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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LORRAINE M. HERGER, NEAL M. KELLER,
MATTHEW A. McCARTHY, and CLIFFORD A. PICKOVER¹

Appeal 2018-000097
Application 14/831,636
Technology Center 2100

Before ROBERT E. NAPPI, KALYAN K. DESHPANDE, and
DAVID M. KOHUT *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1 through 11. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to Appellant, the real party in interest is International Business Machines Corporation. Appeal Brief 2.

INVENTION

Appellants' disclosed invention is directed to a method for determining if a listing of a service should be added to a service catalog based upon feedback received about a candidate service. *See* Abstract. Claim 1 is representative of the invention and reproduced below.

1. A method for listing services in a service catalog, the method comprising:
 - receiving first feedback about a service not published in the service catalog and not created, the first feedback about the service being used to determine a first score for the service, the first feedback includes implicit feedback;
 - determining by a computer processor whether the first score for the service not published in the service catalog exceeds a first threshold;
 - if the first score for the service exceeds the first threshold, listing the service as a published service in the service catalog;
 - receiving second feedback about the published service, the second feedback about the published service being used to determine a second score for the service;
 - determining whether the second score for the service exceeds a second threshold; and
 - if the second score for the service exceeds the second threshold, sending a signal to a service actualization unit to create the service.

REJECTIONS AT ISSUE²

The Examiner rejected claims 1 through 11 under 35 U.S.C. § 101 for being directed to patent-ineligible subject matter. Answer 2–9.

² Throughout this Decision, we refer to the Appeal Brief filed April 25, 2017, Reply Brief filed October 3, 2017, Final Office Action mailed November 25, 2016, and the Examiner's Answer mailed September 25, 2017.

The Examiner rejected claims 1 through 8 under 35 U.S.C. § 103(a) for being unpatentable over Chakrabarti (US 2012/0078747 A1; publ. Mar. 29, 2012) and Powell (US 2010/0114961 A1; publ. May 6, 2010). Final Act. 5–8.

The Examiner rejected claim 9 under 35 U.S.C. § 103(a) for being unpatentable over Chakrabarti, Powell, and Bell (US 2007/0220510 A1; publ. Sept. 20, 2007). Final Act. 8–9.

The Examiner rejected claim 10 under 35 U.S.C. § 103(a) for being unpatentable over Chakrabarti, Powell, and Hadar (US 2011/0231229 A1; publ. Sept. 22, 2011). Final Act. 9–10.

The Examiner rejected claim 11 under 35 U.S.C. § 103(a) for being unpatentable over Chakrabarti, Powell, and Hadar (US 2011/0208606 A1; publ. Aug. 25, 2011). Final Act. 10.

PRINCIPLES OF LAW

Patent-eligible subject matter is defined in 35 U.S.C. § 101 of the Patent Act, which recites:

Whoever 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.

There are, however, three judicially created exceptions to the broad categories of patent-eligible subject matter in 35 U.S.C. § 101: laws of nature, natural phenomena, and abstract ideas. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012). The Supreme Court sets forth a two-part “framework 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.

First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . [*Mayo*, 566 U.S. at 76–77]. If so, we then ask, “[w]hat else is there in the claims before us?” *Id.*, at . . . [77–78]. To answer that question, 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. *Id.*, . . . at [77–78]. We have described step two 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.*, at . . . [71–73].

Id.

Although an abstract idea itself is patent ineligible, an application of the abstract idea may be patent eligible. *Alice*, 134 S. Ct. at 2355. Thus, we must 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.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78). The claim must contain elements or a combination of elements that are “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [abstract idea] itself.” *Id.* (quoting *Mayo*, 566 U.S. at 72–73). The Federal Circuit has explained that, in determining whether claims are patent-eligible under Section 101, “the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.” *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016).

The Federal Circuit also noted in that decision that “examiners are to continue to determine if the claim recites (i.e., sets forth or describes) a concept that is similar to concepts previously found abstract by the courts.” *Id.* at 1294 n.2.

ANALYSIS

We have reviewed Appellants’ arguments in the Briefs, the Examiner’s rejections, and the Examiner’s response to Appellants’ arguments. Appellants’ arguments have not persuaded us of error in the Examiner’s conclusion that the claims are directed to patent-ineligible subject matter and that the claims are obvious over the prior art.

Rejection under 35 U.S.C. § 101

Appellants argue, on pages 4 through 6 of the Reply Brief, that the Examiner’s rejection under § 101 is in error as claim 1 is not directed to an abstract idea. Specifically, Appellants argue that representative claim 1 is not similar to claims found to be directed to abstract ideas by the court in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) or *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1367 (Fed. Cir. 2015). Further, Appellants argue, on pages 6 through 9 of the Reply Brief, that claim 1 is directed to an improvement to a technological process and recites significantly more than the abstract concept.

These arguments have not persuaded us of error in the Examiner’s rejection of claim 1 under 35 U.S.C. § 101. The Examiner has found, that claim 1 recites steps of collecting information, analyzing it and displaying

results of the collection analysis. Answer 3–4 (citing *Electric Power Group and Intellectual Ventures I*). We concur, claim 1 recites two steps of receiving feedback, which are merely collection of data, further, the claim recites the steps of determining a score based upon the feedback and comparing the score to a threshold, which are a form of data analysis. Finally the claim recites a step of sending a signal based upon the analysis. We concur, with the Examiner that these steps are similar to those held abstract by the court in *Electric Power Group*, and also note that they are similar to those held by the court to be abstract in *Content Extraction and Transmission LLC. v. Wells Fargo Bank, National Association*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (holding that the claims were “drawn to the abstract idea of 1) collecting data, 2) recognizing certain data within the collected data set, and 3) storing that recognized data in a memory”). We are not persuaded by Appellants’ argument that the claim differs from those at issue in *Electric Power Group* as Appellants’ claims are to a “new source and/or type of information: feedback about a service not published in the service catalog and not created.” Reply Br. 6. Receiving such feedback as how to improve or create a product/service is well known, e.g., the use of suggestion boxes or surveys to solicit opinions. Thus, Appellants’ arguments have not persuaded us the Examiner erred in finding the claims directed to an abstract idea.

Appellants’ arguments directed to the second part of the *Alice* test, similarly have not persuaded us of error in the Examiner’s rejection.

The Examiner finds and we agree that the claim recitation of a computer processor and actualization unit recites generic computer components. Answer 4. Further, the Examiner finds that the claim does not

recite a combination of elements, which improves the functioning of the computer or any technology. We concur. Appellants argue:

[C]laim 1 clearly recites more than just “collecting, displaying and manipulating data.” For example, claim 1 requires receiving first feedback about a service not published in the service catalog and not created and determining whether the first score for the service not published in the service catalog exceeds a first threshold by a computer processor. Claim 1 not only ties its limitation to a particular machine or apparatus, but the claim specifically recites how the computer processor is used to list services in a service catalog.

Reply Br. 8. We are not persuaded by this argument. Appellants’ Specification, at paragraphs 38 and 39, discusses how the computer implements the claimed method, in general terms and does not identify a specific machine. Further, we do not find that recitation of a service catalog comparison of a data value to a threshold represents a particular machine or apparatus. Thus, Appellants have not persuaded us the Examiner erred in rejecting claim 1 under 35 U.S.C. § 101.

With respect to claims 2 through 11, Appellants argue:

[T]he Office merely repeats the claimed limitations and concludes that the claims are “further directed toward an abstract idea.” Answer, pp. 3-5. The Office does not provide any finding of fact or rational in support of its conclusory statements.

Reply Br. 9. We disagree with Appellants, while the Examiner does repeat the claim language, the Examiner’s rejection also states why the Examiner considers the additional claim language does not draw the claim to patent eligible subject matter (e.g., regarding claim 2, which includes limitations directed to the feedback being implicit or explicit, the Examiner finds that this is directed to the nature of the feedback (data gathered) and is abstract

similar to the data gathering steps in *Electric Power Group*). Thus, we do not consider Appellants' arguments directed to claims 2 through 11 to address the Examiner's findings and conclusions. Rather, Appellants' arguments regarding claims 2 through 11 are considered to be nothing more than a general allegation of patentability and are not considered separate patentability arguments. See *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art”). Accordingly, we sustain the Examiner's rejection of claims 1 through 11 under 35 U.S.C. § 101.

Rejection under 35 U.S.C. § 103(a)

Appellants argue that the Examiner's obviousness rejection is in error as the combination would render Chakrabarti unsatisfactory for its intended purpose and change the principle of operation of Chakrabarti. App. Br. 6–7, Reply Br. 10–12. Specifically, Appellants argue:

Chakrabarti uses a published catalog to receive both explicit feedback and implicit feedback. Without the published catalog, user feedback would not be received. Since Chakrabarti discloses a recommendation system that uses explicit and implicit feedback to assess the quality of the recommendation rules, the Examiner's proposed modification of Chakrabarti would render Chakrabarti unsatisfactory for its intended purpose.

App. Br. 6–7 (emphases omitted).

We are not persuaded of error by these arguments as we do not find combining Chakrabarti with the teachings of Powell changes the intended purpose of Chakrabarti. Chakrabarti is primarily directed to receiving

feedback on recommendations to assess quality of recommendation rules. *See* Abstract. While Chakrabarti discusses the assessment of recommendations in context of a catalog, the Examiner points out that Chakrabarti is not limited to a catalog, and can include other repositories of items. Answer 9–10 (citing Chakrabarti’s discussion of using other repositories of items and systems in para. 13). Thus, we do not concur with the premise of Appellants’ argument that the receiving of feedback is so intertwined with a catalog that modifying the assessment to include feedback about recommendations of non-catalog items would render it unsatisfactory, and change the principle of operation. Thus, we are not persuaded of error in the Examiner’s rejection of obviousness rejection representative claim 1 under 35 U.S.C. § 103(a). Accordingly, we sustain the Examiner’s rejection, under 35 U.S.C. § 103(a), of claim 1 and claims 2 through 7 grouped with claim 1.

Appellants’ have not presented arguments directed to the obviousness rejections of claims 8 and 9. Further, Appellants argue that the Examiner’s obviousness rejections of claims 10 and 11 are in error for the same reason as claim 1. Answer 7, 8. Accordingly, we sustain the Examiner’s obviousness rejections of claims 8 through 11 for the same reasons as claim 1.

DECISION

We affirm the Examiner’s rejection of claims 1 through 11 under 35 U.S.C. § 101 for being directed to patent-ineligible subject matter and the Examiner’s rejections of claims 1 through 11 under 35 U.S.C. § 103(a).

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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