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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHEW J. SMITH

Appeal 2017-000254
Application 13/633,507
Technology Center 3600

Before MURIEL E. CRAWFORD, HUBERT C. LORIN, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1, 7–9, 11–14, 16 and 18–20. We have jurisdiction over the appeal under 35 U.S.C. § 6(b). Appellant appeared for an Oral Hearing on September 10, 2018.

BACKGROUND

Appellant's invention is directed to a system and method of ranking job candidates. Spec. 1

Claim 1 is illustrative:

1. A method of ranking job candidates using human-based assessments, including the steps of:

- a) providing a computer having a memory and including input means for inputting information to said computer, and a display, and loading said computer with software for operating said method;
- b) providing a server connecting said computer to a global computer network;
- c) providing a website accessible to said computer via said global computer network and server whereby said software facilitates displaying images from said website on said display, said website including:
 - i) a main page with links to secondary pages, clicking on said links facilitating access to said secondary pages;
 - ii) said secondary pages including:
 - A) a first page in which an employer can input information so that said computer can create and register an employer profile;
 - B) a second page in which an employer can input information so that said computer can create a contest challenge;
 - C) a third page in which job candidates can input identifying information about themselves;
 - D) a fourth page where said identifying information concerning job candidates who have participated in a contest challenge may be displayed by said computer;

- E) a fifth page on said website and causing said computer to display on said fifth page employer profiles;
- F) a sixth page associated with said second page, where an employer can cause said computer to specify registration and voting time periods and deadlines, said sixth page where said computer can be caused by said employer to designate a contest challenge one of public or private;
- d) employers creating employer profiles on said first page by inputting said profiles into said computer memory via said server;
- e) a website operator using said input means to cause said computer to save said employer profiles in said memory to register said employer profiles;
- f) job candidates providing said identifying information on said third page by inputting said identifying information including their background and credentials into said computer memory via said server;
- g) said website operator using said input means to cause said computer to save said identifying information in said memory to register said job candidates;
- h) at least one employer creating a skills-based contest challenge, said contest challenge being saved by said website operator in said memory by inputting said contest challenge into said computer via said server;
- i) facilitating access to said contest challenge by registered job candidates including causing said computer to display said contest challenge on said display;
- j) registered job candidates competing in said contest challenge and causing said computer to save, in said memory, results from said registered job candidates competing in said contest challenge;

- k) said website operator facilitating human-based assessments of contest challenge entries provided by job candidates, said human-based assessments being conducted by a plurality of eligible authorized voters voting on said contest challenge entries, said eligible authorized voters including a combination of employers, other users, third party industry professionals and neutral judges; and
- l) causing said computer to display on said display, on said fourth page of said website, job candidates who have won contest challenges based upon said human-based assessments, display of said job candidates including identification of contest challenge entry by each respective job candidate and a ranking of contest challenge entries based upon total number of votes received from eligible authorized voters.

The Examiner relies on the following prior art reference as evidence of unpatentability

Speiser et al.	US 2007/0244570 A1	Oct. 18, 2007
Jeon	US 2007/0269786 A1	Nov. 22, 2007
MacDaniel et al.	US 2009/0070126 A1	Mar. 12, 2009

Appellant(s) appeal the following rejection(s):

Claims 1, 7–9, 11–14, 16 and 18–20 under 35 U.S.C. § 101 because the claimed invention is directed to a judicial exception.

Claims 1, 7–9, 11–14, 16 and 18–20 under 35 U.S.C. § 103(a) as unpatentable over MacDaniel, in view of Jeon, and further in view of Speiser.

PRINCIPLES OF LAW

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 implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347, 2354 (2014).

In determining whether a claim 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.*, 566 U.S.72–73 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. *See Alice*, 134 S. Ct. at 2356 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (“Analyzing respondents’ claims according to the above statements from our cases, we think that a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter.”); *Parker v. Flook*, 437 U.S. 584, 594–595 (1978) (“Respondent’s application simply provides a new and presumably better method for calculating alarm limit values.”); *Gottschalk v. Benson*, 409 U.S. 63, 64 (1972) (“They claimed a method for converting binary-coded decimal (BCD) numerals into pure binary numerals.”).

The patent-ineligible end of the spectrum includes fundamental economic practices, *Alice*, 134 S. Ct. at 2357; *Bilski*, 561 U.S. at 611; mathematical formulas, *Parker*, 437 U.S. at 594–95; and basic tools of scientific and technological work, *Gottschalk*, 409 U.S. at 69. On the patent-eligible side of the spectrum are physical and chemical processes, such as curing rubber, *Diamond*, 450 U.S. at 184 n.7, “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores,” and a process for manufacturing flour, *Gottschalk*, 409 U.S. at 69.

If the claim is “directed to” a patent-ineligible abstract idea, we then consider the elements of the claim—both individually and as an ordered combination—to assess whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2355. 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.*

In addition, the Federal Circuit has held that if a method can be performed by human thought alone, or by a human using pen and paper, it is merely an abstract idea and is not patent-eligible under § 101. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) (“[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.”).

Claims involving data collection, analysis, and display are directed to an abstract idea. *Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent ineligible concept”); *see also In re TLI Comma ‘ns*

LLC Patent Litig., 823 F.3d 607, 611 (Fed. Cir. 2016); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093-94 (Fed. Cir. 2016).

Claims that recite an improvement to a particular computer technology have been found patent eligible. *See, e.g., McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314–15 (Fed. Cir. 2016) (determining claims not abstract because they “focused on a specific asserted improvement in computer animation”).

The ultimate determination of eligibility is a question of law, however, “[t]he patent eligibility inquiry may contain underlying issues of fact.” *Berkheimer v. HP*, 881 F.3d 1360, 1365 (quoting *Mortg. Grader, Inc. v. First Choice Loan Inc.*, 811 F.3d 1314, 1325 (Fed. Cir. 2016) (“The § 101 inquiry ‘may contain underlying factual issues’”). The court in *Berkheimer* also held “[w]hen there is no genuine issue of material fact regarding whether the claim element or claimed combination is well-understood, routine, [or] conventional to a skilled artisan in the relevant field, this issue can be decided on summary judgment as a matter of law.” *Berkheimer*, 811 F.3d at 1368. Thus, evidence may be helpful where, for instance, facts are in dispute, but evidence is not always necessary.

ANALYSIS

Rejection under 35 U.S.C. §101

The Examiner determines that the claims are directed to a series of steps instructing how to rank job candidates who participate in skills-based contests using human-based assessments. The Examiner determines that the claims are directed to (1) organizing information through mathematical

correlations; (2) creating, storing and facilitating a skills-based contest challenge; (3) managing a game which consists of mental steps which can be carried out by a human using pen and paper; and (3) organizing human activity. Final Act. 4.

We agree with the Examiner's determination that the claims are directed to an abstract idea. In addition, from our review of claim 1, for example, we determine that the claim is essentially directed to (1) collection of data such as employer profiles, information about a contest challenge, and job candidate information; (2) displaying data such as information concerning job candidates who have participated in a contest challenge, (3) storing data such as employer profiles and contestant information and (4) analyzing data such as facilitating human based assessments of contest challenge entries. Therefore the claim is directed to the collection, analysis, storage and display of data and is directed to an abstract idea on this basis as well.

We additionally note that the Appellant has acknowledged that the claims include a patent-ineligible concept. Br. 28.

The Examiner finds that the generically recited computer elements recited in the claims do not add meaningful limitations to the abstract idea. The Examiner further finds that the claims recite a general purpose computer having a memory, input means, a display and software and that internet access is provided to the computer in a routine way of a server connecting the computer to a global computer network and that accessing a website with various webpages would be routine in any computer implementation. Final Act. 4. In regard to the use of the Internet, the Examiner finds that merely reciting the use of the Internet to perform a business practice of evaluating

job candidates using human assessments is merely and attempt to limit the use of the abstract idea to a particular technological environment. The Examiner finally finds that the claims simply instruct the practitioner to implement the abstract idea with routine, conventional activity. Final Act. 5. We agree with these findings of the Examiner and note that Appellant has not argued that the operations of the computers, server, and global computer network are not well-understood, routine, and conventional to a skilled artisan in the relevant field.

We are not persuaded of error on the part of the Examiner by Appellant's argument that the claims recite a solution to an Internet-centric problem and resolve that problem in a specific way and effect an improvement to the technical field of screening candidates for employment. In making this argument, the Appellant relies on *DDR Holdings, LLC v. Hotels.com, L.P.* 773 F.3d 1245 (Fed. Cir. 2014).

In *DDR*, the Court determined that a claim may amount to more than any abstract idea recited in the claims when it addresses a business challenge, such as "retaining website visitors," where that challenge is particular to a specific technological environment, such as the Internet. In *DDR*, the court stated that "the [] patent's claims address the problem of retaining website visitors that, if adhering to the routine, conventional functioning of Internet hyperlink protocol, would be instantly transported away from a host's website after 'clicking' on an advertisement and activating a hyperlink." *DDR Holdings*, 773 F.3d at 1257. This was done in the claim by serving a composite page with content based on the link that was activated to serve the page.

In contrast, the process of claim 1 ranks job candidates using a contest challenge. The problem addressed is providing a method enabling an employer to determine which candidates are the most talented as it relates to specific job capabilities. Spec. 42. These most talented candidates are identified by use of talent based competitions to win prizes and more job interviews etc. Using a contest to identify the most talented candidates is not a solution to a technical problem but a solution to a business problem. That computers and servers may assist with administrating the contest is not pertinent to determining whether the claim itself provides a technical solution to a technical problem. And, unlike the situation in *DDR Holdings*, we find no indication in the record, nor does Appellant point us to any indication, that the computer, server, memory or the Internet recited in claim 1 is used other than in its normal, expected, and routine manner, e.g., for receiving and transmitting information.

We are also not persuaded of error on the part of the Examiner by Appellant's argument that the automated process of the claims effects an improvement in the technical field of hiring employees nowhere previously accomplished with or without use of a computer and the method of the claims solves a specific problem in an extremely unique way. Br. 29–30. To the extent Appellant maintains that the limitations of claim 1 necessarily amount to “significantly more” than an abstract idea because the claimed apparatus is allegedly patentable over the prior art, Appellant misapprehends the controlling precedent. Although the second step in the *Alice/Mayo* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for “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. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 79, 78.

Appellant likewise is not persuasive of error on the part of the Examiner by the argument that the claims recite significantly more than any abstract idea because in the absence of the present invention, communication or contest entries to a variety of judging parties would entail utilizing U.S. Mail or facsimile, among other possibilities, and the process of receiving scores from all the parties would extend dramatically. Br. 29. Although the computer may make the judging process faster, the fact that the required voting could be performed more efficiently via a computer and the Internet does not materially alter the patent eligibility of the claimed subject matter *See Bancorp Services, L.L.C. v. Sun Life Assurance Co. of Canada (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012).

In the Reply Brief, the Appellant argues that the claims are analogous to those found eligible in *Enfish LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016). Reply 5. However, there is a fundamental difference between computer functionality improvements, on the one hand, and uses of existing computers as tools to perform a particular task, on the other. Indeed, in *Enfish*, the Federal Circuit applied this distinction in rejecting a § 101 challenge because the claims at issue focused on a specific type of data structure, i.e., a self-referential table for a computer database, designed to improve the way a computer carries out its basic functions of storing and retrieving data, and not merely on asserted advances in uses to which existing computer capabilities could be put. *Enfish*, 822 F.3d at 1335–36.

We find no parallel here between the claims before us and the claims in *Enfish* nor any comparable aspect in the claims before us that represents “an improvement to computer functionality,” i.e., an improvement in the way a computer carries out its basic functions. *Id.* The alleged advantages that Appellant argue do not concern an improvement to computer capabilities, but instead relate to an alleged improvement in voting for candidates for which a computer is used as a tool in its ordinary capacity--that is, providing processing technology to execute computer programs that, in turn, receive and manipulate the selected data.

In view of the foregoing, we will sustain the Examiner’s rejection of claim 1 under 35 U.S.C. §101. We will also sustain this rejection as it is directed to the other claims subject to this rejection because the Appellant does not argue the separate patent eligibility of these claims.

Rejection under 35 U.S.C. §103(a)

We are not persuaded of error on the part of the Examiner by Appellant’s argument that neither MacDaniel nor Jeon discloses a contest challenge. We agree with the Examiner that as MacDaniel discloses at paragraphs 49–51 an open job for which candidates compete by submitting resumes with the intention of being hired over other candidates, MacDaniel does disclose a contest. Final Act. 6. In addition, Jeon also discloses at paragraph 1 an open job for which candidates compete and discloses that this competition explicitly employs a game.

We are also not persuaded of error on the part of the Examiner by Appellant’s argument that the teachings the Examiner proposes to modify are not included in MacDaniel until they are provided by Jeon and thus this seriously calls into question whether the Examiner has set forth a *prima*

facie case for obviousness. Br. 33. We know of no precedent, and the Appellant has not cited any, which establishes that modifying a secondary reference by a tertiary reference calls into question an obviousness determination.

In any case, the Examiner relies on Jeon for *explicitly* teaching an employer creating a contest challenge and Speiser for teaching registration and voting time periods and deadlines for contests. Fin. Act. 10. However, we agree with the Examiner that the disclosure of a contest challenge to obtain a job is taught by MacDaniel. Therefore a person of ordinary skill in the art would have had a reason to modify MacDaniel with the teachings in Speiser because any job application process (contest challenge) as taught by MacDaniel would employ voting time periods and deadlines.

In view of the foregoing, we will sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a). We will also sustain this rejection as it is directed to claims 7, 8, 12, 13, 14, 16, and 18-20 because the Appellant advance the same or similar arguments regarding the patentability of these claims as was advanced in regard to the rejection of claim 1.

We will not sustain the Examiner's rejection of claim 9 under 35 U.S.C. § 103(a). Claim 9 is dependent from claim 1 and also recites "said employer causing said computer to specify a number of votes within a time period." The Examiner relies on paragraphs 43 and 44 of Speiser for teaching this subject matter. These paragraphs of Speiser relate to who can be a voter for contestants and how the votes may be cast but do not disclose that an employer specifies a number of votes within a time period.

Appellant argues, in regard to the rejection of claim 11, that the relied on portion of Jeon discloses that a person is a candidate for an interview as

opposed to the definitive statement that a job interview has been awarded as is recited in claim 11. Br. 40. We agree with the Examiner that the disclosure in paragraph 74 of Jeon that a user is selected as a final candidate for interview is a recitation that a job interview has been awarded. Therefore, we will sustain the Examiner's rejection of claim 11 under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner's § 101 rejection.

We also affirm the Examiner's § 103 rejection of claims 1, 7, 8, 11–14, 16 and 18–20.

We do not affirm the Examiner's §103 rejection of claim 9.

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1) (2009).

ORDER

AFFIRMED