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UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* FARHANG KASSAEI

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Appeal 2017-008838<sup>1</sup>  
Application 12/416,051<sup>2</sup>  
Technology Center 3600

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Before ANTON W. FETTING, MICHAEL C. ASTORINO, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) claims 1–5, 7–14, 16–18,  
22, and 23. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> Our decision references Appellant’s Appeal Brief (“Appeal Br.,” filed December 29, 2016), Reply Brief (“Reply Br.,” filed May 30, 2017), the Examiner’s Answer (“Ans.,” mailed March 29, 2017), and Final Office Action (“Final Act.,” mailed June 2, 2016).

<sup>2</sup> Appellant identifies eBay, Inc., as the real party in interest. (Appeal Br. 2).

## CLAIMED INVENTION

Appellant's claims relate "to the field of online commerce," and more particularly to "methods and systems of recommending software to users engaged in online commerce" (Spec. ¶ 1).

Claims 1, 10, and 22 are the independent claims on appeal. Claim 10, reproduced below with bracketed notations added, is illustrative of the claimed subject matter:

10. A method comprising:

[a] creating an online marketplace sales profile for a seller for maintaining in one or more online databases, the creating including calculating a plurality of metrics corresponding to a plurality of online listings of sale items stored in the one or more databases of a network-based marketplace system and posted on the network-based marketplace system by the seller, the plurality of metrics for the seller including sales metrics for the sale items;

[b] identifying other sellers similar to the seller by comparing the online marketplace sales profile for the seller in the one or more databases to online marketplace sales profiles for the other sellers in the one or more databases, the online marketplace sales profiles for the other sellers including a plurality of metrics corresponding to a plurality of listings of other sale items stored in the one or more databases and posted on the network-based trading environment by the other sellers, the plurality of metrics for the other sellers including a plurality of sales metrics for the other sale items;

[c] assessing a performance impact by an online application on the plurality of metrics for the seller [] based on a performance impact by the online application on the plurality of metrics for the other sellers after a subscription by the other sellers to the online application;

[d] communicating a recommendation for presentation in a user interface of a device of the seller based on a rating, the rating including a function of the impact by the online application on the plurality of metrics for the other sellers; and

[e] automatically updating at least a portion of the plurality of listing based on an acceptance by the seller of the recommendation, one or more modules incorporated into the network-based marketplace system to configure the network-based marketplace system to perform the creating, identifying, assessing, providing, and updating, the one or modules implemented by one or more processors of the network-based marketplace system.

### REJECTION

Claims 1–5, 7–14, 16–18, 22, and 23 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

### ANALYSIS

#### *Patent-Ineligible Subject Matter*

Appellant argues claims 1–5, 7–14, 16–18, 22, and 23 as a group (*see* Appeal Br. 19–31; *see also* Reply Br. 1–8). We select independent claim 10 as representative. The remaining claims stand or fall with claim 10. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Under 35 U.S.C. § 101, 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 id.* 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, 192 (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 (1853))); and manufacturing flour (*Gottschalk*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

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 (quotation marks 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.* (alterations in original) (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. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“2019 Revised Guidance”). 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, i.e., that “apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *See* 2019 Revised Guidance, 84 Fed. Reg. at 53; *see also* MPEP § 2106.05(a)–(c), (e)–(h).

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 is 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* 2019 Revised Guidance.

Appellant argues that the Examiner’s rejection is in error because the Examiner fails to establish a prima facie case of subject matter ineligibility (*see* Appeal Br. 19–22; *see also* Reply Br. 1–2). More particularly, Appellant argues the Examiner “failed to properly identify the alleged abstract idea” (Appeal Br. 19). Appellant’s arguments are not persuasive.

In rejecting the pending claims under 35 U.S.C. § 101, the Examiner analyzes the claims using the *Mayo/Alice* two-step framework (*see* Final Act. 10–18; *see also* Ans. 5–13). Here, the Examiner maintains the claims are directed to “recommending items to users in a marketplace based on a comparison of metrics associated with other users” (Ans. 2; *see also* Final Act. 11), which the Examiner considers to be an abstract idea, inasmuch as it may be characterized as being related to “certain methods of organizing human activity (e.g. advertising, marketing, and sales activities or behaviors)” (Final Act. 13). The Examiner further determines that the additional elements of the claims, taken alone and as an ordered combination, do not ensure that the claims amount to significantly more than the abstract idea (*see id.* at 15–16). The Examiner, thus, has clearly followed the two-part framework specified by the Supreme Court in *Mayo/Alice* consistent with Office guidelines.

In this regard, the Examiner has articulated the reasons for the rejection and has notified Appellant of the reasons for the rejection “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” 35 U.S.C. § 132. And we find that, in doing so, the Examiner sets forth a prima facie case of subject matter ineligibility. *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011); *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990)

(Section 132 “is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

Turning to the first step of the *Mayo/Alice* framework, we are not persuaded by Appellant’s arguments that the Examiner “failed to properly identify the alleged abstract idea” and erred in determining that the present claims are directed to an abstract idea (*see* Appeal Br. 19–27; *see also* Reply Br. 1–2). Here, in rejecting the claims under 35 U.S.C. § 101, the Examiner determined that the claims are directed to an abstract idea of “recommending items (i.e. applications) to users (i.e. sellers) in a marketplace based on a comparison of metrics associated with other users (i.e. sellers)” (Final Act. 11; Ans. 2). As described below, the Examiner’s characterization of claim 10 is, in our view, fully consistent with the Specification, including the claim language.<sup>3</sup>

The Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the [S]pecification, based on whether ‘their character as a whole is directed to excluded subject

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<sup>3</sup> That the claim language includes more words than the phrase the Examiner used to articulate the abstract idea, and that the Examiner, thus, articulates the abstract idea at a higher level of abstraction than would Appellant is an insufficient basis to persuasively argue that the claim language has been mischaracterized. *See Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240–41 (Fed. Cir. 2016) (“An abstract idea can generally be described at different levels of abstraction. As the Board has done, the claimed abstract idea could be described as generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location. It could be described in other ways, including, as indicated in the specification, taking orders from restaurant customers on a computer.”).

matter.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

The Specification is titled “APPLICATION RECOMMENDATION ENGINE,” and states that the disclosure relates specifically to “methods and systems of recommending software to users engaged in online commerce” (Spec. ¶ 1). The Background section of the Specification identifies that “sellers may not be aware of applications that could improve their ability to sell items, and they may not know which available applications will best meet their needs” (*id.* ¶ 3). According to the Specification, the present invention provides “business applications designed to improve the effectiveness of selling items on a network-based trading environment to be recommended to appropriate sellers” (*id.* ¶ 19) and that “[b]y assessing the impact that various applications have had on other sellers with a profile similar to the user’s profile, appropriate applications can be recommended to the user that are most relevant to the user’s needs” (*id.* ¶ 25).

Taking independent claim 10 as representative, the claimed subject matter generally recites a method including steps for creating a user profile (limitation [a]), identifying similar other user profiles by comparing the profiles (limitation [b]), analyzing data within the profiles to calculate a performance impact value and rating (limitation [c]), communicating a recommendation to the user based on the rating (limitation [d]), and updating a listing of items for sale based on the recommendation (limitation [e]).

Understood in light of the Specification, independent claim 10 includes steps for identifying information, analyzing information, and

making a recommendation based on the information. Thus, we agree with the Examiner that independent claim 10 is directed broadly to “recommending items to users in a marketplace based on a comparison of metrics associated with other users” (Final Act. 11; Ans. 2). And, when viewed through the lens of the 2019 Revised Guidance, the Examiner’s analysis depicts the claimed subject matter as one of the ineligible “certain methods of organizing human activity” including at least advertising and marketing (Final Act. 13), and as such, an abstract idea under Prong One of Revised Step 2A. *See* 2019 Revised Guidance, 84 Fed. Reg. at 52.

The claim is directed to an idea similar to ideas deemed abstract by our reviewing court in *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369–70 (Fed. Cir. 2015) (customizing and tailoring web page content based on navigation history and known user information), *Elec. Power Grp. LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016) (collecting information and “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, [are] essentially mental processes within the abstract-idea category”), *Affinity Labs of Tex., LLC v. Amazon.com Inc.*, 838 F.3d 1266, 1271 (Fed. Cir. 2016) *cert. denied*, 137 S. Ct. 1596 (2017) (customizing a user interface to have targeted advertising based on user information), and *Personalized Media Comme’ns, LLC v. Amazon.Com, Inc.*, 161 F. Supp. 3d 325, 338 (D. Del. 2015), *aff’d sub nom.*, 671 F. App’x 777 (Fed. Cir. 2016) (providing personalized recommendations).

Having concluded that claim 10 recites a judicial exception, i.e., an abstract idea, we next consider whether the claim recites “additional elements that integrate the [judicial] exception into a practical application”

under Prong Two of Revised Step 2A. *See* 2019 Revised Guidance, 84 Fed. Reg. at 55.

The 2019 Revised Guidance provides five “exemplary considerations” that “are indicative that an additional element (or combination of elements)<sup>□</sup> *may* have integrated the exception into a practical application.” 2019 Revised Guidance at 55 (emphasis added). The first exemplary consideration is whether “[a]n additional element reflects an improvement in the functioning of a computer, or an improvement to other technology or technical field.” *Id.* (citing MPEP § 2106.05(a)). Here, Appellant argues

like the claims in *Enfish*, the claims at issue in this case are directed to an improvement to a computer-related technology, specifically adding modules to a networked system to enable an online application executing on the system to automatically update at least a portion of a plurality of online listings of sale items stored in one or more databases of the networked-based marketplace system.

Appeal Br. 23.

However, we find no indication in the Specification, nor does Appellant direct us to any indication, that the steps recited in independent claim 10 invoke any assertedly inventive programming, require any specialized computer hardware or other inventive computer components, i.e., a particular machine, or that the claimed invention is implemented using other than generic computer components to perform generic computer functions. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”). Instead, we agree with the Examiner that “the ‘modules’ are merely software that the generic computer is programmed with” (Ans. 15

(citing Spec. ¶¶ 71–72)) allowing a generic computer to perform the claimed operations using generic computer functions (*cf.* Spec. ¶¶ 52–54).

We also find no indication in the Specification that the claimed invention effects a transformation or reduction of a particular article to a different state or thing. Nor do we find anything of record, short of attorney argument, that attributes any improvement in computer technology and/or functionality to the claimed invention or that otherwise indicates that the claimed invention “appl[ies], rel[ies] on, or us[es] the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *See* 2019 Revised Guidance, 84 Fed. Reg. at 55.

Appellant further argues that the pending claims are not directed to an abstract idea pursuant to the Federal Circuit decisions in *Enfish* and *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016) (*see* Appeal Br. 23–24, 28–29; *see also* Reply Br. 5–6). However, there is a fundamental difference between computer functionality improvements, on the one hand, and uses of existing computers as tools to perform a particular task, on the other. Indeed, the Federal Circuit applied this distinction in *Enfish* in rejecting a § 101 challenge at the step one stage of the *Mayo/Alice* analysis because the claims at issue focused on a specific type of data structure, i.e., a self-referential table for a computer database, designed to improve the way a computer carries out its basic functions of storing and retrieving data, and not on asserted advances in uses to which existing computer capabilities could be put. *Enfish*, 822 F.3d at 1335–36.

We find no parallel here between independent claim 10 and the claims in *Enfish* nor any comparable aspect in claim 10 that represents “an

improvement to computer functionality.” Appellant asserts the technical solution is “improving the discoverability of [] applications on a network-based publication system” and that “updating a plurality of listings for a seller is a technological improvement” (Reply Br. 5). We cannot agree.

In this regard, we note that the Specification discloses that [t]he machine [for performing any one or more of the methodologies discussed in the application] may be a personal computer (PC), a tablet PC, a set-top box (STB), a Personal Digital Assistant (PDA), a cellular telephone, a web appliance, a network router, switch or bridge, or any machine capable of executing instructions (sequential or otherwise) that specify actions to be taken by that machine (Spec. ¶ 66). The alleged advantages that Appellant identifies do not appear to concern an improvement to computer capabilities or provide details on the technological manner in which the steps are performed; but instead, relate to an alleged improvement in discovering applications that can “improve [a seller’s] ability to sell items” through a process in which a computer is used as a tool in its ordinary capacity (*cf. id.* ¶ 3).

We also find no parallel between independent claim 10 and the claims at issue in *McRO* (*see* Appeal Br. 24; *see also* Reply Br. 6). Appellant asserts that like the claims in *McRO*, the claims are patent-eligible because

the inclusion of specific limitations (e.g., including the way in which an online marketplace sales profile for the seller is created, the way in which other sellers similar to the seller are identified, the way in which the performance impact of an online application on a plurality of metrics corresponding to online listings of sales items is assessed, and the way in which recommendation are communicated to the seller) means that different approaches for automatically updating online listings on a seller are not preempted.

Appeal Br. 24. However, the Federal Circuit premised its determination that the claims in *McRO* were patent-eligible, not merely on the specificity of the claimed animation scheme, but rather on the fact that the claims, when considered as a whole, were directed to a technological improvement over the existing, manual 3-D animation techniques and used limited rules in a process specifically designed to achieve an improved technological result in conventional industry practice. We are not persuaded that a comparable situation is presented here.

Instead, in the present invention, available data from an online seller profile is simply analyzed/compared in order to improve a business practice. Here, as the Examiner points out, the limitations argued by Appellant “amount to no more than broadly collecting some data regarding metrics . . . or some sort of analysis performed without more” (Ans. 7). As our reviewing court has made clear, “relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.” *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015).

Appellant still further argues that independent claim 10, like the claims in *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016) is patent-eligible because it “recite[s] a specific solution for automatically updating at least a portion of a plurality of online listings of sale items stored in one or more databases of a network-based marketplace system and posted by a seller” (Appeal Br. 28; *see also* Reply Br. 7). We do not agree, however, that *BASCOM* is sufficiently analogous to control the outcome here.

In *BASCOM*, the Federal Circuit held that the second step of the *Mayo/Alice* framework was satisfied because the claimed invention “represents a ‘software-based invention[ ] that improve[s] the performance of the computer system itself.’” *BASCOM*, 827 F.3d at 1351 (stating that like *DDR Holdings*, where the patent “claimed a technical solution to a problem unique to the Internet,” the patent in *BASCOM* claimed a “technology-based solution . . . to filter content on the Internet that overcomes existing problems with other Internet filtering systems . . . making it more dynamic and efficient”) (citations omitted). Here, Appellant argues that independent claim 10 is patent-eligible because it “recite[s] a specific solution for automatically updating at least a portion of a plurality of online listings of sale items stored in one or more databases of a network-based marketplace system and posted by a seller” (Appeal Br. 28). The difficulty with Appellant’s argument is that Appellant does not persuade us that “automatically updating at least a portion of a plurality of online listings of sale items stored in one or more databases of a network-based marketplace system and posted by a seller” is a technological improvement, as opposed to an improvement in a business practice for which generic computer components are used in their ordinary capacity (*see, e.g.*, Spec. ¶¶ 1–3, 66, 67).

Appellant further argues that independent claim 10 recites that “one or more modules [are] incorporated into the network-based marketplace system to configure the network-based marketplace system to perform the creating, identifying, assessing, providing, and updating, the one or [more] modules implemented by one or more processors of the network-based marketplace system” and thus “a generic computer would be incapable of performing

these recited operations” (Appeal Br. 28). However, as discussed above, there is no indication here that the steps recited in independent claim 10 require any specialized computer or inventive computer components — the Specification indicates just the opposite (*see, e.g.*, Spec. ¶¶ 66-67). That is, the claimed “modules” are just programming routines for carrying out the various claimed operations (*id.* ¶¶ 52–54) on a general purpose computer (*id.* ¶¶ 66–67).

Appellant does not point to a particular portion of the Specification to show where the Specification discloses how these other elements transform the abstract idea into patent-eligible subject matter. Nor does Appellant provide adequate evidence or technical reasoning that independent claim 10 improves some existing technological process or solves some technological problem in conventional industry practice, such as in *Diamond v. Diehr*, 450 U.S. 175 (1981). *See Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1334 (Fed. Cir. 2015) (determining that the “claims recit[ed] a commonplace business method aimed at processing business information despite being applied on a general purpose computer”), *cert. denied*, 136 S. Ct. 2510 (2016); *see also Alice*, 134 S. Ct. at 2359.

We also are not persuaded of Examiner error to the extent Appellant maintains that the claims are patent-eligible because “the inclusion of specific limitations . . . means that different approaches for automatically updating online listings of a seller are not preempted” (Reply Br. 6; *see also* Appeal Br. 15–16). There is no dispute that the Supreme Court has described “the concern that drives [the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption,” *Alice Corp.*, 573 U.S. at 216. But, characterizing preemption as a driving concern for patent

eligibility is not the same as characterizing preemption as the sole test for patent eligibility. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice Corp.*, 573 U.S. at 216). “[P]reemption may signal patent ineligible subject matter, [but] the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

Turning to the second step of the *Mayo/Alice* framework, Appellant argues that even if the claims are directed to an abstract idea, the claims are nonetheless patent-eligible because they recite significantly more than an abstract idea in light of *BASCOM* and *DDR Holdings* (Appeal Br. 27–31). However, as discussed above, we can find no parallel between the present claims and those at issue in either *BASCOM* or *DDR Holdings*. Instead, we agree with the Examiner that the additional elements taken alone or in combination do not result in anything more than conventional computer implementation (*see* Final Act. 16–18; *see also* Ans. 10–13).

Considered as an ordered combination, the “one or more processors” of Appellant’s independent claim 10 add nothing that is not already present when the limitations are considered separately. Viewed as a whole, independent claim 10 simply recites the concept of “determining recommendations to sellers based on comparing metrics in the profiles of a seller and other similar sellers” (Final Act. 15; Ans. 2). The claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in any other technology or technical field. Instead, independent claim 10 amounts to nothing significantly more than an

instruction to apply the abstract idea of “recommending items to users in a marketplace based on a comparison of metrics associated with other users” (Final Act. 11; Ans. 2), which under our precedents, is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2360.

Appellant last argues that the lack of a prior art rejection is “further evidence that the claims at issue are directed to patentable subject matter” (Appeal Br. 28). However, to the extent Appellant maintains that the claimed invention is patent-eligible, i.e., that the claims amount to “significantly more” than an abstract idea, and/or that the recited functions are not “well-understood, routine, and conventional activities,” because of the lack of § 102 or § 103 rejections of the claimed subject (*id.*), Appellant misapprehends the controlling precedent.

A finding of novelty or non-obviousness does not automatically lead to the conclusion that the claimed subject matter is patent-eligible. Although the second step in the *Mayo/Alice* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for “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. “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90; *see also Diehr*, 450 U.S. at 188–89 (“The ‘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.”).

Appellant’s other arguments, including those directed to now-superseded USPTO guidance, have been considered but are not persuasive of error. (*See* 2019 Guidance at 51 (“Eligibility-related guidance issued prior to the Ninth Edition, R–08.2017 of the MPEP (published Jan. 2018) should not be relied upon.”).)

We are not persuaded, on the present record, that the Examiner erred in rejecting independent claim 10 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection of independent claim 10, and claims 1–5, 7–9, 11–14, 16–18, 22, and 23, which fall with independent claim 10.

#### DECISION

The Examiner’s rejection of claims 1–5, 7–14, 16–18, 22, and 23 under 35 U.S.C. § 101 is affirmed.

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