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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LISA M. WOOD BRADLEY,
TIMOTHY BRANTNER,
JASON M. BROWN, and
HELEN L. GAWOR

Appeal 2020-003061
Application 15/639,417
Technology Center 3600

Before HUBERT C. LORIN, NINA L. MEDLOCK, and
AMEE A. SHAH, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant appeals from the Examiner's Final decision to reject claims 1–20.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM IN PART but denominate that which we affirm as a NEW GROUND of rejection.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies International Business Machines Corporation as the real party in interest. Appeal Br. 2.

CLAIMED SUBJECT MATTER

The claimed subject matter relates generally to to-do lists. Spec. para. 1. Claim 1, reproduced below with emphasis added, is illustrative of the claimed subject matter:

1. *A method for implementing an action-based to-do list, comprising:*

monitoring user actions with a personal management device to compare the user actions against a task definition file, which task definition file comprises a number of criteria which:

indicate completion of at least one task: and

are tracked and used to modify the action-based to

do list;

determining when the user actions fulfill a criteria [sic] within the task definition file;

and

modifying the action-based to-do list with the personal management device based on fulfilled criteria.

Appeal Br. 28 (Claims Appendix).

REFERENCES

The Examiner relies upon the following as evidence of unpatentability:

Name	Reference	Date
James	US 2008/0120616 A1	May 22, 2008
Saravanan	US 2008/0141247 A1	June 12, 2008

REJECTIONS

Claims 1–20 are rejected under 35 U.S.C. § 101 as being directed to judicially-expected subject matter.

Claims 1–20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Saravanan and James.

OPINION

The rejection of claims 1–20 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

Representative claim

The Appellant argues these claims as a group. *See* Appeal Br. 12–16. We select claim 1 as the representative claim for this group, and claims 2–12 and 15–20 stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2018).

Preliminary comment

Appellant states: “it is unclear why a position is being proposed that is contrary to the express position of the Board [in Appeal 2015-002683; Application 12/492,941, now US 9,754,224 B2].” Appeal Br. 13. As for claims 13 and 14, we agree. As for claims 1–12 and 15–20, we see no contradiction between the Examiner’s position that claims 1–12 and 15–20 are patent ineligible and our position in the decision (Dec.) in the prior appeal.

In our decision in Appeal 2015-002683, we reversed a rejection under 35 U.S.C. § 101. Representative claim 1 in that appeal read:

1. A method for implementing an action-based to-do list comprises:
 - accessing a task definition file listing an external application in which a to-do task on the action-based to-do list is to be performed, in which the task definition file comprises a number of criteria which are tracked and used to automatically manipulate the action-based to-do list;
 - automatically configuring the external application within the user’s computing environment to facilitate the user accomplishing the to-do task;
 - monitoring, with a personal management device, user actions within the external application;

comparing, with the personal management device, the user actions within the external application to the number of criteria in the task definition file;

determining when the user actions within the external application fulfill a criteria [sic] within the task definition file; and

automatically modifying the to-do list with the personal management device based on the fulfilled criteria.

Dec. 2.

Claim 13 in this appeal, reproduced below, appears to parallel said representative claim 1:

13. A computer program product for implementing an action-based to-do list comprising:

a non-transitory computer readable storage medium having computer readable program code disposed thereon, the computer readable program code comprising instructions to:

access a task definition file listing an external application in which a to-do task on the action-based to-do list is to be performed, in which the task definition file comprises a number of criteria which:

indicate completion of at least one to-do task; and
are tracked and used to automatically manipulate the action-based to-do list;

automatically configure the external application within the user's computing environment to facilitate the user accomplishing the to-do task;

monitor, with a personal management device, user actions within the external application;

compare, with the personal management device, the user actions within the external application to the number of criteria in the task definition file;

determine when the user actions within the external application fulfill a criteria [sic] within the task definition file; and automatically modify the to-do list with the personal management device based on the fulfilled criteria.

The Examiner does not separately explain why claim 13, which appears to parallel claim 1 that we found patent eligible, is nevertheless patent ineligible.

Accordingly, the rejection of claim 13, and claim 14 depending therefrom, under § 101 is reversed for the reasons discussed in the decision in Appeal 2015-002683.

As for claims 1–12 and 15–20, they do not parallel representative claim 1 in Appeal 2015-002683.

We stated, in Appeal 2015-002683, that “the claims present an unconventional technological solution (involving a task definition file; configuring an external application, etc.)” Dec. 5.

Reading the claims in light of the Specification, it becomes clear that the solution to the problem the inventors have sought to overcome is rooted in technology; that is, via a *task definition file* comprising a number of criteria; *automatically configuring the external application within the user’s computing environment* to facilitate a user accomplishing a to-do task; monitoring, with a *personal management device*, user actions within the external application; comparing, with the personal management device, the user actions within the external application to the number of criteria in the task definition file; determining when the user actions within the external application fulfill a criteria within the task definition file; and *automatically modifying the to-do list with the personal management device* based on the fulfilled criteria.

Id. at 4–5 (emphasis original).

Claims 1–12 and 15–20 here do not provide for “automatically configuring the external application within the user’s computing environment” and/or “automatically modifying the to-do list with the personal management device” (emphases omitted).

Accordingly, our discussion of representative claim 1 in the decision in the prior appeal does not apply to claims 1–12 and 15–20.

Introduction

35 U.S.C. § 101 provides that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor.”

In that regard, claim 1 covers a “process” and is thus statutory subject matter for which a patent may be obtained.² This is not in dispute.

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

In that regard, notwithstanding claim 1 covers statutory subject matter, the Examiner has raised a question of patent eligibility on the ground that claim 1 is directed to an abstract idea.

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

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

Alice step one — the “directed to” inquiry:

According to *Alice* step one, “[w]e must first determine whether the claims at issue are *directed to* a patent-ineligible concept.” *Alice*, 573 U.S. at 218 (emphasis added).

The Examiner determined

[t]he claim(s) recite(s) the following abstract idea indicated by non-boldface font and additional limitations indicated by boldface font:

*a non-transitory computer readable **storage medium** having computer readable program code disposed thereon, the computer readable program code comprising instructions to: access a task definition file listing an external application in which a to-do task on the action-based to-do list is to be performed, in which the task definition file comprises a number of criteria which; indicate completion of at least one to-do task; and are tracked and used to automatically manipulate the action-based to-do list; automatically configure the external application within the user’s computing environment to facilitate the user accomplishing the to-do task; monitor, with a **personal management device**, user actions within the external application; compare, with the **personal management device**, the user actions within the external application to the number of criteria in the task definition file; determine when the user actions within the external application fulfill a criteria within the task definition file; and automatically modify the to-do list with the **personal management device** based on the fulfilled criteria.*

Final Act. 6.

The Examiner’s characterization of the abstract idea to which the claims are directed to simply duplicates what claim 13 recites. Because we have already determined (in Appeal 2015-002683) that said recited subject matter is patent eligible, it cannot be directed to an abstract idea.

Furthermore, claim 1 is much broader than the “abstract idea” the Examiner determined it to be directed to.

Be that as it may, as we will explain, claim 1 is directed to a scheme for managing a to-do list, an abstract idea.

Appellant, on the other hand, argues that “Applicant’s specification is replete with examples indicating how it improves the functioning of the computer and/or technology.” Appeal Br. 15.

Accordingly, a dispute over whether claim 1 is directed to an abstract idea is present. Specifically, is claim 1 directed to a scheme for managing a to-do list or “improv[ing] the functioning of the computer and/or technology” (Appeal Br. 15)?

*Claim Construction*³

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

Claim 1 describes a “method for implementing an action-based to-do list.” The method comprises three steps.

The first and third steps involve a “personal management device.” The Specification exemplifies “computers, laptops, cell phones” as personal management devices. Spec. para. 31. Accordingly, in light of the Specification, “personal management device” is reasonably broadly construed as covering a generic computer. The second step is not attached to any device and therefore can be practiced mentally.

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

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

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

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

The first step calls for “monitoring user actions . . . to compare the user actions against a task definition file, which task definition file comprises a number of criteria which: indicate completion of at least one task: and are tracked and used to modify [an] action-based to do list.” The Specification does not provide an express definition for “task definition file” but illustrates said file on a display. *See* element 300 in Fig. 3. This step thus covers comparing user actions to certain criteria on display.

The second step calls for “determining when the user actions fulfill a criteria [sic] within the task definition file.” This step covers looking at the displayed criteria to determine whether a user action fulfills a criterion.

The third step calls for “modifying the action-based to-do list . . . based on fulfilled criteria.” This step covers modifying a to-do list based on a user action fulfilling a displayed criterion.

Claim 1 is reasonably broadly construed as covering a method employing a generic computer to perform a scheme for managing a to-do list by comparing user actions to certain criteria on display, determining whether a user action fulfills a criterion, and, if so, modifying the to-do list accordingly.

This comports with the Specification.

According to the Specification,

[i]n managing tasks which occur in their day-to-day schedules, people often use to-do lists. To-do lists describe the various tasks that the individual or group needs to accomplish. These to-do lists may take a variety of forms, including paper and electronic lists. While such lists help prevent the user from forgetting a task that needs to be performed, in many instances, managing a to-do list can be time consuming and disruptive. The user has to take the time to both add tasks to the list as they come

up and to remove or update tasks on the list as they are fully or partially completed.

Spec. para. 1. This is the problem the invention seeks to solve. Later, the Specification discusses the solution:

This specification describes systems and methods of managing a to-do list that monitor the actions of a user and interpret these actions with respect to the items on a to-do list so as to help create and manage the to-do list. In this way, the user does not always have to manually add items to their to-do list, and the user does not always need to mark items complete when they are done because the system will keep track of actions that constitute completion of at least some of the to-do tasks. The system recognizes the actions of the user and how they relate to the to-do list.

Id. at para. 21.

Given the method as claimed as reasonably broadly construed above and in light of the Specification's description of the objective of the invention, i.e., to improve the managing of to-do lists, we reasonably broadly construe claim 1 as being directed to a scheme for managing a to-do list by comparing user actions to certain criteria on display, determining whether a user action fulfills a criterion, and, if so, modifying the to-do list accordingly. To put it more succinctly, claim 1 is directed to a scheme for managing a to-do list.

*The Abstract Idea*⁷

Above, where we reproduce claim 1, we identify in italics the limitations we believe recite an abstract idea.⁸ Based on our claim construction analysis (above), we determine that the identified limitations describe a scheme for managing a to-do list. Managing to-do lists is a form of managing personal behavior. It falls within the enumerated “[c]ertain methods of organizing human activity” grouping of abstract ideas set forth in the 2019 Revised 101 Guidance.⁹ 2019 Revised 101 Guidance, 84 Fed. Reg. at 52.

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

⁸ This corresponds to Prong One (a) of Step 2A of the 2019 Revised 101 Guidance. “To determine whether a claim recites an abstract idea in Prong One, examiners are now to: (a) Identify the specific limitation(s) in the claim under examination (individually or in combination) that the examiner believes recites an abstract idea.” 84 Fed. Reg. at 54.

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

(b) Certain methods of organizing human activity—fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions).”

We note that Appellant has challenged the Examiner’s assessment that the “abstract idea” articulated by the Examiner is a “‘certain method[] of organizing human activity including managing personal behavior or relationships or interactions between people.’ (See final Action, p. 6).” Appeal Br. 13. Given that Appellant would likely challenge our similar assessment for the abstract idea we have articulated, we respond that we are unpersuaded that managing to-do lists is not a form of managing personal behavior, and thus falls in the Guidance’s “(b) Certain methods of organizing human activity” grouping. Appellant argues that “[t]here is no management, i.e., administration, control, etc. over any action/behavior of the individual or group of individuals. Accordingly, the claims are not directed to ‘managing personal behavior or relationships or interactions between people.’” Appeal Br. 13–14. We disagree. A to-do list is a sort of control over tasks long associated with efficient administration of personal behavior. *See also Accenture*, 728 F.3d at 1339, 1342 (determining that claims to automated methods for generating task lists to be performed by an insurance organization were directed to a patent-ineligible abstract idea).

Id. at 52.

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

As we pointed out earlier, our characterization of what the claim is directed to is different from the Examiner's. Although "[a]n abstract idea can generally be described at different levels of abstraction" (*Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240, 1240–41 (Fed. Cir. 2016) ("The Board's slight revision of its abstract idea analysis does not impact the patentability analysis.")), here where Examiner's articulation was previously determined as not being an abstract idea and is not commensurate in scope with what is now on appeal, our more germane characterization departs significantly from that of the Examiner.

We have reviewed the record and are unpersuaded as to error in our characterization of what claim 1 is directed to.

Appellant disagrees that claim 1 is directed to an abstract idea. Appellant's position is that claim 1 is directed to an improvement in the functioning of a computer. In support thereof, Appellant directs our attention to the Specification. "Applicant's specification is replete with examples

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

indicating how it improves the functioning of the computer and/ or technology.” Appeal Br. 15.

Three examples are given.

First,

paragraph [0001] of Appellant’s specification describes the problem wherein “managing a to-do list can be time consuming and disruptive” and that “with these lists there is no way to keep track of task completion except for the user manually indicating that they have fully or partially completed the task.” (Appellant’s Specification, paragraphs [0001] and [0020]).

Appeal Br. 15.

Appellant does not explain how this disclosure shows claim 1 is directed to an improvement in the functioning of a computer. If Appellant means to suggest that, in contrast to manually managing to-do lists, claim 1 calls for automatic management, that is not reflected in the claim. Claim 1 does not limit performing the steps in an automatic fashion. It is broader than that. Moreover, simply automating a manual process does not affect our determination that claim 1 is directed to an abstract idea. *Cf. Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1056 (Fed. Cir. 2017).

CAC suggests that the invention solves this problem because it “provides software that allows computers to supplant and enhance” the existing series of manual steps of securing financing—“a task they were previously not configured to perform.” CAC Opening Br. 28.

But merely “configur[ing]” generic computers in order to “supplant and enhance” an otherwise abstract manual process is precisely the sort of invention that the *Alice* Court deemed ineligible for patenting. *See Alice*, 134 S. Ct. at 2357–59 (“[T]he relevant question is whether the claims here do more than simply

instruct the practitioner to implement the abstract idea . . . on a generic computer.”);

Second,

[p]aragraph [0021] then describes how the present system and method address this problem, specifically to:

monitor the actions of a user and interpret these actions with respect to the items on a to-do list so as to help create and manage the to-do list. In this way, the user does not always have to manually add items to their to-do list, and the user does not always need to mark items complete when they are done because the system will keep track of actions that constitute completion of at least some of the to-do tasks.

(Appellant’s Specification, paragraph [0021]).

Appeal Br. 15.

Again, Appellant does not explain how this disclosure shows claim 1 is directed to an improvement in the functioning of a computer. If Appellant means to suggest that, in contrast to manually managing to-do lists, claim 1 calls for automatic management, that is not reflected in the claim. And moreover, simply automating a manual process does not affect our determination that claim 1 is directed to an abstract idea.

Third,

[p]aragraph [0032] of Appellant’s Specification further describes this solution. These paragraphs were particularly referenced by the Board in its affirmance of patent eligibility of the parent claims. Thus, the claimed invention improves a computer or other technology.

Id.

It is true that we referenced paragraph 32 of the Specification in reversing the §101 rejection of the claims on appeal in 2015-002683. *See* Dec. 4, reproduced below:

The Specification discusses how the system solves the problem, as exemplified in Fig. 1.

The action-based to-do list assists a user in remembering and accomplishing a variety of tasks. According to one illustrative embodiment, the personal management device contains a computer storage unit which stores a task definition file. The task definition file contains a number of criteria which can be tracked and used to automatically manipulate the to-do list. The processor of the personal management device monitors the user's actions and compares the user's actions to the criteria within the task definition file to determine if one or more of the criteria have been fulfilled. If a criterion has been met, the processor of the personal management device then modifies the to-do list based on the fulfilled criteria.

Para. 32. The claims are directed to such a system.

But the claims there on appeal reflected what is disclosed there. Claim 1 here appeal does not. Claim 1 does not require a personal management device to contain a computer storage unit which stores a task definition file, automatic manipulation of the to-do list, or the personal management device determining if one or more of the criteria have been fulfilled. These limitations, now missing from claim 1, were critical to our finding that “the solution to the problem the inventors have sought to overcome is rooted in technology.” Dec. 4. We explained in detail what we saw in representative claim 1 on appeal in 2015-002683 that rendered said claim patent eligible. *See id.* at4–5. These limitations have been stripped from claim 1 here on appeal, rendering the claim no longer rooted in

computer technology so as to direct it away from being directed to an abstract idea.

The three disclosures in the Specification Appellant relies upon do not persuasively show that the claim is directed to an improvement in computer functionality and are thus unpersuasive as to error in our determination that the claim is directed to an abstract idea.

Appellant also contends that “the claims very clearly describe a particular way to manage a to-do list which includes the use of a task definition file which describes the completion criteria for a task. Others may still manage a to-do list with or without the assistance of a task definition file.” Appeal Br. 16.

Appellant does not explain and we do not understand from this contention how the claim improves computer functionality. Accordingly, said contention is unpersuasive as to error in our determination that the claim is directed to an abstract idea.

For the foregoing reason, we do not find that the claim adequately reflects an improvement in computer functionality.

The method as claimed describes, in very general terms, steps for processing (via “monitoring,” “determining,” and “modifying” steps) certain types of information, e.g., a to-do list. The method as claimed is not focused on improving technology but on a scheme for managing a to-do list vis-a-vis a task definition file. *Cf. Trading Techs. Int’l, Inc. v. IBG LLC*, 921 F.3d 1378, 1384 (Fed. Cir. 2019) (“The claims are focused on providing information to traders in a way that helps them process information more quickly, ’556 patent at 2:26–39, not on improving computers or technology.”).

We have carefully reviewed the claim. Per our previous claim construction analysis, claim 1 is reasonably, broadly construed as covering a scheme for managing a to-do list. We see no specific asserted improvement in computer capabilities recited in the claim. Rather than being directed to any specific asserted improvement in computer capabilities, the claim supports the opposite view — that the claimed subject matter is directed to a scheme for managing a to-do list.

The claim provides no additional structural details that would distinguish any device required to be employed to practice the method as claimed, such as the recited “personal management device,” from its generic counterparts.¹¹

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

Beyond the abstract idea of offer-based price optimization, the claims merely recite “well-understood, routine conventional activit[ies],” either by requiring conventional computer activities or routine data-gathering steps. *Alice*, [573 U.S. at 225 (quoting

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

Mayo, 566 U.S. at 73)] For example, claim 1 recites “sending a first set of electronic messages over a network to devices,” the devices being “programmed to communicate,” storing test results in a “machine-readable medium,” and “using a computerized system . . . to automatically determine” an estimated outcome and setting a price. Just as in *Alice*, “all of these computer functions are ‘well-understood, routine, conventional activit[ies]’ previously known to the industry.” *Alice*, [573 U.S. at 225 (quoting *Mayo*, 566 U.S. at 73)] (alterations in original); see also *buySAFE[, Inc. v. Google, Inc.]*, 765 F.3d [1350,] 1355 [(Fed. Cir. 2014)] (“That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive.”).

We find Appellant’s suggestion that the claim presents a computer-improvement solution unpersuasive as to error in our characterization of what the claim is directed to because the method as claimed fails to adequately support it. We are unable to point to any claim language suggestive of an improvement in computer functionality. An attorney argument that such an improvement exists is alone insufficient. See generally *In re Glass*, 474 F.2d 1015, 1019 (CCPA 1973); *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); *In re Schulze*, 346 F.2d 600, 602 (CCPA 1965).

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

We have considered Appellant’s other arguments as though they were challenging our determination under step one of the *Alice* framework and find them unpersuasive. For the foregoing reasons, the record supports our determination that claim 1 is directed to an abstract idea.

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

Step two is “a search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 573 U.S. at 217–18 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)).

In that regard, the Examiner determined, *inter alia*, that “viewed as a whole, these additional claim element(s) do not provide meaningful limitation(s) to transform the abstract idea into a patent eligible application of the abstract idea such that the claim(s) amounts to significantly more than the abstract idea itself.” Final Act. 8.

In the context on what is claimed here on appeal, we agree.

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

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

or the second step of the *Alice/Mayo* [framework].” 2019 Revised 101 Guidance, 84 Fed. Reg. at 53.

Appellant’s arguments, discussed above, point to various disclosures in the Specification discussing the problem and solution.

But the arguments do not explain in what way the method, as it is claimed, provides a *technical* improvement. The arguments appear to rely on the claim’s result-based functional language involving the management of a to-do list.

Rather than being based on any technical details, the argument looks to the very scheme for managing to-do lists that we have characterized as being an abstract idea. In effect, such an argument posits that the abstract idea is “not well-understood, routine or conventional.” That may be but “[g]roundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology*, 569 U.S. at 591. *Cf. Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1315 (Fed. Cir. 2016).

Indeed, “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of *no relevance* in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 . . . (1981) (emphasis added); *see also Mayo*, 132 S. Ct. at 1303–04 (rejecting “the Government’s invitation to substitute §§ 102, 103, and 112 inquiries for the better established inquiry under § 101”).¹ Here, the jury’s general finding that Symantec did not prove by clear and convincing evidence that three particular prior art references do not disclose all the limitations of or render obvious the asserted claims does not resolve the question of whether the claims embody an inventive concept at the second step of *Mayo/Alice*.

The arguably unconventional nature of the abstract idea does not affect the determination that the claim is directed to an abstract idea. The abstract idea itself cannot amount to ““significantly more than a patent upon the [ineligible concept] itself.”” *Alice*, 573 U.S. at 218 (quoting *Mayo*, 566 U.S. at 73), whether or not it is conventional.

We are unpersuaded that claim 1 presents an element or combination of elements indicative of a specific asserted computer improvement, thereby rendering the claimed subject matter sufficient to ensure that the patent in practice amounts to significantly more than a patent upon a scheme for managing a to-do list.

We have reviewed the claim in light of the Specification and, as explained above, we find the claimed subject matter insufficiently expresses a computer improvement as a result of performing the functions as broadly as they are recited.

We cited the Specification in our earlier discussion. It is intrinsic evidence that the claimed “personal management device” as claimed is conventional. *See, e.g.*, Spec. para. 31. In doing so, we have adhered to the “Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP Inc.*[], 881 F.3d 1360 (Fed. Cir. 2018)),” USPTO Memorandum, Robert W. Bahr, Deputy Commissioner For Patent Examination Policy, April 19, 2018 (the “*Berkheimer* Memo”).

Here, the Specification indisputably shows the recited “personal management device” individually and in the context of managing a to-do list as claimed was conventional at the time of filing. Accordingly, there is sufficient factual support for the well-understood, routine, or conventional

nature of the claimed “personal management device” individually or in the combination as claimed.

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

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

Accordingly, because we are not persuaded as to error in the determination that representative claim 1, and claims 2–12, and 15–20 which stand or fall with claim 1, are directed to an abstract idea and do not present an “inventive concept,” we sustain the Examiner’s conclusion that they are directed to patent-ineligible subject matter for being judicially-excepted from 35 U.S.C. § 101. *Cf. LendingTree, LLC v. Zillow, Inc.*, 656 F. App’x 991, 997 (Fed. Cir. 2016) (“We have considered all of LendingTree’s remaining arguments and have found them unpersuasive. Accordingly, because the asserted claims of the patents in suit are directed to an abstract idea and do not present an ‘inventive concept,’ we hold that they are directed to ineligible subject matter under 35 U.S.C. § 101.”); *see, e.g., OIP Techs.*, 788 F.3d at 1364; *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016).

However, our reasoning — especially as to the articulation of the abstract idea — departs substantially from that of the Examiner. Accordingly, although we affirm the Examiner’s decision that the claims are

directed to patent-ineligible subject matter, we denominate our affirmance as a new ground of rejection.

The rejection of claims 1–20 under 35 U.S.C. § 103(a) as being unpatentable over Saravanan and James.

All the claims require a task definition file.

In that regard, the Examiner states (with respect to the claim 1 “monitoring” step that calls for a personal management device to compare user actions against a task definition file) the following:

(¶0113 The capabilities of the Daily Planner user interface make it ideally suited for basic delivery of elder care services. Consider the following scenario. Your older parent wants to live alone despite your protestations; you’re uncomfortable because you’re living at a distance. He needs to take his medication three times a day and it could get serious if he misses his medication. You set up the Mediabee application on an inexpensive PC (or on a consumer device licensed to run Mediabee application) in his home similar to system 110 in FIG. 1. It reminds him of his medication 3 times a day requiring that he acknowledge doing so. You’re in between meetings at your office when you notice that he didn’t take his medication in the afternoon -- so you call him. It turns out that he’s not feeling well so you need to visit him).

Final Act. 9.

We agree with Appellant that

nowhere in Saravanan is there anything at all similar to a task definition file. That is, the task definition file in claim 1 includes a number of criteria which “indicate completion of at least one task” and which “are tracked and used to modify), the action-based to do list.” (Claim 1). Saravanan does not include any sort of a description of this type of task definition file. Again, turning to the relied-on portions of Saravanan, what portion of the

disclosure describes a file that indicates criteria to determine when taking medication has been completed?

Appeal Br. 18.

We are unable to discern from the cited passage from the Specification what the Examiner is relying on as evidence that Saravanan discloses the “task definition file” as claimed. Neither the Final Action nor the Answer elaborate. Even if one were to interpret Saravanan’s “Daily Planner User Interface” (*see* Fig. 6 and associated disclosure at para. 72) as a “task definition file,” there is also the matter of the “task definition file” having to “compris[e] a number of criteria which: indicate completion of at least one task: and are tracked and used to modify the action-based to do list” (claim 1). These additional limitations have not been adequately shown to be disclosed in Saravanan or suggested by the combination of Saravanan and James.

Given no other evidence that said “task definition file” is disclosed or suggested by the cited prior art references, a prima facie case of obviousness has not been made out in the first instance. The rejection of the claims is not sustained.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed	New Ground
1–20	101	Eligibility	1–12, 15–20	13, 14	1–12, 15–20
1–20	103(a)	Saravanan, James		1–20	
Overall Outcome			1–12, 15–20	13, 14	1–12, 15–20

NEW GROUND

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground 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 prosecution will be remanded to the examiner. . . .
- (2) *Request rehearing.* Request that the proceeding be reheard under §41.52 by the Board upon the same Record. . . .

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

AFFIRMED IN PART; 37 C.F.R. § 41.50(b)