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43850	7590	06/17/2016	EXAMINER	
MORGAN, LEWIS & BOCKIUS LLP (SF) One Market, Spear Street Tower, Suite 2800 San Francisco, CA 94105			SHANKER, JULIE MEYERS	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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sfipdocketing@morganlewis.com
donald.mixon@morganlewis.com

Art Unit: 3689

The present application is being examined under the pre-AIA first to invent provisions.

DETAILED ACTION

RESPONSE TO PTAB DECISION

1. In the decision by the Board of Patent Appeals and Interferences mailed **March 11, 2016**, the rejections of **claims 1-14, 18-35, 37 and 38** under **35 USC §103** were reversed. The reason for the reversal of **claims 1-14, 18-35, 37 and 38** were, in substance, that the Patent Trial and Appeal Board stated that, “The Examiner cites paragraph 56 of MacDaniel as support for the proposition that remote system 16 acts as an agency to initiate a data store query on behalf of the first and second participants. Yet, that paragraph describes that an employer “after logging into the system” inputs “specific keywords that match the type of job seeker” he or she wants for an available job. Thus, rather than the remote system querying the system on behalf of the employer, MacDaniel discloses, in paragraph 56, that the employer accesses the system and performs the query for him or herself. We fail to see how the ability to perform a query of a data store can be considered anything other than access to the data store itself. Indeed, as Appellant points out, the Examiner’s interpretation “would require that the remote server — acting as an agent on behalf of the first/second member — send an electronic query over the Internet or wide area network to itself— acting as the tangible computer readable media hosting the data store.” For the reasons set forth above, we are persuaded that the Examiner erred in rejecting claim 1 as obvious over the combination of MacDaniel, Springett, AAPA, and Document 1.” (Board Decision, pg. 5).

Art Unit: 3689

Upon review, claims 1-14, 18-35, 37 and 38 are directed to non-statutory subject matter with respect to 101 eligibility guidance. Therefore, under 37 CFR 1.198, prosecution is hereby reopened (see MPEP 1214.04). The new grounds of rejection are detailed below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Technology Center Director has approved of reopening prosecution by signing below:

Status of Claims

Claims 1-14, 18-35, 37 and 38 have been reversed by the Patent Trial and Appeal Board for the rejections under 35 USC 103(a).

Claim Rejections - 35 USC § 101

35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims **1-14, 18-35, 37 and 38** are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. When considering subject matter eligibility under 35 U.S.C. § 101, it must be determined whether the claim is directed to one of the four statutory categories of invention, i.e., process, machine, manufacture, or composition of

Art Unit: 3689

matter. If the claim does fall within one of the statutory categories, it must then be determined whether the claim is directed to a judicial exception (i.e., law of nature, natural phenomenon, and abstract idea), and if so, it must additionally be determined whether the claim is a patent-eligible application of the exception. If an abstract idea is present in the claim, any element or combination of elements in the claim must be sufficient to ensure that the claim amounts to significantly more than the abstract idea itself. Examples of abstract ideas include fundamental economic practices, certain methods of organizing human activities, an idea itself, and mathematical relationships/formulas. *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*, 573 U.S. ___ (2014).

In the instant case, claims 1-14 and 18-35 are directed to a method (i.e., process), claim 37 is directed to a computer program product (i.e., product) and claim 38 is direct to a system (i.e., a machine). Claims 1-14, 18-35, 37 and 38 fall within one of the statutory categories.

With regard to claims 1-14, 18-35, 37 and 38, the claims fall within the judicial exception of an abstract idea. The abstract idea of the claims is defined by the claimed steps/functions of *initiating a query on behalf of a first member. . . or a second member. . . of a data store, which comprises or has access to a plurality of records; when the electronic query is on behalf of the first member, the electronic query includes a first plurality of request parameters that collectively define a first plurality of characteristics of a qualifying family that may adopt an unborn or newly born child from the first member; (ii) when the electronic query is on behalf of the second member, the electronic query includes a second plurality of request parameters that collectively define a second plurality of characteristics of (i) a qualifying unborn child or newly born child that may be adopted by the second member and (ii) optionally a birth parent of the unborn child or newly born child; searching the data store with the query, thereby obtaining a search result comprising one or more records in the plurality of records that match the query, wherein when*

Art Unit: 3689

the electronic query is on behalf of the first member, each record in the search result is of a member in the second class of adoption participants, and when the electronic query is on behalf of the second member, each record in the search result is of a member in the first class of adoption participants; optionally, outputting the search result . . .

Thus, the claimed invention is directed to an idea of itself and a method of organizing human activity. More specifically, the claims are similar to the abstract idea of *Cybersource*, where it was found that the obtaining and comparing of intangible data was abstract. In the pending claims, applicant is retrieving and comparing data in the form of adoption requirements, and is using rules to determine whether or not an adoption match is present. Moreover, the examiner asserts that the claims relate to managing relationships or transactions, as the claims are directed towards performing searches to match adoption participants with one another. Courts have found in several instances that concepts relating to managing relations or transactions between people were abstract. As noted in the July 2015 Update: Subject Matter Eligibility, pg. 4:

Several cases have found concepts relating to managing relationships or transactions between people abstract, such as creating a contractual relationship (*buySAFE*), hedging (*Bilski*), mitigating settlement risk (*Alice Corp.*), processing loan information (*Dealertrack*), managing an insurance policy (*Bancorp*), managing a game of Bingo (*Planet Bingo*), allowing players to purchase additional objects during a game (*Gametek*), and generating rule-based tasks for processing an insurance claim (*Accenture*).¹¹

Therefore, because the recited limitations of independent claims 1, 37 and 38 relate to an idea of itself and a method of organizing human activity, the examiner asserts that the claims are directed towards an abstract idea.

Finding the claims to be directed toward an abstract idea, however, is not the end of the inquiry. *See Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1297 (2012). Rather, the second step requires determining whether additional substantive limitations

Art Unit: 3689

narrow, confine, or otherwise tie down the claim so that, in practical terms, it does not cover the full abstract idea itself. Another way of stating the test is whether the claim language provides “significantly more” than the abstract idea itself.

Applying the test to the claims in the instant application, the structural elements in Claims 1-14, 18-35, 37 and 38 (e.g., data store, tangible computer readable media, a computer that performs the recited search electronically, a central processing unit, a memory, coupled to the central processing unit storing a module, instructions, display) when taken in combination with the functional elements of the claim, together do not offer “significantly more” than the abstract idea itself because the claims do not recite an improvement to another technology or technical field, an improvement to the functioning of any computer itself, or provide meaningful limitations beyond generally linking an abstract idea, namely, matching adoption participants, to a particular technological environment (i.e., a general purpose computer).

Here, the claims require no more than a generic computer devices to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry. For example, the recited structural elements are doing nothing more than performing well-understood, routine, and conventional activities already known in the industry. For example, the tangible computer readable media stores the data store and the recited computer searches the data store by electronic query to find matches. This is nothing more than the performance of receiving, processing and storing data, and/or automating a mental task, which the courts have recognized to be well-understood, routine and conventional functions. See July 2015 Update: Subject Matter Eligibility, pg. 7. Additionally, the step of outputting the match results to a display, tangible computer readable storage product, computer or tangible random access memory is merely directed toward the concept of data output, which is considered by the examiner to constitute insignificant extra-solution activity. Lastly, the

Art Unit: 3689

claimed module storing instructions amounts to mere instructions to implement the abstract idea of matching adoption participants on a computer. Viewing the limitations as an ordered combination does not add anything further than looking at the limitations individually. When viewed either individually, or as an ordered combination, the additional limitations do not amount to a claim as a whole that is significantly more than the abstract idea.

The dependent claims are merely reciting further embellishment of the abstract idea and do not amount to anything that is significantly more than the abstract idea itself. Claims 8-13 recite receiving the electronic query and transmitting the results of the electronic query over the Internet or wide area network from/to a remote computer. This, however, is simply receiving or transmitting of data over a network, which the courts have considered to be well-understood, routine and convention functions when claimed in a generic manner. Claims 24-34 additionally recite functions recognized as well-known, conventional functions amounting to receiving, processing and storing data, automating mental tasks and receiving or transmitting data over a network. See July 2015 Update: Subject Matter Eligibility, pg. 7. Therefore, Claims 1-14, 18-35, 37 and 38 are directed to non-statutory subject matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JULIE M. SHANKER whose telephone number is (571)270-5460. The examiner can normally be reached on M-F 9:00am- 5:00pm CST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3689

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JULIE M SHANKER/
Primary Examiner, Art Unit 3689

/GREG VIDOVICH/
Director, Technology Center 3600