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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER L. HOLT

Appeal 2016-005510
Application 11/891,101
Technology Center 3600


DIXON, Administrative Patent Judge.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellant\(^1\) appeals under 35 U.S.C. § 134(a) from a rejection of claims 21–36. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The claims are directed to a patent examiner information system. Claim 21, reproduced below, is illustrative of the claimed subject matter:

21. A computer-implemented method of generating patent examiner-specific responses to queries, the method comprising:

   displaying, on a search user interface, an examiner input box that prompts textual entry of an examiner name and receives user textual input;

   receiving, through the search user interface, an examiner name input in the examiner input box;

   identifying a given examiner based on the examiner name received;

   searching, using a computer processor, an examiner data store using the given examiner identified;

   aggregating examiner data calculated from specific content of examiner written office actions corresponding to a plurality of different patent applications examined by the given examiner;

   generating examiner statistics from the aggregated examiner data for the given examiner; and

   generating, on a results user interface, a results display showing the examiner statistics, wherein the examiner statistics are indicative of the given examiner's frequency in performing

\(^1\) Appellant contends that the real party in interest is Reed Technology and Information Services, Inc. (App. Br. 2).
one or more actions during prosecution of the plurality of different patent applications.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

<table>
<thead>
<tr>
<th>Inventor</th>
<th>Publication No.</th>
<th>Date</th>
</tr>
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<tbody>
<tr>
<td>Lee et al.</td>
<td>US 2003/0220897 A1</td>
<td>Nov. 27, 2003</td>
</tr>
</tbody>
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REJECTIONS

The Examiner made the following rejections:

Claims 21–36 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more. (Ans. 2).

Claim 36 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Ans. 2).


Claims 27–30 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Slovak in view of Caplan and Lee, and further in view of Barney. (Ans. 2–3).

Claim 34 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Slovak in view of Caplan and Barney, and further in view of Brudz. (Ans. 3).

Claim 36 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Slovak in view of Caplan and Lee, and further in view of Grainger. (Ans. 3).

ANALYSIS

35 U.S.C. § 112, second paragraph

With respect to dependent claim 36, Appellants have not provided a specific argument for patentability. As a result, we pro forma sustain the Examiner’s rejection under 35 U.S.C. § 112, second paragraph.

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2 The Examiner indicated that “Applicant’s amendment to the claims has remedied the written description and indefinites issues of record. The rejections under 35 U.S.C. § 112 have been withdrawn,” but the Examiner makes a new rejection of dependent claim 36 based upon 35 U.S.C. § 112, second paragraph. (Ans. 6).
We have reviewed the Examiner’s rejection in light of Appellant’s contentions and the evidence of record. We concur with Appellant’s contention that the Examiner erred in this rejection.

Section 101 of the Patent Act provides “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. That provision “contains an important implicit exception: Laws 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)). According to the Supreme Court:

[W]e set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . If so, we then ask, “[w]hat else is there in the claims before us?” . . . To answer that question, we consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. . . . We have described step two of this analysis as a 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.” Alice Corp., 134 S.Ct. at 2355.

The Federal Circuit has described the Alice step-one inquiry as looking at the “focus” of the claims, their “character as a whole,” and
the Alice step-two inquiry as looking more precisely at what the claim elements add—whether they identify an “inventive concept” in the application of the ineligible matter to which the claim is directed. See Elec. Power Grp., LLC v. Alstom S.A., 830 F.3d 1350, 1353 (Fed. Cir. 2016); Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1335–36 (Fed. Cir. 2016); Internet Patents Corp. v. Active Network, Inc., 790 F.3d 1343, 1346 (Fed. Cir. 2015).

According to the Federal Circuit, “[t]he second step of the Alice test is satisfied when the claim limitations ‘involve more than performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” Berkheimer v. HP Inc., 881 F.3d 1360, 1367 (Fed. Cir. 2018) (quoting Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n, 776 F.3d 1343, 1347–48 (Fed. Cir. 2014) and Alice, 134 S. Ct. at 2359).

In this case, the Examiner identifies the abstract idea as being directed to “the abstract idea of generating patent examiner-specific responses to queries.” (Ans. 3).

Appellants argue with respect to the Alice step-two analysis, the Examiner has not provide any evidence to support the Examiner’s assertion that the claimed limitations perform well-understood, routine, and conventional functions or steps. (See App. Br. 13–14).

Appellants argue that

Limitations that may be enough to qualify as “significantly more” when recited in a claim with a judicial exception include: effecting a transformation or reduction of a particular article to a different state or thing; or adding a specific limitation other than what is well-understood, routine and conventional in the field, or adding unconventional steps that confine the claim to a particular useful application. Independent claim 21 recites significantly
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more than an abstract idea. the examiner alleges that the abstract idea is "decision maker analysis (i.e., data mining)." (final office action, page 8). the claims recite "significantly more" than the alleged abstract idea of decision maker analysis (i.e., data mining). in particular, independent claim 21 adds specific limitations to what is well-understood, routine and conventional in the field, and add unconventional steps that confine the claims to a particular useful application. each of the pending claims recites a computer-implemented method that, among other things, aggregates examiner data calculated from specific content of examiner-written office actions corresponding to a plurality of different patent applications examined by the given examiner, generates examiner statistics from the aggregated data for the given examiner, and generates a results display showing the examiner statistics for the given examiner. each of the pending claims further recites displaying a search user interface including an examiner input box, and generating a results display showing the examiner statistics on a results user interface. such specific limitations are added to what is well-understood, routine and conventional in the field. furthermore, such added unconventional steps confine the claims to a particular useful application of aggregating, generating, and displaying examiner statistics for use by parties interested in such data.

(app. br. 13–14; reply br. 3).

the examiner finds the claimed invention:

is directed towards performing the well-understood, routine, and conventional activities in the technical field of generating patent examiner-specific responses to queries. independent claims 21 and 34 are directed towards the well-understood, routine, and conventional activities of displaying, receiving, identifying, searching, and aggregating information to generate and display examiner statistics.
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(Ans. 4). The Examiner further finds the claimed invention differentiates from *DDR Holdings* because the claimed invention is not deeply rooted in the technology because:

1.) humans have, for some time, longed been known to perform the well-understood, routine, and conventional activities in the field of generating patent examiner-specific responses to queries, e.g., displaying, receiving, identifying, searching, and aggregating information to generate and display examiner statistics, and the like; and 2.) the well-understood, routine, and conventional activities of the abstract idea does not change, alter, or improve upon how the technology, i.e. user interface and computer, fundamentally functions. The invention further fails to improve upon the technical field (generating patent examiner-specific responses to queries) because merely using the general purpose device to perform the well-understood, routine, and conventional activities of the generating patent examiner-specific responses to queries has been held to not be an “inventive concept” as the general purpose device is being used for the very purpose that such device are known to be used for, e.g. more efficient, faster, and etc.

(Ans. 7). The Examiner maintains that all of the steps of the method are well-understood, routine, and conventional activities of the abstract idea which does not change, alter, or improve upon how the technology fundamentally functions.

The new examination procedure published online by the USPTO on April 19, 2018, entitled “Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*)” (hereinafter “USPTO Memorandum”). We note the USPTO Memorandum sets forth a new fact finding requirement for Examiners that is applicable to rejections under § 101. Specifically, Examiners must now provide specific types of evidence to support a finding
that claim elements (or combinations of elements) are well-understood, routine, and conventional.

We reproduce below changes to prior examination practice, as set forth in the April 19, 2018 USPTO Memorandum (3–4):

A. Formulating Rejections: In a step 2B analysis, an additional element (or combination of elements) is not well-understood, routine or conventional unless the examiner finds, and expressly supports a rejection in writing with, one or more of the following:

1. A citation to an express statement in the specification or to a statement made by an applicant during prosecution that demonstrates the well-understood, routine, conventional nature of the additional element(s). A specification demonstrates the well-understood, routine, conventional nature of additional elements when it describes the additional elements as well-understood or routine or conventional (or an equivalent term), as a commercially available product, or in a manner that indicates that the additional elements are sufficiently well-known that the specification does not need to describe the particulars of such additional elements to satisfy 35 U.S.C. § 112(a). A finding that an element is well-understood, routine, or conventional cannot be based only on the fact that the specification is silent with respect to describing such element.

2. A citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s).

3. A citation to a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s). An appropriate publication could include a book, manual, review article, or other source that describes the state of the art and discusses what is well-known and in common use in the relevant industry. It does not include all items that might otherwise qualify as
Whether something is disclosed in a document that is considered a “printed publication” under 35 U.S.C. § 102 is a distinct inquiry from whether something is well-known, routine, conventional activity. A document may be a printed publication but still fail to establish that something it describes is well-understood, routine, conventional activity. See Exergen Corp., 2018 WL 1193529, at *4 (the single copy of a thesis written in German and located in a German university library considered to be a “printed publication” in Hall “would not suffice to establish that something is ‘well-understood, routine, and conventional activity previously engaged in by scientists who work in the field’”). The nature of the publication and the description of the additional elements in the publication would need to demonstrate that the additional elements are widely prevalent or in common use in the relevant field, comparable to the types of activity or elements that are so well-known that they do not need to be described in detail in a patent application to satisfy 35 U.S.C. § 112(a). For example, while U.S. patents and published applications are publications, merely finding the additional element in a single patent or published application would not be sufficient to demonstrate that the additional element is well-understood, routine, conventional, unless the patent or published application demonstrates that the additional element are widely prevalent or in common use in the relevant field.

4. A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s). This option should be used only when the examiner is certain, based upon his or her personal knowledge, that the additional element(s) represents well-understood, routine, conventional activity engaged in by those in the relevant art, in that the additional elements are widely prevalent or in common use in the relevant field, comparable to the types of activity or elements that are so well-known that they do
not need to be described in detail in a patent application to satisfy 35 U.S.C. § 112(a). Procedures for taking official notice and addressing an applicant's challenge to official notice are discussed in MPEP § 2144.03.

Applying the procedural guidance of the USPTO Memorandum (id.) here, and based upon our review of the record, we find that “an additional element (or combination of elements) is not well-understood, routine or conventional unless the [E]xaminer finds, and expressly supports [the] rejection in writing with, one or more of” the four methods provided therein.

Thus, the various statements in the record by the Examiner as to what is purportedly well-understood, routine or conventional, without more, do not provide any of the types of factual evidence required by the USPTO Memorandum (3–4), which officially implemented the guidance of *Berkheimer* (881 F.3d at 1369).

Therefore, after reviewing the arguments articulated by Appellant in the Appeal and Reply Briefs, we find Appellant’s arguments persuasive, based upon: (1) the intervening authority *Berkheimer* (881 F.3d at 1369), and, (2) the intervening USPTO Memorandum, which changed patent examination practice and procedure to be compliant with the guidance of *Berkheimer*.

Accordingly, for essentially the above reasons, as pertaining to intervening controlling authority of *Berkheimer*, and the additional mandatory examination practice and procedure changes set forth in the USPTO Memorandum, we are constrained on this record to reverse the Examiner’s rejection of claims 21–35 under 35 U.S.C. § 101, as being directed to patent-ineligible subject matter.
The Examiner’s rejection of independent claim 21 is based upon the combination of the Slovak, Caplan, and Lee references, and the Examiner finds that the Slovak reference teaches most of the claimed searching and data retrieval in the legal/judicial field, but not in the same specificity with respect to limitation concerning a “patent examiner” and without expressly teaching the aggregating statistical information from a data set. (Ans. 10–22).

Appellant summarizes the Examiner’s rejection and contends:

the cited references, either alone or in combination, fail to teach or fairly suggest “generating, on a results user interface, a results display showing the examiner statistics, wherein the examiner statistics are indicative of the given Examiner’s frequency in performing one or more actions during prosecution of the plurality of different patent applications,” as recited in claim 21 (emphasis added). Slovak does not disclose generating a report indicative of a frequency in performing one or more actions. Rather, it discloses generating reports such as case load and type of litigation (see FIGS. 5A-5R). Lee only discloses providing a count of patents examined by each examiner. Although Caplan is cited for generally teaching the performance of statistical analysis, neither Slovak nor Lee teach or fairly suggest the type of examiner data and statistics needed by Caplan to perform such examiner statistical analysis as recited in claim 21. Furthermore, a person of ordinary skill in the art would not be motivated to combine Slovak, Caplan, and Lee in the manner asserted by the Examiner. Accordingly, Appellant respectfully submits that the combination of Slovak, Caplan and Lee does teach or fairly suggest “generating, on a results user interface, a results display showing the examiner statistics, wherein the examiner statistics are indicative of the given examiner’s frequency in performing one or more actions during prosecution of the plurality of different patent applications,” as recited in claim 21.

(App. Br. 16; see also Reply Br. 4).
The Examiner responds to Appellants’ arguments by reiterating that “Slovak, Caplan and Lee must be read, not separately, but for what they fairly teach in combination.” (Ans. 7). We agree with the Examiner that the combination of teachings would have taught or suggested the claimed invention. Additionally, the Examiner has provided discussions of the motivations for the combination of each of the references in the combined teachings. (Ans. 12–14). We agree with the Examiner’s factual findings and conclusion of obviousness and find Appellants’ arguments do not show error in the Examiner’s conclusion of obviousness because Appellant’s arguments are directed to the references individually and not what the combination would have suggested to one of ordinary skill in the art at the time of the invention.

As a result, we find Appellant’s argument does not show error in the Examiner’s factual findings or conclusion of obviousness of representative independent claim 21.

Appellant does not set forth separate arguments for patentability of dependent claims 22–36, and we sustain the rejection of these claims for the same reasons set forth above with respect to representative independent claim 21.

CONCLUSIONS

DECISION

For the above reasons, we sustain the Examiner’s rejection of claim 36 based upon indefiniteness; we procedurally reverse the Examiner’s rejection of claims 21–36 based upon a lack of patent eligible subject matter; and we sustain the Examiner’s obviousness rejection of claims 21–36 under 35 U.S.C. § 103.

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