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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* ANDRE G. LAVOIE and DARREN J. CHUN

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Appeal 2017-007053  
Application 12/635,568  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, AMEE A. SHAH, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

The Appellants<sup>2</sup> appeal under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 1–9, 12–14, 18–26, 29–31, and 35–47 under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b).

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<sup>1</sup> Throughout this decision, we refer to the Appellants' Appeal Brief ("Br.," filed Nov. 21, 2016) and Specification ("Spec.," filed Dec. 10, 2009, as amended Feb. 7, 2012), and to the Examiner's Answer ("Ans.," mailed Jan. 27, 2017) and Final Office Action ("Final Act.," mailed May 12, 2016).

<sup>2</sup> According to the Appellants, the real party in interest is "Thomson Reuters Global Resources (TRGR)." Appeal Br. 2.

## STATEMENT OF THE CASE

The Appellants' invention "relates generally to a computer-implemented system and method for facilitating the creation, management, and valuation of securities research within the financial services industry." Spec. ¶ 1.

Claims 1 and 18 are the independent claims on appeal. Claim 1 (Claims App. 29) is exemplary of the subject matter on appeal and is reproduced below.

1. A computer-implemented method for creating, managing, and valuing securities research, the method being implemented by a computer having one or more physical processors programmed by computer program instructions that, when executed by the one or more physical processor, cause the computer to perform the method, the method comprising:

receiving, by the computer, sell-side research content that includes a plurality of information items comprising at least a first content piece from a sell-side entity;

receiving, by the computer, a first feedback on the first content piece from one or more buy-side entities, wherein the first feedback comprises a rating score for the first content piece;

storing, by the computer, the first feedback on the first content piece in a memory associated with the computer;

receiving, by the computer, via a user interface, a command to access the first content piece of the sell-side document;

in response to the received command, causing, by the computer, the first content piece to be launched in an instance of an application, separate from and executing within the user interface, that generated the first content piece;

determining, by the computer, a number of times the first content piece has been accessed;

storing, by the computer in the memory, information indicative of the number of times the first content piece has been accessed;

providing, by the computer, the sell-side entity access to the first feedback and the information indicative of the number of times the first content piece has been accessed stored in the memory associated with the computer; and

allocating, by the computer, a commission for the sell-side entity based on the first feedback.

### ANALYSIS

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. 589 (2013)).

The Supreme Court in *Alice* reiterated the two-step framework, set forth previously in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78–79 (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. The first step in that analysis is to “determine whether the claims at issue are *directed to* one of those patent-ineligible concepts.” *Id.* (emphasis added) (citing *Mayo*, 566 U.S. at 79). If so, the second step is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine

whether the additional elements “transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 78–79).

Although “claim construction is not an inviolable prerequisite” to an analysis under § 101, “a full understanding of the basic character of the claimed subject matter” is, nevertheless, needed to evaluate questions of subject-matter eligibility. *Bancorp Servs., LLC v. Sun Life Assur. Co. of Canada (U.S.)*, 687 F.3d 1266, 1273–74 (Fed. Cir. 2012). *See also McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1311 (Fed. Cir. 2016) (“As an initial matter, we note that, in this case, claim construction is helpful to resolve the question of patentability under § 101.”)

In the present Appeal, we are unable to ascertain such an understanding of the claimed subject matter and, therefore, we do not assess the merits of the rejection under § 101. Rather, for the reasons given below, and pursuant to our authority under 37 C.F.R. § 41.50(b) to enter a new ground of rejection, we determine that the claims are indefinite under 35 U.S.C. § 112, second paragraph. Accordingly, the rejection under § 101 must fall, *pro forma*, because it is necessarily based upon speculative assumption as to the meaning of the claims. *See In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (addressing an obviousness rejection). This determination does not reflect on the merits of the underlying rejection based upon § 101.

#### NEW GROUND OF REJECTION UNDER 35 U.S.C. § 112

Claims 1–9, 12–14, 18–26, 29–31, and 35–47 are rejected under pre-AIA 35 U.S.C. § 112, second paragraph.

The text of pre-AIA 35 U.S.C. § 112, second paragraph, requires “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the [Appellants] regard[] as the invention.” “As the statutory language of ‘particular[ity]’ and ‘distinct[ness]’ indicates, claims are required to be cast in clear — as opposed to ambiguous, vague, indefinite-terms.” *In re Packard*, 751 F.3d 1307, 1313 (Fed. Cir. 2014). Claims are in compliance with 35 U.S.C. § 112(b)/second paragraph if “the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits.” *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385 (Fed. Cir. 1986) (citing *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624 (Fed. Cir. 1985)). Thus, the test for determining the question of indefiniteness may be formulated as whether the claims “set out and circumscribe a particular area with a reasonable degree of precision and particularity.” *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). With regard to the reasonableness standard, one must consider the language in the context of the circumstances. *Packard*, 751 F.3d at 1313. Language is an imprecise method of drawing boundaries delineating patent rights, thus unreasonable precision cannot be demanded. *Id.* On the other hand, the claims must notify the public of what they are excluded from making and using. *Id.* For this reason, while exact precision is not required, an applicant is required to use language as precise as the subject matter reasonably permits. *Id.*

Independent claims 1 and 18 include the limitation of instructions that, when executed, cause a computer to, “in response to the received

command, cause the first content piece to be launched in an instance of an application, separate from and executing within the user interface, that generated the first content piece.” Appeal Br. 33 (Claims App.); *see also id.* at 29. The Appellants cite to the Specification at paragraph 75 and Figure 8 as support for this limitation. *See id.* at 3–4. Paragraph 75 of the Specification provides for the usage module to track and record usage such that “the total number of times an asset has been read (e.g., accessed or launched).” Figure 8 depicts components of a sell-side report (*see Spec.* ¶ 24) and shows the phrase “ACCESS/LAUNCH CUSTOM CHART ASSET.” There are no specific definitions for the terms “content piece” or “launch” in the Specification, including the claims, and no description of how the computer causes a piece to be “launched.”

The dictionary meaning of “launch” in this context can be to start, put into operation or motion, or to load into a computer and run. Merriam-Webster Online Dictionary, available at <https://www.merriam-webster.com/dictionary/launch>, last visited Dec. 17, 2018. Paragraph 73 of the Specification provides that “[w]hen research report 800 is accessed by a user, the user may access or launch one or more of the individual assets comprising research report 800,” and that “a user may launch an asset (e.g., custom chart asset 804), modify it, and then save it as a new asset for later use.” Paragraph 74 provides for a user to “access/launch an asset in a dynamic document by, for example, double-clicking on (or otherwise selecting) any portion of the asset,” and that “[a] user may dynamically launch an asset by selecting its corresponding icon (or other representation) from the asset list.” Thus, in light of the Specification, to launch a content piece appears to mean to open an asset such as a document or file.

However, it is not clear how the computer causes the content piece to be launched/opened “in an instance of an application, separate from and executing within the user interface, that generated the first content piece.” Based on a review of the Specification, a user causes a content to be launched. *See supra*; Spec. ¶¶ 73, 74. But we do not see how – technologically or by what steps – the computer causes a content piece to be launched in an application, separate from and executing within the user interface, that generated the first content piece, as claimed. Paragraph 74 provides that “[a]n instance of the application used to create the asset may be launched in the user interface (e.g., via a plug-in),” but does not discuss launching a content piece in an instance of the application. Paragraph 74 also provides that “a larger picture/view of the asset may be launched in the viewer, but without dynamic capabilities,” but does not discuss how the piece is launched by a computer “in an instance of an application, separate from and executing within the user interface, that generated the first content piece,” as claimed. As such, the limitation is not clear as to what it entails, and we cannot ascertain the scope of the invention.

Therefore, we enter a new ground of rejection of independent claims 1 and 18, along with dependent claims 2–9, 12–14, 19–26, 29–31, and 35–47, under 35 U.S.C. § 112, second paragraph, for failure to particularly point out and distinctly claim the subject matter regarded as the invention.

#### DECISION

We REVERSE the Examiner’s decision rejecting claims 1–9, 12–14, 18–26, 29–31, and 35–47, *pro forma*.

We ENTER A NEW GROUND OF REJECTION for claims 1–9, 12–14, 18–26, 29–31, and 35–47 under 35 U.S.C. § 112(b).

This Decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds 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 proceeding will be remanded to the Examiner. . . .
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. . . .

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).

REVERSED; 37 C.F.R. § 41.50(b).