

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC., DOMINO'S PIZZA, INC., DOMINO'S PIZZA, LLC,
FANDANGO, LLC, AND OPENTABLE, INC.,
Petitioner,

v.

AMERANTH, INC.,
Patent Owner.

Case CBM2014-00013
Patent No. 6,982,733 B1

Before JAMESON LEE, MEREDITH C. PETRAVICK, and
NEIL T. POWELL, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
Covered Business Method Patent Review
35 U.S.C. § 328(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Apple Inc., Fandango, LLC, OpenTable, Inc., Domino's Pizza, Inc., and Domino's Pizza, LLC (collectively, "Petitioner") filed a Petition (Paper 10, "Pet.") requesting review under the transitional program for covered business method patents of claims 1–16 of U.S. Patent No. 6,982,733 B1 (Ex. 1033, "the '733 patent"). On March 26, 2014, pursuant to 35 U.S.C. § 324, we instituted this trial as to claims 1–16 on the proposed ground of unpatentability under 35 U.S.C. § 101. Paper 23 ("Dec. to Inst."). Ameranth, Inc. ("Patent Owner") filed a Patent Owner Response (Paper 29, "PO Resp.") and Petitioner filed a Reply (Paper 30, "Reply").

An oral hearing in this proceeding was held on October 24, 2014. A transcript of the hearing is included in the record (Paper 34, "Tr."). The oral hearing was consolidated with the oral hearing for related CBM2014-00015 and CBM2014-00016.

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1, 2, 4, 5, 10, and 12 of the '733 patent are unpatentable.

A. The '733 Patent

The '733 patent relates to an information management and synchronous communication system and method for generating and transmitting computerized menus for restaurants. Ex. 1033, Abstract. Figure 1 of the '733 patent is reproduced below:

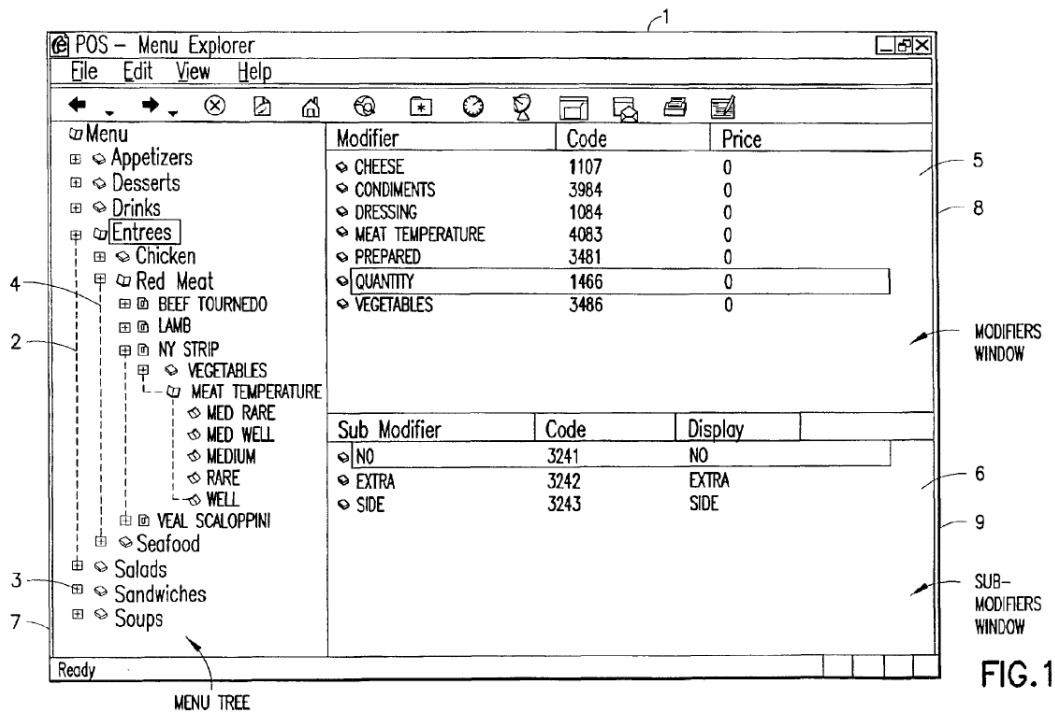


Figure 1 is a schematic representation of the menu display/user interface of the preferred embodiment of the '733 patent.

As shown in Figure 1, Graphical User Interface ("GUI") 1 includes menu tree 7, modifiers window 8, and sub-modifiers window 9. *Id.* at col. 7, ll. 44–48. GUI 1 is used to build a menu on a desktop or other computer. *Id.* at col. 7, ll. 28–29. Menu items are categorized and displayed in a hierarchical manner in menu tree 7. Modifiers (e.g., salad dressing) are shown in modifiers window 8, and sub-modifiers (e.g., Italian dressing, French dressing, Ranch dressing, etc.) are shown in sub-modifiers window 9. *Id.* at col. 7, ll. 30–36. Once the menu is built using GUI 1, the menu may be downloaded to a handheld device or web page. Ex. 1033, col. 10, ll. 1–9, col. 11, ll. 12–18.

Figure 7 is reproduced below:

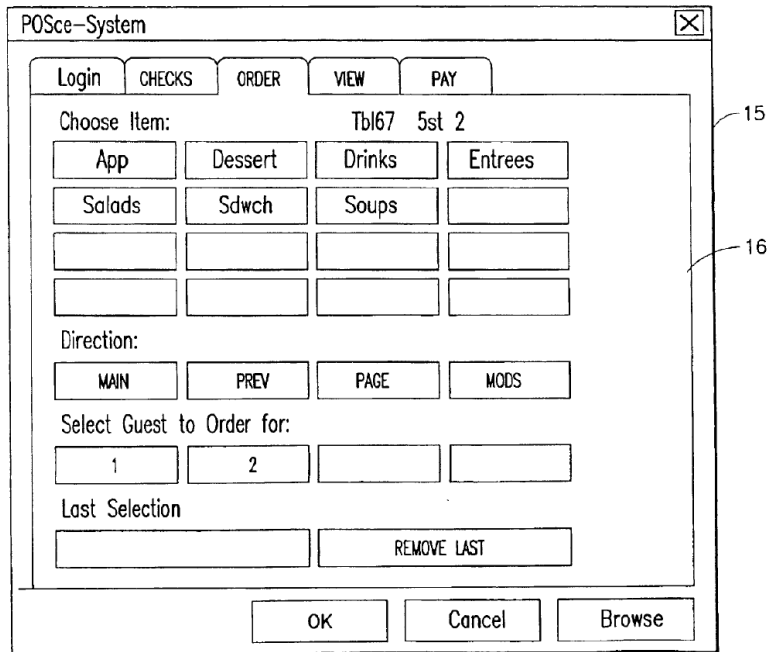


FIG.7

Figure 7 depicts the interface on a typical wireless device used in conformity with the invention of the '733 patent.

As shown in Figure 7, “the page menu is displayed in a catalogue-like point-and-click format . . . [thereby allowing] a person with little expertise [to] ‘page through’ to complete a transaction with the POS [point of sale] interface and avoid having to review the entire menu of Fig. 1 to place an order.” Ex. 1033, col. 11, ll. 34–39. This interface could be shown on a PDA or web page. *Id.* at col. 11, l. 40.

Figure 8 is reproduced below:

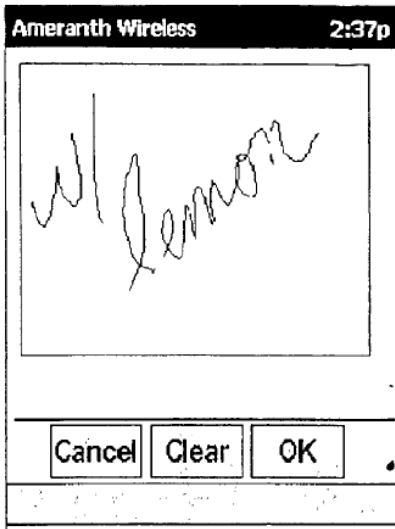


Figure 8 depicts the handwritten screen according to one embodiment of the '733 patent.

In one embodiment, a server may take a drink order by selecting “Iced Tea” from the menu on the handheld device. Ex. 1033, col. 4, ll. 6-7. As shown in Fig. 8, the server then may manually modify the order by writing “w/ lemon” on the screen on the device. *Id.* at col. 4, ll. 7–9, Fig. 8. The manually modified drink order is then presented to the individual preparing the drinks. *Id.* at col. 4, ll. 9–11.

B. Illustrative Claims

Claims 1 and 12 of the '733 patent are illustrative of the claims at issue and read as follows:

1. An information management and synchronous communications system for generating and transmitting menus comprising:
 - a. a central processing unit,
 - b. a data storage device connected to said central processing unit,

- c. an operating system including a graphical user interface,
- d. a first menu consisting of menu categories, said menu categories consisting of menu items, said first menu stored on said data storage device and displayable in a window of said graphical user interface in a hierarchical tree format,
- e. a modifier menu stored on said data storage device and displayable in a window of said graphical user interface,
- f. a sub-modifier menu stored on said data storage device and displayable in a window of said graphical user interface, and
- g. application software for generating a second menu from said first menu and transmitting said second menu to a wireless handheld computing device or Web page, wherein the application software facilitates the generation of the second menu by allowing selection of categories and items from the first menu, addition of menu categories to the second menu, addition of menu items to the second menu and assignment of parameters to items in the second menu using the graphical user interface of said operating system, said parameters being selected from the modifier and sub-modifier menus, wherein said second menu is manually modified after generation.

12. In a computer system having an input device, a storage device, a video display, an operating system including a graphical user interface and application software, an information management and synchronous communications method comprising the steps of:

- a. outputting at least one window on the video display;
- b. outputting a first menu in a window on the video display;
- c. displaying a cursor on the video display;

- d. selecting items from the first menu with the input device or the graphical user interface;
- e. inserting the items selected from the first menu into a second menu, the second menu being output in a window;
- f. optionally adding additional items not included in the first menu to the second menu using the input device or the graphical user interface;
- g. storing the second menu on the storage device; and synchronizing the data comprising the second menu between the storage device and at least one other data storage medium, wherein the other data storage medium is connected to or is part of a different computing device, and wherein said second menu is manually modified after generation.

C. Related Proceedings

Both parties identify numerous related ongoing district court proceedings. Pet. 10–11; Paper 3, 4–5.

In addition, Petitioner requested covered business method patent review of the following related patents: U.S. Patent No. 6,348,850 (CBM2014-00015; “the ’850 patent”) and U.S. Patent No. 8,871,325 (CBM2014-00016). We instituted covered business method patent review in CBM2014-00015 and CBM2014-00016, and final written decisions in those proceedings are entered concurrently with this decision.

Petitioner also requested covered business method patent review of related U.S. Patent No. 8,146,077 (CBM2014-00014). We did not institute covered business method patent review in CBM2014-00014.

D. Alleged Ground of Unpatentability

Petitioner alleges that claims 1–16 are unpatentable under 35 U.S.C. § 101.

II. ANALYSIS

A. Arguments Incorporated By Reference

In footnote 10 on pages 12–13 of the Patent Owner Response, Patent Owner attempts to incorporate certain arguments made in its Preliminary Response (Paper 13) into the Patent Owner Response. Our rules prohibit incorporating arguments by reference. 37 C.F.R. § 42.6(a)(3) states: “[a]rguments must not be incorporated by reference from one document into another document.” Incorporation by reference circumvents our rule limiting the pages in the Patent Owner response to 80 pages. *See* 37 C.F.R. § 42.24(b)(2). Arguments that are not developed and presented in the Patent Owner Response, itself, are not entitled to consideration. *See* Paper 24, 2–3. (cautioning Patent Owner “that any arguments for patentability not raised and fully briefed in the response will be deemed waived”).

B. Claim Construction

The Board interprets claims of unexpired patents using the broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.300(b). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set

forth with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). In the absence of such a definition, limitations are not to be read from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Prior to construing the relevant claim limitations, we turn to some initial matters raised by Patent Owner. First, Patent Owner argues that we must construe “the entirety of the challenged claims” (PO Resp. 31), and proposes constructions for some, but not all, limitations of the challenged claims (*see id.* at 34–36). Claim construction, however, “is not an inviolable prerequisite to a validity determination under § 101.” *Bancorp Servs. L.L.C. v. Sun Life Assur. Co. of Canada (U.S.), L.L.C.*, 687 F.3d 1266, 1273 (Fed. Cir. 2012). *See, e.g., Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (only those terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy). Below, we construe the limitations that are relevant to the issues of patent-eligibility discussed below. We determine that all other claim limitations need no explicit construction.

Second, Patent Owner urges us to adopt all previous judicial constructions and, in particular, the constructions of United States District Court for the Eastern District of Texas Marshall Division (*see Ex. 2014–2016*). PO Resp. 30. Petitioner also relies upon previous judicial constructions (*see Ex. 2017*) to support its arguments. *See Reply 4*. However, the standard for claim construction in a district court infringement action is different than the standard applied by the Board. *See In re Morris*, 127 F.3d 1048, 1053–54 (Fed. Cir. 1997). In covered business method patent review proceedings, the Board applies the broadest reasonable

construction consistent with the specification. 37 C.F.R. § 42.300(b); *see also SAP Am., Inc. v. Versata Dev. Grp., Inc.*, Case CBM2012-00001, slip op. at 7–18 (PTAB June 11, 2013) (Paper 70) (discussing adoption of the broadest reasonable interpretation standard).

i. Preamble

The preamble of independent claim 1 recites “[a]n information management and synchronous communications system for generating and transmitting menus.” The preamble of independent claims 4 and 5 each recites “[a]n information management and synchronous communication system for generating menus.” The preamble of independent claim 12 recites “an information management and synchronous communications method.” Petitioner and Patent Owner dispute whether the preambles limit these claims. Reply 3–7; PO Resp. 34, 35–36.

Patent Owner argues that the preambles are limiting because “[t]erms are recited in the preamble which do not appear in the remainder of the claims and ‘synchronous communications system’ is necessary to define the synchronization functionality of the first menus and the second menus on the back[-]office server (central database) and the handheld device/Web pages.” PO Resp. 36. According to Patent Owner, the preamble should be construed as “a computerized system having multiple devices in which a change to data made on a central server is updated on client devices and vice versa.” *Id.* at 34; *see id.* at 36–37. Patent Owner also argues that the preamble is limiting because the Specification describes that a synchronous communications system is important (*id.* (citing Ex. 1033, Title, Abstract, col. 3, ll. 9–15, 59–67)), and because the Examiner of the related ’850 patent

relied upon the preamble during prosecution to distinguish over the prior art (*id.*).

Petitioner argues that the preambles are non-limiting because the preamble does not recite any structural components not captured in the body of the claims and “merely sets forth the purpose (‘information management and synchronous communication’) and intended use (‘for generating and transmitting menus’) of the claimed invention.” Reply 3–6. Petitioner argues that Patent Owner’s proposed construction improperly reads in a distributed system that includes a central server and client devices and improperly excludes a preferred desktop PC embodiment from the claims. Reply 6–7. Petitioner further argues that, contrary to Patent Owner’s assertion, the Examiner did not rely upon the preamble to distinguish over the prior art. *Id.* at 5–6.

“In general, a preamble limits the invention if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim.” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (citing *Pitney Bowes Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). A preamble, however, is not limiting where the claim body defines a structurally complete invention and the preamble only states a purpose or intended use for the invention. *Id.*

The bodies of the independent claims 1, 4, and 5 recite a system that includes a central processing unit (“CPU”) or microprocessor; a data storage device, a display device; a data input device; an operating system with a GUI, a first (i.e., master) menu, a modifier menu, a sub-modifier menu, and application software. The application software is capable of generating a second (i.e., modified) menu from said first menu. The application software

is capable of transmitting or synchronizing the second menu to another computing device. Claim 1 recites that the other computing device is such a wireless handheld computing device or Web page.

As can be seen from the above, the bodies of the independent claims 1, 4, and 5 recite a structurally complete invention; one that corresponds to the embodiment that has a desktop PC and a menu configuration application described in the Specification at column 7, line 24 thru column 10, line 15 and depicted in Figure 1. As described in the Specification, a menu is updated using the GUI of the menu configuration application and, then, the updated menu is downloaded to a connected handheld device by clicking on a “Download Database” item or icon in GUI 1. Ex. 1033, col. 10, ll. 1–9; *see id.* at col. 3, ll. 24–28, col. 7, ll. 38–41, col. 8, l. 29. Thus, the updated menu is the same on the desktop PC and the handheld device. At the oral hearing, Patent Owner indicated that downloading is synchronizing, as “[i]t’s making something the same with something else.” *See* Tr. 28.

Claim 12’s preamble recites “an information management and synchronous communications method.” The body of claim 12 recites multiple steps that require outputting of a first menu, selecting items from the first menu, inserting the selected items into a second menu, adding items to the second menu, storing the second menu, and a step of synchronizing the second menu between a storage device and another data storage medium. Given this, we determine that the preamble does not recite any essential steps not already recited in the body of claim 12.

For these reasons, we agree with Petitioner that the preambles of claims 1, 4, and 5 are non-limiting because they do not recite any structural components not already captured in the body of the claim and merely set

forth the purpose and intended use of the claimed invention. Also, the bodies of the claims already possess life, meaning, and vitality, without importing anything from the preamble. Further, claim 12's recitation of "information management and synchronous communications method" is non-limiting because the body of claim 12 already possesses life, meaning, and vitality, without importing anything from the preamble.

We further are not persuaded by Patent Owner's argument that the preamble is limiting, because the argument is based upon a proposed construction that is overly narrow. Patent Owner's proposed construction implies that a synchronous communication system requires a central back-office server that communicates data updates to and from multiple client devices. Although the Specification describes communication between a central back-office server and client devices (*e.g.*, *see* Ex. 1033, col. 1, ll. 41–59), we see nothing in the Specification, and Patent Owner points to nothing, that suggests that a synchronous communication system is required to include these elements. Patent Owner's proposed construction attempts to import these extraneous elements from the Specification into the claim. If a feature is not necessary to give meaning to what the inventor means by a claim term, it would be "extraneous," and should not be read into the claim. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998); *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir. 1988).

Further, we are not persuaded by Patent Owner's argument that the preamble is limiting because the Examiner of the related '850 patent relied upon the preamble during prosecution to distinguish over the prior art, as evidenced by the Examiner's reasons for allowance (PO Resp. 36). Clear

reliance on the preamble during prosecution to distinguish the claimed invention from the prior art may transform the preamble into a claim limitation. *Catalina*, 289 F.3d at 808 (citation omitted). The Examiner's reasons for allowance for the related '850 patent do not show that the preamble clearly was relied upon during the prosecution of the '733 patent. Further, contrary to the Patent Owner's argument, the Examiner's reasons for allowance in the '850 patent indicate that the claimed sub-modifier menu and the claimed application software are the uniquely distinct features, and not the synchronous communication system of the preamble. Ex. 1035, 7.

For the reasons discussed above, we are persuaded by Petitioner that the preambles are non-limiting.

ii. "central processing unit"

Independent claims 1 and 4 recite a "central processing unit." Patent Owner proposes that CPU be construed as a "central server." PO Resp. 34, 37. According to Patent Owner, its construction takes into account "the centralized nature of the control over the recited menu generation and synchronous transmission functionally of the central processing unit" described in the Specification. *Id.* at 37.

Petitioner argues that there is nothing in the "intrinsic evidence [that] offers any alternative definition of this common technical term" and argues that Patent Owner's proposed construction is contrary to the Specification, which equates the CPU to a microprocessor. Reply 7 (citing Ex. 1033, col. 6, ll. 52–54, 63–65). Petitioner proposes that CPU should be construed according to its ordinary and customary meaning, which is "the computational and control unit of a computer." Pet. 41 (citing MICROSOFT COMPUTER DICTIONARY, 115 (4th ed. 1999)).

We are persuaded by Petitioner that the broadest reasonable construction in light of the Specification of the term CPU is the computational and control unit of a computer. Petitioner's construction is consistent with the Specification, which describes that the system of the '733 patent uses typical hardware elements in the form of a computer workstation and that "a typical workstation platform includes hardware such as a central processing unit ('CPU'), e.g., a Pentium® microprocessor." Ex. 1033, col. 6, ll. 52–54; *see also id.* at col. 6, l. 65 ("a CPU, e.g., Pentium® microprocessor"). Further, Petitioner's construction is consistent with the Specification, which as discussed above, discloses using a desktop PC to generate and download menus to a connected handheld device (*see id.* at col. 7, l. 38–col. 10, l. 15), as well as, discloses the use of a central back-office server (*e.g., see id.* at col. 2, ll. 37–40). Patent Owner's proposed construction improperly reads into the claims the central back-office server. *See Renishaw*, 158 F.3d at 1249 (explaining that extraneous features should not be read into the claims).

For these reasons, we determine that the broadest reasonable construction, in light of the Specification, of CPU is the computational and control unit of a computer.

iii. "Web page"

Neither Petitioner nor Patent Owner contests the construction of the term "Web page" in the Decision to Institute. *See* PO Resp. 39; Reply 2. We construed Web page to mean "a document with associated files for graphics, scripts, and other resources, accessible over the internet and viewable in a web browser." Dec. on Inst. 9–10.

iv. “menu”

Petitioner does not propose explicitly a construction of menu, but argues that the claim terms should be given their ordinary and customary meaning. Pet. 30–31. Patent Owner proposes that menu should be construed as “computer data representing collections of linked levels of choices or options intended for display in a graphical user interface.” PO Resp. 35, 40–41 ((referring to a construction by a district court); *see* Ex. 2014, 11–12). Patent Owner, however, provides no analysis as to why the district court’s construction is the broadest reasonable construction in light of the Specification. PO Resp. 35, 40–41.

We are not persuaded by Patent Owner that its proposed construction is the broadest reasonable construction in light of the Specification. We see nothing in the Specification, and Patent Owner does not point to anything in the Specification, that provides support for Patent Owner’s proposed construction, in particular that the menus have a “linked levels” feature. Although the Specification discloses some menus that are linked to additional menus, this “linked levels” feature is extraneous and should not be read from the Specification into the claim. *See* Ex. 1033, col. 6, ll. 37–46 (“File options *can have* additional subordinate or child options associated with them. *If* a file option having a subordinate option is selected . . .” (emphases added)).

We give “menu” its ordinary and customary meaning. RANDOM HOUSE WEBSTER’S COLLEGE DICTIONARY defines menu as “a list of options available to a user as displayed on a computer or TV screen.” RANDOM HOUSE WEBSTER’S COLLEGE DICTIONARY, 520 (2nd ed. 1997). This definition is consistent with the Specification, which describes menus as

providing choices or options in a GUI. *See* Ex. 1033, col. 5, ll. 32–34; *see* Figure 1 (depicting a menu, a modifier menu, and a sub modifier menu).

For these reasons, we determine that the broadest reasonable construction, in light of the Specification, of “menu” is a list of options available to a user displayable on a computer.

v. “manually modified”

Petitioner does not propose explicitly a construction of “manually modified” but argues that the claim terms should be given their ordinary and customary meaning. Pet. 40–41. Patent Owner proposes that “manually modified” should be construed as “effecting a change as a result of a user’s input or request.” PO Resp. 35–36, 42–43.

Patent Owner’s proposed construction is consistent with the ordinary and customary meaning of the claim terms (*see* Ex. 3002 (providing a dictionary definition of “manual” and “modify”)) and is consistent with the Specification, which describes embodiments that make manual modifications by handwritten screen captures or voice recorded messages, coupled to the standard menus (Ex. 1033, col. 3, l. 48–col. 4, l. 56). On this record, we determine that Patent Owner’s proposed construction is the broadest reasonable construction, in light of the Specification.

Claims 1 and 5 each recite “wherein said second menu is manually modified after generation.” Claim 4 recites “wherein said second menu is manually modified by handwriting or voice recording after generation.” As discussed in our Decision to Institute, these clauses are “a further limitation regarding the application software’s ability to facilitate the generation of the second menu.” Dec. to Inst. 18. Given our construction of “manually modified” above, we determine that claims 1 and 5 require application

software that is capable of facilitating the generation of a second menu that is capable of being manually modified after generation. Claim 4 requires application software that is capable of facilitating the generation of a second menu that is capable of being manually modified by handwriting or voice recording after generation.

C. 35 U.S.C. § 101

Petitioner challenges claims 1–16 of the ’733 patent as claiming patent-ineligible subject matter under 35 U.S.C. § 101. Pet.49–60; Reply 8–15. According to Petitioner, the claims are directed to the abstract idea of generating a menu and do not contain additional limitations that meaningfully limit the abstract idea to a practical application. *Id.*

Patent Owner disagrees and contends that the claims are patent-eligible because they recite a machine and not an abstract idea and because they recite specialized software that synchronously generates and wirelessly transmits non-PC standard handheld menus comprised of multi-tiered levels of components. PO Resp. 44–80.

a. Section 101 Subject Matter Eligibility

For claimed subject matter to be patentable eligible, it must fall into one of four statutory classes set forth in 35 U.S.C. § 101: a process, a machine, a manufacture, or a composition of matter. The Supreme Court recognizes three categories of subject matter that are ineligible for patent protection: “laws of nature, physical phenomena, and abstract ideas.” *Bilski v. Kappos*, 130 S. Ct. 3218, 3225 (2010) (internal quotations and citation omitted). A law of nature or an abstract idea by itself is not patentable; however, a practical application of the law of nature or abstract idea may be

deserving of patent protection. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293–94 (2012). To be patentable, however, a claim must do more than simply state the law of nature or abstract idea and add the words “apply it.” *Id.*

In *Alice Corp. Pty, Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014), the Supreme Court recently clarified the process for analyzing claims to determine whether claims are directed to patent-ineligible subject matter. In *Alice*, the Supreme Court applied the framework set forth previously in *Mayo*, “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts.” *Alice*, 134 S. Ct. at 2355. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If they are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “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*, 132 S. Ct. at 1291, 1297). In other words, the second step is to “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.* (alteration in original) (quoting *Mayo*, 132 S. Ct. at 1294). Further, the “prohibition against patenting abstract ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or adding ‘insignificant postsolution activity.’” *Bilski*, 130 S. Ct. at 3230 (quoting *Diamond v. Diehr*, 450 U.S.175, 191–92 (1981)).

The patents at issue in *Alice* claimed a “method of exchanging financial obligations between two parties using a third-party intermediary to mitigate settlement risk.” *Alice*, 134 S. Ct. at 2356. Like the method of hedging risk in *Bilski*, 130 S. Ct. at 3240 — which the Court deemed “a method of organizing human activity” — *Alice*’s “concept of intermediate settlement” was held to be “a fundamental economic practice long prevalent in our system of commerce.” *Alice*, 134 S. Ct. at 2356. Similarly, the Court found that “[t]he use of a third-party intermediary . . . is also a building block of the modern economy.” *Id.* “Thus,” the Court held, “intermediate settlement . . . is an ‘abstract idea’ beyond the scope of § 101.” *Id.*

Accordingly, utilizing this framework, we analyze claims 1–16 of the ’733 patent to determine whether these claims are directed to patent-ineligible subject matter.

b. Ineligible Concept

Petitioner argues that the claims are directed to the abstract idea of generating menus. Pet. 62–68; Reply 9–10. Patent Owner argues that the claims “are not directed to an ‘idea’ at all; they are directed to a new machine.” PO Resp. 46 (emphasis omitted).

Nominally, the claimed subject matter of claims 1, 4, and 5 is a machine and the claimed subject matter of claim 12 is a process. A machine or process is one of the four categories of statutory subject matter. Statutory class, however, is not by itself determinative of whether a claim is directed to patent eligible subject matter. “Regardless of what statutory category (‘process, machine, manufacture, or composition of matter,’ 35 U.S.C. § 101) a claim’s language is crafted to literally invoke, we look to the underlying invention for patent-eligibility purposes.” *CyberSource Corp. v.*

Retail Decisions, Inc., 654 F.3d 1366, 1374 (Fed. Cir. 2011). *See Alice*, 134 S. Ct. 2358–2359; *Bancorp Servs. v. Sun Life Assurance Co.*, 687 F.3d 1266, 1275 (Fed. Cir. 2012).

The independent claims recite a system or process that generates a second menu, which is capable of being manually modified after generation, from a first menu. As discussed in section I(A) above, the Specification discloses a user generating a menu by adding or deleting menu categories, such as salads or desserts; menu items, such as caesar salad or green salad; menu modifiers, such as dressing; and menu sub-modifiers, such as ranch or blue cheese, to create the second menu. Ex. 1033, col. 7, l. 38–col. 10, l. 15. The Specification states:

[w]hile the preferred embodiment of the invention includes the selection of items from a master menu wherein the master menu is displayed using a graphical user interface, it is to be appreciated that any means for displaying the master menu to the user and generating another menu in response to and comprised of the selections made is encompassed by the contemplated invention.

Id. at col. 15, ll. 1–7.

Independent claim 1 also recites that the system transmits the second menu to a wireless handheld computing device or Web page, and independent claims 4, 5, and 12 recite that the system is synchronized between the data storage device and at least one other computing device. In that regard, the Specification states:

[t]he inventive concept encompasses the generation of a menu in any context known to those skilled in the art where an object is to facilitate display of the menu so as to enable selection of items from that menu. . . . Likewise, displaying menus generated in accordance with the invention on PDAs and Web pages to facilitate remote ordering are but a few examples of

ways in which such menu might be used in practice. Any display and transmission means known to those skilled in the art is equally usable with respect to menus generated in accordance with the claimed invention.

Id. at col. 15, ll. 31–42.

Given the above, we determine that the claims are directed to the abstract idea of generating a second menu from a first menu and sending the second menu to another location.

c. Inventive Concept

Next, we look for additional elements that can “transform the nature of the claim” into a patent-eligible application of an abstract idea. That is, we determine whether the claims include an “inventive concept,” i.e., an element or combination of elements sufficient to ensure that the patent in practice amounts to significantly more than a patent on the abstract idea itself. *Alice*, 134 S. Ct. at 2357. The Supreme Court in *Alice* cautioned that merely limiting the use of abstract idea “to a particular technological environment” or implementing the abstract idea on a “wholly generic computer” is not sufficient as an additional feature to provide “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.” *Alice*, 134 S. Ct. at 2358.

i. Independent Claim 1

Petitioner argues that the claims require nothing more than a general purpose computer using general purpose programming because the Specification, itself, discloses that the system of the ’733 patent uses typical computer equipment and commonly known programming steps. *See* Pet. 55–56, 60–64; Reply 8–15. Patent Owner argues that the claims recite specialized software that synchronously generates and wirelessly transmits

non-PC standard handheld menus comprised of multi-tiered levels of components. PO Resp. 44–80.

Independent claim 1 recites a CPU, a data storage device, and an operating system with a GUI. The Specification states that “the present invention uses typical hardware elements in the form of a computer workstation, operating system and application software elements which configure the hardware elements for operation in accordance with the present invention.” Ex. 1033, col. 6, ll. 46–52. CPUs and data storage devices are described as “typical hardware elements.” *Id.* at col. 6, ll. 48–49. The Specification also discloses that the use of GUI operating systems, such as Microsoft Windows® and Window CE® for handheld wireless device, were known, and that GUIs were a known means for allowing a user to manipulate data. *Id.* at col. 6, ll. 6–30. Given this, we determine that these claim elements require nothing more than a generic computer with generic computer elements performing generic computer functions. Merely reciting a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. *Alice*, 134 S. Ct. at 2358. Using a graphical user interface, a known way for a user to interact with the computer, does not change the generic nature of the computer.

The independent claim 1 also recites a first menu, a modifier menu, and a sub-modifier menu stored on the data storage device and displayable in a window of a GUI. The first menu is displayable in a hierarchical tree format. The Specification discloses that the use of a data storage device to store data is “typical” and the displaying of menus in a hierarchical format in a GUI is “conventional.” *See* Ex. 1033, col. 6, ll. 31–32, 52–56, col. 7, ll. 4–23. Given this, we determine that storing the menus on the data storage

device is nothing more than routine data gathering and does not transform the abstract idea into a patent-eligible invention. *See CyberSource*, 654 F.3d at 1370. Further, displaying menus in a GUI, including in a hierarchical format, is a well-understood, routine, conventional activity that does not add significantly more to the abstract idea. *Mayo*, 132 S. Ct. at 1298.

The claim, further, recites application software that functions to generate a second menu from a first menu by selecting menu categories and items from the first menu, adding menu categories and item to the second menu, and selecting parameters from modifier and sub-modifier menus to assign to items in the second menu. The Specification discloses that GUIs that display menus from which records can be created, deleted, modified, or arranged are conventional. Ex. 1033, col. 6, ll. 6–32; col. 7, ll. 4–23: *see also* col. 12, ll. 62–65 (“the discrete programming steps are commonly known”). To add significantly more to the abstract idea, additional features must be more than well-understood, routine, conventional activity. *Mayo*, 132 S. Ct. at 1298.

Claim 1 recites that the application software also functions to transmit the second menu to a wireless handheld computing device or Web page. As discussed above in section II(B)(i), the Specification discloses that the menu is transmitted to the wireless handheld device and Web page by downloading. Ex. 1033, col. 10, ll. 1–9 (describing downloading the new menu to a connected PDA); *see also id.* at col. 3, ll. 42–43, col. 6, ll. 33–36, col. 7, l. 26, col. 10, ll. 12–14 (describing downloading the new menu to a wireless handheld device and Web page). Such downloading is merely a conventional post-solution activity. Conventional post-solution activity is

not sufficient to transform the abstract idea into patent-eligible subject matter. *See Parker v. Flook*, 437 U.S. 584, 590–92 (1978).

As discussed above in section II(B)(iv), claim 1 also recites that the “second menu is manually modified after generation,” and we have construed this limitation as requiring the application software to be capable of facilitating the generation of a second menu that is capable of being changed, after generation, as a result of a user’s input or request. This encompasses a second menu that is capable of being changed by being written upon by a user after generation and after being printed. The Specification discloses that menus are commonly printed on paper (Ex. 1033, col. 2, ll. 10–11) and that it is known to use pen and paper in the hospitality industry (*see id.* at col. 1, ll. 27–35). *See Reply 11–12*. This claim element is nothing more than insignificant post solution activity and is not sufficient to transform the abstract idea into patent-eligible subject matter. *See Flook*, 437 U.S. at 590.

Even when the claim elements are considered as a combination, they add nothing that is not already present when the elements are considered separately. *Alice*, 134 S. Ct. at 2359. Claim 1 conveys nothing more meaningful than the fundamental concept of generating a second menu from a first menu and sending the second menu to another location.

Upon review of Petitioner’s analysis and supporting evidence and taking into account Patent Owner’s arguments, discussed below, we are persuaded by Petitioner that independent claim 1 does not recite additional elements that transform the claim into a patent-eligible application of an abstract idea.

We are not persuaded by Patent Owner’s argument that the claims require additional elements that transform the abstract idea into a patent-eligible application (PO Resp. 44–74, 76–80) because it is based up on an overly narrow construction of the claimed elements, as discussed in section II(B) above, and is based on additional elements not recited or required by the claims. Patent Owner argues the claims “supply a new and useful application of the idea by virtue of the fact that they synchronously generate and wirelessly transmit out non-PC standard handheld menus comprised of multi-tiered levels of components.” *Id.* at 47.

Patent Owner’s argument is based upon its overly narrow construction of the preamble of the claim and the claimed CPU and menu. As discussed above in section II(B), when given the broadest reasonable construction in light of the Specification, the claim elements do not require a central back-office server that updates changes to the menu on multiple client devices and vice versa and do not require menus that have multi-tiered levels of components.

Patent Owner’s argument also is based upon elements not recited or required by the claim. Patent Owner implies that the claims require that second menu is transmitted “wirelessly” to the wireless handheld computing device. *E.g., see id.* at 62. Although, the handheld computing device is described as “wireless,” the claims do not recite that the second menu is wirelessly transmitted to the handheld device, and do not preclude, for example, transmitting the second menu to a PDA (i.e., a wireless handheld computing device) via a wire and docking station, as described in the Specification (Ex. 1033, col. 10, ll. 1–9). Patent Owner also implies that the claims require that the application software functions to configure the

second menu so that it is in a non-PC standard graphical format (*e.g.*, *see id.* at 49, 61–67) for the wireless handheld computing device. However, no such limitations appear in the claims. The claims are silent as to the format of the second menu and contain no requirement that the second menu be in such a format.

ii. Independent Claim 4

Independent claim 4 recites a CPU, a data storage device, and an operating system with a GUI. The Specification states that “the present invention uses typical hardware elements in the form of a computer workstation, operating system and application software elements which configure the hardware elements for operation in accordance with the present invention.” Ex. 1033, col. 6, ll. 46–52. CPUs and data storage devices are described as “typical hardware elements.” *Id.* at col. 6, ll. 48–49. The Specification also discloses that the use of GUI operating systems, such as Microsoft Windows® and Window CE® for handheld wireless device, were known, and that GUIs were a known means for allowing a user to manipulate data. *Id.* at col. 6, ll. 6–30. Given this, we determine that these claim elements require nothing more than a generic computer with generic computer elements performing generic computer functions. Merely reciting a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. *Alice*, 134 S. Ct. at 2358. Using a graphical user interface is a known way for a user to interact with the computer and does not change the generic nature of the computer.

Independent claim 4 also recites a first menu stored on the data storage device. The Specification discloses that the use of a data storage device to store data is “typical.” *See* Ex. 1033, col. 6, ll. 52–56. Given this,

we determine that storing the menus on the data storage device is nothing more than routine data gathering and does not transform the abstract idea into a patent-eligible invention. *See CyberSource*, 654 F.3d at 1370.

The claim, further, recites application software that functions to generate a second menu from a first menu by allowing for the selection of items from the first menu, the addition of items to the second menu, and assigning parameters to the items. The Specification discloses that GUIs that display menus from which records can be created, deleted, modified, or arranged are conventional. Ex. 1033, col. 6, ll. 6–32; col.7, ll. 4–23: *see also* col. 12, ll. 62–65 (“the discrete programming steps are commonly known”). To add significantly more to the abstract idea, additional features must be more than well-understood, routine, conventional activity. *Mayo*, 132 S. Ct. at 1298.

Claim 4 also recites that the application software functions to synchronize the second menu between the data storage device and another computing device. As discussed above in section II(B)(i), the Specification discloses downloading a generated menu from a desktop PC to a connected wireless handheld device. Ex. 1033, col. 10, ll. 1–6; *see also id.* at col. 3, ll. 42–43, col. 6, ll. 33–36, col. 7, l. 26, col. 10, ll. 12–14. At the oral hearing, Patent Owner indicated that downloading is synchronizing, as “[i]t’s making something the same with something else.” *See* Tr. 28. Further, the Specification discloses that Windows CE® includes “built in synchronization between handheld devices, internet and desktop infrastructure” (Ex. 1033, col. 12, ll. 15–18) and describes Windows CE® as a common GUI operating system (*id.* at col. 6, ll. 20–24). Such downloading or synchronizing is merely a conventional post-solution

activity. Conventional post-solution activity is not sufficient to transform the abstract idea into patent-eligible subject matter. *See Flook*, 437 U.S. at 590–92.

As discussed above in section II(B)(iv), claim 4 also recites “second menu is manually modified by handwriting or voice recording after generation,” and we have construed this limitation as requiring the application software to be capable of facilitating the generation of a second menu that is capable of being changed by handwriting or voice recognition, after generation, as a result of a user’s input or request. As discussed above with regard to claim 1, this encompasses the second menu being manually modified by being written upon by a user after generation and after being printed. The Specification discloses that menus are commonly printed on paper (Ex. 1033, col. 2, ll. 10–11) and that it is known to use pen and paper in the hospitality industry to record orders (*see id.* at col. 1, ll. 27–35). *See* Reply 11–12. This claim element is nothing more than insignificant post solution activity and is not sufficient to transform the abstract idea into patent-eligible subject matter. *See Flook*, 437 U.S. at 590.

Even when the claim elements are considered as a combination, they add nothing that is not already present when the elements are considered separately. *Alice*, 134 S. Ct. at 2359. Claim 4 conveys nothing more meaningful than the fundamental concept of generating a second menu from a first menu and sending the second menu to another location.

Upon review of Petitioner’s analysis and supporting evidence and taking into account Patent Owner’s arguments, discussed below, we are persuaded by Petitioner that independent claim 4 does not recite additional

elements that transform the claim into a patent-eligible application of an abstract idea.

For the same reasons as discussed above with regard to claim 1, we are not persuaded by Patent Owner's argument that this claim requires additional elements that transform the abstract idea into a patent-eligible application (PO Resp. 44–74, 76–80). In addition, we are not persuaded by Patent Owner's argument because claim 4, unlike claim 1, does not recite that the application software is for transmitting the second menu to a wireless hand-held device or Web page. Claim 4 does not require a wireless hand-held device or Webpage.

iii. Independent Claim 5

Independent claim 5 recites a microprocessor, a display device, an input device, a data storage device, application software, and an operating system with a GUI. The Specification states that “the present invention uses typical hardware elements in the form of a computer workstation, operating system and application software elements which configure the hardware elements for operation in accordance with the present invention.” Ex. 1033, col. 6, ll. 46–52. Microprocessors, display devices, data input device, and data storage devices are described as “typical hardware elements.” *Id.* at col. 5, ll. 53–59. The Specification also discloses that the use of GUI operating systems, such as Microsoft Windows® and Window CE® for handheld wireless device, were known, and that GUIs were a known means for allowing a user to manipulate data. *Id.* at col. 6, ll. 6–30. Given this, we determine that these claim elements require nothing more than a generic computer with generic computer elements performing generic computer functions. Merely reciting a generic computer cannot transform a patent-

ineligible abstract idea into a patent-eligible invention. *Alice*, 134 S. Ct. at 2358. Using a graphical user interface, a known way for a user to interact with the computer, does not change the generic nature of the computer.

Independent claim 5 also recites a master menu stored on the data storage device. The Specification discloses that the use of a data storage device to store data is “typical.” *See* Ex. 1033, col. 6, ll. 52–56. Given this, we determine that storing the menus on the data storage device is nothing more than routine data gathering and does not transform the abstract idea into a patent-eligible invention. *See CyberSource*, 654 F.3d at 1370.

The claim recites that the microprocessor, operating system, and application software function to display the master menu on the display device in response to input from the input device and function to create the modified menu from the master menu in response to input from the input device. The Specification discloses that GUIs that display menus from which records can be created, deleted, modified, or arranged are conventional. Ex. 1033, col. 6, ll. 6–32, col.7, ll. 4–23: *see also* col. 12, ll. 62–65 (“the discrete programming steps are commonly known”). To add significantly more to the abstract idea, additional features must be more than well-understood, routine, conventional activity. *Mayo*, 132 S. Ct. at 1298.

Claim 5 also recites that the system functions to synchronize the modified menu between the data storage device and another computing device. As discussed above in section II(B)(i), the Specification discloses downloading a generated menu from a desktop PC to a connected wireless handheld device. Ex. 1033, col. 10, ll. 1–6; *see also id.* at col. 3, ll. 42–43, col. 6, ll. 33–36, col. 7, l. 26, col. 10, ll. 12–14. At the oral hearing, Patent Owner indicated that downloading is synchronizing, as “[i]t’s making

something the same with something else.” *See* Tr. 28. Further, the Specification discloses that Windows CE® includes “built in synchronization between handheld devices, internet and desktop infrastructure” (Ex. 1033, col. 12, ll. 15–18) and describes Windows CE® as a common GUI operating system (*id.* at col. 6, ll. 20–24). Such downloading or synchronizing is merely a conventional post-solution activity. Conventional post-solution activity is not sufficient to transform the abstract idea into patent-eligible subject matter. *See Flook*, 437 U.S. at 590–92.

As discussed above in section II(B)(iv), claim 5, like claim 1, recites “wherein said modified menu is manually modified after generation.” As discussed above with regard to claim 1, this encompasses the modified menu being changed by being written upon by a user after generation and after being printed. The Specification discloses that menus are commonly printed on paper (Ex. 1033, col. 2, ll. 10–11) and that it is known to use pen and paper in the hospitality industry (*see id.* at col. 1, ll. 27–35). *See* Reply 11–12. This claim element is nothing more than insignificant post solution activity and is not sufficient to transform the abstract idea into patent-eligible subject matter. *See Flook*, 437 U.S. at 590.

Even when the claim elements are considered as a combination, they add nothing that is not already present when the elements are considered separately. *Alice*, 134 S. Ct. at 2359. Claim 5 conveys nothing more meaningful than the fundamental concept of generating a second menu from a first menu and sending the second menu to another location.

Upon review of Petitioner’s analysis and supporting evidence and taking into account Patent Owner’s arguments, discussed below, we are

persuaded by Petitioner that independent claim 5 does not recite additional elements that transforms the claim into a patent-eligible application of an abstract idea.

For the same reasons as discussed above with regard to claim 1, we are not persuaded by Patent Owner's argument that this claim requires additional elements that transform the abstract idea into a patent-eligible application (PO Resp. 44–74, 76–80). In addition, we are not persuaded by Patent Owner's argument because claim 5, unlike claim 1, does not recite that the application software is for transmitting the second menu to a wireless hand-held device or Web page. Claim 5 does not require a wireless hand-held device or Webpage. Further, unlike claims 1 and 4, claim 5 does not require a CPU.

iv. Independent Claim 12

Independent claim 12 recites “a computer system having an input device, a storage device, a video display, an operating system including a graphical user interface and application software.” Claim 12 recites steps of using these elements to display a first menu, a second menu, and a cursor in windows of the video display and using the input device to select items from the first menu and insert the item into a second menu. Claim 12 also recites steps of adding additional items to the second menu and storing the second menu on the storage device.

The Specification states that “the present invention uses typical hardware elements in the form of a computer workstation, operating system and application software elements which configure the hardware elements for operation in accordance with the present invention.” Ex. 1033, col. 6, ll. 47–52; *see also* col. 12, ll. 62–65 (“the discrete programming steps are

commonly known”). CPUs and data storage devices are described as “typical hardware elements.” *Id.* at col. 6, ll. 52–59. The Specification also discloses that the use of GUI operating systems, such as Microsoft Windows® and Window CE® for handheld wireless device, were known, and that GUIs were a known means for allowing a user to manipulate data. *Id.* at col. 6, ll. 6–30. The Specification further discloses that GUIs that display menus from which records can be created, deleted, modified, or arranged are conventional. *Id.* at col. 6, ll. 6–32, col.7, ll. 4–23; *see also* col. 12, ll. 62–65 (“the discrete programming steps are commonly known”). Given this, we determine that these claim elements require nothing more than a generic computer with generic computer elements performing generic computer functions. Merely reciting a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. *Alice*, 134 S. Ct. at 2358. Using a graphical user interface is a known way for a user to interact with the computer and does not change the generic nature of the computer.

Claim 12 further recites a step of synchronizing the second menu between the storage device and another data storage device that is connected to a different computing device. As discussed above in section II(B)(i), the Specification discloses downloading a generated menu from a desktop PC to a connected wireless handheld device. Ex. 1033, col. 10, ll. 1–6; *see also id.* at col. 3, ll. 42–43, col. 6, ll. 33–36, col. 7, l. 26, col. 10, ll. 12–14. At the oral hearing, Patent Owner indicated that downloading is synchronizing, as “[i]t’s making something the same with something else.” *See* Tr. 28. Further, the Specification discloses that Windows CE® includes “built in synchronization between handheld devices, internet and desktop

infrastructure” (Ex. 1033, col. 12, ll. 15–18) and describes Windows CE® as a common GUI operating system (*id.* at col. 6, ll. 20–24). Such downloading or synchronizing is merely a conventional post-solution activity. Conventional post-solution activity is not sufficient to transform the abstract idea into patent-eligible subject matter. *See Flook*, 437 U.S. at 590–92.

Claim 12 recites a step of manually modifying the second menu after generation. As discussed above with regard to claims 1, 4, and 5, this encompasses modifying the menu by a user writing changes on the menu after it is generated and printed. The Specification discloses that menus are commonly printed on paper (Ex. 1033, col. 2, ll. 10–11) and that it is known to use pen and paper in the hospitality industry (*see id.* at col. 1, ll. 27–35). *See Reply 11–12*. This claim element is nothing more than insignificant post solution activity and is not sufficient to transform the abstract idea into patent-eligible subject matter. *See Flook*, 437 U.S. at 590.

Even when the claim steps are considered as a combination, they add nothing that is not already present when the steps are considered separately. *Alice*, 134 S. Ct. at 2359. The claims convey nothing more meaningful than the fundamental concept of generating a second menu from a first menu and sending the second menu to another location.

Upon review of Petitioner’s analysis and supporting evidence and taking into account Patent Owner’s arguments, discussed below, we are persuaded by Petitioner that independent claim 12 does not recite additional elements that transforms the claim into a patent-eligible application of an abstract idea.

For the same reasons as discussed above with regard to claim 1, we are not persuaded by Patent Owner's argument that this claim requires additional elements that transform the abstract idea into a patent-eligible application (PO Resp. 44–74, 76–80). In addition, we are not persuaded by Patent Owner's argument because claim 12, unlike claim 1, does not recite that the application software is for transmitting the second menu to a wireless hand-held device or Web page. Claim 12 contains no requirement for a wireless hand-held device or Webpage. Further, unlike claims 1 and 4, claim 12 does not require a CPU.

iii. Dependent Claims 2 and 10

Claim 2 depends from claim 1 and recites “wherein the modified second menu can be selectively printed on any printer directly from the graphical user interface of a hand-held device.” Claim 10 depends from claims 4 and 5 and recites a similar limitation. The Specification discloses that menus are commonly printed on paper. Ex. 1033, col. 2, ll. 10–11. These claim elements are nothing more than insignificant post solution activity and are not sufficient to transform the abstract idea into patent-eligible subject matter. *See Flook*, 437 U.S. at 590.

Upon review of Petitioner's analysis and supporting evidence and taking into account Patent Owner's arguments, discussed below, we are persuaded by Petitioner that dependent claims 2 and 10 do not recite additional elements that transforms the claim into a patent-eligible application of an abstract idea.

We are not persuaded by Patent Owner's argument that the limitations recited by these claims were unconventional or unique “in 2001 because the very capability of selecting a printer from the GUI on a mobile device . . .

was novel then and unique to mobility and wireless handhelds” (PO Resp. 75). Patent Owner’s argument is based on an additional element not recited or required by the claims. Claim 2 recites that the menu is capable of being printed from a GUI of “a hand-held device” and claim 11 recites that the menu is capable of being printed from a GUI of “said other computing device.” Neither claim requires that the menu be capable of being printed from the menu, itself, or from a mobile or wireless hand-held device.

iv. Dependent Claims 3 and 11

Claim 3 depends from claim 1 and recites “wherein the modified second menu can be linked to a specific customer at a specific table directly from the graphical user interface of a hand-held device.” Claim 11 depends from claims 4 and 5 and recites a similar limitation. These claims require that second menu has the claimed linking functionality. This is consistent with the Specification, which discloses that the hand-held devices can link a customer’s order from the menu to the specific customer’s position at a table. Ex. 1033, col. 4, ll. 38–46.

Patent Owner argues that claims 3 and 11 recite limitations that were unconventional or unique “in 2001 because the very capability of . . . linking a particular order to a particular customer at a table was novel then and unique to mobility and wireless handhelds” (PO Resp. 75) and argues that Petitioner has not provided any evidence that establishes otherwise (*id.* at 75–76).

We are persuaded by Patent Owner’s argument. Petitioner states that the claimed linking is a “classic example[] of manual tasks that cannot be rendered patent-eligible merely by performing them with a computer.” Reply 15. However, Petitioner fails to provide sufficient evidence to support

its statement. *See* Pet. 49–66; Reply 9–15. Petitioner provides insufficient evidence to establish that a menu having the functionality to perform the claimed linking from a GUI on a hand-held device, was well-known or conventional and merely require a general purpose computer. *See id.* Upon review, we determine that Petitioner fails to establish by a preponderance of the evidence that claims 3 and 11 recite patent-ineligible subject matter.

v. Dependent Claims 6–9 and 13–16

Claim 6 depends from claims 1, 4, or 5 and recites “wherein the manual modification involves handwriting capture.” Claim 7 depends from claim 6 and further recites that “the handwriting capture involves handwriting recognition and conversion to text.” Claim 8 depends from claims 1, 4, or 5 and recites “wherein the manual modification involves voice capture.” Claim 9 depends from claim 8 and further recites that “the voice capture involves voice recognition and conversion to text.” Claims 13–16 depend from claim 12 and recite similar limitations. These claims require that the menus have handwriting capture or voice capture functionality. This is consistent with the Specification, which discloses using handwritten screen captures and voice recorded message captures to couple additional information to the fixed menu information before sending it to a point of sale system, printer, or display. *See* Ex. 1033, col. 3, l. 48–col. 4, l. 37; Fig. 8.

Patent Owner argues that these dependent claims recite a particular kind of manual modification that transforms these claims into patent eligible subject matter and argues that Petitioner ignored this in the Petition. PO Resp. 75–76; *see id.* at 53–54, 56, 69.

We are persuaded by Patent Owner argument. Petitioner argues that “[m]anual modification’ of a menu is a classic example of a manual task that can be performed with a pen and paper, which cannot be rendered patent-eligible merely by performing it with a computer.” Reply 11 (citation omitted). Petitioner, further, argues that none of the claims of the ’733 patent are directed to any specific software for accomplishing manual modification. *Id.* Petitioner, however, does not specifically address these dependent claims, which require the menu to have functionality to perform handwriting capture or voice capture. *See* Pet. 49–66; Reply 9–15. Further, Petitioner fails to provide sufficient evidence that menus having handwriting capture or voice capture functionality were well-known or conventional at the time of the ’733 patent or require merely a general purpose computer. *See id.*

Upon review of the Petitioner’s evidence and analysis, we determine that Petitioner fails to establish by a preponderance of the evidence that claims 6–9 and 13–16 recite patent-ineligible subject matter.

III. CONCLUSION

We conclude Petitioner has proven, by a preponderance of the evidence, that claims 1, 2, 4, 5, 10, and 12 of the ’733 patent are unpatentable under 35 U.S.C. § 101.

We conclude Petitioner has not proven, by a preponderance of the evidence, that claims 3, 6–9, 11, and 13–16 of the ’733 patent are unpatentable under 35 U.S.C. § 101.

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This is a final written decision of the Board under 35 U.S.C. § 328(a). Parties to the proceeding seeking judicial review of this decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IV. ORDER

Accordingly, it is hereby:

ORDERED that claims 1, 2, 4, 5, 10, and 12 of U.S. Patent No. 6,982,733 B1 are held unpatentable.

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