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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEFFREY THOMAS KLUMPP, JOHN THOMAS LYNCH II,
JONATHAN GRIMM, VLADIMIR ZELEVINSKY, and BENJAMIN
TRAFTON

Appeal 2017-007530
Application 13/469,761¹
Technology Center 3600

Before ERIC S. FRAHM, CATHERINE SHIANG, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
rejection of claims 1–26, which are all the claims pending in the application.

We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify Oracle International Corporation as the real party in
interest. App. Br. 2.

STATEMENT OF THE CASE

Introduction

According to the Specification, the present invention relates “to a computer system, and in particular to a computer system that generates web site analytics.” Spec. ¶ 2. Claim 1 is exemplary:

1. A non-transitory computer readable medium having instructions stored thereon that, when executed by a processor, cause the processor to generate web page analytics, the generate web page analytics comprising:

generating at a server a plurality of e-commerce web pages, each web page comprising a plurality of products and a plurality of web page sections, and different values are assigned to different sections of the web page, wherein each product is displayed in at least one of the sections of the web page and is a product available for purchase to a user of the e-commerce web page, wherein the e-commerce web page is displayed on a client device accessible by the user;

receiving a plurality of selections by a user at the client device of one or more of the products;

in response to each selection, logging data received from the client device comprising a selected product and a section of the web page where the selected product was displayed when it was selected by the user, wherein the section of the web page where the selected product was displayed is transmitted from the client device to the server after the product is selected by the user; and

generating web page analytics from the logged data, wherein the analytics are based at least on the selected product and the values that correspond to the section of the web page where the selected product was displayed.

References and Rejections²

Claims 1–26 stand rejected under 35 U.S.C. § 101 because they are directed to patent-ineligible subject matter. Final Act. 6–8.

Claims 1–5, 7–9, 11–13, 15–17, 19–21, and 23–25 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Gessner (US 2013/0030908 A1; published January 31, 2013) and Newton (US 2011/0314142 A1; published December 22, 2011). Final Act. 9–21.

Claims 6, 10, 14, 18, 22, and 26 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Gessner, Newton, and Chickering (US 7,143,075 B1; issued November 28, 2006). Final Act. 21–24.

ANALYSIS

35 U.S.C. § 101

With respect to the Examiner’s rejection under 35 U.S.C. § 101, we disagree with Appellants’ arguments, and agree with and adopt the Examiner’s findings and conclusions in (i) the action from which this appeal is taken and (ii) the Answer to the extent they are consistent with our analysis below.³

² Throughout this opinion, we refer to the (1) Final Rejection dated July 19, 2016 (“Final Act.”); (2) Appeal Brief dated December 19, 2016 (“App. Br.”); (3) Examiner’s Answer dated February 16, 2017 (“Ans.”); and (4) Reply Brief dated April 17, 2017 (“Reply Br.”).

³ To the extent Appellants advance new arguments in the Reply Brief without showing good cause, Appellants have waived such arguments. *See* 37 C.F.R. § 41.41(b)(2).

The Examiner rejects the claims under 35 U.S.C. § 101 because they are directed to patent-ineligible subject matter. *See* Final Act. 6–9; Ans. 4–6. In particular, the Examiner concludes the claims are directed to the abstract idea of managing information. *See* Ans. 4. The Examiner determines the claims do not identify an inventive concept to transform the nature of the claims into a patent-eligible application. *See* Ans. 5. Appellants argue the Examiner erred. *See* App. Br. 4–9; Reply Br. 2–4.

Appellants have not persuaded us of error. Section 101 of the Patent Act provides “[w]hoever 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. That 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.*, 133 S. Ct. 2107, 2116 (2013)). According to the Supreme Court:

[W]e set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . If so, we then ask, “[w]hat else is there in the claims before us?” . . . To answer that question, 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. . . . We have 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.”

Alice Corp., 134 S. Ct. at 2355 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S.Ct. 1289, 1294, 1296–98 (2012)).

The Federal Circuit has described the *Alice* step-one inquiry as looking at the “focus” of the claims, their “character as a whole,” and the *Alice* step-two inquiry as looking more precisely at what the claim elements add—whether they identify an “inventive concept” in the application of the ineligible matter to which the claim is directed. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

Regarding *Alice* step one, the Federal Circuit has “treated *collecting information*, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.” *Elec. Power*, 830 F.3d at 1353 (emphasis added); *see also Internet Patents*, 790 F.3d at 1348–49; *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015); *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014). “In a similar vein, we have treated *analyzing information* [including manipulating information] by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Elec. Power*, 830 F.3d at 1354 (emphasis added); *see also In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016). “And we have recognized that *merely presenting the results of abstract processes of collecting and analyzing information, without more* (such as identifying a particular tool for presentation), is abstract as an

ancillary part of such collection and analysis.” *Elec. Power*, 830 F.3d at 1354 (emphasis added); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714–15 (Fed. Cir. 2014).

The rejected claims “fall into a familiar class of claims ‘directed to’ a patent-ineligible concept.” *Elec. Power*, 830 F.3d at 1353. Contrary to Appellants’ arguments (App. Br. 4–9; Reply Br. 2–4), we agree with the Examiner that the claims are similar to the claims of *Electric Power*, and are focused on the combination of abstract-idea processes or functions. *See Elec. Power*, 830 F.3d at 1354; Ans. 4. For example, claim 1 is directed to receiving and collecting information (“receiving . . . logging . . .”), analyzing and generating information (“generating . . .”), and displaying information (“. . . displayed . . .”). *See Elec. Power*, 830 F.3d at 1353. Claims 11 and 19 are similarly directed to receiving and collecting information, analyzing and generating information, and displaying information. The dependent claims are directed to similar functions or processes, and Appellants have not shown such claims are directed to other non-abstract functions or processes. *See* claims 2–10, 12–18, and 20–26.

Appellants’ attorney argument that the claims “recite a new type of information” (Reply Br. 3) is unsupported by evidence and unpersuasive. *See In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997) (“attorney argument [is] not the kind of factual evidence that is required to rebut a prima facie case of obviousness”); *Meitzner v. Mindick*, 549 F.2d 775, 782 (CCPA 1977) (“Argument of counsel cannot take the place of evidence lacking in the record.”). To the contrary, the claimed “a selected product and a section of the web page where the selected product was displayed when it was selected by the user” merely recites a certain information content on a web page—not

a new type of information as Appellants argue, and Appellants have not shown such information content renders the claims patent eligible.

Further, Appellants' assertion regarding pre-emption (App. Br. 8–9) is unpersuasive, because “[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility 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.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP*, 788 F.3d at 1362–63 (“that the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract”).

In addition, Appellants' assertion (App. Br. 9; Reply Br. 3) about *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016) is unpersuasive. In *McRO*, the Court determines:

Claim 1 of the '576 patent is focused on *a specific asserted improvement in computer animation*, i.e., the automatic use of rules of a particular type. . . . It is the incorporation of the claimed rules, not the use of the computer, that “improved [the] existing technological process” by allowing the automation of further tasks

Further, the automation goes beyond merely “organizing [existing] information into a new form” or carrying out a fundamental economic practice. *The claimed process uses a combined order of specific rules that renders information into a specific format that is then used and applied to create desired results: a sequence of synchronized, animated characters.*

McRO, 837 F.3d at 1314–15 (emphases added) (citations omitted).

This case is distinguished from *McRO* because unlike the claims of *McRO*, the rejected claims are not directed to “a specific asserted

improvement in computer animation,” let alone “us[ing] a combined order of specific rules that renders information into a specific format that is then used and applied to create desired results: a sequence of synchronized, animated characters.” *McRO*, 837 F.3d at 1314–15.⁴

Regarding *Alice* step two, contrary to Appellants’ assertion (App. Br. 4–9; Reply Br. 2–4), Appellants have not shown the claims in this case require any “inventive concept” or inventive set of components or methods, or invoke any assertedly inventive programming. *Elec. Power*, 830 F.3d at 1355.

Further, contrary to Appellants’ arguments (App. Br. 4–9; Reply Br. 2–4), the claims are similar to the claims of *Electric Power*, because they do not require any nonconventional computer, network, or display components, or even a “non-conventional and non-generic arrangement of known, conventional pieces,” but merely call for performance of the claimed information collection, analysis, and display functions on generic computer components and display devices. *See Elec. Power*, 830 F.3d at 1355; *see also* claim 1 (reciting a “non-transitory computer readable medium . . . a processor . . . a server . . . a client device”); claims 11 and 19 (each reciting similar components and devices). The dependent claims call for similar generic components and devices, and Appellants have not shown such claims require any non-conventional components or devices. *See* claims 2–10, 12–18, and 20–26.

Similar to the claims of *Electric Power*, the rejected claims specify

⁴ Appellants’ attorney argument that the claimed invention “require[s] a computer” (App. Br. 6) is unsupported by evidence and unpersuasive. In any event, Appellants have not shown using a generic computer renders the claims patent eligible.

what information is desirable to gather, analyze, and display, but they “do not include any requirement for performing the claimed functions of gathering, analyzing, and displaying . . . by use of anything but entirely conventional, generic technology.” *Elec. Power*, 830 F.3d at 1356.

Therefore, similar to the claims of *Electric Power*, the rejected claims “do not state an arguably inventive concept in the realm of application of the information-based abstract ideas.” *Id.* at 1356.

Appellants’ argument about the absence of a credible prior art rejection (App. Br. 7–8; Reply Br. 3–4) is unpersuasive, because a prior art rejection is determined under 35 U.S.C. § 102 and § 103, which are different statutory requirements. As the Supreme Court emphasizes: “[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) (emphasis added). Our reviewing court further guides that “[e]ligibility and novelty are separate inquiries.” *Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017).

Appellants cite *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016) (App. Br. 7), but do not persuasively explain why that case is similar to the present case. In *BASCOM*, the court determined that at the pleading stage and construed in favor of the nonmovant,

[t]he inventive concept described and claimed . . . 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. This design gives the filtering tool both the

benefits of a filter on a local computer and the benefits of a filter on the ISP server. BASCOM explains that the inventive concept rests on taking advantage of the ability of at least some ISPs to identify individual accounts that communicate with the ISP server, and to associate a request for Internet content with a specific individual account.

Id. at 1350 (emphasis added).

The rejected claims are unlike the claims of *BASCOM* because they are not directed to an “installation of a filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each end user.” *Id.* at 1350. Nor do they “give[] the filtering tool both the benefits of a filter on a local computer and the benefits of a filter on the ISP server.” *Id.* In fact, the pending claims do not even recite any “ISP server.”

In short, Appellants have not shown the claims, read in light of the Specification, require anything other than conventional computer, network, and display technology for collecting, analyzing, and presenting the desired information. *See Elec. Power*, 830 F.3d at 1354. Such invocations of computers and networks are “insufficient to pass the test of an inventive concept in the application” of an abstract idea and, therefore, do not add significantly more to that idea. *Id.* at 1355 (citation omitted).

Because Appellants have not persuaded us the Examiner erred, we sustain the Examiner’s rejection of claims 1–26 under 35 U.S.C. § 101.

35 U.S.C. § 103

We have reviewed the Examiner’s rejection in light of Appellants’ contentions and the evidence of record. We concur with Appellants’ contention that the Examiner erred in determining the cited portions of

Gessner and Newton collectively teach “wherein the section of the web page where the selected product was displayed is transmitted from the client device to the server *after the product is selected by the user*,” as recited in independent claim 1 (emphasis added). *See* App. Br. 11–13; Reply Br. 4.

The Examiner finds “Gessner does not explicitly teach” the above limitation. Final Act. 12. The Examiner then cites Newton’s paragraph 105, but does not specifically map the italicized limitation. *See* Final Act. 12. Appellants argue, and we agree, Newton’s paragraph 105 does not teach “after the product is selected by the user,” let alone “wherein the section of the web page where the selected product was displayed is transmitted from the client device to the server after the product is selected by the user,” as required by claim 1. *See* App. Br. 12–13.

In response to Appellants’ arguments, the Examiner determines “[t]he claim language only requires that after a user makes a selection, data is logged about the section of the page the product was located, and then web page analytics are generated.” Ans. 6. That determination contradicts claim 1, which requires “wherein the section of the web page where the selected product was displayed is transmitted from the client device to the server *after the product is selected by the user*” (emphasis added).

Because the Examiner fails to provide sufficient evidence or explanation to support the rejection, we are constrained by the record to reverse the Examiner’s rejection of claim 1.

Each of independent claims 11 and 19 recites a claim limitation that is substantively similar to the disputed limitation of claim 1. *See* claims 11 and 19. Therefore, for similar reasons, we reverse the Examiner’s rejection of independent claims 11 and 19.

We also reverse the Examiner's rejection of corresponding dependent claims 2–10, 12–18, and 20–26. Although the Examiner cites an additional reference for rejecting some dependent claims, the Examiner has not shown the additional reference overcomes the deficiency discussed above in the rejection of claim 1.

DECISION

We affirm the Examiner's decision rejecting claims 1–26.

Because we affirm at least one ground of rejection with respect to each claim on appeal, we affirm the Examiner's decision rejecting claims 1–23. *See* 37 C.F.R. § 41.50(a)(1).

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED