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Shook, Hardy & Bacon L.L.P. (eBay Inc.) 2555 Grand Blvd. KANSAS CITY, MO 64108-2613			CIVAN, ETHAN D	
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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* ERIC J. FARRARO, JOHN TAPLEY,  
and WEI DIANA CHIANG

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Appeal 2016-006435  
Application 12/638,897  
Technology Center 3600

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Before BIBHU R. MOHANTY, MEREDITH C. PETRAVICK, and  
AMEE A. SHAH, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 from the final rejection of claims 1–20 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

### THE INVENTION

The Appellants' claimed invention is directed to a system and method of allowing a user to select fashion accessories in an electronic marketplace (Spec., para. 2). Claim 14, reproduced below, is representative of the subject matter on appeal.

14. A method of retrieving information related to marketplace items within an electronic environment, the method comprising:
- storing the information related to the marketplace items, the information including one or more user-created items, the one or more user-created items including images of a plurality of celebrity models, each of the plurality of celebrity models having one or more tagged items, each of the one or more tagged items having associated descriptive metadata;
  - receiving a query from an end-user;
  - querying the stored information, using one or more hardware-based processors, to match constraints contained within the query to the associated descriptive metadata of the one or more tagged items; and
  - displaying to the end-user one of the plurality of celebrity models and the one or more tagged items.

### THE REJECTION

The following rejection is before us for review:

Claims 1–20 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

## FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence<sup>1</sup>.

## ANALYSIS

### *Rejection under 35 U.S.C. § 101*

The Appellants argue that the rejection of claim 14 is improper because the claims have not been shown to be patent-ineligible subject matter (App. Br. 9–12). The Appellants argue the claim has not been properly shown to be an abstract idea (App. Br. 12, 13, 16, 17). The Appellants further argue that the claim is directed to “significantly more” than any alleged abstract idea (App. Br. 13, 17, 18). The Appellants also argue that the rejection failed to properly consider the dependent claims (App. Br. 14).

In contrast, the Examiner has determined that the rejection of record is proper (Final Act. 2, 3, Ans. 2-9).

We agree with the Examiner. Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “laws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

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<sup>1</sup> *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

In judging whether claim 14 falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. If so, we then consider the elements of the 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 of the abstract idea. *Id.* This is a search for an “inventive concept” an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.* The Court also stated that “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Id.* at 2357.

Here, we determine that the claim is directed to the concept of storing information, receiving a query, and performing the query. This is a method of organizing human information and fundamental economic practice long prevalent in our system of commerce, and is an abstract idea beyond the scope of § 101. See *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016) where collecting information, analyzing it, and displaying results from certain results of the collection and analysis was held to be an abstract idea.

We next consider whether additional elements of the claim, both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the

abstract idea using generic computer components. We conclude that it does not.

Considering each of the claim elements in turn, the function performed by the computer system at each step of the process is purely conventional. Each step of the claimed method does no more than require a generic computer to perform a generic computer function. The Specification, at paragraphs 63–67, describes using conventional computer components such as personal computers, computer networks, and memory devices in a conventional manner for their known uses.

We note the point about pre-emption (App. Br. 15). While pre-emption “might tend to impede innovation more than it would tend to promote it, ‘thereby thwarting the primary object of the patent laws’” (*Alice*, 134 S. Ct. at 2354 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012))), “the absence of complete preemption does not demonstrate patent eligibility” (*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), *cert. denied*, 136 S. Ct. 701, 193 (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.”).

For this reason the rejection of claim 14 is sustained.

We reach the same conclusion as to independent system claim 10. Here, as in *Alice*, “the system claims are no different in substance from the method claims. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea.” *Alice* 134 S. Ct. at

2351. “[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea ‘while adding the words ‘apply it’’ is not enough for patent eligibility.” *Id.* at 2358 (quoting *Mayo*, 132 S. Ct. at 1294).

Independent claims 1 and 19 are directed to similar subject matter and the rejection of these claims is sustained as well. The Appellants have provided no specific arguments for the subject matter of the dependent claims in the application. However, a review of these claims indicates that they are directed to similar subject matter and the rejection of these claims is sustained as well.

#### CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1–20 under 35 U.S.C. § 101

#### DECISION

The Examiner’s rejection of claims 1–20 is sustained.

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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED