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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/831,257	07/31/2007	Krithika Seetharaman	10171-366US1	4117
75158	7590	07/09/2018	EXAMINER	
Verint Systems, Inc. Meunier Carlin & Curfman, LLC 999 Peachtree Street NE Suite 1300 Atlanta, GA 30309			MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER
			3683	
			NOTIFICATION DATE	DELIVERY MODE
			07/09/2018	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KRITHIKA SEETHARAMAN, JASON FAMA,
MICHAEL ROBERT BOURKE, and RICHARD M. LAWRENCE

Appeal 2017-000974¹
Application 11/831,257²
Technology Center 3600

Before BIBHU R. MOHANTY, NINA L. MEDLOCK, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–16 and 18–21. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellants’ Appeal Brief (“Br.,” filed April 25, 2016) and the Examiner’s Answer (“Ans.,” mailed August 18, 2016) and Final Office Action (“Final Act.,” mailed September 24, 2015).

² Appellants identify Verint Systems, Inc. of Melville, New York as the real party in interest. Br. 3.

CLAIMED INVENTION

Appellants' claimed invention "relates to strategic forecasting for customer centers, and more particularly, to generating strategic forecasts that take into account variations in demand" (Spec. ¶ 2).

Claims 1, 8, and 14 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A computer-implemented method of strategic forecasting of demand for a customer center, the method comprising:

- receiving demand data for a past date range;
- determining a future date range for a strategic forecast;
- processing the future date range to determine a variant;
- processing the past date range to determine that the variant is not included in the past date range;
- determining a variant date range that includes the variant;
- receiving historical data for the variant date range;
- computing a variant factor associated with the variant based on the historical data for the variant date range, wherein the variant factor comprises a ratio of a measure of demand on a date associated with the variant to an average of past demand at corresponding non-variant dates;
- computing seasonality factors for the future date range based on the demand data for the past date range; and
- generating the strategic forecast for the future date range based on the variant factor and the seasonality factors.

REJECTION

Claims 1–16 and 18–21 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

ANALYSIS

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).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp.*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78).

The Court acknowledged in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. Therefore, the Federal Circuit has instructed that claims are to be considered in their entirety to determine “whether their character as a whole is directed to excluded subject matter.” *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

In rejecting claims 1–16 and 18–21 under 35 U.S.C. § 101, the Examiner determined that the claims are directed to “forecasting demand for a customer center,” i.e., to mathematical formulas/relationships, and, therefore, to an abstract idea; that the additional elements or combination of elements in the claims other than the abstract idea per se “amounts to no more than: (i) mere instructions to implement the idea on a computer, and/or (ii) recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the pertinent industry”; and that “[v]iewed as a whole, these additional claim elements do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself” (Final Act. 4–5).

Focusing on step one of the *Mayo/Alice* framework, Appellants charge that the § 101 rejection cannot be sustained because the Examiner has provided no facts and/or evidence to support the Examiner’s determination that “forecasting demand for a customer center” is an abstract idea (Br. 7–9); therefore, according to Appellants, “a *prima facie* show[ing] has not . . . been established by the Examiner under the first prong test of *Alice*” (*id.* at 10). We disagree.

There is no requirement that an examiner provide evidentiary support in every case before a conclusion can be made that a claim is directed to an abstract idea.³ Nor, contrary to Appellants’ suggestion (*id.* at 9), did this

³ See, e.g., para. IV “July 2015 Update: Subject Matter Eligibility,” available at <https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf> (“The courts consider the determination of whether a claim

Board hold in *Ex parte Renald Poisson*, Appeal 2012-011084 (PTAB Feb. 27, 2015), that there is any such requirement.⁴ Although evidence may be helpful, e.g., where facts are in dispute, it is not always needed. *See Mortgage Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325–26 (Fed. Cir. 2016) (“[I]t is also possible, as numerous cases have recognized, that a § 101 analysis may sometimes be undertaken without resolving fact issues.”). Appellants’ bare assertion that evidence is needed here, without any supporting reasoning as to why, is insufficient to require the Examiner to provide evidentiary support.⁵

The Federal Circuit, moreover, has repeatedly observed that “the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). The court has, thus, held that the USPTO carries its procedural burden of establishing a prima facie case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for the rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (alteration in original).

is eligible (which involves identifying whether an exception such as an abstract idea is being claimed) to be a question of law. Accordingly, courts do not rely on evidence that a claimed concept is a judicial exception, and in most cases resolve the ultimate legal conclusion on eligibility without making any factual findings.”).

⁴ We would not be bound, in any event, by a non-precedential decision of another panel of the Board.

⁵ We note that the Appellants have put forward no rebuttal evidence showing the claims are not directed to an abstract idea.

Thus, all that is required of the Office is that it sets forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. *Id.*; *see also Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (“Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

The Examiner set forth the statutory basis of the rejection here in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. And we find that, in doing so, the Examiner set forth a proper rejection under § 101 such that the burden shifted to Appellants to demonstrate that the claims are patent-eligible.

Turning to the second step of the *Mayo/Alice* framework, Appellants assert that the claims “do not merely state an abstract idea and apply it with a process that comprises of solely conventional steps known in the art” (Br. 11). Appellants maintain that the evidence of record instead “shows that the claimed steps are not ‘well-understood’ and ‘conventional’ steps performed in present industry practice” (*id.*). Yet, to the extent Appellants maintain that the steps recited in the claims are not “well-understood” and/or “conventional” because the claims are allegedly novel and/or non-obvious, i.e., “because no § 102 or § 103 rejection remains” (*id.* (“If the steps recited in the claims are novel, then the steps recited in the claims cannot be said to be merely ‘conventional’ steps performed in present industry practice.”))), Appellants misapprehend the controlling precedent.

A finding of novelty or non-obviousness does not automatically lead to the conclusion that the claimed subject matter is patent-eligible. Although the second step in the *Mayo/Alice* 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 Corp.*, 134 S. Ct. at 2355 (citation omitted). “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90; *see also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (“The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.”).

Finally, for much the same reasons set forth above, we are not persuaded that the Examiner failed to establish a prima facie case of patent-ineligibility with respect to dependent claims 2–7, 9–13, 15, 16, and 18–21. Appellants assert that a prima facie case has not been established because the Final Office Action “provides no discussion whatsoever regarding *any* of the limitations recited in the dependent claims” (Br. 13). Yet, the Examiner clearly addressed the subject matter recited in the dependent claims together with the subject matter recited in independent claims 1, 8, and 14, and the Examiner determined that the claims, generally, are directed to “forecasting demand for a customer center” (Final Act. 4–5).

We decline to find error in the Examiner’s decision not to recite each dependent claim limitation and address its patent-eligibility separately. *See Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat.*

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Ass'n, 776 F.3d 1343, 1348 (Fed. Cir. 2014) (explaining that when all claims are directed to the same abstract idea, “addressing each claim of the asserted patents [is] unnecessary.”). Aside from asserting that dependent claims 2–7, 9–13, 15, 16, and 18–21 were not addressed individually by the Examiner, Appellants offer no separate arguments for the patent-eligibility of these dependent claims.

We are not persuaded, on the present record, that the Examiner erred in rejecting claims 1–16 and 18–21 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection.

DECISION

The Examiner’s rejection of claims 1–16 and 18–21 under 35 U.S.C. § 101 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