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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MELVIN LEW, SYED HUSAIN,
PERRY FOTINATOS, and JOHN WOSCHINKO

Appeal 2016-007788
Application 11/853,576
Technology Center 3600

Before HUNG H. BUI, JOSEPH P. LENTIVECH, and
AARON W. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants seek rehearing of the August 28, 2017 Decision on Appeal (the "Decision"), wherein we affirmed the rejection of claims 1, 7, 10, 18, 19, and 25–29 under 35 U.S.C. § 101 and under 35 U.S.C. § 103(a) as unpatentable over Apte et al. in view of Official Notice.

We have reconsidered the Decision in light of Appellants' October 30, 2017 Request for Rehearing (the "Request"), but are not persuaded any points were misapprehended or overlooked. *See* 37 C.F.R. § 41.52.

ANALYSIS

Section 101 — Step 1

Appellants first argue their claims "are not *directed* to an abstract idea" because they "recite specific processes that use particular information and techniques and that are specifically designed to achieve a particular result." (Request 4.) Appellants then paraphrase the claim language in a bullet point list. (*Id.*) This is not an argument that was overlooked. It was made in the Appeal Brief on pages 10–11 (using the same bullet point list, but double spaced) and specifically addressed at pages 4–5 of the Decision. Nor is it an argument that, even on further consideration, is persuasive. Claims that manipulate and compare data—regardless of whether the manner of manipulation is "specific," or the data is of a "particular" type—are not eligible for patenting. (*See* Decision 3–4 (citing cases).)

This case is not like *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), or *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016). The *Enfish* claims were eligible because they recited a "self-referential table" that was "a specific type of data structure designed to improve the way a computer stores and retrieves data in memory." *Enfish*, 822 F.3d.at 1339. Appellants' claimed process does not "improve the way a computer stores and retrieves data in memory" or otherwise improve how the computer itself operates; instead, it uses conventional computer programming techniques to implement a system for reconciling inventory that otherwise could be done by hand. The claimed method in *McRo* "allow[ed] computers to produce 'accurate and realistic lip synchronization and facial expressions in animated characters' that previously could only be produced by human animators," providing "an

improved technological result in conventional industry practice." *Id.* at 1313, 1316. Appellants' claims are directed to an allegedly improved *business process*, not "an improved *technological* result." To accept Appellants' attempt to analogize their claims to the *Enfish* and *McRo* claims would be to find that virtually any method implemented on a computer is eligible, a position that cannot be squared with either *Alice* itself or increasingly voluminous Federal Circuit case law.

Appellants also argue "[t]he Decision overlooks the . . . argument that the claims cannot possibly be interpreted as covering any and all forms of the abstract idea and do not preempt the use of the alleged abstract idea." (Request 5.) The preemption argument is not persuasive because, although "preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility." *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). We are instructed that "[w]here a patent's claims are deemed only to disclose patent ineligible subject matter" under the *Alice/Mayo* framework, "preemption concerns are fully addressed and made moot." *Id.*

Section 101 — Step 2

For step 2, Appellants argue "[t]he elements recited in the claims show that the claims amount to significantly more than 'reconciling inventory,'" as "[f]or example, the actual elements recited in Claim 1 . . . involve applying dynamically changing exception data to prioritizing differences in data from different data sources." (Request 6.) We are not persuaded. The claims are directed to an abstract idea for how to reconcile inventory in which two data sets are compared, one is updated to match the other, and an exception is generated in the case of a mismatch, where the

exception is assigned an importance based on a condition, such as its age. We do not agree that any aspect of the claims is significantly more than the abstract idea itself. Appellants' argument that "[n]o cited references disclose or suggest the . . . elements of Claim 1 as recited in the overall combination of the claim" is not persuasive because "a claim for a new abstract idea is still an abstract idea." *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016).

Section 101 — Claim 10

Claim 10 adds to claim 1 "altering or implementing a workflow process to avoid exceptions of a same type as the generated exception." Appellants argue "[n]either the Examiner nor the Decision explains why the elements of Claim 10 do not amount to significantly more than the exception." (Request 8.) We do not agree with that assessment. We explained that altering or implementing a workflow process is simply an abstract idea (*see* Decision 6), which, necessarily, is not "significantly more." Further reflection only confirms that to be the case. The claim places no bounds on "workflow process," which therefore includes a set of steps contained only in a person's mind.[1] It is an abstraction, and not "significantly more," for a person to decide to do something in a different order, or in a different way. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) (explaining that "a method that

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[1] *See* Spec. ¶ 131 (describing how a "person may require that an asset be scanned . . . before the asset is powered on" or "that certain new assets (e.g., new servers) are only delivered to a particular location (e.g., the server room)").

can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101").

Section 103

Appellants argue "[t]he Decision has not demonstrated that assigning and varying at least one importance level to generated exception data . . . is in any way related to aging of help desk or service desk tickets" and "the Decision has overlooked the difference between an aging asset and an aging task." (Request 10.) We are not persuaded that anything was overlooked because, as we explained, "Appellants' focus on the specific 'help desk' context of the Examiner's example is too narrow." (Decision 7.) We agree with the Examiner's finding that the general concept of prioritizing older items was widely known and that it would have been obvious to vary the importance level of an exception based upon age.

DECISION

We grant Appellants' request to reconsider our Decision, but deny the request that the Decision be modified. Our Decision is final for purposes of judicial review. *See* 37 C.F.R. § 41.52(a)(1).

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).

DENIED