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EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHARLES MCGONIGAL, RUSSELL SALSBURY, SARITHA GUNTUMADUGU, MIKE NIEMANN, HERMANTH PUTTASWAMY, and SRINVASA OGIREDDY

Appeal 2016-007593
Application 12/615,476[1]
Technology Center 3600

Before ANTON W. FETTING, BIBHU R. MOHANTY, and CYNTHIA L. MURPHY, *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 of the Non-Final Act. rejection of claims 18–37 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.

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[1] According to Appellants, the real party in interest is International Business Machines Corporation. App. Br. 3.

THE INVENTION

The Appellants' claimed invention is directed to making recommendations to customers based on a variety of tracked customer behaviors (Spec. para. 9). Claim 18, reproduced below, is representative of the subject matter on appeal.

> 18. A method comprising:
>
> collecting data corresponding to monitored actions of a user of a web site, the monitored actions collected over a plurality of browsing sessions;
>
> identifying, with a server computer, at least one affinity product related to a target product, the identifying based on the monitored actions and a weighted formula;
>
> displaying, with the server computer, a preview of the at least one affinity product;
>
> modifying at least one weight of the weighted formula; and
>
> displaying, with the server computer, an updated preview showing any change in the at least one affinity product due to the modifying.

THE REJECTION

The following rejections is before us for review:

Claims 18–37 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[2].

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellants argue that the rejection of claim 18 is improper because the claim is not directed to an abstract idea (App. Br. 3–10, Reply Br. 2–11). The Appellants also argue that the claim is "significantly more" than any alleged abstract idea when considered as an ordered combination and further that the claim is "rooted in computer technology" (App. Br. 26–28, Reply Br. 6–11).

In contrast, the Examiner has determined that the rejection is proper (Non-Final Act. 2–16, Ans. 3, 4).

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: "[l]aws 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).

In judging whether claim 18 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*

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

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 2358.

Here, we determine that the claim is directed to the concept of displaying a related affinity product to a customer based on their actions. This is a fundamental economic practice long prevalent in our system of commerce or a method of organizing human activities and is an abstract idea beyond the scope of § 101. The Specification states that the "present invention relates to the providing recommendations for product purchases based on previous purchases or other behavior by a customer" (Spec. para. 2). The Specification at para. 9 also states the invention provides the ability to "make recommendations to customers based on a variety of tracked customer behaviors." *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. The Specification at para. 18 indicates a web site server is used over the Internet. The Specification at paras. 33 and 34 also describes using conventional RAM based services in a conventional manner.

Considering each of the claim elements in turn and as an ordered combination 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. Here, the claim is not rooted in computer technology but rather in the abstract concept of displaying a related affinity product to a customer based on their actions.

For these above reasons the rejection of claim 18, and its dependent claims which were not separately argued, is sustained. The remaining claims 26 and 34, and their dependent claims, are directed to similar subject matter and the rejection of these claims is sustained as well as similar arguments have been presented for these claims as well.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 18–37 under 35 U.S.C. § 101.

DECISION

The Examiner's rejection of claims 18–37 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)(iv).

AFFIRMED