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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEVEN W. LUNDBERG

Appeal 2017-011549
Application 14/608,520
Technology Center 2100

Before JOHN A. JEFFERY, BRUCE R. WINSOR, and
JUSTIN BUSCH, *Administrative Patent Judges*.

WINSOR, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the final rejection of claims 21–41, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b). Claims 1–20 are cancelled.

We affirm and designate our affirmance as a new ground of rejection under 37 C.F.R. § 41.50(b) (2015).

¹ The real party in interest identified by Appellant is Black Hills IP Holdings, LLC. App. Br. 2.

STATEMENT OF THE CASE

The Invention

Appellant's disclosed invention relates to "automatically tracking change in ownership status of patents listed in a database at a patent registry." Spec., Abstract. Claim 21, which is illustrative, reads as follows:

21. A computer-implemented method of automatically tracking change in ownership of a patent listed in a database, the method comprising:

receiving input identifying the patent to be tracked for changes in ownership, the input further including data associated with a plurality of selected fields relating to the patent, wherein the plurality of selected fields includes two or more of the following fields:

name change in patent holder; date or date range of assignment; date of incorporation of assignor or assignee; place of incorporation, or address, of assignor or assignee; nationality of assignor or assignee; and nature of assignment;

causing the presentation of each field in a user interface, wherein the user interface receives input;

automatically performing a search of the database on a predetermined regular basis based on the input received, wherein the search result identifies one or more intervening changes in ownership status for the patent; and

transmitting the search result for display in the user interface.

The Rejections

Claims 21–41 stand rejected for non-statutory obviousness-type double patenting over claims 1–21 of U.S. Patent No. 8,972,385. *See* Final Act. 3–17.

Claims 21–34 and 38–41 stand provisionally rejected for non-statutory obviousness-type double patenting over claims 1–18 of copending Application 14/628,941. *See* Final Act. 17–31.

Claims 21–41 stand rejected under 35 U.S.C. § 101² as being directed to non-statutory subject matter. *See* Final Act. 31–37.

The Record

Rather than repeat the arguments here, we refer to (1) the Briefs (“App. Br.” filed May 12, 2017; “Reply Br.” filed Sept. 14, 2017) and the Specification (“Spec.” filed Jan. 29, 2015) for the positions of Appellant; and (2) the Final Office Action (“Final Act.” mailed Oct. 12, 2016) and Examiner’s Answer (“Ans.” mailed July 14, 2017) for the reasoning, findings, and conclusions of the Examiner. Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

² All rejections are under the provisions of 35 U.S.C. in effect prior to the effective date of the Leahy-Smith America Invents Act of 2011.

Related Appeals

Appellant identifies one related appeal for App. No. 14/628,941 (Appeal No. 2017-011552). *See* App. Br. 3. There are, in addition, at least thirty (30) other related appeals:

<u>Appeal No.</u>	<u>Application No.</u>	<u>Decided/Status</u>
2009-005709	10/128,141	Decision mailed Mar. 23, 2010
2009-006404	10/874,486	Decision mailed Aug. 2, 2010
2011-009966	11/061,383	Decision mailed Jan. 31, 2014
2012-004166	11/061,312	Decision mailed Nov. 4, 2014
2015-000319	13/309,080	Decision mailed May 27, 2016
2015-000321	13/309,127	Decision mailed July 26, 2017
2015-003180	13/309,039	Decision mailed Sept. 23, 2016
2015-007422	13/309,146	Decision mailed June 1, 2016
2016-000912	13/309,060	Decision mailed Aug. 25, 2017
2016-001687	11/888,632	Decision mailed Jan. 19, 2017
2016-002121	13/309,200	Decision mailed Aug. 28, 2017
2016-002680	13/310,279	Decision mailed Aug. 30, 2017
2016-002792	12/605,030	Decision mailed Sept. 1, 2017
2016-006797	13/310,368	Decision mailed Aug. 30, 2017
2016-007186	13/573,803	Decision mailed July 28, 2017
2016-007415	13/464,598	Decision mailed July 31, 2017
2016-007623	13/408,877	Decision mailed Sept. 6, 2017
2016-007787	13/310,322	Decision mailed Sept. 20, 2017
2016-008030	13/253,936	Decision mailed Aug. 3, 2017
2017-000280	13/408,917	Decision mailed Sept. 12, 2017
2017-000386	11/098,761	Decision mailed Nov, 17, 2017

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2017-002337	14/010,376	Decision mailed Sept. 8, 2017
2017-003702	14/483,903	Decision mailed Sept. 25, 2017
2017-003815	14/094,542	Decision mailed Sept. 18, 2017
2017-004158	14/010,391	Decision mailed Oct. 25, 2017
2017-004159	14/010,380	Decision mailed Sept. 27, 2017
2017-004188	14/010,400	Decision mailed Nov. 3, 2017
2017-006390	13/409,189	Pending
2017-006642	13/310,452	Decision mailed Sept. 27, 2017
2017-011247	13/253,811	Decision mailed Nov. 1, 2017

DOUBLE PATENTING REJECTIONS

Our review of the record indicates that terminal disclaimers submitted January 15, 2016 and February 29, 2016 have been approved. Document Code - DISQ, Feb. 1, 2016; Document Code - DISQ , Mar. 3, 2016. Accordingly, the *approved* terminal disclaimers render these rejections moot. We do not address the non-statutory double patenting rejections further, as they are not now before us.

ISSUE

The issue presented by Appellant's arguments is whether the Examiner errs in finding claims 21–41 are directed to non-statutory subject matter under 35 U.S.C. § 101.

ANALYSIS

Patent eligibility is a question of law that is reviewable *de novo*. *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012). To be

statutorily eligible, the subject matter of an invention must be a “new and useful process, machine, manufacture, or composition of matter, or [a] new and useful improvement thereof.” 35 U.S.C. § 101. We initially note that claims 21–30 are directed to a “method,” i.e., a process, claims 31–37 are directed to a “system” implemented in “hardware,” i.e., a machine, claims 38 and 39 are directed to a “tool” implemented in “hardware,” i.e., a machine, claim 40 is directed to a “system,” which we construe in this case to be a machine, and claim 41 is directed to a “non-transitory machine-readable medium,” i.e., an article of manufacture. Thus, each of the claims is directed to one of the four statutory categories of patentable subject matter. The Supreme Court has held that there are implicit exceptions to the categories of patentable subject matter identified in § 101, including laws of nature, natural phenomena, and abstract ideas. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). In *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 71–73 (2012), the Supreme Court established an analytical framework under § 101 to distinguish patents that claim patent-ineligible laws of nature, natural phenomena, and abstract ideas—or add too little to such underlying ineligible subject matter—from those that claim patent-eligible applications of those concepts. To determine whether claims are patent eligible under § 101, we apply the Supreme Court’s two-step test as articulated in *Alice*.

Prima Facie Case

Appellant contends that the Examiner failed to make a prima facie case of ineligibility because of a failure to follow the guidance materials of the United States Patent and Trademark Office (USPTO) (specifically, *Recent Subject Matter Eligibility Decisions*, Memorandum (Nov. 2, 2016)).

See App. Br. 10 n.62; *see also* Reply Br. 2 n.2. We disagree. Even as stated in one of the USPTO’s guidance materials, “[f]ailure of Office personnel to follow the USPTO’s guidance materials is not, in itself, a proper basis for either an appeal or a petition.” *May 2016 Subject Matter Eligibility Update*, 81 Fed. Reg. 27,381, 27,382 (May 6, 2016). “Rejections will continue to be based upon the substantive law, and it is these rejections that are appealable.” *Id.*

The Examiner has a duty to give notice of a rejection with sufficient particularity to give Appellant a fair opportunity to respond to the rejection. *See* 35 U.S.C. § 132(a). Here, we find the Examiner’s rejection satisfies the initial burden of production by identifying that the claims include limitations similar to the identified abstract idea in *Intellectual Ventures I, LLC v. Erie Indemnity Co.*, 850 F.3d 1315 (Fed. Cir. 2017) (first step of the *Alice* analysis) and that the remainder of the claims do not include significantly more than the abstract idea because the generically-recited computer elements are well-understood, routine, and conventional, and therefore do not add meaningful limitations to the abstract idea (second step of the *Alice* analysis). Ans. 2–12. Accordingly, the Examiner (1) set forth the statutory basis for the rejection, namely 35 U.S.C. § 101; (2) concluded that the claims are directed to a judicial exception to § 101, namely an abstract idea, adding too little to the abstract idea to render the claims patent eligible; and (3) explained the rejection in sufficient detail to permit Appellant to respond meaningfully. *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011). Thus, we find that the Examiner set forth a prima facie case of ineligibility.

Alice Step One

According to *Alice* step one, “[w]e must first determine whether the claims at issue are *directed to* a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355 (emphasis added). “[T]he ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

The Specification discusses the problem to be solved by the invention—an inventor, business manager, or patent attorney’s need to track a competitor’s activities related to patents. Spec. ¶ 11. According to the Specification, “up-to-date information relating to change of ownership . . . occurring in [the] competitor’s patent portfolio may be particularly helpful to the inventor, business manager or patent attorney in planning strategy or making informed business decisions.” *Id.* Appellant’s invention solves the problem by proposing a user interface that serves as an automated ownership tracking tool. *Id.* ¶ 57.

Appellant relies on the arguments made for claim 21 to argue the patentability of the remaining pending claims. *See generally* App. Br. 10–15; Reply Br. 2–5. We, therefore, select independent claim 21 as the representative claim for this group, and the remaining claims 22–41 stand or fall with claim 21. 37 C.F.R. § 41.37(c)(1)(iv). Here, claim 21 requires, in essence, receiving input identifying a patent to be tracked for changes in ownership, presenting fields in a user interface that receives input, performing a search on a predetermined regular basis based on the input

received, and identifying changes in ownership status of the patent for display. Accordingly, in the context of the Specification discussed above, claim 21's "character as a whole" is directed to an automated ownership tracking tool that allows a user to track a patent's ownership changes, such as a competitor's patent.

Appellant similarly asserts the claims, when considered as a whole, are "directed toward tracking changes in ownership of a patent or patent portfolio." App. Br. 13; *see also* Reply Br. 3. Appellant argues the claims are not directed toward an abstract idea because, similar to the claims in *McRO, Inc. v. Bandai Namco Games America, Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016) and *Enfish*, 822 F.3d at 1335, tracking changes in ownership of a patent or patent portfolio "solves a specific issue arising in computer technology." App. Br. 13.

We disagree. The Court addressed improvements to computer-related technology in *Enfish*:

Software can make non-abstract improvements to computer technology just as hardware improvements can, and sometimes the improvements can be accomplished through either route. We thus see no reason to conclude that all claims directed to improvements in computer-related technology, including those directed to software, are abstract and necessarily analyzed at the second step of *Alice*, nor do we believe that *Alice* so directs. Therefore, we find it relevant to ask whether the claims are directed to an improvement to computer functionality versus being directed to an abstract idea, even at the first step of the *Alice* analysis.

Enfish, 822 F.3d at 1335. Thus, we determine whether claim 21 "focus[es] on a specific means or method that improves the relevant technology" or is

“directed to a result or effect that itself is the abstract idea and merely invoke[s] generic processes and machinery.” *McRO*, 837 F.3d at 1314.

We find claim 21 at issue here bears a substantial similarity to the analyzed claim 12 that the Federal Circuit determined was patent ineligible in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016). Under the first step of *Alice*, the Federal Circuit in *Electric Power Group* stated

[t]he claims in this case fall into a familiar class of claims “directed to” a patent-ineligible concept. The focus of the asserted claims, as illustrated by claim 12 . . . , is on collecting information, analyzing it, and displaying certain results of the collection and analysis. We need not define the outer limits of “abstract idea,” or at this stage exclude the possibility that any particular inventive means are to be found somewhere in the claims, to conclude that these claims focus on an abstract idea—and hence require stage-two analysis under §101.

Id. at 1353. Like claim 12 in *Electric Power Group*, Appellant’s claim 21 involves collecting data from disparate sources, analyzing the data, and displaying results, and they amount to no more than providing a user with information about a patent’s ownership change by obtaining, analyzing, and displaying data. As such, claim 21 is “clearly focused on the combination of those abstract-idea processes. The advance [it purports] to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions.” *Elec. Power Grp.*, 830 F.3d at 1354.

Thus, contrary to Appellant’s argument discussed above (App. Br. 13; *see also* Reply Br. 3), “the focus of the claims is not on . . . an improvement in computers as tools, but on certain independently abstract ideas that use

computers as tools.” *Elec. Power Grp.*, 830 F.3d at 1354. Accordingly, we find that claim 21 is not directed to an improvement to computer functionality, but involves nothing more than providing data, displaying data, and selecting data—activities squarely within the realm of abstract ideas. *See id.* at 1353–54 (when “the focus of the asserted claims” is “on collecting information, analyzing it, and displaying certain results of the collection and analysis,” the claims are directed to an abstract idea).

Alice Step Two

Turning to the second step of the *Alice* analysis, because we find claim 21 is directed to an abstract idea, we “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78). The Supreme Court describes the second step of this analysis as “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.” *Id.* (brackets in original) (internal quotations omitted).

Appellant contends the ordered combination of the claimed invention amounts to significantly more than any abstract idea. App. Br. 14 (citing *Bascom Global Internet Servs., Inc. v. AT&T Mobility, LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016)). In particular, Appellant argues that the claimed invention “represents an improvement over previous ways of tracking changes in ownership of a patent or patent portfolio by tracking changes to two or more fields related to ownership.” App. Br. 15. We do not find that providing two or more fields relating to ownership constitutes significantly

more than the abstract idea. “[M]erely selecting information, by content or source, for collection, analysis, and display does nothing significant to differentiate a process from ordinary mental processes, whose implicit exclusion from § 101 undergirds the information-based category of abstract ideas.” *Elec. Power Grp.*, 830 F.3d at 1355. Moreover, claim 21 does “not include any requirement for performing the claimed functions ... by use of anything but entirely conventional, generic technology. The claims therefore do not state an arguably inventive concept.” *Id.* at 1356. In short, each step does no more than require a generic computer processor to perform generic computer functions. *See* Spec. ¶ 17 (describing use of generic computers).

Thus, “the claims at issue amount to ‘nothing significantly more’ than an instruction to apply the abstract idea . . . using some unspecified, generic computer.” *Alice*, 134 S. Ct. at 2360 (citing *Mayo*, 566 U.S. at 71).

Summary

Appellant does not persuade us of error in the rejection of claim 21. Accordingly, we sustain the rejection of (1) independent claim 21; (2) independent claims 31, 38, 40, and 41, which are argued relying on the arguments made for claim 21 (*see* App. Br. 15); (3) claims 22–30, 32–37, and 39, which variously depend, directly or indirectly, from claims 21, 31, and 38, and were not separately argued with particularity (*see id.*).

Although the overall thrust of our analysis is the same as the Examiner’s reasoning, we have provided additional explanation not provided by the Examiner. Accordingly, in the interests of giving Appellant a full and fair opportunity to respond, we designate our affirmance as a new ground of rejection.

DECISION

We do not reach the provisional double patenting rejections.

The Examiner's decision to reject claims 21–41 is affirmed and the affirmance is designated as a new ground of rejection within our authority under 37 C.F.R. § 41.50(b).

Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

Section 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record.

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). *See* 37 C.F.R. §§ 41.50(f), 41.52(b).

AFFIRMED
37 C.F.R. § 41.50(b)