UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/153,376	06/03/2011	Adam GOLDBAND	17-50009-US	8880

128144   7590   05/23/2018
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ART UNIT	PAPER NUMBER
2445	

NOTIFICATION DATE	DELIVERY MODE
05/23/2018	ELECTRONIC

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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 ADAM GOLDBAND, ANDREW SHIREY,
and ADAM HIATT

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Appeal 2018-000382
Application 13/153,376[1]
Technology Center 2400

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Before JASON V. MORGAN, ERIC B. CHEN, and JON M. JURGOVAN,
Administrative Patent Judges.

CHEN, *Administrative Patent Judge.*

DECISION ON APPEAL

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This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1, 2, 4–8, 10–14, and 16–18. Claims 3, 9, and 15 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellants' invention relates to receiving connections between assets from external sources and using such connections for connecting assets from external sources in an internal graph. (Spec. ¶ 12.)

Claim 1 is exemplary:

> 1. A system for organizing asset data, the system comprising:
>
> a database storing asset data items in an ontological index defining relationships between individual asset data items, wherein the relationships are defined based on metadata associated with each asset data item, and
>
> wherein each asset data item represents an item comprising a product, a service, an article, video content, a website, user generated content, or an advertisement; and
>
> one or more processors to:
>
> analyze one or more social media platforms to identify a user review corresponding to an individual item not represented by an asset data item in the ontological index;
>
> determine, based on the user review of the individual item, one or more correlative relationships between the individual item and the asset data items in the ontological index; and
>
> generate a new asset data item representing the individual item to be integrated into the ontological index, wherein generating the new asset data item includes incorporating metadata for the new asset item based on the determined correlative relationships.

Claims 1, 2, 4–8, 10–14, and 16–18 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

RELATED APPEAL

This appeal is related to Appeal No. 2015-003770, entered July 19, 2016, in which we reversed the Examiner's decision to reject claims 1, 2, 4–8, 10–14, and 16–18 under 35 U.S.C. § 112 and 35 U.S.C. § 103(a).

ANALYSIS

We are unpersuaded by Appellants' arguments (App. Br. 4–6) that independent claims 1, 9, and 17 comply with 35 U.S.C. § 101 as statutory subject matter.

The Examiner found that "the claims are directed towards the creation of data items" which "is an idea in and of itself, and thus, the claims include an abstract idea." (Final Act. 4.) In particular, the Examiner found that "[t]hese steps are analogous to . . . 'organizing information through mathematical correlations' (Digitech Image Techs. LLC . . .)." (*Id.* at 6.) Moreover, the Examiner found that

> [t]he claim(s) do not include limitations that are "significantly more" than the abstract idea because the claims do not include an improvement to another technology or technical field, an improvement to the functioning of the computer itself, or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment.

(*Id.* at 4.) We agree with the Examiner.

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 Supreme Court has held that this "provision

contains an important implicit exception: [l]aws of nature, natural phenomena, and abstract ideas are not patentable." *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014); *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) ("Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work"). Notwithstanding that a law of nature or an abstract idea, by itself, is not patentable, the application of these concepts may be deserving of patent protection. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71–72 (2012). In *Mayo*, the Court stated that "to transform an unpatentable law of nature into a patent-eligible *application* of such a law, one must do more than simply state the law of nature while adding the words 'apply it.'" *Mayo*, 566 U.S. at 72 (internal citation omitted).

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 these 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, then 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*, 566 U.S. at 79, 78). In other words, the second step is to "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

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upon the [ineligible concept] itself.'" *Id.* (brackets in original) (quoting *Mayo*, 566 U.S. at 72–73). "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.* at 2357 (brackets in original) (quoting *Mayo*, 566 U.S. at 77–78). The prohibition against patenting an abstract idea "cannot be circumvented by attempting to limit the use of the formula to a particular technological environment or adding insignificant post-solution activity." *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (internal citation and quotation marks omitted). The Court in *Alice* noted that "'[s]imply appending conventional steps, specified at a high level of generality,' was not '*enough*' [in *Mayo*] to supply an 'inventive concept.'" *Alice*, 134 S. Ct. at 2357 (quoting *Mayo*, 566 U.S. at 82–83, 77–78, 72–73).

Step one: Are the claims at issue
directed to a patent-ineligible concept?

Claim 1 is a system claim, which includes "one or more processors to:" (i) "analyze one or more social media platforms to identify a user review corresponding to an individual item not represented by an asset data item in the ontological index" and (iii) "generate a new asset data item representing the individual item to be integrated into the ontological index, wherein generating the new asset data item includes incorporating metadata for the new asset item based on the determined correlative relationships," which incorporates by reference the limitation (ii) "determine, based on the user review of the individual item, one or more correlative relationships between the individual item and the asset data items in the ontological index."

Each of the above steps in claim 1 falls within the patent-ineligible "process that employs mathematical algorithms to manipulate existing information to generate additional information." *Digitech Image Techs., LLC v. Electronics for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014). In particular, the limitation (iii) "generate a new asset data item representing the individual item to be integrated into the ontological index, wherein generating the new asset data item includes incorporating metadata for the new asset item based on the determined correlative relationships" is a process in which a mathematical algorithm is used to generate additional information from existing information—the result of: (i) "analyze one or more social media platforms to identify a user review corresponding to an individual item not represented by an asset data item in the ontological index," as recited in claim 1.

Additionally, the step of: (iii) "generate a new asset data item representing the individual item to be integrated into the ontological index, wherein generating the new asset data item includes incorporating metadata for the new asset item based on the determined correlative relationships" falls within the patent ineligible process of creating "an index used to search and retrieve information stored in a database." *Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1327 (Fed. Cir. 2017).

Claim 7, a corresponding computer-implemented method claim, and claim 13, a non-transitory computer-readable medium claim, recite limitations similar to those discussed with respect to claim 1. Thus, claims 7 and 13 are also directed to a patent-ineligible abstract idea.

*Step two: Is there something else in the claims
that ensures that they are directed to significantly
more than a patent-ineligible concept?*

Because claims 1, 7, and 13 are directed to an abstract idea, the question to be settled next, according to *Alice*, is whether these claims recite an element, or combination of elements, that is enough to ensure that the claim is directed to significantly more than an abstract idea.

Claim 1 is a system claim, which recites "a database" and "one or more processors." Claim 9, a computer-implemented method claim, and claim 13, a non-transitory computer-readable medium claim, recite similar limitations. The claimed hardware components, including the "database" and "one or more processors" are generic, purely conventional computer elements. Thus, the claims do no more than require generic computer elements to perform generic computer functions, rather than improve computer capabilities.

Accordingly, appending a conventional "database" and "one or more processors" to an abstract idea is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2358 ("[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention").

First, Appellants argue that "claim 1 is patent-eligible because claim 1 is not directed wholly to an abstract idea." (App. Br. 4 (emphasis omitted).) In particular, Appellants argue that:

> [w]ith the "analyz[ing]" and "determin[ing]" processes as filters for the ontological index, "a new asset data item" is not simply generated, but rather "generated [to] represent[] the individual item to be integrated into the ontological index, wherein generating the new asset data item includes incorporating

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metadata for the new asset item based on the one or more correlative relationships."

(*Id.* (emphasis omitted).) Accordingly, Appellants argue, "the progression of the analysis and determining steps in generating the 'new asset data item,' as well as the added limitations of 'integrat[ing]' the new asset data item into the ontological index, at the very least place the claims outside the bounds of being wholly directed to the alleged abstract idea of 'the creation of data items.'" (*Id.* (emphases omitted).) However, contrary to Appellants' arguments, the creation of a "new asset data item," as recited in claim 1, is a patent ineligible "process that employs mathematical algorithms to manipulate existing information to generate additional information." *Digitech*, 758 F.3d at 1351. Likewise, the step of "a new asset data item . . . to be integrated into the ontological index," as recited in claim 1, falls within the patent ineligible process of "creation of an index used to search and retrieve information stored in a database." *Intellectual Ventures*, 850 F.3d at 1327.

Second, Appellants argue that "the present application has succeeded through appeal on the merits of novelty and non-obviousness, . . . no substantive prior art has been cited in the Final Office Action alleging that the pending claims lack novelty or non-obviousness" and

> the allegation that the claims "are merely instructions to implement the abstract idea on a computer and require no more than a generic computer to perform generic computer functions that are well understood, routine and conventional activities previously known to the industry," is clearly controverted by the absence of any prior art cited in the instant Office Action.

(App. Br. 5.) However, Appellants improperly conflate the requirements for eligible subject matter with the independent requirements of novelty and

non-obviousness. "The 'novelty' of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter." *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981).

Third, Appellants argue that "[m]ultiple data sources are used in a novel manner to create a new asset data item in a catalog, thereby enhancing the ontological index" and "[w]hile the claims do include creation of data items, the claims recite a specific series of technical steps the result in a data item that improves a stored asset catalog." (App. Br. 6.) However Appellants have not adequately explained why the claim "purport(s) to improve the functioning of the computer itself" or "any other technology or technical field." *Alice*, 134 S. Ct. at 2359. In particular, Appellants have not explained why cataloging of data into an ontological index, improves the function of a computer or other technology.

Fourth, Appellants argue that "[i]n *Amdocs* [(*Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016)], the Federal Circuit held that claims directed to a series of operations enhancing data in a computer database to solve an accounting problem were patent eligible" and "that *Amdocs* [, which claims 'computer code for accounting information to enhance the first network accounting record,'] provides a very strong analogy to the claims at issue." (App. Br. 6.) However, Appellants' arguments are not commensurate in scope with claim 1 because the claim does not recite a computer code for enhancing data in a computer database.

Last, Appellants argue that "[i]t is improper for the Examiner to reduce the claims to merely 'creation of data items' while ignoring the

expressly recited claim limitations and the resulting advantages of those limitations" and "[t]he record does not contain any analysis of the claimed invention as a series of steps." (App. Br. 7 (emphasis omitted).) Accordingly, Appellants argue, "[t]his type of treatment by the Examiner ignores recent clarifying precedential case law which requires that the claims be considered in their entirety, as a series of ordered steps, for the purposes of a §101 analysis." (*Id.*) However, the Examiner has identified the appropriate judicial exception as "an 'idea of itself'" and has persuasively compared the claimed concepts of independent claim 1 to a prior Federal Circuit decision, *Digitech*. (Final Act. 6.) Appellants are improperly conflating part one of the *Alice* test with part two of the *Alice* test, which includes consideration of an element or combination of elements to determine if the claim recites "additional features."

Thus, we agree with the Examiner that claims 1, 7, and 13 are directed towards non-statutory subject matter.

Accordingly, we sustain the rejection of independent claims 1, 7, and 13 under 35 U.S.C. § 101. Claims 2, 4–6, 8, 10–12, 14, and 16–18 depend from independent claims 1, 7, and 13. We sustain the rejection of claims 2, 4–6, 8, 10–12, 14, and 16–18 under 35 U.S.C. § 101 for the same reasons discussed with respect to independent claims 1, 7, and 13.

DECISION

The Examiner's decision rejecting claims 1, 2, 4–8, 10–14, and 16–18 is affirmed.

No time period for taking any subsequent action in connection with

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this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED