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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALVARO BOLIVAR and SUNIL MOHAN

Appeal 2015-002602
Application 13/184,326¹
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
MATTHEW S. MEYERS, Administrative Patent Judges.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Alvaro Bolivar, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

¹ The Appellants identify eBay Inc. as the real party in interest. App. Br. 2.

THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method comprising:

maintaining a database of queries that are submitted by entities, the database storing a query submitted by an entity;

assigning a score to the query based on an action taken by the entity as a result of a first search recommendation provided to the entity,

the assigning of the score being performed by a processor of a machine;

receiving a request for a second search recommendation, the request including an argument;

retrieving the query from the database of queries based on the argument and on the score assigned to the query; and

providing the query in a second search recommendation in response to the received request for the second search recommendation.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 1–20 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.
2. Claims 1–4 and 7–20 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

ISSUES

Did the Examiner err in rejecting claims 1–20 under 35 U.S.C. §101 as being directed to non-statutory subject matter?

Did the Examiner err in rejecting claims 1–4 and 7–20 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement?

ANALYSIS

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

The Appellants argued these claims as a group. *See* Reply Br. 2–17. We select claim 1 as the representative claim for this group, and the remaining claims 2–20 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

The Appellants arguments are unpersuasive as to error in the rejection.

On pages 2 and 3 of the Reply Brief (Section I.), the Appellants correctly state what Section 101 provides; the types of judicially-excepted subject matter implicit in Section 101 that are mentioned by the Supreme Court in *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014); and, the two-step framework set forth in *Alice* for determining whether claimed subject matter is judicially-excepted from patent eligibility under § 101.

Then, the Appellants make the argument that “there is nothing in *Alice Corp.* and the Guidelines [2014 Interim Guidance on Patent Subject Matter

Eligibility] that state that any fundamental practice is an abstract idea.”

Reply Br. 4.

The Examiner found that [claim 1 is] “directed towards a method for providing search recommendations. Providing search recommendations is a fundamental practice and thus, the claims include an abstract idea.” Ans. 3. The Examiner did not find that any fundamental practice is an abstract idea. Rather, the Examiner followed the first step of the *Alice* framework (“[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355). The Examiner found that claim 1 is directed to “providing search recommendations.” The Appellants have not disputed this. Accordingly, we take as accepted that it is. The question is whether “providing search recommendations” is an abstract idea. If so, then claim 1 is directed to an abstract idea.

The Appellants argue that, notwithstanding that claim 1 is directed to “providing search recommendations,” it nevertheless cannot be directed to an abstract idea because “providing search recommendations” is not one the specific types of judicially-expected subject matter mentioned by the Supreme Court in *Alice*; that is, laws of nature, natural phenomena, and abstract ideas and, with respect to abstract ideas, algorithms, mathematical formulas and fundamental economic practices. *See* Reply Br. 3 (“This claim [claim 1] is not directed to a law of nature, natural phenomena, or an abstract idea, because ... this claim is not directed to the subject matter of any of the only three types of claims that the Court has positively identified as being within the implicit exception to subject matter

eligibility: (1) an idea or algorithm of itself, (2) a mathematical formula, or a (3) a fundamental economic practice.”). However, the abstract idea category is not so limited. “[I]n applying the § 101 exception, we must distinguish between patents that claim the ‘buildin[g] block[s]’ of human ingenuity and those that integrate the building blocks into something more, *Mayo*, 566 U.S., at —, 132 S.Ct., at 1303, thereby ‘transform[ing]’ them into a patent-eligible invention, *id.*, at —, 132 S.Ct., at 1294. The former ‘would risk disproportionately tying up the use of the underlying’ ideas, *2355 *id.*, at —, 132 S.Ct., at 1294, and are therefore ineligible for patent protection.” *Alice*, 134 S. Ct. at 2354-2355. Thus, the abstract idea category of judicially-excepted subject matter broadly covers building blocks of human ingenuity. Like fundamental economic practices, providing recommendations is such a building block. Providing recommendations is a fundamental practice of human behavior that, for example, is resorted to advance a common course of action. Therefore, like fundamental economic practices, providing recommendations is an abstract idea. That claim 1 is more specifically directed to providing *search* recommendations does not change the finding that claim 1 is directed to a building block of human ingenuity and thus, an abstract idea. It is simply a lower level of abstraction. *Cf. Apple, Inc. v. Ameranth, Inc.*, 2016 WL 6958650, *7 (Fed. Cir. 2016) (“An abstract idea can generally be described at different levels of abstraction. As the Board has done, the claimed abstract idea could be described as generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location. It could

be described in other ways, including, as indicated in the specification, taking orders from restaurant customers on a computer.”)

Section 1.A of the Reply Brief (pages 4-5) repeat the argument that “[t]he only fundamental practice that *Alice Corp.* and the Guidelines stated is fundamental economic practice” (Reply Br. 4). We disagree with that narrow view for the reasons already discussed. We direct the Appellants to numerous Federal Circuit decisions since *Alice* that suggest a broader view. *Fid. Nat'l Info. Servs., Inc. v. DataTreasury Corp.*, CBM2014-00020, 2015 WL 1967327 *9 (Patent Tr. & App. Bd. Apr. 29, 2015), *aff'd*, No. 2016-1046, 2016 WL 5939431 (mem.) (Fed. Cir. Oct. 13, 2016) (“We hold [] that the challenged claims pose a risk of unacceptable preemption as the claim language is generic in nature-- referring to capturing images, managing the transaction data, collecting the data, encrypting subsystem identification information and transaction data, verifying data and transmitting data within and between a remote location and a central location.”)

Section 1.B. argues that “unlike the claims at issue in [*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)], the claims at issue in this case are not directed to an idea or algorithm of itself.” Reply Br. 6. The reasons given appear to have to do with pre-emption; that is, “while the claims may be related generally to ‘providing search recommendations,’ as alleged by the Examiner, this general idea is not what would be preempted by a granting of a patent of this case.” Reply Br. 5. However, “[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also Techs.*, 788

F.3d at 1362–63 [*OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir.), *cert. denied*, 136 S. Ct. 701, 193 L. Ed. 2d 522 (2015)] (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”).

Sections 1.C. and 1.D. (reply Br. 6-11) discuss mathematical formulas and fundamental economic practices in an effort to argue that since the subject matter covered by claim has not been shown to fit and does not fit into these two types of abstract ideas, claim 1 is not directed to an abstract idea. We have addressed this argument above.

Section II is a discussion related to step 2 of the *Alice* framework; that is, step two is “a search for an ‘inventive concept’—i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 134 S. Ct. at 2355. (alteration in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012)). We have considered the elements of claim 1 both individually and as an ordered combination, in light of the Appellants’ discussion, to determine whether the additional elements transform the nature of the claim into a patent-eligible application. We are unpersuaded that the Examiner erred in finding that they do not. *See e.g.*, Ans. 4.

In Section II.A. (Reply Br. 12), the Appellants argue that claim 1 does “more than simply stat[e] an abstract idea while adding the words ‘apply it’.” *Alice*, 134 S. Ct. at 2358. Reply Br. 11. We disagree. Claim 1 recites two elements: “a database” and “a processor of a machine.” The

Specification supports the view that said elements encompass that which is generic and common in the field at the time of the invention. *See Spec., inter alia*, paras. 17–19. The evidence on record supports the view that only conventional elements of a generic computer system are involved. There is insufficient evidence that claim 1 roots the solution in computer technology. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014) (“the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.”) *See also Amdocs (Israel) Limited v. Openet Telecom, Inc.*, 841 F.3d 1288, 1300-01 (Fed. Cir. 2016) (“the claim’s enhancing limitation necessarily requires that these generic components operate in an unconventional manner to achieve an improvement in computer functionality. The enhancing limitation depends not only on the invention’s distributed architecture, but also depends upon the network devices and gatherers—even though these may be generic—working together in a distributed manner.”) Rather, conventional elements of a generic computer system are employed for their inherent functions to perform as expected; that is, storing, assigning, and retrieving types of information. We note that the information being processed, as claimed, is particular (e.g., queries and scores), their particularity gives a contextual and practical application for providing recommendations. However, this is insufficient to transform the abstract idea of providing recommendations into an inventive concept to ensure that in practice the system amounts to significantly more than to be on providing recommendations itself. *Cf. CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1371 (Fed. Cir.

2011) (“The Court [*Parker v. Flook*, 437 U.S. 584 (1978)] rejected the notion that the recitation of a practical application for the calculation could alone make the invention patentable.”). For the foregoing reasons, albeit the words “apply it” are not expressly recited in claim 1, that is in effect what the claim 1 subject matter would entail in practice.

In Section II.B. (Reply Br. 12-15), the Appellants attempt to make the case that claim 1 is like the claims in *Diehr* and *DDR*. “[J]ust like the claims in [*Diamond v. Diehr*, 450 U.S. 175 (1981)], independent claim 1 solves a technological problem that was in conventional industry practice. Like in *DDR Holdings*, independent claim 1 recites a specific way to overcome a problem specifically arising in the realm of computer networks.” Reply Br. 15. We are unpersuaded. The Appellants reproduce limitations from claim 1 and identify them as solving a “technological problem in convention industry practice” (Reply Br. 14). We do not see in any of the claim limitations, and the Appellants point to none that necessarily root the solution in computer technology so it can be said that computer technology is the factor that overcomes the problem.

The Appellants argue that “[t]he Examiner has failed to provide any evidence that the claim elements of the independent claims, separately or taken together as an ordered combination, ‘are well- understood, routine and conventional activities,’ as alleged by the Examiner.” Reply Br. 14-15. The extensive disclosure in the Specification of generic computer components useful in implementing the invention belies that criticism. And, notwithstanding what the Specification discloses, the Appellants do not themselves present persuasive evidence to the contrary.

The Appellants argue that

the fact that the Examiner, despite significant effort during prosecution of the matter, cannot find any prior art teaching the claim element of assigning a score to the query submitted by an entity based on an action taken by the entity as a result of a first search recommendation provided to the entity is evidence of the independent claims amounting to "significantly more" than an instruction to apply the alleged abstract idea of "providing search recommendations" using some unspecified, generic computer.

Reply Br. 15. That is not a persuasive argument. An abstract idea does not transform into an inventive concept just because the prior art does not disclose or suggest it.

Section II.C. repeats various arguments (e.g., no pre-emption) already addressed.

We have fully considered the Appellants' arguments. For the foregoing reasons, they are unpersuasive as to error in the rejection. The rejection is sustained.

The rejection of claims 1–4 and 7–20 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

The Examiner's position is that "there is no mention in the specification of a 'first search' or 'a request for a second search' or a 'second search'. While there is support for a 'second cube,' there is no support for a 'second search' or that the searches are divided up into 'first' and 'second' searches." Final Act. 2–3. The Appellants point out that

In the Examiner's Answer, the Examiner has acknowledged for the first time during the prosecution of this Application that the Examiner is not citing the actual claim language (i.e., a search recommendation vs. a search). [Ans. 2] However, the Examiner is stating that this is proper because "if there is no mention throughout the entirety of the

specification of a 'second search' then there is no recitation of a 'second search recommendation.

Reply Br. 17. We agree with the Appellants.

Compliance with the written description requirement is a question of fact. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985). “[T]he invention is, for purposes of the ‘written description’ inquiry, whatever is now claimed.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1564 (Fed. Cir. 1991). The Examiner has not focused on what is claimed. Searches and search recommendations are not the same thing. A question of adequate written descriptive support for one does not necessarily lead to a question about the other.

A prima facie case of a lack of written descriptive support in the Specification for the claimed subject matter has not been made out in the first instance by a preponderance of the evidence. Accordingly the rejection is not sustained.

CONCLUSIONS

The rejection of claims 1–20 under 35 U.S.C. §101 as being directed to non-statutory subject matter is affirmed.

The rejection of claims 1–4 and 7–20 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement is reversed.

DECISION

The decision of the Examiner to reject claims 1–20 is affirmed.

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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)(iv).

AFFIRMED