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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* KIRAN RAMA

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Appeal 2016-002946  
Application 13/305,147  
Technology Center 3600

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Before BIBHU R. MOHANTY, AMEE A. SHAH, and  
ALYSSA A. FINAMORE, *Administrative Patent Judges*

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

The Appellant<sup>2</sup> appeals under 35 U.S.C. § 134(a) from the Examiner’s final decision rejecting claims 1, 3–11, 14–18, and 20, which are all of the pending claims, under 35 U.S.C. § 101 as being directed to non-statutory subject matter.<sup>3</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> Throughout this Opinion, we refer to the Appellant’s Appeal Brief (“Appeal Br.,” filed Aug. 20, 2015), Reply Brief (“Reply Br.,” filed Jan. 20, 2016), and Specification (“Spec.,” filed Nov. 28, 2011), and to the Examiner’s Answer (“Ans.,” mailed Nov. 20, 2015) and Final Office Action (“Final Act.,” mailed Mar. 23, 2015).

<sup>2</sup> According to the Appellant, the real party in interest is Dell Products, LP. Appeal Br. 3.

<sup>3</sup> The rejection of claim 14 under 35 U.S.C. § 112, second paragraph, has been withdrawn. Ans. 5–6.

## STATEMENT OF THE CASE

The Appellant's invention "generally relates to information handling systems, and more particularly relates to attributing sales to marketing communications using an information handling system." Spec. ¶ 1.

Claims 1, 11, and 18 are the independent claims on appeal. Claim 1 (Appeal Br. 8 (Claims App.)) is illustrative of the subject matter on appeal, and is reproduced below:

1. A method comprising:

receiving, for each visit of a plurality of visits to a business web site, an identity of a visitor of a plurality of visitors and an identity of a corresponding marketing vehicle of a plurality of marketing vehicles;

calculating, using a computer:

an individual probability that a first visit by a first visitor is associated with a first marketing vehicle;

a joint probability that a second visit by the first visitor is associated with a second marketing vehicle and the first visit by the first visitor is associated with the first marketing vehicle;

a first conditional probability that the first visitor made a purchase during the second visit associated with the second marketing vehicle given the first visit by the first visitor is associated with the first marketing vehicle; and

a second conditional probability that the first visitor made a purchase during the second visit associated with the second marketing vehicle given the second visit by the first visitor is associated with the second marketing vehicle; and

attributing a respective portion of sales revenue to each marketing vehicle by proportionally allocating revenue of the purchase by the first visitor between the first marketing vehicle and the second marketing vehicle based on the first conditional probability and the second conditional probability.

## ANALYSIS

The Supreme Court in *Alice* reiterated the two-step framework, set forth previously in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 78–79 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). The first step in that analysis is to “determine whether the claims at issue are *directed to* one of those patent-ineligible concepts.” *Id.* (citing *Mayo*, 566 U.S. at 79) (emphasis added). If so, the second step is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether the additional elements “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 78–79).

In other words, the second step is to “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.’” *Id.* (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73). 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).

The Appellant does not provide any arguments against the rejection of independent claims 1, 11, and 18 under 35 U.S.C. § 101. *See* Appeal Br. 5. The Appellant further does not contest the Examiner’s determination that, under the first step of the *Alice* framework, the claims are directed to an abstract idea. *See id.* Rather, the Appellant contends that, under the second step of the *Alice* framework, “updating an emphasis of a marketing campaign at a web site is significantly more than the alleged abstract idea, because the recited analytics are further applied in a statutory process” and represent “innovation and improvement in the field of marketing technology.” *Id.* Specifically, the Appellant argues that the elements of the dependent claims “are not well-understood, routine or conventional at least because they have been found to be novel and non-obvious over the prior art, and amount to significantly more than fundamental economic practice.” *Id.*; *see also id.* at 7.

We do not agree. An abstract idea does not transform into an inventive concept just because the prior art does not disclose or suggest it. *See Mayo*, 566 U.S. at 91. “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Association for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2117 (Fed. Cir. 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); *see also Mayo*, 566 U.S. at 91 (rejecting “the Government’s invitation to substitute §§ 102, 103, and 112 inquiries for the better established inquiry under § 101”). In particular, “the novelty of the

mathematical algorithm is not a determining factor at all. Whether the algorithm was in fact known or unknown at the time of the claimed invention, as one of the ‘basic tools of scientific and technological work’ . . . it is treated as though it were a familiar part of the prior art.” *Parker v. Flook*, 437 U.S. 584, 591–92 (1978) (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)).

We also do not agree with the Appellant’s contention that the Examiner’s rejection is in error because the Examiner rejected the claims “based on ‘rationale similar to independent claims 1, 11, and 18,’” and thus did not provide a prima facie case. Appeal Br. 6 (quoting Final Act. 4–5); *see also id.* at 7; Reply Br. 3–4. There is no indication that the Appellant was not put on notice of the Examiner’s rejection or that the rejection otherwise failed to satisfy the requirements of 35 U.S.C. § 132. We decline to find error in the Examiner’s decision not to recite each dependent claim limitation and address its patent-eligibility separately. The Examiner’s discussion in the Final Office Action appears under the heading “Claims 1, 3–11, 14–18, and 20 are rejected under 35 U.S.C. [§] 101 because the claimed invention is directed to a judicial exception (i.e. an abstract idea) without significantly more.” Final Act. 3 (emphasis omitted). The Examiner finds that the claimed subject matter, generally, is directed to the abstract idea of receiving an identity of a plurality of visitors, calculating probabilities, and attributing revenue, using generic computer technology in a conventional manner. *See* Final Act. 3–4; *see also* Ans. 2–3. The dependent claims elaborate on the abstract idea by further defining the attributing step, the type of vehicle and the web site, and adding determining steps and an updating step. *See* Appeal Br. 9–13 (Claims App.). We note

that there is no requirement that the features of the claims be “similar to other concepts found to be abstract by the courts.” *Id.* at 7.<sup>4</sup> *See Alice*, 134 S. Ct. at 2355–57. Nonetheless, the Examiner provides such analysis (Ans. 3, 5), which the Appellant does not contest (*see* Reply Br. 2).

We also do not agree with the Appellant’s contention that the Examiner’s rejection is in error because the “claims do not preempt the field of data collection and analysis.” Appeal Br. 6; *see also id.* at 7; Reply Br. 3–4. 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*, 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*, 134 S. Ct. at 2354). Although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Id.* The

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<sup>4</sup> We note that the guidelines are not legal requirements, and regardless of how closely the Examiner adheres to such guidelines (or not), we still must heed the precedent set by our controlling courts. *Intellectual Ventures I LLC v. Erie Indem. Co.*, No. 2017-1147, 2017 WL 5041460, at \*4 (Fed. Cir. Nov. 3, 2017); *In re Fisher*, 421 F.3d 1365, 1372 (Fed. Cir. 2005) (“The MPEP and Guidelines ‘are not binding on this court.’”); MPEP, Foreword (“The Manual does not have the force of law or the force of the rules in Title 37 of the Code of Federal Regulations”).

aforementioned concept is not sufficiently limiting so as to fall clearly on the side of patent-eligibility.

Finally, we do not agree with the Appellant's contention that the claims are not directed to an abstract idea because they "are necessarily rooted in computer technology." Reply Br. 2; *see also id.* at 4. We note that the Specification provides that the invention is implemented on a generic system comprising a generic processing units, memory, bus, display, and input, i.e., a generic computer. Spec. ¶¶ 42, 44. There is no further specification of particular technology for performing the steps. *See Versata Dev. Grp., Inc. v. SAP America, Inc.*, 793 F.3d 1306, 1334 (Fed. Cir. 2015); *see also Enfish*, 822 F.3d. at 1336 (focusing on whether the claim is "an improvement to [the] computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity"); *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014). The introduction of a computer to implement an abstract idea is not a patentable application of the abstract idea. *Alice*, 134 S. Ct. at 2357–58. The computer implementation here is purely conventional and performs basic functions. *See id.* at 2359–60. The Appellant does not provide evidence to the contrary.

Thus, we are not persuaded of Examiner error in rejecting the claims under 35 U.S.C. § 101, and we sustain the Examiner's rejection.



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Application 13/305,147

DECISION

The Examiner's rejection of claims 1, 3–11, 14–18, and 20 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