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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GEOFFRY A. WESTPHAL

Appeal 2017-009792
Application 13/623,301[1]
Technology Center 2100

Before JAMESON LEE, MICHAEL R. ZECHER, and JUSTIN T. ARBES, *Administrative Patent Judges.*

ZECHER, *Administrative Patent Judge.*

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claim 1. App. Br. 1, 4–9.[2] Claims 2–12 were cancelled. We have jurisdiction under 35 U.S.C. § 6. We *affirm*.

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[1] According to Appellant, the real party in interest is W.W. Grainger, Inc. App. Br. 2.

[2] Our decision will make reference to Appellant's Appeal Brief ("App. Br.," filed January 23, 2017), Appellant's Reply Brief ("Reply Br.," filed July 12, 2017), and the Examiner's Answer ("Ans.," mailed May 17, 2017).

Appellant's Invention

Appellant purportedly invented a new process for using a selection guide to locate one or more items of interest. Spec. 2:15–17. According to Appellant, the disclosed invention automatically invokes a selection guide when the search terms inputted by a prospective user into a free form search query are determined to be associated with a category of an item for which the selection guide will provide the most efficient mechanism for the user to locate one or more items of interest. *Id.* at 2:17–21. The disclosed invention compares the search terms inputted by the user into the free form search query with a listing of keywords that have been associated with a number of selection guides. *Id.* at 2:21–23. If a match is found, the corresponding selection guide may be launched automatically. *Id.* at 2:23–25. In one embodiment, the search terms inputted by the user into the free form search query may be used to pre-populate a template used in connection with the corresponding selection guide. *Id.* at 3:7–10. If it is determined, however, that the free form search query will provide search results that are narrow in scope so as not to frustrate the user, the search results may be provided to the user instead of automatically launching the corresponding selection guide. *Id.* at 3:4–7.

Related Appeals

The present application is a continuation-in-part of U.S. Patent Application No. 11/158,039 ("the '039 application"). Spec. 1:5–7. We previously decided two appeals in the '039 application. *See Ex parte Westphal*, No. 2012-011654, 2015 WL 1089279 (PTAB Mar. 9, 2015) (non-precedential) (affirming the Examiner's obviousness rejection of claims 18–25); *Ex parte Westphal*, No. 2017-006254 (PTAB Feb. 26, 2018) (non-

precedential) (affirming the Examiner's obviousness rejection of claims 18–25).

Illustrative Claim

Claim 1 is the only claim at issue and is reproduced below:

> 1. A non-transitory computer-readable media having stored thereon computer executable instructions for facilitating access to one or more items of interest in an electronic catalog by means of a selection guide having a plurality of parametric data entry fields each having a plurality of predetermined values one of which is selectable by a user to specify requirements for use in searching product records for the one or more items of interest, the instructions, when executed by a server computer device in communication with a client computer device, performing steps comprising:
>
> examining a free form search query by a search engine of the server computer device as the free form search query is being entered on a client computer device to determine if the free form search query includes one or more terms that correspond to a one of the plurality of predetermined values of one or more of the plurality of parametric data entry fields of the selection guide;
>
> when it is determined by the search engine of the server computer device that the free form search query as being entered on the client computer device includes one or more terms that correspond to a one of the plurality of predetermined values of one or more of the parametric data entry fields of the selection guide, *automatically causing the server computer device to launch on the client computer device the selection guide*.

App. Br. 10 (emphasis added to highlight disputed limitation).

Prior Art Relied Upon

Inventor[3]	Patent/Publication	Relevant Date(s)
Ferrari	U.S. Patent Application Pub. No. 2003/0097357 A1	published May 22, 2003
Forstall	U.S. Patent Application Pub. No. 2006/0206454 A1	published Sept. 14, 2006; filed Mar. 8, 2005
Ashkenazi	U.S. Patent No. 7,805,339 B2	issued Sept. 28, 2010; filed Dec. 18, 2002

Rejections on Appeal

Claim 1 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Non-Final Act. 3–4.[4]

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Ferrari, Forstall, and Ashkenazi. *Id.* at 4–8.

Examiner's Findings

1. Beginning with the first step in *Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014), the Examiner finds that independent claim 1 is directed to "examining a query as it is being entered to determine if the query corresponds to a parametric data entry field of a selection guide, and, when the query does, automatically launching the selection guide on a client computer device." Non-Final Act. 3. According to the Examiner, the underlying abstract idea of this claimed subject matter is "comparing new and stored information to identify options" (Non-Final Act. 3; Ans. 3) or, stated differently, "collect[ing] information (the free-form search query), analyz[ing] information (whether the free-form search query includes one or

[3] For clarity and ease of reference, we only list the first named inventor.

[4] All references to the Non-Final Action ("Non-Final Act.") refer to the Non-Final Action entered on October 28, 2016.

more terms that corresponds to a selection guide), and display[ing] results of the analysis (launching a selection guide)" (Ans. 3). Turning to the second step in *Alice,* the Examiner finds that, although independent claim 1 recites non-transitory computer readable media, a server computer device, and a client computer device that perform the steps identified above, these hardware elements "do not amount to significantly more than the abstract idea [itself] because each of the hardware elements represent generic pieces of hardware designed to implement the claimed functions." Non-Final Act. 4. The Examiner, therefore, determines that the claimed elements—taken individually or as an ordered combination—do not amount to significantly more than the abstract idea itself. Non-Final Act. 4; Ans. 3–4.

2. The Examiner finds that Ferrari's disclosure of providing a user with a list of possible selection guides in response to a free-form search query teaches all of the limitations of independent claim 1, except "as the free form search query is being entered on a client computer device," and "when it is determined by the search engine of the computer device that the free form search query as being entered on the client computer device includes one or more terms," automatically causing results to be displayed. Non-Final Act. 4–6 (citing Ferrari ¶¶ 25, 64, 74, 320, Figs. 2, 3, 9, 24). The Examiner turns to Forstall's auto-completed terms and automatic searching functionality as teaching these limitations. *Id.* at 6–7 (citing Forstall ¶¶ 49, 51). The Examiner then concludes that it would have been obvious to one of ordinary skill the art to modify Ferrari with these teaching in Forstall because doing so "increases the response time of a search to a user" and helps "to avoid the drawbacks set forth in Forstall . . . , notably inefficiencies requiring a user to type out an entire word." *Id.* at 7 (underlining omitted).

The Examiner further finds that Forstall does not teach "automatically causing the server computer device to launch on the client computer device the selection guide." Non-Final Act. 7. The Examiner relies on Ashkenazi's "Skip by Popularity" functionality, which automatically launches a selection guide after receiving a keyword search, to teach this particular limitation. *Id.* (citing Ashkenazi, 10:45–11:9). The Examiner then concludes that it would have been obvious to one of ordinary skill the art to modify the combined teachings of Ferrari and Forstall with those of Ashkenazi because doing so "will save a user navigation steps" and "[t]his will help Ferrari . . . to navigate to where more customers want to go more quickly." *Id.* at 7–8 (citing Ashkenazi, 10:46–47) (underlining omitted).

Appellant's Contentions

1. Appellant contends that the Examiner fails to present a *prima facie* case of unpatentability under § 101. App. Br. 4; Reply Br. 2. According to Appellant, the Examiner ignores certain aspects of independent claim 1 that results in an oversimplification that inaccurately states to what this claim is directed. Reply Br. 2. Appellant also argues that the Examiner fails to identify additional elements of independent claim 1, much less recognize that these elements, when treated as an ordered combination, amount to a "programmatic structure that improves the functioning of technology" and is more than a general purpose computer. App. Br. 4 (underlining omitted); Reply Br. 2. In other words, Appellant asserts that the Examiner fails to explain why the additional elements of independent claim 1 do not amount to significantly more than the abstract idea itself. App. Br. 4.

2. Appellant contends that Ashkenazi's "Skip by Popularity" function moves the user past intermediate navigation steps, such as identifying the most popular category for an entered search term, and searches for that term within the identified category prior to directing the user straight to the search results. App. Br. 7–8 (citing Ashkenazi, 11:10–16, 13:1–16, Fig. 7); Reply Br. 2–3 (arguing the same). According to Appellant, this "Skip by Popularity" functionality does not teach "automatically causing the server computer device to launch on the client computer device the selection guide," particularly when certain conditions have been satisfied. App. Br. 8; Reply Br. 3.

II. ISSUES

1. Has the Examiner erred in determining that independent claim 1 is directed to a patent-ineligible concept (e.g., an abstract idea) and, if so, whether the elements of this claim—either individually or as an ordered combination—transform it into a patent-eligible application?

2. Has the Examiner erred in determining that the combined teachings of Ferrari, Forstall, and Ashkenazi account for "automatically causing the server computer device to launch on the client computer device the selection guide," as recited in independent claim 1?

III. ANALYSIS

§ 101 Rejection

Based on the record before us, we do not discern error in the Examiner's rejection of independent claim 1 as being directed to non-statutory subject matter under § 101.

A patent may be obtained for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." 35 U.S.C. § 101. The U.S. Supreme Court has "long held that this [statutory] provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable." *Alice*, 134 S. Ct. at 2354 (quoting *Association for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). Notwithstanding that a law of nature or an abstract idea, by itself, is not patentable, the practical application of these concepts may be deserving of patent protection. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293–94 (2012).

In *Alice*, the Supreme Court reaffirmed the framework set forth previously in *Mayo* "for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts." *Alice*, 134 S. Ct. at 2355. The first step in the analysis is to "determine whether the claims at issue are directed to one of those patent-ineligible concepts." *Id.* If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims "individually and 'as an ordered combination'" to determine whether there are additional elements that "'transform the nature of the claim' into a patent-eligible application." *Id.* (quoting *Mayo*, 132 S. Ct. at 1298, 1297).

Beginning with the first step in *Alice*, we are persuaded by the Examiner's description of independent claim 1 as being directed to the abstract idea of collecting information (i.e., the free-form search query), analyzing information (i.e., whether the free-form search query includes one

or more terms that correspond to a selection guide), and displaying results of the analysis (i.e., launching a selection guide). *See* Ans. 2–3; Non-Final Act. 3. This claim recites steps for accessing one or more items of interest in an electronic catalog that, at best, includes collecting information from a free form search query, analyzing that information (i.e., by determining whether the free form search query includes one or more search terms with one of a plurality of predetermined values of one or more plurality of parametric data entry fields of a selection guide), and then displaying results of the analysis automatically (i.e., by automatically launching a corresponding selection guide). App. Br. 10 (Claims Appendix). We agree with the Examiner that this process of collecting information, analyzing the information, and automatically displaying certain results—without any particular inventive technology for performing those functions—falls within the realm of abstract ideas. *See* Ans. 3 (citing *Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016) (holding that claims directed to a process of collecting information, analyzing that information, and displaying certain results are directed to abstract ideas)).

Turning to the second step in *Alice*, when we consider the claim elements individually, independent claim 1 requires accessing one or more items of interest in an electronic catalog by performing the following steps: (1) examining a free form search query; (2) determining whether the free form search query includes one or more search terms with one of a plurality of predetermined values of one or more plurality of parametric data entry fields of a selection guide; and (3) if so, automatically launching the corresponding selection guide. App. Br. 10 (Claims Appendix). This claim further recites the use of various computers (i.e., "a server computer device"

and "a client computer device") to carry out these aforementioned steps. *Id.* As *Alice* explains, use of a computer to communicate information (like the "client computer device" and "free form search query" here), as well as "use of a computer to obtain data . . . and issue automated instructions" (like the "server computer device" and "selection guide" here) are "[some] of the most basic functions of a computer." *Alice*, 134 S. Ct. at 2359.

Nor does performing the steps with a generic computer or server add an inventive concept. *See Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1341 (Fed. Cir. 2017) (holding that "claims recit[ing] both a generic computer element—a processor—and a series of generic computer 'components'" do not contain an inventive concept). Indeed, the Specification states that "[s]ystems and methods for searching electronic product catalogs to locate items of interest are well known in the art," particularly those that use a search engine employed on a general purpose computer. Spec. 1:12–2:9. Ashkenazi serves as additional evidence that such conventional processes of searching employ generic computers and servers. Ashkenazi, 10:14–15 ("[Figures] 6–8 show a *conventional* process that is known to those skilled in the art of comparison shopping sites." (emphasis added))

When considering the claim elements as an ordered combination, independent claim 1, as a whole, is simply indicative of the abstract idea of collecting information, analyzing the information, and automatically displaying certain results that are applied using generic computers or servers. *See Alice*, 134 S. Ct. at 2359–60 (explaining that the application of an abstract idea using some unspecified, generic computer or server is not enough to transform an abstract idea into a patent-eligible invention).

Independent claim 1, at most, automates previously-known manual processes of selecting a selection guide. *See* Spec. 2:9–12 (stating that "current e-commerce systems suffer the disadvantage of . . . requiring that the user know that . . . selection guides exist on the e-commerce system and what actions are required to *manually* initiate their use" (emphasis added)). "But merely 'configur[ing]' generic computers in order to 'supplant and enhance' an otherwise abstract manual process is precisely the sort of invention that the *Alice* Court deemed ineligible for patenting." *See Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1056 Fed. Cir. 2017 (alteration in original). It follows that the Examiner has not erred in determining that independent claim 1 is directed to non-statutory subject matter under § 101.

§ 103(a) Rejection

We do not discern error in the Examiner's obviousness rejection of independent claim 1, which recites, among other things, "automatically causing the server computer device to launch on the client computer device the selection guide." As we explain above, the Examiner relies on Ashkenazi's "Skip by Popularity" functionality to teach this disputed limitation. We begin our analysis with a brief discussion of Ashkenazi's Figures 6 and 7, which is necessary to provide context for its "Skip by Popularity" functionality, and then we turn to the disputed limitation identified above.

Figure 6 of Ashkenazi, reproduced below, illustrates interactive screen 600.

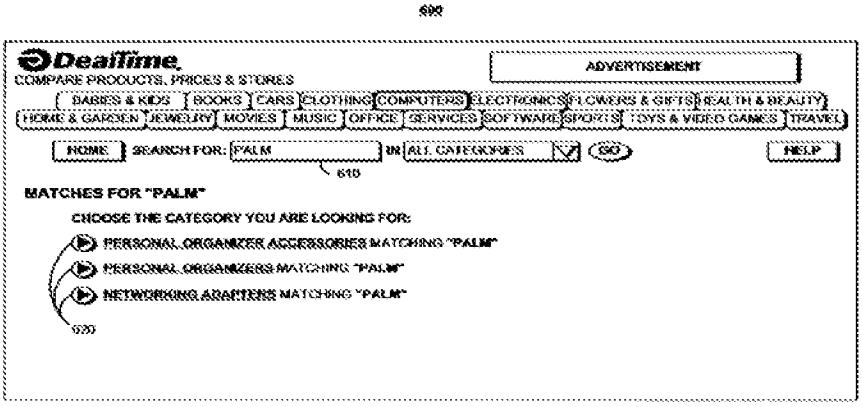

FIG. 6

As shown in Figure 6, when a prospective user enters the word "palm" into keyword area 610, multiple forms 620 are retrieved and placed in the search results. Ashkenazi, 10:17–21. Forms 620 include a personal organizer accessories form, a personal organizers form, and a networking adapters form. *Id.* When the user selects one of these forms 620 (e.g., the personal organizer accessories form), a search is executed using the keyword "palm" and the selected form. *Id.* at Figs. 6, 7.

Figure 7 of Ashkenazi, reproduced below, illustrates the results of this search. Ashkenazi, 10:22.

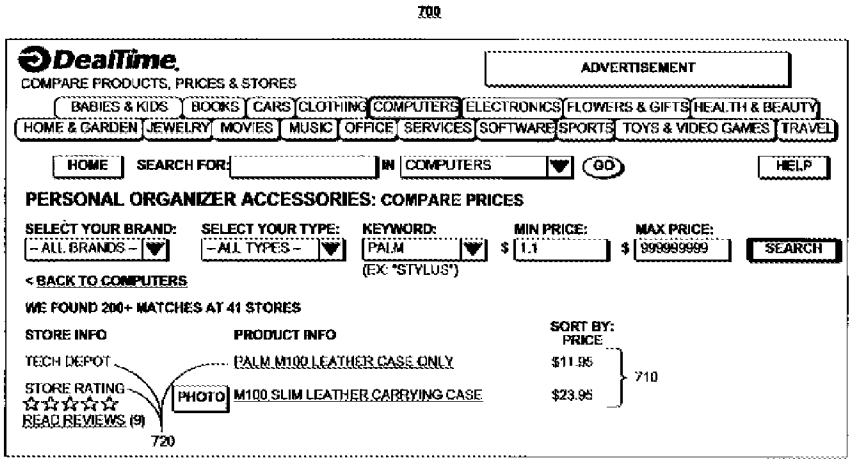

FIG. 7

As shown in Figure 7, interactive screen 700 displays product search results 710 of the products associated with the keyword "palm" and the personal organizer accessories form selected by the user in Figure 6. Ashkenazi, 10:23–25. Product search results 710 include product search links 720 to merchant websites. *Id.* at 10:25–26.

Ashkenazi further discloses that its general search functionality includes a "Skip by Popularity" functionality that evaluates each keyword submitted to the search engine and determines whether one or more keywords are relevant to a specific category. Ashkenazi, 10:56–61. If a relevance threshold with respect to a specific category is met, the user may skip over intermediate navigational steps and immediately be directed to the following: (1) the relevant category; or (2) a comparison shopping page for a specific product. *Id.* at 10:61–66. As one example, Ashkenazi discloses that, when the keyword "Palm PC" is entered by a user, 92% of subsequent clicks occur within the personal organizer category. *Id.* at 11:4–7. By employing the "Skip by Popularity" functionality, once the user enters the keyword "Palm PC," he/she immediately will be directed to the personal organizer category or, alternatively, a comparison shopping page for personal organizers. *Id.* at 11:7–9.

We agree with the Examiner, and we find, that the process illustrated in Ashkenazi's Figure 6 of entering one or more keywords (e.g., "palm" or "Palm PC"), in conjunction with invoking the "Skip by Popularity" functionality that immediately selects the most relevant product category associated with the entered keyword or keywords (i.e., personal organizer accessories), amounts to determining whether certain conditions have been satisfied prior to launching a selection guide automatically. The results of

automatically launching the selection guide are illustrated in Ashkenazi's Figure 7 (e.g., accessories for a palm or personal digital assistant, such as a leather carrying case). We, therefore, are persuaded that the Examiner has presented sufficient evidence to support a finding that Ashkenazi teaches, when certain conditions have been satisfied, "automatically causing the server computer device to launch on the client computer device the selection guide," as recited in independent claim 1.

We are not persuaded by Appellant's argument that Ashkenazi's "Skip by Popularity" functionality does not teach this disputed limitation because, purportedly, it moves the user past intermediate navigation steps, such as identifying the most popular category for an entered search term, and searches for that term within the identified category prior to directing the user straight to the search results. *See* App. Br. 7–8; Reply Br. 2–3. Appellant's argument in this regard is predicated on the incorrect notion that independent claim 1 expressly recites an additional navigation step prior to launching the selection guide automatically. Independent claim 1 does not require displaying a discerned category to the user, nor does this claim require a user response to that display, prior to launching the selection guide automatically. Stated differently, Appellant's argument is not commensurate in scope with independent claim 1 because this claim merely requires examining the one or more keywords in a search query, and if certain conditions have been satisfied (i.e., the free form search query includes one or more search terms with one of a plurality of predetermined values of one or more plurality of parametric data entry fields of a selection guide), then launching the corresponding selection guide automatically. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (explaining that limitations

not appearing in the claims cannot be relied upon for patentability). As we explain above, the process illustrated in Ashkenazi's Figure 6 of entering one or more keywords (e.g., "palm" or "Palm PC"), in conjunction with invoking the "Skip by Popularity" functionality that immediately selects the most relevant product category associated with the entered keyword or keywords (i.e., personal organizer accessories), teaches, when certain conditions have been satisfied, launching a selection guide automatically, as required by independent claim 1. It follows that the Examiner has not erred in determining that the combined teachings of Ferrari, Forstall, and Ashkenazi render the subject matter of independent claim 1 unpatentable.[5]

IV. CONCLUSIONS OF LAW

For the foregoing reasons, the Examiner has not erred in rejecting independent claim 1 as being (1) directed to non-statutory subject matter under § 101; and (2) unpatentable under § 103(a).

[5] If prosecution of the present application resumes, the Examiner should consider whether any asserted prior art must account for the step of "automatically causing the server computer device to launch on the client computer device the selection guide," because, under the broadest reasonable interpretation standard, independent claim 1 need not invoke this step unless certain conditions have been satisfied (i.e., "when it is determined . . ."). *Ex parte Schulhauser*, No. 2013-007847, 2016 WL 6277792, at *4 (PTAB April 28, 2016) (precedential) (determining that the broadest reasonable interpretation of a claim encompassed situations in which conditional method steps "need not be reached").

V. DECISION

We affirm the Examiner's decision to reject independent claim 1.

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