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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 LIAM HARPUR, CORMAC O'LEARY,
PATRICK J. O'SULLIVAN, and HEMA SRIKANTH
_____

Appeal 2018-003627
Application 12/137,010
Technology Center 3600
_____

Before NINA L. MEDLOCK, PHILIP J. HOFFMANN, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant[1] appeals under 35 U.S.C. § 134(a) from the Examiner's
final rejection of claims 1, 2, and 4. We have jurisdiction under 35 U.S.C.
§ 6(b).

We AFFIRM.

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[1] We use the term "Appellant" to refer to "applicant" as defined in 37 C.F.R.
§ 1.42. Our decision references Appellant's Appeal Brief ("Appeal Br.,"
filed March 31, 2017), and the Examiner's Answer ("Ans.," mailed
November 30, 2017) and Final Office Action ("Final Act.," mailed
November 18, 2016). Appellant identifies the real party in interest as
International Business Machines, Inc. Appeal Br. 3.

CLAIMED INVENTION

Appellant's claimed invention "relates to the field of scheduling, [and] more particularly to enhanced viewing/updating of calendar entries based upon relationships between a viewer and a calendar owner and a relative importance value of the calendar entries" (Spec. ¶ 1).

Claim 1, reproduced below with bracketed notations added, is the sole independent claim, and is representative of the claimed subject matter:

1.   A calendaring system comprising:

[(a)]   a data store, which is at least one non-transitory storage medium, configured to digitally encode calendar data specifying a plurality of calendar entries associated with plurality of different calendar owners each of the plurality of calendar entries includes a type selected from a plurality of types;

[(b)]   an entry restrictions component, comprising computer readable instructions executable by processor, said computer readable instructions being stored on at least one non-transitory data store, configured to distinguish between calendar entries representing genuine meetings and user created time blocks set aside to permit an owner of the calendar to complete a task, wherein the calendar entries for the genuine meetings and for the user created time blocks have a fixed start time and a duration or end time;

[(c)]   an event scheduling engine, comprising computer readable instructions executable by processor, said computer readable instructions being stored on at least one non-transitory data store, configured to permit non-owners to push new calendar entries into an owner[']s calendar even when the new calendar entries conflict with at least one of previously established entries for a time block set aside to permit the owner of the calendar to complete a task, wherein a pushing of a new calendar entry to a calendar of an owner does not require explicit owner permission to be granted at a time that the pushing of the new calendar entry occurs;

[(d)] a relationship engine, comprising computer readable instructions executable by processor, said computer

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readable instructions being stored on at least one non-transitory data store, configured to determine a relationship between a non-owner attempting to access a calendar entry of an owner and the owner;

[(e)] a privilege engine, comprising computer readable instructions executable by processor, said computer readable instructions being stored on at least one non-transitory data store, configured to determine a set of privileges to be granted to a non-owner based upon a relationship determined by the relationship engine; and

[(f)] an access engine, comprising computer readable instructions executable by processor, said computer readable instructions being stored on at least one non-transitory data store, configured to compare the set of privileges determined by the privilege engine against entry specific restrictions determined by the entry restrictions component to determine access rights to be granted to calendar entries, wherein said relationship engine is configured to determine a relationship strength, wherein the entry restrictions is configured to determine an entry level, wherein the access engine compares the relationship strength to the access level for each calendar entry based on the calendar entry type to determine access rights to be granted to the non-owner for each calendar entry of the owner.

REJECTION

Claims 1, 2, and 4 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

ANALYSIS

Appellant argues the pending claims as a group (Appeal Br. 10–15). We select independent claim 1 as representative. Claims 2 and 4 stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Under 35 U.S.C. § 101, an invention is patent eligible if it claims a "new and useful process, machine, manufacture, or composition of matter." 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101

to include an implicit exception: "[l]aws of nature, natural phenomena, and abstract ideas" are not patentable. *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), "for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts." *Alice Corp.*, 573 U.S. at 217. The first step in that analysis is to "determine whether the claims at issue are directed to one of those patent-ineligible concepts." *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered "individually and 'as an ordered combination'" to determine whether there are additional elements that "'transform the nature of the claim' into a patent-eligible application." *Id.* (quoting *Mayo*, 566 U.S. at 79, 78). This is "a search for an 'inventive concept' — *i.e.*, 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 (alteration in original).

In rejecting the pending claims under 35 U.S.C. § 101, the Examiner determined that the claims are directed to "identifying and permitting individuals to use and share calendars," which the Examiner concluded is an abstract idea similar to other concepts that the courts have held abstract (Final Act. 11–13). The Examiner also determined that the claims do not include additional elements or a combination of elements sufficient to amount to significantly more than the abstract idea itself (*id.* at 13–16).

After Appellant's Appeal Brief was filed, and the Examiner's Answer mailed, the U.S. Patent and Trademark Office (the "USPTO") published revised guidance for use by USPTO personnel in evaluating subject matter eligibility under 35 U.S.C. § 101. 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50, 57 (Jan. 7, 2019) (the "2019 Revised Guidance"). That guidance revised the USPTO's examination procedure with respect to the first step of the *Mayo/Alice* framework by (1) "[p]roviding groupings of subject matter that [are] considered an abstract idea"; and (2) clarifying that a claim is not "directed to" a judicial exception if the judicial exception is integrated into a practical application of that exception. *Id.* at 50. The 2019 Revised Guidance, by its terms, applies to all applications, and to all patents resulting from applications, filed before, on, or after January 7, 2019. *Id.*[2]

Step One of the Mayo/Alice Framework (*2019 Revised Guidance*, *Step 2A*)

The first step in the *Mayo/Alice* framework, as mentioned above, is to determine whether the claims at issue are "directed to" a patent-ineligible concept, e.g., an abstract idea. *Alice Corp.*, 573 U.S. at 217. This first step, as set forth in the 2019 Revised Guidance (i.e., Step 2A), is a two-prong test; in Step 2A, Prong One, we look to whether the claim recites a judicial

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[2] The 2019 Revised Guidance supersedes MANUAL OF PATENT EXAMINING PROCEDURE ("MPEP") § 2106.04(II) and also supersedes all versions of the USPTO's "Eligibility Quick Reference Sheet Identifying Abstract Ideas." *See* 2019 Revised Guidance, 84 Fed. Reg. at 51 ("Eligibility-related guidance issued prior to the Ninth Edition, R-08.2017, of the MPEP (published Jan. 2018) should not be relied upon."). Accordingly, Appellant's arguments challenging the sufficiency of the Examiner's rejection will not be addressed to the extent those arguments are based on now superseded USPTO guidance.

exception, e.g., one of the following three groupings of abstract ideas:
(1) mathematical concepts; (2) certain methods of organizing human
activity, e.g., fundamental economic principles or practices, commercial or
legal interactions; and (3) mental processes. 2019 Revised Guidance,
84 Fed. Reg. at 54. If so, we next consider whether the claim includes
additional elements, beyond the judicial exception, that "integrate the
[judicial] exception into a practical application," i.e., that apply, rely on, or
use the judicial exception in a manner that imposes a meaningful limit on the
judicial exception, such that the clam is more than a drafting effort designed
to monopolize the judicial exception ("Step 2A, Prong Two"). *Id.* at 54–55.
Only if the claim (1) recites a judicial exception and (2) does not integrate
that exception into a practical application do we conclude that the claim is
"directed to" the judicial exception, e.g., an abstract idea. *Id.*

    We are not persuaded, as an initial matter, by Appellant's argument
that the Examiner has failed to establish a prima facie case of patent
ineligibility (Appeal Br. 11–13). The Federal Circuit has observed
repeatedly that "the prima facie case is merely a procedural device that
enables an appropriate shift of the burden of production." *Hyatt v. Dudas*,
492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443,
1445 (Fed. Cir. 1992)). The court has, thus, held that the USPTO carries its
procedural burden of establishing a prima facie case when its rejection
satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of
the reasons for the rejection, "together with such information and references
as may be useful in judging of the propriety of continuing the prosecution of
[the] application." *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011)
(alteration in original). Thus, what is required of the Office is that it sets

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forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. *Id.*; *see also Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (citation omitted) ("Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.").

Here, in rejecting the pending claims under 35 U.S.C. § 101, the Examiner analyzed the claims in accordance with the *Mayo/Alice* two-step framework, and consistently with the USPTO guidance in effect at the time the Final Office Action was mailed. The Examiner, thus, notified Appellant, as described above, that the claims are directed to "identifying and permitting individuals to use and share calendars," which the Examiner concluded is similar to other concepts that the courts have held abstract (Final Act. 11–13); and that the claims do not include additional elements or a combination of elements sufficient to amount to significantly more than the abstract idea itself (*id.* at 13–16). The Examiner set forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of 35 U.S.C. § 132. And we find that, in doing so, the Examiner established a prima facie case of patent ineligibility.

We also are not persuaded that the Examiner erred in determining that claim 1 is directed to an abstract idea. The Federal Circuit has explained that "the 'directed to' inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether 'their character as a whole is directed to excluded subject matter.'" *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). It asks whether

the focus of the claims is on a specific improvement in relevant technology or on a process that itself qualifies as an "abstract idea" for which computers are invoked merely as a tool. *See id.* at 1335–36. Here, it is clear from the Specification (including the claim language) that the claims focus on an abstract idea, and not on any improvement to technology and/or a technical field.

The Specification is entitled "ENHANCED VIEWING/UPDATING OF CALENDAR ENTRIES BASED UPON RELATIONSHIPS BETWEEN A VIEWER AND A CALENDAR OWNER AND A RELATIVE IMPORTANCE VALUE OF THE CALENDAR ENTRIES," and describes, in the Background section, that many computing applications provide users with a shared calendar; some of these applications implement shared calendars where users get their own calendars while others implement a common calendar that multiple users share (Spec. ¶ 2). The Specification describes that when personal calendars are provided, they can be shared with other users, who can see what time is scheduled and what time the user has free (*id.* ¶ 3). However, according to the Specification, conventional calendaring systems do not customize calendar actions, e.g., the ability to access and manipulate a user's calendar entries, based on a relationship between the owner and the accessing party; these conventional systems also make no distinctions between different types of calendar entries (*id.*)

The claimed invention is ostensibly intended to provide an improved calendaring system, which distinguishes between calendar entries representing genuine meetings and user-created time blocks set aside to permit the calendar owner to complete a task (*id.* ¶ 4). Each calendar entry also has associated access restrictions; a non-owner is, thus, allowed access

to a particular calendar entry based on the results of a comparison between the non-owner's access privileges (which are determined based on the relationship between the calendar owner and the non-owner) and the access restrictions associated with the calendar entry.

Consistent with this disclosure, claim 1 recites a calendaring system comprising "a data store . . . configured to digitally encode calendar data specifying a plurality of calendar entries associated with plurality of different calendar owners each of the plurality of calendar entries includes a type selected from a plurality of types" (limitation (a)), and a plurality of additional components comprising computer readable instructions executable by a processor to: (1) establish entry specific access restrictions for each of a plurality of stored calendar entries associated with a plurality of calendar owners, i.e.,

> an entry restrictions component, comprising computer readable instructions executable by processor, said computer readable instructions being stored on at least one non-transitory data store, configured to distinguish between calendar entries representing genuine meetings and user created time blocks set aside to permit an owner of the calendar to complete a task, wherein the calendar entries for the genuine meetings and for the user created time blocks have a fixed start time and a duration or end time

(limitation (b)); (2) permit a non-owner to push new calendar entries into an owner's calendar, i.e.,

> an event scheduling engine, comprising computer readable instructions executable by processor, said computer readable instructions being stored on at least one non-transitory data store, configured to permit non-owners to push new calendar entries into an owner[']s calendar even when the new calendar entries conflict with at least one of previously established entries for a time block set aside to permit the owner of the calendar to complete a task, wherein a pushing of a new calendar entry to a

> calendar of an owner does not require explicit owner permission
> to be granted at a time that the pushing of the new calendar entry
> occurs

(limitation (c)); (3) determine the relationship between the non-owner and

the owner, i.e.,

> a relationship engine, comprising computer readable instructions
> executable by processor, said computer readable instructions
> being stored on at least one non-transitory data store, configured
> to determine a relationship between a non-owner attempting to
> access a calendar entry of an owner and the owner

(limitation (d)); (4) determine a set of privileges granted to the non-owner

based on the non-owner's relationship with the owner, i.e.,

> a privilege engine, comprising computer readable instructions
> executable by processor, said computer readable instructions
> being stored on at least one non-transitory data store, configured
> to determine a set of privileges to be granted to a non-owner
> based upon a relationship determined by the relationship engine

(limitation (e)); and (5) allow the non-owner access to a calendar entry based

on the results of a comparison between the privileges granted to the non-

owner and the access restrictions for the calendar entry, i.e.,

> an access engine, comprising computer readable instructions
> executable by processor, said computer readable instructions
> being stored on at least one non-transitory data store, configured
> to compare the set of privileges determined by the privilege
> engine against entry specific restrictions determined by the entry
> restrictions component to determine access rights to be granted
> to calendar entries, wherein said relationship engine is
> configured to determine a relationship strength, wherein the
> entry restrictions is configured to determine an entry level,
> wherein the access engine compares the relationship strength to
> the access level for each calendar entry based on the calendar
> entry type to determine access rights to be granted to the non-
> owner for each calendar entry of the owner

(limitation (f)). Claim 1, given its broadest reasonable interpretation, thus, recites selectively sharing calendar entries based on a relationship between the calendar owner and a user seeking to access the calendar entry. In other words, claim 1 recites a method of managing human behavior or interactions between people, which is a method of organizing human activity and, therefore, an abstract idea. *See* 2019 Revised Guidance, 84 Fed. Reg. at 52.

The Federal Circuit has held similar concepts to be abstract. Thus, for example, the Federal Circuit has held that abstract ideas include the concepts of collecting data, analyzing the data, and displaying the results of the collection and analysis, including when limited to particular content. *See, e.g.*, *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017) (identifying the abstract idea of collecting, displaying, and manipulating data); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (characterizing collecting information, analyzing information by steps people go through in their minds, or by mathematical algorithms, and presenting the results of collecting and analyzing information, without more, as matters within the realm of abstract ideas); *see also SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1168 (Fed. Cir. 2018) ("As many cases make clear, even if a process of collecting and analyzing information is 'limited to particular content' or a particular 'source,' that limitation does not make the collection and analysis other than abstract.") (quoting *Elec. Power Grp.*, 830 F.3d at 1353, 1355 (citing cases)). Determining whether to allow a non-owner to access a calendar entry, by comparing the non-owner's privileges to access restrictions for the calendar entry, also is substantially similar to other concepts that the courts have held abstract. *See, e.g.*, *Berkheimer v. HP, Inc.*, 881 F.3d 1360, 1366

(Fed. Cir. 2018) (concluding that parsing, comparing, storing, and editing data are abstract ideas); *SmartGene, Inc. v. Advanced Biological Labs.*, 555 F. App'x 950 (Fed. Cir. 2014) (comparing new and stored information and using rules to identify options is an abstract idea).

Having concluded that claim 1 recites a judicial exception, i.e., an abstract idea (Step 2A, Prong One), we next consider whether the claim recites additional elements that integrate the judicial exception into a practical application (Step 2A, Prong Two).

The only additional elements recited in claim 1, beyond the abstract idea, are a "data store"; a "non-transitory storage medium"; and a "processor" — elements that, as the Examiner observes (Final Act. 13–15), are described in the Specification as generic computer components (*see, e.g.*, Spec. ¶¶ 10–15). We find no indication in the Specification, nor does Appellant direct us to any indication, that the operations recited in claim 1 require any specialized computer hardware or other inventive computer components, i.e., a particular machine, invoke any assertedly inventive programming, or that the claimed invention is implemented using other than generic computer components to perform generic computer functions. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) ("[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.").

We also find no indication in the Specification that the claimed invention effects a transformation or reduction of a particular article to a different state or thing. Nor do we find anything of record, short of attorney argument, that attributes an improvement in technology and/or a technical

field to the claimed invention or that otherwise indicates that the claimed invention integrates the abstract idea into a "practical application," as that phrase is used in the 2019 Revised Guidance.[3]

Appellant argues that "the claimed invention provides a technological improvement to electronically maintained calendars, namely a specific manner as to how calendar[ ] entries can be added to a calendar" (Appeal Br. 14). But, we fail to see how, and Appellant does not explain how, allowing calendar entries to be added to a calendar based on a relationship between the calendar owner and the user seeking to add the calendar entry somewhat amounts to a technological improvement, as opposed to an improvement in a business practice. It clearly appears from the Specification that the problem the claimed invention addresses is one prompted by the inability with conventional calendaring systems to customize calendar actions based on a relationship between an owner and an accessing party (Spec. ¶ 2). This is not a technical problem but, as Appellant describes, a business or personal concern related to a user's desire that his or her boss in a business context, or his or her spouse in a personal context, has enhanced viewing and/or calendar manipulation options available for calendaring events (*id.* ¶ 3).

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[3] The 2019 Revised Guidance references MPEP § 2106.05(a)–(c) and (e) in describing the considerations that are indicative that an additional element or combination of elements integrates the judicial exception, e.g., the abstract idea, into a practical application. 2019 Revised Guidance, 84 Fed. Reg. at 55. If the recited judicial exception is integrated into a practical application, as determined under one or more of these MPEP sections, the claim is not "directed to" the judicial exception.

We conclude, for the reasons set forth above, that claim 1 recites a method of organizing human activity, i.e., an abstract idea, and that the additional elements recited in the claim are no more than generic computer components used as tools to perform the recited abstract idea. As such, they do not integrate the recited abstract idea into a practical application. *See Alice Corp.*, 573 U.S. at 223–24 ("[W]holly generic computer implementation is not generally the sort of 'additional featur[e]' that provides any 'practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.'" (quoting *Mayo*, 566 U.S. at 77)). Accordingly, we agree with the Examiner that claim 1 is directed to an abstract idea.

Step Two of the Mayo/Alice Framework (*2019 Revised Guidance*, *Step 2B*)

Having determined under step one of the *Mayo/Alice* framework that claim 1 is directed to an abstract idea, we next consider under Step 2B of the 2019 Revised Guidance, the second step of the *Mayo/Alice* framework, whether claim 1 includes additional elements or a combination of elements that provides an "inventive concept," i.e., whether claim 1 adds specific limitations beyond the judicial exception that are not "well-understood, routine, conventional" in the field. 2019 Revised Guidance, 84 Fed. Reg. at 56.

Appellant notes that

[c]laim 1 recites, *inter alia*, the claimed relationship engine, privilege engine, and access engine[,] which operate to evaluate the relationship between the owner of the calendar and the non-owner seeking [to] add the calendar entry to the owner's calendar, the privileges of the non-owner based on that relationship, and whether to allow the calendar entry to be entered into the owner's calendar

(Appeal Br. 13). And Appellant argues that these and other recited limitations "go substantially beyond the idea of allowing changes to electronically maintained calendars; they limit which times can be affected, and prescribe particular functionality that determines whether changes are allowed based on relationships of the calendar owner and the non-owner" (*id.* at 13–14).

The difficulty with Appellant's argument is that the limitations that Appellant identifies (i.e., evaluating the relationship between the owner of the calendar and the non-owner seeking to add the calendar entry to the owner's calendar, the privileges of the non-owner based on that relationship, and determining whether to allow the calendar entry to be entered into the owner's calendar) are part of the abstract idea itself, i.e., selectively sharing calendar entries based on a relationship between the calendar owner and a user seeking to access, e.g., to view and/or modify, the calendar entry;[4] they are not additional elements to be considered when determining whether claim 1 includes additional elements or a combination of elements that is sufficient to amount to significantly more than the judicial exception.

It could not be clearer from *Alice*, that under step two of the *Mayo/Alice* framework, the elements of each claim are considered both

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[4] Our articulation of the abstract idea to which claim 1 is directed is not materially different from that of the Examiner. *Cf. Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016) ("An abstract idea can generally be described at different levels of abstraction. As the Board has done, the claimed abstract idea could be described as generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location. It could be described in other ways, including, as indicated in the specification, taking orders from restaurant customers on a computer.").

individually and "as an ordered combination" to determine whether the additional elements, i.e., the elements *other* than the abstract idea itself, "transform the nature of the claim" into a patent-eligible application. *Alice Corp.*, 573 U.S. at 217 (internal quotations and citation omitted); *see Mayo*, 566 U.S. at 72–73 (requiring that "a process that focuses upon the use of a natural law also contain *other* elements or a combination of elements, sometimes referred to as an 'inventive concept,' sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the natural law itself" (emphasis added) (internal citation omitted)). In other words, the inventive concept under step two of the *Mayo/Alice* test cannot be the abstract idea itself:

> It is clear from *Mayo* that the "inventive concept" cannot be the abstract idea itself, and *Berkheimer* . . . leave[s] untouched the numerous cases from this court which have held claims ineligible because the only alleged "inventive concept" is the abstract idea.

Berkheimer v. HP, Inc., 890 F.3d 1369, 1374 (Fed. Cir. 2018) (Moore, J., concurring); *see also BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018) ("It has been clear since *Alice* that a claimed invention's use of the ineligible concept to which it is directed cannot supply the inventive concept that renders the invention 'significantly more' than that ineligible concept.") (internal citation omitted).

The Examiner determined here, and we agree, that the only claim elements beyond the abstract idea are the "data store"; "non-transitory storage medium"; and "processor," i.e., generic computer components used to perform generic computer functions (Final Act. 13–15) — a determination

amply supported by, and fully consistent with the Specification (*see, e.g.*, Spec. ¶¶ 10–15).[5]

Appellant cannot reasonably contend, nor does Appellant, that there is a genuine issue of material fact regarding whether the operation of these components is well-understood, routine, or conventional, where, as here, there is nothing in the Specification to indicate that the operations recited in claim 1 require any specialized hardware or inventive computer components or that the claimed invention is implemented using other than generic computer components to perform generic computer functions, e.g., receiving, matching, and processing information. Indeed, the Federal Circuit, in accordance with *Alice*, has "repeatedly recognized the absence of a genuine dispute as to eligibility" where claims have been defended as involving an inventive concept based "merely on the idea of using existing computers or the Internet to carry out conventional processes, with no alteration of computer functionality." *Berkheimer*, 890 F.3d at 1373 (Moore, J., concurring) (internal citations omitted); *see also BSG Tech*, 899 F.3d at 1291 ("BSG Tech does not argue that other, non-abstract features of the claimed inventions, alone or in combination, are not well-

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[5] The Office's April 19, 2018 Memorandum to the Examining Corps from Deputy Commissioner for Patent Examination Policy, Robert W. Bahr, entitled, Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*), available at https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF, expressly directs that an examiner may support the position that an additional element (or combination of elements) is not well-understood, routine or conventional with "[a] citation to an express statement in the specification . . . that demonstrates the well-understood, routine, conventional nature of the additional element(s)" (*id.* at 3).

understood, routine and conventional database structures and activities. Accordingly, the district court did not err in determining that the asserted claims lack an inventive concept.").

Finally, Appellant misapprehends the controlling precedent to the extent Appellant maintains that claim 1 includes additional elements or a combination of elements that is not well-understood, routine and conventional, because the claim is allegedly novel and/or non-obvious in view of the prior art (Appeal Br. 13–14). Neither a finding of novelty nor a non-obviousness determination automatically leads to the conclusion that the claimed subject matter is patent eligible. Although the second step in the *Mayo/Alice* framework is termed a search for an "inventive concept," the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for "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 Corp.*, 573 U.S. at 217–18 (citation omitted). "Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry." *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent ineligible. *See Mayo*, 566 U.S. at 90; *see also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) ("The '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.").

We are not persuaded, on the present record, that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 101. Therefore, we

sustain the Examiner's rejection of claim 1, and claims 2 and 4, which fall with claim 1.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2, 4	101	Eligibility	1, 2, 4	

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