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TERRILE, CANNATTI, CHAMBERS & HOLLAND, LLP
P.O. BOX 203518
AUSTIN, TX 78720

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM NIX, CLINT H. O'CONNOR, MICHAEL HAZE, and YUAN-CHANG LO

Appeal 2017-008449
Application 13/570,495[1]
Technology Center 2400

Before MATTHEW R. CLEMENTS, SCOTT E. BAIN, and STEVEN M. AMUNDSON, *Administrative Patent Judges*.

BAIN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1, 3–7, 9–13, and 15–18, which constitute all claims pending in the application. Claims 2, 8, and 14 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] Appellants identify Dell Products L.P. as the real party in interest. Br. 1.

STATEMENT OF THE CASE

The Claimed Invention

The claimed invention relates to providing "personalized recommendations" for products and services to increase the efficiency of a user's information handling system (i.e., computing environment). Spec. ¶¶ 1–5, 13. The recommendations are based on characteristics of the user's existing hardware and software, and the user's usage thereof. *Id.* Claims 1, 7, and 13 are independent. Claim 1 is illustrative of the invention and the subject matter of the appeal, and reads as follows:

> 1. A computer-implementable method for providing personalized recommendations, comprising:
>
> receiving a first set of input data comprising recommendation input data associated with a profile and usage of an information handling system associated with a user;
>
> processing the first set of input data to generate personalized recommendation data; and
>
> providing the personalized recommendation data, *the personalized recommendation data being used to provide personalized recommendations that guide the user in selecting products or services that increase the efficiency of the information handling system associated with the user*; and
>
> wherein the first set of data is obtained by accessing the information handling system associated with the user and comprises
>
> data associated with the information handling system associated with the user hardware configuration;
>
> data associated with the information handling system associated with the user hardware capabilities;
>
> data associated with the information handling system associated with the user software usage;

> data associated with software installed on the information handling system associated with the user;
>
> data associated with the user's hardware usage; and
>
> data associated with peripherals attached to the information handling system associated with the user.

Br. 8 (Claims App.) (emphasis added).

The Rejections on Appeal

Claims 1, 3–7, 9–13, and 15–18 are rejected under 35 U.S.C. § 101 as directed to ineligible subject matter. Final Act. 3–9.

Claims 1, 3–7, 9–13, and 15–18 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Revashetti et al. (US 2002/0184367 A1; Dec. 5, 2002) ("Revashetti") and Binder (US 6,513,052 B1; Jan. 28, 2003). Final Act. 10–27.

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments presented in this appeal. Arguments which Appellants could have made but did not make in the Brief are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). On the record before us, we are not persuaded the Examiner erred. We adopt as our own the findings and reasons set forth in the rejections from which the appeal is taken and in the Examiner's Answer, and provide the following discussion for highlighting and emphasis.

Rejection Under 35 U.S.C. § 101

Appellants argue the Examiner erred in rejecting the claims as directed to ineligible subject matter, namely, the abstract idea of generating personalized recommendations. Br. 3–5; Ans. 2. Appellants contend the Examiner "ignores the specific details of the claim elements" and that the claims are directed to a "technological improvement that does not rely on an implementation on a computer." Br. 5. For the following reasons, however, we are not persuaded 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. The Supreme Court has long held that this provision contains an implicit exception: "[l]aws 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)). The Court has set forth a two-part inquiry to determine whether this exception applies. First, we must "determine whether the claims at issue are directed to one of those patent-ineligible concepts." *Alice*, 134 S. Ct. at 2355 (citation omitted). Second, if the claims are directed to one of those patent-ineligible concepts, 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." *Alice*, 134 S. Ct. at 2355 (quoting *Mayo Collaborative Servs.*

v. Prometheus Labs., Inc., 132 S. Ct. 1289, 1297 (2012)). Put differently, we must search the claims for an "inventive concept," that is, "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*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1294).

Regarding step one of the *Alice* analysis, as the Examiner finds, the claims are directed to data gathering and data manipulation in order to provide information (recommendations) to a user. *Id.* Data gathering and manipulation encompass an abstract idea. *See, e.g.*, *Elec. Power Grp. LLC 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"); *see also In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016).

Appellants argue that characterizing the claims as abstract data gathering and manipulation "ignores the specific details of the claim elements" and that the claims are "analogous" to those found patent eligible (under *Alice* step one) in *McRO*. Br. 4–5 (citing *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016)). Appellants, however, do not identify which pertinent claim elements the Examiner ignores. Moreover, Appellants' argument regarding *McRO* consists entirely of summarizing *McRO* itself, and does not explain how *Appellants' claims* allegedly are analogous to those in *McRO*, which involved a "technological

improvement over the existing, manual 3–D animation techniques." *McRO*, 837 F.3d at 1316. Nor do Appellants attempt to explain how the claims otherwise satisfy the first step of *Alice*. Br. 4–5. Accordingly, Appellants have not persuaded us of error in the Examiner's analysis under *Alice* step one, and we proceed to step two.

> In the second step of our analysis under *Alice*,
>
> > 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. 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]."

Alice Corp., 134 S. Ct. at 2357 (internal citations omitted). Appellants argue the claims encompass a sufficient inventive concept, namely, a "technological improvement that does not rely on an implementation on a computer," as in *Bascom*. Br. 4–5 (citing *Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)). Similar to the argument in step one, however, Appellants' argument in step two simply repeats the holdings of *Bascom*, without attempting to demonstrate how Appellants' invention is analogous to the claims in that case, or how that case otherwise supports Appellants' argument. Br. 5.

We, like the Examiner, find Appellants' claims are dissimilar to the claims at issue in *Bascom*, which (like the claims in *McRO*) were directed to technical improvements in a computer or network. *See Bascom*, 827 F.3d at 1350 ("harness[ing] this technical feature of network technology in a filtering system" to customize content filtering); *see also McRO*, 837 F.3d at 1315 ("improvement in computer animation," for "achieving automated lip-

synchronization"). Appellants' invention, in contrast, is performed by standard, generic data processing and storage elements. Specification Figs. 1–2, ¶¶ 14–15. The use of such generic computing elements "do[es] not alone transform an otherwise abstract idea into patent-eligible subject matter." *FairWarning*, 839 F.3d at 1096 (Fed. Cir. 2016) (citing *DDR Holdings, LLC, v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014)); Ans. 3. Accordingly, Appellants do not persuade us the Examiner erred in the second step of the *Alice* analysis.

For the foregoing reasons, we sustain the rejection of claims 1, 3–7, 9–13, and 15–18 as directed to ineligible subject matter.

Rejections Under 35 U.S.C. § 103

Appellants argue the Examiner erred in finding the prior art teaches or suggests "personalized recommendations that guide the user in selecting products or services that increase the efficiency" of the user's computing (information handling) system, as recited in claim 1. Br. 6. Specifically, although Appellants acknowledge Revashetti's disclosure of "update opportunities" for a client computer, Appellants contend Revashetti does not teach or suggest the claimed "personalized recommendations . . . that increase [] efficiency." *Id.* On the record before us, however, we are not persuaded of error.

As the Examiner finds, Revashetti teaches scanning a user's "client" computer system to determine and recommend "update opportunities" for the user. Ans. 3–5; Revashetti Abstract, ¶¶ 37–39, 42, 125. The "update opportunities" are based upon an analysis of the "files and/or other

configurations, hardware or software, present on the client computer." Revashetti ¶ 39; *see also id.* ¶¶ 38, 42. Further, Revashetti teaches recommending products that better meet the computing "power" and "mobility" needs of the user, "based upon an inferred profile of the user" and "configuration detected on the client computer." *Id.* ¶ 125.

We, like the Examiner, find one of ordinary skill in the art would understand the foregoing teachings in Revashetti as "recommendations" that "increase the efficiency" of the user's computing (information handling) system. Ans. 3–4. As the Examiner finds in the Answer, an "update" of hardware or software, or increased power, or increased mobility, all would be understood as making the user's system "faster, better, [or] easier to use," i.e., more efficient. *Id.* at 3.[2] Appellants do not rebut this finding, as no reply brief was filed, and we discern no error therein.

Appellants further argue that Revashetti's focus on "provid[ing] marketing information" is not the same as providing "personalized recommendations," as recited in claim 1. Br. 7. As the Examiner finds, however, Revashetti does not merely teach "marketing" in a general sense, but *targeted* marketing of products and services recommended specifically for a user based upon that user's profile and computer configuration. Ans.

[2] Neither Appellants' Specification nor the Brief proposes any definition of "efficiency," and Appellants do not dispute the Examiner's assertion that making a system faster, better, or easier to use equates to increasing efficiency. Ans. 3. We agree. *See, e.g.*, *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (claim terms given "'their broadest reasonable interpretation consistent with the specification'" (citation omitted)).

3–4; Revashetti Abstract, ¶¶ 125, 132, 156. In the system taught by Revashetti, "the user is provided with a simple, accessible way to purchase or learn more about a related product *directly relevant to the user's client computer configuration* in a number of different ways." Revashetti ¶ 156 (emphasis added). Moreover, Revashetti further provides, if

> the configuration detected on the client computer [] is determined to infer that the user . . . is a "road warrior," meaning that the user requires both power and mobility in computing products, the [recommended] product marketed to that user may be a handheld computing device such as a Palm Computing® connected organizer.

Id. ¶ 126

We discern no error in the Examiner's finding, unrebutted by Appellants, that one of ordinary skill in the art would understand the foregoing passages in Revashetti as "personalized recommendations" that guide a user in selecting products or services. Ans. 3.

Accordingly, we sustain the Examiner's obviousness rejection of claim 1. For the same reasons, we also sustain the obviousness rejections of the remaining claims 3–7, 9–13, and 15–18, which are not argued separately.

DECISION

We affirm the Examiner's decision rejecting claims 1, 3–7, 9–13, and 15–18.

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED