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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JOHN NICHOLAS GROSS, KEN SALE, ALAN MEYER,  
and KEN BOASSO<sup>1</sup>

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Appeal 2017-004236  
Application 13/355,392  
Technology Center 3600

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Before MARC S. HOFF, JAMES R. HUGHES, and  
JOHN D. HAMANN, *Administrative Patent Judges*.

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's decision rejecting claims 1–6 and 13–21. Claims 7–12 and 22 have been canceled. Non-Final Act. 1.<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 Patent Savant LLC. App. Br. 5.

<sup>2</sup> We refer to Appellants' Specification ("Spec.") filed Jan. 20, 2012 (claiming benefit of US 61/434,588 (filed Jan. 20, 2011) and US 61/442,049 (filed Feb. 11, 2011)); Appeal Brief ("App. Br.") filed Aug. 17, 2016; and Reply Brief ("Reply Br.") filed Jan. 4, 2017. We also refer to the

*Appellants' Invention*

The invention generally relates to “automated electronic system tools and methods for modeling and understanding intellectual property rights proceedings and challenges.” Spec. 1:27–29. *See* Spec. 2:2–6:5; Abstract.

*Representative Claim*

Independent claim 1, reproduced below, further illustrates the invention:

1. A method of indirectly analyzing and predicting behavior of a target organization with a computing system, which target organization processes input submissions from third parties using a staff of human personnel in accordance with a first rule set to generate output events for an intellectual property asset that includes intellectual property content describing characteristics of the intellectual property asset, the method comprising:

causing the computing system to access a publicly accessible database of event records derived from the output events of the target organization, and which event records identify at least an event type and event date associated with processing by the target organization of the input submissions;

wherein each of said input submissions includes one or more electronic files containing: 1) a first request document with first request content requesting the target organization to process a first intellectual property asset and generate a first output with respect to assessing said first intellectual property asset in accordance with said first rule set; 2) one or more second reference documents containing second reference content identified in said first request document as overlapping sufficiently with said intellectual property content so as to satisfy said first rule set;

processing the event records with the computing system to identify a historical event behavior of the target organization, including a timing performance parameter and a resolution parameter associated with the output events;

wherein said processing of said event records includes natural language processing by the computing system to compare said first request content, said second reference content and said intellectual property content to generate said resolution parameter, said timing performance parameter and a profile of behavior of said target organization with respect to said first rule set;

providing a hypothetical submission to be processed by the target organization;

wherein said hypothetical submission includes hypothetical request content, hypothetical reference content, and hypothetical intellectual property content for a hypothetical intellectual property asset;

generating a prediction with the computing system of an output expected to be generated by the target organization for said hypothetical submission for said hypothetical intellectual property asset based on said historical event behavior for said first rule set.

#### *Rejections on Appeal*

1. The Examiner rejects claims 1–6 and 13–21 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
2. The Examiner rejects claims 1–6 and 13–21 under pre-AIA 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
3. The Examiner rejects claims 1–6 and 13–21 under pre-AIA 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

4. The Examiner rejects claims 1, 3, 5, 6, 13–15, 17, and 18 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Holt (US 2008/0016067 A1, published Jan. 17, 2008), Busch et al. (US 2010/0299301 A1, published Nov. 25, 2010) (“Busch”), and Johnson et al. (US 2004/0138936 A1, published July 15, 2004) (“Johnson”).

5. The Examiner rejects claim 2 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Holt, Busch, Johnson, and Axford (US 2004/0249739 A1, published Dec. 9, 2004).

6. The Examiner rejects claim 4 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Holt, Busch, Johnson, and Tran (US 2008/0140786 A1, published June 12, 2008).

7. The Examiner rejects claim 16 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Holt, Busch, Johnson, and Sheets (US 2009/0150326 A1, published June 11, 2009).

8. The Examiner rejects claims 19 and 20 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Holt, Busch, Johnson, and Gibbs et al. (US 2007/0294232 A1, published Dec. 20, 2007) (“Gibbs”).

9. The Examiner rejects claim 21 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Holt, Busch, Johnson, and Van Luchene et al. (US 2007/0219816 A1, published Sept. 20, 2007) (“Van Luchene”).

#### RELATED APPEAL

The instant Appeal is related to Appeal No. 2017-007253 for US 13/828,923. In that decision (Appeal No. 2017-007253) (“Decision”) mailed on Feb. 28, 2018, the Board affirmed the Examiner’s indefiniteness rejection of claims 29–32, but reversed the Examiner’s rejections under 35 U.S.C. §§ 101 and 103(a).

## ISSUES

Based upon our review of the record, Appellants' contentions, and the Examiner's findings and conclusions, the issues before us are as follows:

1. Did the Examiner err in finding claims 1–6 and 13–21 were directed to patent ineligible subject matter under 35 U.S.C. § 101?
2. Did the Examiner err in finding claims 1–6 and 13–21 failed to comply with the written description requirement under 35 U.S.C. § 112, first paragraph?
3. Did the Examiner err in finding claims 1–6 and 13–21 were indefinite under 35 U.S.C. § 112, second paragraph?
4. Did the Examiner err in finding that the combination of Holt, Busch, and Johnson collectively would have taught or suggested:

processing the event records with the computing system to identify a historical event behavior of the target organization, including a timing performance parameter and a resolution parameter associated with the output events;

wherein said processing of said event records includes natural language processing by the computing system to compare said first request content, said second reference content and said intellectual property content to generate said resolution parameter, said timing performance parameter and a profile of behavior of said target organization with respect to said first rule set

within the meaning of Appellants' claim 1 and the commensurate limitations of claim 13?

## ANALYSIS

### *The 35 U.S.C. § 101 Rejection of Claims 1–6 and 13–21*

Appellants argue independent claims 1 and 13 (as well as dependent claims 2–6 and 14–21) together as a group with respect to the § 101 rejection. *See* App. Br. 11–15. We select independent claim 1 as representative of Appellants’ arguments with respect to claims 1–6 and 13–21. 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner rejects the claims as being directed to patent-ineligible subject matter in that the claimed invention is “directed to a judicial exception in the form of an abstract idea”—“analyzing and predicting the behavior of an organization that processes requests for intellectual property . . . so that an outcome can be predicted for a submission to the organization” (Non-Final Act. 4) or, in other words, “using information about an entity or organization to make a prediction about a possible outcome that involves the entity/organization” (*id.*). The Examiner further finds that “[t]he claimed abstract idea constitutes an idea of itself” (*id.*), in that the claims recite “using behavior information to make predictions about a possible outcome[, which] is a fundamental concept long recognized by and used by human beings” (Non-Final Act. 5). Additionally, the Examiner finds Appellants’ claims do “not include additional elements that are sufficient to amount to significantly more than the judicial exception” (*id.*). *See* Non-Final Act. 3–6; Ans. 3–9.

Appellants contend that the claims are not directed to an improper judicial exception or abstract idea because the Examiner does not identify such an abstract idea (App. Br. 11–12), the Examiner misapplies the relevant precedent by “pigeonhol[ing]” Appellants’ claims into an “overly broad

‘humans can do this’ exception [that] is not in accordance with modern precedent” (App. Br. 12), the Examiner misapplied the second part of the *Alice* test (App. Br. 13), and the Examiner did not show that the claims preempt the delineated and purportedly abstract idea (App. Br. 14). *See* App. Br. 11–14; Reply Br. 4–13.

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “long held that this 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.*, 569 U.S. 576, 589 (2013)).

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, 77–80 (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*, 134 S. Ct. at 2355. Assuming that a claim nominally falls within one of the statutory categories of machine, manufacture, process, or composition of matter, the first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts” (*id.*), e.g., to an abstract idea. For example, abstract ideas include, but are not limited to, fundamental economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Id.* at 2355–57. If the claims are not directed to 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 the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78, 79). This second step is described as “a search for an “inventive concept””—*i.e.*, an element or combination of elements that is ‘. . . significantly more than . . . the [ineligible concept] itself.’” *Id.* at 2355 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

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. We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

#### *Alice Step 1 Analysis*

Turning to the first step of the eligibility analysis, “[t]he first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish*, 822 F.3d at 1335–36. “The abstract idea exception prevents patenting a result where ‘it matters not by what process or machinery the result is accomplished.’” *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 113 (1853)). “We therefore look to whether the claims . . . focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself

is the abstract idea and merely invoke generic processes and machinery.”  
*McRO*, 837 F.3d at 1314.

The Examiner finds claim 1 is directed to the abstract idea of collecting and analyzing information similar to *Electric Power Group* (see Ans. 6). The Examiner also finds that the collecting and analyzing of information can be performed mentally or “can be done by a person with pen and paper” (Ans. 7), and is, therefore, an “idea of itself” (*id.*, citing *Electric Power Group*). See Ans. 6–7 (citing *Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016)). The Examiner also counters Appellants’ arguments concerning narrowness of the invention and preemption. See Ans. 5–6 (citing *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1353–54 (Fed. Cir. 2014) (“reject[ing] the contention that the very narrow scope . . . [is] a reason to find patent eligibility” *id.* at 1353 (citing *Mayo*, 566 U.S. at 88)) and *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“that the claims do not preempt all price optimization . . . do not make them any less abstract”))). Conversely, Appellants attack the Examiner’s findings on numerous grounds without explaining why Appellants’ claims are not analogous to those in *Electric Power Group*. See Reply Br. 4–6.

Instead of using a fixed definition of an abstract idea and analyzing how claims fit (or do not fit) within the definition, “the 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.” *Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (citing *Elec. Power Grp.*, 830 F.3d at 1353–54). As part of this inquiry, we must “look at the ‘focus of the

claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas, LLC v. DirecTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

Here, Appellants’ claims generally, and independent claims 1 and 13 in particular, relate to collecting and analyzing information (collecting various records and content, analyzing (processing) this information (data) to determine (identify) behavior and parameters, and generate a prediction—that is, analyzing and manipulating data utilizing un-recited processes or algorithms to determine a result (a prediction). Therefore, the claims broadly recite collecting, analyzing, and manipulating information (data). *See* Abstract; Spec. 1:27–32; 7:20–8:25. This is consistent with how Appellants describe the claimed invention. *See id.*; Spec. 76:20–77:2. Contrary to Appellants’ assertions, the present claims are directed to an abstract idea, in that the instant claims are analogous to a number of cases in which courts have identified similar claims as encompassing abstract ideas. *See* Ans. 6–7 (discussed *supra*).

Our reviewing court has held that abstract ideas include gathering, analyzing, and displaying information. *See Elec. Power Grp.*, 830 F.3d at 1354 (finding “gathering and analyzing information of a specified content, then displaying the results,” to be directed to an abstract idea). Similarly, our reviewing court has held that abstract ideas include gathering, analyzing, and storing information. *See Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass’n.*, 776 F.3d 1343, 1345, 1347 (Fed. Cir. 2014) (finding the “claims generally recite . . . recognizing specific information from the extracted data, and . . . storing that information in a memory” (*id.* at 1345) and that the “claims are drawn to the basic concept of data recognition

and storage” (*id.* at 1347)). Also, collecting, analyzing, and manipulating information has been found to be a collection of abstract ideas. *See Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1341 (Fed. Cir. 2017) (holding that the claimed invention is directed to the abstract idea of “collecting, displaying, and manipulating data of particular documents”); *FairWarning IP, LLC v. Iatric Systems, Inc.*, 839 F.3d 1089, 1093–95 (Fed. Cir. 2016) (finding the claims were directed to a combination of abstract ideas including collecting and analyzing information and utilizing rules to determine fraud).

Here, the collection and analysis of information to predict a result is similar to the abstract idea of collecting, analyzing, and manipulating information discussed in *Elec. Power Grp., Content Extraction, Intellectual Ventures I*, and *FairWarning*. Accordingly, we agree with the Examiner that the claims are directed to an abstract idea of collecting, analyzing, and manipulating information.

We also agree with the Examiner that the steps recited in claim 1 could be “be done by a person with pen and paper.” Ans. 7. We find a person could perform each process (step or function) in Appellants’ claim 1, either mentally, or using pen and paper. *See* Ans. 6–7. In that regard, our reviewing court has held that “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, [are] essentially mental processes within the abstract-idea category.” *Elec. Power Grp.*, 830 F.3d at 1354; *see also Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146 (Fed. Cir. 2016) (“Methods which can be performed entirely in the human mind are unpatentable” (*id.*, quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972))); *CyberSource Corp. v. Retail Decisions*,

*Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011) (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*). “[T]he fact that the required calculations could be performed more efficiently via a computer does not materially alter the patent eligibility of the claimed subject matter.” *Bancorp Servs., LLC v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012). Thus, we agree with the Examiner that Appellants’ claims are directed to an abstract idea of collecting, analyzing, and manipulating information, which could be performed by purely mental processes.

#### *Alice Step 2 Analysis*

Having found Appellant’s claims are directed to an abstract concept under *Alice*’s step 1 analysis, we next address whether the claims add significantly more to the alleged abstract idea. As directed by our reviewing Court, we search for an “‘inventive concept’ sufficient to ‘transform the nature of the claim into a patent-eligible application.’” *McRO*, 837 F.3d at 1312 (quoting *Alice*, 134 S. Ct. at 2355). The implementation of the abstract idea involved must be “more than performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction*, 776 F.3d at 1347–48 (alteration in original) (quoting *Alice*, 134 S. Ct. at 2359). The “inventive concept” “must be significantly more than the abstract idea itself, and cannot simply be an instruction to implement or apply the abstract idea on a computer.” *Bascom Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349 (Fed. Cir. 2016).

Here, the Examiner found that Appellants’ claims do not add significantly more. *See* Non-Final Act. 5–6; Ans. 8–10. Appellants, on the

other hand, contend that the Examiner’s analysis was faulty (*see* App. Br. 13; Reply Br. 7–11), that “there is more than ‘an inventive concept’ presented in claim 1” (App. Br. 14), and that “the limitations in combination . . . clearly embody an inventive concept . . . [and] recite[] significantly more than an abstract idea” (Reply Br. 11 (internal quotations omitted)).

Appellants fail to persuade us of error in the Examiner’s rejection with respect to the second *Alice* step. Here Appellants repeat the limitations of claim 1—asserting that the limitations embody an inventive concept, but do not directly address the Examiner’s findings. *See* Reply Br. 7–11. Appellants also conflate the *Alice* two-part analysis. *See* App. Br. 14; Reply Br. 11–12. To the extent Appellants’ arguments might be interpreted as invoking *DDR Holdings* (*see* Reply Br. 7, 13)—in that the instant claims improve the operation of a computer system—we disagree. In *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), the court held that a claim may amount to more than an abstract idea recited in the claims when it addresses and solves problems *only* encountered with computer technology and online transactions, e.g., by providing (serving) a composite web page rather than adhering to the routine, conventional functioning of Internet hyperlink protocol. *See DDR Holdings*, 773 F.3d at 1257–59. In contrast, claim 1 performs a process of collecting, analyzing and manipulating information, utilizing conventional computer networks and systems. *See* Ans. 8–10; Spec. 76:20–77:2; Fig 1. Despite Appellants’ arguments to the contrary, nothing in the claim recites a “specific improvement to the way computers operate” (*supra*), the analysis of collected data, is not a solution to a technical problem as discussed in *DDR Holdings*. Predicting organizational behavior by data analysis is a

commercial solution to an efficiency problem, not a technical solution. This commercial solution may be assisted using a general purpose computer to perform the data collection, analysis, and manipulation processes, but does not improve how the computer itself functions. As we previously explained, the instant claims are more akin to the claims for analyzing information found to be abstract in *Elec. Power Grp*, 830 F.3d at 1353.

We agree with the Examiner that the additional limitations, separately, or as an ordered combination, do not provide meaningful limitations (i.e., do not add significantly more) to transform the abstract idea into a patent eligible application. *See e.g.*, Non-Final Act. 5–6; Ans. 8–10. Indeed, the claim merely recites processes collecting existing data, analyzing the data to determine other data, and predicting organizational behavior. Such steps are all routine and conventional and well-understood computer functions of a general processor. The Specification supports this view in discussing the processes implemented in software which operates on generic computers to perform the recited data manipulation steps. *See Spec.* 76:20–77:2.

To implement the above functions a server computing system used by the described embodiments is preferably a collection of computing machines and accompanying software modules of any suitable form known in the art for performing the operations described above and others associated with typical website support.

*Spec.* 76:20–24. Such conventional computer processes “do not alone transform an otherwise abstract idea into patent-eligible subject matter.”

*FairWarning IP*, 839 F.3d at 1096 (citing *DDR Holdings*, 773 F.3d at 1256).

For at least the reasons above, we are not persuaded of Examiner error in the rejection of claim 1 under 35 U.S.C. § 101. Thus, we sustain the

Examiner's rejection under § 101 of independent claims 1 and 13, and also dependent claims 2–6 and 14–20, which were not argued separately.

*The Written Description Rejection of Claims 1–6 and 13–21*

The Examiner rejects claims 1–6 and 13–21 as failing to comply with the written description requirement. *See* Non-Final Act. 8–18; Ans. 10–18. Appellants contend that their Specification and claims, as originally filed, support the disputed claim language. *See* App. Br. 15–18; Reply Br. 14–19. For example, Appellants contend that the recited “natural language processing” in claim 1 is described in the originally filed Specification. App. Br. 15–16; Reply Br. 14 (citing, e.g., Spec. 12:20–28). The cited portion of the Specification describes “natural language (NL) logic” “responsible for collecting and analyzing documents and other associated metadata associated with the submissions” (Spec. 12:20–28). Appellants similarly address the other disputed language of claim 1 and claims 2–6 and 13–21. *See* App. Br. 15–18; Reply Br. 14–19. We agree with Appellants. Appellants' Specification discusses the disputed language and (in a limited fashion) its functionality. *See id.* Accordingly, Appellants persuasively argue that the Specification describes and supports the disputed language. The Examiner, on the other hand, seems to base much of the rejection on a failure of the claims and Specification to explain the specific implementations of the functionality recited in Appellants' claims—i.e., that the Specification would not have enabled one of ordinary skill in the art to make the invention recited in the claims. *See* Non-Final Act. 8–18; Ans. 10–18. In conflating the § 112, first paragraph analysis, the Examiner has not clearly articulated either a § 112, first paragraph, enablement rejection or a § 112, first paragraph, written description rejection. Consequently, we are

constrained by the record before us to find that the Examiner erred in rejecting claims 1–6 and 13–21 as failing to comply with the written description requirement. Accordingly, we reverse the Examiner’s § 112, first paragraph, rejection of claims 1–6 and 13–21.

*The Indefiniteness Rejection of Claims 1–6 and 13–21*

The Examiner rejects claims 1–6 and 13–21 as being indefinite. *See* Non-Final Act. 18–21; Ans. 16–18. Specifically, the Examiner finds there is no antecedent basis for “said historical event behavior” in claim 1 (*see* Non-Final Act. 18–19), the comparison of content in Appellants’ claim 1 is unclear (*see* Non-Final Act. 19), “said user’s” in Appellants’ claim 3 lacks antecedent basis (*see* Non-Final Act. 19), and claims 6, 17, 18, 20, and 21 are unclear for various reasons (*see* Non-Final Act. 19–21). Appellants contend that the recitation of the comparison in claim 1 is broad, but not indefinite and the Specification supports and further clarifies the various recited comparisons. App. Br. 18–19; Reply Br. 19–21. Appellants also contend that the language in claims 3, 6, 17, and 18 is clear and the Specification and drawings further clarify the disputed language. App. Br. 19–20; Reply Br. 20–21. Additionally, Appellants contend “[t]he Examiner also rejects claims 3, 6, 17–18 and 20 on new arguments based on what are really minor informalities that can be rectified easily.” App. Br. 19; *see also* App. Br. 19–20; Reply Br. 20–21.

The essence of the requirement under 35 U.S.C. § 112, second paragraph, is that the language of the claims must make clear what subject matter the claims encompass — i.e., “whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 655 F.3d

1364, 1380 (Fed. Cir. 2011) (quoting *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)); see *In re Packard*, 751 F.3d 1307, 1310–14 (Fed. Cir. 2014).

“[W]e apply the approach for assessing indefiniteness approved by the Federal Circuit in *Packard*, i.e., ‘[a] claim is indefinite when it contains words or phrases whose meaning is unclear.’ Put differently, ‘claims are required to be cast in clear—as opposed to ambiguous, vague, indefinite—terms.’” *In re McAward*, Appeal 2015-006416, 2017 WL 3669566, \*5 (PTAB Aug. 25, 2017) (precedential) (quoting *In re Packard*, 751 F.3d at 1310, 1313–14) (internal citations omitted).

We find claims 1 and 3 have antecedent basis for the disputed language. Further, the Examiner does not explain why the disputed language would be unclear to one of ordinary skill in the art. With respect to the comparisons made in claim 1, Appellants persuade us that the comparisons would be clear to one of ordinary skill in the art. See App. Br. 18–19; Reply Br. 19–21. As explained by Appellants, “[b]readth is not indefiniteness.” App. Br. 19 (quoting *In re Gardner*, 427 F.2d 786, 788 (1970)). In light of our findings and Appellants arguments, we find the Examiner, with respect to claims 1–6 and 13–19, fails to sufficiently explain why one of ordinary skill in the art would *not* understand what is claimed by Appellants.

With respect to claims 20 and 21 we agree with the Examiner that the “output” is a thing (the term is used as a noun), and it is unclear how an output can include a step (process). See Non-Final Act. 20–21; Ans. 18. Appellants do not address the Examiner’s rejection directly, and concede that claims 20 and 21 are unclear, stating that the claims 20 and 21 can

easily be made clear by a simple amendment—that the indefiniteness issues may be “easily resolved by a minor language change” (App. Br. 20). *See* App. Br. 20; Reply Br. 21. Therefore, we find Appellants do not dispute the substance of the Examiner’s rejection and, thus, do not persuade us of error in the Examiner’s indefiniteness rejection with respect to claims 20 and 21. Accordingly, we sustain the Examiner’s indefiniteness rejection of claims 20 and 21, but do not sustain the Examiner’s indefiniteness rejection of claims 1–6 and 13–19.

*The 35 U.S.C. § 103 Rejection of Claims 1, 3, 5, 6, 13–15, 17, and 18*

The Examiner rejects independent claims 1 and 13 as being obvious in view of Holt, Busch, and Johnson. *See* Non-Final Act. 21–35; Ans. 18–22. Appellants contend that Holt, Busch, and Johnson do not teach the disputed features of claim 1 (or claim 13). *See* App. Br. 20–26; Reply Br. 22–27. More specifically, Appellants contend that Holt fails to teach a key feature of claim 1—that the claim “is directed to a particular method in which input submissions from third parties to a target organization are processed to derive a historical event behavior, and timing and resolution parameters for the organization” and that “it is the behavior of the organization relative to the first rule set that is being analyzed to determine these parameters” (Reply Br. 22). According to Appellants, the Examiner’s citation of Holt and related discussion of the reference “failed to account for the fact that this reference is much more limited: it only teaches processing materials produced by the organization itself” (Reply Br. 22). *See* App. Br. 21–22; Reply Br. 22–23.

The Examiner relies on Holt to teach processing the records to identify historical event behavior and generate the various parameters. *See*

Non-Final Act. 22–27; Ans. 18–19. In particular, the Examiner finds that much of the terminology in the disputed limitations is non-functional descriptive material and that the rule set does not further limit Appellants’ claim 1. *See* Non-Final Act. 24–26.

We disagree with the Examiner’s interpretation of claim 1, which fails to give weight to, or properly consider, the terminology recited in the claim. We further agree with Appellants that the Examiner-cited portions of Holt, at best, generally describe US Patent and Trademark Office (USPTO) databases and extracting data from the USPTO databases. *See* App. Br. 21–22; Reply Br. 22–23.

Appellants’ claim 1 (and claim 13) recite “analyzing and predicting behavior of a target organization with a computing system, which target organization processes input submissions from third parties using a staff of human personnel in accordance with a first rule set to generate output events” by “processing the event records” “to identify a historical event behavior of the target organization, including a timing performance parameter and a resolution parameter associated with the output events” including using “natural language processing” “to compare said first request content, said second reference content and said intellectual property content to generate said resolution parameter, said timing performance parameter and a profile of behavior of said target organization with respect to said first rule set” (claim 1). As explained by Appellants (*supra*), the claim language requires evaluation of the input submissions (which are processed according to the first rule set to generate output events), the first rule set, and the event records (records of the output events) in processing of the event records to determine the historical behavior and various parameters. The Examiner

cited portions of Holt only teach collecting data from databases. The Examiner has not provided a sufficient explanation of how Holt (in combination with Busch, and Johnson) teaches the disputed features of claim 1.

Consequently, we are constrained by the record before us to find that the Examiner erred in finding Holt, Busch, and Johnson teach the disputed features of Appellants' claim 1. Independent claim 13 includes limitations of commensurate scope. Dependent claims 3, 5, 6, 14, 15, 17, and 18 depend on and stand with independent claims 1 and 13, respectively. Accordingly, we do not sustain the Examiner's obviousness rejection of claims 1, 3, 5, 6, 13–15, 17, and 18.

*The 35 U.S.C. § 103 Rejection of Claims 2, 4, 16, 19, and 20*

The Examiner rejects dependent claim 2 as obvious in view of Holt, Busch, Johnson, and Axford. *See* Non-Final Act. 47–50. The Examiner rejects claim 4 as obvious in view of Holt, Busch, Johnson, and Tran. *See* Non-Final Act. 50–51. The Examiner rejects claim 16 as obvious in view of Holt, Busch, Johnson, and Sheets. *See* Non-Final Act. 52–54. The Examiner rejects claims 19 and 20 as obvious in view of Holt, Busch, Johnson, and Gibbs. *See* Non-Final Act. 54–62. The Examiner rejects claim 21 as obvious in view of Holt, Busch, Johnson, and Van Luchene. *See* Non-Final Act. 62–65. The Examiner does not suggest, and we do not find, that the additional references cure the deficiencies of Holt, Busch, and Johnson (*supra*). We reverse the Examiner's obviousness rejections of dependent claims 2, 4, 16, 19, and 20, for the same reasons set forth with respect to claim 1 (*supra*).

### CONCLUSIONS

Appellants have not shown that the Examiner erred in rejecting claims 1–6 and 13–21 under 35 U.S.C. § 101.

Appellants have shown that the Examiner erred in rejecting claims 1–6 and 13–21 under 35 U.S.C. § 112, first paragraph.

Appellants have not shown that the Examiner erred in rejecting claims 20 and 21 under 35 U.S.C. § 112, second paragraph.

Appellants have shown that the Examiner erred in rejecting claims 1–6 and 13–19 under 35 U.S.C. § 112, second paragraph.

Appellants have shown that the Examiner erred in rejecting claims 1–6 and 13–21 under 35 U.S.C. § 103(a).

### DECISION

We affirm the Examiner’s rejection of claims 1–6 and 13–21.

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