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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID FENG-LIN CHEN, ANTHONY A. HAEUSER,
MARY MCCARTHY, SCOTT ALAN PETTIT, and
CHRISTOPHER A. LEE

Appeal 2020-000997
Application 15/070,889
Technology Center 3600

Before ST. JOHN COURTENAY III, JUSTIN BUSCH, and
JAMES W. DEJMEK, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from a Final rejection of claims 21–40. Claims 1–20 are canceled. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42(a) (2018). According to Appellant, the real party in interest is AT&T Intellectual Property I, L.P. *See* Appeal Br. 2.

STATEMENT OF THE CASE²

Introduction

Appellant’s claimed invention relates generally to “the provision [of] content over a television network.” Spec. ¶ 2.

*Rejection*³

Claims Rejected	35 U.S.C. §	Reference(s)/Basis
21–40	101	Eligibility

USPTO § 101 Guidance

The U.S. Patent and Trademark Office (USPTO) has published revised guidance on the application of 35 U.S.C. § 101. *See* USPTO January 7, 2019 Memorandum, 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (“January 2019 Memorandum”).⁴

² We herein refer to the Final Office Action, mailed October 31, 2018 (“Final Act.”); Appeal Brief, filed July 19, 2019 (“Appeal Br.”); the Examiner’s Answer, mailed September 6, 2019 (“Ans.”); and the Reply Brief, filed November 25, 2019. Throughout this opinion, we refer to the Manual of Patent Examining Procedure (MPEP), Ninth Edition, Revision 10.2019, last revised June 2020.

³ As noted by Appellant: “The nonstatutory double patenting rejection of Claims 21–40 as being unpatentable over Claims 1–20 of U.S. Patent No. 9,294,729 is moot in view of a previously submitted and approved electronic terminal disclaimer (eTD).” Appeal Br. 8. We note the terminal disclaimer was filed on March 15, 2019, and was approved on the same day. Therefore, this rejection is not before us on appeal.

⁴ The Office issued a further memorandum on October 17, 2019 (the “October 2019 Memorandum”) clarifying guidance of the January 2019

Under that guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes) (*see* January 2019 Memorandum *Step 2A – Prong One*; MPEP § 2106.04(a)(2)[R-10.2019]); and
- (2) any additional elements that integrate the judicial exception into a practical application (*see* MPEP §§ 2106.04(d); 2106.05(a)–(c), (e)–(h) [R-10.2019]) (*see* January 2019 Memorandum *Step 2A – Prong Two*).⁵

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

- (3) adds a specific limitation, or combination of limitations, 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.

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

⁵ This evaluation is performed by (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception and (b) evaluating those additional elements individually and in combination to determine whether the claim as a whole integrates the exception into a practical application. *See* 2019 October Memorandum, Section III(A)(2), page 10, *et seq.*

See January 2019 Memorandum *Step 2B*.

Because there is no single definition of an “abstract idea” under *Alice Corp. v. CLS Bank International*, 573 U.S. 208 (2014) Step 1, the January 2019 Memorandum synthesizes, for purposes of clarity, predictability, and consistency, key concepts identified by the courts as abstract ideas to explain that the “abstract idea” exception includes the following three groupings:

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

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

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

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

1. Improvements to the functioning of a computer, or to any other technology or technical field — *see* MPEP § 2106.05(a);
2. Applying the judicial exception with, or by use of, a particular machine — *see* MPEP § 2106.05(b);
3. Effecting a transformation or reduction of a particular article to a different state or thing — *see* MPEP § 2106.05(c); and
4. Applying or using the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception — *see* MPEP § 2106.05(e).

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

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

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

ANALYSIS

*January 2019 Memorandum, Step 2A, Prong One
The Judicial Exception*

We reproduce *infra* independent claim 21 in Table One. We have considered all of Appellant’s arguments and any evidence presented. We highlight and address specific findings and arguments for emphasis in our analysis below.⁶

The Examiner concludes that independent claim 21 recites an abstract idea, i.e., a method of organizing human activity:

[I]t is a method of organizing human activity because the claims are similar in concept to the claims in *Intellectual Ventures I LLC v. Capitol One Bank (USA)*, Case No. 2014-1506 (Fed. Cir. July 6, 2015). The claims in *Intellectual Ventures* deal with the administration of financial accounts and providing user display access of web pages. The[] claims in *Intellectual Ventures* are also directed toward tailoring content based on information about the user. Since *Intellectual Ventures* was found to be abstract, the claims in the instant case are abstract.

Final Act. 5.⁷

In the Answer, the Examiner clarifies the abstract idea: i.e., “as a certain method of organizing human activity, specifically, a commercial interaction.” Ans. 10.

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

⁷ The Examiner is citing *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363 (Fed. Cir. 2015).

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

Independent Claim 21

In Table One below, we identify in *italics* the specific claim limitations that we conclude recite an abstract idea. We also identify in **bold** the additional claim elements that we find are generic computer components:

TABLE ONE

Independent Claim 21	January 2019 Memorandum
[a] A system comprising: ⁸	
[b] a server having access to a remote desktop application; and	A server is a generic computer component, as shown in bold. <i>See</i> January 2019 Memorandum, 84 Fed. Reg. at 52 n.14.
[c] a memory that stores executable instructions that, when executed by the server , facilitate performance of operations, comprising:	A memory and the server are generic computer components, as shown in bold. <i>See</i> January 2019 Memorandum, 84 Fed. Reg. at 52 n.14.

⁸ A system (i.e., apparatus) falls under the statutory subject matter class of a machine. *See* 35 U.S.C. § 101 (“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”).

Independent Claim 21	January 2019 Memorandum
<p>[d] launching the remote desktop application in response to detecting a user request to access web content provided by a service partner, wherein said launching includes creating a reverse-proxy that simulates the user in accordance with a security message;</p>	<p>Launching the remote desktop application in response to detecting a user request to access web content provided by a service partner is insignificant extra-solution activity. <i>See</i> January 2019 Memorandum, 84 Fed. Reg. at 55 n.31; <i>see also</i> MPEP § 2106.05(g).</p>
<p>[e] wherein the remote desktop application accesses first and second user account information, wherein <i>the first user account information is associated with a media services account</i> for providing a media service to a user over a network, and wherein <i>the second user account information is associated with a service partner account</i> for providing a web content service to the user by the service partner, and</p>	<p>Abstract Idea — <i>associating the first user account information with a media services account</i> could be performed alternatively by a person as a mental process.</p> <p>Abstract Idea — <i>associating the second user account information with a service partner account</i> could also be performed alternatively by a person as a mental process. <i>See</i> January 2019 Memorandum, 84 Fed. Reg. at 52.</p> <p>These steps of <i>associating</i> could be carried out by a human with pen and paper. <i>See CyberSource Corp. v. Retail Decisions, Inc.</i>, 654 F.3d 1366, 1375 (Fed. Cir. 2011) (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in <i>Gottschalk v. Benson</i>.”).</p>

Independent Claim 21	January 2019 Memorandum
	<p>A network is a generic computer component, as shown in bold. <i>See</i> January 2019 Memorandum, 84 Fed. Reg. at 52 n.14.</p> <p>Providing a web content service to the user by the service partner is insignificant extra-solution activity (data transmission). <i>See</i> January 2019 Memorandum, 84 Fed. Reg. at 55 n.31; MPEP § 2106.05(g); <i>see also buySAFE, Inc. v. Google, Inc.</i>, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (computer receives and sends information over a network).</p>
<p>[f] wherein the remote desktop application <i>associates the service partner account with the media services account</i> to invoke the web content service over the network, wherein the user request does not provide the second user account information.</p>	<p>Abstract Idea — <i>Associating the service partner account with the media services account</i> could be performed alternatively by a person as a mental process. <i>See</i> January 2019 Memorandum, 84 Fed. Reg. at 52.</p> <p>Invoking the web content service over the network is insignificant extra-solution activity (data gathering). <i>See</i> January 2019 Memorandum, 84 Fed. Reg. at 55 n.31; <i>see also</i> MPEP § 2106.05(g).</p>

Abstract Idea

Appellant notes that the Final Action (mailed October 31, 2018) predates the January 2019 Memorandum. *See* Appeal Br. 5. Appellant thus concludes that “the subject matter eligibility determination set forth in the Office Action was made under guidance that is now obsolete.” *Id.*

However, as identified above in Table One, we conclude system functions (e) and (f) each involve *associating* one type of account with another type of account, which can be performed alternatively by a person as a mental process. *See* January 2019 Memorandum, 84 Fed. Reg. at 52. *See also* October 2019 Memorandum, section C: “Mental Processes” page 7.

Although we describe the abstract idea slightly differently than the Examiner (Final Act. 5; Ans. 10), the Examiner’s characterization of the idea is not erroneous. “An abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). The level of abstraction an Examiner uses to describe an abstract idea need not “impact the patentability analysis.” *Apple*, 842 F.3d at 1241.

Regardless of the level of generality used to describe the abstract idea, we conclude independent claim 21 recites an abstract idea. *Cf. Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (“Although not as broad as the district court’s abstract idea of organizing data, it is nonetheless an abstract concept.”).

Although independent claim 21 requires the recited functions to be performed by a system including a server, memory and network, we find this generic computer implementation of a mental process is insufficient to take the invention out of the realm of abstract ideas. *See also* independent claims

30 and 39 which similarly recite “a processor” and “a network.”

“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*.” See also *CyberSource*, 654 F.3d at 1375. If a method can be performed by human thought alone, or by a human using pen and paper, it is merely an abstract idea and is not patent eligible under § 101. See *CyberSource*, 654 F.3d at 1372–73; see also *Versata Dev. Grp. 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.”); *Alice*, 573 U.S. at 223 (“Stating an abstract idea while adding the words ‘apply it with a computer’” is insufficient to confer eligibility.).

Moreover, “[u]sing a computer to accelerate an ineligible mental process does not make that process patent-eligible.” *Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can.* (U.S.), 687 F.3d 1266, 1279 (Fed. Cir. 2012); see also *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (“[R]elying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.”).

Because claim 21 considered as a whole **recites** an abstract idea, as identified in Table One, *supra*, and because remaining independent claims 30 and 39 recite similar language of commensurate scope, we conclude all claims 21–40 recite an abstract idea, as identified above, under *Step 2A, Prong One*. Therefore, we proceed to *Step 2A, Prong Two*.

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

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

Additional Limitations

As emphasized in bold in Table One, *supra*, we note the additional generic computer components recited in claim 21, i.e., the “**server**” “**memory**” and “**network.**” (Emphasis added). We further note the supporting exemplary, non-limiting descriptions of generic computer components found in the Specification, for example at paragraph 22:

Still referring to FIG. 1, the backbone network 110 includes an auto-account association system 180 that includes one or more servers 182, a database 184 that stores customer information and a set of computer programs 186 which contains instructions that are executed by the server 182 to perform the methods and functions described herein.

Spec. ¶ 22.

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

Thus, we conclude Appellant’s claimed invention merely implements the abstract idea (i.e., the mental processes of associating various account types — claim 21) using *instructions* executed on generic computer

components, as depicted in Table One (above), and as supported in Appellant’s Specification, for example, at paragraph 22. Therefore, we conclude Appellant’s claims merely use a generic programmed computer as a tool to perform an abstract idea. *See* MPEP § 2106.05(f).

As mapped in the right column of Table One, *supra*, we conclude that independent claim 21 also recites several additional limitations that are extra-solution activities the courts have determined to be insufficient to transform judicially excepted subject matter into a patent-eligible application. *See* MPEP § 2106.05(g); January 2019 Memorandum, 84 Fed. Reg. at 55 n.31.

For example, *see* Claim 21, Table One, *supra*, function (f): we conclude that *invoking the web content service over the network* is insignificant extra-solution activity (data gathering). *See* January 2019 Memorandum, 84 Fed. Reg. at 55 n.31; *see also* MPEP § 2106.05(g); *buySAFE*, 765 F.3d at 1355 (“That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive.”).

These extra or post-solution limitations use a generic computer component that performs a generic computer function as a tool to perform an abstract idea. Thus, these limitations do not integrate the abstract idea into a practical application. *See Alice*, 573 U.S. at 223–24. Instead, these limitations merely perform insignificant extra-solution activities. *Cf. Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1242 (Fed. Cir. 2016) (agreeing with the Board that printing and downloading generated menus are insignificant post-solution activities); *see also Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1341 (Fed. Cir. 2017) (streaming

audio/visual data over a communications system like the Internet held patent ineligible).

We consider next the question of whether there are any claimed improvements to the functioning of a computer or to any other technology or technical field, applying the January 2019 Memorandum and the guidance set forth under MPEP § 2106.05(a).

The Examiner finds:

Viewed as a whole, the claims do not, for example, purport to *improve* the functioning of the computer itself. Nor do they effect an *improvement* in any other technology or technical field. They do not describe any particular *improvement* in the manner a computer functions. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea. Under precedent, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 573 U.S. at 225–26.

Ans. 7 (emphasis added).

Appellant does not agree with the Examiner. Appellant urges that the “Examiner’s declaration that a better customer experience is not a technological improvement is both irrelevant and insufficient. Irrelevant because the claim does not recite a better customer experience and insufficient because technical improvement is only one consideration that is indicative of a practical application integrated into an abstract idea.” Appeal Br. 6 (emphasis added).

However, even if “customer experience” is irrelevant, we find Appellant does not advance any substantive, persuasive arguments regarding any specific claimed improvements. To the extent that the claimed “association” functions recited in claim 21 are actually performed by an “*auto-account association system 180* that includes one or more servers

182” and “a database 184” (Spec. ¶ 22, Fig. 1 (emphasis added)), the “‘mere automation of manual processes using generic computers’ . . . ‘does not constitute a patentable improvement in computer technology.’” *Trading Techs. Int’l, Inc. v. IBG LLC*, 921 F.3d 1378, 1384 (Fed. Cir. 2019) (quoting *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017)).

Simply adding generic hardware and computer components to perform abstract ideas *does not integrate those ideas into a practical application*, because the “mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 573 U.S. at 223; *see* January 2019 Memorandum, 84 Fed. Reg. at 55, n.30; *id.* at 55 (“merely includ[ing] instructions to implement an abstract idea on a computer” is an example of when an abstract idea has not been integrated into a practical application).

To the extent Appellant *arguendo* claims an improved approach to *associating* various types of accounts (claim 21), an improved abstract idea is still an abstract idea. *See Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 90 (2012) (holding that a novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent ineligible); *see also Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (“[A] claim for a *new* abstract idea is still an abstract idea.”).

As set forth under MPEP § 2106.05(a):

To show that the involvement of a computer assists in *improving the technology*, the claims *must recite the details regarding how a computer aids the method, the extent to which the computer aids the method, or the significance of a computer to the performance of the method* Merely adding generic computer components to perform the method is not sufficient. Thus, the

claim must include more than mere instructions to perform the method on a generic component or machinery to qualify as an improvement to an existing technology.

(Emphasis added).

Here, we find Appellant has not persuasively shown how the claims “*recite the details regarding how a computer aids the method, the extent to which the computer aids the method, or the significance of a computer to the performance of the method.*” *Id.* (Emphasis added).

Therefore, we agree with the Examiner that independent claims 21, 30, and 39 “do not recite an improvement to the functioning of the computer itself or to any other technology or technical field.” Ans. 9; *see* MPEP § 2106.05(a).

The Examiner additionally finds “the claims do not recite . . . *a particular machine, a particular transformation, or other meaningful limitations.*” Ans. 9.

We note Appellant advances no arguments that any method (process) claims on appeal are tied to a particular machine, or transform an article to a different state or thing. *See* MPEP § 2106.05(b), 2106.05(c).

However, Appellant contends: “[c]laim 21 integrates its recited elements into a practical application that imposes *meaningful limits* preventing the claim from monopolizing any abstract element or any combination of abstract elements recited.” Appeal Br. 6–7. In support, Appellant refers to the created “reverse-proxy” limitation that “simulates the user,” as recited in claim 21. Appeal Br. 6.

But the Supreme Court guides: “[T]he prohibition against patenting abstract ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or [by] adding

‘insignificant postsolution activity.’” *Bilski v. Kappos*, 561 U.S. 593, 610–12 (2010) (quoting *Diamond v. Diehr*, 450 U.S. 175, 191–92 (1981)); see MPEP § 2106.05(h).

Our reviewing court provides further guidance: “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); see also *OIP Technologies, Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“that the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract”).

This reasoning is applicable here. Therefore, we find Appellant advances no substantive, persuasive arguments that the claims on appeal recite specific “meaningful” claim limitations, such as those of the types addressed under MPEP § 2106.05(e), that impose meaningful limits on the judicial exception.⁹

Nor do claims 21–40 present any other issues, as set forth in the January and October 2019 Memoranda, regarding a determination of whether the additional generic computer elements integrate the judicial exception into a practical application. See January 2019 Memorandum, 84 Fed. Reg. at 55.

⁹ See January 2019 Memorandum, 84 Fed. Reg. at 55, citing MPEP § 2106.05(e): “[A]ppl[y]ing or us[ing] the judicial exception in some other *meaningful* way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception.” (Emphasis added).

Thus, under *Step 2A, Prong Two* (see MPEP § 2106.05(a)–(c) and (e)–(h)), we conclude claims 21–40 do not integrate the judicial exception into a practical application.

The Inventive Concept – Step 2B

Under the January 2019 Memorandum, only if a claim: (1) recites a judicial exception, and (2) does not integrate that exception into a practical application, do we then look to whether the claim adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (see MPEP § 2106.05(d)); **or**, simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

Berkheimer v. HP Inc., 881 F.3d 1360 (Fed. Cir. 2018)

Berkheimer was decided by the Federal Circuit on February 8, 2018. On April 19, 2018, the PTO issued the Memorandum titled: “Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*),” (hereinafter “*Berkheimer* Memorandum”).¹⁰ The *Berkheimer* Memorandum provided specific requirements for an Examiner to support with evidence any finding that *claim elements* (or a *combination of elements*) are well-understood, routine, or conventional.

¹⁰ Available at <https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF>.

Here, under *Step 2B*, the Examiner finds:

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. All of these computer functions are generic, routine, conventional computer activities that are performed only for their conventional uses. See *Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). Also see *In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303, 1316 (Fed. Cir. 2011) (“Absent a possible narrower construction of the terms ‘processing,’ ‘receiving,’ and ‘storing,’ . . . those functions can be achieved by any general purpose computer without special programming”). None of these activities are used in some unconventional manner nor do any produce some unexpected result. In short, each step does no more than require a generic computer to perform generic computer functions.

Ans. 8.

We find Appellant has not substantively traversed this *Berkheimer* (type two) case law evidence in the Reply Brief.¹¹ Arguments not made are waived. See 37 C.F.R. § 41.37(c)(1)(iv).

Therefore, in light of the foregoing, and under the Director’s policy guidance, as set forth in the January and October 2019 Memoranda, we conclude that each of Appellant’s claims 21–40, considered as a whole, is directed to a patent-ineligible abstract idea that is not integrated into a practical application, and does not include an inventive concept. Accordingly, we sustain the Examiner’s rejection under 35 U.S.C. § 101 of representative claim 21, and the rejection of grouped claims 22–40 (not

¹¹ “2. A citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s).” *Berkheimer* Memorandum 4.

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argued separately), which fall with claim 21. *See* 37 C.F.R. § 41.37(c)(1)(iv).

CONCLUSION

Under the Director’s policy guidance, and the *Alice /Mayo* framework, as set forth in the January and October 2019 Memoranda, we conclude that claims 21–40, rejected under 35 U.S.C. § 101, are directed to patent-ineligible subject matter.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
21–40	101	Eligibility	21–40	

FINALITY AND RESPONSE

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

AFFIRMED