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 BHOOSHAN PRAFULLA KELKAR and
MAHESH SHIVRAM PARADKAR

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Appeal 2018-003223
Application 13/173,115[1]
Technology Center 3600

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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 7, 9, 12, 13, 15, 22, and 23. Claims 1–6, 8, 10, 11, 14, 16–21, 24, and
25 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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STATEMENT OF THE CASE

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

Claim 7 is exemplary:

7.   A computer program product residing on a non-transitory computer readable storage medium having a plurality of instructions stored thereon, which, when executed by a processor, cause the processor to perform operations comprising:

receiving 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 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 identifying 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 updated historical project data including, at least in part, adding 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 one or more new project requirements associated with a new project identifying 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 one or more new project requirements;

identifying 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 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 7, 9, 12, 13, 15, 22, and 23 stand rejected under 35 U.S.C. § 101 as directed to patent ineligible subject matter.

Claims 7, 9, 12, 13, 15, 22, and 23[2] stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 6, 18, and 19 of commonly-owned Application No. 13/440,307.[3]

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[2] Appellants do not present any substantive arguments with respect to the rejection of claims 7, 9, 12, 13, 15, 22, and 23 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. 13/440,307 was docketed as Appeal 2018-003016 on February 5, 2018.

ANALYSIS

We are persuaded by Appellants' arguments (Br. 17–18) 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 7, the Examiner determined that
the operations 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. 9.) In particular, the Examiner
determined that claim 7 "effectively relate[s] to collecting and comparing
known information, which was deemed an abstract concept by the Courts
(*Classen*) . . . similar to comparing new and stored information and using
rules to identify options, which was also deemed an abstract concept by the
courts (*SmartGene*)" (*id.*) and "effectively relate[s] to interpersonal and
intrapersonal activities and manage transactions between people (*buySAFE*)"
(*id.* at 10). 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: "[l]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 are 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. at 56.

Although the Examiner generally states that independent claim 7 "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. at 56. In particular, the Examiner neither accounts for all the limitations recited in claim 7, nor adequately articulates why the claimed concepts are analogous to the facts of *Classen*,[4] *SmartGene*,[5] and *buySAFE*.[6] For example, the Examiner has not adequately addressed the limitation

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[4] *Classen v. Immunotherapies, Inc. v. Biogen Idec*, 659 F.3d 1057 (Fed. Cir. 2011).
[5] *SmartGene, Inc. v. Advanced Biological Labs.*, SA, 555 F. App'x. 950 (Fed. Cir. 2014).
[6] *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350 (Fed. Cir. 2014).

"determining psychometric data associated with the at least one historical project team member, *through sentiment analysis of 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*" (emphasis added).

Accordingly, we are persuaded by Appellants' arguments that "the Examiner has failed to establish a *prima facie* case of unpatentability." (Br. 17–18.)

Thus, we do not sustain the rejection of independent claim 7 under 35 U.S.C. § 101. Claims 9 and 12 depend from independent claim 7. We do not sustain the rejection of claims 9 and 12 under 35 U.S.C. § 101 for the same reasons discussed with respect to independent claim 7.

Independent claims 13 and 22 recite limitations similar to those discussed with respect to independent claim 7. We do not sustain the rejection of claims 13 and 22, as well as dependent claims 15 and 23, for the same reasons discussed with respect to claim 7.

DECISION

The Examiner's decision rejecting claims 7, 9, 12, 13, 15, 22, and 23 under 35 U.S.C. § 101 is reversed.

The Examiner's decision rejecting claims 7, 9, 12, 13, 15, 22, and 23 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