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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EMILIO MIGUELANEZ and
GREG LABONTE

Appeal 2010-005496
Application 11/535,851
Technology Center 2800

Before JOSEPH F. RUGGIERO, MARC S. HOFF, and
STANLEY M. WEINBERG, *Administrative Patent Judges*.

WEINBERG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-6 and 8-21. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Claims 1-6, 8-13, and 15-20 stand rejected under 35 U.S.C. § 102(b) as anticipated by Tabor (US 2003/0014205 A1 (Jan. 16, 2003; filed May 24, 2002)).¹

Claims 8-21 stand rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter.²

Claims 14 and 21 have been objected to as being dependent upon a rejected base claim and are tentatively allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, assuming the § 101 rejections are overcome. 6/10/2009 Final Rejection, ¶ 4.

Claim 7 has also been objected to and indicated as being tentatively allowable, also assuming the § 101 rejections have been overcome. 6/10/2009 Final Rejection, ¶ 4. The Examiner's statement that the allowability of claim 7 depends upon resolution of the § 101 rejections is incorrect because claim 7 has not been rejected based upon § 101. *See*

¹ Throughout this opinion, we refer to (1) the Appeal Brief filed October 16, 2009; (2) the Examiner's Answer mailed December 28, 2009; and (3) the Reply Brief filed March 1, 2010.

² Appellants acknowledge that these claims have been rejected under § 101 (App. Br. 4, ¶ III.3); but in one part of their brief, they do not identify claims 14 and 21 as being appealed. App. Br. 4, ¶ III.1. Because other parts of Appellants' Appeal Brief identify claims 14 and 21 as being appealed (App. Br. 14, ¶ VI, Issue 1; 15-17), we conclude that those claims are, in fact, on appeal. *See also* Reply Br. 2-3.

6/10/2009 Final Rejection ¶ 2; Ans. 3, ¶ 1. Claim 7 has therefore not been rejected on any basis.

STATEMENT OF THE CASE

Appellants' invention relates to a method and apparatus for testing semiconductor devices on a wafer, circuit boards, packaged devices, or other electrical or optical systems. Spec. ¶ 0020.

Independent claim 1 is illustrative:

1. A test data analysis system for analyzing test data for multiple components fabricated on a wafer, comprising:
 - a memory configured to store the test data; and
 - a hybrid outlier system having access to the memory and configured to, for each of a plurality of test data for each of a plurality of selected components:
 - select a component as a central component;
 - identify a plurality of local components in a local area near the central component;
 - determine a derived value of the test data for the plurality of local components;
 - compare the test data for the central component to the derived value for the plurality of local components; and
 - identify whether the test data for the central component represents a hybrid outlier according to the comparison of the test data for the central component to the derived value for the plurality of local components.

THE ANTICIPATION REJECTION

The Examiner finds that Tabor discloses every recited feature of representative claim 1. Ans. 4-5.

Appellants argue that Tabor does not qualify as prior art and therefore cannot support the rejection. App. Br. 17-18; Reply Br. 3-5.

ISSUE

Under § 102, has the Examiner erred by concluding that Tabor qualifies as prior art?

FINDINGS OF FACT

The record supports the following Findings of Fact:

1. The present application was filed on September 27, 2006. Paragraph 0001 of the application states:

This application is a continuation-in-part of U.S. Patent Application Serial No. 11/134,843, filed on May 20, 2005, entitled METHODS AND APPARATUS FOR LOCAL OUTLIER DETECTION, and incorporates the disclosure of such application by reference. To the extent that the present disclosure conflicts with any referenced application, however, the present disclosure is to be given priority.

2. A rejection of claims 1-6, 8-13, and 15-20 as anticipated by Tabor was mailed on September 28, 2007.

3. On December 28, 2007, Appellants responded to the September 28, 2007 rejection by amending the Abstract. Appellants' response made no other amendment to the Specification.

4. A Final Rejection of claims 1-6, 8-13, and 15-20 as anticipated by Tabor was mailed on March 14, 2008.

5. Tabor's Application No. 10/154,627 was filed on May 24, 2002.

6. On May 13, 2008, Appellants filed a Request For Reconsideration After Final Office Action which sought to amend the Specification as follows (footnote added):

This application is a continuation-in-part of U.S. Patent Application Serial No. 11/134,843, filed on May 20, 2005, entitled ~~METHODS AND APPARATUS FOR LOCAL~~

OUTLIER DETECTION which is a continuation-in-part (“CIP”) of U.S. Serial No. 10/817,750, filed April 2, 2004, which is a CIP of U.S. Serial No. 10/730,388, filed on December 7, 2003, which is a CIP of U.S. Serial No. 10/367,355, filed on February 14, 2003, which is a CIP of U.S. Serial No. 10/154,627, filed on May 24, 2002, and incorporates the disclosure of such applications³ by reference. To the extent that the present disclosure conflicts with any referenced application, however, the present disclosure is to be given priority.

7. In an Office Action mailed on February 9, 2009, prosecution was reopened and the May 13, 2008 amendment was objected to because it introduces new matter that was not supported by the original disclosure. 2/9/2009 Office Action 3. The Office Action again rejected claims 1-6, 8-13, and 15-20 as anticipated by Tabor. *Id.* at 4.

8. On May 11, 2009, Appellants filed a Response to Office Action which sought to amend the Specification as follows (footnote added):

This application is a continuation-in-part of U.S. Patent Application Serial No. 11/134,843, filed on May 20, 2005, entitled ~~METHODS AND APPARATUS FOR LOCAL OUTLIER DETECTION~~ which is a continuation-in-part (“CIP”) of U.S. Serial No. 10/817,750, filed April 2, 2004, which is a CIP of U.S. Serial No. 10/730,388, filed on December 7, 2003, which is a CIP of U.S. Serial No. 10/367,355, filed on February 14, 2003, which is a CIP of U.S. Serial No. 10/154,627, filed on May 24, 2002, and incorporates the disclosure of such applications⁴ by reference. To the extent that the present disclosure conflicts with any referenced

³ Even though the version of this statement that was contained in the application as originally filed used the singular “application,” this amendment changed “application” to “applications” without indicating that the word had been changed.

⁴ See *supra* note 3.

application, however, the present disclosure is to be given priority.

9. In an Office Action mailed on June 10, 2009, the Examiner objected to the May 11, 2009 Specification Amendment and declined to enter it, stating that “it is improper to change the priority after the time define[d] in MPEP 201.11, 37 CFR 1.78 (a)(2)(ii), any change of priority after the date is by petition.” 6/10/2009 Office Action 2. The Office Action also objected to the amendment filed on May 13, 2008 under 35 U.S.C. § 132(a), stating that it introduced new matter into the disclosure and the added material was not supported by the original disclosure. *Id.* The Office Action included a Final Rejection of claims 1-6, 8-13, and 15-20 as anticipated by Tabor. *Id.* at 4.

10. The file history of the present application does not indicate that Appellants filed a petition to accept an unintentionally delayed priority claim under 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(3).

PRINCIPLES OF LAW

1. 35 U.S.C. § 120 states, in part (footnote added):

An application for patent for an invention disclosed . . . in an application previously filed in the United States . . . which is filed by an inventor or inventors named in the previously filed application⁵ shall have the same effect, as to such invention, as though filed on the date of the prior application . . . if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section

⁵ The inventors in the present application are Emilio Miguelanez and Greg Labonte. The sole inventor in the Tabor reference for which Appellants seek to obtain priority is Eric Paul Tabor. The Examiner did not raise an issue as to whether the inventorship in the present application satisfies 35 U.S.C. § 120 and we decline to raise it in the first instance on appeal.

unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures . . . to accept an unintentionally delayed submission of an amendment under this section.

2. 37 C.F.R. § 1.78(a) states, in part:

(2)(i) . . . any nonprovisional application . . . must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) . . . and indicating the relationship of the applications.

(ii) . . . [T]his reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. . . . These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120 . . . to such prior-filed application.

. . . .

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120 . . . may be accepted if the reference identifying the prior-filed application by application number . . . was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120 . . . for the benefit of a prior-filed application must be accompanied by:

[the items specified in sub-sections (i) – (iii)].

ANALYSIS

An objection to an amendment and a refusal to enter an amendment are not usually considered to be under the Board's jurisdiction. In the present case, the objection and the refusal to enter Appellants' proposed Amendment bear directly on the claims and the Examiner's rejection under 35 U.S.C. § 102(b). FF 2, 4, 6, 8. We will therefore address the Examiner's refusal to enter the Amendment and the Examiner's conclusion that the proposed Amendment constitutes new matter. *See In re Hengehold*, 440 F.2d 1395, 1404 (CCPA 1971) (“[T]he kind of adverse decisions of examiners which are reviewable by the board must be those which relate, at least indirectly, to matters involving the rejection of claims.”).

*The Examiner's Refusal to Enter the
Proposed May 11, 2009, Amendment*

The Examiner refused to enter the proposed May 11, 2009 Amendment because: (1) it would change the priority after the time deadlines in MPEP § 201.11 and 37 C.F.R. § 1.78(a)(2)(ii); and (2) no petition had been filed seeking permission to file such an Amendment. Ans. 15-16.

Appellants contend that the present application is entitled to the benefit of Tabor's filing date because the required priority reference was included in the present application as filed. In particular, they contend, their application as filed incorporated Tabor by reference in paragraph [0001] of the Specification of the present application and the purported incorporation by reference is sufficient to support the priority claim. App. Br. 17-18; Reply Br. 3-4.

First, Appellants contend that 37 C.F.R. § 1.57(b) provides that a clear intent to incorporate by reference using the root words “incorporat(e)” and “reference” along with a clearly identified reference to a patent application is sufficient to incorporate the material in the referenced patent application into the newer application. App. Br. 18; Reply Br. 4.

To the contrary, 37 C.F.R. § 1.57(b) applies “[e]xcept as provided in paragraph [1.57](a)” which in turn requires as a preliminary condition that the application contains a claim under § 1.78 for the benefit of a prior-filed application. As explained in MPEP § 201.17(II) “Conditions and Requirements of 37 CFR 1.57(a),” “a claim under 37 CFR 1.78 for the benefit of a prior-filed . . . application, must have been present on the filing date of the application.” The provisions of § 1.57(b)(1) do not reduce Appellants’ burden to fully comply with § 1.78. Instead, § 1.78 is a *prerequisite* to obtaining the benefit of § 1.57(b)(1). Therefore, the provisions of § 1.57(b) apply only if a proper claim under § 1.78 is already of record.

Appellants’ application as originally filed on September 27, 2006, included an explicit and specific reference only to Application No. 11/134,843. FF 1. The originally filed application did not include an explicit and specific reference to Tabor. FF 1. Appellants’ May 13, 2008 Request for Reconsideration included a proposed Amendment to the Specification that provided a specific reference to prior applications, including Application No. 10/154,627, Tabor’s application number, and stated Tabor’s filing date as May 24, 2002. FF 5, 6. Appellants’ May 13, 2008 filing was the first time Appellants sought to include a specific reference to Tabor in their Specification. *See* FF 1-6. The May 13, 2008

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filing was more than 4 months after the filing of Appellants' current application and more than 16 months after the filing of the Tabor application. *Compare* FF 1 with FF 6.

Appellants filed the same specific reference to prior applications, including Tabor, on May 11, 2009. FF 8.

The file history of Appellants' present application does not indicate that Appellants filed a petition to accept an unintentionally delayed claim under 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(3). FF 10.

We disagree with Appellants and conclude that § 1.57 does not eliminate their obligation to comply fully with § 1.78 and we conclude that Appellants did not comply with § 1.78 in such a way as to afford them priority any earlier than May 20, 2005.

Second, Appellants contend that

[a]s soon as the Tabor publication was cited as a prior art reference against the present claims and it was discovered that an explicit claim of priority to the Tabor publication had been inadvertently omitted, the appellant filed an amendment in compliance with 37 C.F.R. § 1.57(a) to incorporate the inadvertently omitted material and clarify the already present claim of priority.

Reply Br. 4.

To the contrary, Appellants did not file a clarifying amendment as soon as the Tabor publication was cited on September 28, 2007. Instead, they filed only an amendment to the Abstract. FF 3. Proposed clarifying amendments were not filed until May 13, 2008 and May 11, 2009. FF 6, 8.

Third, Appellants contend that 37 C.F.R. § 1.57(a) and MPEP § 201.06(c)(IV) support their position that the proposed priority claims filed after their original filing date should be considered. Specifically citing these

authorities, Appellants contend that “if the inadvertently omitted material is ‘completely contained in the prior-filed application, the claim under . . . §1.78 shall also be considered an incorporation by reference.” App. Br. 18; Reply Br. 3. They also contend that “the purpose of 37 CFR 1.57(a) is to provide a safeguard for applicants when all or a portion of the specification and/or drawing(s) is (are) inadvertently omitted from an application.” Reply Br. 4 (quoting MPEP § 201.06(c)(IV)).⁶ We disagree with Appellants’ interpretation of these authorities.

37 C.F.R. § 1.57, by the very terms quoted by Appellants, requires a proper claim under § 1.78 as a prerequisite. In addition, the MPEP provision cited by Appellants, MPEP § 201.06(c)(IV) includes a paragraph A entitled “Application NOT Entitled to a Filing Date,” which states, in part: “if the material needed for a filing date is completely contained within a prior-filed application to which benefit is claimed, applicant may file a petition under 37 CFR 1.57(a)(3)” along with other requirements.

Based upon the facts of record, we find that Appellants’ originally filed application did not explicitly and specifically incorporate by reference any prior application other than Application No. 11/134,843 and did not amend their Specification within the time limits required by 37 C.F.R. § 1.78. We also find that Appellants did not file a petition to amend their Specification to change their priority date.

Accordingly, we conclude that the Examiner properly refused to enter the proposed Amendment filed on May 11, 2009.

⁶ Appellants apparently inadvertently referred to a section of the MPEP that they identified as § 2106(c) part IV. Reply Br. 4:25. The quotation, instead, is in MPEP § 201.06 (c) Part IV.

*The Examiner's Objection to the
Proposed Amendment as New Matter*

The Examiner objects to the proposed May 11, 2009 Amendment under 35 U.S.C. § 132(a) because it introduces new matter in the disclosure in that the added material is not supported by the original disclosure. Ans. 16. Appellants do not respond to the new matter objection. Arguments that Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2010).

We observe, nevertheless, the following passage in MPEP § 201.06(c)(IV):

An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Indus. v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980).

This section of the MPEP directly supports the Examiner's conclusion that the proposed amendments constitute new matter.

Based upon Appellants' failure to respond to the new matter objection and upon MPEP § 201.06(c)(IV), we conclude that the proposed Amendment constitutes new matter.

We are therefore not persuaded that the Examiner erred in (1) refusing to enter the proposed priority Amendment to the Specification; (2) in

objecting to the proposed Amendment as new matter; and (3) in rejecting claims 1-6, 8-13, and 15-20 as anticipated by Tabor.

Accordingly, we will sustain the Examiner's rejection of claims 1-6, 8-13, and 15-20 as anticipated by Tabor.

THE 35 U.S.C. § 101 REJECTION

The Examiner concludes that claims 8-21 are directed to non-statutory subject matter because they are not tied to a particular machine or do not transform any underlying subject matter. Ans. 3. Appellants contend that claims 8 and 15 are patentable subject matter because they are tied to a particular machine and transform data into a representation of a physically tangible object. App. Br. 17.

Claim 8 is illustrative:

8. A computer-implemented method for analyzing test data for multiple components fabricated on a wafer, comprising:
 - selecting a component as a central component;
 - identifying a plurality of local components in a local area near the central component;
 - determining a derived value of the test data for the plurality of local components;
 - comparing the test data for the central component to the derived value for the plurality of local components; and
 - identifying whether the test data for the central component represents a hybrid outlier according to the comparison of the test data for the central component to the derived value for the plurality of local components.

ISSUE

Under § 101, has the Examiner erred in rejecting claims 8-21 by finding that the computer-implemented method of claim 8 and the computer program of claim 15 are non-statutory subject matter?

ANALYSIS

Under § 101, there are four categories of subject matter that are eligible for patent protection: (1) processes; (2) machines; (3) manufactures; and (4) compositions of matter. 35 U.S.C. § 101. While the scope of patentable subject matter encompassed by § 101 is “extremely broad” and intended to “include anything under the sun that is made by man,” it is by no means unlimited. *In re Comiskey*, 554 F.3d 967, 977 (Fed. Cir. 2009) (quoting *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980)). For example, laws of nature, abstract ideas, and natural phenomena are excluded from patent protection. *Diamond v. Diehr*, 450 U.S. 175, 188 (1981).

Appellants argue that claim 8 recites statutory subject matter because it is tied to a computer (App. Br. 16:1; 17:1), which is a particular machine (App. Br. 16:7), the calculated hybrid outlier inherently corresponds to the physical location of a component on a wafer and therefore represents a physically tangible object (App. Br. 16:16-21), and the recited “components” are components on a wafer and are therefore physically tangible objects represented by “derived values” and “test data.” Reply Br. 5-6.

Appellants also argue that the identification of a hybrid outlier represents the transformation of test data from among a plurality of selected components on a wafer to the possible identification of a hybrid outlier from

among the plurality of selected components (App. Br. 16:24-27; 17:2). They also argue that it is not necessary for the components recited in the claims to undergo a transformation as long as the underlying data has been transformed into something more than simple data gathering. Reply Br. 3:11-13.

It is the second exclusion noted above – abstract ideas – that is relevant to the appeal before us. Thus, even if the claimed invention nominally recites subject matter that falls within the enumerated categories under § 101, the claimed invention is still ineligible if the claim as a whole is nonetheless directed to an abstract idea. *Diehr*, 450 U.S. at 191-93.

To make this determination for claimed processes, the machine-or-transformation test is “a useful and important clue.” *Bilski v. Kappos*, 130 S.Ct. 3218, 3227 (2010). Although not the sole test, the machine-or-transformation test is nonetheless an investigative tool that asks whether a claimed process is (1) tied to a particular machine or apparatus, or (2) transforms a particular article into a different state or thing. *Id.* at 3225, 3227 (quoting *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008) (en banc)).

Independent claim 8 recites a computer-implemented method for analyzing test data for multiple components fabricated on a wafer. This test data analyzing includes: (1) selecting a component as a central component; (2) identifying a plurality of local components in a local area near the central component; (3) determining a derived value of the test data for the plurality of local components; (4) comparing the test data for the central component to the derived value for the plurality of local components; and (5) identifying whether the test data for the central component represents a hybrid outlier

according to the comparison of the test data for the central component to the derived value for the plurality of local components.

We conclude that the method in independent claim 8, when interpreted as a whole, is not tied to a particular machine or apparatus, nor does it transform a particular article into a different state or thing. We address each prong of the machine-or-transformation test separately.

Claim 8 recites a computer implemented method for analyzing test data. The Specification states that the invention may be described in terms of functional block components and various process steps that may be realized by hardware or software components configured to perform the specified functions. Spec. ¶ 0018. Other software may be used to facilitate the testing of components. Spec. ¶ 0024. We therefore regard the claimed method as steps executed by the software. The method steps are then considered under *Bilski* to determine if they are tied to a particular machine or apparatus or transform a particular article to a different state or thing. We find these steps do not satisfy either prong.

Claim 8 merely recites software for selecting and identifying components, deriving and comparing test data regarding the components, and identifying whether the comparison represents a hybrid outlier. Accordingly, claim 8 is software that does nothing more than receive data and analyze data. There is no reference to a specific machine by reciting structural limitations to any apparatus, nor is there any recitation to any specific operations that would cause a machine to receive or operate on a component or to receive and use the recited data. Thus, absent any specific structural limitations, claim 8 recites no more than an abstract concept.

The mere recitation of a “computer-implemented method” in the preamble of claim 8 is not a sufficient tie to a particular machine. We are guided by the outcome in *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012), where the Federal Circuit found that a similarly tangential computer recitation did not render patent-eligible a method that “‘explain[ed] the basic concept’ of processing information through a clearinghouse.” *Id.* (“[Appellants’] primary argument is that the ‘computer-aided’ limitation in the preamble sufficiently limits the claims to an application of the idea. We disagree.”). In that case, the claims at issue were silent with respect to how a computer aided the method, the extent to which a computer aided the method, and the significance of the computer to the performance of the method. *Id.* The claims did not “specify[] any level of involvement or detail” of a computer, and thus the case was distinguishable from *Ultramercial, LLC v. Hulu, LLC*, 657 F.3d 1323 (Fed. Cir. 2011), where “the patent claimed a practical application with concrete steps requiring an extensive computer interface.” *Dealertrack*, 674 F.3d at 1334.

Here too there is no limitation on how a computer is involved in performing the steps recited in claim 8. “Simply adding a ‘computer aided’ limitation to a claim covering an abstract concept, without more, is insufficient to render the claim patent eligible.” *Id.* at 1333.

Furthermore, the transformation of data does not make the claim patent-eligible. Although Appellants contend that claim 8 requires that test data be transformed in information regarding a hybrid outlier and the calculated hybrid outlier is associated with a component on a wafer (App. Br. 16:11-17), the transformation is merely mapping one set of data to

another set of data. Accordingly, no transformation to a different state or thing occurs, even if the items in claim 8 represent physical objects.

Thus, claim 8 fails the machine-or-transformation test. However, our analysis does not end there. In holding that the machine-or-transformation test “is not the sole test for deciding whether an invention is a patent-eligible ‘process,’” *Bilski*, 130 S.Ct. at 3227, the Supreme Court has made clear that a claim’s failure to satisfy the machine-or-transformation test is not dispositive of the § 101 inquiry. We find that claim 1 fails to recite patent-eligible subject matter because it is drawn to an unpatentable mathematical algorithm, which is a subcategory of unpatentable abstract ideas. *Diehr*, 450 U.S. at 191-92; *Parker v. Flook*, 437 U.S. 584 (1978).

Claim 8 recites the steps of determining data, comparing data, and identifying data. The steps of determining, comparing, and identifying data are mere data gathering steps that cannot make an otherwise nonstatutory claim statutory. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011). The step of “identifying whether the test data for the central component represents a hybrid outlier according to the comparison of the test data for the central component to the derived value for the plurality of local components” is a “mathematical formula [that] has no substantial practical application except in connection with a digital computer, which means that . . . [the claim] would wholly pre-empt the mathematical formula and in practical effect would be a patent on the algorithm itself.” *Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972).

Claim 8 therefore pre-empts a fundamental principle, rather than being limited to a particular application of the principle. Dependent claims

9-14 fail to recite anything more than additional steps of the mathematical algorithm.

We are therefore not persuaded that the Examiner erred in rejecting (1) representative claim 8 as directed to non-statutory subject matter; (2) claim 15 for similar reasons; and (3) claims 9-14 and 16-21 not argued separately with particularity.

CONCLUSION

Under § 102, the Examiner did not err in rejecting claims 1-6, 8-13, and 15-20. Under § 101, the Examiner did not err in rejecting claims 8-21.

DECISION

The Examiner's decision rejecting claims 1-6 and 8-21 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

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