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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* JOHN F. BONNER, EVAN T. RILES,  
GEORGE P. BONNE, IAN ERICKSON,  
and ANDREW NEBLETT

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Appeal 2017-003754  
Application 13/327,972  
Technology Center 3600

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Before ST. JOHN COURTENAY III, LARRY J. HUME, and  
JOYCE CRAIG, *Administrative Patent Judges*.

CRAIG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants<sup>1</sup> appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1, 3–10, 12–15, 17–19, 22, and 24, which are all of the claims pending in this application.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> According to Appellants, the real party in interest is Thomson Reuters Global Resources. App. Br. 2.

<sup>2</sup> Claims 2, 11, 16, 20, 21, and 23 have been cancelled. Final Act. 2.

## INVENTION

Appellants' application relates to predicting initial public offering opportunities. Abstract. Claim 1 reads as follows:

1. A computer-implemented method for identifying a marketing opportunity comprising:

receiving a set of search criteria for identifying a set of privately-held entities;

identifying the set of privately held entities in response to electronically receiving the set of search criteria;

executing an activity module for computing an activity value computed using one or more data items maintained in at least one of an inventor data store, a deals data store, a market data store and a company data store in order to identify a number of entities having initiated an initial public offering (IPO) over a first time interval in a same industry as each privately-held entity of the set of privately-held entities as compared to the total number of privately-held entities within the set of privately-held entities, wherein the inventor data store, the deals data store, the market data store and the company data store are each a composite from one or more disparate sources;

executing a prediction module for computing a set of prediction scores based on a funding value, a profitability value, a growth value, a market level value, and the activity value associated with each privately-held entity of the set of privately-held entities, the growth value being based on a sales growth ratio associated with each of the privately-held entities;

executing the prediction module for associating the set of prediction scores with the set of privately-held entities to generate the associated set of scores and entities, the set of prediction scores and the set of privately-held entities having a one to one relationship within the associated set of scores and entities, wherein each predictive score of the associated set of scores and entities indicates a likelihood of initiating an (IPO);  
and

transmitting to the access device the associated set of scores and entities for display in a graphical user interface.

#### REJECTION

Claims 1, 3–10, 12–15, 17–19, 22, and 24 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to a judicial exception without significantly more. Final Act. 2.

#### ANALYSIS

We have reviewed the rejection of claims 1, 3–10, 12–15, 17–19, 22, and 24 in light of Appellants’ arguments that the Examiner erred. We have considered in this decision only those arguments Appellants actually raised in the Briefs. Any other arguments Appellants could have made, but chose not to make, in the Briefs are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Appellants’ arguments are not persuasive of error. We agree with and adopt as our own the Examiner’s findings of facts and conclusions as set forth in the Answer (Ans. 2–5) and in the Action from which this appeal was taken (Final Act. 4–7). We provide the following explanation for emphasis.

#### *Rejection of Claims 1, 3–10, 12–15, 17–19, 22, and 24 under § 101*

Appellants contend the Examiner erred in rejecting the pending claims as directed to patent-ineligible subject matter. *See* App. Br. 8. Appellants argue claims 1, 3–10, 12–15, 17–19, 22, and 24 as a group (*id.* at 7), and we choose claim 1 as representative of the group. *See* 37 C.F.R. § 41.37(c)(1)(iv).

In *Alice*, the Supreme Court sets forth an analytical “framework 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. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355

(2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012)). The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* (citing *Mayo*, 566 U.S. at 77–78). If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “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). In other words, the second step is to “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.’” *Id.* (brackets in original) (quoting *Mayo*, 566 U.S. at 72–73). The prohibition against patenting an abstract idea “‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or adding ‘insignificant postsolution activity.’” *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (citation omitted).

Turning to the first step of the *Alice* inquiry, we agree with the Examiner that claim 1 is directed to the abstract idea of computing a score and comparing new and stored information, which can be performed mentally and is “an idea of itself.” See Final Act. 2 (citing *SmartGene, Inc. v. Adv. Bio. Labs., SA*, 555 Fed. App’x 950 (Fed. Cir. 2014)) (non-precedential). In *SmartGene*, the Federal Circuit concluded the claims were ineligible because they did “no more than call on a ‘computing device,’ with basic functionality for comparing stored and input data and rules, to do what doctors do routinely.” *SmartGene*, 555 Fed. App’x at 954.

Appellants argue the Examiner’s analysis “oversimplified the claim” by ignoring the “substantive transformative steps undertaken in determining and subsequently transmitting a set of scores for predicting which privately held company will go public.” App. Br. 8–9. Appellants specifically point to “limitations of techniques for analyzing the likelihood of IPO opportunities,” such as computing an activity value, computing a set of prediction scores, and generating an associated set of prediction scores and entities. *Id.* at 9–10. Appellants analogize those limitations to the “rules” in *McRO, Inc. v. Bandai Namco Games America, Inc.*, 837 F.3d 1299 (Fed. Cir. 2016), arguing the claim limitations improve “the existing technological process by allowing the determination of the likelihood of IPO opportunities.” Reply Br. 6.

We are not persuaded of Examiner error. In *McRO*, the claimed process used a combined order of specific rules that rendered information in a specific format that was applied to create a sequence of synchronized, animated characters. *McRO*, 837 F.3d at 1315. Notably, the recited process automatically animated characters using particular information and techniques—an improvement over manual three-dimensional animation techniques that was not directed to an abstract idea. *Id.* at 1316.

Unlike in *McRO*, the recited “prediction module” is not a rule-based improvement of a technological process. The *McRO* court determined that *McRO*’s claim was not directed to an abstract idea because it “uses the limited rules in a process specifically designed to achieve an improved technological result” over “existing, manual 3-D animation techniques.” *McRO*, 837 F.3d at 1316.

In contrast, Appellants' claims address identifying a business and marketing opportunity by executing a predictive module to generate scores and associations. *See* Spec. 2. Additionally, the claims in *McRO* were drawn to improvements in the operation of a computer at a task, rather than applying a computer system to perform generic data manipulation steps, as in Appellants' claim 1. *See McRO*, 837 F.3d at 1314.

For these reasons, we agree with the Examiner that the claims are directed to the abstract concept of computing a score and comparing new and stored information, which is similar to what courts have found abstract in *SmartGene* and *Electric Power Group, LLC v. Alstom Ltd.*, 830 F.3d 1350, 1351–52 (Fed. Cir. 2016).

Turning to the second step of the *Alice* inquiry, we find nothing in claim 1 that adds anything “significantly more” to transform the abstract concept of computing a score and comparing new and stored information into patentable subject matter. *Alice Corp.*, 134 S. Ct. at 2357.

We are not persuaded by Appellants' argument that claim 1 is patent-eligible due to the recitations of specific computer components. App. Br. 10 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014)). Appellants' Specification describes the recited computer components in a generic manner. *See* Spec. 4–6, 17. Thus, we discern no error in the Examiner's conclusion that the computer is simply a tool (*see* Ans. 5), or that the prediction module is software stored on a server comprising of a processor, random access memory, input/output and non-volatile memory. Final Act. 3. Appellants also have not identified improvements to the functioning of the computer itself, or meaningful

limitations that do more than generally link the use of the abstract idea to a particular technological environment.

Appellants also rely on *Bascom Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), arguing that

a specific, discrete implementation of the alleged abstract idea (i.e., collecting data, analyzing data using a prediction module and displaying results), the particular arrangement of the claimed elements is a technical improvement to the traditional analysis by individuals in industries and provides for a more accurate computed method as opposed to the traditional instinctive methods.

Reply Br. 6–8.

In *Bascom*, the Federal Circuit held “[t]he inventive concept described and claimed in the ’606 patent is the installation of a filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each end user.” *Bascom*, 827 F.3d at 1350. In determining this feature to be an inventive concept, the Federal Circuit explained that the remote location of a filtering tool having customizable user-specific filtering features provides the filtering tool both the benefits of a filter on a local computer and the benefits of a filter on the ISP server and is a technical improvement over prior art ways of filtering content. *Id.* at 1350–51. Notably, the Federal Circuit specifically determined that “the claims may be read to ‘improve[] an existing technological process.’” *Id.* at 1351 (citing *Alice*, 134 S. Ct. at 2358). The Federal Circuit emphasized that the claims of the ’606 patent are a technical solution that improves computer technology. *See id.*

In considering the instant claims individually and as an ordered combination, we fail to see how the specific steps recited in the claims

improve the functioning of a computer or some other technology. Instead, we conclude the steps of the claimed method are directed to generating a set of predictive scores and associations, in which the steps may be performed by any generic computer with appropriate programming. App. Br. 9–10. However, “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 134 S. Ct. at 2358.

Consequently, the claims do not recite something apart from the generic computer implementation of the abstract idea of computing a score and comparing new and stored information, which is not an inventive concept sufficient to confer patent-eligibility. *Id.* at 10–11.

For these reasons, we are not persuaded the Examiner erred in concluding the subject matter of claim 1 is judicially-excepted from patentability.

Accordingly, we sustain the Examiner’s § 101 rejection of representative, independent claim 1, as well as the Examiner’s § 101 rejection of grouped claims 3–10, 12–15, 17–19, 22, and 24, not argued separately.

#### DECISION

We affirm the decision of the Examiner rejecting claims 1, 3–10, 12–15, 17–19, 22, and 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).

AFFIRMED