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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM R. ODEN, MATTHEW D. GALLOWAY,
MONICA A. MURRAY, DANIEL NELSON, and
JOSEPH BAUMGARTNER¹

Appeal 2018-001828
Application 11/517,336
Technology Center 3600

Before JENNIFER S. BISK, LARRY J. HUME, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 59–66, which are all claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify the real party in interest as Thomson Reuters Global Resources Unlimited Company. Appeal Br. 2.

BACKGROUND²

Appellants' disclosed embodiments and claimed invention relate to subscribing to "a web-based application in which a server monitors websites or publisher's services, to scan and compile predetermined information or items for downloading to a client, for potential monitoring and tracking internally by the client." Spec. ¶ 2. Claim 59, reproduced below, is illustrative of the subject matter on appeal:

59. A subscription method performed over a computerized network, comprising the steps of:

receiving, at a publisher's content server, automatic uploads of content from a plurality of third party organizations, wherein the content comprises a plurality of individual data records including law related to an industry of one or more subscribers and regulations related to an industry of the one or more subscribers;

storing the content in a database;

organizing, by a program, the database into one or more channels, wherein the one or more channels are constructed based on a set of channel rules that group a subset of the individual data records into a channel based at least on the individual data records' relation to a defined industry, and wherein the set of channel rules group one or more of the individual data records into more than one channel of the one or more channels based on the individual data records' relation to more than one defined industry;

receiving user subscription preferences of a user, wherein the user subscription preferences identify one or more

² Throughout this Decision we have considered the Specification filed September 8, 2006 ("Spec."), the Final Office Action mailed April 25, 2017 ("Final Act."), the Appeal Brief filed September 5, 2017 ("Appeal Br."), the Examiner's Answer mailed October 12, 2017 ("Ans."), and the Reply Brief filed December 12, 2017 ("Reply Br.")

channels to which the user subscribes and identify user selected filters;

generating a graphical user interface (GUI) for the user and including within the GUI access to the one or more channels to which the user has subscribed, the GUI at least provides:

- (a) listing at least a portion of the individual data records according to a set of subscription rules that limit the listing to individual data records that are organized into the one or more channels that the user subscription preferences identify as being a channel to which the user subscribes,
- (b) reducing the amount of individual data records in the listing by omitting one or more individual data records from the listing according to a set of filtering rules based on the user selected filters of the user subscription preferences, and
- (c) accepting input from the user identifying a disposition of at least some of the listed individual data records, wherein identifying the disposition comprises:
 - (1) receiving a first input from the user identifying a first individual data record of the listed individual data records as being of interest,
 - (2) receiving a second input from the user identifying a second individual data record of the listed individual data records as being not of interest, and
 - (3) receiving a third input from the user identifying a third individual data record of the listed individual data records as being resolved;

transferring each individual data record dispositioned by the user as being of interest to an issue tracking and monitoring software application operatively connected to the GUI; and changing the GUI at least in response to the disposition of individual data records.

Appeal Br. 13–14 (Claims App’x).

REJECTION

Claims 59–66 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 4–8.

ANALYSIS

We review the appealed rejections for error based upon the issues identified by Appellants, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). To the extent Appellants have not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. 37 C.F.R. § 41.37(c)(1)(iv).

We have considered all of Appellants’ arguments and any evidence presented. We highlight and address specific findings and arguments for emphasis in our analysis below.

Rejection of Claims 59–66 under 35 U.S.C. § 101

Section 101 of the Patent Act provides that “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” is patent eligible. 35 U.S.C. § 101. But the Supreme Court has long recognized an implicit exception to this section: “. . . Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). To determine whether a claim falls within one of these excluded categories, the Court has set out a two-part framework. The framework requires us first to consider whether the claim is “directed to one of those patent-ineligible concepts.” *Alice*, 573 U.S. at 217. If so, we then

examine “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.” *Alice*, 573 U.S. at 217 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78, 79 (2012)). That is, we examine the claims for an “inventive concept,” “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.’” *Alice*, 573 U.S. at 217–18 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

The Patent Office recently issued guidance regarding this framework. *See* USPTO, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Revised Guidance”). Under the Revised Guidance, to decide whether a claim is “directed to” an abstract idea, we evaluate whether the claim (1) recites subject matter falling within an abstract idea grouping listed in the Revised Guidance and (2) fails to integrate the recited abstract idea into a practical application. *See* Revised Guidance, 84 Fed. Reg. at 51. If the claim is “directed to” an abstract idea, as noted above, we then determine whether the claim recites an inventive concept. The Revised Guidance explains that when making this determination, we should consider whether the additional claim elements add “a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field” or “simply append[] well-understood, routine, conventional activities previously known to the industry.” Revised Guidance, 84 Fed. Reg. at 56.

Appellants argue claims 59–66 together as a group. *See* Appeal Br. 3–12; Reply Br. 1–4. Therefore, consistent with the provisions of 37 C.F.R.

§ 41.37(c)(1)(iv), we limit our discussion to independent claim 59.
Dependent claims 60–66 stand or fall with independent claim 59.

With these principles in mind, we turn to the Examiner’s § 101 rejection.

The Judicial Exception—Abstract Idea

The Examiner determined the claims are directed to “monitoring publisher content to compile information or items for downloading to a client,” which comprises an abstract idea—an idea of itself, organizing human activity, and advertising and sales activities. Final Act. 6. For the reasons explained below, we agree that the claims recite an abstract idea.

Claim 59 recites, in pertinent part, a method comprising the following steps (with language contributing to the abstract idea emphasized):

[(1)] *receiving, at a publisher’s content server, automatic uploads of content from a plurality of third party organizations, wherein the content comprises a plurality of individual data records including law related to an industry of one or more subscribers and regulations related to an industry of the one or more subscribers;*

[(2)] *storing the content in a database;*

[(3)] *organizing, by a program, the database into one or more channels, wherein the one or more channels are constructed based on a set of channel rules that group a subset of the individual data records into a channel based at least on the individual data records’ relation to a defined industry, and wherein the set of channel rules group one or more of the individual data records into more than one channel of the one*

or more channels based on the individual data records' relation to more than one defined industry;

[(4)] receiving user subscription preferences of a user, wherein the user subscription preferences identify one or more channels to which the user subscribes and identify user selected filters;

[(5)] generating a graphical user interface (GUI) for the user and including within the GUI access to the one or more channels to which the user has subscribed, the GUI at least provides:

(a) listing at least a portion of the individual data records according to a set of subscription rules that limit the listing to individual data records that are organized into the one or more channels that the user subscription preferences identify as being a channel to which the user subscribes,

(b) reducing the amount of individual data records in the listing by omitting one or more individual data records from the listing according to a set of filtering rules based on the user selected filters of the user subscription preferences, and

(c) accepting input from the user identifying a disposition of at least some of the listed individual data records, wherein identifying the disposition comprises:

(1) receiving a first input from the user identifying a first individual data record of the listed individual data records as being of interest,

(2) receiving a second input from the user identifying a second individual data record of the listed individual data records as being not of interest, and

(3) receiving a third input from the user identifying a third individual data record of the listed individual data records as being resolved;

[(6)] transferring each individual data record dispositioned by the user as being of interest to an issue tracking and monitoring software application operatively connected to the GUI; and

[(7)] changing the GUI at least in response to the disposition of individual data records.

Appeal Br. 13–14 (Claims App’x) (bracketed limitation numbering added).

Limitations (1)–(4), (5)(a)–(c), and (6) of claim 1, quoted and emphasized above, under their broadest reasonable interpretation, recite gathering, storing, organizing, and transferring data. In particular, limitations (1), (4), and 5(c) recite receiving data from third party organizations (limitation (1)) and users (limitations (4) and 5(c)). Limitation (2) recites storing the gathered data, and limitations (3), 5(a), and 5(b) recite organizing the stored data by industry (limitation (3)) and based on filtering input from the user (limitations 5(a) and 5(b)).

These limitations, under their broadest reasonable interpretation, cover steps that, but for the recitation of the “content server” and “program”/“software application operatively connected to the GUI,” could be performed in the mind or with pencil and paper. Similar claims have been found ineligible by the Federal Circuit. For example, the Federal Circuit continues to “‘treat[] analyzing information by steps people go through in their minds, . . . without more, as essentially mental processes within the abstract-idea category.’” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146–47 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016)).

When claimed in a manner similar to the claims here, gathering and analyzing information using conventional techniques has been determined to be an abstract idea. *In re TLI Comme’ns LLC Patent Litig.*, 823 F.3d 607, 612–13 (Fed. Cir. 2016). Also, more recently, our reviewing court has also concluded that some acts of collecting, analyzing, manipulating, and displaying data are patent ineligible. *Univ. of Fl. Research Found., Inc. v. General Electric Co.*, 916 F.3d 1363, 1367 (Fed. Cir. 2019) (citing

Intellectual Ventures I LLC v. Capital One Fin. Corp., 850 F.3d 1332, 1340 (Fed. Cir. 2017); *Elec. Power*, 830 F.3d at 1353–54).

Accordingly, we conclude the claims recite concepts performed in the human mind (including an observation, evaluation, judgement opinion) which is a mental process identified in the Revised Guidance, and thus an abstract idea.³ Revised Guidance, 84 Fed. Reg. at 52, 53 (listing “[m]ental processes—concepts performed in the human mind (including an observation, evaluation, judgment, opinion)”).

Integration of the Judicial Exception into a Practical Application

If a claim recites a judicial exception, we determine whether the recited judicial exception is integrated into a practical application of that exception by: (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application. If the recited judicial exception is integrated into a practical application, the claim is not directed to the judicial exception.

³ Our reviewing court recognizes that “[a]n abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). That need not and, in this case does not, “impact the patentability analysis.” *Id.* at 1241. “The Board’s slight revision of its abstract idea analysis does not impact the patentability analysis.” *Id.* Moreover, merely combining several abstract ideas does not render the combination any less abstract. *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“Adding one abstract idea (math) to another abstract idea . . . does not render the claim non-abstract.”); *see also FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (determining the pending claims were directed to a combination of abstract ideas).

Here, claim 59 recites the additional elements of “database,” “content server,” “program”/“software application operatively connected to the GUI,” “generating a graphical user interface (GUI) for the user and including within the GUI access to the one or more channels to which the user has subscribed,” and “changing the GUI at least in response to the disposition of individual data records.” Appeal Br. 13–14 (Claims App’x). Considering claim 59 as a whole, the additional elements do not apply or use the abstract idea in a meaningful way such that the claim as a whole is more than a drafting effort designed to monopolize the exception. The Supreme Court guides that the “prohibition against patenting abstract ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or [by] adding ‘insignificant postsolution activity.’” *Bilski*, 561 U.S. at 610–11 (quoting *Diamond v. Diehr*, 450 U.S. 175, 191–92 (1981)).

The Specification describes each of these elements as generic components. For example, the Specification states that the content server, server 120, may include a processor 121, which “may be a general data processing unit,” and other generic components. Spec. ¶¶ 66–69. The recited “database can be a computer searchable database and may be a relational database.” *Id.* ¶ 63. And the Specification explains that “processing operations may be realized by dedicated hardware, or may be realized as programs including code instructions executed on data processing units.” *Id.* ¶ 76. Finally, the Specification states:

the graphics user interface (GUI) is a client application written to run on existing computer operating systems which may be ported to other personal computer (PC) software, personal digital assistants (PDAs), and cell phones, and any other digital

device that has a screen or visual component and appropriate storage capability.

Id. ¶ 57.

Appellants’ arguments have not persuaded us claim 1 is “directed to” a patent-eligible concept. For example, Appellants argue “the terminology recited in the claims are in line with examples provided by the Federal Circuit Court as being patent eligible subject matter in the field of computer technology.” Appeal Br. 4 (citing *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299 (Fed. Cir. 2016)). According to Appellants, “the claimed [channel] rules result in a technological improvement over existing, manual techniques” by saving on time and labor and resulting inaccuracies in data. *Id.* at 4–9 (citing Spec. ¶¶ 3–4); Reply Br. 3.

We do not agree with Appellants’ analogy to *McRO*. Here, the recited channels are described as “contain[ing] a specific kind of data that the program 125 has packaged together — similar to a radio station that offers jazz, or rock, or classical music.” Spec. ¶ 80. Outside the claims, however, the Specification does not use the word “rules.”⁴ From the claims, we know that “channels are constructed based on a set of channel rules that group a subset of the individual data records into a channel based at least on the individual data records’ relation to a defined industry.” Appeal Br. 13 (Claims App’x). However, unlike *McRO* where the claimed process uses

⁴ We have not considered, and do not decide, whether Appellants’ Specification satisfies the written description and enablement requirements of 35 U.S.C. § 112(a). The Examiner may wish to consider these issues in further prosecution. Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. See MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 1213.02 (9th ed., Rev. 08.2017 (Jan. 2018)).

particular information and techniques to improve manual three-dimensional animation techniques, we see nothing in the Specification that describes the details of channel rules—which simply group information into categories—or how they are implemented. *McRO*, 837 F.3d at 1316.

Moreover, the “technological improvements” referred to by Appellants are not tied to channel rules, but instead are attributed to “a comprehensive, automated, and accurate way to locate items or issues that are of importance to a company.” In fact, as pointed out by the Examiner (Final Act. 2; Ans. 7), these improvements are the typical improvements expected by automating a manual process using a computer. There is no indication that any increase in efficiency or accuracy comes from the recited process itself. *See FairWarning*, 839 F.3d at 1095 (citing *Bancorp Services, LLC v. Sun Life Assurance Co.*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (“[T]he fact that the required calculations could be performed more efficiently via a computer does not materially alter the patent eligibility of the claimed subject matter.”)); *see also Intellectual Ventures I LLC v. Erie Indemnity Co.*, 711 F. App’x 1012, 1017 (Fed. Cir. 2017) (unpublished) (“Though the claims purport to accelerate the process of finding errant files and to reduce error, we have held that speed and accuracy increases stemming from the ordinary capabilities of a general-purpose computer ‘do[] not materially alter the patent eligibility of the claimed subject matter.’” (alteration in original) (citation omitted)).

Appellants similarly point to the recited “subscription rules” and “filtering rules,” as having “specific characteristics.” Appeal Br. 9. These rules, however, like the “channel rules,” are only referred to in the claims. “[S]ubscription rules” are said to “limit the listing to individual data records

that are organized into the one or more channels that the user subscription preferences identify as being a channel to which the user subscribes” and “filtering rules” are “based on the user selected filters of the user subscription preferences” and are used to “reduc[e] the amount of individual data records in the listing.” Appeal Br. 13 (Claims App’x). Unlike *McRO*, the Specification does not describe the details of these rules or how they are implemented and does not tie the rules to any particular technological improvement. *See McRO*, 837 F.3d at 1316.

Appellants also point to the recited customized GUI as providing a “significant technological improvement to the organization, accuracy, speed, adaptability, and communication of the manual version of this process.” Appeal Br. 10. However the Specification does not describe the implementation details of the GUI with any particular detail and, as such, presumes that user interfaces that provide the recited functions are already available. *See Spec.* ¶¶ 53, 57, 61 (the only paragraphs of the Specification referring to user interface). Moreover, the Federal Circuit has held that claims that recite a graphical user interface may not encompass eligible subject matter if they “are focused on providing information . . . in a way that helps [users] process information more quickly . . ., not on improving computers or technology.” *Trading Techs. Int’l, Inc. v. IBG LLC*, Case No. 2017-2323, 2019 WL 1907236, *4 (Fed. Cir. April 30, 2019)

Finally, Appellants argue “claim 59 is novel and nonobvious, when the claim is considered as a whole and as an ordered combination of elements, the claim is not a longstanding, well known method.” Appeal Br. 11. However, “[t]he ‘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.” *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1315 (Fed. Cir. 2016) (emphasis omitted) (quoting *Diehr*, 450 U.S. at 188–89).

Accordingly, even in combination with all the other recited elements, the addition of “database,” “content server,” “program”/“software application operatively connected to the GUI,” “generating a graphical user interface (GUI) for the user and including within the GUI access to the one or more channels to which the user has subscribed,” and “changing the GUI at least in response to the disposition of individual data records” does not integrate the abstract idea into a practical application because it does not impose any meaningful limits on practicing the abstract idea. For these reasons, we determine that claim 59 does not integrate the recited abstract idea into a practical application.

Inventive Concept

Because we agree with the Examiner that claim 59 is “directed to” an abstract idea, we consider whether an additional element (or combination of elements) adds a limitation that is not well-understood, routine, conventional (“WURC”) activity in the field or whether the additional elements simply append WURC activities previously known to the industry, specified at a high level of generality, to the judicial exception. Revised Guidance, 84 Fed. Reg. at 23. The Examiner’s finding that an additional element (or combination of elements) is WURC activity must be supported with a

factual determination. *Id.* (citing MPEP § 2106.05(d), as modified by the *Berkheimer* Memorandum⁵).

Whether the additional elements (“database,” “content server,” “program”/“software application operatively connected to the GUI,” and “generating a graphical user interface (GUI) for the user and including within the GUI access to the one or more channels to which the user has subscribed”) are WURC activity is a question of fact. *See Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018) (“Whether something is well-understood, routine, and conventional to a skilled artisan . . . is a factual determination.”). On the record before us, Appellants have not shown that the claims on appeal add a specific limitation beyond the judicial exception that is not “well-understood, routine, [and] conventional” in the field (*see* MPEP § 2106.05(d)). Other than asserting that the entirety of the claimed subject matter is nonobvious, Appellants do not point to any particular claimed element that does not qualify as WURC. Appeal Br. 11.

In fact, Appellants’ Specification demonstrates the WURC nature of the additional elements because it indicates they may be implemented with generic devices. Spec. ¶¶ 52–78. In addition, courts have recognized that receiving or transmitting data over a network, in a manner similar to that recited in the claims, is WURC. *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (sending messages over a network); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (computer receives and sends information over a network).

⁵ Robert W. Bahr, *Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (Berkheimer v. HP, Inc.)* (Apr. 9, 2018) (hereinafter “*Berkheimer* Memorandum”).

For these reasons, we conclude that claim 59, considered as a whole, does not include an inventive concept.

Therefore, we sustain the Examiner's § 101 rejection of independent claim 59. We also sustain the Examiner's § 101 rejection of claims 60–66, for which Appellants rely on the same arguments made with respect to claim 59. Appeal Br. 3–12; Reply Br. 1–4.

CONCLUSION

We conclude Appellants have *not* demonstrated the Examiner erred in rejecting claims 59–66 under 35 U.S.C. § 101.

DECISION

We affirm the Examiner's rejection of claims 59–66.

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED