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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANDRES FABRIS and RICHARD PENDERGAST

Appeal 2020-003147
Application 14/599,956
Technology Center 3600

Before BIBHU R. MOHANTY, BRADLEY B. BAYAT, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

BAYAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 5–11, 15–20, and 22–27, which are all the claims pending in the application, under 35 U.S.C. § 101 as directed to a judicial exception without significantly more. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as “Traxo Inc.” Appeal Br. 2.

BACKGROUND

Appellant's invention is titled "**SYSTEM AND METHOD FOR PROVIDING A BEST FIT TRAVEL SERVICE RECOMMENDATION.**"

Appellant's "disclosure relates to a system and method for searching for a hotel or other travel service and providing one or more recommendations based on a user's stored profile information, loyalty preferences, previously submitted reviews, past travels, and/or previously booked travel." Spec. ¶ 2.

The Background section of the Specification discloses:

With the convenience of the internet, the need to call many different hotels or other travel services for price checks and availability is coming to an end. Booking travel services online is more popular than ever. Many travel sites lists hotels or other travel services where the user is traveling. The list of hotels is normally randomized and has no specific customization to the individual user. In many cases, the search results are presented to the user based on distance from an arbitrary location or are based upon ultimate profitability for the website or travel service supplier.

Id. ¶ 3.

Appellant's invention purportedly solves this problem by "searching for a hotel or other travel service and providing one or more recommendations based on a user's stored profile information, loyalty preferences, previously submitted reviews, past travels, and/or previously booked travel." *Id.* ¶ 4.

CLAIMED SUBJECT MATTER

Claims 1, 11, and 20 are independent and recite substantially similar subject matter. Independent claim 1, reproduced below with added bracketed notations, is representative of the claimed subject matter. *See* Appeal Br., Claims App.

1. A method for recommending travel services, comprising:

[(a)] determining, *by a processor*, that a travel service is required for a trip destination of a user;

[(b)] selecting, *by the processor*, a pool of travel services associated with the trip destination;

[(c)] filtering, *by the processor*, the pool of travel services into a filtered group of travel services using one or more filters;

[(d)] sorting, *by the processor*, the filtered group of travel services into a list using one or more sort criteria; and

[(e)] *controlling, by the processor, a display to display the list to the user*, [(f)] wherein selecting the pool of travel services associated with the trip destination comprises:

[(1)] determining whether any first travel services are associated with a prior booking by the user at the trip destination and, if so, including the first travel services in the pool of travel services;

[(2)] upon a determination that a number of travel services in the pool of travel services is less than a predetermined threshold, determining whether any second travel services are associated with a prior booking by the user in

a larger geographical area surrounding the trip destination, and if so, including the second travel services in the pool of travel services;

[(3)] upon a determination that the number of travel services in the pool of travel services is less than the predetermined threshold after the second travel services are included, determining whether any third travel services are associated with a booking by one or more buddies of the user at the trip destination and, if so, including the third travel services in the pool of travel services; and

[(4)] upon a determination that the number of travel services in the pool of travel services is less than the predetermined threshold after the third travel services are included, (i) determining one or more second users that have a travel score in a range of travel scores associated with a travel score of the user, the travel score of each user indicating a travel savviness of the user, and (ii) determining whether any fourth travel services are associated with a booking by the one or more second users at or near the trip destination, and if so, including the fourth travel services in the pool of travel services.

OPINION

Under 35 U.S.C. § 101, an invention is patent eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and

abstract ideas” are not patentable. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp.*, 573 U.S. at 217. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 78, 79). This 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.’” *Id.* at 217–18 (alteration in original) (citation omitted).

In rejecting claims 1, 5–11, 15–20, and 22–27 as being directed to an abstract idea without significantly more, the Examiner evaluated the claims together under the *Alice* framework and the 2019 Revised Guidance.² Final

² The U.S. Patent and Trademark Office (“USPTO”) published revised guidance for use by USPTO personnel in evaluating subject matter eligibility under 35 U.S.C. § 101. 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50, 57 (Jan. 7, 2019) (the “2019 Revised Guidance”). That guidance revised the USPTO’s examination

Act. 7–10. Appellant argues claims 1, 5–11, 15–20, and 22–27 as a group, and selects claim 1 for discussion. Appeal Br. 10–18. We select claim 1 as representative of the group, with claims 5–11, 15–20, and 22–27 standing or falling therewith. 37 C.F.R. § 41.37(c)(1)(iv)(2019).

Statutory Categories under § 101

To determine subject matter eligibility under 35 U.S.C. § 101, the Examiner must first determine if the claims fall into one of the four statutory categories of invention: processes, machines, manufactures, or composition of matter. *See* MPEP § 2106.03. There is no dispute that independent claim 1 recites a method and is directed to a process, which is one of the statutory categories under § 101.

We now turn to the two step *Alice* framework.

Step One of the Alice Framework (2019 Revised Guidance, Step 2A)
Step 2A, Prong One

The first step in the *Alice* framework is to determine whether the claims at issue are “directed to” a patent-ineligible concept, e.g., an abstract idea. *Alice Corp.*, 573 U.S. at 217. This first step, as set forth in the 2019 Revised Guidance (i.e., Step 2A), is a two-prong test; in Step 2A, Prong One, the Examiner must look to whether the claim recites a judicial exception, e.g., one of the following three groupings of abstract ideas: (1) mathematical concepts; (2) certain methods of organizing human activity, e.g., fundamental economic principles or practices, commercial or

procedure with respect to the first step of the *Alice* framework by (1) “[p]roviding groupings of subject matter that [are] considered an abstract idea”; and (2) “clarifying that a claim is not ‘directed to’ a judicial exception if the judicial exception is integrated into a practical application of that exception.” *Id.* at 50.

legal interactions; and (3) mental processes. 2019 Revised Guidance, 84 Fed. Reg. at 54.

To that end, the Examiner determines that representative claim 1 “as a whole recites a method of organizing human activity.” Final Act. 7. According to the Examiner, steps (a)–(d) and (f)(1)–(f)(4) of claim 1 *supra* (not italicized) recite “a method of managing interactions between people, which falls into the methods of organizing human activity grouping.” *Id.* at 8. The Examiner indicates that “[t]he travel service and pool of travel services provided into a filtered group through the use of one or more filters are all part of the abstract idea.” Ans. 4. The Examiner asserts that the “mere recitation of a generic computer (processor, display of claim 1) does not take the claim out of the methods of organizing human activity grouping. Thus, the claim recites an abstract idea.” *Id.* at 8.

Appellant does not contest the Examiner’s evaluation of the abstract idea under Step 2A, Prong One.³ Instead, Appellant contends that claim 1 is integrated into a practical application under Step 2A, Prong Two. *See* Appeal Br. 13–16.

This abstract idea of recommending travel services based on user information is not meaningfully different from the ideas found to be abstract in other cases before our reviewing court involving methods of organizing human activity. For example, in *Bridge and Post, Inc. v. Verizon Communications, Inc.*, 778 F. App’x 882 (Fed. Cir. 2019), the Federal

³ *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (“If an appellant fails to present arguments on a particular issue — or, more broadly, on a particular rejection — the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection.”).

Circuit held that abstract ideas include tracking a user’s computer network activity and using information gained about the user to deliver targeted media, such as advertisements. *See also, e.g., Affinity Labs of Texas, LLC v. Amazon.com, Inc.*, 838 F.3d 1266, 1271 (Fed. Cir. 2016) (customizing a user interface to have targeted advertising based on user information); *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015) (tailoring information presented to a user based on particular information); *Morsa v. Facebook, Inc.*, 77 F. Supp. 3d 1007, 1013 (C.D. Cal. 2014), *aff’d*, 622 F. App’x 915 (Fed. Cir. 2015) (concluding that targeting advertisements to certain consumers is no more than an abstract idea); *BASCOM Global Internet v. AT&T Mobility, LLC*, 827 F.3d 1341, 1345–46 (Fed. Cir. 2016) (finding that filtering content was an abstract idea under step 2A). In light of these precedents, claim 1 equally recites an abstract idea.

Step 2A, Prong Two

Having concluded that claim 1 recites a judicial exception, i.e. an abstract idea (Step 2A, Prong One), we next consider whether the claim recites additional elements that integrate the judicial exception into a practical application (Step 2A, Prong Two). 2019 Revised Guidance, 84 Fed. Reg. at 51. When a claim recites a judicial exception and fails to integrate the exception into a practical application, the claim is “directed to” the judicial exception. *Id.* A claim may integrate the judicial exception when, for example, it reflects an improvement to technology or a technical field. *Id.* at 55.

The Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the specification,

based on whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). It asks whether the focus of the claims is on a specific improvement in relevant technology or on a process that itself qualifies as an “abstract idea” for which computers are invoked merely as a tool. *See id.* at 1335–36.

Under Step 2A, Prong Two, the Examiner determines:

This judicial exception is not integrated into a practical application because the claim recites the additional elements [italicized in claim 1 *supra*] of (controlling, by the processor, a display to display the list to the user) [as recited in step (e)]. The processor and display in the claims, are recited at a high level of generality and are generically recited computer elements. The generically recited computer elements amount to simply implementing the abstract idea on a computer.

Final Act. 9 (alteration from original).

Appellant argues that claim 1 provides a “method for electronically determining and presenting a user with a customized list of recommended hotels or other travel services directed at the individual user for a travel destination. Such a practical application is reflected in the additional elements recited in” steps (f)(1)–(f)(4). Appeal Br. 13–14. In support of this argument, Appellant relies on Example 40 of the Subject Matter Eligibility Examples released with the 2019 Revised Guidance. *Id.* at 14–16; Reply Br. 3–4.

We are not persuaded by Appellant’s argument at least because the features Appellant relies on are part of the abstract idea, which cannot integrate that into a practical application. Under Step 2A, Prong two, “examiners evaluate whether the claim recites *additional elements* that

integrate the exception into a practical application of that exception.”
84 Fed. Reg. at 54 (emphasis added). As such, features of the abstract idea cannot be relied upon to integrate itself into a practical application.

We also are unpersuaded by Appellant’s argument that Example 40 is similar to claim 1. According to Appellant, “taken as a whole, instant Claim 1 recites a combination of features and limitations that are very analogous to the kind of limitations described as making Claim 1 of Example 40 to be integrated into a practical application.” Appeal Br. 16. Example 40 “as a whole is directed to a particular improvement in collecting traffic data. Specifically, the method limits collection of additional Netflow protocol data to when the initially collected data reflects an abnormal condition, which avoids excess traffic volume on the network and hindrance of network performance.” *Id.* at 15. Unlike the alleged “improvement in electronically determining and presenting a user with a customized list of recommended hotels or other travel services” (*id.* at 16), the improvement in Example 40 is related to “improved network monitoring,” which improves network technology. Claim 1 is distinguished from Example 40 because claim 1 does not recite any communications network, let alone improvements to network technology.

We agree with the Examiner that Appellant’s alleged improvement may reflect an improvement to the abstract idea of recommending travel services based on user information, but that does not reflect “improvements to the way the computer/processor functions.” Ans. 5 (“Rather the improvement is through the business aspect of the invention.”). We recognize that “[s]oftware can make non-abstract improvements to computer technology just as hardware improvements can, and sometimes the

improvements can be accomplished through either route.” *Enfish*, 822 F.3d at 1335. However, “to be directed to a patent-eligible improvement to computer functionality, the claims must be directed to an improvement to the functionality of the computer or network platform itself.” *Customedia Techs., LLC v. Dish Network Corp.*, 951 F.3d 1359, 1365 (Fed. Cir. 2020) (citing *Enfish*, 822 F.3d at 1336–39). Claim 1 recites generic components arranged in no particular way to perform generic functions of determining, selecting, filtering, sorting, and displaying without improving computers or networks. The Specification’s description of these components makes clear that they are generic components that do not improve the functioning of a computer or other technology, and which are used as tools in their ordinary capacity to implement the abstract idea. *See, e.g.*, Spec. ¶¶ 53–59, Fig 5.

Accordingly, we determine that claim 1 lacks any additional elements sufficient to integrate the abstract idea into a practical application.

Step Two of the Alice Framework (2019 Revised Guidance, Step 2B)

We next consider whether claim 1 recites additional elements, individually, or as an ordered combination, that provide an inventive concept. *Alice*, 573 U.S. at 217–18. The second step of the *Alice* test is satisfied when the claim limitations involve more than performance of well-understood, routine, and conventional activities previously known to the industry. *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1367 (Fed. Cir. 2018).

Appellant argues that “the Examiner does not include any of these four supportive elements . . . [discussed in the *Berkheimer Memo*] to demonstrate that the combination of features recited in Claim 1 is well-understood, routine, or conventional” because “Claim 1 recites far more

additional elements than a generic conventional processor and the alleged abstract idea of ‘recommending travel services to a user.’” Appeal Br. 17.

For example, as discussed above, Claim 1 recites multiple determining operations associated with multiple different conditions: (i) whether any first travel services are associated with a prior booking by a user, (ii) whether any second travel services are associated with a prior booking by the user in a larger geographical area surrounding the trip destination, (iii) whether any third travel services are associated with a booking by one or more buddies of the user at the trip destination, and (iv) whether any fourth travel services are associated with a booking by the one or more second users at or near the trip destination. Claim 1 also recites operations (including travel services in a pool of travel services) that are performed only when each of these four conditions is true. Claim 1 also recites additional elements such as one or more filters. None of these additional elements are discussed by the Examiner in conjunction with Step 2 (also known as Step 2B) of the *Alice/Mayo* test.

Id. at 17–18. We are not persuaded of error.

We agree with the Examiner that claim 1 lacks additional elements that are sufficient to amount to significantly more than the judicial exception. Final Act. 9. In compliance with the *Berkheimer* memo, the Examiner cited to the Specification and court decisions noting the well-understood, routine, conventional nature of the additional elements. *See* Final Act. 9–10. As discussed, the additional elements recited in claim 1, i.e., “processor” and “controlling, by the processor, a display to display the list to the user” as recited in step (e) are generic computer components (*see* Spec. ¶¶ 53–59) that perform well-understood, routine, or conventional functions of determining, selecting, filtering, sorting, and displaying at a high level of generality. In fact, Appellant acknowledges that the claimed processor is a “generic conventional processor.” Appeal Br. 17. *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 Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1316 (Fed. Cir. 2011) (“Absent a possible narrower construction of the terms ‘processing,’ ‘receiving,’ and ‘storing,’ discussed below, those functions can be achieved by any general purpose computer without special programming.”).

As an ordered combination, these additional elements provide no more than when they are considered individually. *Alice*, 573 U.S. at 225. They recite generic computer components that perform well-understood and conventional functions. They are used as tools to implement the judicial exception. *See SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1169–70 (Fed. Cir. 2018) (limitations of various databases and processors did not improve computers but used already available computers and available functions as tools to execute the claimed process); *Inventor Holdings LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (considering the method steps of the representative claims as an “ordered combination” reveals that they “amount to ‘nothing significantly more’ than an instruction to apply [an] abstract idea” using generic computer technology).

Further, the Examiner under the second step of the *Alice* analysis and the Revised Guidance properly considers whether claim 1 adds a specific limitation beyond a judicial exception that is not “well-understood, routine, conventional” activity in the field. 2019 Revised Guidance, 84 Fed. Reg. 56. Appellant’s argument *supra* relies on features which are part of the abstract idea, yet, “[i]t has been clear since *Alice* that a claimed invention’s use of the ineligible concept to which it is directed cannot supply the inventive concept

that renders the invention ‘significantly more’ than that ineligible concept.” *BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018).

We disagree with Appellant’s contention that “[b]y withdrawing the rejection of the claims under Section 103, the Examiner concedes that the prior art of record does not teach or suggest these elements, and so as a matter of *fact* the claims cannot be considered to be well-understood, routine, or conventional.” Reply Br. 7. “The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89, (1981). Even if the steps are groundbreaking, innovative, or brilliant, that is not enough for eligibility. *See Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). Indeed, “the absence of the exact invention in the prior art does not prove the existence of an inventive concept.” *Western Express Bancshares v. Green Dot Corp.*, Appeal No. 2020-1079, 2020 WL 3967855, *3 (Fed. Cir. July 14, 2020).

Accordingly, we agree with the Examiner that claim 1 lacks an inventive concept sufficient to transform the abstract idea into patent-eligible subject matter. Thus, we sustain the rejection of independent claim 1 as directed to a judicial exception under 35 U.S.C. § 101, and claims 5–11, 15–20, and 22–27, which fall with claim 1.

CONCLUSION

The Examiner's rejection of claims 1, 5–11, 15–20, and 22–27 under 35 U.S.C. § 101 is affirmed.

In summary:

| Claims Rejected | 35 U.S.C. § | Reference(s)/Basis | Affirmed | Reversed |
|------------------------------|--------------------|---------------------------|------------------------------|-----------------|
| 1, 5–11, 15–20, 22– 27 | 101 | Eligibility | 1, 5–11, 15–20, 22– 27 | |

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