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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HOWARD W. LUTNICK and MICHAEL SWEETING

Appeal 2016–004930
Application 13/912,453
Technology Center 3600

Before ANTON W. FETTING, BIBHU R. MOHANTY, and ALYSSA A. FINAMORE, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

STATEMENT OF CASE

This is a decision on rehearing in Appeal No. 2016-004930. We have jurisdiction under 35 U.S.C. § 6(b).

Requests for Rehearing are limited to matters misapprehended or overlooked by the Board in rendering the original decision, or to responses to a new ground of rejection designated pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.52.

ISSUE ON REHEARING

Appellants raise the issue of eligible subject matter.

ANALYSIS

We found in our Decision that the rejection of claims 58–69, 71, 72, and 74–79 under 35 U.S.C. § 101 as directed to non-statutory subject matter is proper. Decision 13. The Appellants argue all claims pass both parts of the *Alice* test. Request 2.

The Appellants contend that we misapprehended that the Examiner failed to present a prima facie case. Request 2–3. We presented a prima facie case in the Decision. The determination of whether claims recite eligible subject matter is a question of law, subject to *de novo* review. That said, the Examiner made sufficient findings as to the first part of the *Alice* test at Final Action 3. In particular, the Examiner found that the claims are directed to trading an item based on the act of causing the vending of a trading priority and that trading is a fundamental practice. The Examiner made sufficient findings as to the second part of the *Alice* test at Final Action 4. In particular, the Examiner found that

> The elements of the instant process, when taken alone, each execute in a manner routinely and conventionally expected of these elements. The elements of the instant process, when taken in combination, together do not offer substantially more than the sum of the functions of the elements when each is taken alone.

Id. Accordingly, the Examiner did present a prima facie case.

Appellants next contend that the Decision makes a new ground of rejection that the claims are directed to the allegedly abstract idea of "executing a trade for a financial instrument." Request 3. This is the same thrust as the Examiner's finding that the claims are directed to trading an item. Simply characterizing the item as a financial instrument, which is the typical object of trades in the financial industry, does not change the rejection in any meaningful way.

Appellants next contend that we must show the claims are directed to an abstract idea by comparing the claims to those in settled case law. Request 4. Without conceding this as a legal requirement, we find that we made such comparisons with respect to *Bilski v Kappos*, 561 U.S. 593 (2010) (Decision 6–7), *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014) (Decision 11–12), *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014) (Decision 11–12), and *Electric Power Group v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (Decision 7–8).

Appellants cite *Trading Technologies International, Inc. v. CQG Inc.*, 675 F. App'x 1001 (Fed. Cir. 2016) as the most similar case decided by the courts to Applicants' claims. Request 4. First, as the citation to the Federal Appendix indicates, this case offers no precedential value. Second, and more critically, the facts in this case are those in which the invention did

affect the underlying technology of the computer in the manner of dynamic user interface run time animation. No such underlying technology improvement is present in the instant claims.

Appellants next contend that every claim must be separately analyzed, limitation by limitation. Request 5–6. Rather, every limitation in every claim must be separately considered, but there is no legal requirement for a full written explication for every claim. Appellants cite *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (2016) for the holding that an inventive concept may be found in the nonconventional and non-generic arrangement of the additional elements. *Id.* We agree this is the holding in *BASCOM*. Appellants do not show how the claims recite such nonconventional and non-generic arrangement of the additional elements. And it must be remembered that the *BASCOM* outcome was very much dependent on its procedural posture as arising from a challenge against an FRCP 12(b)(6) motion to dismiss, taking the allegations of the complaint to be true. *BASCOM*, 827 F.3d at 1347. As we found, there is nothing nonconventional and non-generic about the additional elements in the claims. For example, claim 77 takes in data and writes it to a data stack, and then rearranges the data in the stack. This is among the most primitive computer operations, as stacks are among the most fundamental data structures used. To the extent Appellants rely on the nature of the data present in the stacks as being unconventional, such data has meaning only to the human mind, and is therefore afforded little or no weight. *In re Bernhart*, 417 F.2d 1395, 1399 (CCPA 1969).

Appellants finally contend that the claims are like those in *DDR Holdings, BASCOM,* and *Trading Technologies*. Request 6–8. We addressed this contention supra and in our Decision. Appellants also contend the claims are like those in *Amdocs (Israel) Limited v. Openet Telecom, Inc.*, 841 F.3d 1288 (2016). *Id.* The holding in *Amdocs* turned on a claim construction based on additional details in the Specification not explicitly recited in the claims from an earlier court case for which there is no parallel here.

CONCLUSION

Nothing in Appellants' request has convinced us that we have overlooked or misapprehended the law as argued by Appellants. Accordingly, we deny the request.

DECISION

To summarize, our decision is as follows:

- We have considered the REQUEST FOR REHEARING
- We DENY the request that we reverse the Examiner as to claims 58–69, 71, 72, and 74–79

REHEARING DENIED