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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* FRANCK BARILLAUD

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Appeal 2016-006616
Application 12/258,971[1]
Technology Center 3600

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Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and PHILIP J. HOFFMANN, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Franck Barillaud (Appellant) seeks our review under 35 U.S.C. § 134(a) of the Non-Final Rejection of claims 1, 2, 4–10, 12–17, 19 and 20. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

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[1] The Appellant identifies Business Machines Corporation as the real party in interest. App. Br. 2.

## THE INVENTION

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

> 1. A method in a data processing system for providing a user with intelligent access to a skilled consultant, said method comprising:
>
> in response to receiving a user input describing an issue about which consultation is desired, the data processing system mapping said user input to a selected problem domain from among a plurality of problem domains, wherein said mapping includes:
>
> the data processing system generating a first list containing multiple of the plurality of problem domains based on a first portion of the user input and generating a second list containing multiple of the plurality of problem domains based on a second portion of the user input;
>
> the data processing system intersecting the first and second lists; and
>
> the data processing system selecting the selected problem domain responsive to intersecting the first list and the second list;
>
> based on a list of one or more skills for consulting in said selected problem domain, the data processing system mapping said selected problem domain to a consultant set of one or more consultants associated with said one or more skills;
>
> the data processing system filtering said consultant set to determine whether at least one consultant in said consultant set is available to consult utilizing communication via said data processing system;
>
> the data processing system sending a consultation request to at least one available consultant in said consultant set; and

> in response to the data processing system receiving, from an available consultant, an acceptance of said consultation request, communicating consulting information between said available consultant and said user in substantially real time via said data processing system, such that both the user and the available consultant have access to the consulting information when communicating.

## THE REJECTION

The following rejection is before us for review:

1. Claims 1, 2, 4–10, 12–17, 19 and 20 are rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

## ISSUE

Did the Examiner err in rejecting claims 1, 2, 4–10, 12–17, 19 and 20 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter?

## ANALYSIS

*The rejection of claims 1, 2, 4–10, 12–17, 19 and 20 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.*

The Appellant argued these claims as a group. *See* App. Br. 7–13. We select claim 1 as the representative claim for this group, and the remaining claims 2, 4–10, 12–17, 19 and 20 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

*Alice Corp. Proprietary Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether

claimed subject matter is judicially-excepted from patent-eligibility under 35 U.S.C. § 101.

According to *Alice* step one, "[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept," such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

In that regard, the Examiner determined

> [t]hese claims are directed to an abstract idea related to finding a group of consultants who can help a user seeking consulting help. The user provides input for an issue and based on the area of the issue, appropriate consultants are found. Based on availability of the consultant, a consultant is assigned to provide consultation. Furthermore, it is basically organizing a human activity based on the issue and a list of consultants

Non-Final Action 4.

The Appellant challenges the concept the Examiner characterized claim 1 as being directed to. According to the Appellant, when the claim is considered as a whole, claim 1 "is directed not to . . . a specific method of data processing by which a data processing system maps a user input to a selected problem domain." App. Br. 9–10. When characterized that way, "Claim 1, viewed as a whole, is not directed to an abstract idea as alleged by the Examiner . . . ." App. Br. 10.

We do not agree that the Examiner's characterization of what claim 1 is directed to is incorrect. The Examiner's characterization is at a general level but is nevertheless consistent with applying the "directed to" inquiry; that is, "the 'directed to' inquiry 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.'" *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)." *Enfish, LLC v.*

*Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). Granted the Examiner's characterization lacks a mention of the data processing system recited in claim 1 which the claimed method employs to select a consultant for a user's issue about which consultation is desired. But the Examiner appears to treat that limitation as a matter for consideration under step two in determining whether there is an inventive concept. It is true that claims must be considered as a whole. "[I]n determining the eligibility of respondents' claimed process for patent protection under § 101, their claims must be considered as a whole." *Diamond v. Diehr*, 450 U.S. 175, 188 (1981). But the question is whether the claims as a whole "focus on a specific means or method that improves the relevant technology" or are "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). It is clear from the Examiner's position that the Examiner determined claim 1 was directed to the latter; that is, claim 1 is not focused on the data processing system; rather, the recited "data processing system" acts merely as a conduit for the abstract idea. *Cf. In re TLI Communications LLC Patent Litigation*, 823 F.3d 607, 612 (Fed. Cir. 2016) ("Put differently, the telephone unit itself is merely a conduit for the abstract idea of classifying an image and storing the image based on its classification. Indeed, the specification notes that it 'is known' that 'cellular telephones may be utilized for image transmission,' *id.* at col. 1 ll. 31–34, and existing telephone systems could transmit pictures, audio, and motion pictures and also had 'graphical annotation capability,' *id.* at col. 1 ll. 52–59.").

The Appellant's alternative characterization of what claim 1 is directed to – i.e., "a specific method of data processing by which a data processing system maps a user input to a selected problem domain" (App. Br. 9–10) – focuses on only the mapping limitations in claim 1 and arguably does not itself cover all that claim 1 is directed to as the Appellant has argued with respect to the Examiner's characterization. Be that as it may, the Appellant does not persuade us that the mapping as claimed is not an abstract idea.

According to claim 1, a data processing system maps user input to a selected problem domain from among a plurality of problem domains. According to the Specification, a "problem domain is an abstract view of the specific problem at hand." Spec., para. 30. Thus the data processing system maps user input to a selected abstract view from among a plurality of abstract views. In other words, the data processing system maps a first type of information ("user input") to a second type ("a selected problem domain from among a plurality of problem domains"). Claim 1 further describes the mapping process as including

> generating a first list containing multiple of the plurality of problem domains based on a first portion of the user input and generating a second list containing multiple of the plurality of problem domains based on a second portion of the user input;
>
> the data processing system intersecting the first and second lists; and
>
> the data processing system selecting the selected problem domain responsive to intersecting the first list and the second list.

Claims App. 14. The claim 1 mapping scheme calls for generating two lists of information based on two portions of inputted information and selecting that information which is at the intersection of the two lists.

Generating two lists of information based on two portions of inputted information and selecting that information which is at the intersection of the two lists is similar to the concept of "1) collecting data, 2) recognizing certain data within the collected data set, and 3) storing that recognized data in a memory" that the court has been determined to be an abstract idea. *Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass'n*, 776 F.3d 1343 (Fed. Cir. 2014). "[T]he decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided. *See, e.g., Elec. Power Grp.*, 830 F.3d at 1353–54." *Amdocs (Israel) Limited v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016). Accordingly, even if we were to accept the Appellant's characterization of the mapping concept to which claim 1 is directed to, said mapping concept, like "1) collecting data, 2) recognizing certain data within the collected data set, and 3) storing that recognized data in a memory," is an abstract idea.

For the foregoing reasons, the Appellant's arguments are unpersuasive as to error in the Examiner's determination that claim 1 is directed to an abstract idea. We now turn to step two.

Step two is "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*, 134 S. Ct. at 2355 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 73 (2012)).

In that regard, the Examiner determined

> [t]he claims do not amount to be an improvement to another technology or a technical field. The claims do not amount to an improvement to the functioning of a computer itself. The claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception. The generic elements of the claimed invention can be performed on any generic computer and these elements add nothing to the abstract idea.
>
> As an example, claim 1 is related to finding a group of consultants who can help a user seeking consulting help. The user provides input for an issue and based on the area of the issue, appropriate consultants are found and one of them is assigned to the issue.
>
> These steps of the claim 1 related to assigning an appropriate consultant based upon the issue, consultant specialty and availability would be routinely used by those of ordinary skill in art to provide proper help.

Non-Final Action 5.

The Appellant disagrees. According to the Appellant, claim 1 sets forth mapping steps which "provide improvement to the operation of a data processing system in its mapping of user inputs to a selected problem domain." App. Br. 11. "This improvement over the operation of conventional data processing systems is described in ¶¶ [0003]-[0008] . . . ." App. Br. 11.

We have reviewed ¶¶ [0003]-[0008] of the Specification but do not see in those passages any disclosure that the mapping steps provide improvement to the operation of a data processing system. Said passages describe difficulties with prior art systems for providing technical support.

"The most common method of technical support is still a telephone conversation with technical support personnel." Spec. Para. 5. According to the Specification

> the result [of past systems of providing technical support] is that end users often feel like the vendor is trying to push them away. Moreover, the end user will eventually turn to other vendors in search of a better customer service experience. Such unintended consequences can translate into lost revenues and higher costs for the vendor.

Spec. Para. 8. Given this, "a method, system, and computer program product for providing a user with intelligent access to a skilled consultant are disclosed." Spec. Para. 9.

We see nothing in the claim to suggest that generating two lists of information based on two portions of inputted information and selecting that information which is at the intersection of the two lists improves a data processing system. Data processing systems are known to generate lists of information based on inputted information. Data processing systems are also known to compare information and present selected information. When "the focus of the asserted claims" is "on collecting information, analyzing it, and displaying certain results of the collection and analysis," the claims are directed to an abstract idea. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1343 (Fed. Cir. 2016). "[C]omparing one thing to another" is an abstract idea. *See Blue Spike, LLC v. Google Inc.*, No. 14-cv-01650-YGR, 2015 WL 5260506 (N.D. Cal. Sept. 8, 2015), *aff'd*, No. 2016-1054, 2016 WL 5956746 (mem) (Fed. Cir. Oct. 14, 2016).

The Appellant's arguments with respect to the step two determination have been considered and found unpersuasive as to error in the Examiner's

determination that claim 1 does not include an element or combination of elements sufficient to ensure that the claim 1 method in practice amounts to significantly more than an ineligible concept of "finding a group of consultants who can help a user seeking consulting help" (as the Examiner characterizes it) or "a specific method of data processing by which a data processing system maps a user input to a selected problem domain" (as the Appellant characterizes it) itself.

We have considered all of the Appellant's remaining arguments and have found them unpersuasive. Accordingly, because representative claim 1, and claims 2, 4–10, 12–17, 19 and 20 which stand or fall with claim 1, are directed to an abstract idea and do not present an "inventive concept," we sustain the Examiner's determination that they are directed to ineligible subject matter under 35 U.S.C. § 101. *Cf. LendingTree, LLC v. Zillow, In*c., 656 F. App'x 991, 997 (Fed. Cir. 2016) ("We have considered all of LendingTree's remaining arguments and have found them unpersuasive. Accordingly, because the asserted claims of the patents in suit are directed to an abstract idea and do not present an 'inventive concept,' we hold that they are directed to ineligible subject matter under 35 U.S.C. § 101.").

## DECISION

The decision of the Examiner to reject claims 1, 2, 4–10, 12–17, 19 and 20 is affirmed.

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