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11/753,128	05/24/2007	Avadis Tevanian JR.	TEV 2007-1	5034
23694	7590	12/30/2019	EXAMINER	
Law Office of J. Nicholas Gross, Prof. Corp. PO BOX 9489 BERKELEY, CA 94709			STERRETT, JONATHAN G	
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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* AVADIS TEVANIAN JR. and MARK STEVANS

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Appeal 2018-001188  
Application 11/753,128  
Technology Center 3600

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Before ANTON W. FETTING, BIBHU R. MOHANTY, and JAMES A. WORTH, *Administrative Patent Judges*.

WORTH, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant<sup>1,2</sup> filed a Request for Rehearing (hereinafter “Request”) dated September 17, 2019, seeking reconsideration of our Decision, mailed September 16, 2019 (“Decision”), in which we affirmed the rejection of claims 33–56 under 35 U.S.C. § 101.

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<sup>1</sup> 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 for this appeal is “the John Nicholas and Kristin Gross Trust U/A/D April 13, 2010.” Appeal Br. 2.

<sup>2</sup> Our Decision refers to the Examiner’s Final Office Action (“Final Act.,” mailed Jan. 20, 2017) and Answer (“Ans.,” mailed Sept. 14, 2017).

## ANALYSIS

Appellant's Request is limited to one issue, i.e., Appellant asks the Board to designate its decision as a new ground of rejection. *See* Request 2. We grant the Request.

An appellant may include such a request in a request for rehearing before the Board:

(c) Review of undesignated new ground of rejection. Any request to seek review of a panel's failure to designate a new ground of rejection in its decision must be raised by filing a request for rehearing as set forth in §41.52. Failure of appellant to timely file such a request for rehearing will constitute a waiver of any arguments that a decision contains an undesignated new ground of rejection.

37 C.F.R. § 41.50(c).

In its Request, Appellant asserts that the Board's formulation of the abstract idea was different than the Examiner's formulation of the abstract idea. Request 2. In particular, Appellant states that "[t]he examiner describes the abstract idea as a method of consensus forecasting and also of predicting asset performance using votes [as embodied in the steps of] 'specifying, receiving and generating' as claimed." *Id.* at 1 (quoting Ans. 6). We agree with this characterization of the Answer. *See* Ans. 6. In addition, we note that the Examiner stated in the Final Action that the abstract idea was "predicting asset performance using votes" and that this was an "idea of itself." Final Act. 9.

Appellant states that the Board describes the abstract idea as "predicting an asset price by taking into account multiple predictions, and stating the confidence one has in the prediction," and that this was a "fundamental economic practice, which is one of certain methods of

organizing human activity.” Request 2 (citing Decision 10). This was indeed what the Board determined. Decision 10. The Decision relied on the category of a fundamental economic principle, whereas the Examiner relied on the concept of an “idea of itself.” *Compare* Decision 10, *with* Final Act. 9. The Board also characterized the abstract idea in a different formulation of the abstract idea and added additional analysis of the claims under § 101, which we do not reproduce at this time. *See* Decision 3–17.

Appellant argues that the Board’s formulation was never briefed inasmuch as it was not based on the Examiner’s formulation and included new language. Request 2. On the facts of this case, we determine that it is reasonable to designate the Decision as containing a new ground of rejection. Accordingly, we grant the request.

#### DECISION

In view of the foregoing, the panel has granted Appellants’ Request.

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Granted</b>	<b>Denied</b>
33–56	101	Eligibility	33–56	

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>	<b>New Ground</b>
33–56	101	Eligibility	33–56		33–56

#### TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of

rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground 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 prosecution 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. . . .

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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).

GRANTED; 37 C.F.R. § 41.50(b)