



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes sub-tables for EXAMINER, ART UNIT, PAPER NUMBER, NOTIFICATION DATE, DELIVERY MODE.

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ibmptomail@iplawpro.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BINH Q. NGUYEN

Appeal 2016-002533¹
Application 10/119,995²
Technology Center 3600

Before ANTON W. FETTING, NINA L. MEDLOCK, and
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 21–40. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellant’s Appeal Brief (“App. Br.,” filed June 8, 2015) and Reply Brief (“Reply Br.,” filed January 6, 2016), and the Examiner’s Answer (“Ans.,” mailed November 6, 2015) and Final Office Action (“Final Act.,” mailed January 5, 2015).

² Appellant identifies IBM Corporation as the real party in interest. App. Br. 1.

CLAIMED INVENTION

Appellant's claimed invention "relates to the field of e-commerce" and more particularly, "to the correlation of web browsing with purchase behavior so that the effectiveness or ineffectiveness of web content can be more easily evaluated" (Spec. 1, ll. 5–7).

Claims 21, 28, and 35 are the independent claims on appeal.

Claim 21, reproduced below, is illustrative of the claimed subject matter:

21. A computer-implemented method of correlating interaction data with a website by a session participant during an on-line search session with obtaining of an item at an off-line location, comprising:

assigning a session identifier to the session participant engaged in the on-line search session;

associating the session identifier with the collected interaction data;

storing the collection interaction data with the session identifier;

electronically presenting, to the session participant, an incentive to obtain an item from an off-line location;

correlating the obtaining of the item with the interaction data based upon presentation of the session identifier at the off-line location to produce correlation results, wherein the incentive includes the session identifier.

REJECTION

Claims 21–40 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

ANALYSIS

Appellant argues claims 21–40 as a group (App. Br. 5). We select independent claim 21 as representative. The remaining claims stand or fall with claim 21. 37 C.F.R. §41.37(c)(1)(iv).

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (citation omitted).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts.” *Alice Corp.*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Alice Corp.*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78).

The Court acknowledged in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

In rejecting claims 21–40 under 35 U.S.C. § 101, the Examiner finds that the claims are directed to “correlating interaction data with a website by a session participant during an on-line search session with obtaining of an item at an off-line location,” i.e., to a fundamental economic practice, and, therefore, to an abstract idea; and that the claims do not include additional elements or a combination of elements that are sufficient to amount to significantly more than the abstract idea because

the additional element(s) or combination of elements in the claim(s) . . . amount(s) to no more than: (i) mere instructions to implement the idea on a computer, and/or (ii) recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the pertinent industry.

(Final Act. 3).

Appellant argues that the rejection cannot be sustained because the pending claims, like the claims found patent-eligible in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), are “necessarily rooted in computer technology and used to overcome problems specifically arising in the realm of computer networks and e-commerce” (App. Br. 6–7). Yet, we find no parallel between the present claims and those at issue in *DDR Holdings*.

The claims in *DDR Holdings* were directed to retaining website visitors, and in particular to a system that modified the conventional web browsing experience by directing a user of a host website, who clicks an advertisement, to a “store within a store” on the host website, rather than to the advertiser’s third-party website. *DDR Holdings*, 773 F.3d at 1257–1258. The court, thus, determined that the claims were directed to statutory subject

matter because they claim a solution “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks,” and that the claimed invention did not simply use computers to serve a conventional business purpose. *Id.* Rather, there was a change to the routine, conventional functioning of Internet hyperlink protocol. *Id.*

Here, “correlating interaction data with a website by a session participant during an on-line search session with obtaining of an item at an off-line location” is not a challenge particular to computer networks; nor is it necessarily rooted in computer technology. Rather, it is an implementation on generic computer components of an abstract idea itself.

Although Appellant ostensibly suggests otherwise (App. Br. 7), the court did not conclude in *DDR Holdings* that the claims were patent-eligible merely because the claims did not recite the performance of a business practice known from the pre-Internet world along with the requirement to perform it on the Internet. Instead, the Federal Circuit held that the claims were directed to statutory subject matter because they claimed a solution “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks,” i.e., retaining website visitors who, if adhering to the routine, conventional functioning of Internet hyperlink protocol, would be transported instantly away from a host’s website after “clicking” on an advertisement and activating a hyperlink. *DDR Holdings*, 773 F.3d at 1257. We find no comparable aspect in claim 21 that represents more than the conventional use of a computer or the Internet.

We also are not persuaded of Examiner error to the extent that Appellant argues that claim 21 is patent-eligible because the claimed method steps require the use of a computer (Reply Br. 2–5). We find no indication in the Specification, nor does Appellant point to any indication, that any specialized hardware or inventive computer components are required or that the claimed method is implemented using other than a generic computer. And, as the Supreme Court made clear in *Alice*, the recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible. *See Alice Corp.*, 134 S. Ct. at 2358 (holding that if a patent’s recitation of a computer amounts to a mere instruction to implement an abstract idea on a computer, that addition cannot impart patent eligibility).

Appellant further argues that the § 101 rejection cannot be sustained because the Examiner has “produced no evidence or analysis” that the claims are directed to a fundamental economic practice (App. Br. 8). However, we are aware of no controlling authority that requires the Office to identify specific references to support a finding that a claim is directed to an abstract idea. Instead, 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.*; see also *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (“Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

Here, in rejecting the pending claims under § 101, the Examiner analyzed the claims using the *Mayo/Alice* two-step framework, consistent 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 Final Office Action was mailed. The Examiner, thus, notified Appellant of the reasons for the rejection “together with such information . . . as may be useful in judging of the propriety of continuing the prosecution of [the] application.” 35 U.S.C. § 132. And, contrary to Appellant’s assertions (*see, e.g.*, Reply Br. 6), in doing so, the Examiner set forth a proper rejection under § 101 such that the burden shifted to Appellant to demonstrate that the claims are patent-eligible. Appellant’s bare assertion that evidence is needed, without any supporting reasoning as to why, is insufficient to require the Examiner to provide evidentiary support.

Responding to the Examiner’s Answer, Appellant notes that the Examiner has not set forth an art rejection of the claims, and asserts that this implies that the claimed invention, as a whole, is directed to more than generic computer functions (Reply Br. 5). However, a finding of novelty or non-obviousness does not automatically lead to the conclusion that the claimed subject matter is patent-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). 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 [patent-ineligible concept] itself.’” *Alice Corp.*, 134 S. Ct. at 2355 (citation omitted). A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90. *See also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (“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 categories of possibly patentable subject matter.”).

Finally, we are not persuaded of Examiner error to the extent that Appellant argues that the USPTO’s “2014 Interim Guidelines on Patent Subject Matter Eligibility,” 79 Fed. Reg. 74618 (2014) and its “July 2015 Update: Subject Matter Eligibility” require the Examiner to perform particular steps in specific ways to establish that the claims are not patent-eligible (Reply Br. 3–6). As described above, the USPTO carries its procedural burden of establishing a *prima facie* case where, as here, the Examiner sets forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of 35 U.S.C. § 132. Appellant does not contend that the § 101 rejection was not understood or that the Examiner has, otherwise, failed to comply with the notice requirements of § 132.

Appeal 2016-002533
Application 10/119,995

We are not persuaded, for the reasons set forth above, that the Examiner erred in rejecting claim 21 under 35 U.S.C. § 101. Therefore, we sustain the Examiner's rejection of claim 21, and claims 22–40, which fall with claim 21.

DECISION

The Examiner's rejection of claims 21–40 under 35 U.S.C. § 101 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