particular technological environment.” Final Act. 7; Ans. 7 (citing Spec. ¶ 43). Consequently, we focus on any evidence Appellant cites, as discussed in the Update.

In this case, Appellant argues that the claimed invention ensures that a digital contract document includes a clause with an appropriate jurisdiction for its contract class and focuses on the mappings and how they are used. Appeal Br. 11, 16–19. However, these alleged improvements are improvements in agreements in the form of contracts, which fall within the category of an abstract idea, as discussed *supra*, not an improvement to technology. “[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). “[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).

Furthermore, the additional elements in the present claims, namely “processors,” “non-transitory computer storage medium,” “database,” “jurisdiction computer system,” “sender device,” “signer device,” and “network,” do not, either individually or in combination, integrate the abstract idea into a practical application. Appellant’s Specification discloses that these elements encompass generic components, such as generic processors (Spec. ¶¶ 25–26, 44, 46, Fig. 6), a generic non-transitory computer storage medium (*id.* at ¶¶ 43, 45), a generic database (*id.* at ¶¶ 18, 26, Fig. 1), a generic jurisdiction computer system (*id.* at ¶¶ 25, 44–47, Fig. 6), generic sender and signer devices (*id.* at ¶ 26, Fig. 1), and a generic network (*id.*). Merely adding generic hardware and computer components to perform abstract ideas does not integrate those ideas into a practical application. *See* 2019 Revised Guidance, 84 Fed. Reg. at 55 (identifying “merely includ[ing] instructions to implement an abstract idea on a computer” as an example of when an abstract idea has not been integrated into a practical application).

We disagree with Appellant’s argument that, similar to the claims in *McRO*, the present claims recite an improvement in allowing computers to automatically determine an improper jurisdiction specified in a contract and incorporate an appropriate new jurisdiction, which previously could only be done by human actors. Appeal Br. 20–22; Reply Br. 2–6. In particular, Appellant argues that the claims are similar to those in *McRO*, because they improve the prior art using rules, rather than humans, to implement the claimed steps. Reply Br. 4. 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 1313. Notably, the court in *McRO* determined that the process required by the claims was not a process previously used by human animators. *Id.* at 1314. As such, the court determined that the present claims were “unlike *Flook*, *Bilski*, and *Alice*, where the claimed computer-automated process and the prior art method were carried out in the same way.” *Id.* at 1314–15 (emphasis added). Therefore, 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.

Here, in contrast to *McRO*, the present claims do not recite a computer-automated process that uses rules unlike those previously employed by humans. As discussed *supra*, the claimed process recites rules such as, “the sender mapping associating a contract class to first one or more jurisdictions and the signer mapping associating the contract class to second one or more jurisdictions;” “analyzing . . . terms of a digital contract document to identify keywords in the terms, the digital cont[r]act document being sent by a sender to a signer”; “determining . . . a contract class of the digital contract document and a jurisdiction specified in the terms of the digital contract document based on the identified keywords;” “determining . . . using the sender mapping and the signer mapping . . . the specified jurisdiction fails to match at least one of the first one or more jurisdictions and the second one or more jurisdictions associated with the determined

contract class;” “determining . . . a new jurisdiction based on the new jurisdiction matching both the sender mapping and the signer mapping for the contract class;” “based on the analyzing, altering . . . the terms of the digital contract document to include a clause specifying the new jurisdiction;” “transmitting . . . a notification to at least one of the sender and the signer of the altering of the terms;” and “sending . . . the digital contract document comprising the clause to the signer,” which are all rules routinely performed by human contract drafters to incorporate correct or appropriate jurisdiction clauses, based on the sender and signer jurisdictions and the jurisdiction for the type of contract, into legal contracts.

Furthermore, Appellant’s argument that the Examiner has not applied prior art to anticipate or render obvious the present claims (Appeal Br. 21, 25; Reply Br. 4) improperly conflates the requirements for eligible subject matter (§ 101) with the independent requirements of novelty (§ 102) and non-obviousness (§ 103). “The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diehr*, 450 U.S. at 188–89; *see also Genetic*, 818 F.3d at 1376 (stating that, “under the *Mayo/Alice* framework, a claim directed to a newly discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the novelty of that discovery for the inventive concept necessary for patent eligibility”).

Appellant’s argument that the present claims do not preempt any abstract idea (Appeal Br. 25; Reply Br. 4, 7) does not persuade us that the claims are eligible. Although preemption may denote patent ineligibility, its absence does not demonstrate patent eligibility. *See FairWarning, IP, LLC v.*

*Iatric Sys., Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016). For claims covering a patent-ineligible concept, preemption concerns “are fully addressed and made moot” by an analysis under the *Mayo/Alice* framework. *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015).

Appellant does not make any other arguments pertaining to Step 2A, Prong Two. Because the present claims recite an abstract idea that is not integrated into a practical application, we proceed to Step 2B.

*F. Step 2B*

We disagree with Appellant’s argument that that the additional elements are not well-understood, routine, and conventional or include unconventional steps that amount to significantly more than the abstract idea. Appeal Br. 22–24 (citing *BASCOM, Amdocs*).

Here, the Examiner finds that the additional elements amount to mere instructions to apply the exception using generic computer components, which cannot provide an inventive concept. Ans. 7–8 (citing Spec. ¶ 43). An inventive concept “cannot be furnished by the unpatentable law of nature (or natural phenomenon or abstract idea) itself.” *Genetic*, 818 F.3d at 1376; see also 2019 Revised Guidance, 84 Fed. Reg. at 56; *Alice*, 573 U.S. at 217 (explaining that, after determining a claim is directed to a judicial exception, “we then ask, ‘[w]hat else is there in the claims before us?’” (alteration in original) (quoting *Mayo*, 566 U.S. at 78)). Instead, an “inventive concept” is furnished by an element or combination of elements that is recited in the claim in addition to the judicial exception and sufficient to ensure the claim as a whole amounts to significantly more than the judicial exception itself. *Alice*, 573 U.S. at 218–19 (citing *Mayo*, 566 U.S. at 72–73); see *BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018) (explaining

that the Supreme Court in *Alice* “only assessed whether the claim limitations other than the invention’s use of the ineligible concept to which it was directed were well-understood, routine and conventional” (emphasis added)). Because the present claims merely use generic computer components in a conventional manner, we disagree with Appellant’s argument that the claims overcome the deficiencies of existing electronic signature systems (Appeal Br. 11, 24).

Furthermore, we disagree with Appellant’s argument that the additional elements are not well-understood, routine, and conventional (Appeal Br. 22–24), because the Specification explains that “processors,” “non-transitory computer storage medium,” “database,” “jurisdiction computer system,” “sender device,” “signer device,” and “network” are generic computer components and describes the additional elements at a high level of generality. Spec. ¶¶ 18, 25–26, 43–47, Figs. 1, 6. We, therefore, find that “processors,” “non-transitory computer storage medium,” “database,” “jurisdiction computer system,” “sender device,” “signer device,” and “network” are additional elements that are well-understood, routine, and conventional. *Id.*

We disagree with Appellant’s contention that the present claims, similar to those in *BASCOM*, use a specific method that is not conventional or generic. Appeal Br. 23. In *BASCOM*, 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, however, the present claims recite an abstract idea using additional elements that are generic computer components as discussed *supra*, or at best, improving an abstract idea—not an inventive concept for the reasons discussed above.

We also disagree with Appellant’s argument that, similar to *Amdocs*, the present claims provide an unconventional technological solution to a technological problem. Appeal Br. 23–24. The subject claim considered by the *Amdocs* court related to distributed architecture that led to load distribution, which was an advantage over the prior art because it made it easier to keep up with record flows, allowed for smaller databases, and minimized impact on network and system resources. *Amdocs (Isr.) Ltd.*, 841 F.3d at 1303. Additionally, the court construed the claimed “enhance” to mean “to apply a number of field enhancements in a distributed fashion.” *Id.* at 1292, 1300. In contrast to the claims of *Amdocs*, the present claims do not pertain to components working together in an unconventional distributed fashion. Instead, the claims are directed to components that work together in a conventional fashion—collecting data from known and routinely-used sources of determining an appropriate jurisdiction—to improve the abstract idea of contract drafting. Accordingly, Appellant’s assertions and citations to *BASCOM* and *Amdocs* fail to identify error in the Examiner’s analysis.

For at least the above reasons, we conclude, under the 2019 Revised Guidance, that each of Appellant’s claims 1–20, considered as a whole, is

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directed to a patent-ineligible abstract idea that is not integrated into a practical application, and does not include an inventive concept. We therefore sustain the Examiner's rejection of claims 1–20 under 35 U.S.C. § 101.

### CONCLUSION

<b>Claim(s) Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
15–17	112(b)	Indefiniteness	15–17	
1–20	101	Eligibility	1–20	
<b>Overall Outcome</b>			1–20	

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