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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GREGORY GORDER,
NATHAN P. MYHRVOLD, and
EDWARD K.Y. JUNG

Appeal 2017–009767
Application 13/420,394¹
Technology Center 3600

Before HUBERT C. LORIN, KENNETH. G. SCHOPFER, and
AMEE A. SHAH, Administrative Patent Judges.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Gregory Gorder, et al. (Appellant) seeks our review under 35 U.S.C. § 134(a) of the Final Rejection of claims 1, 3–8, and 10–45. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

¹ The Appellant identifies IVP Holdings III LLC as the real party in interest.
Br. 1.

THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A computer-implemented method, comprising:
 - under control of a computing system having a memory, a computer processor, and a data store, the data store having information regarding products and/or companies, patent information, and subject matter areas, determining an invention gap with respect to a business entity, the invention gap indicating a difference between invention-related assets that are applicable to one or more products and invention-related assets that are held by or otherwise available to the business entity, by instructing the processor with instructions stored in the memory by:
 - receiving an indication of a product;
 - determining, by retrieving information from the data store, a subject matter category implicated by the indicated product, the subject matter category referring to multiple patents that are each directed at least in part to the subject matter category, each of the multiple patents having an associated assignee that has a corresponding assignee type, at least some of the assignees being different from one another;
 - determining, specific to the business entity and without reference to independent or dependent patent claims of the multiple patents, an aggregate risk associated with the determined subject matter category, the aggregate risk based at least in part on computing a likelihood that the business entity is exposed to a loss with respect to at least some of the multiple patents that are directed at least in part to the determined subject matter category, wherein the at least some of the multiple patents are not held by or otherwise available to the business entity, wherein the aggregate risk is computed as a numerical function that considers, for each of the at least some of the multiple patents, a numerical likelihood that the business entity is exposed to a loss with respect to the patent, wherein the numerical likelihood is weighted based on the assignee type of the patent, wherein determining the aggregate risk is further based at least in part on

patent rights available to the business entity, and wherein the computed likelihood that the business entity is exposed to a loss is reduced based on how many patents are available to the business entity; and

transmitting information about the determined aggregate risk as a measure of the invention gap.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Wilkinson	US 2002/0077870 A1	Jun. 20, 2002
Barnett	US 2002/0082778 A1	Jun. 27, 2002
Adler	US 2003/0033295 A1	Feb. 13, 2003
Del Vecchio	US 2003/0036945 A1	Feb. 20, 2003
Pejic	US 2003/0229470 A1	Dec. 11, 2003
Bilak	US 2005/0261927 A1	Nov. 24, 2005
Zilka	US 7,117,443 B1	Oct. 3, 2006
Rozich	US 2008/0243799 A1	Oct. 2, 2008
Pellegrino	US 7,536,331 B1	May 19, 2009
Avasarala	US 2010/0287478 A1	Nov. 11, 2010

The following rejections² are before us for review:

Claims 1, 3–8, and 10–45 are rejected under 35 U.S.C. § 101 for claiming patent-ineligible subject matter.

Claims 1, 3–5, 7, 11, 12, 16, 18, 21–26, 28, 30, 32–38, 40, 42, and 43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, and Del Vecchio.

² The Examiner withdrew a §103 rejection of claim 45. Ans. 3. A rejection of claim 45 under the second paragraph of 35 USC §112 was also withdrawn. Advisory Action, mailed April 21, 2017.

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Pejic.

Claims 8, 27, and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Adler.

Claims 10, 19, 20, and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Bilak.

Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Pellegrino.

Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, Pellegrino, and Colson.

Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Barney.

Claims 17, 31, and 44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Wilkinson.

Claim 41 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Avasarala.

ISSUE

Did the Examiner err in rejecting claims 1, 3–8, and 10–45 under 35 U.S.C. §101 for claiming patent-ineligible subject matter?

Did the Examiner err in rejecting claims 1, 3–5, 7, 11, 12, 16, 18, 21–26, 28, 30, 32–38, 40, 42 and 43 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, and Del Vecchio?

Did the Examiner err in rejecting claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Pejic?

Did the Examiner err in rejecting claims 8, 27 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Adler?

Did the Examiner err in rejecting claims 10, 19, 20 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Bilak?

Did the Examiner err in rejecting claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Pellegrino?

Did the Examiner err in rejecting claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, Pellegrino, and Colson?

Did the Examiner err in rejecting claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Barney?

Did the Examiner err in rejecting claims 17, 31 and 44 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Wilkinson?

Did the Examiner err in rejecting claim 41 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Avasarala?

ANALYSIS

The rejection of claims 1, 3–8, and 10–45 under 35 U.S.C. §101 for claiming patent-ineligible subject matter.

Preliminary comments

#1 The Appellant has grouped the claims in five groups for purposes of argument: I. Claims 1, 22, and 33 (Br. 8–19); II. Claim 6 (Br. 20–21); III. Claims 8 and 27 (Br. 21–22); IV. Claim 45 (Br. 22); and V. Claims 3–5, 7, 10–21, 23–26, and 28–32 (Br. 23). Each group will be addressed separately and in that order.

#2 The Appellant points to previous USPTO guidance of patent eligibility (e.g., “July 2015 Update: Subject Matter Eligibility” (Br. 13)). The 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019), hereinafter “2019 Revised 101 Guidance,” supersedes the earlier guidance that was in effect at the time the Appeal Brief was filed (Dec. 19, 2016). *Id.* 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.”). Accordingly, our analysis will not address the sufficiency of the Examiner’s rejection against the Office’s previous guidance. Rather, our analysis will comport with the 2019 Revised 101 Guidance.

I. CLAIMS 1, 22, AND 33

Representative claim

The Appellant argued these claims as a group. *See* App. Br. 8–10. To be in accord with the Appellant’s discussion, we select claim 1 as the representative claim for this group, and the remaining claims 22 and 33

stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv). Claim 1 is reproduced above.

Introduction

35 U.S.C. § 101 provides that “[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.”

In that regard, claim 1 covers a “process” and is thus statutory subject matter for which a patent may be obtained.³ This is not in dispute.

Section 101, however, “contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

In that regard, notwithstanding claim 1 covers statutory subject matter, the Examiner has raised a question of patent eligibility on the ground that claim 1 is directed to an abstract idea.

Alice identifies a two-step framework for determining whether claimed subject matter is directed to an abstract idea. *Alice*, 573 U.S. at 217.

³ This discussion corresponds to Step 1 of the 2019 Revised 101 Guidance which requires determining whether a “claim is to a statutory category.” 84 Fed. Reg. at 53; *see also id.* at 53–54 (“consider[] whether the claimed subject matter falls within the four statutory categories of patentable subject matter identified by 35 U.S.C. 101”).

Alice step one – the “directed to” inquiry

According to *Alice* step one, “[w]e must first determine whether the claims at issue are *directed to* a patent-ineligible concept.” *Id.* at 218 (emphasis added).

The Examiner determined that claim 1 is directed to “the concept of determining an invention gap.” Final Act. 16.

The Appellant contends that the “claims represent an advance over the prior art in the form of an improvement to computer functionality” Br. 11. The Appellant argues, *inter alia*, that “Appellant’s claimed techniques provide an important advance over the prior art of computer-facilitated patent assessment technology.” *Id.* at 10. “Appellant’s solution relies on an inventive combination of specific techniques in order to perform large-scale patent risk assessment for a given business entity.” *Id.* See also *Id.* at 18 (“Determining aggregate risk without reference to the claims improves the technology of patent risk assessment by increasing the efficiency of the risk assessment process.”)

Accordingly, there is a dispute over what claim 1 is directed to. Is it directed to “the concept of determining an invention gap” (Final Act. 16) or “an improvement to computer functionality” (Br. 11)?

*Claim Construction*⁴

We consider the claim as a whole⁵ giving it the broadest reasonable construction⁶ as one of ordinary skill in the art would have interpreted it in light of the specification⁷ at the time of filing.

Claim 1 involves a computer (“computer-implemented method”), a database (“a database of a computer”); that is, “a computing system having a memory, a computer processor, and a data store.” The “computing system”

⁴ “[T]he important inquiry for a § 101 analysis is to look to the claim.” *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1345 (Fed. Cir. 2013). “In *Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can.*, 687 F.3d 1266, 1273 (Fed. Cir. 2012), the court observed that ‘claim construction is not an inviolable prerequisite to a validity determination under § 101.’ However, the threshold of § 101 must be crossed; an event often dependent on the scope and meaning of the claims.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1347–48 (Fed. Cir. 2015).

⁵ “In determining the eligibility of respondents’ claimed process for patent protection under § 101, their claims must be considered as a whole.” *Diamond v. Diehr*, 450 U.S. 175, 188 (1981).

⁶ 2019 Revised 101 Guidance, page 53, footnote 14 (If a claim, under its *broadest reasonable interpretation*”) (emphasis added.)

⁷ “First, it is always important to look at the actual language of the claims. . . . Second, in considering the roles played by individual limitations, it is important to read the claims ‘in light of the specification.’” *Smart Systems Innovations, LLC v. Chicago Transit Authority*, 873 F.3d 1364, 1378 (Fed. Cir. 2017) (J. Linn, dissenting in part and concurring in part), *citing Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016), among others.

and its parts (“a memory, a computer processor, and a data store”) are generic.⁸

The claimed method calls on a generic “computing system” to perform five functions on various types of information. They are “receiving,” “determining,” “retrieving,” “comput[ing], and “transmitting. We reproduce claim 1 below showing the various types of information (Information A–F).

1. A computer-implemented method, comprising:
under control of a computing system having a memory, a computer processor, and a data store, the data store having [Information A], by instructing the processor with instructions stored in the memory by:

receiving [Information B];

determining, by retrieving [Information C];

determining, [Information D], wherein [Information D] is computed as a numerical function that considers [Information E];
and

transmitting [Information D] as [Information F].

⁸ *Cf. Intellectual Ventures I LLC v. Capital One Financial Corporation*, 850 F.3d 1332, 1341 (Fed. Cir. 2017) (“the claims recite [] a generic computer element—a processor— ...”); *Planet Bingo, LLC v. VKGS LLC*, 576 Fed. Appx. 1005, 1008 (Fed. Cir. 2014) (nonprecedential) (“the claims at issue [] require ‘a computer with a central processing unit,’ ‘a memory,’ ‘an input and output terminal,’ ‘a printer,’ in some cases ‘a video screen,’ and ‘a program . . . enabling’ the steps of managing a game of bingo. . . the claims recite a generic computer implementation of the covered abstract idea.”); and, *Smartflash LLC v. Apple Inc.*, 680 Fed. Appx. 977, 984 (Fed. Cir. 2017) (nonprecedential) (“we find here that ‘interfaces,’ ‘program stores,’ and ‘processors’ are all generic computer components.”)

Where

Information A is “information regarding products and/or companies, patent information, and subject matter areas, determining an invention gap with respect to a business entity, the invention gap indicating a difference between invention-related assets that are applicable to one or more products and invention-related assets that are held by or otherwise available to the business entity”;

Information B is “an indication of a product”;

Information C is “information from the data store, a subject matter category implicated by the indicated product, the subject matter category referring to multiple patents that are each directed at least in part to the subject matter category, each of the multiple patents having an associated assignee that has a corresponding assignee type, at least some of the assignees being different from one another”;

Information D is “specific to the business entity and without reference to independent or dependent patent claims of the multiple patents, an aggregate risk associated with the determined subject matter category, the aggregate risk based at least in part on computing a likelihood that the business entity is exposed to a loss with respect to at least some of the multiple patents that are directed at least in part to the determined subject matter category, wherein the at least some of the multiple patents are not held by or otherwise available to the business entity”;

Information E is “for each of the at least some of the multiple patents, a numerical likelihood that the business entity is exposed to a loss with respect to the patent, wherein the numerical likelihood is weighted based on the assignee type of the patent, wherein determining the aggregate risk is further based at least in part on patent rights available to the business entity, and wherein the computed likelihood that the business entity is exposed to a loss is reduced based on how many patents are available to the business entity”; and,

Information F is “a measure of the invention gap.”

We reasonably broadly construe claim 1 as being directed to a scheme for “receiving,” “determining,” “retrieving,” “comput[ing], and

“transmitting” various types of information implemented on a generic computer system.

*The Abstract Idea*⁹

Just above where we reproduce claim 1, we identify in italics the limitations we believe recite an abstract idea.

The recited italicized limitations, individually and collectively, describe mental processes; that is, “receiving,” “determining,” “retrieving,” “comput[ing], and “transmitting” various types of information. These concepts are akin to making observations and evaluations that can be performed in the human mind and thus are matters that fall within the “Mental processes” enumerated grouping of abstract ideas, both as to each claim limitation and the claim as a whole.¹⁰

⁹ This corresponds to Step 2A of the 2019 Revised 101 Guidance. Step 2A determines “whether a claim is ‘directed to’ a judicial exception,” such as an abstract idea. 2019 Revised 101 Guidance 53. Step 2A is a two prong inquiry.

¹⁰ This corresponds to Prong One [“Evaluate Whether the Claim Recites a Judicial Exception”] (b) of Step 2A of the 2019 Revised 101 Guidance. “To determine whether a claim recites an abstract idea in Prong One, examiners are now to: ... (b) determine whether the identified limitation(s) falls within the subject matter groupings of abstract ideas enumerated in Section 1 of the [2019 Revised 101 Guidance].” *Id.* at 54. This case implicates subject matter grouping “(c)”:

(c) Mental processes – concepts performed in the human mind (including an observation, evaluation, judgment, opinion).

Id. at 52.

*Improvement in the Functioning of a Computer*¹¹ (*Appellant’s Argument*)

The Examiner’s characterization of what the claim is directed to (“the concept of determining an invention gap” (Final Act. 16)) is similar to our own (receiving, determining, retrieving, computing, and transmitting various types of information), albeit ours is described at a lower level of abstraction. *Cf. 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.”) Presumably, the Appellant would challenge our characterization in a way similar to the

¹¹ This corresponds to Prong Two (“If the Claim Recites a Judicial Exception, Evaluate Whether the Judicial Exception Is Integrated Into a Practical Application”) of Step 2A of the 2019 Revised 101 Guidance. 2019 Revised 101 Guidance 54. “A claim that integrates a judicial exception into a practical application will 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.” *Id.* One consideration, implicated here, that is “indicative that an additional element (or combination of elements)[] may have integrated the exception into a practical application” (*id.* at 55) is if “[a]n additional element reflects an improvement in the functioning of a computer, or an improvement to other technology or technical field” (*id.*).

Appellant’s challenge of the Examiner’s characterization as set forth in the briefs.

We have reviewed the record and are unpersuaded as to error in our or the Examiner’s characterization of what claim 1 is directed to.

The Appellant argues claim 1 is directed to an improvement in computer functionality. *See, inter alia*, Br. 9. Citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016). The Appellant argues that “Appellant’s claimed techniques provide an important advance over the prior art of computer-facilitated patent assessment technology.” App. Br. 12.

We are unpersuaded that claim 1 is directed to a problem in the computer-facilitated patent assessment technology arts. To the extent that the Appellant means to argue that the recited steps functionally improve the “computing system having a memory, a computer processor, and a data store” (claim 1), it is true that specific asserted improvements in computer capabilities, when claimed, can render claimed subject matter not directed to an abstract idea. *Cf. McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1316 (Fed. Cir. 2016) (“When looked at as a whole, claim 1 is directed to a patentable, technological improvement over the existing, manual 3–D animation techniques.”). But, there is insufficient evidence in the record before us that the claimed subject matter reflects any such improvement.

“The ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs*

of *Texas v. DirectTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); see also *Enfish*, 822 F.3d at 1335. See also *Ancora Techns.*, 908 F.3d at 1347:

We examine the patent’s “‘claimed advance’ to determine whether the claims are directed to an abstract idea.” *Finjan, Inc. v. Blue Coat System, Inc.*, 879 F.3d 1299, 1303 (Fed. Cir. 2018). “In cases involving software innovations, this inquiry often turns on whether the claims focus on ‘the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an “abstract idea” for which computers are invoked merely as a tool.’” *Id.* (quoting *Enfish*, 822 F.3d at 1335–36); see *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1285–86 (Fed. Cir. 2018). Computers are improved not only through changes in hardware; “[s]oftware can make non-abstract improvements to computer technology” *Enfish*, 822 F.3d at 1335; see *Finjan*, 879 F.3d at 1304. We have several times held claims to pass muster under *Alice* step one when sufficiently focused on such improvements.

The Specification’s description of the problem and solution shows the advance over the prior art by the claimed invention is in the type of information to be processed, not on any improvement in computer functionality. According to the Specification, “[i]n typical approaches, the claims of a patent are interpreted and applied to a product or a service associated with the company to determine whether the patent poses a risk to the company.” Spec., para. 2. The solution is to “determin[e] or identify[] invention gaps.” *Id.* at para. 9.

We have carefully reviewed the Specification but can find no disclosure of a technical improvement. There is no suggestion in the Specification that the claimed subject matter means to solve a problem in the

computer arts as the Appellant has argued. The heart of the invention is a scheme for determining or identifying invention gaps, not the “computing system having a memory, a computer processor, and a data store” (claim 1), which are plainly generic and does not change upon implementation of said scheme. *Cf. Intellectual Ventures I LLC v. Erie Indemnity Company*, 850 F.3d at 1328 (“the heart of the claimed invention lies in creating and using an index to search for and retrieve data . . . an abstract concept.”)

The Specification attributes no special meaning to “receiving,” “determining,” “retrieving,” “comput[ing], and “transmitting” with respect to the “computing system having a memory, a computer processor, and a data store” (claim 1). In our view, consistent with the Specification, these are common processing functions one of ordinary skill in the art at the time of the invention would have associated with generic computer systems. *Cf. OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015):

Beyond the abstract idea of offer-based price optimization, the claims merely recite “well-understood, routine conventional activit[ies],” either by requiring conventional computer activities or routine data-gathering steps. *Alice*, 134 S. Ct. at 2359 (*quoting Mayo*, 132 S.Ct. at 1294) (alterations in original). . . . For example, claim 1 recites “sending a first set of electronic messages over a network to devices,” the devices being “programmed to communicate,” storing test results in a “machine-readable medium,” and “using a computerized system ... to automatically determine” an estimated outcome and setting a price. Just as in *Alice*, “all of these computer functions are ‘well-understood, routine, conventional activit[ies]’ previously known to the industry.” *Alice*, 134 S.Ct. at 2359 (*quoting Mayo*, 132 S.Ct. at 1294) (alterations in original); *see also buySAFE[, Inc. v. Google, Inc.]*, 765 F.3d [1350,] 1355 [(Fed. Cir. 2014)] (“That a computer receives and

sends the information over a network—with no further specification—is not even arguably inventive.”).

Claim 1 describes a method whereby various types of information are received, determined, retrieved, computed, and transmitted. The “computing system having a memory, a computer processor, and a data store” (claim 1) is generic and conventional. *See* Spec., paras. 63 (“general purpose ... computing systems”) – 75. The generic system claimed distinguishes over other generic systems by certain types of information (Information A–F) that are processed. But, that informational content difference alone is not patentably consequential. This is so because “[c]laim limitations directed to the content of information and lacking a requisite functional relationship are not entitled to patentable weight because such information is not patent eligible subject matter under 35 U.S.C. § 101.” *Praxair Distribution, Inc. v. Mallinckrodt Hospital Products IP Ltd.*, 890 F.3d 1024, 1032 (Fed. Cir. 2018).

The receiving, determining, retrieving, computing, and transmitting scheme for identifying invention gaps as claimed does not ask the “computing system having a memory, a computer processor, and a data store” (claim 1) to go beyond its common functions. While instructions a computer must follow to invoke the performance of certain steps can be patentably significant (*see Enfish*, and *Ancora Technologies, Inc. v. HTC America, Inc.*, 908 F.3d 1343 (Fed. Cir. 2018)), here the instant record does not sufficiently support the view that the recited steps are caused to be performed by computer-executable instructions having a non-generic effect on the “computing system having a memory, a computer processor, and a data store” (claim 1). To the contrary, the record supports viewing the

recitation of a “computing system having a memory, a computer processor, and a data store” (claim 1) amounts to a mere instruction to implement the recited scheme on a generic computer. *Cf. Alice* 573 U.S. at 225–26 (“Instead, the claims at issue amount to ‘nothing significantly more’ than an instruction to apply the abstract idea of intermediated settlement using some unspecified, generic computer.”)

Rather than being directed to any specific asserted improvement in computer capabilities, the record supports the view that the claimed subject matter is directed to a receiving, determining, retrieving, computing, and transmitting scheme for identifying invention gaps, using a generic computer.¹²

The claim provides no additional structural details¹³ that would distinguish the “computing system having a memory, a computer processor, and a data store” (claim 1) from that which was well known as being generic at the time the application was filed.

¹² *See* the 2019 Revised 101 Guidance at 55:

The courts have also identified examples in which a judicial exception has not been integrated into a practical application:

- An additional element merely recites the words “apply it” (or an equivalent) with the judicial exception, or merely includes instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea;

¹³ *Cf. Move, Inc. v. Real Estate Alliance Ltd.*, 721 Fed. Appx. 950, 954 (Fed. Cir. 2018) (Nonprecedential). “Claim 1 is aspirational in nature and devoid of any implementation details or technical description that would permit us to conclude that the claim as a whole is directed to something other than the abstract idea identified by the district court.”

Rather, claim 1 describes it functionally, by describing certain resulting steps; that is, receiving, determining, retrieving, computing, and transmitting scheme various types of information. But, in that regard, there is insufficient evidence showing they affect the “computing system having a memory, a computer processor, and a data store” (claim 1) in any structural way.

Accordingly, within the meaning of the 2019 Revised 101 Guidance, we find there is no integration into a practical application.

We have considered all the Appellant’s arguments challenging the Examiner’s determination under step one of the *Alice* framework and find them unpersuasive. For the foregoing reasons, the record supports the Examiner’s determination that claim 1 is directed to an abstract idea.

*Alice step two – Does the Claim Provide an Inventive Concept?*¹⁴

Step two is “a search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 573 U.S. at 221 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 73 (2012)).

In that regard, the Examiner determined that:

¹⁴ This corresponds to Step 2B of the 2019 Revised 101 Guidance page 56 (“[I]f a claim has been determined to be directed to a judicial exception under revised Step 2A, examiners should then evaluate the additional elements individually and in combination under Step 2B to determine whether they provide an inventive concept (*i.e.*, whether the additional elements amount to significantly more than the exception itself).”).

The claim requires no more than a general purpose computer to perform generic computer functions that are well-understood in the art of patent portfolio evaluation. After considering all claim elements, both individually and in combination, it has been determined that the claim does not amount to significantly more than the abstract idea itself or more than a mere instruction to apply the abstract idea. While the claim recites hardware and software elements, such as "under control of a computing system having a memory, a computer processor, and a data store, the data store having information regarding products . . . " these limitations are not sufficient to qualify as being "significantly more" than the abstract idea. Further, claims to an apparatus "comprising a computer for executing computer instructions" and computer-readable medium which "stores a computer program for evaluating pattern-based constraints" are held ineligible for the same reason, e.g., the generically-recited computers add nothing of substance to the underlying abstract idea. Therefore, since there are no limitations in the claim that transform the exception into a patent eligible application such that the claim amounts to significantly more than the exception itself, the claims are rejected under 35 USC 101 as being directed to non-statutory subject matter. Having considered the claim as a whole, we turn to determine if the claim is sufficient to ensure that the claim amounts to "significantly more" than the abstract idea itself. The additional element(s) or combination of elements in the claim(s) other than the abstract idea per se amount(s) to no more than: an instruction to adjust a design class.

Final Act. 17–18.

We agree with the Examiner.

In the section "**Improving Another Technology**" (Br. 18), the Appellant argues, *inter alia*, that

There can be no doubt that evaluating patent risk is a technical endeavor. Technology is the application of science and mathematics to achieve industrial or commercial objectives. Determining aggregate risk as recited by the claims is an application of scientific and mathematical techniques to understand the quantity and quality of patent risk faced by a business. The patent landscape is modeled in

order to understand the likelihood of particular outcomes. In that way, the claims can be analogized at a high level to, for example, technologies such as weather forecasting, climate modeling, seismic analysis, or other predictive technologies. While there may be family resemblances to other modeling and prediction arts, the claimed invention solves challenges and problems that are specific to the patent analysis context.

We addressed the Appellant’s argument as to purported specific asserted improvements in technology under step one of the *Alice* framework. This is consistent with the case law. *See Ancora*, 908 F.3d at 1347 (“We have several times held claims to pass muster under *Alice* step one when sufficiently focused on such improvements.”). Such an argument can also challenge a determination under step two of the *Alice* framework – as the Appellant has done here (*see* App. Br. 17–21; e.g., 20: “a solution to a technological problem”). *See buySAFE*, 765 F.3d at 1354–55. “[R]ecent Federal Circuit jurisprudence has indicated that eligible subject matter can often be identified either at the first or the second step of the *Alice/Mayo* [framework].” 2019 Revised 101 Guidance at 53; *see also id.* n.17.

Be that as it may, we are unpersuaded that claim 1 presents an element or combination of elements indicative of a specific asserted improvement in computer capabilities, thereby rendering the claimed subject matter sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the receiving, determining, retrieving, computing, and transmitting scheme for identifying invention gaps abstract idea itself.

We have reviewed the Specification and, as explained above, we can find no suggestion of any technical improvements associated with the performance of the recited steps. The Specification is focused on determining invention gaps, not on the “computing system having a

memory, a computer processor, and a data store” (claim 1). Rather than focusing on said computer system, the Specification focuses on the receiving, determining, retrieving, computing, and transmitting various types of information that will lead to the identifying of invention gaps, the “computing system having a memory, a computer processor, and a data store” (claim 1) acting merely as a conduit for practicing that scheme. *Cf. In re TLI Communications LLC Patent Litigation*, 823 F.3d at 612 (Fed. Cir. 2016) (“Put differently, the telephone unit itself is merely a conduit for the abstract idea of classifying an image and storing the image based on its classification. Indeed, the specification notes that it ‘is known’ that ‘cellular telephones may be utilized for image transmission,’ [U.S. Patent 6,038,295,] col. 1 ll. 31–34, and existing telephone systems could transmit pictures, audio, and motion pictures and also had ‘graphical annotation capability,’” *id.* at col. 1 ll. 52–59.”)

We are unpersuaded that the record supports interpreting the steps recited in the claim as resulting in a technological improvement as the Appellant has argued. As discussed above, a “computing system having a memory, a computer processor, and a data store” (claim 1) was notoriously well-known, and the recited steps they perform ask nothing more of them than to use them for their commonly-associated information-processing functions. Much like the “data storage unit” and “computer, coupled to said storage unit” in the claims of *Alice* (U.S. Patent 7,149,720, claim 1), “the claims here do [not do] more than simply instruct the practitioner to implement the abstract idea [...] on a generic computer.” *Alice*, 573 U.S. at 225. *See also Bancorp Services, L.L.C. v. Sun Life Assur. Co. of Canada*

(*U.S.*), 687 F.3d 1266, 1278 (Fed. Cir. 2012) (“[T]he use of a computer in an otherwise patent-ineligible process for no more than its most basic function—making calculations or computations—fails to circumvent the prohibition against patenting abstract ideas and mental processes.”).

For the reasons discussed above, we are unpersuaded that the record supports interpreting the steps recited in the claim as yielding any improvement in technology.

The Appellant also argues in the section “**Unconventional Limitations**” (Br. 17) that, *inter alia*, “determining aggregate risk without reference to patent claims adds a specific, unconventional limitation that confines the claim to a particular useful application.”

Claim limitations found to be novel and/or nonobvious can affect a patent-eligibility determination. *Cf. Ariosa Diagnostics, Inc., v. Sequenom, Inc.*, 788 F.3d 1371 (Fed. Cir. 2015) (“For process claims that encompass natural phenomenon, the process steps are the additional features that must be new and useful.”). Thus, novelty is a factor to be considered when determining “whether the claims contain an inventive concept” to “transform” the claimed abstract idea into patent-eligible subject matter.” *Ulramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014). “[N]ovelty in implementation of the idea is a factor to be considered only in the second step of the Alice analysis.” *Id.* However, a finding of novelty or nonobviousness does not necessarily lead to the conclusion that subject matter is patentable eligible. “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2117 (2013).

Indeed, “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (emphasis added); *see also Mayo*, 132 S. Ct. at 1303–04 (rejecting “the Government’s invitation to substitute §§ 102, 103, and 112 inquiries for the better established inquiry under § 101”). Here, the jury’s general finding that Symantec did not prove by clear and convincing evidence that three particular prior art references do not disclose all the limitations of or render obvious the asserted claims does not resolve the question of whether the claims embody an inventive concept at the second step of Mayo/Alice.”

Intellectual Ventures I LLC v. Symantec Corp., 838 F.3d 1307, 1315 (Fed. Cir. 2016). Nor does a finding of obviousness necessarily lead to the conclusion that subject matter is patentable ineligible. *See also Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1050 (Fed. Cir. 2016) (“That each of the claims’ individual steps (freezing, thawing, and separating) were known independently in the art does not make the claim unpatentable.”). “[P]atent-eligibility does not turn on ease of execution or obviousness of application. Those are questions that are examined under separate provisions of the Patent Act.” *Id.* at 1052 (citing *Mayo*, 566 U.S. at 90).

Notwithstanding that “the § 101 patent-eligibility inquiry and, say, the § 102 novelty inquiry might sometimes overlap,” [] a claim for a new abstract idea is still an abstract idea.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (quoting *Mayo*, 566 U.S. at 90). The question in step two of the *Alice* framework is not whether an additional feature is novel but whether the implementation of the abstract idea involves “more than the performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction and Transmission*

LLC v. Wells Fargo Bank, Nat. Ass’n, 776 F.3d 1343, 1347–48 (*quoting Alice*, 134 S.Ct. at 2359). In that regard, the Appellant has not shown that any of the allegedly novel features of the receiving, determining, retrieving, computing, and transmitting scheme for identifying invention gaps transforms that abstract idea into patent-eligible subject matter.

We cited the Specification to show that it discloses that the claimed system, i.e., the “computing system having a memory, a computer processor, and a data store” (claim 1) is conventional. *E.g.*, *see* para. 63 (“general purpose computing systems/devices may be used . . .”).” In doing so, we have followed “Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP Inc.*), 881 F.3d 1360 (Fed. Cir. 2018),” USPTO Memorandum, Robert W. Bahr, Deputy Commissioner For Patent Examination Policy, April 19, 2018 (the “Berkheimer Memo”).

The court in *Berkheimer* held that “[t]he patent eligibility inquiry may contain underlying issues of fact.” *Berkheimer*, 881 F.3d at 1365 (*quoting Mortgage Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325 (Fed. Cir. 2016) (“The § 101 inquiry ‘*may* contain underlying factual issues.”)). But, the court also held that “[w]hen there is *no genuine issue of material fact* regarding whether the claim element or claimed combination is well-understood, routine, [and] conventional to a skilled artisan in the relevant field, this issue can be decided on summary judgment as a matter of law.” *Id.* at 1368 (emphasis added). This qualification has been subsequently reiterated.

If there is a genuine dispute of material fact, Rule 56 requires that summary judgment be denied. In *Berkheimer*, there was

such a genuine dispute for claims 4–7, but not for claims 1–3 and 9 [I]n accordance with *Alice*, we have repeatedly recognized the absence of a genuine dispute as to eligibility for the many claims that have been defended as involving an inventive concept based merely on the idea of using existing computers or the Internet to carry out conventional processes, with no alteration of computer functionality.

Berkheimer v. HP Inc., 890 F.3d 1369, 1371–73 (Fed. Cir. 2018) (Order, On Petition for rehearing en banc, May 31, 2018); *see also Aatrix Software, Inc. v. Green Shades Software, Inc.*, 890 F.3d 1354, 1368 (Fed. Cir. 2018) (“A factual allegation or dispute should not automatically take the determination out of the court’s hands; rather, there needs to be justification for why additional evidence must be considered—the default being a legal determination.”). Here, the Specification indisputably shows the claimed “computing system having a memory, a computer processor, and a data store” (claim 1) was conventional at the time of filing. Accordingly, no genuine issue of material fact exists as to the well-understood, routine, or conventional nature of the claimed “computing system having a memory, a computer processor, and a data store” (claim 1) as claimed.

Finally, as to the question of preemption, the Appellant asserts “Appellant has identified numerous specific features that prevent preemption of the allegedly abstract idea of determining an invention gap.” Br. 16.

With respect to the pre-emption concern, “[w]hat matters is whether a claim threatens to subsume the full scope of a fundamental concept, and when those concerns arise, we must look for meaningful limitations that prevent the claim as a whole from covering the concept’s every practical application.” *CLS Bank Intern. v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269,

1281 (Fed. Cir. 2013) (Lourie, J., concurring). Pre-emption is not a separate test.

To be clear, the proper focus is not preemption *per se*, for some measure of preemption is intrinsic in the statutory right granted with every patent to exclude competitors, for a limited time, from practicing the claimed invention. *See* 35 U.S.C. § 154. Rather, the animating concern is that claims should not be coextensive with a natural law, natural phenomenon, or abstract idea; a patent-eligible claim must include one or more substantive limitations that, in the words of the Supreme Court, add “significantly more” to the basic principle, with the result that the claim covers significantly *less*. *See Mayo* 132 S. Ct. at 1294. Thus, broad claims do not necessarily raise § 101 preemption concerns, and seemingly narrower claims are not necessarily exempt.

Id. *See also Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”). Because we find the claimed subject matter covers patent-ineligible subject matter, the pre-emption concern is necessarily addressed. “Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, [] preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics*, 788 F.3d at 1379.

No other persuasive arguments having been presented, we conclude that no error has been committed in the determination under *Alice* step two that claim 1 does not include an element or combination of elements circumscribing the patent-ineligible concept it is directed to so as to transform the concept into an inventive application.

We have considered all of the Appellant’s remaining arguments and find them unpersuasive.

Accordingly, because we are not persuaded as to error in the determinations that representative claim 1 and claims 22 and 33, which stand or fall with claim 1, are directed to an abstract idea and do not present an “inventive concept,” we sustain the Examiner’s conclusion that they are directed to patent-ineligible subject matter for being judicially-excepted from 35 U.S.C. § 101. *Cf. LendingTree, LLC v. Zillow, Inc.*, 656 Fed. Appx. 991, 997 (Fed. Cir. 2016) (“We have considered all of LendingTree’s remaining arguments and have found them unpersuasive. Accordingly, because the asserted claims of the patents in suit are directed to an abstract idea and do not present an ‘inventive concept,’ we hold that they are directed to ineligible subject matter under 35 U.S.C. § 101.”); *see, e.g., OIP Techs.*, 788 F.3d at 1364; *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016).

II. Claim 6

According to the Appellant,

Dependent claim 6 recites “determining the subject matter category includes extracting, by using computer-based natural language processing, semantic information from a textual description of the product.”

With respect to the first part of the *Alice* analysis, this additional limitation further adds to the inventive combination of features by additionally performing natural language processing to obtain semantic information from a textual description of a product. This operation further improves the efficiency and usability of the claimed invention, by allowing a textual description of a product to drive the determination of relevant subject matter categories.

Under the second part of the *Alice* analysis, computer-based natural language processing is not a conventional computer operation.

This combination of operations is simply not the kind of generic computer operation (e.g., reading data, storing data, performing calculations) that the Supreme Court had in mind when it developed the “significantly more” portion of the test.

Br. 20.

With regard to “[t]his operation further improves the efficiency and usability of the claimed invention, by allowing a textual description of a product to drive the determination of relevant subject matter categories” (Br. 20), there is insufficient evidence on the record of such an improvement.

The Specification says this:

In yet another example, the user 110 provides a description of a product in a natural language representation (e.g., a parts list, a technical overview/abstract). The PRAS 100 may then process the received information (e.g., by using natural language processing techniques) to extract semantic information about the elements of the product.

Para. 18. That is all that is said. *Cf. In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); *Meitzner v. Mindick*, 549 F.2d 775 (CCPA 1977), *cert. denied*, 434 US 854 (1977); *In re Schulze*, 346 F.2d 600, 602 (CCPA 1965); and *In re Walters*, 168 F.2d 79, 80 (CCPA 1948):

Although it is asserted in the brief of counsel for appellant that “the result of using an oil modified alkyd resin coating on a loading coil core was revolutionary” and that “It marked the greatest advance in loading coil manufacture in many years,” there is no evidence of record to substantiate that assertion, nor any evidence of record of comparative tests to show superiority of the coating compositions claimed here over the ceramic materials disclosed in the patent to Gills. Furthermore, statements of counsel in a brief cannot take the place of evidence.

With regard to “computer-based natural language processing is not a conventional computer operation” (Br. 20), the evidence in this record shows otherwise. With respect to the ¶ 103 rejection of claim 6 (see Final Act. 55), the Examiner cited Pejic (US 2003/0229470, filed Jun. 10, 2003) which specifically discloses computer-based natural language techniques as being conventional. See para. 89. Pejic is similarly concerned with patent-related information.

The arguments challenging the rejection of claim 6 are unpersuasive for the foregoing reasons.

III. Claims 8 and 27

The Appellant argues:

Dependent claim 8 recites:

determining, by the computer processor, an expanded set of patents that includes at least one of: (1) patents that cite patents in the initial set, (2) patents cited by patents in the initial set, (3) patents having common inventorship with patents in the initial set, and/or patents having common assignees with patents in the initial set, wherein determining the expanded set of patents includes limiting which patents are included in the expanded set of patents based on keyword filtering and date-based filtering, such that the expanded set of patents only includes patents that include a specified keyword and that are unexpired and/or have a specified amount of patent term remaining

(Numbering added.) Dependent claim 27 includes similar limitations.

With respect to the first part of the *Alice* analysis, these claim aspects further add to the specific inventive combination of techniques by determining a relevant patent set by first determining an expanded set of patents and then limiting that set based on keyword and date. This technique further limits any risk of preemption by adding

specific requirements and leaving open other approaches for assessing patent risk.

With respect to the second part of the *Alice* analysis, this operation cannot be performed by simple reliance on standard computer programming constructs or libraries. Again, this combination of operations is simply not the kind of generic computer operation (e.g., reading data, storing data, performing calculations) that would ordinarily be considered a conventional computer operation under *Alice*.

Br. 21.

The Appellant does not spell out, and we are unable to discern from the recited determining step, a “specific inventive combination of techniques” (Br. 21). The step calls for determining certain types of information “which includes limiting which patents are included in the expanded set of patents based on keyword filtering and date-based filtering” (claim 8). But we do not see how employing a filter per se, as broadly claimed here, transforms the abstract idea to which the claim is directed to into an inventive concept. *See LendingTree, LLC*, 656 Fed. Appx. at 995.

Regarding the Appellant’s contention that “this operation cannot be performed by simple reliance on standard computer programming constructs or libraries” (Br. 21), the record suggests the opposite. *See e.g.*, Spec., para. 63 (“general purpose or special purpose computing systems/devices may be used to implement the PRAS 410”) and para. 71 (“In an example, components/modules of the PRAS 410 are implemented using standard programming techniques. . . . In general, a range of programming languages known in the art may be employed . . .”).

The arguments challenging the rejection of claims 8 and 27 are unpersuasive for the foregoing reasons.

IV. Claim 45

The Appellant argues

Dependent claim 45 recites:

computing a numerical value that is a sum of the number of patents in the first set [non-practicing entity patents] multiplied by a first weight, the number of patents in the second set [competitor patents] multiplied by a second weight, and the number of patents in the third set [academic institution patents] multiplied by a third weight, minus the number of patents in the fourth set [entity patents] multiplied by a fourth weight, wherein the first weight is larger than the second weight.

Claim 45 recites operations for computing aggregate risk, by computing a sum of the number of patents owned or licensed by different entity types (e.g., competitor, non-practicing entity, and academic), where each of these numbers is weighted by a specific weight for each entity type. Furthermore, claim 45 recites the relationship between the weights, which is that the non-practicing entity weight is greater than the competitor weight.

The specific operations recited by claim 45 are not conventional operations. They are not performed by computers without special configuration or programming. Furthermore, the recited specific operations limit claim 45 to a particular way of determining an aggregate risk, thereby confining the alleged abstract idea to a particular application and limiting the risk of preemption.

Br. 22.

The Appellant argues that “[t]he specific operations recited by claim 45 are not conventional operations. They are not performed by computers without special configuration or programming.” *Id.* But, there is insufficient support in the record for this argument. As we have pointed out, the Specification indicates that a general purpose computer and general programming can be used to implement the claimed method. Accordingly, the record suggests the opposite from what is being argued.

The arguments challenging the rejection of claim 45 are unpersuasive for the foregoing reasons.

V. Claims 3–5, 7, 10–21, 23–26, and 28–32

The Appellant makes a single statement that these claims are directed to patent-eligible subject matter for the reasons given in challenging the rejection of the respective independent claims. Br. 23. Since we did not find those reasons persuasive, we are unpersuaded as to the patent-eligibility of these claims as well.

The rejection of claims 1, 3–5, 7, 11, 12, 16, 18, 21–26, 28, 30, 32–38, 40, 42 and 43 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, and Del Vecchio.

Claims 1, 22, and 33 are the independent claims and parallel each other.

The Examiner’s position is that Zilka discloses all that is claimed but for

the aggregate risk based at least in part on computing a likelihood that the business entity is exposed to a loss with respect to at least some of the multiple patents that are directed at least in part to the determined subject matter category, wherein the aggregate risk is computed as a numerical function that considers, for each of the at least some of the multiple patents, a numerical likelihood that the business entity is exposed to a loss with respect to the patent, wherein the numerical likelihood is weighted based on the assignee type of the patent (Final Act. 31), for which Rozich is relied upon; “the numerical likelihood is weighted based on the assignee type of the patent” (*id.* at 35), for which Barnett is relied upon; and “the computed likelihood that the business entity

is exposed to a loss is reduced based on how many patents are available to the business entity” (*id.* at 38), for which Del Vecchio is relied upon.

Specifically, the Examiner states that col. 7, lines 31–42 of Zilka discloses the claim limitation “determining, specific to the business entity and without reference to independent or dependent patent claims of the multiple patents, an aggregate risk associated with the determined subject matter category.” *See* Final Act. 25. The Examiner finds that Zilka teaches:

determining, specific to the business entity and without reference to independent or dependent patent claims of the multiple patents, an aggregate risk associated with the determined subject matter category (col. 7, lines 31-42, discussing that the competing intellectual property identifiers may be collected by doing a “forward search” or “backward search” utilizing information positioned on the patent, utilizing the aforementioned databases, or any other data source; as an option, such a “forward search” or “backward search” may be initiated automatically or manually upon the selection of a corresponding icon 508 found on the graphical user interface 500; as an example, a backward search can be performed by identifying patents listed on the face of the patent itself or in its text[.])

Id. at 27. We reproduce col. 7, lines 31-42 of Zilka:

In an alternate embodiment, the competing intellectual property identifiers may be collected by doing a “forward search” or “backward search” utilizing information positioned on the patent, utilizing the aforementioned databases 120 of FIG. 1, or any other data source. As an option, such a “forward search” or “backward search” may be initiated automatically or manually upon the selection of a corresponding icon 508 found on the graphical user interface 500. As an example, a backward search can be performed by identifying patents listed on the face of the patent itself or in its text.

We do not see in the above portion of Zilka disclosure of “determining, specific to the business entity and without reference to independent or dependent patent claims of the multiple patents, an aggregate risk associated with the determined subject matter category” as claimed.

There being no other position as the prior art disclosing or leading one to the subject matter of said limitation, we accordingly do not sustain the rejection of the independent claims, and that of the claims depending therefrom which necessarily include said limitation and to which the Examiner takes the same position that said Zilka passage discloses said limitation (*see* Final Act. 39–55), because a prima facie case of obviousness has not been made out in the first instance.

The rejection of claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Pejic.

The rejection of claims 8, 27 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Adler.

The rejection of claims 10, 19, 20 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Bilak.

The rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Pellegrino.

The rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, Pellegrino, and Colson.

The rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Barney.

The rejection of claims 17, 31 and 44 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Wilkinson.

The rejection of claim 41 under 35 U.S.C. § 103(a) as being unpatentable over Zilka, Rozich, Barnett, Del Vecchio, and Avasarala.

These rejections of claims depending from the independent claims addressed above are not sustained for the same reasons. The Examiner’s position as to the aforementioned claim limitation is the same. *See* Final Act. 55–86.

CONCLUSION

In summary:

Claims Rejected	Basis	Affirmed	Reversed
1, 3–8, and 10–45	§ 101	1, 3–8, and 10–45	
1, 3–5, 7, 11, 12, 16, 18, 21–26, 28, 30, 32–38, 40, 42 and 43	§ 103 over Zilka, Rozich, Barnett, and Del Vecchio		1, 3–5, 7, 11, 12, 16, 18, 21–26, 28, 30, 32–38, 40, 42 and 43
6	§ 103 over Zilka, Rozich, Barnett, Del Vecchio, and Pejic		6
8, 27, and 39	Zilka, Rozich, Barnett, Del Vecchio, and Adler		8, 27, and 39

Claims Rejected	Basis	Affirmed	Reversed
10, 19, 20, and 29	Zilka, Rozich, Barnett, Del Vecchio, and Bilak		10, 19, 20, and 29
13	Zilka, Rozich, Barnett, Del Vecchio, and Pellegrino		13
14	Zilka, Rozich, Barnett, Del Vecchio, Pellegrino, and Colson		14
15	Zilka, Rozich, Barnett, Del Vecchio, and Barney		15
17, 31, and 44	Zilka, Rozich, Barnett, Del Vecchio, and Wilkinson		17, 31, and 44
41	Zilka, Rozich, Barnett, Del Vecchio, and Avasarala		41

DECISION

The decision of the Examiner to reject claims 1, 3-8, and 10-45 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