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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN P. ASHBURN, JAMES A. BALLINGALL,
ANDREW SCOTT CROCKETT, ERIC ANDREW RATTNER,
ANDREW MARC RUSSAKOFF, and DUSTIN TED WHITNEY

Appeal 2016-000599
Application 13/707,060¹
Technology Center 3600

Before, ANTON W. FETTING, JOSEPH A. FISCHETTI, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

¹ Appellants identify Pellucid Analytics, LP, a Limited Partnership as the real party in interest. Br. 1.

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants claim a system and method for the creation, review and revision of investment banking materials (Title).

Claim 20 reproduced below, is representative of the subject matter on appeal.

20. A non-transitory computer-readable medium comprising first computer program instructions, wherein the first computer program instructions are executable by at least one computer processor to perform a method, the method comprising:

- coupling in real time to a financial data source,
- establishing one or more user accounts corresponding to respective users,
- establishing a set of default financial chart templates and one or more preselected companies for each of the user accounts,
- receiving real-time financial data from the financial data source to populate one or more of the templates to generate a default library of charts for each of the preselected companies,
- receiving requests concerning the user accounts, such requests including selection from among the default library of which selected chart or charts is to be placed into one or more slides,
- updating the default library of charts for each of the preselected companies with the retrieved real-time financial data, and propagating the real-time financial data into any selected charts, whereby slides that contain the selected charts also contain real-time financial data; and
- rendering the graphic image of the selected charts and the one or more slides.

THE REJECTION

The following rejection is before us for review.

Claims 1-20 are rejected under 35 U.S.C. § 101.

ANALYSIS

35 U.S.C. § 101 REJECTION

Claims 1-20 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. We will sustain this rejection.

Representative independent claim 20 recites in pertinent part:

coupling in real time to a financial data source,
establishing one or more user accounts corresponding to respective users,
establishing a set of default financial chart templates and one or more preselected companies for each of the user accounts,
receiving real-time financial data from the financial data source to populate one or more of the templates to generate a default library of charts for each of the preselected companies,
receiving requests concerning the user accounts, such requests including selection from among the default library of which selected chart or charts is to be placed into one or more slides,
updating the default library of charts for each of the preselected companies with the retrieved real-time financial data, and propagating the real-time financial data into any selected charts, whereby slides that contain the selected charts also contain real-time financial data; and
rendering the graphic image of the selected charts and the one or more slides.

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Appeal Br. A-4.

The Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, . . . determine whether the claims at issue are directed to one of those patent-ineligible concepts. If so, we then ask, “[w]hat else is there in the claims before us?” To answer that question, . . . consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. [The Court] described step two of this analysis as 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 Corp., Pty. Ltd. v. CLS Bank Int’l, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

Although the Court in *Alice* made a direct finding as to what the claims were directed to, we find that this case’s claims themselves and the Specification provide enough information to inform one as to what they are directed to.

The steps in claim 20 result in updating a default library of charts for each of preselected companies with the retrieved real-time financial data,

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and propagating the real-time financial data into any selected charts, whereby slides that contain the selected charts also contain real-time financial data. The Specification states that the process involves a

senior banker then provides comments to the junior banker either as comments to the .pdf file, hand-written comments on a printout, or orally via phone or in person. This repeats until a satisfactory result is achieved. Some of these steps may be substituted, but without any gains in efficiency or accuracy.”

Specification 1:22-23; 2:1-3. The Specification furthermore echoes fundamental financial principals concerns stating:

What is needed is a system and method that generates a superior deck product to an investment bank senior banker, and by extension, to the bank's client. In particular, what is needed is a system and method that will lower expenses for investment banks by allowing them to require fewer junior resources, freeing those resources for other use. What is also needed is a system and method that can increase the number of clients a senior banker can cover, thereby increasing productivity. What is also needed is a system and method that will decrease the time it takes for a senior banker to respond to a client request, thereby building relationship capital. Such a system and method should also provide to senior bankers the benefits of mobility (the ability to do deck-creation work wherever he or she is), velocity (validation of ideas with quickly-created charts) and relevancy (only those deck charts that are truly needed, from among all that are possible).

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Specification 2:8-18.

Thus, all this evidence shows that claim 20 is directed to a process of gathering and analyzing information of a specified content, then displaying the results. It follows from prior Supreme Court cases, and *Gottschalk v. Benson*, 409 U.S. 63 (1972) in particular, that the claims at issue here are directed to an abstract idea. We treat “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016).

In addition, this evidence shows that the claims are also directed to a fundamental economic principles in that the process is “for use in creating investment-banking materials” (claim 1), and doing so more productively. The ultimate goal is the creation of a *deck*² (*see e.g.*, claim 17), which is a financial report which requires the most up to date data possible. Key to financial investing is data collection and the analysis thereof. The patent-ineligible end of the 35 U.S.C. § 101 spectrum includes fundamental

² Currently, the predominant workflow for the creation of investment banking client presentations requires iterative interaction between the senior banker (who will present to the client) and the junior banker or bankers (who will construct the presentation ahead of time for the senior banker). Such presentations are called “decks,” as in a deck of cards. They might involve, for example, twenty to one hundred pages of financial charts and executive summaries.

Specification 1:4-9.

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economic practices. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2355–1257. Thus, a process of gathering and analyzing information of a specified content (financial), then displaying the results is an “abstract idea” beyond the scope of § 101.

As in *Alice Corp. Pty. Ltd.*, we need not labor to delimit the precise contours of the “abstract ideas” category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of an intermediated settlement in *Alice* and a process of gathering and analyzing information of a specified content (financial), then displaying the results. Both are squarely within the realm of “abstract ideas” as the Court has used that term. That the claims do not preempt all forms of the abstraction or may be limited to financial data decks, does not make them any less abstract. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1360–61 (Fed. Cir. 2015).

The introduction of a computer into the claims does not alter the analysis at *Mayo* step two.

the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility. Nor is limiting the use of an abstract idea “to a particular technological environment.” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implement[t]” an abstract idea “on ... a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption

concern that undergirds our § 101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional feature[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

Alice Corp. Pty. Ltd., 134 S. Ct. at 2358 (alterations in original) (citations omitted).

“[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2359. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to take in data, compute a result, and return the result to a user amounts to electronic data query and retrieval—some of the most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the industry. In short, each step does no more than require a generic computer to perform generic computer functions.

Considered as an ordered combination, the computer components of Appellants’ method add nothing that is not already present when the steps are considered separately. Viewed as a whole, Appellants’ claims simply recite a process of gathering and analyzing information of a specified content (financial), then displaying the results. The claims do not, for example, purport to improve the functioning of the computer itself. Nor do

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they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than instructions for gathering and analyzing information of a specified content (financial), then displaying the results. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2360.

Appellants argue, “claim 1 requires the specific structures of a first server and a rendering server. Claim 17 requires a connected web server. And claim 20 implements a method of populating charts via manufacture, namely a non-transitory computer-readable medium comprising first program instructions.” (Appeal Br. 35).

We are not persuaded by Appellants’ arguments here because these claims

are no different from method claims in substance. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea. This Court has long “warn[ed] ... against” interpreting § 101 “in ways that make patent eligibility ‘depend simply on the draftsman’s art.’”

Alice Corp. Pty. Ltd., 134 S. Ct. at 2360 (alterations in original).

Appellants argue,

the application claims here cannot be reduced to any conventional and long-known abstract idea. They are more like *Diehr*. As the Examiner acknowledges, at least claims 1-16 and 20 are

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patentable over the prior art under sections 102 and 103. Thus, the Examiner has acknowledged that the patent claims recite unconventional features, bringing them within the ambit of Diehr.

(Appeal Br. 12).

We disagree with Appellants because the standard for patentability under 35 U.S.C. § 103(a) is obviousness, the standard for patentability under 35 U.S.C. § 102 is novelty, and the standard for patent eligibility under 35 U.S.C. § 101 is abstract idea. Each of these standards is separately required to be met before patentability can be conferred on invention, which is not the case here based on the latter standard. “The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981).

Appellants also argue,

Here, as in DDR Holdings, the application claims specify how interactions over a network are manipulated to yield the desired result of the creation of investment-banking materials. In particular, a real time connection to a financial data source keeps the template charts in a user's account populated. As in DDR Holdings, this is not the "expected manner" for the creation of such charts and decks, but rather saves considerable labor and trouble.

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(Appeal Br. 25-26).

We disagree with Appellants. First, Appellants' system claim 1 does not require "a real time connection" as argued by Appellants. Instead, claim 1 only recites "a server³ constructed to receive real time financial data". Thus, there is no positive recitation of "a real time connection". Any interpretation that "real time financial data" means "real time connection", would be based on speculation.

But, even if so claimed, we still would not find such nominal recitation of "a real time connection" to rise to the configuration found in the *DDR Holdings* claims. In *DDR Holdings*, the claims at issue recited, inter alia, "web pages displays [with] at least one active link associated with a commerce object associated with a buying opportunity of a selected one of a plurality of merchants" (claim 1 of US 7,818,399). In other words, unlike the claims before us here, which only generally recite the use of a computer server receiving financial data in real time, the claims in *DDR Holdings* "specify how interactions with the Internet are manipulated to yield a desired result — a result that overrides the routine and conventional sequence of events ordinarily triggered by the click of a hyperlink." *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1258 (Fed. Cir. 2014).

Claim 1 also requires a rendering server which renders graphic images from the compiled data, but this is merely a device dedicated to an

³ Claim 1 recites a "first computer server" which is generically recited to act in real time in response to requests -which is how servers work.

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insignificant post solution activity. *See Parker v. Flook*, 437 U.S. 584, 588-90 (1978) (insignificant post-solution activity step found to be insufficient to impart patentability).

We also disagree with Appellants that the claims “improve the technical process of creating investment banking materials” (Appeal Br. 35), because the issue is not whether the technology provides a real world benefit, but rather whether claims purports to improve computer functioning or “effect an improvement in any other technology or technical field.” *Alice*, 134 S. Ct. at 2359. The improvement here is in the creation of a compilation of financial data which is an abstraction. The claims do not claim a particular way of programming or designing the software to create the compilation, but instead merely claim the resulting process. *See McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016) (“directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery”).]

We are also not persuaded by Appellants’ argument that, the claims recite a process “previously done by a time consuming, laborious process involving multiple disparate applications” (Appeal Br. 35), because “the 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.” *FairWarning IP, LLC v. Iatric Systems, Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016), *citing Bancorp Servs.*, 687 F.3d at 1278.

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We find Appellants' arguments based recent Board Decisions (Appeal Br. 33-38) likewise unpersuasive, because our analysis above, unlike those Decisions, is specifically tailored to the facts before us in this appeal.

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 1-20 under 35 U.S.C. § 101.

DECISION

The decision of the Examiner to reject claims 1-20 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED.