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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AARON FISH

Appeal 2020-001555
Application 12/949,575
Technology Center 2800

Before ERIC S. FRAHM, CARL L. SILVERMAN, and JOYCE CRAIG,
Administrative Patent Judges.

CRAIG, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1, 3–6, 9–14, 16–20, 24–28, and 32. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Accordios Worldwide Enterprises Inc. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The claims are directed to a digital marketing and revenue generation method and system. Spec. 2. “Digital showroom,” as recited in the claims, means “online user/provider digital interfaces and exchange apparatus that enable providers to display goods, services and survey questions; and enable users to interact with as well as select goods and services, and input information and or survey answers.” Spec. 7. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method of obtaining dual-purpose interactions from workers with each of a series of multiple, exclusive digital showrooms before granting benefits to the workers, comprising:
 - receiving in a data store, from a first provider via a first web browser, a configuration of a first digital showroom including a first logo and data representing a first group of prizes, which is offered by the first provider;
 - receiving in the data store, from a second provider via a second web browser, a configuration of a second digital showroom including a second logo and data representing a second group of prizes, which is offered by the second provider;
 - displaying on a first page on a plurality of communication devices, by a computing system connected by a network to said plurality of devices and the data store, the first digital showroom including the first logo and the first group of prizes offered by the first provider;
 - displaying on a second page on said plurality of devices, by the system, the second digital showroom including the second logo and the second group of prizes offered by the second provider;
 - receiving, by the system, via inputs to said plurality of devices, from each of a plurality of workers:
 - a selection of one prize from the first group of prizes displayed in the first digital showroom; and
 - a selection of one prize from the second group of prizes displayed in the second digital showroom;

said selections being at least part of a body of work received by the system from each worker;

defining, by the system, a selected prize package for each worker comprising said selections;

granting, by the system, to each of the plurality of workers, a benefit comprising a chance to win his or her selected prize package;

providing to the first provider on a first additional communication device connected to the network, a first portion of each body of work, said first portion including the selection of the prize from the first group and excluding the selection of the prize from the second group;

providing to the second provider on a second additional communication device connected to the network, a second portion of each body of work, said second portion including the selection of the prize from the second group and excluding the selection of the prize from the first group;

each said selection serving to define both its corresponding selected prize package and a consumer preference data portion of the body of work; and

selecting, by the system, at least one winner from the plurality of workers, said winner winning his or her selected prize package.

Appeal Br. 8 (Claims Appendix).

REJECTION

Claims 1, 3–6, 9–14, 16–20, 24–28, and 32 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to patent-ineligible subject matter. Final Act. 2.

ANALYSIS

Appellant argues the Examiner's rejection of the pending claims under 35 U.S.C. § 101 as directed to patent-ineligible subject matter is in error. To the extent Appellant has not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. 37 C.F.R. § 41.37(c)(1)(iv). Appellant argues claims 1, 3–6, 9–14, 16–20,

24–28, and 32 as a group. Appeal Br. 5. Given our discretion under 37 C.F.R. § 41.37(c)(1)(iv), we decide the § 101 rejection of claims 1, 3–6, 9–14, 16–20, 24–28, and 32 based on representative claim 1.

Principles of Law

“Whether a claim is drawn to patent-eligible subject matter is an issue of law that we review de novo.” *SiRF Tech., Inc. v. Int’l Trade Comm’n*, 601 F.3d 1319, 1331 (Fed. Cir. 2010).

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 part 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.*

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”).² “All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.” *Id.* at 51; *see also* October 2019 Update at 1.

Under the 2019 Revised Guidance and the October 2019 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”).³

² 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* (the “October 2019 Update”) (available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf).

³ 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

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

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.

Step 1

Claim 1, as a method claim, falls within the process category of § 101. *See* 2019 Revised Guidance, 84 Fed. Reg. at 53–54 (citing MPEP §§ 2106.03, 2106.06).

Step 2A(i): Does the Claim Recite a Judicial Exception?

The Examiner determined that claim 1 recites “certain methods of organizing human activity,” which is an abstract idea. Ans. 3–5; Final Act. 3. Appellant presents no arguments challenging the Examiner’s conclusion that claim 1 recites “certain methods of organizing human activity,” which is an abstract idea. *See* Appeal Br. 5; Reply Br. 2.

We agree with the Examiner’s determination that claim 1 is fairly characterized as advertising and marketing activities, and managing relationships and transactions between people, which fall into the certain method of organizing human activity category of abstract ideas. *See* 84 Fed.

practical application. *See* 2019 Revised Guidance - Section III(A)(2), 84 Fed. Reg. 54–55.

Reg. at 52; Ans. 3–5. The preamble of claim 1 recites “obtaining dual-purpose interactions from workers with each of a series of multiple, exclusive digital showrooms before granting benefits to the workers.” Appeal Br. 8 (Claims App.). The Specification describes that “[t]he present invention is directed to a digital marketing and revenue generation method and system.” Spec. 2. The Specification describes “exchanges of work for items and benefits” and “exchanges of work for prizes.” Spec. 3. Claim 1 reflects such description by receiving configurations of digital showrooms from providers; displaying digital showrooms, which display a selection of prizes; receiving selections of prizes from workers; granting workers chances to win prizes; providing providers with prize selections; and selecting a winner from the plurality of workers. *See* Appeal Br. 8–9 (claim 1). In the Appeal Brief, Appellant acknowledges that “[i]n the claimed invention, the problem is solved by requiring interaction from the consumer, defined in the claim as a worker, with each provider of online commercial content before a benefit is granted.” Appeal Br. 5. For at least these reasons, we agree with the Examiner that claim 1 involves advertising and marketing activities, and managing relationships and transactions between people, which are “certain methods of organizing human activity,” and thus an abstract idea.

Appellant does not challenge the Examiner’s determination that claim recites “certain methods of organizing activity.” Rather, Appellant argues that “without the computing environment, there is no invention, so whatever it is that can be done on paper is outside of the claimed invention.” Appeal Br. 5.

To the extent Appellant argues that claim 1 does not recite a “mental process” that can be performed in the human mind or with pen and paper, we disagree. Steps that may be performed in the mind, even if recited as being performed on a computer, are mental processes. *See Intellectual Ventures LLC v. Symantec Corp.*, 838 F.3d 1307, 1318 (Fed. Cir. 2016) (noting, in holding that the claim recites an abstract idea, that “with the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper”); *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324 (Fed. Cir. 2016) (holding that a computer-implemented method for “anonymous loan shopping” was an abstract idea because it could be “performed by humans without a computer”); *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.”); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375, 1372 (Fed. Cir. 2011) (holding that the incidental use of “computer” or “computer readable medium” does not make a claim otherwise directed to process that “can be performed in the human mind, or by a human using a pen and paper” patent eligible).

Here, at least the limitations “defining . . . a selected prize package for each worker comprising said selections, “granting . . . to each of the plurality of workers, a benefit comprising a chance to win his or her selected prize package,” and “selecting . . . at least one winner from the plurality of workers, said winner winning his or her selected prize package” can be

performed in the human mind.⁴ *See* 2019 Revised Guidance, 84 Fed. Reg. at 52, 53 nn.14–15 (listing mental processes as including observation, evaluation, judgment, and opinion); *see also Elec. Power Grp. LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016) (“we have treated analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” 830 F.3d at 1354 (citations omitted)).

Because we agree with the Examiner that claim 1 recites an abstract idea, we proceed to Prong Two of Step 2A to determine if the idea is integrated into a practical application, in which case the claim as a whole would not be “directed to” merely an abstract idea.

Step 2A(ii): Judicial Exception Integrated into a Practical Application?

We determine whether the recited judicial exception is integrated into a practical application of the judicial exception by: (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application.

We use the term “additional elements” for claim features, limitations, or steps that the claim recites beyond the identified judicial exception. *See* Revised Guidance at 55 n.24. In claim 1, the additional elements include the limitations “data store,” “web browser,” “communication devices,”

⁴ In our “mental process” analysis, the “receiving,” “displaying,” and “providing” steps, as recited in claim 1, amount to mere data gathering, which is insignificant extra-solution activity. *See* 2019 Revised Guidance, 84 Fed. Reg. at 55; MPEP § 2106.05(g).

“computing system,” “network,” “inputs to said plurality of devices,” and “digital showroom.”

To integrate the exception into a practical application, the additional claim elements must, for example, improve the functioning of a computer or any other technology or technical field (*see* MPEP § 2106.05(a)), apply the judicial exception with a particular machine (*see* MPEP § 2106.05(b)), affect a transformation or reduction of a particular article to a different state or thing (*see* MPEP § 2106.05(c)), or apply or use the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment (*see* MPEP § 2106.05(e)). *See* 2019 Revised Guidance.

The Examiner determined that none of the additional limitations integrates the abstract idea into a practical application because the additional elements are generic computer components that do not provide “any practical assurance that the process is significantly more than a drafting effort designed to monopolize the abstract idea itself.” Final Act. 5. We agree with the Examiner. *See* Ans. 6–7 (citing Spec. 12–13).

Appellant does not argue that the additional elements are not generic computer components. Rather, Appellant argues that the claimed invention “represents” a practical application because it requires providers to configure and customize their own specific digital showroom, the separate display of each showroom, the interaction of the workers with each showroom without omitting any, and each selection to serve the dual purpose of being a prize choice and consumer preference data. Appeal Br. 5.

Appellant’s argument is not persuasive. The claim simply includes instructions to implement an abstract idea on a computer and “does no more

than generally link the use of a judicial exception to a particular technological environment or field of use.” 2019 Revised Guidance, 84 Fed. Reg. at 55.

Appellant next argues that the computing environment, “i.e., machine,” is essential because “without the machine in the claims, there is no solution.” Appeal Br. 6 (citing *SiRF Tech., Inc. v. Int’l Trade Comm’n*, 601 F.3d 1319 (Fed. Cir. 2010)).

We are not persuaded the claims here are comparable to those in *SiRF*, where the Federal Circuit determined that the claimed GPS receiver was a machine that was integral to each of the claims at issue. 601 F.3d at 1331. In *SiRF*, the goal of the claims was to determine the position of the GPS receiver. *Id.* In other words, the claims of the patents at issue were determined patent eligible not simply because they required a GPS receiver, but because they were directed to improved techniques for computing the position of the GPS receiver. No such technological improvement is evident in the claimed invention. Unlike the situation in *SiRF*, Appellant does not identify any improvement to GPS technology or any other computer technology. Instead, Appellant’s claims merely invoke the use of a generic computer components for receiving, displaying, providing, and selecting information to associate with a digital showroom.

Appellant next argues that claim 1 “improves digital brand engagement, which is a technical field because it necessarily involves digital devices.” Appeal Br. 7.

Claim 1 does not recite an improvement for electronic devices because receiving, displaying, defining, granting, providing, and selecting information to associate with a digital showroom, as in claim 1, “does not

improve the functioning of the computer, make it operate more efficiently, or solve any technological problem.” *Trading Techs. Int’l, Inc. v. IBG LLC*, 921 F.3d 1378, 1385 (Fed. Cir. 2019). Rather, the claim simply “includes instructions to implement an abstract idea on a computer” and “does no more than generally link the use of a judicial exception to a particular technological environment or field of use.” 2019 Revised Guidance, 84 Fed. Reg. at 55. We agree with the Examiner that the invention’s use of digital devices does not equate to improving the technology or the digital device structures themselves. Ans. 9–10.

Considering claim 1 as a whole, then, Appellant’s invention lacks a technical solution to a technical problem like the claims in these cases. Claim 1 as a whole merely uses instructions to implement the abstract idea on a computer or, alternatively, merely uses a computer as a tool to perform the abstract idea. Here, the additional limitation(s) do not integrate the judicial exception into a practical application. More particularly, the claim does not recite (i) an improvement to the functionality of a computer or other technology or technical field; (ii) a “particular machine” to apply or use the judicial exception; (iii) a particular transformation of an article to a different thing or state; or (iv) any other meaningful limitation. *See* 84 Fed. Reg. at 55. Rather, claim 1 recites an abstract ideas as identified in Step 2A(i), *supra*, and none of the limitations integrates the judicial exception into a practical application.

Therefore, because the abstract idea is not integrated into a practical application, we conclude that the claim is directed to the judicial exception.

Step 2B — “Inventive Concept” or “Significantly More”

If a claim is directed to a patent-ineligible concept, as we conclude above, we proceed to the “inventive concept” step. For Step 2B we must “look with more specificity at what the claim elements add, in order to determine ‘whether they identify an “inventive concept” in the application of the ineligible subject matter’ to which the claim is directed.” *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1258 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016)). We look to see whether there are any “additional features” in the claims that constitute an “inventive concept,” thereby rendering the claims eligible for patenting even if they are directed to an abstract idea. *Alice*, 573 U.S. at 221. Those “additional features” must be more than “well-understood, routine, conventional activity.” *Mayo*, 566 U.S. at 79.

We find no such features in claim 1. Pages 12 through 15 of Appellant’s Specification describe computer systems upon which embodiments of the present invention may be implemented. *See* Spec. 12–15. Because the Specification describes the additional elements in general terms, without describing the particulars, we conclude the claim limitations may be broadly but reasonably construed as reciting conventional computer components and techniques, particularly in light of Appellant’s Specification, as cited above.

Appellant does not direct our attention to anything in the Specification that indicates the computer components perform anything other than well-understood, routine, and conventional functions, such as receiving data, displaying data, sending data, and storing data in a database. *See buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (“That a computer

receives and sends the information over a network—with no further specification—is not even arguably inventive”); *In re TLI Commc 'ns LLC Patent Litig.*, 823 F.3d 607, 614 (Fed. Cir. 2016) (server that receives data, extracts classification information from the received data, and stores the digital images insufficient to add an inventive concept); *Alice*, 573 U.S. at 225-26 (receiving, storing, sending information over networks insufficient to add an inventive concept). Courts have recognized that receiving or transmitting data over a network, in a manner similar to that recited in claim 1, is well-understood, routine, and conventional. *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (sending messages over a network); *buySAFE*, 765 F.3d at 1355 (computer receives and sends information over a network).

We conclude claim 1 does not have an inventive concept because the claim, in essence, merely recites various computer-based elements along with no more than mere instructions to implement the identified abstract idea using the computer-based elements.

Because claim 1 is directed to an abstract idea, without significantly more, we sustain the Examiner's § 101 rejection of independent claim 1 and grouped claims 3–6, 9–14, 16–20, 24–28, and 32, not argued separately with particularity.

DECISION

We affirm the Examiner's decision rejecting claims 1, 3–6, 9–14, 16–20, 24–28, and 32.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 3-6, 9-14, 16-20, 24-28, 32	101	Eligibility	1, 3-6, 9-14, 16-20, 24-28, 32	

TIME PERIOD FOR 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED