UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte GEOFFRY A. WESTPHAL

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Appeal 2017-009964
Application 14/178,807[1]
Technology Center 2100

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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 1–10. App. Br. 1, 5–10.[2] Claims 11–15 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 18,
2017), and the Examiner's Answer ("Ans.," mailed May 19, 2017).

Appellant's Invention

Appellant purportedly invented a new process for using a selection guide to locate one or more items of interest. Spec. 2:16–18. 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 2:18–22. 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 2:22–24. If a match is found, the corresponding selection guide may be launched automatically. *Id.* at 2:24–3:1. 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 3:8–11. 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 3:5–8.

Related Appeals

The present application is a continuation of U.S. Patent Application No. 13/568,927 ("the '927 application"), which, in turn, is a continuation of U.S. Patent Application No. 11/158,039 ("the '039 application"). Spec. 1:5–8. We previously decided an appeal in the '927 application. *See Ex parte Westphal*, No. 2014-003997 (PTAB March 27, 2017) (non-precedential) (reversing the Examiner's obviousness rejection of claims 1–5 and 16–19).

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).

<div align="center">Illustrative Claim</div>

Claims 1 and 6 are independent. Each of independent claims 1 and 6 is directed to "[a] non-transitory computer readable media having stored thereon executable instructions which, when executed by a processing device, perform [certain] steps." App. Br. 11–13 (Claims Appendix). Claims 2–5 directly or indirectly depend from independent claim 1; and claims 7–10 directly or indirectly depend from independent claim 6. Independent claim 1 illustrative of the claimed subject matter and is reproduced below:

> 1. A non-transitory computer readable media having stored thereon executable instructions which, when executed by a processing device, perform steps comprising:
>
> determining if a search term included in a free form search query received from a user is used as a searchable parameter within each of a plurality of selection guides wherein each of the plurality of selection guides comprises a plurality of graphical user interface elements provided for locating items of a corresponding one of a plurality of predefined types of items within an electronic catalog of items; and
>
> *when the search term* included in the free form search query *is determined to be used as a searchable parameter within only a single one of the plurality of selection guides, causing the single one of the plurality of selection guides to be presented to the user.*

Id. at 11 (emphasis added to highlight disputed limitation).

Prior Art Relied Upon

Inventor[3]	Patent/Publication	Relevant Date(s)
Pak	U.S. Patent Application Pub. No. 2004/0260534 A1	published Dec. 23, 2004; filed June 19, 2003
Ouchi	U.S. Patent No. 7,139,769 B2	issued Nov. 21, 2006; filed Mar. 11, 2002
Hamaguchi	U.S. Patent No. 7,509,314 B2	issued Mar. 24, 2009; filed Mar. 4, 2005
Ashkenazi	U.S. Patent No. 7,805,339 B2	issued Sept. 28, 2010; filed Dec. 18, 2002

Rejections on Appeal

Claims 1–6 stand provisionally rejected on the ground of non-statutory double patenting over claims 1–3 and 5 of the '927 application. Non-Final Act. 2–5.[4]

Claims 1, 5, 6, and 10 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. *Id.* at 5–7.

Claims 1, 2, 6, and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Ashkenazi and Pak. *Id.* at 7–13.

Claims 3, 4, 8, and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Ashkenazi, Pak, and Ouchi. *Id.* at 13–16.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Ashkenazi, Pak, and Hamaguchi. *Id.* at 16–17.

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[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 September 13, 2016.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Ashkenazi, Pak, Ouchi, and Hamaguchi. *Id.* at 17–18.

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 "determining if a search term is used as a searchable parameter within a selection guide, and, when a search term is used as a searchable parameter within only a single one of the plurality of selection guides, displaying the selection guide to the user." Non-Final Act. 6. The Examiner finds that independent claim 6 is directed to "determin[ing] whether a number of items within the catalog that corresponds to the search term is less than a threshold, [and, if so,] presenting search results for each item[]. Otherwise, if the number is not less than the threshold, presenting a selection guide for the query." *Id.* According to the Examiner, the abstract idea underlying both claims is "comparing new and stored information and using rules to identify options" (Non-Final Act. 6; Ans. 2) or, stated differently, "collecting data, analyzing the data, and outputting results" (Ans. 2–3).

Turning to the second step in *Alice,* the Examiner finds that, although independent claims 1 and 6 include certain hardware elements (i.e., a non-transitory computer readable medium and processing device) that perform the steps identified above, these hardware elements "do[] not amount to significantly more than the abstract idea [itself] because the non-transitory medium [and processing device] represent[] . . . generic piece[s] of hardware designed to facilitate the execution of the claimed abstract idea." Non-Final Act. 7; *see also* Ans. 3–4 (finding the same). The Examiner also finds that

the subject matter of dependent claims 5 and 10 do not add any element—
taken individually or in combination with the elements of their underlying
base claim—that would amount to significantly more than the abstract idea
itself. Non-Final Act. 7.

2. The Examiner finds that Ashkenazi's Figures 6 and 7, and their
corresponding descriptions, along with Ashkenazi's "Skip by Popularity"
functionality, teach all of the limitations of independent claim 1, except
Ashkenazi does not disclose explicitly "an example wherein the search term
included in the free form search query is determined to be used as a
searchable parameter within only a single one of the plurality of selection
guides, causing the single one of the plurality of selection guides to be
presented to the user." Non-Final Act. 8–9 (citing Ashkenazi, 10:13–35,
10:56–11:16, Figs. 6, 7). The Examiner turns to Pak's disclosure of
determining whether natural language text matches "only" a single category
and, if so, only selecting that category, to teach this limitation. *Id.* at 9 (Pak
¶¶ 68, 69).

The Examiner then concludes that it would have been obvious to
modify Ashkenazi with these teachings in Pak because (1) both Ashkenazi
and Pak are directed to the same field of endeavor; and (2) "Pak . . . provides
an example wherein a concept in a query is limited to a single category."
Non-Final Act. 9. The Examiner also relies on Ashkenazi's "Skip by
Popularity" functionality, particularly its example of 92% of clicks, to teach
looking for the most popular category and, based on this teaching, concludes
that it would have been obvious to one of ordinary skill in the art, in "a
situation . . . wherein 100% of clicks are directed toward a single category,"
to only select that category. *Id.* at 9–10 (citing Ashkenazi, 11:3–16). The

Examiner asserts that Pak merely provides an example where a keyword is related to only one category. *Id.* at 10.

The Examiner relies upon essentially the same findings and conclusions to support the obviousness rejection of independent 6. *Compare* Non-Final Act. 8–10, *with id.* at 10–13.

Appellant's Contentions

1.   Appellant contends that the Examiner fails to present a *prima facie* case of unpatentability under § 101. App. Br. 5; Reply Br. 2. According to Appellant, the Examiner ignores certain aspects of claims 1, 5, 6, and 10 that results in an oversimplification that inaccurately states to what these claims are directed. Reply Br. 2. Appellant also argues that the Examiner fails to identify additional elements of claims 1, 5, 6, and 10, much less recognize that these elements, when treated as an ordered combination, amount to "a programmatic structure" that results in "an improvement to a website searching application." App. Br. 5–6; Reply Br. 2 (underlining and emphasis omitted). In other words, Appellant argues that, although the individual elements of claims 1, 5, 6, and 10 "may" be "well-understood, routine, and conventional," these claim elements set forth "an arrangement of known, conventional pieces in a non-conventional and non-generic manner." App. Br. 7 (emphasis and underlining omitted).

2.   Appellant contends that Ashkenazi's "Skip by Popularity" functionality identifies the most popular category for an entered search term, and then searches for that term within the identified category prior to directing the user straight to the search results. App. Br. 8–9 (citing Ashkenazi, 10:23–31, 11:4–9, Fig. 7); Reply Br. 3 (arguing the same). According to Appellant, this "Skip by Popularity" functionality does not

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teach causing a single one of the plurality of selection guides to be presented to the user when it is determined that a search term included in a free form search query is used as a searchable parameter within only a single one of the plurality of selection guides, as required by independent claims 1 and 6. App. Br. 9; Reply Br. 3. In addition, Appellant argues that Pak also fails to disclose this limitation because, similar to Ashkenazi, Pak discloses determining whether natural language text matches a single category and, if so, then providing the search results to the user. App. Br. 10 (citing Pak ¶ 71); *see also* App. Br. 10; Reply Br. 3–4 (arguing that Pak discloses the "exact same functionality" as Ashkenazi).

II. ISSUES

1. Has the Examiner erred in determining that claims 1, 5, 6, and 10 are directed to a patent-ineligible concept (e.g., an abstract idea) and, if so, whether the elements of these claims—either individually or as an ordered combination—transform them into a patent-eligible application?

2. Has the Examiner erred in determining that the combined teachings of Ashkenazi and Pak account for, "when the search term included in the free form search query is determined to be used as a searchable parameter within only a single one of the plurality of selection guides, causing the single one of the plurality of selection guides to be presented to the user," as recited in independent claim 1, and similarly recited in independent claim 6?

III. ANALYSIS

Provisional Non-Statutory Double Patenting Rejection

Because Appellant does not contest the Examiner's provisional non-statutory double patenting rejection of claims 1–6 (*see generally* App. Br. and Reply Br.), and the Examiner did not withdraw the provisional non-statutory double-patenting rejection (*see generally* Ans.), we summarily sustain this rejection without comment. *See* MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 1205.02 (9th ed., R-08.2017, Jan. 2018) ("If a ground of rejection stated by the examiner is not addressed in the appellant's brief, appellant has waived any challenge to that ground of rejection and the Board may summarily sustain it, unless the examiner subsequently withdrew the rejection in the examiner's answer."); *see also Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir. 2008) ("When the appellant fails to contest a ground of rejection to the Board, . . . the Board may treat any argument with respect to that ground of rejection as waived.").

§ 101 Rejection

Based on the record before us, we do not discern error in the Examiner's rejection of claims 1, 5, 6, and 10 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*

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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 claims 1 and 6 as being directed to the abstract idea of "collecting data, analyzing the data, and outputting results." *See* Ans. 2–3; Final Act. 6. These claims recite steps for locating one or more items of interest in an electronic catalog that, at best, include collecting data from a free form search query, analyzing the data (i.e., by determining whether a search term is a searchable parameter within a single selection guide amongst a plurality of selection guides (claims 1 and 6) and by determining whether a number of items within the electronic catalog that correspond to the search term is less than a threshold (only claim 6)), and

then displaying results of the analysis (i.e., by presenting the corresponding selection guide to the user (claims 1 and 6) and by presenting search results to the user (only claim 6)). App. Br. 10, 12–13 (Claims Appendix). We agree with the Examiner that these processes of collecting data, analyzing the data, and displaying certain results—without any particular inventive technology for performing those functions—falls within the realm of abstract ideas. *See* Ans. 2–3 (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 locating one or more items of interest in an electronic catalog by performing the following steps: (1) determining whether the free form search query includes a search term that is used as a searchable parameter within a single selection guide amongst a plurality of selection guides; and (2) if so, presenting the corresponding selection guide to the user. App. Br. 10 (Claims Appendix). Independent claim 6 recites the same steps as independent claim 1, except independent claim 6 also requires the additional step of determining whether a number of items within the electronic catalog that correspond to the search term is less than a threshold prior to presenting search results to the user. *Id.* at 12–13. These claims further recite the use of a computer (i.e., "a processing device") to carry out these aforementioned steps. *Id.* As *Alice* explains, use of a computer to communicate information (like the "processing device" and "free form search query" here), as well as "use of a computer to obtain data . . . and issue automated instructions" (like the

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"processing device" and "selection guide/search results" 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 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. 1:13–2:10. Ashkenazi serves as additional evidence that such conventional processes of searching employ a generic computer. 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 claims 1 and 6, as a whole, are simply indicative of the abstract idea of collecting data, analyzing the data, and displaying certain results that are applied using a generic computer. *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 claims 1 and 6, at most, automate previously-known manual processes of presenting a selection guide and presenting search results. *See* Spec. 2:10–14 (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]' [a] generic computer[] 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).

Each of dependent claims 5 and 10 recite "wherein the search term comprises a numeric value." App. Br. 12, 14 (Claims Appendix). We agree with the Examiner, and we find, that the limitations of these dependent claims do not add anything significantly more to the abstract idea identified above in the context of independent claims 1 and 6, and, therefore, do not supply an inventive concept. *See* Non-Final Act. 7. It follows that the Examiner has not erred in determining that claims 1, 5, 6, and 10 are directed to non-statutory subject matter under § 101.

§ 103(a) Rejection Based on the Combined Teachings of Ashkenazi and Pak

We do not discern error in the Examiner's obviousness rejection of independent claim 1, which recites, among other things, "when the search term included in the free form search query is determined to be used as a searchable parameter within only a single one of the plurality of selection guides, causing the single one of the plurality of selection guides to be presented to the user." Independent claim 6 recites a similar limitation.

As we explain above, the Examiner relies upon Ashkenazi's Figures 6 and 7, and their corresponding descriptions, along with Ashkenazi's "Skip by Popularity" functionality, to teach this disputed limitation. The Examiner also relies on Pak's disclosure of determining whether natural language text matches "only" a single category and, if so, only selecting that category, to

teach this limitation. We begin our analysis with a brief discussion of Ashkenazi's Figures 6 and 7, followed by a discussion of Pak's relevant disclosure, and then we turn to the disputed limitation identified above.

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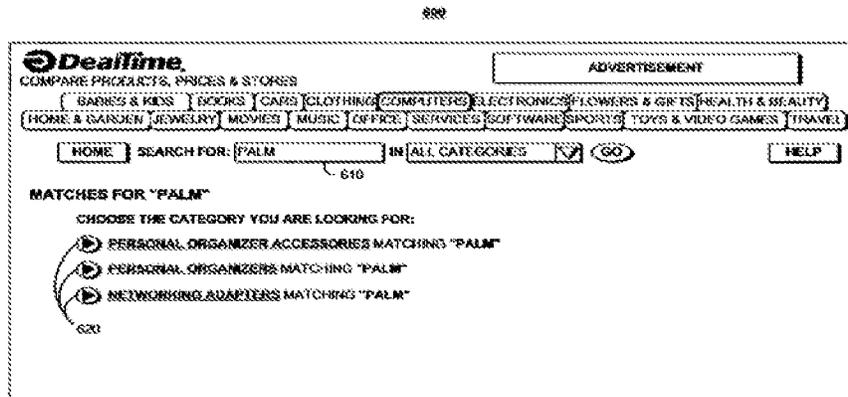
600

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610

MATCHES FOR "PALM"

CHOOSE THE CATEGORY YOU ARE LOOKING FOR:

- PERSONAL ORGANIZER ACCESSORIES MATCHING "PALM"
- PERSONAL ORGANIZERS MATCHING "PALM"
- NETWORKING ADAPTERS MATCHING "PALM"

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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.

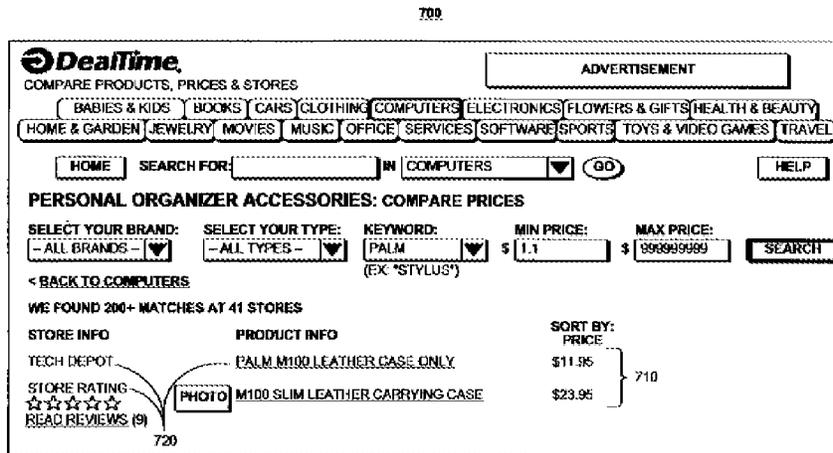Figure 7 of Ashkenazi, reproduced below, illustrates the results of this search. Ashkenazi, 10:22.

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.

Figure 4 of Pak buttresses the aforementioned disclosures in Ashkenazi by setting forth certain steps for processing natural language text extracted from a string of data processed by an application program (e.g., a search engine). Pak ¶ 68. In step 420, a statistical representation of the natural language text is determined for the purpose of matching it against categories in a knowledge base. *Id.* In step 430, the knowledge base is searched to determine one or more categories related to the underlying concept communicated in the natural language text. *Id.* In step 432, if "only" one category is identified, control proceeds to step 470 to search for materials associated with that category. *Id.* ¶ 69.

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 presenting a selection guide to the user. The results of presenting the selection guide to the user are illustrated in Ashkenazi's Figure 7 (e.g., accessories for a palm or personal digital assistant, such as a leather carrying case).

In our view, Pak's Figure 4 further refines this process by ensuring that, if a search term in natural language text "only" identifies one category, only that category is presented to the user. This process is essentially the same as determining if a search term used in a free form search query may

be used as a searchable parameter only with a single selection guide and, if so, only presenting that selection guide to the user. We, therefore, are persuaded that the Examiner has presented sufficient evidence to support a finding that the combined teachings of Ashkenazi and Pak account for, "when the search term included in the free form search query is determined to be used as a searchable parameter within only a single one of the plurality of selection guides, causing the single one of the plurality of selection guides to be presented to the user," as recited in independent claim 1, and similarly recited in independent claim 6.

We are not persuaded by Appellant's argument that Ashkenazi's "Skip by Popularity" functionality does not teach this disputed limitation because, purportedly, it identifies 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. 8–9; Reply Br. 3. Nor are we persuaded by Appellant's argument that Pak does not teach this disputed limitation because Pak discloses the exact same functionality as Ashkenazi. *See* App. Br. 10; Reply Br. 3–4.

It is well-settled that "non-obviousness [cannot be established] by attacking references individually," when, as here, the Examiner's obviousness rejection is based upon the combined teachings of Ashkenazi and Pak. *In re Keller*, 642 F.2d 413, 426 (CCPA 1981). Instead, the test is what the combined teachings of these references would have taught or suggested to one with ordinary skill in the art. *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991). Here, the Examiner does not rely upon either Ashkenazi or Pak alone to teach the disputed limitation. Rather, the Examiner turns to Ashkenazi's disclosure of determining whether certain

conditions have been satisfied prior to presenting a selection guide to the user. This disclosure in Ashkenazi, in conjunction with Pak's disclosure of determining if a search term used in a free form search query may be used as a searchable parameter only with a single selection guide and, if so, only presenting that selection guide to the user, teaches the disputed limitation. It follows that the Examiner has not erred in determining that the combined teachings of Ashkenazi and Pak render the subject matter of independent claims 1 and 6 unpatentable.[5]

Claims 2 and 7

Appellant does not address separately the patentability of dependent claims 2 and 7. We, therefore, group these dependent claims with their underlying base claim. Consequently, dependent claims 2 and 7 fall with independent claims 1 and 6, respectively. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Remaining § 103(a) Rejections

Claims 3–5 and 8–10

Appellant does not address separately the patentability of dependent claims 3–5 and 8–10. We, therefore, group these dependent claims with

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[5] If prosecution of the present application resumes, the Examiner should consider whether any asserted prior art must account for the step of, "when the search term included in the free form search query is determined to be used as a searchable parameter within only a single one of the plurality of selection guides, causing the single one of the plurality of selection guides to be presented to the user," as recited in independent claim 1, and similarly in independent claim 6. Applying the broadest reasonable interpretation standard, independent claims 1 and 6 need not invoke this step unless certain conditions have been satisfied (i.e., "when . . . [it] is determined to be . . .") . *Ex parte Schulhauser*, No. 2013-007847, 2016 WL 6277792, slip op. 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").

their underlying base claim. Consequently, dependent claims 3–5 and 8–10 fall with independent claims 1 and 6, respectively. *See* 37 C.F.R. § 41.37(c)(1)(iv).

IV. CONCLUSIONS OF LAW

For the foregoing reasons, the Examiner has not erred in (1) provisionally rejecting claims 1–6 on the ground of non-statutory double patenting; (2) rejecting claims 1, 5, 6, and 10 as directed to non-statutory subject matter under § 101; and (3) rejecting claims 1–10 as unpatentable under § 103(a).

V. DECISION

We affirm the Examiner's decision to reject claims 1–10.

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