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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* BRIAN COLODNY and MICHAEL McLAUGHLIN

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Appeal 2020-000386  
Application 13/224,244  
Technology Center 3600

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Before MAHSHID D. SAADAT, JOHN A. JEFFERY, and  
LINZY T. McCARTNEY, *Administrative Patent Judges*.

McCARTNEY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> seeks review under 35 U.S.C. § 134(a) of the Examiner's final rejection of claims 1–21. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse and enter a new ground of rejection.

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<sup>1</sup> Appellant identifies the real party in interest as Chargerback, Inc. Appeal Brief 1, filed May 6, 2019 (Appeal Br.).

## BACKGROUND

This patent application concerns the inventory and return of lost items. *See* Specification ¶¶ 4, 27, filed September 1, 2011 (Spec.). Claim 1 illustrates the claimed subject matter:

1. A system to monitor lost items, the system comprising:
  - a lost item database including:
    - a first memory operable to store lost item information, the lost item information pertaining to lost items recovered at one or more establishments;
    - a second memory operable to store recovery item information, the recovery item information pertaining to a forgotten item at the one or more establishments;
    - an establishment database operable to store establishment information associated with each of the one or more establishments, the establishment information including at least an establishment logo;
  - a processor operable to:
    - [a] receive the lost item information and the recovery item information;
    - [b] associate a status indicator with the lost item associated with the lost item information and the forgotten item with the recovery item information;
    - [c] browse or search the lost item database to compare the lost item information and the recovery item information;
    - [d] determine whether there is a match between the lost item information and the recovery item information;
    - [e] retrieve the establishment information from the establishment database, the establishment information associated with the one or more establishments where the lost item was recovered;

[f] customize an electronic recovery notification using the establishment information including at least the establishment logo;

[g] facilitate transmission of the customized electronic recovery notification to a patron device associated with a current or prior patron of the one or more establishments if there is a match; and

[h] automatically update the status indicator to indicate the lost item and the forgotten item have been recovered.

Appeal Brief, Claims Appendix A-1 to A-2 (Claims App'x) (bracketed letters added).

## REJECTIONS<sup>2</sup>

<b>Claims</b>	<b>35 U.S.C. §</b>	<b>References/Basis</b>
1, 5, 8–14, 20, 21	102(b)	Nudd <sup>3</sup>
2	103(a)	Nudd, Klein <sup>4</sup>
3, 4, 6, 7	103(a)	Nudd, Orton <sup>5</sup>
15–19	103(a)	Nudd

## DISCUSSION

We have reviewed the Examiner's rejections and Appellant's arguments, and Appellant has persuaded us that the Examiner erred in rejecting claims 1, 5, 8–14, 20, and 21 under § 102(b) and claims 2–4, 6, 7, and 15–19 under § 103(a). But as permitted by 37 C.F.R. § 41.50(b), we reject claims 1–21 under § 101 and designate this rejection a new ground of

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<sup>2</sup> As clarified in the Examiner's Answer, the Examiner did not reject claims 1–21 under § 101 in the Final Office Action. *See* Examiner's Answer 3, mailed August 20, 2019 (Ans.).

<sup>3</sup> Nudd (US 2009/0187433 A1; July 23, 2009).

<sup>4</sup> Klein (US 6,259,367 B1; July 10, 2001).

<sup>5</sup> Orton III et al. (US 7,424,473 B2; September 9, 2008).

rejection. We first address the new ground of rejection under § 101 and then turn to the § 102 and § 103 rejections.

### Section 101 Rejection

Section 101 of the Patent Act provides that “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” is patent eligible. 35 U.S.C. § 101. But the Supreme Court has long recognized an implicit exception to this section: “Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. 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)). To determine whether a claim falls within one of these excluded categories, the Court has set out a two-part framework. The framework requires us first to consider whether the claim is “directed to one of those patent-ineligible concepts.” *Alice*, 573 U.S. at 217. If so, we then examine “the elements of [the] claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 573 U.S. at 217 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78, 79 (2012)). That is, we examine the claim for an “inventive concept,” “an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 573 U.S. at 217–18 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

The Patent Office has revised its guidance about this framework. *See* 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Revised Guidance”). Under the Revised Guidance, to decide

whether a claim is directed to an abstract idea, we evaluate whether the claim recites subject matter that falls within one of the abstract idea groupings listed in the Revised Guidance, and if so, whether the claim fails to integrate the recited abstract idea into a practical application. *See* Revised Guidance, 84 Fed. Reg. at 51, 54; *see also* USPTO, October 2019 Update: Subject Matter Eligibility at 1–2, 10–15, [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) (“October SME Update”) (providing additional guidance on determining whether a claim recites a judicial exception and integrates a judicial exception into a practical application). If the claim is directed to an abstract idea, as noted above, we then determine whether the claim has an inventive concept. The Revised Guidance clarifies that when making this determination, we should consider whether the additional claim elements add “a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field” or “simply append[] well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality.” Revised Guidance, 84 Fed. Reg. at 56.

With this framework in mind, we turn to claims 1–21

#### Independent Claim 1

##### *Directed To*

The Revised Guidance explains that the abstract idea exception includes “certain methods of organizing human activity” such as (1) fundamental economic principles or practices, (2) commercial or legal interactions, and (3) managing personal behavior or relationships or interactions between people. Revised Guidance, 84 Fed. Reg. at 52. The Revised Guidance explains that the abstract idea exception also includes

“mental processes,” that is, acts that people can perform in their minds or using pen and paper. Revised Guidance, 84 Fed. Reg. at 52 & nn.14–15. Claim 1 recites subject matter that falls within both of these categories of abstract ideas.

We begin with certain methods of organizing human activity. Claim 1 recites “[a] system to monitor lost items” that includes a processor operable to perform the steps recited in limitations [a]–[h]. These steps allow the system to determine than an establishment has recovered an item lost by a patron, customize a recovery message, facilitate transmission of the message to the patron’s device, and update a status indicator to reflect that the item has been recovered. *See* Claims App’x A-1 to A-2. These steps recite a type of lost-and-found service, and lost-and-found services are fundamental practices long prevalent in society. *See, e.g.,* John Tagliabue, *A Toast to Napoleon’s Long Lost Cause*, Chicago Tribune, May 23, 2005, 2005 WLNR 23392940 (explaining that “[t]wo hundred years ago, Napoleon ordered his prefect of police to establish an office . . . for lost objects”); Norimitsu Onishi, *Never Lost, but Found Daily: Japanese Honesty*, New York Times (Jan. 8, 2004), <https://www.nytimes.com/2004/01/08/world/never-lost-but-found-daily-japanese-honesty.html> (explaining that modern Japanese lost-and-found centers are “based on a 1,300-year-old system that long preceded Japan’s unification as a nation and its urbanization”); Spec. ¶¶ 2–3 (describing, in the Background of the Invention, how hotel employees “[t]ypically” handle lost items); Nudd ¶¶ 6–38 (describing prior art lost-and-found services). Claim 1 thus recites certain method of organizing human activity. *See, e.g., Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369–71 (Fed. Cir. 2015) (determining that claims that

involve “a fundamental . . . practice long prevalent in our system” are directed to an abstract idea); Manual of Patent Examining Procedure § 2106.04(a)(2)(II)(D) (explaining that the patent-ineligible claims in *Intellectual Ventures* are examples of claims directed to certain methods of organizing human activity).

The lost-and-found service recited in limitations [a]–[h] also encompasses a commercial interaction. The written description indicates that claimed invention concerns businesses such as hotels and airlines using the steps recited in limitations [a]–[h] to return lost items to their customers. *See, e.g.*, Spec. ¶¶ 74–100 (describing an example of the claimed invention). Because businesses generally offer this type of lost-and-found service as part of a commercial relationship or transaction with their customers, limitations [a]–[h] recite a commercial interaction. We see no meaningful difference between this commercial interaction and other commercial interactions that courts and the Board have determined are abstract ideas. *See, e.g., Elec. Comm’n Techs., LLC v. ShoppersChoice.com, LLC*, 958 F.3d 1178, 1181–84 (Fed. Cir. 2020) (providing advance notification of the pickup or delivery of a mobile thing); *Automated Tracking Sols., LLC v. Coca-Cola Co.*, 723 F. App’x 989, 992–996 (Fed. Cir. 2018) (locating, identifying, or tracking an object); *Baggage Airline Guest Servs., Inc. v. Roadie, Inc.*, 351 F. Supp. 3d 753, 758–61 (D. Del. 2019) (coordinating and monitoring baggage delivery), *aff’d*, 783 F. App’x 1022 (Fed. Cir. 2019); *Mobile Telecomms. Techs., LLC v. United Parcel Serv., Inc.*, 173 F. Supp. 3d 1324, 1329–35 (N.D. Ga. 2016) (providing delivery notification for express packages), *aff’d*, 708 F. App’x 684 (Fed. Cir. 2018); *Wireless Media Innovations, LLC v. Maher Terminals, LLC*, 100 F. Supp. 3d 405, 412–17 (D.N.J. 2015) (tracking shipping



containers), *aff'd*, 636 F. App'x 1014 (Fed. Cir. 2016); *GT Nexus, Inc. v. Intra, Inc.*, No. C 11-02145-SBA, 2015 WL 6747142, at \*3–6 (N.D. Cal. Nov. 5, 2015) (booking and tracing shipping containers through a third party), *aff'd*, 669 F. App'x 562 (Fed. Cir. 2016); *MacroPoint, LLC v. FourKites, Inc.*, No. 1:15 CV 1002, 2015 WL 6870118, at \*2–7 (N.D. Ohio Nov. 6, 2015) (tracking freight), *aff'd*, 671 F. App'x 780 (Fed. Cir. 2016); *Ex parte Colodny*, Appeal No. 2018-005764 (PTAB Aug. 12, 2019) (system for the transfer of found items between different establishments associated with an entity). Because commercial interactions fall within the category of certain methods of organizing human activity under the Revised Guidance, *see* Revised Guidance, 84 Fed. Reg. at 52, claim 1 recites certain methods of organizing human activity for this additional reason.

Although the Examiner did not expressly reject the pending claims under § 101 in the Final Office Action, Appellant argues that claim 1 does not recite certain methods of organizing human activity. *See* Appeal Br. 8–10. Appellant contends that claim 1 does not fall into this category of abstract ideas because the claimed system “is not a fundamental economic [principle] or a long-standing commercial practice.” Appeal Br. 10; *see also* Appeal Br. 8, 9 (making similar arguments).

We disagree. As discussed above, lost-and-found services like the one recited in limitations [a]–[h] are fundamental practices long prevalent in society. *See* Tagliabue, *supra*; Onishi, *supra*; Spec. ¶¶ 2–3; Nudd ¶¶ 6–38. For this reason alone, claim 1 recites certain methods of organizing human activity. And even if limitations [a]–[h] did not recite a fundamental practice long prevalent in society, as also discussed above, these limitations recite a commercial interaction that is not meaningfully different from other

commercial interactions that courts and the Board have determined are abstract ideas. Such commercial interactions are certain methods of organizing human activity under the Revised Guidance. *See Revised Guidance*, 84 Fed. Reg. at 52. We thus find these arguments unpersuasive.

In any event, claim 1 also recites mental processes. Claim 1 recites a series of broadly worded, result-oriented steps. These steps are so broadly drawn that they encompass steps that people can perform in their minds or using pen paper. For example, people can perform the receiving, browsing, and retrieving steps recited in limitations [a], [c], and [e], respectively, by reviewing a paper or digital database and mentally comparing information in the database. *See, e.g., CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372 (Fed. Cir. 2011) (determining that a claim step that “requires ‘obtaining information about other transactions that have utilized an Internet address that is identified with the [ ] credit card transaction’—can be performed by a human who simply reads records of Internet credit card transactions from a preexisting database” (alteration in original)). Even if these steps did not recite mental processes, they would not make claim 1 patent eligible because they simply gather data. *CyberSource*, 654 F.3d at 1372 (explaining that “even if some physical steps are required to obtain information from the database (e.g., entering a query via a keyboard, clicking a mouse), such data-gathering steps cannot alone confer patentability”).

Limitations [b], [d], and [f]–[h] also encompass acts that people can perform mentally or using pen and paper. People can perform the associating and determining steps respectively recited in limitations [b] and [d] by, for example, writing down a status for the recited items and comparing the

recited information. And people can perform the customizing, facilitating, and updating recited in limitations [g]–[h] by, for example, identifying in their minds establishment information to place in a recovery notification, giving written permission to send the notification, and assigning in their minds or writing down an updated status for the recited items. *See, e.g., CyberSource*, 654 F.3d at 1372 (determining that “unpatentable mental processes are the subject matter of” a claim when the claim’s “steps can be performed in the human mind, or by a human using a pen and paper”).

Because limitations [a]–[h] encompass acts that people can perform in their minds or by using pen and paper, claim 1 recites mental processes. This is true even though claim 1 recites that a processor is operable to perform the steps recited in these limitations. “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 Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1335 (Fed. Cir. 2015) (“Courts have examined claims that required the use of a computer and still found that the underlying, patent-ineligible invention could be performed via pen and paper or in a person’s mind.”); Revised Guidance, 84 Fed. Reg. at 52 n.14 (“If a claim, under its broadest reasonable interpretation, covers performance in the mind but for the recitation of generic computer components, then it is still in the mental processes category unless the claim cannot practically be performed in the mind.”). We therefore determine that claim 1 recites mental processes.

Because we determine that claim 1 recites abstract ideas, we next consider whether claim 1 integrates the abstract ideas into a practical application. *See* Revised Guidance, 84 Fed. Reg. at 51. In doing so, we

evaluate the claim as a whole to determine whether the claim “integrate[s] the [abstract ideas] into a practical application, using one or more of the considerations laid out by the Supreme Court and the Federal Circuit.” Revised Guidance, 84 Fed. Reg. at 55; *see also* October SME Update at 12 (discussing the practical application analysis). That is, we consider any additional elements recited in the claim along with the limitations that recite an abstract idea to determine whether the claim integrates the abstract ideas into a practical application. *See* October SME Update at 12.

Other than the abstract ideas discussed above, claim 1 recites (1) “a lost item database” that includes first and second memories operable to store certain information, (2) “an establishment database operable to store” specified “establishment information,” and (3) “a processor operable” to perform the steps recited in limitations [a]–[h]. Claims App’x A-1 to A-2. The written description makes clear that these additional elements encompass generic computer components. *See, e.g.*, Spec. ¶¶ 29 (“In accordance with the present invention, the components, process steps, and/or data structures may be implemented using various types of operating systems, computing platforms, computer programs, and/or general purpose machines.”), 106 (describing a processor) Figs. 1 (showing an exemplary system that includes a lost item database), 17 (showing an exemplary computer device that includes a processor).

The system recited in claim 1 uses these generic computer components as tools to implement the recited abstract ideas. *See* Claims App’x A-1 to A-2. Thus, considering the additional elements recited in claim 1 along with the limitations that recite an abstract idea, we determine that claim 1 does not integrate the recited abstract ideas into a practical

application. *See, e.g., Alice*, 573 U.S. at 223–24 (“[W]holly generic computer implementation is not generally the sort of ‘additional featur[e]’ that provides any ‘practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.’”) (second and third alterations in original) (quoting *Mayo*, 566 U.S. at 77)); *Intellectual Ventures*, 792 F.3d at 1370 (“Steps that do nothing more than spell out what it means to ‘apply it on a computer’ cannot confer patent-eligibility.”). Because claim 1 recites abstract ideas and does not integrate the abstract ideas into a practical application, we determine that claim 1 is directed to abstract ideas.

Appellant contends that claim 1 is patent eligible because the claim “address[es] a particular challenge involved [in] identifying, finding and returning lost items to patrons.” Appeal Br. 8. According to Appellant, “[t]he claimed solution is rooted in computer technology in order to overcome the conventional difficulties associated with lost and found items.” Appeal Br. 8–9. Appellant also asserts that “[c]laim 1 recites various limitations that provide technological improvements.” Appeal Br. 9.

We disagree. At best, the claimed system improves an abstract idea. Although the claimed system uses generic computer components to do so, that does not mean that the system is “rooted in computer technology” in a way that makes the system patent eligible or that the system improves technology. The claimed system merely uses generic computer components as tools to perform the recited abstract ideas. That is not enough to make claim 1 patent eligible. *Cf. Customedia Techs., LLC v. Dish Network Corp.*, 951 F.3d 1359, 1365 (Fed. Cir. 2020) (determining that “the claimed invention is at most an improvement to the abstract concept of targeted

advertising wherein a computer is merely used as a tool. This is not an improvement in the functioning of the computer itself.”); *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 . . . not on improving computers or technology.”); *Versata Dev. Grp.*, 793 F.3d at 1334 (determining that “the claims at issue are more like the claims we summarized in *DDR Holdings* as insufficient to reach eligibility—claims reciting a commonplace business method aimed at processing business information despite being applied on a general purpose computer”). We thus find these arguments unpersuasive.

Appellant also contends that claim 1 is similar to the patent-eligible claims in *Finjan, Inc. v. Blue Coat Systems, Inc.*, 879 F.3d 1299 (Fed. Cir. 2018). Appeal Br. 10–11. We disagree. In *Finjan*, the patent-eligible claims employed “a new kind of file that enable[d] a computer security system to do things it could not do before.” 879 F.3d at 1305. Here, Appellant has not shown that the claimed system changes the way computers operate, much less improves the way computers operate or enables computers to do things that they could not do before. And although Appellant contends otherwise, *see* Appeal Br. 10–11, claim 1 lacks the specificity of the claims in *Finjan*. As discussed above, claim 1 recites a series of broadly worded, result-oriented steps. We therefore find Appellant’s comparison of claim 1 to the claims in *Finjan* unpersuasive.

Finally, Appellant contends that claim 1 does “not present a preemption concern.” Appeal Br. 11. Even if claim 1 does not preempt the identified abstract ideas, that does not make claim 1 patent eligible. “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).

*Inventive Concept*

Finally, we consider whether claim 1 has an inventive concept, that is, whether the claim has additional elements that “transform the nature of the claim’ into a patent-eligible application.” *Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 78, 79). This requires us to evaluate whether the additional claim elements add “a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field” or “simply append[] well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality.” Revised Guidance, 84 Fed. Reg. at 56.

As noted above, the additional elements recited in claim 1 include “a lost item database” that includes first and second memories operable to store certain information, “an establishment database operable to store” specified “establishment information,” and “a processor operable” to perform the steps recited in limitations [a]–[h]. The written description describes these elements in a manner that indicates they encompass conventional computer components. *See, e.g.*, Spec. ¶¶ 29 (“In accordance with the present invention, the components, process steps, and/or data structures may be implemented using various types of operating systems, computing platforms, computer programs, and/or general purpose machines.”), 106 (describing a processor) Figs. 1 (showing an exemplary system that includes a lost item database), 17 (showing an exemplary computer device that includes a processor); *see also* USPTO, Memorandum on Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter

Eligibility Decision (*Berkheimerv. HP, Inc.*) at 3 (Apr. 19, 2018), available at <https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF> (explaining that a specification that describes additional elements “in a manner that indicates that the additional elements are sufficiently well-known that the specification does not need to describe the particulars of such additional elements to satisfy 35 U.S.C. § 112(a)” can show that the elements are well understood, routine, and conventional).

Considering the additional elements individually and in combination, we determine that the additional elements do not provide an inventive concept. Claim 1 recites a system that employs conventional computer components to perform the recited abstract ideas, which is not enough to provide an inventive concept. *Alice*, 573 U.S. at 223 (“[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.”); *Customedia Techs.*, 951 F.3d at 1366 (“[T]he invocation of ‘already-available computers that are not themselves plausibly asserted to be an advance . . . amounts to a recitation of what is well-understood, routine, and conventional.’” (quoting *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1170 (Fed. Cir. 2018))).

#### *Summary*

For the above reasons, we determine that claim 1 is directed to abstract ideas and lacks an inventive concept. We therefore reject claim 1 under § 101.

#### Independent Claims 10 and 21

Independent claims 10 and 21 are patent ineligible for the same reasons that claim 1 is patent ineligible. Appellant acknowledges that “[i]ndependent claims 10 and 21 provide for similar features as claim 1.”



Appeal Br. 8. Like claim 1, claims 10 and 21 recite a type of lost-and-found service. *See* Claims App’x A-4 to A-5, A-7 to A-8. For the reasons discussed above for claim 1, claims 10 and 21 also recite certain methods of organizing human activity and mental processes, do not integrate these abstract ideas into a practical application, and lack an inventive concept. We thus reject claims 10 and 21 under § 101.

#### Dependent Claims 2–9 and 11–20

Dependent claims 2–9 and 11–20 are also patent ineligible. These claims at most narrow the abstract ideas recited in their respective independent claims, but this narrowing does not make the dependent claims patent eligible. *See, e.g., BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1291 (Fed. Cir. 2018) (“As a matter of law, narrowing or reformulating an abstract idea does not add ‘significantly more’ to it.”); *SAP Am.*, 898 F.3d at 1169 (determining that the dependent claims at issue add limitations that “simply provide further narrowing of what are still mathematical operations” and thus “add nothing outside the abstract realm”); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (“The dependent claims’ narrowing to particular types of such relationships, themselves familiar, does not change the analysis. This kind of narrowing of such long-familiar commercial transactions does not make the idea non-abstract for section 101 purposes.”). And several of the dependent claims merely add token extra-solution activities to the abstract ideas recited in their respective independent claims. That is not enough to make the dependent claims patent eligible. *See Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (“[T]he prohibition against patenting abstract ideas ‘cannot be circumvented by’ . . . adding ‘insignificant postsolution activity.’”); *Fort Properties, Inc. v. Am. Master*

*Lease LLC*, 671 F.3d 1317, 1323–24 (Fed. Cir. 2012) (determining that claims that add only “insignificant post-solution activity” “cannot qualify as patent-eligible”). We accordingly reject dependent claims 2–9 and 11–20 under § 101.

### Section 102 and 103 Rejections

As discussed above, limitations [f] and [g] of claim 1 respectively require customizing an electronic recovery notification using establishment information and facilitating transmission of the customized electronic recovery notification to a patron device associated with a current or prior patron. Claims App’x A-2. The Examiner found that Nudd discloses the establishment information recited in limitation [f] because Nudd discloses that a person who finds a lost item (an establishment in the Examiner’s view) provides information such as her address (establishment information) to a lost-and-found provider. *See* Final Office Action 4, 8, mailed January 29, 2019 (Final Act.). The Examiner found that Nudd discloses the steps recited in limitations [f] and [g] because Nudd discloses that a “central system will transmit a notification to the item finder,” the notification including “information unique to the item, item owner, and item finder.” Final Act. 8.

Appellant argues that the Examiner erred because the Examiner found that Nudd discloses transmitting a customized notification to the *item finder* instead of a patron device associated with a current or prior patron, that is, the *item owner*. *See* Reply Brief 3, 4, filed October 21, 2019.

Appellant has persuaded us that the Examiner erred. Limitations [f] and [g] require customizing a notification using information about an establishment and facilitating the transmission of the notification to a

different entity, a patron device associated with a current or prior patron. *See* Claims App’x A-2. But as argued by Appellant, the Examiner found that Nudd discloses facilitating transmission as required by limitation [g] because Nudd discloses sending the customized notification to the *item finder*, not to a different entity. *See* Final Act. 8. Although the Examiner also found that Nudd discloses sending notifications and messages “to associated parties,” *see, e.g.,* Ans. 8, the Examiner has not shown that these notifications and messages were customized using the establishment information as required by limitation [f].

We therefore do not sustain the Examiner’s anticipation rejection of claim 1 and claims 5, 8, and 9, which depend from claim 1. Because the Examiner’s anticipation rejection of independent claims 10 and 21 suffer from similar deficiencies, we also do not sustain the Examiner’s anticipation rejection of these claims and claims 11–14 and 20, which depend from claim 10. Because the Examiner’s obviousness rejections of dependent claims 2–4, 6, 7, and 15–19 do not remedy the deficiencies in the rejections of their respective independent claims, we also do not sustain these rejections.

### CONCLUSION

The following table summarizes our decision for claims 1–21, the claims before us on appeal:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>	<b>New Ground</b>
1–21	101	Eligibility			1–21
1, 5, 8–14, 20, 21	102(b)	Nudd		1, 5, 8–14, 20, 21	
2	103(a)	Nudd, Klein		2	
3, 4, 6, 7	103(a)	Nudd, Orton		3, 4, 6, 7	
15–19	103(a)	Nudd		15–19	
<b>Overall Outcome</b>				1–21	1–21

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

Section 41.50(b) also provides the following: When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner,

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overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

No period for taking any action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. §§ 1.136(a)(1)(iv), 41.50(f), 41.52(b).

REVERSED

37 C.F.R. § 41.50(b)