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NEW YORK, NY 10022

EXAMINER
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ALLADIN, AMBREEN A

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* STEPHEN DICKSON and PELHAM TEMPLE

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Appeal 2015-005044<sup>1</sup>  
Application 13/285,427  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, NINA L. MEDLOCK, and  
BRADLEY B. BAYAT, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants filed a Motion for Rehearing (“Req. Reh’g.”), pursuant to 37 C.F.R. § 41.52, dated June 19, 2017, seeking reconsideration of our Decision on Appeal mailed April 19, 2017 (“Decision”), in which we affirmed the Examiner’s rejection of claims 1–36 under 35 U.S.C. § 101 as

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<sup>1</sup> Our decision references Appellants’ Appeal Brief (“App. Br.,” filed October 10, 2014) and Reply Brief (“Reply Br.,” filed April 6, 2015), and the Examiner’s Answer (“Ans.,” mailed February 6, 2015) and Final Office Action (“Final Act.,” mailed September 12, 2013).

directed to non-statutory subject matter.<sup>2</sup> We have jurisdiction over the Request under 35 U.S.C. § 6(b).

## DISCUSSION

We note at the outset that a request for rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the [Patent Trial and Appeal Board (the “Board”)].” 37 C.F.R. § 41.52(a). A request for rehearing is not an opportunity to rehash arguments raised in the briefs. Neither is it an opportunity to merely express disagreement with a decision without setting forth the points believed to have been misapprehended or overlooked. Arguments not raised in the briefs before the Board and evidence not previously relied on in the briefs also are not permitted except in the limited circumstances set forth in §§ 41.52(a)(2) though (a)(4).<sup>3</sup>

Turning to the Request, Appellants first argue that the Examiner has failed to establish a prima facie case of patent-ineligibility (Req. Reh’g 2–5). Citing “binding PTO examination guidelines from May 4, 2016,” Appellants charge that the Examiner does not cite to appropriate court decisions or explain how the subject matter recited in the claims corresponds to concepts in the cited court decisions,<sup>4</sup> and that the Examiner also presents no evidence

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<sup>2</sup> We also reversed the Examiner’s rejection of claims 1–36 under 35 U.S.C. § 103(a).

<sup>3</sup> Appellant may present a new argument based on a recent relevant decision of either the Board or a federal court; new arguments responding to a new ground of rejection designated as such under § 41.50(b) and new arguments that the Board decision contains an undesignated new ground of rejection are also permitted.

<sup>4</sup> The Examiner notes, in the Answer, that courts have identified claims directed to the performance of certain financial transactions as involving

regarding the long prevalence of any abstract ideas (*id.* at 2–3). Appellants, thus, maintain that the Examiner’s reasoning and analysis do not include sufficient substance to rise to the level of a *prima facie* showing (*id.* at 5). We disagree.

The Federal Circuit has repeatedly noted that “the *prima facie* case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). The court has, thus, held that the USPTO carries its procedural burden of establishing a *prima facie* case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011). Thus, all that is required of the Office is that it set forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. *Id.*

Here, in rejecting claims 1–36 under 35 U.S.C. § 101, the Examiner analyzed the claims using the *Mayo/Alice* two-step framework, consistent

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abstract ideas and cites, as examples, *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (creating a transaction performance guaranty for a commercial transaction on computer networks such as the Internet); *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1338 (Fed. Cir. 2013) (generating rule-based tasks for processing an insurance claim); *Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Canada (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (managing a stable value protected life insurance policy); *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012) (processing loan information through a clearinghouse). Ans. 17.

with the guidance set forth in the USPTO’s “2014 Interim Guidance on Patent Subject Matter Eligibility,” 79 Fed. Reg. 74618 (Dec. 16, 2014), in effect at the time the rejection was made, i.e., on February 6, 2015. As we indicate in the Decision (*see* Decision 5), the Examiner notified Appellants of the reasons for the rejection “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” 35 U.S.C. § 132. And, contrary to Appellants’ assertions, in doing so, the Examiner set forth a *prima facie* case of unpatentability such that the burden shifted to Appellants to demonstrate that the claims are patent-eligible.

Appellants ostensibly argue that evidentiary support is required to establish a *prima facie* case of patent-ineligibility (*see, e.g.*, Req. Reh’g 3 (“[T]he Examiner made no allegation and presented no evidence regarding the long prevalence of any abstract ideas.”)). But we are aware of no controlling precedent that requires the Office to provide factual evidence to support a finding that a claim is directed to an abstract idea. And, although it may be useful in some circumstances to compare the claims at issue with those in earlier cases in which a similar issue of patent-eligibility has been decided, such a comparison, contrary to Appellants’ suggestion (*id.* at 5), is not required for a *prima facie* showing, nor is it mandated by “proper examination procedure” (*id.*).

Appellants maintain that *Trading Technologies International, Inc. v. CQG, Inc.*, 675 Fed. Appx 1001 (Fed. Cir. 2017) is the “most similar case decided by the courts” to Appellants’ claims, and that if “the courts’ and PTO’s examination procedures were followed[,] a comparison to [the *Trading Technologies*] case would have shown the claims to be patent

eligible” (Req. Reh’g 6). Appellants assert that the Federal Circuit upheld the patentability of the claims in *Trading Technologies* because they improved the speed, usability and efficiency of computerized economic interfaces, and argue that the present claims similarly improve the usability and efficiency of computerized economic interfaces (*id.*; *see also id.* at 12). But Appellants present no evidence or technical reasoning to support that position. For example, Appellants do not identify or otherwise highlight any portions of the Specification. And we found nothing, from our review of the Specification, which ascribes any particular technical improvement in computerized economic interfaces to the claimed invention.

Appellants further argue that the claims are not directed to an abstract idea because, like the claims at issue in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), the claims are directed to “an improvement in computerized economic systems” (Req. Reh’g 7). Appellants assert that the claims “improve the speed, usability and efficiency of conventional economic systems” (*id.*). However, we find nothing in the Specification, nor do Appellants point to anything in the Specification, to indicate that any increased speed, usability, or efficiency comes from the claimed invention itself, rather than from the capabilities of the recited “computing device,” i.e., the general-purpose computer (*see, e.g.*, Spec. 46, 51), responsible for performing the claimed method steps. *See Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (“[T]he fact that the required calculations could be performed more efficiently via a computer does not materially alter the patent eligibility of the claimed subject matter.”); *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (relying on a computer to perform

routine tasks more quickly or more accurately is insufficient to render a claim patent-eligible).

Appellants note that the Specification goes into great detail about the vast amount of data and calculations performed to provide the described user interface (Req. Reh'g 8). And Appellants assert that “[t]his information simply could not be processed or even understood without the use of modern computer techniques” (*id.*). Yet automating a manual process is insufficient to render a claim patent-eligible. *See, e.g., Tranxition, Inc. v. Lenovo (U.S.), Inc.*, 664 Fed. Appx. 968, 971 (Fed. Cir. 2016).

Appellants’ further argument that the claims pose no preemption risk is similarly unpersuasive of Examiner error (Req. Reh’g 8). Although the Supreme Court has described “the concern that drives this exclusionary principle [i.e., the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption,” *see Alice Corp.*, 134 S. Ct. at 2354, characterizing pre-emption as a driving concern for patent eligibility is not the same as characterizing pre-emption as the sole test for patent eligibility. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice Corp.*, 134 S. Ct. at 2354). Although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

Ostensibly seeking to draw a further analogy between the present claims and those at issue in *Bascom Global Internet Service, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016) and *Trading Technologies*,

Appellants argue that the Examiner, “in alleging that the claims are not directed to significantly more than an abstract idea,” improperly “relies entirely on a position that the claims could be performed by a general purpose computing device” (Req. Reh’g 8–9). Appellants note that, in *Trading Technologies*, the Federal Circuit found a trading system implemented on a general purpose computer to be patent-eligible, and in *Bascom*, although the claim limitations recited generic computer network and Internet components, the court held that an inventive concept may be found in the non-conventional, non-generic arrangement of known conventional elements (*id.* at 9).

Appellants argue that the evidence of record shows that the present claims are similarly directed to a non-conventional and non-generic arrangement of elements (*id.* at 10), and, like the claims at issue in *DDR Holdings*, recite technological improvements, e.g., speed, usability, and efficiency, that are rooted in computers and networking (*id.* at 11–12). Yet Appellants do not identify the “evidence of record,” short of attorney argument, which supports their position. And, to the extent that Appellants rely for support on the Board’s reversal of the Examiner’s obviousness rejections (*id.* at 12 (“The claims override the routine, conventional and generic manner of operation of those technologies as is evidenced by the removal of any prior art rejections by the Decision.”))), Appellants misapprehend the controlling precedent. Although the second step in the *Mayo/Alice* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for “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 Corp.*, 134 S. Ct. at 2355.

A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 132 S. Ct. at 1304.

Claim 1, for example, recites an apparatus comprising a computing device and a non-transitory medium for storing a plurality of instructions that, when executed by the computing device, cause the computing device to perform certain actions, i.e., to collect and analyze particular information (e.g., interest rates and interest rate expectations); perform certain calculations (e.g., calculate a spread between a first interest rate and a second interest rate and a spread of spreads between a first spread and a second spread); and display the results via a user interface. In this regard, the steps of claim 1 are similar to the steps that the Federal Circuit determined were patent-ineligible in *Electric Power Group LLC v. Alstom*, 830 F.3d 1350 (Fed. Cir. 2016).

In *Electric Power*, the method claims at issue were directed to performing real-time performance monitoring of an electric power grid by collecting data from multiple data sources, analyzing the data, and displaying the results. *Elec. Power Grp.*, 830 F.3d at 1351–52. There, the Federal Circuit held that the claims were not patent-eligible because “[t]he advance they purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions.” *Id.* at 1354.

Similarly here, we find that claim 1 involves nothing more than collecting data, e.g., regarding interest rates and interest rate expectations; performing certain calculations, e.g., calculating spreads and spreads of

spreads; analyzing the data, e.g., to determine a correlation between a rate and a spread; and displaying the results through a user interface — activities squarely within the realm of abstract ideas. *See id.* at 1353–54 (characterizing collecting information, analyzing information by steps people go through in their minds, or by mathematical algorithms, and presenting the results of collecting and analyzing information, without more, as matters within the realm of abstract ideas).

Appellants do not assert that claim 1 (or any other claim, for that matter) involves a new technique for analyzing and/or displaying information. Nor is there any indication in the record that the calculations performed are not well-known or that an inventive device is required for performing the calculations or displaying the calculated results. Instead, the Specification is clear that the claimed invention “may be implemented by, e.g., appropriately programmed general purpose computers” (Spec. 46; *see also id.* at 51 (further describing the use of a general purpose computer programmed to perform a particular function or algorithm)). The mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. *See DDR Holdings*, 773 F.3d at 1256 (“After *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”).

We are not persuaded that the Examiner erred in finding that claims 1–36 are directed to patent-ineligible subject matter. Therefore, we decline to modify our original Decision.

Appeal 2015-005044  
Application 13/285,427

DECISION

Appellants' Request for Rehearing has been granted to the extent that we have reconsidered our Decision in light of Appellants' Request, but is denied in all other respects.

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

DENIED