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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* RICHARD D. DETTINGER and RICHARD J. STEVENS

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Appeal 2016-003116  
Application 13/758,492  
Technology Center 3600

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Before ALLEN R. MacDONALD, NABEEL U. KHAN, and  
SHARON FENICK, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This is a decision on Appellants' Request for Rehearing.<sup>1</sup> Appellants have filed a paper under 37 C.F.R. § 41.52(a)(1) requesting that we reconsider our Decision of July 27, 2017, wherein we affirmed the Examiner's rejection of claims 1–12. We have reconsidered our Decision in

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<sup>1</sup> “The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised, and Evidence not previously relied upon, pursuant to §§41.37, 41.41, or 41.47 are not permitted in the request for rehearing except as permitted by paragraphs (a)(2)through (a)(4) of this section.” 37 C.F.R. § 41.52(a)(1).

light of Appellants' comments in the request, and have found no errors. We, therefore, decline to change the Decision.

Appellants' request is denied.

## DISCUSSION

### *Alice Step 1*

Appellants contend the Board has misapprehended the Court's *Alice* analysis step 1 requirement to consider *the elements* of the claim as a whole because:

In support of the affirmance of the rejection under 35 U.S.C. § 101, the Board, without citing any supporting authority, erroneously concludes that the "Alice step 1" analysis does not require a claim to "be considered as a whole."

Req. Reh'g 2. Appellants assert authority cited "belies" the board's conclusion:

In footnote 3, *cited by the Board*, the *Alice* Court stated:

Because the approach we made explicit in *Mayo* considers *all claim elements*, both individually and in combination, it is consistent with the general rule that patent claims "must be considered as a whole." *Diamond v. Diehr*, 450 U.S. 175, 188, 101 S.Ct. 1048, 67 L.Ed.2d 155 (1981); see *Parker v. Flook*, 437 U.S. 584, 594, 98 S.Ct. 2522, 57 L.Ed.2d 451 (1978) ("Our approach ... is ... not at all inconsistent with the view that a patent claim must be considered as a whole").

Req. Reh'g 2. (emphasis added). Appellants assert the *Alice* Court's footnote 3 (directed to step 2 of *Alice*) is somehow modified by earlier decisions of the Court (e.g., *Diamond v. Diehr*) so that step 1 of the *Alice* analysis must consider the *claim elements* as a whole. We find no such narrow holding in *Alice*. Contrary to Appellants' argument, the Examiner

properly considered the *claim elements* of Claim 1 as a whole under the two-step *Alice* analysis when the Examiner considered all *claim elements*, both individually and in combination, under step 2 of the analysis.

Appellants' Appeal Brief and Reply Brief do not contend that the Examiner failed to consider all *claim elements* of Claim 1 as a whole under step 2 of the *Alice* analysis.

Appellants then contend the Board has overlooked the requirement under *Alice* step 1 to analyze the claim's *character* as a whole.

[T]he Board also ignored relevant Federal Circuit law. In *Enfish, LLC v. Microsoft Corp.*, 822 F. 3d 1327 (2016), the Federal Circuit expressly analyzed the claims “as a whole” in the context of step 1. Specifically, the *Enfish* court noted that step 1 “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.’” *Id.* at 1335 (emphasis added).

Req. Reh'g 3.

First, Appellants are conflating (a) the *Alice* step 2 requirement that *all claim elements*, both individually and in combination, must be considered as a whole with (b) the step 1 requirement (explicit in *Enfish* and implicit in *Alice*) to determine whether the claim's *character* as a whole, considered in light of the specification, is directed to excluded subject matter. These “as a whole” requirements are not interchangeable. Even when a claim's *character* as a whole is directed to an abstract idea, this is not conclusive as to whether *all claim elements* considered as a whole are directed to eligible subject matter. The step 2 analysis must still be performed. Yet it is not an error to defer consideration of the character of the claim until step 2 of the *Alice* analysis.

This case, unlike *Enfish*, presents a “close call[ ] about how to characterize what the claims are directed to.” See [*Enfish LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016)]. The *Enfish* claims, understood in light of their specific limitations, were unambiguously directed to an improvement in computer capabilities. See *id.* at 1335–37[ ]. Here, in contrast, the claims and their specific limitations do not readily lend themselves to a step-one finding that they are directed to a nonabstract idea. We therefore defer our consideration of the specific claim limitations’ narrowing effect for step two.

*Bascom Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349 (Fed. Cir. 2016).

Second, to the extent Appellants previously argued the claim’s character as a whole (considered in light of the Specification) is not directed to an abstract idea, we remain unpersuaded. Contrary to Appellants’ argument, Appellants’ Specification repeatedly states within its Background section the concerns of *fee-based* access and the *value* of information. Appellants’ Summary section then states

Systems, methods and articles of manufacture for accessing data for a *fee* are provided. ***Fee schedules are defined*** for any arbitrary granularity of data, including for fields and data structures (e.g., tables in a database). ***Fees may be calculated*** based on the type of operation to be performed. ***Fees may also be calculated*** per operation and/or per data item involved in the operation.

Spec. ¶ 7 (emphasis added). We conclude there is more than sufficient basis to conclude under step 1 of the Alice analysis that claim 1 is directed to an abstract idea of *fee-based* access to information and the calculation of a *value* of information.

*Alice Step 2*

Appellants also contend the Board has overlooked that claim 1 satisfies the requirement under *Alice* step 2 to claim significantly more than the abstract idea.

[E]ven if claims 1 and 6 were considered to embody an abstract idea, the claims satisfy Part 2 of the *Alice* test, by claiming a combination of components that amounts to significantly more than a patent upon an abstract idea. . . . The claimed processes solve the technological problem of processing modification statements in an abstract database.

Req. Reh’g 9. In our Decision, we referenced our decision for related Appeal 2016-003115 where we concluded

Appellants list elements of claim 1 without any persuasive explanation of how the elements either individually, or as an ordered combination, amount to an inventive concept that converts an abstract idea into patent-eligible subject matter. Appellants assert that like *DDR*, the claim solution is rooted in computer technology and solves a technical problem of composing and executing abstract queries, ***but do not explain why***. App Br. 22. Without more we are not persuaded the Examiner’s reasoning is mistaken.

*Ex parte Dettinger*, Appeal 2016-003115, slip op. at 11 (PTAB July 27, 2017) (emphasis added). Essentially, Appellants repeat (Req. Reh’g 9–10) their earlier cut-and-paste contention format of listing claim elements and case law, and then without sufficient explanation asserting the claim amounts to significantly more than merely the abstract idea itself. Again, we find this form of conclusory argument to be unpersuasive.

Our review of the Request does find one attempt to add explanation as to why claim 1 amounts to significantly more than a patent upon an abstract idea. Appellants now, for the first time, state that the claimed invention avoids requiring “***users to be aware*** of the underlying physical

representation of data.” Req. Reh’g 9 (emphasis added). However, do not find where Appellants made this point in the Appeal Briefs. We could not have overlooked or misapprehended an argument that was not made in the Principal Brief or Reply Brief. Appellants have not indicated where in the appeal brief(s) this misapprehended or overlooked argument was initially raised. Rather, Appellants’ Request for Rehearing newly argues the merits of the Examiner’s analysis not previously addressed in the Appeal Brief or the Reply Brief. *See Cooper v. Goldfarb*, 154 F.3d 1321, 1331 (Fed. Cir. 1998) (“A party cannot wait until after the Board has rendered an adverse decision and then present new arguments in a request for reconsideration.”); 37 C.F.R. § 41.52(a)(1) (2011). Appellants’ argument is untimely under our rules of procedure.

#### *Other Arguments*

Appellants now, for the first time, present an argument that

These claims do not preempt any alternative approaches for processing modification operations in an abstract database insofar as such approaches are disclosed by the references of record.

Req. Reh’g 7. As noted above, we could not have overlooked or misapprehended an argument that was not made in the Principal Brief or Reply Brief.

#### DECISION

Based on the record before us now and in the original appeal, we have granted Appellants’ request to the extent that we have reconsidered our Decision, but we deny Appellants’ request to make any changes in our

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Decision. It is our view that Appellants have not identified any points the Board has misapprehended or overlooked.

The request for rehearing is denied.

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)(v).

REQUEST FOR REHEARING DENIED