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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* BRUCE KELLY JACKSON, MARK LESLIE CAUNTER, and  
STEVEN GEACH

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Appeal 2017-011555  
Application 12/141,523<sup>1</sup>  
Technology Center 3600

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Before ERIC S. FRAHM, CATHERINE SHIANG, and  
CARL L. SILVERMAN, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–58, which are all the claims pending and rejected in the application. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

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<sup>1</sup> Appellants identify QUALCOMM Incorporated as the real party in interest. App. Br. 3.

## STATEMENT OF THE CASE

### *Introduction*

The present invention relates to “interactive workspaces and ubiquitous computing. More particularly, it pertains to an infrastructure for a population of disparate computing platforms to readily utilize one or more separate search services located in a distributed system whose results can generate revenue to an operator.” Spec. ¶ 2. Claim 1 is exemplary:

1. A method for facilitating a rated, distributed search at a network device, comprising:

defining, by the network device, a search rating bid process in a tuple space;

placing, by the network device, a search object in the tuple space based upon a search query from a client device received over a network, wherein the search object contains at least one search descriptor generated from the search query;

detecting, by the network device, a plurality of search result objects placed in the tuple space, wherein each search result object of the plurality of search result objects includes search results returned by a search engine of a plurality of search engines when the search engine performs a search based on the at least one search descriptor in the search object;

receiving, by the network device, at least one rating bid associated with a selected one of the plurality of search result objects from an originating entity, wherein the at least one rating bid is for preferential placement of at least one search result included in the selected one of the plurality of search result objects; and

transmitting, by the network device, the plurality of search result objects to the client device over the network with the at least one search result prominently ranked.

*Rejection<sup>2</sup>*

Claims 1–58 are rejected under 35 U.S.C. § 101 because they are directed to patent-ineligible subject matter. Final Act. 20–24.

ANALYSIS

We have reviewed the Examiner’s rejection in light of Appellants’ contentions and the evidence of record. We concur with Appellants’ contentions that the Examiner erred in this case.

Section 101 of the Patent Act provides “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 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. Pty. Ltd. 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

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<sup>2</sup> Throughout this opinion, we refer to the (1) Final Office Action mailed November 25, 2017 (“Final Act.”); (2) Appeal Brief filed April 18, 2017 (“App. Br.”); (3) Examiner’s Answer mailed July 24, 2017 (“Ans.”); and (4) Reply Brief filed September 14, 2017 (“Reply Br.”).

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, 67 (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. (15 How.) 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 187; *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 (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. USPTO’s 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”). Under the 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) (Step 2A, Prong 1); 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)) (9<sup>th</sup> ed., rev. 08.2017, 2018) (Step 2A, Prong 2).

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 is 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. (Step 2B.)

*See* Guidance, 84 Fed. Reg. at 54–56.

Turning to Step 2B of the Guidance, “[t]he second step of the *Alice* test is satisfied when the claim limitations ‘involve more than performance of []well-understood, routine, [and] conventional activities previously known to the industry.’” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1367 (Fed. Cir. 2018) (quoting *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347–48 (Fed. Cir. 2014) and *Alice*, 573 U.S. at 225). “Whether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination.” *Berkheimer*, 881 F.3d at 1369.

In this case, the Examiner makes factual findings about “routine and conventional” steps of the claims and asserts “[t]here is no requirement to provide evidence. Unlike 102 and 103, which is evidenced based, 101 is a question of law and evidence is not required.” Ans. 10–12, 15. Appellants argue “whether or not specific claim features are ‘well-understood, routine and conventional’ is a factual analysis that must be based on evidence” and “the Examiner has not provided any reasoned explanation or actual evidence to show various claim features as being well-understood, routine and conventional, but rather, has simply alleged that ‘no evidence is required.’” Reply Br. 11–12.

We agree with Appellants, because the Examiner has not provided sufficient evidence required by *Berkheimer* to support the “routine and

conventional” factual findings. *See Berkheimer*, 881 F.3d at 1369. In particular, the Memorandum of Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*) (“*Berkheimer* Memorandum”) requires the information listed below:

1. A citation to an express statement in the specification or to a statement made by an applicant during prosecution that demonstrates the well-understood, routine, conventional nature of the additional element(s). . . .
2. A citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s).
3. A citation to a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s). . . .
4. A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s). . . .

*Berkheimer* Memorandum at 3–4. But the Examiner has not provided any of the four categories of information required by the *Berkheimer* Memorandum.

Therefore, the Examiner erred with respect to Step 2B of the Guidance, and we are constrained by the record to reverse the Examiner’s rejection of independent claims 1, 14–17, 30, and 43–46, and corresponding dependent claims 2–13, 18–29, 31–42, and 47–58 on procedural grounds.

#### DECISION

We reverse the Examiner’s decision rejecting claims 1–58.

REVERSED