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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS SCHACHNER, RUDOLF GENTNER,
RALF KUEHNER, MICHAEL HOHENDORF, and
DIRK HENRICH

Appeal 2016-001963
Application 13/327,303¹
Technology Center 3600

Before HUBERT C. LORIN, BART A. GERSTENBLITH, and
ROBERT J. SILVERMAN, Administrative Patent Judges.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Thomas Schachner et al. (Appellants) seek our review under 35 U.S.C. § 134(a) of the Final Rejection of claims 1–13 and 15–21. We have jurisdiction under 35 U.S.C. § 6(b).

¹ The Appellants identify SAP SE as the real party in interest. Br. 2.

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

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

1. A method comprising:

maintaining, at a host financial system, an accounting system with a generic cost object;

providing instructions, by the host financial system to a system of an entity separate from the host financial system, that cause presentation of a user interface to the entity, the user interface to receive attributes to create a configured cost object that represents a specialized business item;

receiving, by the host financial system from the system of the entity separate from the host financial system, data representing the configured cost object created by the entity;

creating, by a hardware processor, a mirror cost object using the received data representing the configured cost object created by the entity, the mirror cost object being a mirror instance of the configured cost object;

storing the mirror cost object in a storage device of the host financial system;

causing the accounting system to perform accounting operations using the mirror cost object and a corresponding business configuration set, the accounting operations comprising

accessing a configuration database to obtain the corresponding business configuration set that corresponds to the mirror cost object, and

replacing the generic cost object of the accounting system at the host financial system with the mirror cost object;
and

providing output based on performing the accounting operations using the mirror cost object and the corresponding business configuration set.

THE REJECTION

The following rejection is before us for review:

1. Claims 1–13 and 15–21 are rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

ISSUE

Did the Examiner err in rejecting claims 1–13 and 15–21 under 35 U.S.C. § 101 as being directed to non-statutory subject matter?

ANALYSIS

The Appellants argued these claims as a group. *See* Br. 8–27. We select claim 1 as the representative claim for this group, and the remaining claims 2–13 and 15–21 stand or fall with claim 1.

37 C.F.R. § 41.37(c)(1)(iv). *Alice Corp. Proprietary Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014), identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent-eligibility under 35 U.S.C. § 101.

According to *Alice* step one, “[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.

In that regard, the Examiner determined that “[c]laims 1–13 and 15–21 are directed to a series of steps configuring cost objects in a financial system, which is a fundamental economic practice and thus an abstract idea.” Final Rej. 2.

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 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)).

In that regard, the Examiner determined that “[t]he claim(s) do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the addition of the generically recited computer elements do not add a meaningful limitation to the abstract idea because they would be routine in any computer implementation.” Final Rej. 2.

The Examiner adds:

To be clear, the claims recite transferring “objects” between entities and replacing “objects” at a host system with a different, created “object.” Applicant's Specification states that objects and entities can be software modules. For patent-eligibility purposes, everything recited can be performed through a generic computer(s), where the functioning of the underlying computer(s) would essentially stay the same except for the implementation of standard cost objects, that may be changed through the implementation of the abstract idea. In other words, under the claim’s broadest reasonable interpretation, the claims recite software instructions that are implemented on generic computer(s).

Final Rej. 2–3.

The Appellants challenge the rejection starting at page 8 of the Appeal Brief. Headings are used to organize the Appellants’ arguments. We will do the same as we evaluate the contentions in each corresponding section.

A) *The Applicable Law under 35 U.S.C. § 101* (Br. 8)

We have no issue with what is generally stated in this section.

B) *Discussion of the rejection of claims 1–13 and 15–21 under 35 U.S.C. § 101 as allegedly being directed to a judicial exception without significantly more* (Br. 9)

This section briefly summarizes the Examiner’s position and the grounds on which the Appellants challenge said position, that is,

- 1) the Examiner has not established a prima facie case that the claims are not directed to patent-eligible subject matter;
- 2) the claims at issue are not directed to an abstract idea (Mayo step I); and 3) even if the claims are directed to an abstract idea, they are not directed to an unpatentable idea (Mayo step II).

Br. 9.

We have no issue with what is generally stated in this section.

I. *The Examiner has not established a prima facie case that the claims are not directed to patent-eligible subject matter* (Br. 9–10)

In this section, the Examiner’s position that “[c]laims 1-13 and 15-21 are directed to a series of steps configuring cost objects in a financial system, which is a fundamental economic practice and thus an abstract idea” (Final Rej. 2) is criticized because allegedly it is a “mere conclusory statement,” “no evidentiary support in making this allegation” has been provided, it “fails to establish a prima facie case that the claims are directed to an abstract idea,” “*specific claim limitations and the claims as a whole* [were ignored] *and* [instead] *merely reduced the subject matter of the claims to an Examiner-created summarization of the claims,*” “there is no

evidence on the record that the invention, *as defined by the particular claim limitations*, is simply some abstract idea,” and there is “no evidence or even argument as to why ‘a series of steps configuring cost objects in a financial system’ is a fundamental economic practice long prevalent in our system of commerce.” (Br. 9).

The method of claim 1 comprises seven steps whereby a host financial system:

1. maintains an accounting system with A;
2. provides instructions to a system of an entity separate from the host financial system to cause presentation of a user interface to the entity, the user interface to receive attributes to create B;
3. receives data representing information B from the entity;
4. creates C using the data representing B via a hardware processor;
5. stores C;
6. causes the accounting system to perform accounting operations using C and D by (a) accessing a database to obtain D and (b) replacing A with C;
7. provides output based on performing the accounting operations using C and D; where A, B, C, and D are types of information; that is, A = a generic cost object; B = a configured cost object that represents a specialized business item; C = a mirror cost object; and, D = a business configuration corresponding to C.

In other words, claim 1 defines an information-processing method whereby information a financial system uses to perform accounting operations is changed based on an entity’s input. The claimed method is

directed to information gathering, replacing and presenting, albeit specifically applied to financial accounting. This characterization of what the claim is directed to is consistent with what is discussed in the Specification. The Specification states *inter alia* that “[c]onventionally when a user wants to incorporate financial information that is specialized to the needs of the user into an accounting system, the user will need to purchase a customized or specialized accounting system that addresses the needs of the user.” Para. 2. The invention overcomes the need to purchase a customized system by allowing a user to change the information the system already uses. This characterization is not far off from what the Examiner determined it to be. The concept of “a series of steps configuring cost objects in a financial system” that the Examiner characterized the concept to which the claim is directed to is simply at lower level of abstraction. *Cf. Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240–41 (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.”).

Accordingly, we disagree that the Examiner has failed to properly determine what the claim is directed to.

As far as evidentiary support for the determination that the concept to which the claim is directed is an abstract idea, suffice it say that it is not necessary to resort to additional facts and evidence in making the *Alice* step one determination when the claims can adequately be compared to claims

declared abstract in past cases. *See Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (“Instead of a definition, then, the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.”). Here, as we stated, claim 1 calls for gathering four types of information, one is used to replace another, and two are used for performing an accounting operation on which to base an output. Thus, claim 1 is directed to gathering and replacing information and using information for an output. This is similar to the claimed methods for achieving real-time performance monitoring of an electric power grid that were held directed to the abstract idea in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016). When “the focus of the asserted claims” is “on collecting information, analyzing it, and displaying certain results of the collection and analysis,” the claims are directed to an abstract idea. *Id.* at 1353. “[C]ollecting information, including when limited to particular content (which does not change its character as information), [is] within the realm of abstract ideas.” *Id.*

Accordingly, notwithstanding the Appellants have not made the case that a factual dispute has arisen necessitating additional evidentiary support, it is sufficient to show the claimed subject matter is directed to an abstract idea by comparing the claims to those previously declared abstract as we have done here.

The remaining arguments in this section are unpersuasive as to error in the rejection.

- A. The Examiner is required under the Administrative Procedures Act to provide substantial evidence to support a § 101 rejection. (Br. 10–11)*
- B. There is no other area where rejections can be sustained on conclusory statements. (Br. 11–12)*
- C. The Supreme Court and Federal Circuit cited authoritative documentation to support their assertions about abstract ideas. (Br. 12–13)*
- D. The PTAB also indicates a need to cite authoritative documentation rather than rely on conclusory statements (Br. 13–14)*

The Appellants next argue that “the Examiner has failed to comply with the requirements of the Administrative Procedures Act, namely, the requirement to provide ‘substantial evidence’ in rejecting claims under 35 U.S.C. § 101” (Br. 10); “there is no instance where the courts have sustained the ability of the Examiner to provide a conclusory statement without support” (Br. 11); “unless the Examiner does provide authoritative documentation just as the Supreme Court did in *Alice*, the Examiner’s [sic] has not performed a ‘proper 101 analysis’” (Br. 12); and, “the PTAB indicates a need to rely on actual evidence rather than conclusory statements when supporting an assertion that something is an abstract idea” (Br. 13).

These arguments repeat the point that the Appellants made earlier — that they would like to see the Examiner provide evidentiary support for the determination that the claims are directed to an abstract idea. As we stated, notwithstanding the Appellants have not made the case that a factual dispute has arisen necessitating additional evidentiary support, it is sufficient to show the claimed subject matter is directed to an abstract idea by comparing the claims to those previously declared abstract as we have done above.

Whether or not § 101 should be applied in the same way other areas of patent law are applied and whether the APA, Supreme Court, Federal Circuit, and PTAB mean to require evidentiary support to reject claims

under § 101 are not questions we need to explore. Here, the Appellants have not made the case that a factual dispute has arisen that additional evidence can help resolve. Up to this point in the Brief, the Appellants have not shown that claim 1 is not directed to information processing (i.e., gathering, replacing, outputting) as is clear from a plain reading of the claim.

[T]he “directed to” inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether “their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015); see *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1375 (Fed. Cir. 2016) (inquiring into “the focus of the claimed advance over the prior art”).

Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1335 (Fed. Cir. 2016). “The ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas, LLC v. DirecTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC*, 830 F.3d at 1353); see also *Enfish, LLC*, 822 F.3d at 1335 (quoted in *Apple, Inc. v. Ameranth, Inc.*, 7842 F.3d at 1241). In that regard, we explained above that the Specification shows that the invention overcomes the need to purchase a customized system by allowing a user to change the information the system already uses. In accord with what is claimed, the Specification supports the view that “the heart of the claimed invention lies,” *Intellectual Ventures I LLC v. Erie Indemnity Company*, 850 F.3d 1315, 1328 (Fed. Cir. 2017), in gathering, replacing, and outputting information, albeit applied in an accounting context.

E. The Examiner has not established a prima facie case against the dependent claims (Br. 14–15)

This section argues that the Examiner has not treated the dependent claims. Yet, except to say that “each dependent claim includes elements relevant to the subject matter eligibility of these claims,” nothing more is said about why the limitations in said claims render said claims patent-eligible. From our review of the dependent claims, they appear to describe various information gathering/processing schemes, which do little to patentably transform the abstract idea. For example, claim 5 calls for “receiving a notification” and claim 6 that “the notification comprises data indicating cost or revenue associated with the mirror cost object.” These claims add a step of receiving certain information that do little to transform the information-gathering abstract idea that claim 1 is directed to. *Cf. Apple, Inc. v. Ameranth, Inc.*, 842 F.3d at 1244 (“These claims depend from independent claims which were found to be directed to unpatentable subject matter, as discussed above. Merely appending this preexisting practice to those independent claims does not make them patentable. It is an insignificant post-solution activity.”). Also, where all claims are directed to the same abstract idea, “addressing each claim of the asserted patents [is] unnecessary.” *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014).

II. The claims are not directed to an abstract idea under the Mayo Test (Mayo Step I) (Br. 15–16)

In this section, the Appellants quote the two-step *Alice* framework, reproduce claim 1 — emphasizing actions such as “receiving” and types of information such as “data representing the configured cost object the claim” recited in the claim, and conclude that:

[t]his claim 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 types of claims that the Court has positively identified as being within the implicit exception to subject matter eligibility, specifically: (1) an idea or algorithm of itself or a (2) a fundamental economic practice.

Br. 15–16.

For the reasons already discussed, this section does not present a persuasive argument that claim 1 is not directed to an abstract idea. Claim 1 is directed to an information-processing scheme that is similar to that which the Federal Circuit has already deemed to be an abstract idea.

A. The claims at issue are not directed to an idea or algorithm of itself. (Br. 16)

The Appellants argue that “the claims at issue are directed to something that can be physically perceived or causes a physical change.” Br. 16. In other words, Appellants contend that because something physical is involved, that necessarily obviates the abstract nature of what is claimed. But that is not the law. Whether or not something as claimed is “concrete” and “physical” is not the test for determining whether claimed subject matter is judicially-excepted from patent-eligibility. If that were the case, claims to computers would necessarily be patent eligible. But that is not the case. *See Alice*, 134 S. Ct. at 2358–59 (“The fact that a computer “necessarily exist[s] in the physical, rather than purely conceptual realm” is beside the point. There is no dispute that a computer is a tangible system (in § 101 terms, a “machine”), or that many computer-implemented claims are formally addressed to patent-eligible subject matter. But if that were the end of the § 101 inquiry, an applicant could claim any principle of the physical or

social sciences by reciting a computer system configured to implement the relevant concept.”).

B. The claims at issue are not directed to a fundamental practice long prevalent in our system of commerce (Br. 17–18)

The Appellants argue that, “[i]n particular, the generic cost objects are replaced by mirror cost objects to specially configure the host financial system to the specific needs of the partner system. This is not a fundamental economic practice like risk management or intermediated settlement.”

Br. 17. Whether or not something is a fundamental economic practice is not the test for determining whether something is an abstract idea. Nevertheless, replacing one type of information with another is arguably fundamental in almost every practice, include economic practices.

If the Appellants are arguing that the claim specifically requires “generic cost objects” being replaced by “mirror cost objects,” as we have stated, this is merely replacing one type of information with another, albeit a certain type of information. It should be noted that “mirror cost objects” can be in any form including “free text.” *See* Specification, para. 45.

Accordingly, claim 1 covers replacing text with other text. The fact that said text is accounting-related is not a persuasive reason to determine that the claimed subject matter is patent-eligible. This is so because “collecting information, including when limited to particular content (which does not change its character as information), [is] within the realm of abstract ideas.” *Elec. Power Grp., LLC*, 830 F.3d at 1353. “Limiting the field of use of the abstract idea to a particular existing technological environment does not

render any claims less abstract.” *Affinity Labs of Tex., LLC*, 838 F.3d at 1259 (citing *Alice*, 134 S. Ct. at 2358; *Mayo*, 132 S. Ct. at 1294).

C. When viewed as a whole, the claims at issue do not seek to tie up a judicial exception such that others cannot practice it. (Br. 18–19)

The argument here, as we understand it, is that the claimed subject matter is not a product of nature. That may be so, but the question is whether claim 1 is directed to the abstract idea of information-processing and, if so, whether claim 1 includes an element or combination of elements sufficient to ensure that the claimed subject matter amounts to significantly more than information-processing.

We are satisfied that the record supports the determination that claim 1 is directed to the abstract idea of information-processing, namely gathering, replacing, and outputting information. The Appellants’ arguments challenging that determination are unpersuasive.

We now turn to the Appellants’ arguments challenging the Examiner’s determination under step two of the *Alice* analysis.

V. Assuming, arguendo, that the claims at issue are directed to an abstract idea, the claims at issue are nevertheless directed to patentable subject matter (Mayo Step II) (Br. 19)

We have no issue with what is said here.

A. An analysis of the relevant factors weighs in favor of the subject matter eligibility of the claims at issue (Br. 19–20)

This section does not clearly explain what is wrong with the Examiner’s determination under step two of the *Alice* analysis. The Appellants argue that “there is no evidence that the Examiner actually took into consideration any of the factors specified by the Court in *Alice*.” Br. 20. What those factors are is not explained. Accordingly, the argument is unpersuasive as to error in the determination.

i. The claims at issue recite a specially-configured computer (Br. 20)

The Appellants argue:

the claims at issue in this case not only recite storing the mirror cost object in a storage device but also a hardware processor configured to create the mirror cost object. Further still, the claims provide an accounting system that is specially configured by replacing the generic cost object of the accounting system with the mirror cost object. Given the disclosure in the specification, it is clear that the claims recite a specially-configured computer [unlike the generic one in *Alice*].

Br. 20.

This is an unpersuasive argument. The intrinsic evidence supports the opposite view — that claim 1 covers using generic computer components. *See Spec.*, paras. 51–63, especially para. 53 (“general-purpose processor”).

ii. The steps recited in the claims are specified at a low level of generality. (Br. 21)

The Appellants argue that “[h]ere, the operations recited in the claims at issue are at a lower-level of generality than the operations recited in the claims at issue in *Bilski* and *Alice*.” Br. 21. But a lower level of generality than the operations recited in the claims at issue in *Bilski* and *Alice* does not make claim 1 any less abstract.

iii. The claims at issue solve a technological problem in conventional industry practice. (Br. 21)

The Appellants argue that “independent claim 1 solves a technological problem that was in conventional industry practice.” Br. 22.

Here, as noted in the as-filed application, under conventional industry practice, “when a user wants to incorporate financial information that is specialized to the needs of the user into an accounting system, the user will need to purchase a customized or specialized accounting system . . . [or] customize an existing account system.” As a result, “more than one accounting system may be needed by an entity in order to manage the financials of the entity.”

Br. 21–22 (citing para. 2 of the Specification).

The difficulty here is that the resulting scheme still amounts to gathering, replacing, and outputting information, which is an abstract idea. While this scheme may overcome the need to purchase a customized or specialized accounting system, the scheme does not overcome a technical problem with the computer. Rather it overcomes the hardship that purchasing another customized or specialized accounting system might impose on someone. Overcoming that hardship necessarily means that

“computing resources used by one or more devices within the system [are reduced]” (Spec., para. 16). But reducing resources per se is not a technical solution. Replacing information in a computer rather than using a new computer is not a solution to a technical problem. It is an efficient use of resources. In effect, the claimed subject matter provides only a result-oriented solution involving common computer components. *Cf. Credit Acceptance Corp. v. Westlake Servs., LLC*, 859 F.3d 1044, 1057 (Fed. Cir. 2017) (“Significantly, the claims do not provide details as to any non-conventional software for enhancing the financing process.”); *see Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1342 (Fed. Cir. 2017) (explaining that “[o]ur law demands more” than claim language that “provides only a result-oriented solution, with insufficient detail for how a computer accomplishes it”); *Elec. Power Grp.*, 830 F.3d at 1354 (explaining that claims are directed to an abstract idea where they do not recite “any particular assertedly inventive technology for performing [conventional] functions”).

iv. When considered separately, the functions of each step of the claims at issue are not purely conventional (Br. 22–25)

The Appellants argue that “the functions recited in the claims at issue are not purely conventional functions.” Br. 23.

The evidence more strongly supports the opposite view. As we pointed out, the Specification shows that generic computer components can be used to practice the method as claimed. The claim steps of “maintaining,” “providing,” “receiving,” “creating,” “storing,” “causing,” “accessing,” “replacing,” and “providing output,” are operations a generic

computer commonly performs. *Cf. buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (stating “[t]hat a computer receives and sends the information over a network—with no further specification—is not even arguably inventive”).

v. When considered as an ordered combination, the elements of the claims at issue include something more (Br. 25)

The Appellants appear to argue that claim 1 presents an ordered combination that adds significantly more. We note that much of claim 1 has been reproduced. Br. 25.

But “[t]aking the claim elements separately, the function performed by the computer at each step of the process is ‘[p]urely conventional.’” *Alice*, 134 S. Ct. at 2359 (*citing Mayo*, 132 S. Ct. at 1298). “Considered ‘as an ordered combination,’ the computer components of petitioner’s method ‘ad[d] nothing . . . that is not already present when the steps are considered separately.” *Alice*, 134 S. Ct. at 2359. We reach this view based on reading the claim in light of the Specification’s disclosure – as we have discussed above. Given no other countervailing evidence, the argument that claim 1 presents an ordered combination that adds significantly more is unpersuasive as to error in the determination under step two of the *Alice* analysis.

B. Like the claims in DDR Holdings, the claims at issue are rooted in computer technology in order to overcome a problem specifically arising in a particular computer realm (Br. 25–26)

This section repeats arguments we have already addressed above. The reliance on *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), is inapposite. There the court found that

upon the click of an advertisement for a third-party product displayed on a host's website, the visitor is no longer transported to the third party's website. Instead, the patent claims call for an “outsource provider” having a web server which directs the visitor to an automatically-generated hybrid web page that combines visual “look and feel” elements from the host website and product information from the third-party merchant's website related to the clicked advertisement.

Id. at 1258.

There is nothing similar in claim 1. Claim 1 simply calls for processing certain information. Unlike claim 1, the claims at issue in *DDR* “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.” *Id.*

C. Allowable subject matter (Br. 26–27)

Lastly, the Appellants argue that “*if the known art does not render the ordered combination of elements obvious, then those differences that serve to make the claims non-obvious should also serve to make the claims “something more” than the mere recitation of an alleged abstract idea combined with known technology.*” Br. 27. There is no prior art rejection on appeal.

However, a finding of novelty or nonobviousness does not necessarily lead to the conclusion that subject matter is patentable eligible.

“Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2117 (2013).

Indeed, “[t]he ‘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) (emphasis added); *see also Mayo*, 132 S. Ct. at 1303–04 (rejecting “the Government’s invitation to substitute §§ 102, 103, and 112 inquiries for the better established inquiry under § 101”). Here, the jury’s general finding that Symantec did not prove by clear and convincing evidence that three particular prior art references do not disclose all the limitations of or render obvious the asserted claims does not resolve the question of whether the claims embody an inventive concept at the second step of Mayo/Alice. *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1315 (Fed. Cir. 2016).

Nor does a finding of obviousness necessarily lead to the conclusion that subject matter is patentable ineligible. *See Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1050 (Fed. Cir. 2016) (“That each of the claims’ individual steps (freezing, thawing, and separating) were known independently in the art does not make the claim unpatentable.”). “[P]atent-eligibility does not turn on ease of execution or obviousness of application. Those are questions that are examined under separate provisions of the Patent Act.” *Id.* at 1052 (citing *Mayo*, 566 U.S. at 90).

Notwithstanding that “‘the § 101 patent-eligibility inquiry and, say, the § 102 novelty inquiry might sometimes overlap[,]’ . . . a claim for a *new*

abstract idea is still an abstract idea.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (quoting *Mayo*, 566 U.S. at 90). The question in step two of the *Alice* framework is not whether an additional feature is novel but whether the implementation of the abstract idea involves “more than the performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction and Transmission*, 776 F.3d at 1347–48 (quoting *Alice*, 134 S. Ct. at 2359). In that regard, for the reasons discussed, the Appellants have not shown the novel features transform the abstract idea into patent-eligible subject matter.

We have considered all of the Appellants’ remaining arguments and have found them unpersuasive. Accordingly, because representative claim 1, and claims 2–13 and 15–21, which stand or fall with claim 1, are directed to an abstract idea and do not present an “inventive concept,” we sustain the Examiner’s determination that they are directed to ineligible subject matter under 35 U.S.C. § 101.

DECISION

The decision of the Examiner to reject claims 1–13 and 15–21 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)(iv).

AFFIRMED