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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/949,652	07/24/2013	Stephen DRYE	2011-0011US01	1392
74739	7590	04/02/2019	EXAMINER	
Potomac Law Group, PLLC (Oracle International) 8229 Boone Boulevard Suite 430 Vienna, VA 22182			BARGEON, BRITTANY E	
			ART UNIT	PAPER NUMBER
			3684	
			NOTIFICATION DATE	DELIVERY MODE
			04/02/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEPHEN DRYE, SEAN KAUFFMAN, and
MATTHEW LANDAU

Appeal 2017-008382
Application 13/949,652
Technology Center 3600

Before JOSEPH L. DIXON, JENNIFER L. McKEOWN, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

McKEOWN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Examiner's
decision to reject claims 1–21. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ According to Appellants, the real party in interest is Oracle International Corporation. App. Br. 2.

STATEMENT OF THE CASE

Appellants' disclosed and claimed invention "is directed generally to an electronic catalog system, and in particular to an electronic catalog system that defines values for different contexts." Spec. ¶ 2.

Claim 1 is illustrative of the claimed invention and reads as follows:

1. A non-transitory computer readable medium having instructions stored thereon that, when executed by a processor, cause the processor to retrieve product information from a product selected from an ecommerce web site, the retrieving comprising:

receiving a first request from a first web site store for first item data for the product from an Extensible Markup Language (XML) file that comprises an electronic product catalog, the first request including a first context for providing the first item data and is in response to a selection of a first link corresponding to the product;

receiving a second request from a second web site store that is different than the first web site store for second item data for the product from the XML file, the second request including a second context for providing the second item data that is different than the first context and is in response to a selection of a second link corresponding to the product;

wherein the XML file comprises for the product, a plurality of common item attribute values, at least one first context item attribute value for the first context and at least one second context item attribute value for the second context;

parsing the XML file in response to the first request and replacing at least one of the common item attribute values with the first context item attribute value, wherein the parsing and replacing forms the first item data;

parsing the XML file in response to the second request and replacing at least one of the common item attribute values with the second context item attribute value, wherein the parsing and replacing forms the second item data; and

providing the first item data to the first web site store and the second item data to the second web site store, wherein the first item data is different than the second item data.

THE REJECTIONS

The Examiner rejected claims 1–21 under 35 U.S.C. § 101 as directed to patent ineligible subject matter. Final Act. 2–3, 6; Non-Final Act., dated 2/8/2016, 4–5.

The Examiner rejected claims 1, 4, 8, 11, 15, and 18 under 35 U.S.C. § 103 as unpatentable over Peyrelevade et al. (US 2003/0120550 A1, published June 26, 2003) (“Peyrelevade”), and Gopal et al. (US 2008/0222011 A1, published Sept. 11, 2008) (“Gopal”). Final Act. 7–9.

The Examiner rejected claims 2, 3, 6, 7, 9, 10, 13, 14, 16, 17, 20, and 21 under 35 U.S.C. § 103 as unpatentable over Peyrelevade, Gopal, and Iida et al. (US 8,452,785 B1, issued May 28, 2013) (“Iida”). Final Act. 9–11.

The Examiner rejected claims 5, 12, and 19 under 35 U.S.C. § 103 as unpatentable over Peyrelevade, Gopal, and Angel et al. (US 2005/0193055 A1, published Sept. 1, 2005) (“Angel”). Final Act. 11–12.

ANALYSIS

THE § 101 REJECTION

Claims 1–21

Based on the record before us, we are persuaded that the Examiner erred in rejecting claims 1–21 as 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. *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, 69 (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 section 101. USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Memorandum”). 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 MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) § 2106.05(a)-(c), (e)-(h) (9th ed. 2018)).

See Memorandum 52, 55–56. 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 Memorandum 56.

Examiner’s Findings and Conclusion

Under step one of the *Alice* test, the Examiner determines that the claims are directed to “providing item data which is a fundamental economic practice and/or a method of organizing human activity and thus an abstract idea.” Non-Final Act. 4; Ans. 2. The Examiner equates the steps of receiving requests, parsing stored data, and providing item data with receiving data, retrieving stored data, and forwarding reply data. *Id.* The Examiner explains that this claimed concept is similar to the abstract idea receiving data from one source, selectively forwarding the data and

forwarding reply data to the first source, which was found to be ineligible in *Dealertrack Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012); *see also* Final Act. 2–3; Ans. 2. The Examiner also relies on *Cyberfone Systems, LLC v. CNN Interactive Group, Inc.*, 558 F. App'x 988 (Fed. Cir. 2014), which “held that the well-known concept of categorical data storage, i.e. the idea of collecting information in classified form, then separating and transmitting that information according its classification, is an abstract idea.” *Id.*; *see also* Ans. 2.

Appellants’ Contentions

Appellants argue that the Examiner’s alleged abstract idea, namely providing idea data, “ignores essentially all of the claim limitations.” App. Br. 5. Appellants contend that the claims “at the highest level, are directed to a centralized electronic product catalog that can be used for multiple different web sites.” App. Br. 6. Appellants explain that “[i]n response to a selection of a link corresponding to a product. . . different information for the same product is received depending on which web site store was displaying the link.” *Id.* (emphasis omitted). According to Appellants, this allows different information for the same product to be displayed on different websites and, like in *DDR*, this addresses a problem that “specifically arises in the realm of computer networks, and specifically for e-commerce web sites.” *Id.* Appellants additionally explain that the claimed invention provides technical advances over the prior art by “provid[ing] specific rules/functionality that allow a centralized XML file to provide product information to different web sites, where the product information may differ for the same product.” App. Br. 9.

Analysis – Revised Step 1

In step one we consider whether the claimed subject matter falls within the four statutory categories of patentable subject matter identified by 35 U.S.C. § 101: process, machine, manufacture, or composition of matter. The claimed invention here recites a process including a number of a steps. Accordingly, the claimed invention falls within the process category.

Analysis – Revised Step 2A

Under the Memorandum, in prong one of step 2A we look to whether the claims recite a judicial exception. The claims include (1) first and second requests for first and second item data from first and second web site stores, respectively, for a product from an XML file containing an electronic product catalog, each of the first and second request including a first context for providing first item data and second context for providing second item data that is different from the first context; (2) an XML file comprising a plurality of common item attribute values for the product as well as at least one context item attribute value for the first context and at least one second context item attribute value for the second context; (3) parsing the XML file in response to each request and replacing a common item attribute value with either a first or second context item attribute value wherein the parsing and replacing forms the first or second item data; and (4) providing the first and second item data to each of the first and second web site store. As Appellants summarize, at a high level, the claims recite using a centralized electronic product catalog that can be used to provide different product information for the same product to different web sites based on the request context. We determine that this providing product information to web site

stores are sales activities, which are a commercial or legal interaction that falls into the category of certain methods of organizing human activity identified in the Memorandum.

Under prong two of revised step 2A, though, we determine that the recited judicial exception is integrated into a practical application. Namely, the claimed invention provides a technological improvement to the prior art process. The Specification explains that web site retailers may at times wish to customize an item's attribute for a particular context. In prior art systems,

When retailer web sites need to present different data associated with an item depending on the context in which the item is presented, typically an item either needs to be entered into an electronic catalog system multiple times, one for each context, or complex coding must be implemented in the display presentation software to choose the appropriate data to display for the context.

Spec. ¶ 4; *see also* Spec. ¶ 19. The claimed invention addresses this problem by using requests that identify a context that is then used to parse a single XML file and replace common data with context specific data based on the request. As such, the claimed invention is directed to a technological improvement. *See* MPEP § 2106.05(a); *see also* *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1313–14 (Fed. Cir. 2016).

We further disagree with the Examiner's reliance on *Dealertrack*. The Federal Circuit, in *Dealertrack*, found ineligible claims that “‘explain the basic concept’ of processing information through a clearinghouse.” *Dealertrack*, 674 F.3d at 1333. The Court further finds that the claims did “‘not specify how the computer hardware and database are ‘specially programmed’ to perform the steps claimed in the patent” (*Id.*), and that “‘the claims [] recite only that the method is ‘computer aided’ without specifying any level of involvement or detail.” *Id.* at 1334.

The claims here are not the mere automation of a manual process. Instead, the claims are more analogous to *DDR Holdings, LLC v. Hotels.com*, 113 USPQ2d 1097 (Fed. Cir. 2014) in that the claims provide a technological solution to a challenge particular to the Internet. Namely, the claims recite specific steps to use a single XML file to replace common data with first or second item data for the same product based on the context of a request from different web site stores. As such, based on the record before us, we agree with Appellants that the Examiner erred in finding that the claimed invention is directed to an abstract idea.

Accordingly, we reverse the Examiner's decision to reject claims 1–21 as directed to patent ineligible subject matter.

THE § 103 REJECTION BASED ON PEYRELEVADE AND GOPAL
Claims 1, 4, 8, 11, 15, and 18

Based on the record before us, we are persuaded that the Examiner erred in finding that claims 1, 4, 8, 11, 15, and 18 are unpatentable over Peyrelevade and Gopal.

Appellants contend that Peyrelevade does not disclose the claimed parsing and replacing. App. Br. 13. For example, Appellants assert that Peyrelevade “fails to disclose an XML file that functions as a centralized product catalog . . . that is parsed and has values replaced to provide ‘customized’ information for a product.” App. Br. 13; *see also id.* (asserting that “there simply is no disclosure in these paragraphs of ‘parsing’ and ‘replacing’ or any equivalent functionality.”).

Both the claimed invention and Peyrelevade's system are directed to using data stored in a single location to provide customized product

information to different websites or resellers based on the request received from each website. *See, e.g.*, Peyrelevade ¶¶ 49–51. Peyrelevade includes a database that stores defined modules and its associated descriptions that are used in constructing websites of multiple resellers. Peyrelevade ¶¶ 70–71. The modules may include common information as well as information unique to each website. Abstract. In an exemplary embodiment, Peyrelevade explains

The reseller website 2500a may make a request to the supplier website 2700 for lipstick product information. The computing platform 3300 may process the request to determine an appropriate module for providing the information requested by the reseller website 2500a. For example, the computing platform 3300 may determine the appropriate module by searching module descriptions for “lipstick.” In this example, the module 4100 may include the phrase “lipstick” in its description.

Peyrelevade ¶ 74. As such, Peyrelevade discloses parsing a database to determine the appropriate module. Peyrelevade ¶ 74. The module description and associated rules are then used to construct the website. Peyrelevade ¶¶ 75–76. The claims here, however, require *replacing* a common attribute value with a first context item attribute value and *replacing* a common attribute value with a second context item attribute value. Peyrelevade does not disclose a *common* attribute value or equivalent, such as initial or default values. Instead, Peyrelevade uses an already defined module and associated description in combination with rules to construct the website. The Examiner fails to sufficiently explain how the Peyrelevade *replaces a common value* with the first or second context attribute value. Based on the record before us, then, we are persuaded of Examiner error.

Accordingly, we reverse the Examiner's decision to reject claims 1, 4, 8, 11, 15, and 18 as unpatentable over Peyrelevade and Gopal.

THE REMAINING § 103 REJECTIONS

Claims 2, 3, 5–7, 9, 10, 12–14, 16, 17, and 19–21

Based on the record before us, we are persuaded that the Examiner erred in rejecting the remaining claims are unpatentable over the cited combinations of prior art. As discussed above, the cited combination of Peyrelevade and Gopal fails to teach or suggest the limitations of independent claims 1, 8, and 15. The additional cited prior art fails to cure the deficiencies of the combination of Peyrelevade and Gopal. As such, we are similarly persuaded that the Examiner erred in rejecting dependent claims 2, 3, 5–7, 9, 10, 12–14, 16, 17, and 19–21.

Accordingly, we reverse the Examiner's decision to reject claims 2, 3, 5–7, 9, 10, 12–14, 16, 17, and 19–21 as unpatentable over the cited combinations of prior art.

DECISION

We reverse the Examiner's decision to reject claims 1–21.

REVERSED