# UNITED STATES PATENT AND TRADEMARK OFFICE

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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* NANCY V. LANG, YUMIKO CHRISTINE YOKOI,
STEVEN K. CHU, ANDREW PHILIP GILLIBRAND and
CHAU HA LEUNG

_____

Appeal 2017-001223
Application 13/149,593
Technology Center 3600

_____

Before ROBERT E. NAPPI, CATHERINE SHIANG, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.


DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
rejection of claims 1, 7, 9–14, 16, 17, and 19–24, which are all the claims
pending and rejected in the application. We have jurisdiction under 35
U.S.C. § 6(b). We affirm.


STATEMENT OF THE CASE

*Introduction*

According to the Specification, the present invention relates to
software for accessing and organizing information in stored documents, such

as employee performance review documents. *See generally* Spec. 1. Claim

1 is exemplary:

      1.    A processor implemented method for controlling association of displayed feedback comments with performance review categories and sub-categories executed by a server system coupled to a plurality of clients over a network, the method comprising:

      receiving employee identification data pertaining to an employee being reviewed from a first data record;

      receiving feedback information including a plurality of words formed into one or more sentences independently authored by each of a plurality of independent reviewers pertaining to the employee from a second data record;

      in response to the employee identification data and the feedback information, generating a graphical user interface having a plurality of display regions defining a performance review display;

      in response to the employee identification data and the feedback information, arranging the plurality of display regions into at least two display windows positioned within the graphical user interface to visually convey an association between the employee identification data, the feedback information displayed, and a feedback quality indicator associated with at least some of the feedback information;

      in response to a selection signal, parsing the feedback information into selected portions of the feedback information forming fragmented sentences;

      rendering in the graphical user interface a first user option to visually distinguish the selected portions of the feedback information;

      displaying in a second window of the graphical user interface and in response to user input, a list of performance review categories and performance review subcategories relating to employee performance;

      associating in response to a user input, the selected portions of the feedback information with a selected performance review category or a performance review subcategory;

      displaying in a third window of the graphical user interface in response to user input indicating the selected performance review category or performance review subcategory and the employee, a set of the selected portions of the feedback information associated with the selected performance review category or sub-category; and

      in response to the selected performance review category or performance review subcategory, visually arranging the set of selected

portions of the feedback information to accentuate the association between the employee identification data and the set of selected portions of the feedback information displayed to visually distinguish and accentuate a relationship between the employee identification data, the selected performance review category or performance review subcategory, and the set of selected portions of the feedback information displayed.

*References and Rejections*

| | | |
|---|---|---|
| Levin | US 2003/0101091 A1 | May 29, 2003 |
| Dave | US 2007/0078671 A1 | Apr. 5, 2007 |
| Guo | US 2011/0209043 A1 | Aug. 25, 2011 |

Claims 1, 7, 9–14, 16, 17, and 19–24 are rejected under 35 U.S.C. § 101 because they are directed to patent-ineligible subject matter.

Claims 1, 7, 9–14, 16, 17, and 19–23 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Levin (US 2003/0101091 A1; published May 29, 2003) and Dave (US 2007/0078671 A1; published Apr. 5, 2007).

Claim 24 is rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Levin, Dave, and Guo (US 2011/0209043 A1; published Aug. 25, 2011).

PRINCIPLES OF LAW

"[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (citation omitted).

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (citation omitted).

The "mere disclosure of alternative designs does not teach away" and "just because better alternatives exist in the prior art does not mean that an inferior combination is inapt for obviousness purposes." *In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012) (citations omitted).

> Although a reference that teaches away is a significant factor to be considered in determining unobviousness, the nature of the teaching is highly relevant, and must be weighed in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.

*In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

## ANALYSIS

We disagree with Appellant's arguments, and agree with and adopt the Examiner's findings and conclusions in (i) the action from which this appeal is taken (Final Act. 3–13) and (ii) the Answer (Ans. 2–17) to the extent they are consistent with our analysis below.[1]

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[1] To the extent Appellants advance new arguments in the Reply Brief without showing good cause, Appellants have waived such arguments. *See* 37 C.F.R. § 41.41(b)(2).

*35 U.S.C. § 101*

The Examiner rejects the claims under 35 U.S.C. § 101 because they are directed to patent-ineligible subject matter. *See* Final Act. 3–4; Ans. 2–3, 13. In particular, the Examiner determines the claims are directed to the abstract idea of organizing human activity. *See* Ans. 2. The Examiner determines the claims use generic computer components to perform generic computer functions. *See* Ans. 3. Appellants argue the Examiner erred. *See* App. Br. 12–13; Reply Br. 4.

Appellants have not persuaded us of error. Section 101 of the Patent Act provides "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." 35 U.S.C. § 101. That provision "'contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.'" *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). According to the Supreme Court:

> [W]e set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . If so, we then ask, "[w]hat else is there in the claims before us?" . . . To answer that question, we consider the elements of each 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. . . . We have described step two of this analysis as 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 Corp.,* 134 S. Ct. at 2355.

The Federal Circuit has described the *Alice* step-one inquiry as
looking at the "focus" of the claims, their "character as a whole," and the
*Alice* step-two inquiry as looking more precisely at what the claim elements
add—whether they identify an "inventive concept" in the application of the
ineligible matter to which the claim is directed. *See Elec. Power Grp., LLC
v. Alstom S.A.,* 830 F.3d 1350, 1353 (Fed. Cir. 2016); *Enfish, LLC v.
Microsoft Corp.,* 822 F.3d 1327, 1335–36 (Fed. Cir. 2016); *Internet Patents
Corp. v. Active Network, Inc.,* 790 F.3d 1343, 1346 (Fed. Cir. 2015).

Regarding *Alice* step one, the Federal Circuit has "treated *collecting
information,* including when limited to particular content (which does not
change its character as information), as within the realm of abstract ideas."
*Elec. Power,* 830 F.3d at 1353 (emphasis added); *see also Internet Patents,*
790 F.3d at 1348–49; *OIP Techs., Inc. v. Amazon.com, Inc.,* 788 F.3d 1359,
1363 (Fed. Cir. 2015); *Content Extraction & Transmission LLC v. Wells
Fargo Bank, Nat'l Ass'n,* 776 F.3d 1343, 1347 (Fed. Cir. 2014). "In a
similar vein, we have treated *analyzing information* by steps people go
through in their minds, or by mathematical algorithms, without more, as
essentially mental processes within the abstract-idea category." *Elec.
Power,* 830 F.3d at 1354 (emphasis added); *see also In re TLI Commc'ns
LLC Patent Litig.,* 823 F.3d 607, 613 (Fed. Cir. 2016). "And we have
recognized that *merely presenting the results of abstract processes of
collecting and analyzing information, without more* (such as identifying a

particular tool for presentation), is abstract as an ancillary part of such collection and analysis." *Elec. Power*, 830 F.3d at 1354 (emphasis added); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714–15 (Fed. Cir. 2014).

The rejected claims "fall into a familiar class of claims 'directed to' a patent-ineligible concept." *Elec. Power*, 830 F.3d at 1353. Contrary to Appellants' arguments (App. Br. 12–13; Reply Br. 4), the claims are similar to the claims of *Electric Power,* and are focused on the combination of abstract-idea processes or functions. *See Elec. Power*, 830 F.3d at 1354. For example, claim 1 is directed to receiving or collecting information ("receiving . . . "), and analyzing and displaying information ("generating . . .; arranging . . .; parsing . . .; rendering . . .; displaying . . .; associating . . .; visually arranging . . . ."). Claim 19 is an apparatus claim directed to performing similar functions. Similarly, claim 20 is directed to receiving or collecting information ("receiving . . . "), and analyzing and displaying information ("generating . . .; arranging . . .; parsing . . .; rendering . . .; displaying . . .; associating . . .; visually arranging . . . ."). *See Elec. Power*, 830 F.3d at 1353. The dependent claims are directed to similar functions or processes, and Appellants have not shown such claims are directed to other non-abstract functions or processes. *See* claims 7, 9–14, 16, 17, and 21–24.

Appellants' assertion regarding pre-emption (App. Br. 12–13) is unpersuasive, because "[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility . . . . Where a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot." *Ariosa*

*Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP*, 788 F.3d at 1362–63 ("that the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract").

Regarding *Alice* step two, contrary to Appellants' assertion (App. Br. 12–13; Reply Br. 4), Appellants have not shown the claims in this case require an arguably inventive set of components or methods, or invoke any assertedly inventive programming. *See Elec. Power*, 830 F.3d at 1355.

Further, contrary to Appellants' arguments (App. Br. 12–13; Reply Br. 4), the claims are similar to the claims of *Electric Power*, because they do not require any nonconventional computer, network, or display components, or even a "non-conventional and non-generic arrangement of known, conventional pieces," but merely call for performance of the claimed information collection, analysis, and display functions on generic computer components and display devices. *See Elec. Power*, 830 F.3d at 1355; *see also* Claim 1 (reciting "[a] processor . . . a server system coupled to a plurality of clients over a network"); Claim 19 (reciting "a digital processor coupled to a display and to a processor-readable storage device"); Claim 20 (reciting a "processor-readable storage device . . . a digital processor"). The dependent claims call for similar generic components and devices, and Appellants have not shown such claims require any non-conventional components or devices. *See* claims 7, 9–14, 16, 17, and 21–24.

Similar to the claims of *Electric Power*, the rejected claims specify what information is desirable to gather, analyze, and display, but they "do not include any requirement for performing the claimed functions of gathering, analyzing, and displaying . . . by use of anything but entirely

conventional, generic technology." *Elec. Power*, 830 F.3d at 1355.
Therefore, similar to the claims of *Electric Power*, the rejected claims "do
not state an arguably inventive concept in the realm of application of the
information-based abstract ideas." *Elec. Power*, 830 F.3d at 1356.

In short, Appellants have not shown the claims, read in light of the
Specification, require anything other than conventional computer, network,
and display technology for collecting, analyzing, and presenting the desired
information. *See Elec. Power*, 830 F.3d at 1354. Such invocations of
computers and networks are "insufficient to pass the test of an inventive
concept in the application" of an abstract idea. *See Elec. Power*, 830 F.3d
at 1355.

In the Reply Brief and for the first time, Appellants belatedly argue
the claimed limitations are unlike traditional user interfaces. *See* Reply
Br. 4. Appellants have waived such arguments because they are untimely,
and Appellants have not demonstrated any "good cause" for the belated
presentation. *See* 37 C.F.R. § 41.41(b)(2).

Because Appellants have not persuaded us the Examiner erred, we
sustain the Examiner's rejection of claims 1, 7, 9–14, 16, 17, and 19–24
under 35 U.S.C. § 101.

*Obviousness*

On this record, the Examiner did not err in rejecting claim 1.

I

Appellants contend "Levin . . . does not discloses [sic] selectively
using and freely associating the feedback and fragmented portions of the

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feedback to the review as desired" (App. Br. 14) and "neither Levin nor Dave provides a means, tool, or process, to allow the user to selectively and freely associate portions of sentences to an employee review as desired." App. Br. 14–15.

The above arguments are unpersuasive because they are not commensurate with the scope of the claims. Further, because the Examiner relies on the combination of Levin and Dave to teach claim 1, Appellants cannot establish nonobviousness by attacking the references individually. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

The Examiner finds—and Appellants do not dispute—Dave teaches "in response to a selection signal, parsing the feedback information into selected portions of the feedback information forming fragmented sentences." *See* Final Act. 8. Therefore, Dave teaches "the selected portions of the feedback information," and Levin does not need to separately teach that element. Further, the Examiner determines Levin and Dave collectively teach

> associating in response to a user input, the selected portions of the feedback information with a selected performance review category or a performance review subcategory;
>
> . . .
>
> visually arranging the set of selected portions of the feedback information to accentuate the association between the employee identification data and the set of selected portions of the feedback information displayed to visually distinguish and accentuate a relationship between the employee identification data, the selected performance review category or performance review subcategory, and the set of selected portions of the feedback information displayed;

as recited in claim 1. *See* Final Act. 6–8. Appellants do not analyze the majority of the reference portions cited by the Examiner, and do not critique the Examiner's specific findings regarding those limitations. Therefore, Appellants fail to show Examiner error.[2]

## II

Appellants contend each of Levin and Dave teaches away from the claim and, as a result, the references are not combinable. *See* App. Br. 14–16; Reply Br. 5. In particular, Appellants assert Levin teaches away from fragmenting comments, and Dave teaches away from "a user deciding which fragmented comment may be associated with a review." App. Br. 15; *see also* App. Br. 14, 16; Reply Br. 5.

Appellants' teaching-away argument is unpersuasive because Appellants fail to provide adequate analysis under the case law. For example, Appellants do not show the cited references criticize or discourage the proposed combination. In short, Appellants fail to assert—let alone show—one skilled in the art "would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *Kahn*, 441 F.3d at 990.

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[2] Appellants also list the entire claim 1, and assert the cited references do not teach the limitations. *See* App. Br. 15–16. Appellants' general assertion is unpersuasive of error. *See* 37 C.F.R. § 41.37(c)(1)(iv) ("A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim."); *see also In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (holding that "the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art").

Further, as discussed above, Dave teaches "the selected portions of the feedback information," and Levin does not need to separately teach that element. In addition, as discussed above, Appellants fail to show the Examiner erred in determining Levin and Dave collectively teach "associating . . . the selected portions of the feedback information with a selected performance review category or a performance review subcategory."

Because Appellants have not persuaded us the Examiner erred, we sustain the Examiner's rejection of independent claim 1, and independent claims 19 and 20 for similar reasons.

## Separately Argued Dependent Claims

Regarding dependent claim 7, Appellants contend:

> as described above Levin discloses receiving feedback in *verbatim form* and does not disclose associating selected portions of the feedback information with one or more performance review categories.

App. Br. 16.

As discussed above, because the Examiner relies on the combination of Levin and Dave to teach the claim, Appellants cannot establish nonobviousness by attacking the references individually. *See Merck & Co.,* 800 F.2d at 1097. As discussed above, Appellants' arguments regarding claim 1 are unpersuasive. Therefore, we also sustain the Examiner's rejection of claim 7.

Regarding dependent claims 9–14, 16, 17, and 21–23, Appellants advance arguments similar to those discussed above with respect to claim 7. *See* App. Br. 17–19. Therefore, for similar reasons discussed above with

respect to claims 1 and 7, we sustain the Examiner's rejection of dependent claims 9–14, 16, 17, and 21–23.

> Regarding dependent claim 24, Appellants contend:
>
> Thus, by providing a sentiment summary object, and not disclosing a means, tool, or process to allow a user to select portions of comments authored by independent reviewers and associated such selected portions of comments with an employee's review, Guo does not make up for what Levin and Dave lack as discussed supra.
> . . .
> Guo is cited to disclose this feature at . . . of Guo in view of Levin with the addition of . . . Dave. However, as discussed supra Guo does not disclose allowing a user to select portions of independently authored comments for association with an employee review.

App. Br. 20.

Because the Examiner relies on the combination of Levin, Dave, and Guo to teach claim 24, Appellants cannot establish nonobviousness by attacking the references individually. *See Merck & Co.*, 800 F.2d at 1097. As discussed above, Appellants' arguments regarding Levin and Dave are unpersuasive. Further, Appellants' arguments regarding Guo are not directed to the Examiner's specific findings, because the Examiner determines Levin, Dave, and Guo collectively teach claim 24 (Final Act. 11–13). Therefore, Appellants fail to show Examiner error.

Accordingly, we sustain the Examiner's rejection of dependent claim 24.

## DECISION

We affirm the Examiner's decision rejecting claims 1, 7, 9–14, 16, 17, and 19–24.

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). *See* 37 C.F.R. § 41.50(f).

## AFFIRMED