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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DMITRY CHECHUY

Appeal 2017-003504
Application 13/651,955¹
Technology Center 3600

Before BIBHU R. MOHANTY, MEREDITH C. PETRAVICK, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–10 and 27–46. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM, designating the affirmance of the rejection under 35 U.S.C. § 101 as a NEW GROUND OF REJECTION, and also impose a NEW GROUND OF REJECTION under 35 U.S.C. § 112(b).

¹ The Appellant identifies CBS Interactive Inc. as the real party in interest. Appeal Br. 1.

ILLUSTRATIVE CLAIM

1. A method executed by one or more computing devices for managing a product catalog, the method comprising:

determining, by at least one of the one or more computing devices, whether two or more product listings have different unique product identifiers, wherein the two or more product listings comprise at least a portion of the product catalog;

analyzing, by at least one of the one or more computing devices, at least a portion of the two or more product listings based at least in part on a determination that the two or [sic] product listings have different unique product identifiers to determine whether the two or more product listings refer to an identical product; and

de-duplicating, by at least one of the one or more computing devices, the two more or product listings based at least in part on a determination that the two or more product listings refer to an identical product.

REJECTIONS

I. Claims 1–10 and 27–46 are rejected under 35 U.S.C. § 101 as ineligible subject matter.

II. Claims 1, 2, 8–10, 27, 28, 34–38, and 44–46 are rejected under 35 U.S.C. § 102(e) as anticipated by Tromble (US 8,655,737 B1, iss. Feb. 18, 2014).

III. Claims 3–5, 7, 29–31, 33, 39–41, and 43 are rejected under 35 U.S.C. § 103(a) as unpatentable over Tromble and Tenorio et al. (US 2008/0059335 A1, pub. Mar. 6, 2008) (“Tenorio”).

IV. Claims 6, 32, and 42 are rejected under 35 U.S.C. § 103(a) as unpatentable over Tromble, Tenorio, and Mock et al. (US 2008/0232885 A1, pub. Sept. 25, 2008) (“Mock”).

FINDINGS OF FACT

The findings of fact relied upon, which are supported by a preponderance of the evidence, appear in the following Analysis.

ANALYSIS

Subject-Matter Eligibility (New Ground of Rejection)

Laws of nature, natural phenomena, and abstract ideas are deemed ineligible for patenting, because they are regarded as the basic tools of scientific and technological work, such that their inclusion within the domain of patent protection would risk inhibiting future innovation premised upon them. *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013). Of course, “[a]t some level, ‘all inventions . . . embody, use, reflect, rest upon, or apply’” these basic tools of scientific and technological work. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014). Accordingly, ascertaining ineligible subject matter involves a two-step framework for “distinguish[ing] between patents that claim the buildin[g] block[s] of human ingenuity and those that integrate the building blocks into something more, thereby transform[ing] them into a patent-eligible invention.” *Id.* (internal quotation marks and citation omitted). The first step determines whether the claim is directed to judicially excluded subject matter (such as a so-called “abstract idea”); the second step determines whether there are any “additional elements” recited in the claim that (either individually or as an “ordered combination”) amount to “significantly more” than the identified judicially excepted subject matter itself. *Id.* at 2355.

The “directed to” inquiry of the first *Alice* step “applies a stage-one filter to claims, considered in light of the specification, based on whether

‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). Notably, in such an inquiry, a claim may be characterized properly, in various ways, because “[a]n abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). Because the first step is consequential — among other things, framing the terms for what may (or may not) constitute meaningful claim elements, for the second *Alice* step — it must strike an appropriate balance between opposing concerns. Describing a claim in broad and vague terms might make it appear, by comparison, that insignificant claim elements should be sufficient to establish patent eligibility, under the second *Alice* step. By contrast, hewing too closely to the recited details might undermine any sense that the claim really threatens to cover a “basic tool[] of scientific and technological work,” *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972), that would merit the exclusion from patenting.

We determine that independent claims 1, 27, and 37 are directed to the abstract idea of ***correlating two or more different identifiers for the same item***. This abstract idea is consistent with the focus of the claims. For example, claim 1 recites steps of determining whether product listings have different unique product identifiers, analyzing whether the product listing refer to an identical product, and de-duplicating (e.g., removing product listings that refer to an identical product). This focus is consistent with the Specification’s description of the purpose of the invention as “reduction in duplication and redundancy amongst product listings or a product catalog.” Spec. ¶ 8.

In regard to the second *Alice* step, the claimed elements that the Appellant proposes as constituting “significantly more” than the abstract

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idea (*see* Appeal Br. 9–14, Reply Br. 5–8) are simply features that result from applying the abstract idea to the technological context of an online product catalog, or that amount to post-solution activity, neither of which cannot give rise to patent-eligibility. *See Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (“[T]he prohibition against patenting abstract ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or adding ‘insignificant postsolution activity’”) (quoting *Diamond v. Diehr*, 450 U.S. 175, 191–92 (1981)).

For example, other than the abstract idea itself (i.e., correlating items having two or more identifiers for the same item) claim 1 recites only the features of “execut[ion] by one or more computing devices,” a “product catalog” having “product listings” and “unique product identifiers” that refer to “product[s]” (some of which may be “identical”), and “de-duplicating . . . the . . . product listings.” The claimed features of “computing devices” and a “product catalog” having “product listings” and “product identifiers” do no more than provide a particular technological context — an online product catalog — for implementing the abstract idea. *See Alice*, 134 S. Ct. at 2358 (“[L]imiting the use of an abstract idea to a particular technological environment” is “not enough for patent eligibility.”) (internal citations and quotation omitted); *Bilski*, 561 U.S. at 610–11; *Elec. Power Grp., LLC v. Alstom, SA*, 830 F.3d 1350, 1354 (Fed Cir. 2016) (“[L]imiting the claims to the particular technological environment of power-grid monitoring is, without more, insufficient to transform them into patent-eligible applications of the abstract idea at their core.”); *Ultramarcial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014) (“Narrowing the abstract idea of using advertising as a currency to the Internet is an ‘attempt[] to limit the use’ of

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the abstract idea ‘to a particular technological environment,’ which is insufficient to save a claim.’”) (quoting *Alice*, 134 S. Ct. at 2358).

The claimed step of “de-duplicating, by at least one of the one or more computing devices, the two more or product listings” may be accomplished, for example, by “linking or consolidating product listings,” “removing some product listings,” or “flagging some product listings for removal.” Spec.

¶ 28. The “de-duplicating” step also amounts to no more than the application of the abstract idea in a computer-based catalog environment and, furthermore, this step may be regarded as a post-solution activity (i.e., after determining that “the two or more product listings refer to an identical product,” as claimed) that cannot confer patent eligibility to claim 1. *See Bilski*, 561 U.S. at 610–11; *Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1328–29 (Fed. Cir. 2017) (“While limiting the index to XML tags certainly narrows the scope of the claims, in this instance, it is simply akin to limiting an abstract idea to one field of use or adding token post solution components that do not convert the otherwise ineligible concept into an inventive concept.”)

Moreover, the “BACKGROUND” portion of the Specification indicates that the features other than the abstract idea itself — i.e., the elements particular to the implementation of an online computer-based product catalog — are conventional, well-understood, and generic: “Online commerce sites often utilize online product catalogs that list products from numerous manufacturers and providers. The online catalogs typically include product listings for individual products.” Spec. ¶ 2. Because these features — not only individually, but also their ordered combination, as practiced — are generic and conventional, they cannot amount to significantly more than the identified abstract idea, such that claim 1 is not

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patent-eligible. *See Alice*, 134 S. Ct. at 2358 (“[W]holly generic computer implementation is not generally the sort of ‘additional featur[e]’ that provides any ‘practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.’”) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 77 (2012)).

Accordingly, for the reasons discussed above we sustain the rejection of claims 1–10 and 27–46 under 35 U.S.C. § 101. Although we sustain this rejection, because we depart from the Examiner’s reasoning, we designate this aspect of the Decision as a new ground of rejection, under 37 C.F.R. § 41.50(b).

Anticipation

The Appellant contends that claims 1, 2, 8–10, 27, 28, 34–38, and 44–46 were rejected incorrectly, as being anticipated, because Tromble does not teach the requirement of independent claims 1, 27, and 37 to analyze “at least a portion of the two or more product listings based at least in part on a determination that the two or [sic] product listings have different unique product identifiers to determine whether the two or more product listings refer to an identical product.” *See* Appeal Br. 8–10.

The proper construction of the claimed expression “unique product identifiers,” which the Specification defines, resolves this issue. The Specification states:

Numerous examples provided herein refer to a “manufacturer part number” or “MPN,” which are examples of ***unique product identifiers***. Other examples of ***unique product identifiers*** include Universal Product Code (“UPC”), International Standard Book Number (“ISBN”), European Article Number (“EAN”) or Japanese Article Number (“JAN”).

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Id. ¶ 17 (emphasis added). This sense — i.e., that the claimed “unique product identifiers” are any of a number codes that explicitly identify a particular product in commercial contexts — is reinforced by, e.g., dependent claim 10, which recites:

10. The method of claim 1, wherein the unique product identifiers of the two or more product listings comprise one of manufacturer part number ([“]MPN[”]), Universal Product Code (“UPC”), International Standard Book Number (“ISBN”), European Article Number (“EAN”) or Japanese Article Number (“JAN”).

Thus a particular “product listing[],” as claimed, may have a plurality of “different unique product identifiers” (e.g., an ISBN and a JAN) that refer to the same product.

The portion of Tromble identified in the rejection, as purportedly disclosing the determination of whether two product offers relate to the same product (*see* Answer 7), does not specify that such a product must have a plurality of “different unique product identifiers,” as claimed:

For each pair of product offers that include an acceptable brand pair, the analysis module **125** evaluates other attributes of the pair of product offers to determine whether the pair of product offers relate to the same product. For example, the analysis module **125** may evaluate titles for the products of the two product offers, model numbers and other product identifiers, product description, price, and/or any other information associated with the two product offers.

Tromble col. 5, ll. 26–34.

Therefore, we are persuaded of error in the anticipation rejection, such that we do not sustain the rejection of claims 1, 2, 8–10, 27, 28, 34–38, and 44–46 under 35 U.S.C. § 102(e).

Obviousness

The obviousness rejections rely upon the findings set forth in the anticipation rejection, regarding the teachings of Tromble. *See* Final Action 9, 10. Accordingly, for the same reason set forth above, we do not sustain the rejection of claims 3–7, 29–33, and 39–43 under 35 U.S.C. § 103(a).

Indefiniteness
(New Ground of Rejection)

Each of independent claims 1, 27, and 37 requires the analysis of “at least a portion of the two or more product listings based at least in part on a determination that the two or [sic] product listings have different unique product identifiers to determine whether the two or more product listings refer to an identical product.”

The identified limitations appear to be missing a word or words (such as the word “more”) that renders the meaning of the limitation unclear. Accordingly, pursuant to 37 C.F.R. § 41.50(b), we issue a new ground of rejection for independent claims 1, 27, and 37, as well as their dependent claims 2–10, 28–36, and 38–46, under 35 U.S.C. § 112(b), for failing to point out and distinctly claiming the subject matter that the Appellant regards as the invention.

DECISION

We AFFIRM the Examiner’s decision rejecting claims 1–10 and 27–46 under 35 U.S.C. § 101, designating this affirmance as a NEW GROUND OF REJECTION under 37 C.F.R. § 41.50(b).

We REVERSE the Examiner’s decision rejecting claims 1, 2, 8–10, 27, 28, 34–38, and 44–46 under 35 U.S.C. § 102(e).

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We REVERSE the Examiner's decision rejecting claims 3–7, 29–33, and 39–43 under 35 U.S.C. § 103(a).

Pursuant to 37 C.F.R. § 41.50(b), we add a NEW GROUND OF REJECTION for claims 1–10 and 27–46 under 35 U.S.C. § 112(b).

This Decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in MPEP § 1214.01.

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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; 37 C.F.R. § 41.50(b)