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patentdocketing@hklaw.com
robyn.lecesse@hklaw.com
Daniel.Juffre@hklaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BHOOSHAN PRAFULLA KELKAR and
MAHESH SHIVRAM PARADKAR

Appeal 2018-003016
Application 13/440,307¹
Technology Center 3600

Before DAVID M. KOHUT, ERIC B. CHEN, and
JOSEPH P. LENTIVECH, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1, 3, 6, 18, and 19. Claims 2, 4, 5, 7–17, and 20–25 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to Appellants, the real party of interest is “International Business Machines Corporation.” (Br. 4.)

STATEMENT OF THE CASE

Appellants' invention relates to "human resource analytics using profile data." (Abstract.)

Claim 1 is exemplary:

1. A method comprising:

receiving, via one or more computing devices, historical project data, wherein the historical project data includes at least one profile of at least one historical project team member, one or more historical project requirements, and one or more historical project results;

determining, via the one or more computing devices, psychometric data associated with the at least one historical project team member through sentiment analysis of at least one social networking source, wherein the psychometric data includes psychological characteristics and mental abilities of the at least one historical project team member, wherein sentiment analysis includes computationally identifying and extracting, via the one or more computing devices, at least one of a positive, negative, and neutral sentiment from at least one of a post and a comment from the at least one social networking source, wherein the at least one social networking source includes at least one of a blog, a social networking site, and a social interaction site;

generating, via the one or more computing devices, updated historical project data including, at least in part, adding the psychometric data associated with the at least one historical project team member to the at least one profile included in the historical project data;

receiving, via the one or more computing devices, one or more new project requirements associated with a new project;

identifying, via the one or more computing devices, a similarity between the one or more historical project requirements and the one or more new project requirements, including comparing the psychometric data of the at least one historical project team member to the new project requirements;

identifying, via the one or more computing devices, an indication of success associated with the psychometric data included in the updated historical project data and with the one or more historical project requirements identified as similar to the one or more new project requirements;

determining, via the one or more computing devices, a set of modified project requirements for the new project based upon, at least in part, identifying the indication of success and the psychometric data associated with the at least one historical project team member determined through sentiment analysis; and

determining a ranked list of various possible team compositions that are optimal for the one or more new project requirements based upon, at least in part, the psychometric data associated with the at least one historical project team member determined through sentiment analysis.

Claims 1, 3, 6, 18, and 19 stand rejected under 35 U.S.C. § 101 as directed to patent ineligible subject matter.

Claims 1, 3, 6, 18, and 19² stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7, 9, 12, 13, 15, 22, and 23 of commonly-owned Application No. 13/173,115.³

² Appellants do not present any substantive arguments with respect to the rejection of claims 1, 3, 6, 18, and 19 under the judicially created doctrine of obviousness-type double patenting. Thus, any such arguments are deemed to be waived. As a result, we summarily sustain the Examiner's obvious-type double patenting rejection.

³ An appeal for Application No. 13/173,115 was docketed as Appeal 2018-003223 on February 7, 2018.

ANALYSIS

We are persuaded by Appellants' arguments (Br. 17) that the Examiner has not satisfied the proper burden for making a prima facie case for patent ineligibility under 35 U.S.C. § 101.

With respect to independent claim 1, the Examiner determined that the limitations claimed “when considered both individually and as a whole are directed to actions that facilitate receiving historical project data of a historical project team member to compose a team of members determined through sentiment analysis.” (Final Act. 7.) In particular, the Examiner determined that claim 1 “effectively relate[s] to collecting and comparing known information, which was deemed an abstract concept by the Courts (*Classen*) . . . similar to collecting information, analyzing it, and displaying certain results of the collection and analysis, which was also deemed an abstract concept by the courts (*Electric Power Group*)” (*id.*) and “effectively relate to interpersonal and intrapersonal activities and manage transactions between people (*buySAFE*)” (*id.* at 8–9). We agree that the Examiner has not satisfied the proper burden for a prima facie case.

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 implicit exceptions: “[I]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *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)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 176; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection

of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine 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.” *Alice*, 573 U.S. at 221 (citation omitted). “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.* (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of § 101. USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019). Under that guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h) (9th ed. 2019)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

(3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or

(4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See 84 Fed. Reg. 56.

Although the Examiner generally states that independent claim 1 “effectively relate[s] to collecting and comparing known information” and “effectively relate[s] to interpersonal and intrapersonal activities and manage[ment] [of] transactions between people” with citations to multiple Federal Circuit cases, these statements neither: (a) identify the specific limitations in the claims under examination that the Examiner believes recite an abstract idea; nor (b) demonstrate the identified limitations fall within the subject matter groupings of abstract ideas of mathematical concepts, certain methods of organizing human activity, or mental processes. *See* 84 Fed. Reg. 56. In particular, the Examiner neither accounts for all the limitations recited in claim 1, nor adequately articulates why the claimed concepts are analogous to the facts of *Classen*,⁴ *Electric Power Group*,⁵ and *buySAFE*.⁶ Moreover, based on the Examiner’s statements, we are unable to determine

⁴ *Classen v. Immunotherapies, Inc. v. Biogen Idec*, 659 F.3d 1057 (Fed. Cir. 2011).

⁵ *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016).

⁶ *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350 (Fed. Cir. 2014).

to which category of patent-ineligible subject matter the Examiner finds claim 1 is directed.

Accordingly, we are persuaded by Appellants' arguments that "the Examiner has failed to establish a *prima facie* case of unpatentability" under 35 U.S.C. § 101. (Br. 17.)

Thus, we do not sustain the rejection of independent claim 1 under 35 U.S.C. § 101. Claims 3 and 6 depend from independent claim 1. We do not sustain the rejection of claims 3 and 6 under 35 U.S.C. § 101 for the same reasons discussed with respect to independent claim 1.

Independent claim 18 recite limitations similar to those discussed with respect to independent claim 1. We do not sustain the rejection of claim 18, as well as dependent claim 19, for the same reasons discussed with respect to claim 1.

DECISION

The Examiner's decision rejecting claims 1, 3, 6, 18, and 19 under 35 U.S.C. § 101 is reversed.

The Examiner's decision rejecting claims 1, 3, 6, 18, and 19 under the judicially created doctrine of obviousness-type double patenting is affirmed.

Because at least one rejection encompassing all claims on appeal is affirmed, the Examiner's decision is affirmed.

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