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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN HUTCHINSON,
VENKATESWARAN KRISHNAN,
and SENTHILKUMAR VADIVEL

Appeal 2017-004362
Application 13/309,069¹
Technology Center 3600

Before ALLEN R. MacDONALD, MICHAEL J. ENGLE, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

ENGLE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1 and 3–20, which are all of the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Technology

The application relates to a method “for purchasing organizations to review and influence search and purchasing decisions of employees to comply with supplier contracts,” such as “restricting the purchase of some items.” Spec. ¶¶ 2–3.

¹ Appellants state the real party in interest is Vinimaya, Inc. App. Br. 3.

Illustrative Claim

Claim 1 is illustrative and reproduced below:

1. An electronic procurement system comprising:

a processor; and

a non-transitory, tangible computer readable memory coupled to the processor, the memory storing instructions to direct the processor to perform operations comprising:

enabling at least two electronic supplier catalogs chosen from the group consisting of static catalogs, punchout catalogs, and web-enabled catalogs, for access through the electronic procurement system;

receiving a first search request from a first user;

searching said electronic supplier catalogs to generate a plurality of items based on the first search request, wherein the electronic supplier catalogs are remote from the electronic procurement system;

providing an interface, via an input/output device, to said first user comprising a set of results, from said first search request, which further allows said first user to assign a priority ranking for at least one of the results in said set of results;

receiving priority rankings for at least one item of the plurality of items identified based on the first search request, wherein said priority rankings include a block setting that excludes one or more manufacturer items;

receiving a second search request from a second user;

after receiving the second search request from the second user, in near real time relative to receiving the second search request:

searching electronic supplier catalogs to generate a plurality of items based on the second search request, wherein the electronic supplier

catalogs are remote from the electronic procurement system;

receiving said plurality of items based on the second search request;

applying said priority rankings to plurality of items based on the second search request;

and

rendering a set of filtered search results based on said priority rankings for display to said second user wherein the one or more manufacturer items included in the block setting is eliminated from the plurality of items based on the second search request.

Rejection

Claims 1 and 3–20 stand rejected under 35 U.S.C. § 101 as being directed to ineligible subject matter. Final Act. 3.

Related Appeal

Appellants identify Application No. 13/309,109 (Appeal No. 2016-007167) because it “includes claims to similar technology,” but Appellants suggest the “issues . . . are different.” App. Br. 3. In that case’s decision dated January 26, 2018, the PTAB affirmed a rejection under § 101 of claims related to auditing pricing for compliance with supplier contracts.

ISSUE

Did the Examiner err in determining claim 1 was ineligible under § 101?

ANALYSIS

Section 101 defines patentable subject matter: “Whoever 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. The Supreme Court, however, has “long held that this provision contains an important implicit exception” that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012) (quotation omitted). “Eligibility under 35 U.S.C. § 101 is a question of law, based on underlying facts.” *SAP Am., Inc. v. InvestPic, LLC*, 890 F.3d 1016, 1020 (Fed. Cir. 2018).

To determine patentable subject matter, the Supreme Court has set forth a two part test. *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). Here, Appellants challenge both steps of the § 101 rejection.

Step One:

Whether the Claims Are Directed to an Abstract Idea

In the first step, “we determine whether the claims at issue are directed to one of those patent-ineligible concepts” of “laws of nature, natural phenomena, and abstract ideas.” *Alice*, 134 S. Ct. at 2355. “The inquiry often is whether the claims are directed to ‘a specific means or method’ for improving technology or whether they are simply directed to an abstract end-result.” *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1326 (Fed. Cir. 2017). A court must be cognizant 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), and “describing the claims at . . . a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016).

Instead, “the claims are considered in their entirety to ascertain whether their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

A) Whether Limitations Providing Benefits Must Be Included in What a Claim Is “Directed To”

Appellants argue that “when a claim recites limitations which allow it to achieve its beneficial results, those limitations must be included in what the claim is ‘directed to’ for purposes of subject matter eligibility.” App. Br. 8. According to Appellants, in the present application, certain limitations were added to overcome prior art rejections (e.g., different types of catalogs, and filtering a second user’s search results to remove items blocked by the first user) and those limitations “allow for an improved result relative to the prior art,” such as conforming to contracts “restricting the purchase of some items.” *Id.* at 7–8 (quoting Spec. ¶ 3). Based on these alleged improvements, Appellants argue that the Examiner’s rejection “improperly omitted limitations” when determining what the claims were “directed to.” *Id.* at 10.

We are not persuaded by Appellants’ argument. As an initial matter, Appellants have not adequately tied the amended limitations to the cited benefit. For example, it is unclear how the claimed *types* of catalogs relate to the cited problem of individuals not knowing if their organization has a restrictive contract in place. *See* Spec. ¶ 3. Regardless, Appellants’ theory does not align with Federal Circuit precedent. For example, in one recent case, “[b]oth the prosecution history and the specification emphasize that the key distinguishing feature of the claims is the ability to automate or otherwise make more efficient traditional price-optimization methods.” *OIP*

Techs., Inc. v. Amazon.com, Inc., 788 F.3d 1359, 1363 (Fed. Cir. 2015).

Nevertheless, the Federal Circuit analyzed the automating computer under step two of the *Alice/Mayo* framework, not step one. *Id.* at 1362–63.

Therefore, contrary to Appellants’ argument, a limitation allowing a beneficial result (e.g., automation by a computer) does not necessarily need to be included in what the claim is “directed to” under the first step of the *Alice/Mayo* framework.

Instead, the proper inquiry for step one—as set forth by the Supreme Court—is to “determine whether the claims at issue are *directed to* a patent-ineligible concept.” *Alice*, 134 S. Ct. at 2355 (emphasis added). The question then is not whether a single limitation allows a beneficial result, but rather what the claim as a whole is “directed to,” such as a claim directed to a particular technical application of an abstract idea rather than directed to the abstract idea itself. *See Internet Patents*, 790 F.3d at 1346 (“the claims are considered *in their entirety* to ascertain whether their character *as a whole* is directed to excluded subject matter”) (emphasis added). The cases cited by Appellants confirm this approach, an approach we now apply to determine what the claims here are directed to. App. Br. 8–10.²

² *Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1048 (Fed. Cir. 2016) (“[T]he claims are simply not directed to the ability of hepatocytes to survive multiple freeze-thaw cycles. Rather, the claims of the ’929 patent are directed to a new and useful laboratory technique for preserving hepatocytes.”); *Enfish*, 822 F.3d at 1335–36 (“the first step in the *Alice* inquiry in this case asks whether the focus of the claims is on the specific asserted improvement in computer capabilities (i.e., the self-referential table for a computer database) or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool”); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016) (“We therefore look to whether the claims in these patents focus on a

B) What the Claims Are “Directed To”

Here, the Examiner determines the claims are directed to an abstract idea based on at least three related points:

- (1) The claims are directed to filtering content, which the Federal Circuit has deemed an abstract idea in *BASCOM*. Ans. 3.
- (2) The claimed steps are “merely using categories (i.e. priority rankings) to organize[,] store[,] and transmit information (i.e. filtered search results), which is similar to the abstract idea recited in *Cyberfone* (i.e. using categories to organize, store and transmit information).” Ans. 3; Final Act. 3–4.
- (3) Other than the generic computer components, the claims “can be performed in the human mind, or by a human using a pen and paper.” Final Act. 7, 4; Ans. 3.

First, we agree with the Examiner that the claims are directed to filtering content. Ans. 3. More specifically, the claims are directed to a first user providing a setting to “block” certain manufacturer items from future search results by a second user. *See* claim 1; App. Br. 17 (“enable the administrator to easily select specific items for blocking from future searches run by a given user”). The Examiner’s determination is supported by Appellants’ “Summary of Claimed Subject Matter,” which contains a heading of “Claim 1 Is Directed Toward Eliminating Items From a Second Search Request.” App. Br. 3 (emphasis omitted). Eliminating items from a second search request is filtering. Claim 1 expressly recites these as “filtered search results.” For step one of the *Alice/Mayo* framework, the Federal Circuit has previously held that “filtering content is an abstract idea because it is a longstanding, well-known method of organizing human

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.”).

behavior, similar to concepts previously found to be abstract.” *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016); Ans. 3 (citing *BASCOM*).

Appellants argue that “the rendering of filtered search results from the present claims does effect a *meaningful transformation* of data, because it blocks specific items that would otherwise be included in a result but which a company does not want an end user to perceive.” Reply Br. 5 (emphasis added). Yet transformation alone is not the test. “[I]n *Mayo*, the Supreme Court emphasized that satisfying the machine-or-transformation test, by itself, is not sufficient to render a claim patent-eligible, as not all transformations or machine implementations infuse an otherwise ineligible claim with an ‘inventive concept.’” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014). The Federal Circuit has already held that claims directed to filtering, such as those here, are directed to an abstract idea, not an inventive concept *beyond* an abstract idea. *BASCOM*, 827 F.3d at 1348.

Appellants also argue the Examiner’s reliance on *BASCOM* and filtering “should not have been included in the Examiner’s Answer without being identified as a new ground of rejection.” Reply Br. 5–6. However, by regulation, “[a]ny request to seek review of the primary examiner’s failure to designate a rejection as a new ground of rejection in an examiner’s answer must be by way of a petition to the Director . . . before the filing of any reply brief” and “[f]ailure of appellant to timely file such a petition will constitute a waiver of any arguments that a rejection must be designated as a new ground of rejection.” 37 C.F.R. § 41.40(a).

Second, the Federal Circuit has held that (A) “collecting information, including when limited to particular content (which does not change its character as information)”; (B) “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more”; (C) “merely presenting the results of abstract processes of collecting and analyzing information, without more”; and (D) “the combination” of the aforementioned items are all “within the realm of abstract ideas.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016); *see also* Ans. 3 (relying on an earlier non-precedential case regarding the similarly abstract idea of “using categories (i.e. priority rankings) to organize[,] store[,] and transmit information (i.e. filtered search results)”). Here, claim 1 recites collecting potential items from catalogs, analyzing and limiting those items to particular content based on a rule to “block” a certain category of items (e.g., items by a particular manufacturer), and presenting the results of applying that rule the next time a user runs a search. Therefore, just as in *Electric Power Group*, “[t]he advance [the claims] purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions. They are therefore directed to an abstract idea.” *Elec. Power Grp.*, 830 F.3d at 1354.

Third, we agree with the Examiner that “with the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper.” *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1318 (Fed. Cir. 2016); *see also* Final Act. 7, 4; Ans. 3. Appellants argue that a human could not process such a high volume of data “in near real time.”

Reply Br. 8. But Appellants' argument is not commensurate with the scope of the claims given that the claimed "plurality of items" can be as few as two. Moreover, Federal Circuit precedent forecloses such an argument because "the 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., L.L.C. v. Sun Life Assurance Co.*, 687 F.3d 1266, 1278 (Fed. Cir. 2012). Here, the concept of one person setting a filter to block items from another person's search can be performed by a human either mentally or with pen and paper, whether it be an administrator blocking an employee's option to purchase certain supplies or a parent blocking a child's option to purchase certain mature content. *See also Elec. Power Grp.*, 830 F.3d at 1355 ("But merely selecting information, by content or source, for collection, analysis, and display does nothing significant to differentiate a process from ordinary mental processes, whose implicit exclusion from § 101 undergirds the information-based category of abstract ideas.").

C) Evidence in Step One of the Alice/Mayo Framework

Appellants also argue procedural error on the part of the Examiner, contending that step one of the *Alice/Mayo* framework is not a "pure question of law" if an applicant or patent owner presents "contrary evidence" "raising questions of fact" as to whether the claims are directed to an abstract idea. App. Br. 11–15 (citing *TQP Dev., LLC v. Intuit Inc.*, No. 2:12-cv-180-WCB, 2014 WL 651935, at *5 (E.D. Tex. Feb. 19, 2014) (Bryson, J., sitting by designation)). According to Appellants, "while it is true that subject matter eligibility is a question of law, this is insufficient to justify ignoring the evidence which may be presented in any particular

case.” *Id.* at 13–14. Specifically, Appellants argue the Examiner failed to consider two pieces of evidence raised by Appellants: (1) a declaration from one of the named inventors explaining that “the claimed invention could not be performed in the human mind or with a pen and paper” and (2) the prior art, which Appellants argue practices the Examiner’s abstract idea without using the present application’s claimed techniques, thereby demonstrating no preemption. *Id.* at 11–12 (emphasis omitted).

We agree with Appellants that in a § 101 analysis, an examiner should consider *all* evidence and arguments that are timely raised by an applicant or appellant, regardless of whether the challenge is to a factual finding or a legal conclusion. Nevertheless, we disagree with Appellants’ implication that (A) the mere existence of evidence necessarily creates a genuine dispute or (B) an examiner necessarily must respond with factual evidence rather than, for example, case law.

The Federal Circuit has held that “[t]he § 101 inquiry ‘*may* contain underlying factual issues.’” *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325 (Fed. Cir. 2016) (quoting *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1341 (Fed. Cir. 2013)). Yet the Federal Circuit also has explained that “not every § 101 determination contains genuine disputes over the underlying facts material to the § 101 inquiry.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018); *see also BSG Tech LLC v. BuySeasons, Inc.*, No. 2017-1980, ___ F.3d ___, 2018 WL 3862646, at *6–7 (Fed. Cir. Aug. 15, 2018). Instead, the Federal Circuit has suggested that many § 101 cases either (A) will not involve any factual disputes or (B) alleged factual issues are not genuine because they are, for example, not material or not persuasive. *Id.*; *Mortg.*

Grader, 811 F.3d at 1325–26; see also *Arrhythmia Research Tech., Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1055–56 (Fed. Cir. 1992) (“Although determination of this question may require findings of underlying facts specific to the particular subject matter and its mode of claiming, in this case there were no disputed facts material to the issue.”).

In *Mortgage Grader*, the Federal Circuit affirmed summary judgment of invalidity under § 101 after noting that “[t]he mere existence in the record of dueling expert testimony does not necessarily raise a genuine issue of material fact.” *Mortg. Grader*, 811 F.3d at 1325–26. The expert declarations in that case set forth (1) “non-material historical information”; (2) a problem allegedly solved by the invention that the Federal Circuit found was not reflected in the actual claim language; and (3) an “opinion . . . that the patents-in-suit require use of a computer.” *Id.* at 1326. Yet the first was not material, the second was not persuasive, and the third was refuted by *Alice*. *Id.* The Federal Circuit therefore determined that such opinions “do[] not create a genuine dispute of material fact” and “no reasonable factfinder could find based on the expert reports that the asserted claims are directed to patent-eligible subject matter.” *Id.* Thus, the district court in *Mortgage Grader* did not err in granting summary judgment that the asserted claims were directed to patent-ineligible subject matter despite not relying on or crediting any expert declaration in its § 101 analysis. *Id.* at 1325–26. Therefore, under *Mortgage Grader*, factual allegations that are not material or persuasive, including based on prior case law, do not give rise to a genuine dispute of material fact.

Similarly, in the context of a motion to dismiss in district court, the Federal Circuit has held that “plausible factual allegations *may* preclude

dismissing a case under § 101 where, for example, nothing on the record refutes those allegations as a matter of law.” *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1097 (Fed. Cir. 2016) (quotation omitted, emphasis added). In that same case, however, the Federal Circuit also held that the patent owner’s “purportedly factual claims” about the invention being “rooted in computer technology” were “insufficient” to avoid a motion to dismiss because another Federal Circuit decision already held that “collecting, analyzing, and displaying data” was an abstract idea. *Id.* at 1097–98. Thus, in some cases, factual allegations may not be sufficient to overcome an abstract idea determination that is based on similar claims found to be abstract in prior cases. *See also Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (“[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.”).

In light of *Mortgage Grader* and *FairWarning*, the factfinder in a § 101 analysis should consider the totality of the record giving due consideration to whether any alleged factual evidence is material, credible, persuasive, and of sufficient weight. In this respect, factual evidence is treated the same under § 101 as any other alleged factual dispute. *See, e.g., In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (“After evidence or argument is submitted by the applicant in response [to a rejection under § 103], patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.”); *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609–10 (1950) (“Like any other issue of fact, final determination [of

equivalence] requires a balancing of credibility, persuasiveness and weight of evidence.”); *cf. Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 252 (1986) (“The mere existence of a scintilla of evidence in support of the plaintiff’s position will be insufficient; there must be evidence on which the jury could reasonably find for the plaintiff [in order to avoid summary judgment].”).

Here, the declaration of one of the named inventors states that “[i]t is my opinion that the claimed activities could never be carried out by a human, without the aid of a technology solution” because “machines are either expressly or inherently required by the steps of the claimed method” and “a human simply could not perform [the claimed] steps . . . in near real time.” Hutchinson Decl. ¶¶ 2, 4, 5 (Mar. 23, 2016). This factual assertion is analogous to *Mortgage Grader*, in which an “opinion . . . that the patents-in-suit require use of a computer” was insufficient to create even a genuine issue of material fact. *Mortg. Grader*, 811 F.3d at 1326. And just as in *Mortgage Grader* and *FairWarning*, the declaration is further insufficient because prior case law confirms that “the 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.*, 687 F.3d at 1278; *OIP Techs.*, 788 F.3d at 1363 (“relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible”). Thus, the Examiner correctly “considered the Declaration . . . but did not find it to be persuasive.” Ans. 5.

Appellants’ other evidence is the prior art previously relied upon by the Examiner to reject earlier versions of the claims as obvious. App. Br. 11. According to Appellants, the prior art is evidence that the claims here do not preempt the Examiner’s abstract idea because the prior art

practices the abstract idea in ways other than the claimed technique. *Id.*; *see also id.* at 16 (arguing no preemption), 18 (same).

But the Federal Circuit has “consistently held that claims that are otherwise directed to patent-ineligible subject matter cannot be saved by arguing the absence of complete preemption.” *Return Mail, Inc. v. U.S. Postal Service*, 868 F.3d 1350, 1370 (Fed. Cir. 2017); *see also* Ans. 5 (“the courts do not use preemption as a stand-alone test for eligibility”); Final Act. 8. “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). “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.” *Id.* Thus, Appellants’ alleged factual evidence of the prior art does not create a material factual dispute because, just as in *Mortgage Grader* and *FairWarning*, prior case law rejects Appellants’ argument.

Finally, Appellants argue “it would not be appropriate to take judicial notice that the present claims are directed to subject matter falling within a judicial exception because, as set forth above, in this case there is evidence that that is untrue.” App. Br. 14–15 (arguing the Supreme Court took judicial notice of fundamental economic practices in *Bilski* and *Alice* based on treatises). We need not address that issue here because the Examiner did not rely on (A) judicial notice or (B) the claims being directed to a fundamental economic practice. Rather, in accordance with the “decisional mechanism” set forth by the Federal Circuit in *Amdocs*, the Examiner

examined earlier cases having a similar or parallel descriptive nature and based his determination on that case law.

Step Two:

Whether the Claims Contain Significantly More than the Abstract Idea

In the second step of the *Alice/Mayo* framework, 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.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79, 78). The Supreme Court has “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.” *Id.* (quotation omitted). For computer-related technology, the Federal Circuit has held that a claim may pass the second step if “the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer [technology].” *DDR Holdings*, 773 F.3d at 1257.

Here, Appellants argue that “the claims are novel and not rendered obvious by the prior art” so therefore are a “far cry from something that could be fairly characterized as a basic tool of scientific and technological work.” App. Br. 18 (quotation omitted). “But § 101 subject-matter eligibility is a requirement separate from other patentability inquiries.” *Return Mail*, 868 F.3d at 1370; *see also* Ans. 6. Thus, “under the *Mayo/Alice* framework, a claim directed to a newly discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the novelty of that discovery for the inventive concept necessary for patent eligibility.” *Genetic*

Techs. Ltd. v. Merial L.L.C., 818 F.3d 1369, 1376 (Fed. Cir. 2016). Instead, the Supreme Court has held that “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981). Thus, the lack of a prior art rejection, by itself, does not render the claims less abstract or significantly more than an abstract idea.

Appellants also argue, for both step one and step two, that the problem in the prior art and the solution in the claims are “unique to the world of e-procurement.” App. Br. 15–16 (step one), 19 (step two); Reply Br. 12–13, 2–4. Appellants analogize to *DDR Holdings*, but that case involved “a challenge particular to the Internet” that did not exist in the physical world. *DDR Holdings*, 773 F.3d at 1257. In *DDR Holdings*, the Federal Circuit explained the key difference between a physical store and an online store:

[O]nce a customer enters a physical warehouse store, that customer may encounter a kiosk selling third-party cruise vacation packages. There is, however, no possibility that by walking up to this kiosk, the customer will be suddenly and completely transported outside the warehouse store and relocated to a separate physical venue associated with the third-party—the analog of what ordinarily occurs in “cyberspace” after the simple click of a hyperlink— . . . without any need to “return” to the aisles of the store after completing the purchase. It is this challenge of retaining control over the attention of the customer in the context of the Internet that the ’399 patent’s claims address.

DDR Holdings, 773 F.3d at 1258.

We are not persuaded here that the problem or solution are unique to e-procurement and divorced from problems arising, for example, in

procurement more generally. Other than generic components (e.g., a processor, a memory, and “electronic” supplier catalogs), a parent looking at a newspaper with movie theater timetables to filter movie possibilities for a child goes through the same process of a first user (the parent) deciding which results to “block” from the second user (the child). Similarly, an assistant going through two paper catalogs before presenting the top candidates to his or her boss likewise goes through the same process of one person (the assistant) filtering results for another person (the boss). Thus, the claims do not recite a technical problem or a technical solution specific to “electronic” procurement.

We also agree with the Examiner that “Appellant’s own specification indicates the computer components and functions are well-understood, routine and conventional activity.” Ans. 5 (citing Spec. ¶¶ 30–31); Final Act. 8–9. “[T]he claimed invention generally links the abstract idea to a particular technological environment” but “does not recite a specific way to override the routine conventional way that the claimed computer components operate.” Final Act. 9; *see also id.* at 4. Thus, the claimed electronic components may limit the field of use to e-procurement, but “[t]he Supreme Court and [the Federal Circuit] have repeatedly made clear that merely limiting the field of use of the abstract idea to a particular existing technological environment does not render the claims any less abstract.” *Affinity Labs of Texas, LLC v. DirecTV, LLC*, 838 F.3d 1253, 1259 (Fed. Cir. 2016); *Alice*, 134 S. Ct. at 2358.

In *BASCOM*, the Federal Circuit determined the claims provided an inventive concept *beyond* filtering, namely a central remote system doing “customizable filtering . . . specific to each end user.” *BASCOM*, 827 F.3d

at 1350 (relying in part on the specification’s explanation “how its particular arrangement of elements is a technical improvement over prior art ways of filtering such content,” as discussed at 827 F.3d at 1344). Here, however, none of the e-procurement components identified by Appellants provides any such inventive concept beyond filtering. Appellants’ reliance on “specific technology details” described in the Specification but not the claims also is unpersuasive. App. Br. 17.

Accordingly, we sustain the Examiner’s rejection of claim 1, and claims 3–20, which Appellants do not substantively argue separately. 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

For the reasons above, we affirm the rejection of claims 1 and 3–20.

No time for taking subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED