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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN NIENSTEDT SR.

Appeal 2017-010914
Application 13/601,591
Technology Center 3600

Before IRVIN E. BRANCH, JOSEPH P. LENTIVECH, and
DAVID J. CUTITTA II, *Administrative Patent Judges*.

LENTIVECH, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–20, the only claims pending in the application on appeal. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellant, the real party in interest is Competitive Edge and Research and Communication. App. Br. 2.

STATEMENT OF THE CASE

Appellant's Invention

Appellant's invention generally relates to "assessing the effectiveness of a message in influencing a person, and more particularly to measuring the effect of a message, endorsement, biographical information or provision on a group of people and scoring the persuasive effect of a message." Spec. ¶ 1.

Claim 1, which is illustrative, reads as follows:

1. A method of assessing the effectiveness of a message, comprising:

obtaining a first opinion from a plurality of respondents on a position statement;

assigning a numerical value to each of the first opinions from the plurality of respondents;

obtaining an assessment from the plurality of respondents of at least one message related to the position statement;

assigning a numerical value to each assessment of each message from the plurality of respondents;

obtaining a second opinion from the plurality of respondents on the position statement after the plurality of respondents have assessed the at least one message; and

calculating an effectiveness score of the at least one message based on the numerical values of the assessments provided by a number of respondents in the plurality of respondents whose opinions on the position statement changed from the first opinion to the second opinion, wherein calculating the effectiveness score of the at least one message includes:

dividing the number of respondents into a first subgroup of respondents having the associated second opinions increase in agreement with the position statement and a second subgroup of respondents having the associated second opinions decrease in agreement with the position statement;

computing a first score for the at least one message produced by the first subgroup of respondents and a second score for the at least one message produced by the second subgroup of respondents;

determining if the second score is a negative score;
and

if so, subtracting the second score from the first score for the at least one message produced by the first subgroup of respondents to obtain the effectiveness score.

Rejections

Claims 1–20 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Non-Final Act. 7–9.

Claims 1–20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Non-Final Act. 9–11.

Claims 1–20 stand rejected under 35 U.S.C. § 101 because the claimed subject matter is judicially-excepted from patent eligibility under § 101. Non-Final Act. 11–15.

Claims 1–5, 10–15, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Luby et al. (US 2011/0202388 A1; published Aug. 18, 2011) (“Luby”) and Lee et al. (US 2010/0191680 A1; published July 29, 2010) (“Lee”). Non-Final Act. 15–26.

Claims 6–8 and 16–18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Luby, Lee, and Johnmar (US 2014/0032657 A1; published Jan. 30, 2014). Non-Final Act. 26–29.

Claims 9 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Luby, Lee, Johnmar, and Hopwood (US 2013/0124282 A1; published May 16, 2013). Non-Final Act. 29–30.

ANALYSIS

Rejection under 35 U.S.C. § 112, First Paragraph

The Examiner finds the Specification fails to provide adequate written support for the limitations:

dividing the number of respondents into a first subgroup of respondents having the associated second opinions increase in agreement with the position statement and a second subgroup of respondents having the associated second opinions decrease in agreement with the position statement;

computing a first score for the at least one message produced by the first subgroup of respondents and a second score for the at least one message produced by the second subgroup of respondents;

determining if the second score is a negative score; and

if so, subtracting the second score from the first score for the at least one message produced by the first subgroup of respondents to obtain the effectiveness score,

as recited in claim 1 and similarly recited in independent claims 10 and 20.

Non-Final Act. 8. The Examiner finds the Specification “does not adequately describe with sufficient clarity in such a way as to reasonably convey to one skilled in the relevant art how the present invention performs the above limitations.” *Id.* Specifically, the Examiner finds:

Paragraph [0034] discusses that *respondents whose opinion moved away from a candidate* may be used to determine the effectiveness score if the score by *respondents whose opinion moved away from a candidate* (i.e. the second score) is a negative

score, and the negative score is subtracted from the score of persons whose opinion moved toward a candidate. Does determining if the second score is a negative score mean determining if the score is numerically negative or indicates a negative sentiment? Pursuant to paragraphs [0020] and [0036] of Applicant's Specification, the effectiveness score may be the average of a rating scale that includes all positive numbers or a different scale that includes both negative and positive numbers. That is, in some circumstances, the effectiveness scores may never be a negative number and in other circumstances the effectiveness score may be either a negative or positive number. If negative means numerically negative, then subtracting the negative number, as would be required by the claim and Applicant's Specification, amounts to adding the second score, and adding the scores that are numerically negative would seem to give a false indication of the effectiveness of a message. Further, if negative means numerically negative, when the rating scale contains only positive numbers, such as those recited in dependent claims 6 and 16, the invention would never be capable of producing a negative result, and the invention would be inoperable. Additionally, if negative means negative sentiment, Applicant's Specification does define which scores are negative sentiment scores, and again, when the scores are determined using a scale that includes numerically negative scores and if negative sentiment coincides with numerically negative scores, the calculation recited in the claims would result in a false indication of the effectiveness of the message. In addition, these claims and paragraph [0034] of Applicant's Specification seem to presume that the effectiveness score of those whose opinion moved toward the candidate is positive and the score from the other group of respondents are the scores of respondents whose opinion moved away from a candidate, and accordingly, it appears the score for respondents who moved away from a candidate should then be presumed to be negative, which would make determining if the second score is negative to be superfluous.

Non-Final Act. 8–9; *see also* Ans. 10–13.

Appellant contends “the application explicitly and inherently provides

support [for] the claimed features.” App. Br. 15–16 (citing Spec. ¶¶ 26, 34–39). Appellant argues:

[C]alculating the effectiveness score is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that subtracting the second score from the first score for the at least one message produced by the first subgroup of respondents to obtain the effectiveness score can be implemented using a numerical scale. For example, a negative score is subtracted from the score produced by the movers that moved toward Candidate A when calculating the effectiveness score can be implemented with a computer program product embodied on a computer-readable medium.

App. Br. 17. Appellant further argues one of ordinary skill in the art would reasonably understand “the claim language of determining if the second score is a negative score refers to a negative response”; and “how to implement the second score so that it can be subtracted from the first score for the at least one message produced by the first subgroup of respondents to obtain the effectiveness score, such as employing an abs [absolute value] program command.” App. Br. 17.

To satisfy the written description requirement, the specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1562–63 (Fed. Cir. 1991). Specifically, the specification must describe the claimed invention in a manner understandable to a person of ordinary skill in the art and show that the inventor actually invented the claimed invention. *Id.*; *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

To have “possession,” “the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” *Ariad*, 598 F.3d at 1351. Original claims may fail to satisfy the written description requirement when the invention is claimed and described in functional language but the specification does not sufficiently identify how the invention achieves the claimed function. *Id.*

For software, this can occur when the algorithm or steps for performing the computer function are not explained at all or are not explained in sufficient detail. It is not enough that one skilled in the art could write a program to achieve the claimed function because the specification must explain how the inventor intends to achieve the claimed function to satisfy the written description requirement. *See, e.g., Vasudevan Software, Inc. v. MicroStrategy, Inc.*, 782 F.3d 671, 681–683 (Fed. Cir. 2015); MPEP § 2161.01(1).

Here, we agree with the Examiner that the Specification fails to show how to achieve the claimed functionality of determining if the second score is a negative score. Absent from the Specification is any discussion as to the particular steps, i.e., algorithm, necessary to perform the claimed function. As such, we agree with the Examiner that the Specification does not disclose an algorithm in sufficient detail to demonstrate to one of ordinary skill in the art that the inventor possessed the invention including how to perform the claimed function. Non-Final Act. 8–9; *see also* Ans. 10–13. Stated differently, the steps, procedure or algorithm used to determine if the second score is a negative score is not described in sufficient detail in the Specification to demonstrate that the inventor was in possession of that knowledge. It is not enough that a skilled artisan could write a program to

achieve the claimed function because the Specification must explain how the inventor intends to achieve the claimed function to satisfy the written description requirement. *See, e.g., Vasudevan*, 782 F.3d at 681–83; *see also* MPEP § 2161.01(1) (“For computer-implemented inventions, the determination of the sufficiency of disclosure will require an inquiry into the sufficiency of both the disclosed hardware and the disclosed software due to the interrelationship and interdependence of computer hardware and software.”). For these reasons, we are not persuaded the Examiner erred in finding Appellant’s disclosure does not reasonably convey possession of the claimed subject matter.

Accordingly, we are not persuaded the Examiner erred in rejecting claims 1–20 under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 112, Second Paragraph

The Examiner finds the limitations:

dividing the number of respondents into a first subgroup of respondents having the associated second opinions increase in agreement with the position statement and a second subgroup of respondents having the associated second opinions decrease in agreement with the position statement;

computing a first score for the at least one message produced by the first subgroup of respondents and a second score for the at least one message produced by the second subgroup of respondents;

determining if the second score is a negative score; and

if so, subtracting the second score from the first score for the at least one message produced by the first subgroup of respondents to obtain the effectiveness score,

as recited in claim 1 and similarly recited in independent claims 10 and 20,

render the claims indefinite. Non-Final Act. 9–10. In particular, the Examiner finds the meaning of “negative score” is unclear and renders the claims indefinite. *Id.*

Appellant argues “one of ordinary skill in the art would reasonably understand the negative score refers to a non-convincing message in view of the Specification” and that the “ordinary meaning of the claims terms are in order to ‘particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.’” App. Br. 18; *see also* Reply Br. 10–11.

Under 35 U.S.C. § 112, the claims must “particularly point[] out and distinctly claim[] the subject matter” regarded as the invention. 35 U.S.C. § 112, second paragraph. A lack of definiteness renders the claims invalid. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 902 (2014). Claims, viewed in light of the specification and prosecution history, must “inform those skilled in the art about the scope of the invention with reasonable certainty.” *Id.* at 910; *see Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371 (Fed. Cir. 2014) (“The claims, when read in light of the specification and the prosecution history, must provide objective boundaries for those of skill in the art.”). This standard “mandates clarity, while recognizing that absolute precision is unattainable.” *Nautilus*, 572 U.S. at 910. “[A] claim is indefinite when it contains words or phrases whose meaning is unclear.” *In re Packard*, 751 F.3d 1307, 1310, 1314–15 (Fed. Cir. 2014).

We agree with the Examiner that the meaning of “negative score” is unclear. According to Appellant, “negative score” refers to a “non-convincing message.” App. Br. 18. However, the Specification provides

that the first and second scores computed for the at least one message may be positive and/or negative values, depending on the set of numerical values used to assign a numerical value to each of the first opinions and to each assessment of each message. Spec. ¶¶ 20–23. It is unclear whether “negative score” refers to any numerical value (either positive or negative) assigned to a non-convincing message or to only negative values assigned to these messages. As such, we agree with the Examiner that the term “negative score” renders the claims indefinite.

Accordingly, we are not persuaded the Examiner erred in rejecting claims 1–20 under 35 U.S.C. § 112, second paragraph.

Rejection under 35 U.S.C. § 101

PRINCIPLES OF LAW

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g., Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (internal quotation marks and citation omitted).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement

risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and, thus, patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 176; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula

to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (internal citation omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of § 101. 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Memorandum”). Under that guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* Manual of Patent Examining Procedure (MPEP) § 2106.05(a)–(c), (e)–(h) (9th Ed., Rev. 08.2017, Jan. 2018)).

See Memorandum, 84 Fed. Reg. at 52, 54–55. Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

(3) adds a specific limitation beyond the judicial exception that are not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or

(4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See Memorandum, 84 Fed. Reg. at 56.

The Examiner finds the claims “describe the concept of measuring the effect of a message on a respondent by calculating an effectiveness score.” Non-Final Act. 12. The Examiner further finds “[t]he concept of measuring the effect of a message on a respondent by calculating an effectiveness score is both a method of organizing human activity and a mathematical relationship/formula, both of which are held by the courts to be abstract ideas.” *Id.*

Initially, Appellant argues the Examiner’s rejection is improper because the Examiner “fails to properly identify the abstract idea through analyzing and identifying the limitation or limitations that describe or set forth the abstract idea.” App. Br. 11. Appellant further argues, a proper analysis of the claims leads to a finding that the claims are not directed to an abstract idea. *Id.* According to Appellant, “the task of the examiner is to go beyond the broad categories and determine whether the claims are similar to an identified patent-ineligible concept” and “the Examiner [is] to look at examples of what the courts have found to be abstract ideas and by way of comparison determine if the claims are directed to a similar abstract idea.” App. Br. 12. Appellant argues the method recited in claim 1 “is NOT one of the examples, nor is it even abstract on its face – i.e., the way the [Examiner] characterizes the abstract idea makes clear that the claims are NOT directed to an abstract idea.” *Id.*

We find Appellant’s arguments unpersuasive. We agree with the Examiner that the claims are directed to “measuring the effect of a message on a respondent by calculating an effectiveness score.” Non-Final Act. 12. Measuring the effect of a message on a respondent by calculating an effectiveness score using rules as recited in Appellant’s independent claims 1, 10, and 20 is nothing more than “mental processes” that could be performed in the human mind or by a human using a pen and paper—a subject matter that falls within the three types of abstract ideas identified by the Memorandum. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) 1372–73 (“[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.”); *see also In re Comiskey*, 554 F.3d 967, 979 (Fed. Cir. 2009) (“[M]ental processes—or processes of human thinking—standing alone are not patentable even if they have practical application.”); *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (“Phenomena of nature, . . . *mental processes*, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.” (Emphasis added)). Additionally, mental processes remain unpatentable even when automated to reduce the burden on the user of what once could have been done with pen and paper. *CyberSource*, 654 F.3d at 1375 (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*.”).

We discern no additional element (or combination of elements) recited in Appellant’s claims 1, 10, and 20 that integrate the judicial exception into a practical application. *See Memorandum*, 84 Fed. Reg. at 54–55 (“Prong Two”). For example, Appellant’s claims 1, 10, and 20 do not

(1) improve the functioning of a computer or other technology, (2) are not applied with any particular machine (except for a generic computer), (3) do not effect a transformation of a particular article to a different state, and (4) are not applied in any meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception. *See* MPEP §§ 2106.05(a)–(c), (e)–(h). We disagree with Appellant that the claims are similar to the claims in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). App. Br. 13. Instead, generic computer components, such as, for example, first and second opinion assessment units, a message assessment unit, and an effectiveness calculation unit (claim 10), are merely used as a tool to facilitate the measuring of the effect of a message on a respondent by calculating an effectiveness score. *Enfish*, 822 F.3d at 1335–36, 1338.

For these reasons, we find claims 1–20 are directed to an abstract idea that is not integrated into a practical application.

Under current Federal Circuit precedent, an “inventive concept” under *Alice* step 2 can be established by showing, for example, that the patent claims:

- (1) provide a technical solution to a technical problem unique to the Internet, e.g., a “solution . . . necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks” (*DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014));
- (2) transform the abstract idea into “a particular, practical application of that abstract idea,” e.g., “installation of a filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each

end user” (*BASCOM Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350, 1352 (Fed. Cir. 2016)); or

- (3) “entail[] an unconventional technological solution ([e.g.,] enhancing data in a distributed fashion) to a technological problem ([e.g.,] massive record flows [that] previously required massive databases)” and “improve the performance of the system itself” (*Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1300, 1302 (Fed. Cir. 2016)).

Similarly, as recognized by the Memorandum, an “inventive concept” under *Alice* step 2 can also be evaluated based on whether an additional element or combination of elements:

- (1) adds a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field, which is indicative that an inventive concept may be present (*see* MPEP § 2106.05(d)); or
- (2) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception, which is indicative that an inventive concept may not be present.

See Memorandum, 84 Fed. Reg. at 56.

In this case, however, we find no element or combination of elements recited in Appellant’s claims 1, 10, and 20 that contains any “inventive concept” or adds anything “significantly more” to transform the abstract concept into a patent-eligible application. *Alice*, 573 U.S. at 221–22. For example, Appellant’s abstract idea of “measuring of the effect of a message on a respondent by calculating an effectiveness score” using information and rules as recited in Appellant’s independent claims 1, 10, and 20 is not rooted in computer technology; nor does it (1) provide any technical solution to a

technical problem as required by *DDR Holdings*; (2) provide any particular practical application as required by *Bascom*; or (3) entail an unconventional technological solution to a technological problem as required by *Amdocs*. Instead, Appellant’s invention simply uses generic computer components to perform the abstract idea of “measuring the effect of a message on a respondent by calculating an effectiveness score.” In fact, the only “additional elements” recited in Appellant’s claims merely implement the abstract idea on generic computing elements. *See* Spec. Fig. 2; ¶¶ 41–43. However, the use of a generic computer device does not alone transform an otherwise abstract idea into patent-eligible subject matter. As our reviewing court has observed, “after *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.” *DDR Holdings*, 773 F.3d at 1256 (citing *Alice*, 573 U.S. at 223).

Moreover, Appellant has not shown any specific limitation in claims 1, 10, and 20 beyond the judicial exception that is not “well-understood, routine, and conventional” in the field (*see* MPEP § 2106.05(d)). Appellant’s argument (App. Br. 13) that the claims recite subject matter that is novel and non-obvious over the prior art is not persuasive because a novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90–91.

Because Appellant’s claims 1–20 are directed to a patent-ineligible abstract concept, and do not recite something “significantly more” under the second prong of the *Alice* analysis, we sustain the Examiner’s rejection of these claims under 35 U.S.C. § 101.

Rejections under 35 U.S.C. § 103(a)

Appellant contends the combination of Luby and Lee fails to teach or suggest:

calculating an effectiveness score of the at least one message based on the numerical values of the assessments provided by a number of respondents in the plurality of respondents whose opinions on the position statement changed from the first opinion to the second opinion, wherein calculating the effectiveness score of the at least one message includes:

dividing the number of respondents into a first subgroup of respondents having the associated second opinions increase in agreement with the position statement and a second subgroup of respondents having the associated second opinions decrease in agreement with the position statement;

computing a first score for the at least one message produced by the first subgroup of respondents and a second score for the at least one message produced by the second subgroup of respondents;

determining if the second score is a negative score;
and

if so, subtracting the second score from the first score for the at least one message produced by the first subgroup of respondents to obtain the effectiveness score,

as recited in claim 1. App. Br. 21–22. In particular, Appellant argues “[i]n Luby, behavioral correlations are used to predict changes rather than finding respondents whose opinions on the position statement changed.” Reply Br. 12 (citing Luby ¶¶ 19, 81, 88). Appellant further argues “[n]othing in Lee teaches or suggests user’s with changing opinions of a position statement” and “nothing in Lee, alone or in combination with Luby, teaches or suggests calculating an effectiveness score of a message based on the

numerical values of assessments from subgroups of respondents with different changing opinions of the position statement.” App. Br. 22 (citing Lee ¶¶ 35, 42–43); *see also* Reply Br. 12.

The Examiner finds Luby teaches “respondents whose opinions on the position statement changed from the first opinion to the second opinion,” “respondents having the associated second opinions increase in agreement with the position statement,” and “respondents having the associated second opinions decrease in agreement with the position statement.” Ans. 16–18 (citing Luby ¶¶ 3, 4, 28, 35, 74–77, 80, 82, 85–86, 89; Fig. 4; Abstract) (emphasis omitted). The Examiner finds Lee teaches dividing the number of respondents into a first subgroup of respondents having the associated positive agreement with the position statement and a second subgroup of respondents having negative agreement with the position statement. Non-Final Act. 17 (citing Lee ¶¶ 35–36, 53).

The Examiner concludes the combination of Luby and Lee teaches or suggests the disputed limitation because:

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include in the promotion assessment survey systems of Luby the ability to calculate a metric by subtracting the sum of ratings of respondents from one subgroup of respondents from the sum of ratings from another subgroup of respondents as taught by Lee since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Further, it would have been obvious to one of ordinary skill in the art to modify Luby with the aforementioned teachings of Lee in order to effectively evaluate the overall opinions of the respondents by calculating a reliable and

objective aggregate metric reflecting opinions of disparate subgroups of respondents.

Non-Final Act. 18.

The Examiner, however, fails to explain how determining how the detail and counter detail contributes to changes in respondent attitudes and beliefs surrounding the product, as taught by Luby (§ 86) and determining a rank of specific content based on a value obtained by subtracting a sum of negative ratings from a sum of positive ratings, as taught by Lee (§ 53) teaches or suggests dividing the number of respondents into a first subgroup of respondents whose opinions (regardless of whether the opinion is positive or negative regarding the position statement) increase in agreement with the position statement and a second group of respondents whose opinions decrease in agreement with the position statement, as required by claim 1.

Accordingly, we do not sustain the Examiner's rejection under 35 U.S.C. § 103(a) of claim 1; independent claims, 10 and 20, which recite corresponding limitations; and claims 2–9 and 11–19, which depend from claims 1 and 10.

Appellant's arguments raise additional issues with respect to the Examiner's rejection of claims 1–20 under 35 U.S.C. § 103(a). *See* App. Br. 23–25. However, because we find the issue discussed above with respect to claim 1 to be dispositive as to the rejection of all the pending claims, we do not reach these additional issues.

DECISION

We affirm the Examiner's rejection of claims 1–20 under 35 U.S.C. § 112, first paragraph.

Appeal 2017-010914
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We affirm the Examiner's rejection of claims 1–20 under 35 U.S.C. § 112, second paragraph.

We affirm the Examiner's rejection of claims 1–20 under 35 U.S.C. § 101.

We reverse the Examiner's rejection of claims 1–20 under 35 U.S.C. § 103(a).

Since at least one rejection encompassing all claims on appeal is affirmed, the decision of the Examiner 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