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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DUANE FREDRICK BUSS

Appeal 2016-004103
Application 12/257,797
Technology Center 3600

Before ALLEN R. MacDONALD, IRVIN E. BRANCH, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1, 4–10, 12–15, 18–20, and 22–26. App. Br. 5–6.² We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellant identifies Novell, Inc. as the real party in interest. App. Br. 1.

² This Decision refers to the Final Office Action mailed February 9, 2015 (“Final Act.”); Appellant’s Appeal Brief filed July 15, 2015 (“App. Br.”); the Examiner’s Answer mailed December 16, 2015 (“Ans.”); and Appellant’s Specification filed October 24, 2008 (“Spec.”).

STATEMENT OF THE CASE

The Claimed Invention

Appellant's application relates to a "[s]ystem and method for monitoring reputation changes." Abstract. In general, the described embodiments provide a "user policy controlled application or service capable of maintaining baseline reputation information in connection with a reputation of interest; actively and/or passively gathering incremental reputation updates; applying evaluation functions to the baseline reputation information and the reputation updates; and providing notifications based on results of the applied evaluation functions." Spec. ¶ 8.

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

1. A method comprising:

receiving, at a computer, an interest list from a primary entity, the interest list identifying a reputation of interest, evaluation rules, and notification rules established for the reputation of interest, the reputation of interest being associated with a secondary entity, wherein the interest list includes a reputation identifier and one or more baseline indicators, the reputation identifier and the one or more baseline indicators being associated with the reputation of interest;

receiving, at the computer, updated reputation information regarding the reputation of interest from a reputation information provider;

evaluating, by the computer, the received updated reputation information in accordance with the evaluation rules established for the reputation of interest, the evaluating including comparing the updated reputation information regarding the reputation of interest with the one or more baseline indicators thereby detecting a change in the reputation of interest;

in response to the detected change, generating, by the computer, a message in accordance with the notification rules established for the reputation of interest, the message including the detected change and remediation options, the remediation options defining potential actions taken by the primary entity with respect to the secondary entity; and

transmitting the generated message including the detected change and the remediation options to the primary entity.

References and Rejections

The Examiner relies on the following references as evidence of unpatentability:

Harms et al. ("Harms")	US 2003/0078981 A1	Apr. 24, 2003
Oliver et al. ("Oliver")	US 2005/0052998 A1	Mar. 10, 2005
Bandhole et al. ("Bandhole")	US 2007/0208688 A1	Sept. 6, 2007
Lester et al. ("Lester")	US 2009/0265198 A1	Oct. 22, 2009

Claims 1, 4–10, 12–15, 18–20, and 22–26 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Final Act. 2–3.^{3,4}

³ The Examiner additionally includes claim 17 as being subject to rejection under 35 U.S.C. §§ 101 and 103(a) (Final Act. 2–3, 6, 21), but Appellant indicates that claim 17 has been cancelled (App. Brief. 23 (Claims App'x)). We omit that claim here for clarity.

⁴ We note that claims 4 and 12 purport to depend from cancelled claims 3 and 11, respectively (App. Br. 20, 22 (Claims App'x)), and, therefore, fail to comply with the requirement of 35 U.S.C. § 112, fourth paragraph, that "a claim in dependent form shall contain a reference *to a claim previously set forth*" (emphasis added). For purposes of this Decision, we have assumed

Claims 9, 10, 12–15, 18–20, 23, and 25 stand rejected under 35 U.S.C. § 112(b) or pre-AIA 35 U.S.C. § 112, second paragraph, as being indefinite. *Id.* at 4–6.

Claims 1, 4–10, 12–15, 18–20, 24, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oliver and Lester. *Id.* at 6–11.

Claims 9, 10, 12, 13, 23, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oliver, Lester, and Harms. *Id.* at 11–17.

Claims 14, 15, 18–20, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oliver, Lester, and Bandhole. *Id.* at 17–22.⁵

ANALYSIS

Rejection under 35 U.S.C. § 101

In determining whether the claims set forth patent-eligible subject matter under 35 U.S.C. § 101, we first must determine whether the claims at issue are directed to laws of nature, natural phenomena, or abstract ideas. *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714 (Fed. Cir. 2014). Section 101 provides that a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and

that claims 4 and 12 should instead depend from claims 1 and 9, respectively, from which cancelled claims 3 and 11 previously depended. Because we affirm the rejection of all pending claims on other grounds, we do not enter a new ground of rejection with respect to this defect.

⁵ Although omitted from the heading of the rejection over Oliver, Lester, and Bandhole (Final Act. 17), claim 20 is addressed in the discussion of that rejection in the Final Office Action (*id.* at 22). We determine that the omission was harmless and include claim 20 here for completeness.

useful improvement thereof.” 35 U.S.C. § 101. The Supreme Court has long held, however, that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)); see also *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (“Phenomena of nature, . . . mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.”).

In *Alice*, the Supreme Court reiterated a two-step framework, previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 75–77 (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*, 134 S. Ct. at 2355. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* (citing *Mayo*, 132 S. Ct. at 1296–97). If so, the second step requires consideration of 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).

Applying the analytical framework set forth by the Supreme Court in *Alice*, the Examiner finds that claims 1, 4–10, 12–15, 18–20, and 22–26 are

“directed to the abstract idea of a fundamental economic practice and/or organizing human activities”; that “[t]he additional element(s) or combination of elements in the claim(s) other than the abstract idea per se amount[] 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”; and that “[v]iewed as a whole, these additional claim element(s) do not provide meaningful limitation(s) to transform the abstract idea into a patent eligible application of the abstract idea such that the claims[] amount[] to significantly more than the abstract idea itself.” Final Act. 2–3.

In the Appeal Brief, Appellant contends that, whereas the Examiner has the burden in the first part of the *Alice* analysis to prove that the claims are directed to a “judicial exception,” the Examiner “provides no evidence or reasons and simply makes the conclusory statement that claims 1, 9 and 14 are ‘directed to the abstract idea of a fundamental economic practice and/or organizing human activities.’” App. Br. 6–7 (citing 2014 Interim Guidance on Patent Subject Matter Eligibility, 79 Fed. Reg. 74618, 74622 (Dec. 16, 2014); MPEP § 2106(III); Final Act. 2). According to Appellant, “[t]his conclusory statement is insufficient to present a *prima facie* case of unpatentability.” *Id.* at 7. Appellant further contends that the independent claims on appeal satisfy Section 101. *Id.* For example, according to Appellant, independent claim 1 “recites a particular structure (‘an interest list’) that is ‘received, at a computer,’” where the interest list “has particular characteristics that are recited in the claim elements,” and “[f]urther, particular computer processing is described corresponding to the interest

list.” *Id.* Appellant contends claim 1 “recites claim elements that are narrowly focused such that they do not ‘tie up . . . excepted subject matter,[’]” and “by providing detailed recitations of features of the interest list and computer processing that is performed corresponding to the interest list, the claims are not directed to an abstract idea, but rather to a statutory process.” *Id.* at 8. Further, according to Appellant, “[c]laims 9 and 14 recite similar elements (corresponding to a ‘computer program product’ and ‘system,’ respectively) and are likewise not directed to an abstract idea.” *Id.*

Appellant contends that the Examiner has failed to present a *prima facie* case with respect to the second part of the *Alice* analysis as well, and that, “[c]ontrary to the Examiner’s unsupported assertion, the claims recite numerous elements that provide meaningful limitation to the claims.” *Id.* at 8–9. Citing independent claim 14, for example, Appellant contends, “the claim elements define a particular novel structure that is received by a computer” and “identify particular processing mechanisms performed on the particular structure.” *Id.* at 9–10. According to Appellant, “[t]he computer functions and structures recited in the claims are particular, not generic,” and “the Examiner has combined no fewer than three references to (defectively) argue that the above elements are obvious, which is illustrative that the above structures and functions [referring to elements of claim 14] are not well-understood, routine and/or conventional activities.” *Id.* at 10. Lastly, Appellant contends that the Examiner has provided no analysis with respect to the additional claim elements recited in the dependent claims and also “therefore has not met the burden to ‘present[] a *prima facie* case of unpatentability’ with respect to these claims,” which Appellant contends

“are also directed to statutory subject matter merely by virtue of their dependency from independent claims 1, 9 and 14.” *Id.* at 11.

In Response to Appellant’s contentions, the Examiner repeats that all of the claims are directed to the abstract idea of a fundamental economic practice and/or organizing human activities such as:

receiving the interest list . . . ; receiving updated reputation . . . ;
evaluating the received updated reputation information . . .
including comparing updated reputation information . . . ;
generating a message in accordance with the notification
rules . . . ; transmitting the generated message (claim 1);
receive an interest list . . . ; detect a transaction . . . ; add a
reputation . . . ; receiving updated reputation evaluate the
updated reputation information . . . ; compare the updated
reputation . . . ; generating notification . . . ; transmitting the
generated message (claim 9); receive an interest list . . . ;
discover an ontologically similar reputation . . . ; receive the
reputation information . . . ; evaluate the received reputation
information . . . ; comparing the reputation information . . . ;
generate a notification (claim 14).

Ans. 23–24 (alterations in original). The Examiner finds, “the abstract idea[s] of reputation and remediation as recited are directly related to economics, e.g. sales may be lost or gained based on reputation,” and “[t]his represents a risk, which relates to the risk that has been held to be abstract in Alice.” *Id.* at 24. Further, the Examiner finds, “the claimed limitations are also directed to abstract idea of human organizing activities as they are related to managing relationship between people that has been held to be abstract in [*buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350 (Fed. Cir. 2014)].” *Id.*

Regarding Appellant’s argument that claim 1 recites a “particular structure” that is “received, at a computer” and has “particular characteristics” (App. Br. 7), the Examiner responds that these are merely

details of the abstract idea and points out that “any novelty in implementation of the idea is a factor to be considered only in the second step of the Alice analysis.” Ans. 24–25 (quoting *Ultramercial*, 772 F.3d at 715). Regarding Appellant’s argument that the recited claim elements do not “tie up . . . ex[cep]ted subject matter” (App. Br. 8), the Examiner responds that “[questions of] preemption are inherent in the part-two framework from *Alice Corp[.]* and *Mayo* . . . and are resolved by using this framework to distinguish between preemptive claims[] and those that integrate the building blocks into something more.” Ans. 25 (quoting July 2015 Update: Subject Matter Eligibility 8 (2015), <https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf> (“July 2015 Update”)).

With respect to Appellant’s arguments regarding the second step of the *Alice* analysis, the Examiner reiterates that the additional elements or combination of elements in the claims, other than the abstract idea *per se*, amount to no more than mere instructions to implement the idea on a computer or recitation of generic computer structure that serves to perform generic computer functions and do not provide meaningful limitations to transform the abstract idea into a patent-eligible application of the abstract idea. *Id.* at 26–27. Regarding the recited “reputation computation engine” in claim 14, for example, the Examiner finds “[t]he claim does not describe any unconventional [features] . . . other than the abstract idea.” *Id.* at 27. Pointing to the description of that claim element in the Application, the Examiner finds “the reputation computation engine as recited is merely a generic computer which does not add a meaningful limitation to the abstract idea because they would be routine in any computer implementation.” *Id.*

(citing Spec. ¶ 18, Fig. 1). Similarly with respect to other claim elements Appellant alleges to define a particular novel structure, the Examiner finds such elements “effectively . . . are the details of the abstract idea.” *Id.*

We have considered Appellant’s arguments, but do not find them persuasive of error. In considering whether a claim is directed to an abstract idea, we acknowledge, as did the Court 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.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016). In other words, if the claims are directed to an abstract idea, we then must consider whether the claim contains an element or a combination of elements that is sufficient to transform the nature of the claim into a patent-eligible application. *Alice*, 134 S. Ct. at 2347; *Ultramercial*, 772 F.3d at 714.

In applying step two of the *Alice* analysis, we must “determine whether the claims do significantly more than simply describe [the] abstract method” and thus transform the abstract idea into patentable subject matter We look to see whether there are any “additional features” in the claims that constitute an “inventive concept,” thereby rendering the claims eligible for patenting even if they are directed to an abstract idea. . . . Those “additional features” must be more than “well-understood, routine, conventional activity.” *Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1328 (Fed. Cir. 2017) (citations omitted).

In view of these principles, we agree with the Examiner that claims 1, 4–10, 12–15, 18–20, and 22–26 are directed to patent-ineligible subject matter. First, we agree with the Examiner that the claims are directed to an abstract idea, and more specifically, a fundamental economic practice or a method of organizing human activity. “The term ‘fundamental’ [in the phrase ‘fundamental economic practices’] is used in the sense of being foundational or basic, and not in the sense of necessarily being ‘old’ or well-known.” July 2015 Update, at 4. We agree with the Examiner that the claims are essentially directed to the abstract ideas of managing relationships between transacting parties and mitigating risks in a transactional context (*see* Ans. 24), particularly monitoring the reputations of secondary entities in which a primary entity has an interest, and providing notifications of changes in such reputations or remediation options, such as by notifying a consumer whose personal information is retained and stored by a company of changes in the company’s ownership or control, hacking activity, or other scenarios in which the customer’s information could be jeopardized, so that the consumer may be kept aware of potential risks (*see, e.g.*, Spec. ¶¶ 2–3). Neither the identification in the claims of an “interest list,” nor the specification and use of “evaluation rules,” “notification rules,” and “baseline indicators,” nor the recitation of a “reputation information provider” as the source of updated reputation information alters the basic and fundamental nature of the process. Nor does the fact that independent claim 14 and its dependent claims implement this process using a computer “including reputation computation engine” and “including at least one notification mechanism operable to generate a notification,” as well as “a device of a primary entity operable to receive the notification . . . [and] to

allow the primary entity to take action based on [a] received detected change and . . . remediation options,” alter the basic and fundamental nature of the process.

Indeed, the claims on appeal are analogous to those found to be patent-ineligible in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016). In that case, the Federal Circuit explained,

The claims in this case fall into a familiar class of claims “directed to” a patent-ineligible concept. The focus of the asserted claims . . . is on collecting information, analyzing it, and displaying certain results of the collection and analysis. . . .

Information as such is an intangible. Accordingly, we have treated collecting information, including when limited to particular content . . . as within the realm of abstract ideas. In a similar vein, we have treated 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. And we have recognized that merely presenting the results of abstract processes of collecting and analyzing information, without more (such as identifying a particular tool for presentation), is abstract as an ancillary part of such collection and analysis.

Id. at 1353–54 (citations omitted). As in *Electric Power Group*, the claims in this case

are clearly focused on the combination of those abstract-idea processes. The advance they purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions. They are therefore directed to an abstract idea.

Id. at 1354.

Further, we agree with the Examiner that the additional elements or combination of elements in the claims other than the abstract idea *per se*

amounts 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. “Viewed as a whole, these additional claim element(s) do not provide meaningful limitation(s) to transform the abstract idea into a patent eligible application of the abstract idea.” *Id.* In contrast with precedential cases in which the Federal Circuit has found claims directed to computer-implemented methods to be patent-eligible under the *Alice* framework, the instant claims do not provide, for example, (1) a “solution . . . necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks” (*see DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014)); (2) “a specific improvement to the way computers operate” (*Enfish*, 822 F.3d at 1336; *see also McRO*, 837 F.3d at 1303; *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1259 (Fed. Cir. 2017)); or (3) an “unconventional technological solution . . . to a technological problem” that “improve[s] the performance of the system itself” (*Amdocs (Israel) Ltd. v. Openet Telecom, Inc.* 841 F.3d 1288, 1302, 1306 (Fed. Cir. 2016); *see also Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1352 (Fed. Cir. 2016); *Thales Visionix Inc. v. United States*, 850 F.3d 1343, 1347, 1349 (Fed. Cir. 2017).

As the Federal Circuit explained in *buySAFE*, “[t]he claims’ invocation of computers adds no inventive concept.” 765 F.3d at 1355; *see also Alice*, 134 S. Ct. at 2357 (“[C]laims [that] merely require generic computer implementation[] fail to transform [an] abstract idea into a

patent-eligible invention.”). Here, the generic recitation in claim 1 (and similarly in claim 9) of the steps of “receiving . . . an interest list from a primary entity, the interest list identifying a reputation of interest, evaluation rules, and notification rules . . .”; “receiving . . . updated reputation information regarding the reputation of interest from a reputation information provider”; “evaluating . . . the received updated reputation information in accordance with the evaluation rules . . . , the evaluating including comparing the updated reputation information . . . with . . . one or more baseline indicators thereby detecting a change . . .”; “generating . . . a message in accordance with the notification rules . . .”; and “transmitting the generated message . . . to the primary entity” does not provide any greater specificity than the steps recited in the claims at issue in *buySAFE*. Nor do we find that the recitation of a “reputation computation engine,” a “notification mechanism operable to generate a notification,” or “a device . . . operable to receive the notification” provides any meaningfully greater specificity than the “safe transaction service provider computer” recited in *buySAFE*. See 765 F.3d at 1352. Appellant provides no evidence in support of their assertions that “the claim elements define a particular novel structure,” that “particular processing mechanisms [are] performed on . . . particular structure,” and that “[t]he computer functions and structures recited in the claims are particular, not generic” such that a person of ordinary skill in the art would understand those processes or structures to have any specific meaning other than those carried out by or included in a general purpose computer with routine programming. App. Br. 9–10; see *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997) (attorney argument cannot take the place of evidence).

As in *Electric Power Group*, we find “[n]othing in the claims, understood in light of the specification, requires anything other than off-the-shelf, conventional computer, network, and display technology” 830 F.3d at 1355. As the court explained in that case, “[w]e have repeatedly held that such invocations of computers and networks that are not even arguably inventive are ‘insufficient to pass the test of an inventive concept in the application’ of an abstract idea.” *Id.* (quoting *buySAFE*, 765 F.3d at 1353, 1355; citing *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324–25 (Fed. Cir. 2016); *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1348–49 (Fed. Cir. 2015); *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347–48 (Fed. Cir. 2014)).

We also are not persuaded by Appellant’s argument that the recited claim elements “do not ‘tie up . . . excepted subject matter.[.]’” App. Br. 8 (citation omitted). As the Federal Circuit explained in *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307 (Fed. Cir. 2016), “[a] narrow claim directed to an abstract idea . . . is not necessarily patent-eligible, for “[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Id.* at 1321 (quoting *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); see also *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”)).

Lastly, regarding Appellant's contention that the Examiner's combination of "no fewer than three references" in the rejection of certain claims under 35 U.S.C. § 103(a) "is illustrative that the above structures and functions are not well understood, routine and/or conventional" (App. Br. 10), we note that Appellant has not provided any authority for the contention that the number of prior art references used in a rejection under 35 U.S.C. § 103(a) is probative with respect to the analysis under Section 101, and we agree with the Examiner that the fact that the abstract idea to which the invention is directed may be narrow does not change the fact that the invention is still directed toward an abstract idea (Ans. 28 (citing *buySAFE*; July 2015 Update)).

For the foregoing reasons, we discern no error in the Examiner's rejection of claims 1, 4–10, 12–15, 18–20, and 22–26 under 35 U.S.C. § 101, and we sustain the rejection.

Rejection under 35 U.S.C. § 112

Independent claim 9 recites instructions stored on a computer-readable medium for causing a computer to, *inter alia*, "detect a transaction between [a] primary entity and a detected entity; [and] add a reputation associated with the detected entity to [an] interest list." Dependent claims 23 and 25 recite similar limitations. Independent claim 14 recites, *inter alia*, a "reputation computation engine operable to receive from a primary entity an interest list identifying a reputation of interest . . . , wherein the interest list includes a reputation identifier and one or more baseline indicators . . . associated with the reputation of interest," and "wherein the reputation computation engine is adapted to discover an

ontologically similar reputation related to the reputation of interest and add the ontologically similar reputation to the interest list.”

The Examiner determined that the quoted limitations are vague as they are “inconsistent meaning [sic] with the specification.” Final Act. 4–5. In particular, with regard to claim 9, the Examiner points to disclosure in the Specification that “a user interface of the primary entity 102 may detect a transaction between the primary entity and a secondary entity and prompt the primary entity to add a reputation identifier for the secondary entity . . . to the interest list,” and concludes, “[t]hus, Applicant’s specification appear[s] to show ‘add the reputation identifier’, but not the ‘add a reputation’ associated with the detected entity.” *Id.* at 4 (quoting paragraph 24 of Appellant’s published application, corresponding to Spec. ¶ 20). With regard to claim 14, the Examiner quotes paragraphs 11 and 27 of Appellant’s published application (corresponding to paragraphs 11 and 23, respectively, of the Specification), which disclose that “[t]he reputation identifier may refer to a single reputation or set of reputations, a particular reputation engine evaluation output, given a specific set of inputs (‘baseline indicators’), a set of ontologically similar reputations, or rules for finding ontologically similar reputations” and “[s]imilarly, there may also exist ontologically similar reputations of interest for an entity that a user might want to monitor via the interest list and reputation computation engine,” which “may be accomplished by specifying certain types or elements of ontologically similar reputations the user would like to monitor” *Id.* at 5. The Examiner finds paragraph 11 “appears to indicate the reputation identifier may refer to e.g. a set of ontologically similar to reputations” and paragraph 27 “appears to show the user specifies

the type or element ontological similar reputation that the user would like to monitor,” but that “[t]here is no indication of the reputation computation engine is adapted to discover an ontologically similar to reputation of interest and the reputation engine also add the ontological similar reputation to the interest list.” *Id.* at 5–6.

In the Appeal Brief, Appellant responds that “[t]he test for definiteness under the second paragraph of 35 U.S.C. § 112 is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’” App. Br. 11 (quoting MPEP § 2173.02). With respect to claim 9, Appellant points out that the Specification discloses at paragraph 24 the “addition of reputations of interest to the interest list” and at paragraph 26 “discovering reputations with a specified degree of separation from a reputation identified in the interest list and adding those reputations to the interest list,” and contends that one of ordinary skill in the art “would understand from these teachings that a reputation would be added to an interest list, for example when reputations are discovered that are within a specified degree of separation from a reputation identified in an interest list.” *Id.* at 12. With respect to claim 14, Appellant contends that the Specification “discloses at least in par. 0018 a ‘reputation computation engine 108 to perform the functions’ that include ‘rules for finding ontologically similar reputations’ (par. 0011) and ‘discovering reputations with a specified degree of separation from a reputation identified in the interest list and adding those reputations to the interest list’ (par. 16).” *Id.* at 13. Thus, according to Appellant, “[t]he specification clearly describes and supports the claim elements such that one of ordinary skill in the art would understand what is claimed in light of the specification.” *Id.*

In the Answer, the Examiner responds to Appellant's arguments regarding claim 9 by stating that paragraph 24 of Appellant's published application "does not show the 'adding reputation in the interest list', but only show 'adding reputation identifier in the interest list,'" which, the Examiner finds, is consistent with disclosure in paragraphs 9 and 10 of the published application. Ans. 29. The Examiner concludes, "[i]n . . . other words, the reputation of interest list includes 'reputation of interest, reputation identifier, and base line indicator', but not the reputation." *Id.* Regarding claim 24, the Examiner responds that "par. 0011 (or par. 0018, Application publication) discloses the 'reputation computation engine 108 to perform the functions', but does not specifically describe that 'functions' also encompasses the 'discovering/finding ontologically similar reputation,'" and otherwise repeats the findings from the Final Office Action. Ans. 30–31.

We are persuaded by Appellant's arguments. In this regard, we note that Appellant relies on the disclosure of paragraphs 24 and 26 of the *Specification* in support of claim 9, whereas the Examiner's findings relate to paragraph 24 of the *published application* (which corresponds to paragraph 20 of the *Specification*). *Compare* App. Br. 12, with Ans. 29. Although paragraph 24 of the published application does not appear to disclose adding a "reputation," paragraph 24 of the *Specification* does include such disclosure. With respect to claim 14, we are persuaded that a person of ordinary skill in the art would understand "the functions described herein," as that phrase is used in paragraph 18 of the *Specification* ("In one embodiment, the reputation computation engine 108 comprises a computer that includes a computer-readable medium (such as, for example, a hard disk

drive or a CD-ROM) having stored thereon computer-executable instructions for causing the reputation computation engine 108 to perform the functions described herein.”), to include “finding ontologically similar reputations,” as recited in paragraph 11 of the Specification. As quoted above, claim 14 recites that the reputation computation engine is “operable to receive . . . an interest list . . . , wherein the interest list includes a reputation identifier,” and paragraph 11 of the Specification specifically discloses that “[t]he reputation identifier may refer to . . . rules for finding ontologically similar reputations.” Accordingly, we agree with Appellant that the Examiner’s rejection of claim 14 as indefinite also was in error.

For the foregoing reasons, we reverse the Examiner’s rejection of claims 9, 14, 23, and 25, as well as claims 10 and 13, dependent from claim 9, claim 12, which we assume for purposes of this Decision to depend from claim 9,⁶ and claims 15 and 18–20, dependent from claim 14, under 35 U.S.C. § 112(b) or pre-AIA 35 U.S.C. § 112, second paragraph.

Rejections under 35 U.S.C. § 103(a)

The Examiner finds Oliver discloses all elements of claim 1, with the exception of any explicit disclosure of “receiving at a computer an interest list from a primary entity, the interest list identifying a reputation of interest, evaluation rules, and notification rules . . . wherein the interest list includes a reputation identifier and one or more baseline indicators.” Final Act. 6–8. The Examiner finds that that step would nonetheless have been obvious over the teachings of Oliver and Lester. *Id.* at 8–10. The Examiner finds Oliver

⁶ See *supra* note 4.

discloses, among other things, collecting reputation data for a particular target computer entity/node from a plurality of computer entities, evaluating the collected reputation data by comparing the collected data with a predefined value threshold (which the Examiner maps to the recited “baseline indicator(s)”), and generating a message in response to detecting a change, in order to determine an action to be taken with respect to the target computer entity, as well as the reputation of interest being associated with a secondary entity, evaluation rules, and notification rules. *Id.* at 8–9. The Examiner finds, further, that Lester explicitly discloses that a user/entity can request to receive the reputation information for a particular entity that the user is interested in, and concludes that it would have been obvious to one of ordinary skill in the art to include in combination with the teachings of Oliver the ability to receive the request for the reputation of interest associated with an entity, as taught by Lester. *Id.* at 9–10. The Examiner makes similar findings with respect to independent claims 9 and 14, additionally relying on Harms and Bandhole, respectively, for certain other elements of those claims.⁷

⁷ Although the Examiner included claims 9, 10, 12–15, and 18–20 in the heading of the rejection over Oliver and Lester (Final Act. 6), we note that those claims are not addressed in the discussion of that rejection. Indeed, the Examiner finds that the combination of Oliver and Lester alone does not explicitly disclose “detect[ing] a transaction between the primary entity and a detected entity [and] add[ing] a reputation [identifier] associated with the detected entity to the interest list,” as recited in claim 9, or “specifying/adding the type or elements of ontologically similar reputation that the primary entity would like to monitor for the secondary entity,” as recited in claim 14 (*id.* at 15, 20); and claims 9, 10, 12–15, and 18–20 are instead addressed only in the discussion of the rejections over Oliver, Lester,

In the Appeal Brief, Appellant contends that the prior art combinations cited by the Examiner fail to establish a prima facie case of obviousness with respect to independent claims 1, 9, and 14. App. Br. 14–18. In particular, Appellant asserts,

the Examiner has failed to show that the references teach or suggest at least the following elements recited in claim 1:

receiving, at a computer, an interest list from a primary entity, the interest list identifying a reputation of interest, evaluation rules, and notification rules established for the reputation of interest, the reputation of interest being associated with a secondary entity,

wherein the interest list includes a reputation identifier and one or more baseline indicators, the reputation identifier and the one or more baseline indicators being associated with the reputation of interest.

Id. at 14. Appellant further contends that, “despite admitting that Oliver is silent regarding these claim elements, without citation to any particular paragraphs of Oliver, [the Examiner] goes on to reject the claim elements over the Oliver reference.” *Id.* at 15 (citing Final Act. 8–9). Appellant contends “the Examiner relies on Oliver but fails to clearly explain the pertinence of the reference by designating the particular parts relied upon and providing clear explanation supporting the rejection,” and “[a]s a matter of fundamental fairness, Appellant respectfully submits that the Examiner has not designated the particular part relied on as nearly as practicable and

and Harms (*id.* at 11–17) and over Oliver, Lester, and Bandhole (*id.* at 17–22). We accordingly reverse, without further discussion, the rejection of claims 9, 10, 12–15, and 18–20 as unpatentable over Oliver and Lester alone.

clearly explained the pertinence of the Oliver reference.” *Id.* Appellant additionally contends that “any characterization of [the identified elements] . . . as being inherent is improper, because the claim elements do not necessarily flow from the Oliver reference, and the Examiner has not provided citations and a clear explanation regarding the Oliver reference that would support a rejection of the claim elements as inherent.” *Id.* at 16.

Lastly with respect to claim 1, Appellant contends, “Lester does not overcome the deficiencies of Oliver.” *Id.* Appellant professes to have “reviewed the cited paragraphs in detail and [to] ha[ve] not found any teaching or suggestion in any of the paragraphs that cure the deficiencies of Lester with regard to the claim elements at issue.” *Id.* Appellant argues that, “[a]t best, Lester is alleged by the Examiner to show ‘receiv[ing] reputation information.’” *Id.* According to Appellant,

[t]here is no citation or analysis provided by the Examiner regarding any teachings of Lester regarding “receiving, at a computer, an interest list,” let alone “the interest list identifying a reputation of interest, evaluation rules, and notification rules . . . wherein the interest list includes a reputation identifier and one or more baseline indicators” as recited in the claim.

Id. (alterations in original).

Appellant relies on the same arguments with respect to independent claims 9 and 14 as for claim 1, which “include features similar to those of claim 1,” adding that “[t]he additional references relied upon for claim 9 and 14, Harms and Bandhole, do not appear to be cited to by the Examiner as curing any of the deficiencies noted above with respect to the rejection of claim 1 under Oliver and Lester,” and further contesting the Examiner’s reliance on Bandhole with respect to claim 14. *Id.* at 17. Regarding the latter point, Appellant contends that the Final Office Action “does not

provide any rationale for why ‘ranking and rating of vendor reputation,’ as the Examiner relies upon from Bandhole, teaches ‘discover[ing] an ontologically similar reputation related to the reputation of interest and add[ing] the ontologically similar reputation to the interest list,’” as recited in claim 14. *Id.* at 18. According to Appellant, “even assuming for the sake of argument that the ‘ranking and rating of vendor reputation’ teaches a ‘reputation,’ the Examiner has provided no explanation for how Bandhole teaches ‘discover[ing] an ontologically similar reputation related to the reputation of interest’ as recited in the claim,” and “[t]he Examiner has . . . failed to provide a *prima facie* case that Bandhole teaches all of the claim elements.” *Id.*

We have reviewed the Examiner’s rejections under 35 U.S.C. § 103(a) in light of Appellant’s arguments that the Examiner erred. We disagree with Appellant that the Examiner erred and adopt as our own the findings and conclusions set forth in the Final Office Action and in the Examiner’s Answer. We highlight and address specific findings and arguments for emphasis as follows.

First, we disagree with Appellant’s contentions that the Examiner has not designated the particular parts of Oliver relied upon in the rejection. *See* App. Br. 14–15. The Examiner points, for example, to paragraphs 75, 76, 83–85, and Figures 1–4 of Oliver as disclosing “*receiving at a computer, updated reputation information regarding a reputation of interest from a reputation information provider*” (Final Act. 7 (emphasis added)); paragraphs 39–42, 64, 75, 76, 81–85, 95–97, 101, and Figures 4–7 of Oliver as disclosing “evaluating . . . the received updated reputation information in accordance with *evaluation rules established for the reputation of interest,*

the evaluating including comparing the updated reputation information . . . with *base line reputation information of the reputation of interest . . .*” (*id.* (emphasis added)); and paragraphs 95–97, 101, and Figures 7 and 8 of Oliver as disclosing “in response to the detected change, generating, by the computer, a message in accordance with the *notification rules established for the reputation of interest . . .*” (*id.* at 7–8 (emphasis added)). The Examiner then refers back to those findings in the discussion of the challenged step of “receiving, at a computer, an interest list from a primary entity, the interest list identifying a reputation of interest, evaluation rules, and notification rules . . . , wherein the interest list includes a reputation identifier and one or more baseline indicators.” *Id.* at 8 (“ . . . OLIVER also discloses the reputation of interest being associated with a secondary entity (a target computer entity), evaluation rules and notification rules *as indicated above.*” (emphasis added)). We have reviewed the portions of Oliver cited by the Examiner and agree that they teach the claim elements for which they are cited.

Further, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Accordingly, because the Examiner’s rejection of each of the claims is based on the combination of at least Oliver and Lester, we are not persuaded by Appellant’s arguments that the references individually do not teach or suggest the challenged limitations. For example, whereas Appellant contends

[t]here is no citation or analysis provided by the Examiner regarding any teachings of Lester regarding “receiving, at a computer, an interest list,” let alone “the interest list identifying

a reputation of interest, evaluation rules, and notification rules . . . wherein the interest list includes a reputation identifier and one or more baseline indicators” as recited in the claim (App. Br. 16 (modifications in original)), the Examiner relies on Oliver for the interest list, reputation of interest, evaluation rules, notification rules, reputation identifier, and baseline indicators (Final Act. 7–8), and Appellant’s argument that Lester does not separately teach those elements is unpersuasive. Likewise, because the Examiner relies on Lester for its disclosure that a user (i.e., a “primary entity,” in the parlance of the claims) may provide a request for a reputation of interest, such that such a request would be “receiv[ed], at a computer,” we are not persuaded by Appellant’s argument that the Examiner has not established that such receipt is “inherent” in Oliver (App. Br. 16).

Finally, we are not persuaded of error in the Examiner’s rejection of claim 14 over the combination of Oliver, Lester, and Bandhole. Claim 14 recites, “wherein the reputation computation engine is adapted to discover an ontologically similar reputation related to the reputation of interest and add the ontologically similar reputation to the interest list.” We agree with the Examiner’s interpretation of the recited “ontologically similar reputation” in light of the Specification to include Bandhole’s rating or ranking reputation for a particular entity. *See* Ans. 38 (citing paragraph 27 of Appellant’s published application, corresponding to Spec. ¶ 23; Bandhole ¶¶ 66, 80, 84). Indeed, paragraph 23 of the Specification explicitly provides “a star rating system” and “a ranking with respect to peers” as examples of reputation forming information that provide for monitoring of ontologically similar reputations of interest. As found by the Examiner, Bandhole likewise discloses, for example, “rating and ranking lookup of vendor reputation”

(*see* Bandhole ¶ 80), which, when combined with the teachings of Oliver and Lester, we agree would have taught or suggested the disputed limitation.

For the foregoing reasons, we sustain the Examiner's rejections of claims 1, 4–8, 24, and 26 as unpatentable over the combination of Oliver and Lester;⁸ claims 9, 10, 12, 13, 23, and 25 as unpatentable over the combination of Oliver, Lester, and Harms; and claims 14, 15, 18–20, and 22 over the combination of Oliver, Lester, and Bandhole.

DECISION

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's rejection of claims 1, 4–10, 12–15, 18–20, and 22–26 is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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

⁸ *See supra* note 7 regarding claims 9, 10, 12–15, and 18–20.