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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEAN-MICHEL LEON, ANSELM PAUL BAIRD-SMITH, and
LOUIS MARCEL GINO MONIER

Appeal 2017-001982¹
Application 11/241,883²
Technology Center 3600

Before JOSEPH A. FISCHETTI, BIBHU R. MOHANTY, MICHAEL W. KIM,
Administrative Patent Judges.

KIM, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellants appeals from the Examiner's decision to reject claims 1–23, 37 and 37. We have jurisdiction under § 6(b).

We AFFIRM.

¹ We reference the Specification (“Spec.,” filed Sept. 22, 2009), Appeal Brief (“App. Br.,” filed Mar. 2, 2016), and Reply Brief (“Reply Br.,” filed Nov. 21, 2016), as well as the Examiner’s Answer (“Ans.,” mailed Sept. 9, 2016) and Final Office Action (“Final Act.,” mailed May 15, 2015).

² According to the Appeal Brief, the real party in interest is EBAY INC. Appeal Br. 2.

SUBJECT MATTER ON APPEAL

The invention “relates generally to the technical field of data communication.” Spec. ¶ 2. More specifically, the invention contemplates “methods and system [sic] to facilitate searching a data resource,” which is “used by sellers and buyers that transact items in a network-based marketplace.” Spec. ¶¶ 2, 6.

Claims 1, 12, and 23 are the independent claims on appeal. Independent claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method to facilitate searching items in a network-based marketplace, the method including:

presenting, by the network-based marketplace, an interface to author, by a seller, an item listing for an item that is being offered for sale on the network-based marketplace, the item listing to present the item to a buyer when viewing the item in the network-based marketplace, the item listing including an item description authored by the seller, the network-based marketplace being a computer implemented system coupled to a network to interact with user devices to perform item transactions between users of the network-based marketplace, the users of the network-based marketplace including sellers and buyers, the seller being one of the sellers and the buyer being one of the buyers, the sellers being those who offer items for sale on the network-based marketplace, and the buyers being those browsing the network-based marketplace;

receiving, by the network-based marketplace from the interface, the item description;

evaluating, by the network-based marketplace in response to receipt of the item description, the item description with an expression from a rule, the rule including the expression and supplemental information, the expression evaluating to true for the item description, the rule being stored in a first data resource of the network-based marketplace prior to receipt of the item description;

supplementing, by the network-based marketplace in response to the rule evaluating to true, the item description by adding the supplemental information to the item description for the item listing to create a supplemental item description for the item listing; and

storing, by the network-based marketplace, the supplemental item description for the item listing in a second data resource of the network-based marketplace, the evaluating, supplementing and storing performed in real time, using one or more processors, to facilitate search of the item description and the supplemental information in real time.

REJECTIONS

Claims 1–23, 36 and 37 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

Claims 1–23, 36, and 37 stand rejected under pre-AIA 35 U.S.C. 103(a) as unpatentable over *Clendinning et al.*³ in view of *Subramanian et al.*⁴.

ISSUE

Two issues are before the Board on Appeal: (1) has the Examiner erred in rejecting the claims under 35 U.S.C. § 101; and (2) has the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a) as unpatentable over Clendinning in view of Subramanian.

ANALYSIS

Claims 1–23, 36 and 37 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

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

³ Clendinning, US Patent Application Publication No. 2013/0198183 (pub. Aug. 1, 2013).

⁴ Subramanian, US Patent Application Publication No. 2002/0123912 (pub. Sept. 5, 2002).

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. 66, 77–78 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *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 following method is then used to determine whether what the concept the claim is “directed to” is an abstract idea:

[T]he decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided. *See, e.g., Elec. Power Grp. [v. Alstom S.A.]*, 830 F.3d [1350,] 1353–54 [(Fed. Cir. 2016)]. That is the classic common law methodology for creating law when a single governing definitional context is not available. *See generally* Karl N. Llewellyn, *The Common Law*

Tradition: Deciding Appeals (1960). This more flexible approach is also the approach employed by the Supreme Court. *See Alice*, 134 S. Ct. at 2355–57. We shall follow that approach here.

Amdocs (Israel) Limited v. Openet Telecom, Inc., 841 F.3d 1288, 1294 (Fed. Cir. 2016) (footnote omitted).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 134 S. Ct. at 2357; *Bilski*, 561 U.S. at 611); mathematical formulas (*Flook*, 437 U.S. at 594–95); and mental processes (*Benson*, 409 U.S. at 69). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diehr*, 450 U.S. at 192), “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores” (*id.* at 184 n.7 (citing *Corning v. Burden*, 56 U.S. 252, 267–268 (1854))), and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

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.*

The Appellants argue claims 1–23 and 36–37 as a group. Appeal Br. 11–14; Reply Br. 2–4. We select independent claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds claim 1 directed to “tagging an item listing with more common descriptive information in order to facilitate searching, or indexing a list

of items by category.” Final Act. 10. The Examiner then explains that this concept “is the same as the fundamental economic practice of organizing products by category information in a catalog, simply utilized in electronic form within the field of digital commerce.” Final Act. 10. The Examiner further compares the claims at issue to, among other cases, those in *Intellectual Ventures I LLC v. Erie Indem. Co.*, 134 F. Supp. 3d 877 (W.D. Pa. 2015). The Examiner underscores that, in *Intellectual Ventures I*, claims directed to “the abstract idea of gathering, storing, and acting on data based on predetermined rules,” and “retrieving information from a database using ‘an index of XML tags and metafiles,’” was found ineligible as “directed to the abstract idea ‘of creating an index and using that index to search for and retrieve data.’” Ans. 4.

The Appellants argue that the Examiner’s comparison is incorrect, and that the “claims are directed to improving computer search technology” analogous to those determined to be patent eligible, for example, in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016). Appeal Br. 14; Reply 3. We agree with the Examiner.

Specifically, we agree with the Examiner’s determination that the Appellants’ claims are directed to “tagging an item listing with more common descriptive information in order to facilitate searching, or indexing a list of items by category.” Final Act. 10. Representative claim 1 includes assigning supplemental information to an item listing— authored through its interface—and stores that supplemental information to “facilitate a search of the item description and the supplemental information in real time.” The specification explains further that this supplemental information, or item classification information, may include “a domain, classification tags, and inference tags.” Spec. ¶ 90. As noted by the

Examiner, these tags represent more common descriptive information that the invention uses to facilitate searching items by category.

We further agree with the Examiner that the claims at issue are similar to the claims found ineligible in *Intellectual Ventures I*. Like the claims in *Intellectual Ventures I*—which were found to be directed to the concept “gathering, storing, and acting on data based on predetermined rules,” which are an abstract idea—the current claims review the item listings, authored through its interface; supplement, based on a set of rules, the item listings with supplemental information to create a supplemental item description; and store that supplemental item description. We agree with the Examiner that these steps, like the ones in *Intellectual Ventures I*, constitute no more than the abstract idea of “gathering” information, “acting on data based on predetermined rules,” and “storing” that information.

By contrast, we are unpersuaded by the Appellants’ argument that its claims are directed to an improvement in computer technology like those in *Enfish*. In *Enfish*, the invention at issue was directed at a wholly new type of logical model for a computer database: a self-referential table that allowed the computer to store many different types of data in a single table and index that data by column and row information. *Enfish*, 822 F.3d at 1330–32. In finding the claims “not directed to an abstract idea,” but “to a specific improvement to the way computers operate,” the Federal Circuit noted that “the claims are not simply directed to *any* form of storing tabular data, but instead are specifically directed to a *self-referential* table for a computer database.” 822 F.3d at 1336–37 (emphasis in original).

Unlike the claims at issue in *Enfish*, we find the current invention not directed to any specific thing that improves computer functionality. The Appellants appear to be asserting that the following combination of limitations constitute computer operations “resulting in the creation, use, and manipulation of

specialized data structures in a computer system”: “evaluating, by the network-based marketplace an expression from a rule,” “supplementing, by the network-based marketplace . . . the item description by adding the supplemental information,” and “storing . . . the item listing in a second data resource.” App. Br. 13. The problem, however, is that the Appellants do not identify anything that is a computer-specific operation similar to the self-referential table of *Enfish*. For example, we are unpersuaded that “evaluating . . . an expression from a rule” is computer-specific – as claimed, it is nothing more than a mental process step, with instructions to “apply it” to a network-based marketplace. In another example, we are unpersuaded that the “second data resource” is computer-specific when the particulars of how the “second data resource” stores is not specified. The same analysis can be applied to the Appellants’ comparisons to *McRO*, and *Bascom*. Reply Br. 4.

Because we are unpersuaded that the Examiner erred in asserting that the claims are directed to an abstract idea, we turn next to *Alice* step 2 and assess whether the claims recite additional elements that transform the nature of the claim into a patent-eligible application of the abstract idea.

Under *Alice* step 2, the Examiner finds that the claims at issue “amount to nothing more than a 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.” Final Act. 10–11.

The Appellants conversely argue that the claims “recite[] an unconventional combination of elements that confine the claim to a particular useful application other than what is well-understood, routine and conventional in the field.” Appeal Br. 13. For example, the Appellants assert that the claims “include[] the presentation of an authoring interface to permit users to create item listings” that

are “then texted and manipulated to include additional, or supplemental information . . . [and] stored with the item description to enhance searching of the listings.” Appeal Br. 13–14. The problem, however, is that the only item listed above that can be considered an additional element to the abstract idea is the “authoring interface,” but that term does not appear in the claims. Of course, the term “interface” does appear, however, the purportedly unconventional functions attributed to the “interface,” such as “permit users to create item listings” and “include additional, or supplemental information” are part of the abstract idea of “tagging an item listing with more common descriptive information in order to facilitate searching, or indexing a list of items by category.”

For these reasons, we sustain the Examiner’s rejection of claims 1–23, 36, and 37 under 35 U.S.C. § 101 as patent in-eligible subject matter.

Claims 1–23, 36 and 37 rejected under 35 U.S.C. § 103(a) as obvious over Clendinning in light of Subramanian

The Examiner rejected claims 1–23 and 36–37 under 35 U.S.C. § 103(a) as obvious over a combination of Clendinning and Subramanian. Final Act. 11. The Appellants assert that neither Clendinning nor Subramanian disclose any of “modifying the item description for the listing,” “vendors being presented with a user interface to enter an item listing,” and “the information is actually a listing (because one must travel to the vendor themselves to purchase any item).” Appeal Br. 15–22; Reply Br. 4–5. We address each assertion in turn.⁵

⁵ We note that the Appellants only argue independent claim 1 specifically, and also assert that “[i]ndependent claims 12 and 23 recite subject matter similar to that argued above with respect to claim 1 and are also allowable for the reasons given above. Dependent claims 2–11, 13–22 and 36–37 ultimately depend from one of allowable independent claims 1 or 12 and thus are also allowable.” Appeal Br. 15–22; Reply Br. 4–5. Accordingly, we also select independent claim 1 as representative. See 37 C.F.R. § 41.37(c)(1)(iv).

For “modifying the item description for the listing,” the Examiner responds that “the features upon which applicants rely (i.e., ‘providing an authoring platform to allow the seller to enter the item listing,’ and ‘editing the entered listing itself,’) are not recited in the rejected claims.” Final Act. 5. The Examiner believes that the “Appellants [are] confusing this [modifying listings] feature with the ‘supplementing’ or ‘supplemental information’ limitations”—both which, the Examiner finds, are disclosed in Clendinning. Ans. 7. As an initial matter, we agree with the Examiner that it is unclear what the Appellants are asserting. In any case, however, even when we read the Appellants’ assertion in light a most favorable to them, we still agree with the Examiner. Specifically, even when the Appellants are given the benefit of the doubt that they meant “supplementing,” which is recited in the claim, instead of “modifying,” which is not, the Appellants’ assertion are unpersuasive.

Essentially, it appears the Appellants are asserting that “supplementing” means “modifying,” i.e., changing an item in a data field from a pre-existing notation to another notation, and not “adding,” i.e., appending information. We are unpersuaded the Appellants are correct. Beginning with claim language, independent claim 1 recites “supplementing, . . . in response to the rule evaluating to true, the item description *by adding* the supplemental information to the item description.” Accordingly, by its own express claim language, “supplementing” is “adding.” The specification is consistent with this understanding. For example, the specification discloses that “the received information (e.g., item information 120) *is supplemented with* supplemental information (e.g., item classification information 131). Instances of item classification information 131 may include a domain 130, classification tags 97, and inference tags 99.” Spec. ¶ 90 (emphasis added). The passive use “is supplemented with” is more consistent with “adding”

than “modifying.” Indeed, further down from that, the specification discloses “[a]dding classification tags 97 to the tagged item information 93 structures the item information 120” Spec. ¶ 90. It goes without saying that the use of the term “adding” is more consistent with “adding” than “modifying.” By contrast, the Appellants have not identified any example in the specification where anyone “supplements” a listing by “modifying” it.

Under that construction of “supplementing,” we find that Clendinning that expressly discloses “adding” additional information as follows: “The data may be subsequently *combined* with additional information collected from other sources.” Clendinning ¶ 35 (emphasis added). “The information collected will typically contain one or more product identifiers.” *Id.* ¶ 44. On those bases, we agree with the Examiner that Clendinning discloses “supplementing by the network-based marketplace in response to the rule evaluating to true, the item description by adding the supplemental information to the item description for the item listing to create a supplemented item description for the item listing.”

In response to Appellant’s second assertion that Clendinning does not “mention . . . vendors being presented with a user interface to enter an item listing,” Appeal Br. at 18, the Examiner responds that “the claim is not directed to a ‘vendor interface’ but to ‘an interface to author by a seller an item listing.’” Appellant’s disclosure does not disclose or otherwise describe a ‘vendor’ or ‘vendor interface.’” Ans. at 5 (internal citation omitted). Analogous to our analysis of “supplementing,” we agree with the Examiner.

Specifically, while independent claim 1 does recite “an interface to author, by a seller, an item listing” we are unpersuaded that this is the same as a vendor interface, as the Appellants appear to advance. Beginning again with claim language, by its own terms, independent claim 1 does not recite “vendor,” and the

Appellants have not explained sufficiently a relationship between “vendor” and “seller” that would indicated otherwise. The specification is consistent with this understanding, as it only refers to “seller” and not “vendor” with respect to the interface. *See, e.g.*, Spec. ¶ 72 (“[a]uthoring/publishing applications, in the example form of the listing creation applications 60, allow authors/publishers sellers conveniently to author information (e.g., listing pertaining to goods or services that they wish to transact via the computer-based system 12), and application management applications (e.g., listing management applications 62) allow authors/publishers to manage such published information.”).

For the corresponding disclosure in Clendinning for the limitation of “an interface to author, by a seller, an item listing,” the Examiner asserts the following:

Cited portions of the reference describe a merchant using a merchandising system to enter and store item information in a database and author an item listing for display to shoppers. *See at least Clendinning* ¶ 0014–0016. An objective consideration of the reference clearly shows that it is the merchant that is equivalent to the presently claimed seller. *See also Clendinning* ¶ 0036 (describing a human operator manually collecting item information from various sources including a vendor, and loading this information into the aforementioned database).

Ans. 6. The Appellants reply as follows:

Cited paragraphs 14–16 of Clendenning merely describe how users store their own data or put it on the web. This section of Clendenning, *e.g.*, paragraph 17, also then expresses how these techniques don’t work well. The Answer also cites a section of Clendenning (paragraph 36) that describes an employee of the marketplace manually entering other people’s data.

Reply Br. 5. We agree with the Examiner’s assessment of the cited portions of Clendinning as more accurate.

With respect to the Appellants’ argument that Clendinning does not disclose a “listing . . . because one must travel to the vendor themselves to purchase any

item” (App. Br. 18), the argument is misplaced because the Appellants have not shown how the claim language requires this. All independent claim 1 recites is “the sellers being those who offer items for sale on the network-based marketplace, and the buyers being those browsing the network-based marketplace” which does not preclude the actual sale being conducted at another location.

Finally, the Appellants assert that Subramanian does not remedy the aforementioned deficiencies of Clendinning. We are unpersuaded, however, that Clendinning is deficient for the reasons set forth above.

For these reasons, we sustain the Examiner’s rejection of claims 1–23, 36, and 37 under 35 U.S.C. § 103 as unpatentable over Clendinning in view of Subramanian.

DECISION

We AFFIRM the rejection of claims 1–23, 36, and 37 under 35 U.S.C. § 101 as directed to abstract ideas and the rejection of claims 1–23, 36, and 37 under 35 U.S.C. § 103(a).

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