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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/687,273	03/16/2007	Grant I. Thrall	42238	7876

62487 7590 04/26/2018

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ART UNIT	PAPER NUMBER
3715	

MAIL DATE	DELIVERY MODE
04/26/2018	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GRANT I. THRALL and M. HARRY DANIELS

Appeal 2017-006492
Application 11/687,273
Technology Center 3700

Before STEVEN D.A. McCARTHY, MICHAEL L. HOELTER, and JEFFREY A. STEPHENS, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 31 and 33–48. Final Act. 1 (Office Action Summary). Claims 1–30 and 32 have been canceled. Br. 13 (Claims Appendix). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

THE INVENTION

The disclosed subject matter "relates to information systems." Spec. ¶ 1. Claims 31 and 39 are independent. Claim 31, reproduced below, is illustrative of the claimed subject matter:

> 31. A system for predicting future academic performance, the system comprising:
>
> a database storing a plurality of lifestyle segmentation profiles (LSPs), each of the LSPs being statistically correlated with past academic performance data from a plurality of profiled students and a plurality of geographic locations;
>
> a processor cooperating with the database and operable to:
>
> identify at which of the plurality of geographic locations the at least one unprofiled student resides;
>
> identify to which of the plurality of LSPs at least one unprofiled student belongs based on the identified geographic location; and
>
> generate an academic performance indicator statistically correlated to future academic performance of the at least one unprofiled student dependent on the identified LSP and the stored correlation of past academic performance data therewith.

REJECTION[1]

Claims 31 and 33–48 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to an abstract idea.

ANALYSIS

Based on Appellants' arguments (Br. 7–9), we will decide the appeal of the claims at issue based on claim 31 alone. 37 C.F.R. § 41.37(c)(1)(iv).

To determine whether a claim falls within a judicially recognized exception to patent eligibility under 35 U.S.C. § 101, we apply the two-step

[1] "The rejection under 35 U.S.C. [§] 112, first paragraph, set forth in the previous office action is withdrawn." Ans. 2.

framework set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1293–94 (2012), and reaffirmed in *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347, 2355 (2014). For the first step, we determine whether the claims at issue are directed to a patent-ineligible concept such as an abstract idea, law of nature, or natural phenomenon. *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 132 S. Ct. at 1296–97). If so, then "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" of the otherwise patent-ineligible concept. *Id.* (quoting *Mayo*, 132 S. Ct. at 1298, 1297). The Court has described this second step "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.* (citing *Mayo*, 132 S. Ct. at 1294 (internal quotation marks and alterations omitted)).

In the present case, and regarding the first step in the *Alice* framework, the Examiner determines "The claim(s) is/are directed to the abstract idea of a method of organizing human activities, or an idea of itself."[2] Final Act. 2. Regarding the second step, the Examiner determines, "The additional element(s) or combination of elements in the claim(s) other than the abstract idea per se amount(s) to no more than recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known

[2] The Examiner explains, "the current claimed invention can be performed, for example, **by a human using a pen and paper** (*which is one of the tests to prove whether a given claim is directed to an 'abstract idea'*)." Ans. 13; *see also id.* at 12. Appellants do not argue that this is not the case.

to the pertinent industry." Final Act. 2; *see also id.* at 3; Ans. 11–12. In short, and as per the Examiner, "none of the current claims involves a feature(s) that transforms the claim(s) to 'significantly more' than the abstract idea itself." Ans. 8–9.

Appellants contend, "the second step of the § 101 analysis [] is clearly satisfied." Br. 7. This is because claim 31 recites "[a] system for predicting future academic performance" by correlating data and the claims "would have no impact on academic performance indicators generated based on peer groupings yet to be identified." Br. 8. In other words, "the claims would not monopolize the act of correlation *per se*" and "the claims do not prevent others from studying the correlation, or utilizing the correlation for purposes other than the generation of academic performance indicators." Br. 8; *see also id.* at 9.

The Examiner explains, "the courts do not use preemption as a stand-alone test for eligibility." Ans. 10. There is merit to the Examiner's explanation because we are instructed that "the exclusion applies if a claim involves a natural law or phenomenon or abstract idea, even if the particular natural law or phenomenon or abstract idea at issue is narrow." *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1353 (Fed. Cir. 2014) (citing *Mayo*, 132 S. Ct. at 1303); *see also Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (holding that "[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility"). Accordingly, Appellants' arguments on this point are not persuasive of Examiner error.

Appellants further contend that claim 31 satisfies "the next step of the § 101 analysis – because a system that specifically requires a database [] and a processor [] recite significantly more than 'making one or more

predictions.'" Br. 9 (referencing Final Act. 3). However, the Examiner has explained that this additional recitation to "a database" and "a processor" "amount(s) to no more than recitation of generic computer structure that serves to perform generic computer functions." Final Act. 2; *see also* Ans. 11–12. As such, the Examiner explains, "these additional claim element(s) do not provide meaningful limitation(s) to transform the abstract idea into a patent eligible application of the abstract idea such that the claim(s) amounts to significantly more than the abstract idea itself." Final Act. 3; *see also* Ans. 8–9, 11–12.

Our reviewing court has provided instruction that "[u]sing a computer to accelerate an ineligible mental process does not make that process patent-eligible." *Bancorp Servs. L.L.C. v. Sun Life Assur. Co. of Canada (U.S.)*, 687 F.3d 1266, 1279 (Fed. Cir. 2012). As also instructed, claims involving data collection, analysis, and publication are directed to an abstract idea. *Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (holding that "collecting information, analyzing it, and displaying certain results of the collection and analysis" are "a familiar class of claims 'directed to' a patent ineligible concept"). Similarly, we are informed that 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. In other words, adding the words "apply it with a computer" cannot convert a patent-ineligible abstract idea into a patent-eligible invention. *Alice*, 134 S. Ct. at 2358. Accordingly, Appellants' arguments on this point are not persuasive of Examiner error.

Appellants further "submit[] that the correlation discovered by the present inventors is more in the line of a natural phenomenon than an abstract idea. Br. 8; *see also id.* at 9. Even though Appellants distinguish

this statement (*see* Br. 8), the Examiner clearly states, "the judicial exception 'natural phenomena' does not apply to the current claimed invention." Ans. 10. Hence we do not pursue Appellants' self-characterization of the claims on appeal as "more in the line of a natural phenomenon." Br. 8.

For the above reasons, we sustain the Examiner's rejection of claims 31 and 33–48 under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.

DECISION

We affirm the Examiner's rejection of claims 31 and 33–48.

No time period for taking any subsequent action in connection with this appeal may be extended as set forth in 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED