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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* CHRISTOPHER L. HOLT

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Appeal 2017-008341  
Application 11/823,557  
Technology Center 2100

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Before ERIC B. CHEN, JEREMY J. CURCURI, and  
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the non-final rejection of claims 1–10, 12, 14–16, 18, 20, and 21. Claim 11, 13, 17, and 19 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

An oral hearing was held on April 17, 2019. The record includes a written transcript of the oral hearing.

We affirm.

### STATEMENT OF THE CASE

Appellant’s invention relates to a patent examiner information accessing system, such that a user can search information aggregated by the system. (Abstract.)

Claims 1, 10, and 16 are exemplary, with disputed limitations in italics:

1. A computer-implemented patent data accessing system, comprising:

[i] a data store containing a collection of patent office actions generated by at least one patent examiner during administrative prosecution of a plurality of different patent applications, and *grouped by patent examiner and by type of rejection*;

[ii] a data aggregation system that identifies rejection types of rejections in the patent office actions for each patent examiner based on a statutory section under which the rejections are made;

[iii] a data search component that counts a number of office actions issued before allowance in each of the plurality of different patent applications, and calculates and stores in the data store, an average number of office actions before allowance for each patent examiner, and that, in response to receiving a search request identifying a specific patent examiner and rejection type, searches the data store and identifies and returns a subset of the collection of patent office actions, wherein the subset is a set of the patent office actions that are identified as containing a denial of patentability based on the

rejection type for the specific patent examiner identified in the search request and wherein the data search component, in response to receiving a search request identifying the specific patent examiner, searches the data store and identifies and returns the average number of office actions before allowance for the specific patent examiner; and

[iv] a computer processor that is a functional component of a computing device, the computer processor being utilized by the data search component to facilitate said identification of the subset of the collection of patent office actions.

10. A data accessing system, comprising:

[i] a computer-implemented identifier that analyzes textual content of office actions generated by a patent examiner during prosecution of a patent application and identifies rejection bases based on the analysis of the textual content of the office actions, the rejection bases corresponding to a statutory section upon which the rejections are based, and *wherein the identifier generates a data store storing plurality of office actions arranged by patent examiner and rejection bases*;

[ii] a component that calculates a set of statistics indicative of how often each patent examiner uses each rejection basis;

[iii] a report generation system that receives a request identifying a specific patent examiner and, in response, retrieves the set of statistics identifying how often the specific patent examiner uses each of a plurality of different rejection bases;

[iv] a computer processor that is a component of a computing device, the computer processor being utilized by the computer-implemented identifier to facilitate said identification of the rejection basis.

16. A computer-implemented method of providing information, the method comprising:

[i] obtaining a computer readable data store of a plurality of different office actions generated by a given patent examiner during administrative prosecution of a plurality of different patent applications;

[ii] utilizing a computer processor that is a component of a computing device to count a number of office actions before allowance in each of the plurality of different patent applications;

[iii] using the computer processor to generate a statistic indicative of an average number of office actions issued before allowance for the given patent examiner, based on the count;

[iv] repeating steps of obtaining, utilizing and generating a statistic for a plurality of different patent examiners to generate a data store of sets of office actions and statistics arranged by patent examiner;

[v] receiving a query that contains an indication of a specific patent examiner;

[vi] comparing the indication of the specific patent examiner to the data store;

[vii] determining if the indication of the specific patent examiner matches a patent examiner in the data store;

[viii] if it matches, then responding to the query by displaying an indication of the statistic showing an average number of office actions issued before allowance in the patent applications for the specific patent examiner; and

[ix] if it does not match, then responding to the query indicating that no match is found.

Claims 1–10, 12, 14–16, 18, 20, and 21 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.

Claims 1–9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Luchene (US 2007/0219853 A1; Sept. 20, 2007), Ikeda (US 6,505,195 B1; Jan. 7, 2003), Mueller (US 2007/0219854 A1; Sept. 20, 2007), and Greening (US 2001/0013009 A1; Aug. 9, 2001).

Claims 10, 12, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Luchene, Ikeda, and Mueller.

Claims 16, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Luchene, Greening, and Carr (US 2007/0050238 A1; Mar. 1, 2007).

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Luchene, Greening, Carr, and Ikeda.

## ANALYSIS

### *§ 101 Rejection*

We are unpersuaded by Appellant’s arguments (App. Br. 11–17; *see also* Reply Br. 2–6) that independent claims 1, 10, and 16 are directed to patent-eligible subject matter under 35 U.S.C. § 101.

The Examiner determined that independent claims 1, 10, and 16 “read, retrieval data being organized and classified and stored to the system,” which is analogous to *Digitech Image Techs., LLC v. Electronics for Imaging, Inc.*, 758 F.3d 1344 (Fed. Cir. 2014). (Ans. 4.) Moreover, the Examiner determined that the limitations

counting number office actions issue before allowance, calculate and store in the data store an average number of office action, in claim 1, and calculate a set of statistic indicative of how often each patent examiner uses each rejection basis in claim 10, and using the computer to generate a statistic indicative of an average number of office action issued before allowance . . . for plurality of different examiners in claim 16 are the mathematical calculation either to provide a statistic of examiner using rejection or average number of office action before allowance

are analogous to *Cyberfone Sys. v. CNN Interactive Grp.*, 558 Fed. Appx. 988 (Fed. Cir. 2014). (*Id.*) In addition, the Examiner determined that the claims 1, 10, and 16 “do not include additional elements that are sufficient to

amount to significantly more than the judicial exception.” (*Id.* at 2.) We agree with the Examiner’s determinations and ultimate conclusion that the claims are directed to patent-ineligible subject matter.

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191

(1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 176; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (citation omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing]

generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of § 101. USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019). Under that guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h) (9th ed. 2019)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

- (3) adds a specific limitation beyond the judicial exception that are not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or
- (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

*See* 84 Fed. Reg. at 56.

*Are the claims at issue directed  
to a patent-ineligible concept?*

### Step One

Claim 1 is a data accessing system claim, which falls within the “manufacture” category of 35 U.S.C. § 101. Likewise, claim 10 is a data accessing system, which also falls within the “manufacture” category of 35

U.S.C. § 101, and claim 16 is a computer-implemented method claim, which falls within the “process” category of 35 U.S.C. § 101. Therefore, claims 1, 10, and 16 fall within one of the four statutory categories of patentable subject matter identified by 35 U.S.C. §101.

Although claims 1, 10, and 16 fall within the statutory categories, we must still determine whether the claims are directed to a judicial exception, namely an abstract idea. *See Alice*, 573 U.S. 208 (2014). Thus, we must determine whether the claims recite a judicial exception and whether the exception is integrated into a practical application. *See* 84 Fed. Reg. at 52–55. If both elements are satisfied, the claim is directed to a judicial exception under the first step of the *Alice/Mayo* test. *See id.*

#### Step 2A, Prong One

Appellant’s application is entitled “Examiner Information System.” (Spec. 1.) Appellant discloses that “there is currently no convenient way to efficiently gather information on an Examiner-specific basis.” (*Id.*) Appellant, therefore, provides a system that “aggregates data and can index it in a variety of different ways, illustratively one way is by Examiner, and stores it in aggregated Examiner data store.” (*Id.* at 2.)

#### *Independent Claim 1*

Independent claim 1 is a system claim, and includes the following limitation: “[i] a collection of patent office actions generated by at least one patent examiner during administrative prosecution of a plurality of different patent applications . . . .” Such limitation of claim 1 is directed to a patent-ineligible abstract idea of certain methods of organizing human activity,

such as a collecting data. *See, e.g., Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (“collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.”).

Moreover, independent claim 1 recites: “[ii] a collection of patent office actions . . . grouped by patent examiner and by type of rejection,” “[iii] a data aggregation system that identifies rejection types of rejections in the patent office actions for each patent examiner based on a statutory section under which the rejections are made,” and “[iv] a data search component that counts a number of office actions issued before allowance in each of the plurality of different patent applications, and calculates and stores in the data store, an average number of office actions before allowance for each patent examiner . . . searches the data store and identifies and returns a subset of the collection of patent office actions, wherein the subset is a set of the patent office actions that are identified as containing a denial of patentability based on the rejection type for the specific patent examiner identified in the search request . . . identifying the specific patent examiner, searches the data store and identifies and returns the average number of office actions before allowance for the specific patent examiner.” Such limitations of claim 1 are directed to a patent-ineligible abstract idea of mathematical concepts, such as the use of mathematical algorithms to manipulate existing information. *See, e.g., Digitech Image Techs., LLC v. Electronics for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014) (“[w]ithout additional limitations, a process that employs mathematical algorithms to manipulate existing information to generate additional information is not patent eligible”).

*Independent Claim 10*

Independent claim 10 is a system claim, and includes the following limitations: “[i] analyzes textual content of office actions generated by a patent examiner during prosecution of a patent application and identifies rejection bases based on the analysis of the textual content of the office actions, the rejection bases corresponding to a statutory section upon which the rejections are based, and wherein the identifier generates a data store storing plurality of office actions arranged by patent examiner and rejection bases” and “[ii] calculates a set of statistics indicative of how often each patent examiner uses each rejection basis.” Such limitations of claim 10 are directed to a patent-ineligible abstract idea of mathematical concepts, such as the use of mathematical concepts to manipulate existing information.

*See, e.g., Digitech*, 758 F.3d at 1351.

Additionally, independent claim 10 recites “[iii] receives a request identifying a specific patent examiner and, in response, retrieves the set of statistics identifying how often the specific patent examiner uses each of a plurality of different rejection bases.” Such limitation of claim 10 is directed to a patent-ineligible abstract idea of certain methods of organizing human activity, such as routing information. *See Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1337 (2017) (“The claim requires the functional results of . . . ‘routing,’ . . . but does not sufficiently describe how to achieve these results in a non-abstract way”).

*Independent Claim 16*

Independent claim 16 is a method claim, and includes the following limitation: “[i] obtaining . . . a plurality of different office actions generated

by a given patent examiner during administrative prosecution of a plurality of different patent applications.” Such limitation of claim 16 is directed to a patent-ineligible abstract idea of certain methods of organizing human activity, such as a collecting data. *See, e.g., Elec. Power Grp.*, 830 F.3d at 1353.

Additionally, independent claim 16 recites the following: “[iii] generate a statistic indicative of an average number of office actions issued before allowance for the given patent examiner, based on the count,” “[iv] repeating steps of obtaining, utilizing and generating a statistic for a plurality of different patent examiners to generate a data store of sets of office actions and statistics arranged by patent examiner,” “[vi] comparing the indication of the specific patent examiner,” and “[vii] determining if the indication of the specific patent examiner matches a patent examiner.” Such limitations of claim 16 are directed to a patent-ineligible abstract idea of mathematical concepts, such as the use of mathematical algorithms to manipulate existing information. *See, e.g., Digitech*, 758 F.3d at 1351.

Additionally, independent claim 16 recites “[viii] if it matches, then responding to the query by displaying an indication of the statistic showing an average number of office actions issued before allowance in the patent applications for the specific patent examiner” and “[ix] if it does not match, then responding to the query indicating that no match is found.” Such limitations of claim 16 are directed to a patent-ineligible abstract idea of certain methods of organizing human activity, such as routing information. *See Two-Way Media Ltd.*, 874 F.3d at 1337.

Step 2A, Prong Two

Because claims 1, 10, and 16 recite a judicial exception, we next determine if the claims recite additional elements that integrate the judicial exception into a practical application.

System claim 1 recites “[i] a *data store* containing a collection of patent office actions generated by at least one patent examiner during administrative prosecution of a plurality of different patent applications” and “[iv] a *computer processor* . . . being utilized by the data search component to facilitate said identification of the subset of the collection of patent office actions” (emphases added). Similarly, system claim 10 recites “[iv] a *computer processor* . . . being utilized by the computer-implemented identifier to facilitate said identification of the rejection basis.” Moreover, method claim 16 recites “[i] obtaining a *computer readable data store* of a plurality of different office actions generated by a given patent examiner during administrative prosecution of a plurality of different patent applications,” “[ii] utilizing a *computer processor* that is a component of a computing device to count a number of office actions before allowance in each of the plurality of different patent applications,” and “[iii] using the *computer processor* to generate a statistic indicative of an average number of office actions issued before allowance for the given patent examiner . . . .”

The recited computer hardware, including the recited “data store” (or “computer readable data store”), “computer processor,” and “computing device,” are merely tools for performing the abstract idea. *See Affinity Labs v. DirecTV*, 838 F.3d 1253, 1262 (Fed. Cir. 2016) (“the claims are directed not to an improvement in cellular telephones but simply to the use of cellular telephones as tools in the aid of a process focused on an abstract idea”).

Accordingly, claims 1, 10, and 16 do not recite additional elements that integrate the judicial exception into a practical application.

*Is there something else in the claims  
that ensures that they are directed to significantly  
more than a patent ineligible concept?*

Step 2B

Because claims 1, 10, and 16 are directed to a judicial exception, we next determine, according to *Alice*, whether these claims recite an element, or combination of elements, that is enough to ensure that the claim is directed to significantly more than a judicial exception. We look to whether the claims: (a) add a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field, or (b) simply append well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. 84 Fed. Reg. at 56.

Claim 1 is a data accessing system claim, which includes “a data store” and “a computer processor.” Similarly, claim 10 is a data accessing system claim, which includes “a computer processor” and method claim 16 includes “a computer readable data store.”

With respect to the claimed hardware components, Appellant’s Specification discloses the following:

FIG. 1 shows that Examiner information accessing system 102 includes a data search system 118 and data aggregation system 122. The query 116 is provided to data search system 118 which, in turn, executes the query against aggregated Examiner data 106 . . . . The data search system 118 may illustratively be a conventional search engine or another type of searching system that searches through aggregated Examiner data 106. In any case,

data search system 118 generates results 120 that are provided, through search user interface system 108, and through the search UI 110 generated by system 108, to a user over network 114. *The query 116 and results 120 can contain any of a wide variety of different information, depending on what the user 112 desires, and depending on the type of data aggregated in aggregated Examiner data store 106.*

(¶ 18 (emphasis added).) Appellant’s Specification is silent with respect to the terms “computer processor” or “computing device.”

The generalized functional terms by which the computer components are described reasonably indicate that Appellant’s Specification discloses conventional data store 106 which interacts with a conventional “computer processor” as component in a conventional “computing device.”

In view of Appellant’s Specification, the claimed hardware components, including “data store” (or “computer readable data store”), “computer processor,” and “computing device,” reasonably may be determined to be generic, purely conventional computer elements. Thus, the claims do no more than require generic computer elements to perform generic computer functions at a high level of generality, rather than improve computer capabilities.

First, Appellant argues “that [the] claims . . . are not directed to an abstract idea, but instead are directed to specific applications of computer-implemented patent data accessing systems and computer-implemented methods of providing information to new and useful ends.” (App. Br. 11.) In particular, Appellant argues that “[s]uch computer-implemented systems and methods are inextricably tied to computer technology and distinct from the types of concepts typically found as abstract.” (*Id.*) However, other than providing a conclusory statement that the claims are “inextricably tied to

computer technology,” Appellant has not adequately explained why the claims overcome a problem that specifically arises in computer technology. In particular, Appellant has not explained how collecting, analyzing, and routing information relating to patent examiners is a problem rooted in computer technology.

Second, Appellant argues that “[s]imilar to the claims at issue in *Enfish*, which are directed to steps of configuring a computer memory in accordance with a self-referential table, the claims of the present application are not claims ‘where a general-purpose computer components are added post-hoc to a fundamental economic or mathematical equation.’” (App. Br. 12.) In particular, “the claims of the present application solve a problem in the software arts . . . that affect a real world result (users’ inability to have information regarding an examiner with whom they are interacting . . .).” (*Id.*) Again, Appellant has not explained how the collecting, analyzing, and routing information relating to patent examiners is a problem rooted in computer technology. Moreover, any increased speed in generating information about patent examiners is derived solely from the capabilities of a general-purpose computer. *FairWarning IP, LLC v. Iatric Sys.*, 839 F.3d 1089, 1095 (Fed. Cir. 2016).

Third, Appellant argues that “the fact that the claims of the present application do not unduly monopolize the basic tools of scientific and technological work further weighs in favor of the patent eligibility of the pending claims” and “the pending claims, which recite specific applications of computer-implemented patent data accessing systems and computer-implemented methods of providing information that all include a number of detailed and specific features, do not preempt basic tools of science or

technology.” (App. Br. 13.) However, although “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 claims are deemed to recite only patent ineligible subject matter under the two-step *Alice* analysis, as they are here, “preemption concerns are fully addressed and made moot.” *Id.*

Fourth, Appellant argues that “[i]n addition to characterizing the claims at an impermissibly high level of abstraction that is untethered from the actual claim language, this rejection is facially deficient because the Examiner has not analogized to case law to substantiate the rejection.” (App. Br. 15; *see also* Reply Br. 2–5.) Contrary to Appellant’s arguments, the Examiner has identified the appropriate judicial exceptions of organizing human activity or mathematical concepts, and the Examiner has compared the claimed concepts of independent claim 1 to the appropriate Federal Circuit decisions (i.e., *Digitech* and *Cyberfone*). Accordingly, the Examiner has met the burden of a general prima facie notice requirement. *See In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011) (“[A]ll that is required of the [Patent] [O]ffice to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of § 132.”).

Fifth, Appellant argues that “even if the pending claims are erroneously viewed as being directed to an abstract idea, the elements of these claims amount to significantly more than the alleged abstract idea itself to transform the nature of the claims into a patent-eligible invention”

because “each of the pending claims recites an ‘inventive concept’ and is accordingly eligible for patenting.” (App. Br. 17.) However, other than providing block quotes of the independent claims with a conclusory statement that “the elements of these claims amount to significantly more than the alleged abstract idea,” Appellant does not adequately explain why the claims recite “significantly more.”

Last, Appellant argues that “the more recent non-precedential decision of *Trading Technologies v. CQG*, 2016-1616 (Fed. Cir. 2017) . . . is more applicable than *Cyberfone* and/or *Digitech*” and “that the graphical user interface in *Trading Technologies* . . . uniquely matches the facts as compared with *Digitech* and/or *Cyberfone*.” (Reply Br. 5–6.) However, other than citing to *Trading Technologies*, and providing unsupported conclusory statements, Appellant does not adequately explain how this case pertains to the claimed invention.

Thus, we agree with the Examiner that claims 1, 10, and 16 are directed towards patent-ineligible subject matter. Accordingly, we sustain the rejection of independent claims 1, 10, and 16 under 35 U.S.C. § 101.

Claims 2–9, 12, 14, 15, 18, 20, and 21 depend from independent claims 1, 10, and 16, and Appellant has not presented any additional substantive arguments with respect to these claims. We sustain the rejection of claims 2–9, 12, 14, 15, 18, 20, and 21 under 35 U.S.C. § 101 for the same reasons discussed with respect to independent claims 1, 10, and 16.

*§ 103 Rejection—Van Luchene, Ikeda, Mueller, and Greening*

We are persuaded by Appellant’s arguments (Reply Br. 9–10) that the combination of Van Luchene, Ikeda, Mueller, and Greening would not have

rendered obvious independent claim 1, which includes the limitation “grouped by patent examiner and by type of rejection.”

The Examiner found that the document retrieval apparatus of Ikeda, having classification attribute storage, corresponds to the limitation “grouped by patent examiner and by type of rejection.” (Non-Final Act. 15.) In particular, the Examiner stated that “[t]his suggests the concept of analyzing the content of the retrieved documents and the documents to classify documents based on attributes such as rejection types as such 112, 101, 102, 103 and others.” (*Id.*) Alternatively, the Examiner found that the database of Van Luchene, which includes Examiner profiles, corresponds to the limitation “grouped by patent examiner and by type of rejection.” (Ans. 7.) We do not agree with the Examiner’s findings.

Ikeda relates to “retrieving documents matching an indicated condition from a large number of documents.” (Col. 1, ll. 10–11.) Ikeda explains that the following:

Specifically, the document retrieval apparatus has a classification attribute storage storing only types of indicated attributes, among a plurality of types of attributes that can be used to classify documents, an attribute analyzing means for analyzing each of the retrieved documents to determine whether an attribute element belonging to the types of attributes stored in the classification attribute storage is contained in the document or not, and an attribute classifying means for classifying each of the retrieved documents such that documents containing the same type of attribute elements fall in the same category and documents containing no attribute elements fall in an independent category.

(Col. 3, ll. 10–20.)

Van Luchene relates to “various automated and non-automated

means for selecting a qualified examiner based on a number of criteria including the examiners history, current workload and the subject matter of the filed application.” (Abstract.) Van Luchene explains the following:

In some embodiments, a database may be created of all of the examiners and their histories. Such information may be used to create a profile of a patent examiner. Profiles may include information regarding previous applications that the examiner has examined, the patent applications in the examiner’s queue for examination, the examiner’s efficiency rating, the prior art cited in the previous and/or waiting applications, the examiner’s education, the examiner’s particular area of expertise, the length of time it takes the examiner to examine an application, the examiner’s grade or level, the examiner’s current workload, the examiner’s seniority, the examiner’s previous experience, the examiner’s training, the number of reissues in previously filed applications, the number of appeals filed, the results of appealed applications, or any combination thereof.

(¶ 107.)

Although the Examiner cited to Ikeda for the “plurality of types of attributes that can be used to classify documents, [including] an attribute analyzing means for analyzing each of the retrieved documents” (col. 3, ll. 12–14), the Examiner has provided insufficient evidence to support a finding the Ikeda teaches the limitation “grouped by patent examiner and by type of rejection.” Likewise, although the Examiner cited to Van Luchene for the examiner profiles, which includes “previous applications that the examiner has examined” or “the number of reissues in previously filed applications,” the Examiner has provided insufficient evidence to support a finding that Ikeda teaches the limitation “grouped by patent examiner and by type of rejection.” In particular, both Ikeda and Van Luchene are silent with respect to “grouping by rejection,” as recited in claim 1. Therefore, on this record, the Examiner has not demonstrated either Ikeda or Van Luchene

teaches the limitation “grouped by patent examiner and by type of rejection.” Moreover, the Examiner’s application of Mueller and Greening does not cure the deficiencies of Ikeda and Van Luchene.

Accordingly, we are persuaded by Appellant’s arguments that “the mere grouping of data by its attributes [in Ikeda] does not teach or fairly suggest a plurality of different patent applications grouped by patent examiner and type of rejection, as recited in claim 1” (Reply Br. 10 (emphasis omitted)) and “a reissue application [of Van Luchene] is not a ground of rejection, and therefore does not teach or fairly suggest a type of rejection” (*id.* at 9–10).

Thus, we do not sustain the rejection of independent claim 1 under 35 U.S.C. § 103(a). Claims 2–9 depend from claim 1. We do not sustain the rejection of claims 2–9 under 35 U.S.C. § 103(a) for the same reasons discussed with respect to claim 1.

*§ 103 Rejection—Van Luchene, Ikeda, and Mueller*

Independent claim 10 recites limitations similar to those discussed with respect to claim 1, and claims 12, 14, and 15 depend from claim 10. We do not sustain the rejection of claims 10, 12, 14, and 15 under 35 U.S.C. § 103(a) for the same reasons discussed with respect to rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Van Luchene, Ikeda, Mueller, and Greening.

*§ 103 Rejection—Van Luchene, Greening, and Carr*

We are persuaded by Appellant’s arguments (Reply Br. 15–16) that the combination of Van Luchene, Greening, and Carr would not have

rendered obvious independent claim 16, which includes the limitation “to count a number of office actions before allowance in each of the plurality of different patent applications.”

The Examiner found that the user interface process of Greening, in which a user rates an item by recording the number of time the user mentions a word, corresponds to the limitation “utilizing a computer processor that is a component of a computing device to count a number of office actions before allowance in each of the plurality of different patent applications.” (Ans. 11; *see also* Non-Final Act. 17.) In particular, the Examiner found that “Greening . . . discloses a calculation of an average number times a user mention a word and stored in the database for retrieval which the same concept can be used to calculate a number of office action before allowance in each of the plurality of different patent applications.” (Ans. 11.) We do not agree with the Examiner’s findings.

Greening relates to “marketing products and services,” in particular, “using a computer system to compare an individual’s reaction to items to other people’s reactions.” (¶ 3.) Greening explains that “step 203 gets a rating by providing a scalar rating selection control from which the user selects” and “ get[s] a rating by recording the number of times a user mentioned a word in text chat, in a review, in a story, or in an article.” (¶ 63.)

Although the Examiner cited to the rating function of Greening, in which one mechanism of “rating [is] by recording the number of times a user mentioned a word,” the Examiner has provided insufficient evidence to support a finding that Greening teaches the limitation “to count a number of office actions before allowance in each of the plurality of different patent

applications,” as recited in claim 16. In particular, the Examiner has not adequately explained how the rating function in *Greening*, which counts the frequency of words in a text file document (e.g., text, review, story, or article), can be used to count Office actions issued by the Examiner prior to allowance. Therefore, on this record, the Examiner has not demonstrated that *Greening* teaches the limitation “to count a number of office actions before allowance in each of the plurality of different patent applications.” Moreover, the Examiner’s application of *Van Luchene* and *Carr* does not cure the deficiencies of *Greening*.

Accordingly, we are persuaded by Appellant’s arguments that “equating an average number of times a user mentions a word with the average number of office actions before allowance for the specific patent examiner . . . is facially deficient.” (Reply Br. 15–16 (emphasis omitted).)

Thus, we do not sustain the rejection of independent claim 16 under 35 U.S.C. § 103(a). Claims 20 and 21 depend from claim 16. We do not sustain the rejection of claims 20 and 21 under 35 U.S.C. § 103(a) for the same reasons discussed with respect to claim 16.

*§ 103 Rejection—Van Luchene, Greening, Carr, and Ikeda*

Claim 18 depends from independent claim 16. *Ikeda* was cited by the Examiner for teaching the additional features of claim 18. (Non-Final Act. 29.) However, the Examiner’s application of *Ikeda* does not cure the above noted deficiencies of *Van Luchene*, *Greening*, and *Carr*.

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DECISION

The Examiner's decision rejecting claims 1–10, 12, 14–16, 18, 20, and 21 under 35 U.S.C. § 101 is affirmed.

The Examiner's decision rejecting claims 1–10, 12, 14–16, 18, 20, and 21 under 35 U.S.C. § 103(a) is reversed.

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