UNITED STATES PATENT AND TRADEMARK OFFICE

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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 MARTIN B. SCHOLZ, SHYAM SUNDAR RAJARAM,
GEORGE FORMAN, RAJAN LUKOSE, and HENRI J. SUERMONDT
_____

Appeal 2018-000772
Application 12/533,763
Technology Center 2100
_____

Before JEFFREY S. SMITH, TERRENCE W. McMILLIN, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the

Examiner's decision to reject claims 1–20, which are all the claims pending

in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.[2]

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[1] We use the word "Appellant" to refer to "applicant" as defined in
37 C.F.R. § 1.42. Appellant identifies the real party in interest as Hewlett-
Packard Development Company, LP. Appeal Br. 3. On January 24, 2018, a
statement under 37 C.F.R. § 3.73(b) was filed showing an assignment to
ENTIT Software LLC.
[2] Our Decision refers to Appellant's Appeal Brief filed June 1, 2017
("Appeal Br."); Appellant's Reply Brief filed October 31, 2017 ("Reply

CLAIMED SUBJECT MATTER

Claims 1, 8, and 16 are independent claims. Claim 1 is reproduced below.

> 1. A method of receiving Website content, comprising:
> generating a user profile comprising a cluster type obtained from a list of cluster types, wherein the list of cluster types is generated by processing, via a clustering algorithm, a word-Website matrix generated from a database of search queries performed by a plurality of users;
> wherein the cluster type is added to the user profile in response to Web activity associated with the user profile;
> wherein each cluster type in the list of cluster types corresponds with a unique cluster generated by the clustering algorithm and includes a grouping of Websites and grouping of words that pertain to the Websites; and
> providing the cluster type included in the user profile to a selected Website, wherein the cluster type provided to the Website is used by the Website, at least in part to personalize content to the user profile.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Pashupathy et al.	US 6,574,660 B1	June 3, 2003
Turpin et al.	US 2008/0189169 A1	Aug. 7, 2008
Zamir et al	US 7,693,827 B2	Apr. 6, 2010

REJECTIONS

Claims 1–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Turpin, Zamir, and Pashupathy. Final Act. 2–19.

Br."); Examiner's Answer mailed September 1, 2017 ("Ans."); and Final Office Action mailed January 5, 2017 ("Final Act.").

Claims 1–20 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter. Ans. 3–5.

ANALYSIS

Rejection under 35 U.S.C. § 103(a)

Appellant argues the Examiner erred in finding the combination of Zamir and Turpin teaches the limitation of claim 1 reciting that "the list of cluster types is generated by processing, via a clustering algorithm, a word-Website matrix generated from a database of search queries performed by a plurality of users." Appeal Br. 8–11; Reply Br. 7–10. In particular, Appellant argues that, in Turpin, "the keyword/webpage matrix is generated by its web crawling application crawling web pages on the Internet, not by considering a database of search queries performed by a plurality of users." Appeal Br. 8. The Examiner, however, relies on Zamir to teach "a database of search queries performed by a plurality of users," as recited in claim 1. Final Act. 3–4 (citing Zamir, col. 2, ll. 56–65, col. 20, ll. 46–47). Zamir discloses that "a search engine utilizes user profiles to customize search results," that "[a] user profile comprises multiple items that characterize a user's interests or preferences," and that "[t]hese items are extracted from various information sources, including previous search queries submitted by the user." Zamir, col. 2, ll. 56–65. Zamir also discloses that "[t]he user's profile is obtained (1104) from a database or repository of user profiles." Zamir, col. 20, ll. 46–47. Thus, Zamir teaches retrieving user profiles from a database and using the user profiles, which include previous search queries by the users, to customize search results. Zamir's database contains search

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queries, and, therefore, we disagree with Appellant's assertion that Zamir's database does not teach "a database of search queries." *See* Reply Br. 10.[3]

Appellant also argues that Zamir does not "disclose[] or render[] obvious a word-Website matrix generated from a database of search queries performed by a plurality of users." Appeal Br. 9. The Examiner, however, relies on Turpin in combination with Zamir to teach this subject matter. Final Act. 3–4; *see In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citation omitted) ("Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.").

Appellant argues that "no plausible reason has been set forth to explain why one of ordinary skill in the art would have derived the claimed invention, absent impermissible hindsight gleamed solely from the present application" (Appeal Br. 10), but Appellant fails to address the Examiner's stated rationale for combining the teachings of Turpin and Zamir. In particular, the Examiner concludes that "it would have been obvious to one of the ordinary skill in the art, at the time of the invention, to combine the applied references and include 'a database of search queries performed by a plurality of users' in *Turpin* because doing so would provide 'a list of sources of user information that are beneficial for user profile construction.'" Final Act. 3–4 (quoting Zamir, col. 4, ll. 45–46). Zamir discloses that "a search engine user's past search activities provide useful hints about the user's personal search preferences" and "provides a list of sources of user

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[3] Although Appellant refers to column 20 of Turpin, we understand Appellant's argument to be directed to column 20 of Zamir, on which the Examiner relied.

information that are beneficial for user profile construction." Zamir, col. 4,
ll. 43–46. Thus, the Examiner's articulated reasoning for the combination
finds support in the disclosure of the prior art, namely Zamir's teaching of
the benefit of considering the past search activities of users.

Based on the foregoing, we are not persuaded the Examiner erred in
finding the combination of Zamir and Turpin teaches the limitation of
claim 1 reciting that "the list of cluster types is generated by processing, via
a clustering algorithm, a word-Website matrix generated from a database of
search queries performed by a plurality of users." We also are not persuaded
of error in the Examiner's articulated reasoning in support of the
combination of Zamir and Turpin. Thus, we sustain the Examiner's
obviousness rejection of claim 1. Appellant does not present additional
persuasive arguments as to the Examiner's obviousness rejection for
claims 2–20. *See* Appeal Br. 11–13. Therefore, we sustain the Examiner's
obviousness rejection of claims 1–20.

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
the following implicit exceptions: laws of nature, natural phenomena, and
abstract ideas. *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014).

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)). The first step determines what concept the claim is "directed to." *See id.* at 219. The second step "examine[s] 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." *Id.* at 221 (citation omitted). That "search for an 'inventive concept'" examines "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 217–18 (alterations in original) (quoting *Mayo*, 566 U.S. at 77).

The PTO has published revised guidance on the application of § 101, which describes considerations in determining whether recited elements amount to "significantly more" than the abstract idea itself. *See* 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (USPTO Jan. 7, 2019) ("Eligibility Guidance"). In its Step 2B, the Eligibility Guidance explains that the second step of the *Alice* and *Mayo* framework considers whether an additional element or combination of elements recited in the claim "[a]dds 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" or "simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception." *Id.* at 56.

Our reviewing court has explained that "whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact." *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018) (citing *Microsoft Corp. v. i4i Ltd.*

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P'ship, 564 U.S. 91, 95 (2011)). The PTO released guidance addressing the requirements of *Berkheimer* in its April 19, 2018 Memorandum of Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*) ("Berkheimer Memorandum"). The Berkheimer Memorandum requires the Examiner to support a finding that claim elements are well-understood, routine, and conventional by providing any of the four categories of information:

> 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.

Discussion

The Examiner's § 101 rejection focuses on claim 1 as representative of the independent claims (Ans. 3–5), and Appellant argues the § 101 rejection by focusing on claim 1 (Reply Br. 2–7). We select independent claim 1 as representative of Appellant's arguments for the § 101 rejection of independent claims 1, 8, and 16. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner determines the claims are not patent eligible because they are directed to a judicial exception without reciting significantly more.

Ans. 3. Addressing the second step of the *Alice* patent-eligibility inquiry, which corresponds to Step 2B of the Eligibility Guidance, the Examiner finds as follows:

> [R]epresentative claim 1 does not amount to significantly more than "Collecting information, analyzing it, and displaying certain results of the collection and analysis (*Electric Power Group*)" and "Customizing information and presenting it to users based on particular characteristics (*Int. Ventures v. Cap One Bank*)" because clustering algorithm and word-Website are generic computing elements for analyzing data; the features do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claim amounts to significantly more than the abstract idea itself.

Ans. 5.

Appellant argues that "the Examiner's Answer summarily concludes that the 'clustering algorithm' and 'word-Website' are generic computing elements for analyzing data" but "fails to introduce any evidence or reasoning, to support such a conclusion." Reply Br. 6.

We are persuaded that the Examiner has not established that the recited "clustering algorithm" and "word-Website matrix" "do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claim amounts to significantly more than the abstract idea itself." *See* Ans. 5. In particular, the Examiner finds that these "are generic computing elements for analyzing data" (Ans. 5), but the Examiner does not establish that these are well-understood, routine, and conventional as required by the Berkheimer Memorandum, discussed above. The record clearly establishes that this subject matter was known in the prior art because Turpin discloses "a clustering algorithm [that] is applied to the keyword/webpage matrix to compute keyword clusters."

Turpin ¶ 82; *see also* Appeal Br. 8 (quoting this disclosure of Turpin). As the Federal Circuit has explained, however, "[w]hether a particular technology is well-understood, routine, and conventional goes beyond what was simply known in the prior art. The mere fact that something is disclosed in a piece of prior art, for example, does not mean it was well-understood, routine, and conventional." *Berkheimer*, 881 F.3d at 1369. Thus, the Examiner's obviousness rejection and our affirmance of that rejection are not by themselves sufficient to sustain the § 101 rejection on this record.

Therefore, we are constrained by the record to reverse the Examiner's § 101 rejection of claim 1, as well as the § 101 rejection of independent claims 8 and 16, which also recite "clustering algorithm" and "word-Website matrix," and the § 101 rejection of dependent claims 2–7, 9–15, and 17–20.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1–20	103(a)	Turpin, Zamir, Pashupathy	1–20	
1–20	101	Eligibility		1–20
Overall Outcome			1–20	

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED