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 RYLAN MICHAEL HAWKINS, ERIC SCOTT ALBRIGHT,
NICHOLAS A. BEAL, PETER GEOFFREY CONSTABLE,
WADE H. CURTISS, ERIK FORTUNE, ANDREW STUART GLASS,
and SAMUEL AARON BEARD

_____

Appeal 2018-004554
Application 13/485,917
Technology Center 2600

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Before MAHSHID D. SAADAT, ERIC S. FRAHM, and JOHN A. EVANS,
Administrative Patent Judges.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

Pursuant to 35 U.S.C. § 134(a), Appellant[2] appeals from the
Examiner's decision to reject claims 1–4, 6–19, 21, and 22.[3] We have
jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] An oral hearing scheduled on December 6, 2019, for this appeal has been
waived.
[2] We use the word Appellant to refer to "applicant" as defined in 37 C.F.R.
§ 1.42(a) (2017). Appellant identifies the real party in interest as Microsoft
Technology Licensing, LLC. Appeal Br. 3.
[3] Claims 5 and 20 have been canceled.

STATEMENT OF THE CASE

Introduction

Appellant's invention relates to "techniques for configuring a device to select resources from the resource set in response to a resource request," by calculating a weight "representing a suitability of the language for the resource request, and identify a selection order according to the weights of the selected languages." Spec. ¶ 5.

Exemplary Claim

> 1.   A method of providing language-specific resources to an application executing on a device having a processor and having access to a resource set of resources respectively associated with at least one language, the method comprising:
>
> executing, on the processor, instructions that cause the device to:
>
> receive from a user a user preference order of at least two selected languages that are available on the device; and
>
> fulfill a resource request by the application for a resource of the resource set by:
>
> for each language available on the device, calculating a weight representing a suitability of the language specifically for the resource request;
>
> identifying an application selection order according to the weights of the at least two languages; and
>
> meshing the user preference order and the application selection order to identify, among the languages that are associated with at one resource of the resource set, a selected language;
>
> from at least two resources of the resource, identify a selected resource that is associated with the selected language; and
>
> presenting the selected resource to the application to fulfill the resource request.

Rejections

Claims 1–4, 6–19, 21, and 22 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. *See* Non-Final Act. 6–8.

Claims 1–4, 6–8, 10–14, 17–19, 21, and 22 stand rejected under 35 U.S.C. § 103 as unpatentable over Lim (US 8,639,701 B1; iss. Jan. 28, 2014) and Reitan (US 2012/0316860 A1, pub. Dec. 13, 2012). *See* Non-Final Act. 10–23.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Lim, Reitan, and Etzioni (US 8,209,164 B2, iss. June 26, 2012). *See* Non-Final Act. 23–25.

Claims 15 and 16 stand rejected under 35 U.S.C. § 103 as unpatentable over Lim, Reitan, and Gupta (US 8,600,993 B1, iss. Dec. 3, 2013). *See* Non-Final Act. 25–28.[4]

ANALYSIS

35 U.S.C. § 101 Rejection

Arguments

The Examiner determines that the claims are directed to "an application on behalf of a user receiving a resource in one or more languages according to his language selection," which the Examiner characterizes as "a mathematical manipulation of data; i.e., in so doing it employs a weighting scheme in order to determine a selection order which is used in presenting the resources." Non-Final Act. 6–7. The Examiner adds that:

> There are no pre and or post processing steps claimed, which
> could bring the claimed steps within range of normal human

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[4] The rejection of claims 1–4, 6–19, 21, and 22 for lack of written description has been withdrawn. *See* Ans. 2.

activity except perhaps "calculating a weight" which is merely a mathematical manipulation of data and hence an abstract idea. The "weight" is an abstract concept, and the process of "a selection order" amounts to "Organizing information through mathematical correlations", one of the abstract idea categories listed in the "July 2015 Update: Interim Eligibility Guidance Identifying Abstract Ideas" and updated in December 2016.

Non-Final Act. 7. Additionally, the Examiner finds "the additional limitation simply calls for the implementation of the abstract idea on a processor, e.g., a conventional computer" and therefore do not "amount to significantly more than the abstract idea itself." *Id.*

Appellant argues the claims do not recite an abstract idea of "a mathematical manipulation of data employing a weighting scheme. . . " Appeal Br. 21. Instead, Appellant argues that "[t]he inclusion of a 'mathematical manipulation of data,' as one of many steps of a technique that is otherwise applied in a specific useful context, is not an adequate rationale for rejecting the claim under 35 U.S.C. § 101," as the claims include limitations that are similar to those in court cases found to be patent eligible, such as *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016), *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), *Visual Memory LLC v. NVIDIA Corp., 867 F.3d 1253 (Fed. Cir. 2017)*, and *Diamond v. Diehr*, 450 U.S. 175 (1981)), *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016), *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), and *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014). Appeal Br. 22 (emphasis omitted). Appellant also argues the claimed techniques are directed to "a specific technical solution to a specific technical problem," and "the result of such techniques is,

centrally, an improvement in the functioning of the device itself: *i.e.*, a resolution of conflicting information to provide the selection of an optimal resource to provide to an application." Appeal Br. 25. Appellant further argues that certain dependent claims (*i.e.*, dependent claims 2, 3, 4, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, and 22) recite additional elements that are significantly more than the abstract idea. *See* Appeal Br. 26–27; *see also* Reply Br. 6.

Legal Principles

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." *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 187 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 187; *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

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concept' sufficient to 'transform' the claimed abstract idea into a patent-eligible application." *Alice*, 573 U.S. at 221 (quotation marks 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.* (alterations in original) (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, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) ("Revised Guidance"). 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* MANUAL OF PATENT EXAMINING PROCEDURE ("MPEP") §§ 2106.05(a)–(c), (e)–(h) (9th ed. 2018)).

See 2019 Revised Guidance, 84 Fed. Reg. at 52, 55–56. 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 Revised Guidance, 84 Fed. Reg. at 54–56.

The Judicial Exception – Abstract Idea

Under the Revised Guidance, we begin our analysis by first considering whether the claims recite any judicial exceptions, including certain groupings of abstract ideas, in particular: (a) mathematical concepts, (b) mental steps, and (c) certain methods of organizing human activities. Turning to independent claim 1, we observe the claim recites, inter alia, "executing, on the processor, instructions that cause the device to" perform the following functions:

> **receive** from a user **a user preference order** of at least two selected languages that are available on the device;
>
> **fulfill a resource request** by the application for a resource of the resource set by:
>
> . . ., **calculating** a weight representing a suitability of the language specifically for the resource request;
>
> **identifying** an application selection order according to the weights of the at least two languages; and
>
> **meshing** the user preference order and the application selection order to identify, . . ., a selected language;
>
> . . ., **identify** a selected resource that is associated with the selected language; and
>
> **presenting** the selected resource to the application to fulfill the resource request.

Claim 1 (emphases added).

Thus, we conclude the aforementioned *receive a user preference and fulfill the request by: calculating a weight, identifying an application selection, meshing the preference and selection orders, identifying a selected resource* functions could be performed alternatively as mental processes, i.e., concepts performed in the human mind or using pen and paper

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(including an observation, evaluation, judgment, and opinion) under the 2019 Revised Guidance, 84 Fed. Reg. at 52.[5] Contrary to Appellant's assertion that the claim as a whole is more than "manipulation of weights" (Reply Br. 3–4), a person can perform the above-mentioned steps of claim 1 by using their minds (or pen and paper) in the claimed manner. For example, a person can obtain the user preference order and fulfill the request by memorizing or writing down the application selection order and compute the meshed user preference order and the application selection order based on the calculated weight for each order of at least two languages, using their minds or pen and paper.

We note remaining independent claims 19 and 21 recite similar language of commensurate scope that we conclude also falls into the abstract idea category of a mental process including the abstract idea subcategories of an observation, evaluation, judgment, opinion. *Id.* Claim 21 recites the additional non-abstract generic limitation of "a computer-readable storage device comprising instructions that, when executed on a processor,"

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[5] If a method can be performed by human thought alone, or by a human using pen and paper, it is merely an abstract idea and is not patent eligible under § 101. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011); *see also Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146–47 (Fed. Cir. 2016) ("While the Supreme Court has altered the § 101 analysis since *Cyber Source* in cases like *Mayo* and *Alice,* we continue to 'treat[ ] analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category'" (brackets in original) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016).); *CyberSource*, 654 F.3d at 1375 ("That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*.").

provides "language-specific resources to an application executing on the device" by performing functions discussed above in claim 1. Claim 1 recites the additional non-abstract generic limitations of a device including a processor, a memory storing instructions for performing the functions recited in claim 1.

We also note the recited "calculating a weight" and "meshing the user preference order and the application selection order," as well as "presenting the selected resources" functions of claim 1, and similar language recited in other independent claims merely access and manipulate information. Courts have found such data gathering steps to be insignificant extra-solution activity. *See, e.g.*, *In re Bilski*, 545 F.3d 943, 963 (Fed. Cir. 2008) (en banc), *aff'd sub nom Bilski*, 561 U.S. 593 (characterizing data gathering steps as insignificant extra-solution activity).[6]

Because we conclude all claims on appeal **recite an abstract idea,** as discussed above, under *Step 2A, Prong One,* we proceed to *Step 2A, Prong Two.* Although claim 1 recites an abstract idea based on these mental processes, we, nevertheless, must still determine whether the abstract idea is integrated into a practical application, namely whether the claim applies, relies on, or uses the abstract idea in a manner that imposes a meaningful limit on the abstract idea, such that the claim is more than a drafting effort designed to monopolize the abstract idea. *See* Revised Guidance, 84 Fed. Reg. at 54–55. We, therefore, (1) identify whether there are any additional

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[6] We agree with the Examiner that the steps of "calculating a weight . . . of the language" and "meshing the user preference order and the application selection order" could alternatively be characterized as "mathematical manipulation" or the abstract idea of mathematical concepts. *See* Non-Final Act. 7.

recited elements beyond the abstract idea, and (2) evaluate those elements individually and collectively to determine whether they integrate the exception into a practical application. *See id.*

Integration of the Judicial Exception into a Practical Application

Further pursuant to the Revised Guidance, we consider whether there are additional elements set forth in the claims that integrate the judicial exception into a practical application. *See* Revised Guidance, 84 Fed. Reg. at 54–55. We have identified *supra*, the additional non-abstract limitations recited in independent claim 1 as a processor, a resource set of resources, and instructions executed on the processor. Claims 19 and 21 recite additional elements, such as a computer-readable medium comprising instructions, a processor, and a memory. *See* Appeal Br. 36, 40, 41 (Claims App.).

Under MPEP § 2106.05(a) ("Improvements to the Functioning of a Computer or to Any Other Technology or Technical Field"), Appellant contends the claims amount to significantly more than an abstract idea and assert the recited function provide "an improvement in the functioning of the device itself: *i.e.*, a resolution of conflicting information to provide the selection of an optimal resource to provide to an application." Appeal Br. 25. We, however, note the remaining elements recited in claim 1, as well as other independent claims, do not integrate the above-identified abstract ideas into a practical application.

The written description indicates that each of these elements encompass commonplace generic components. *See* Spec. ¶¶ 24, 25, 45, 56; Figs. 1, 6. Appellant does not describe the "processor," "resources," and "computer-readable medium" with any specificity. For example,

Appellant's Specification describes the processor as the "processor of device 102" or "processor 412 of device 410" (Spec. ¶¶ 25, 30) and the computer-readable medium 402 as including DRAM, SDRAM, CD-R, DVD-R, or a platter of a hard disk drive, etc. Spec. ¶¶ 24, 25.

Other than disclosing these additional elements performing their accustomed functions utilizing standard techniques—the processor executing instructions, and the processor calculating a weight and identifying an application selection order using the calculated weight—the written description describes these components in functional, result-oriented terms with no technical details. *See, e.g.*, Spec. ¶¶ 40–43 (Providing no specific definition for the term "processor" and "computer-readable medium" other than listing different types of a generic computer processor including processing instructions that are stored in a generic memory or storage device). These descriptions show that additional elements are generic. *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986) ("[A] patent need not teach, and preferably omits, what is well known in the art."); *Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1331 (Fed. Cir. 2017) ("The claimed mobile interface is so lacking in implementation details that it amounts to merely a generic component (software, hardware, or firmware) that permits the performance of the abstract idea, i.e., to retrieve the user-specific resources."). Simply adding generic hardware and computer components to perform abstract ideas does not integrate those ideas into a practical application. *See* Revised Guidance, 84 Fed. Reg. at 55 (identifying "merely includ[ing] instructions to implement an abstract idea on a computer" as an example of when an abstract idea has not been integrated into a practical application).

Even assuming, without deciding, that the claimed invention can automatically identify the application selection order based on the calculated weights and mesh the user preference order and the application selection order more efficiently than a human, the increased efficiency comes from the capabilities of the generic computer components, not the recited process itself including the weight calculation and meshing. *See FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1095 (Fed. Cir. 2016) ("[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." (Quoting *Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012))); *see also Intellectual Ventures I LLC v. Erie Indem. Co.*, 711 F. App. 1012, 1017 (Fed. Cir. 2017) (unpublished) (alteration in original) (citation omitted) ("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.'"). Like the claims in *Fair Warning*, the focus of claim 1 is not on an improvement in computer systems or databases as tools, but on certain independently abstract ideas that use generic computing components to lookup values in a database as tools. *See FairWarning*, 839 F.3d at 1095.

Appellant's claim 1 can be distinguished from patent-eligible claims such as those in *Enfish* that are directed to "a specific improvement to the way computers operate." *Enfish*, 822 F.3d at 1336. Appellant's claims can also be distinguished from patent-eligible claims such as those that solve a technology-based problem (*see BASCOM Glob. Internet Servs., Inc. v.*

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AT&T Mobility LLC, 827 F.3d 1341, 1349–52 (Fed. Cir. 2016)), or a method "rooted in computer technology in order to overcome a problem specifically arising in the realm of computer [technology]" (*DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014)). Contrary to Appellant's arguments (*see supra* and Appeal Br. 22 (contending [a] number of recent cases from the Court of Appeals for the Federal Circuit involved such "manipulation," yet were found to be patent-eligible), claim 1 is not a technological improvement or an improvement in a technology. Appellant's claim 1 does not "improve the functioning of the computer itself" or "any other technology or technical field." *Alice*, 573 U.S. at 225. Nor does it provide a technological solution to a technological problem. *See DDR Holdings*, 773 F.3d at 1257; MPEP § 2106.05(a). Appellant fails to sufficiently and persuasively explain how the instant claims are directed to an improvement in the way computers operate, nor has Appellant identified any technical advance or improvement or specialized computer components. *See* Appeal Br. 19–27; Reply Br. 3–6.

Thus, the claims do not integrate the judicial exception into a practical application. The claims do not (1) improve the functioning of a computer or other technology, (2) are not applied with any particular machine (except for a generic computer), (3) do not effect a transformation of a particular article to a different state, and (4) are not applied in any meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception. *See* MPEP §§ 2106.05(a)–(c), (e)–(h).

Inventive Concept

Because we determine claim 1 is "directed to" an abstract idea, we consider whether claim 1 recites an "inventive concept." Under the Revised Guidance, if a claim: (1) recites a judicial exception, and (2) does not integrate that exception into a practical application, we then look to whether the claim adds a specific limitation beyond the judicial exception that is not "well-understood, routine, conventional" in the field (*see* MPEP § 2106.05(d)); or, simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. *See* Revised Guidance, 84 Fed. Reg. at 56.

The Examiner determined claim 1 does not recite an inventive concept because "[t]here is nothing special about the "processor" and/or its associated programs doing the weight calculation and/or determining the selection order, by reciting a special technique specifically designed in doing those respective calculations." *See* Final Act. 7.

Appellant argues that the inventive steps includes "the presently claimed techniques are obviously directed to a specific technical solution to a specific technical problem, and that the result of such techniques is, centrally, an improvement in the functioning of the device itself: *i.e.*, a resolution of conflicting information to provide the selection of an optimal resource to provide to an application," which is not disclosed by any of the prior art references applied by the Examiner. Appeal Br. 25. Appellant specifically argues "[t]he omission of any such statement in the cited references demonstrates the general failure to recognize this problem, as well as the absence of any techniques that address this problem." *Id.*

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We are unpersuaded. First, Appellant's claims can be distinguished from patent-eligible claims such as those in *Bascom*, where the system claims were directed to a "content filtering system for filtering content retrieved from an Internet computer network," which the court held were directed to an abstract idea. *Bascom*, 827 F.3d at 1348–49. The court further held the claims included an inventive concept in the ordered combination of system components, including a local client computer and a remote ISP server connected to the client computer and Internet computer network providing for "the installation of a filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each end user." *Id.* at 1350. Appellant has failed to establish that claim 1 includes a similar or analogous arrangement or "ordered combination" of components, and, instead, make only the conclusory statement that the recited first and second databases used to determine intermediate property values or target property values are "non-traditional" and "improve[] the functioning of the computer." Appeal Br. 22, 25.

Second, the additional elements recited in the independent claims include a processor, a memory, a resource set of resources, instructions executed on the processor, and a computer-readable medium comprising instructions. The claim recites these elements at a high level of generality, and the written description provides no details about receiving a user preference order, calculating a weight, identifying an application selection order based on the weight, or meshing the user preference order and the application selection order. *See, e.g.*, Spec. ¶¶ 21 (describing generic and routine ways for selecting resources and calculating a weight for the selections), 4 (describing high level process that meshes the language

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selected by the user and the languages requested by the application), 46 (describing generic implementation of the instructions on a processor based on modules, functions, and objects using data structures, and the like). Consequently, we find that the above-identified claim elements constitute no more than what would have been well-understood, routine and conventional to a skilled artisan. *See Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (2018).[7]

Dependent Claims

We are also not persuaded by Appellant's contentions that dependent claims 2–4, 6–18, and 22 are separately patent-eligible. For the reasons indicated by the Examiner, we agree with the Examiner's conclusion that dependent claims 2–4, 6–18, and 22 do not recite additional elements that are significantly more than the underlying abstract idea. *See* Final Act. 8.

Conclusion

For at least the above reasons, we agree with the Examiner that claims 1–4, 6–19, 21, and 22 are "directed to" an abstract idea, and do not recite an "inventive concept." Accordingly, we sustain the Examiner's rejection of claims 1–4, 6–19, 21, and 22 under 35 U.S.C. § 101.

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[7] A specification demonstrates the well-understood, routine, conventional nature of additional elements when it describes the additional elements as well-understood or routine or conventional (or an equivalent term), as a commercially available product, or in a manner that indicates that the additional elements are sufficiently well-known that the specification does not need to describe the particulars of such additional elements to satisfy 35 U.S.C. § 112(a). Memorandum on *Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision* (*Berkheimer v. HP, Inc.*) (Apr. 19, 2018) available at: https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF

35 U.S.C. § 103 REJECTION

In rejecting claim 1, the Examiner finds Lim discloses all the recited elements of the claim, but not "the application selection order" and "meshing the user preference order and the application selection order to identify among the languages that are associated with at [least] one resource of the resource set," for which the Examiner relies on Reitan. *See* Final Act. 10–13. The Examiner finds Reitan teaches "the application selection order" as the process for selecting a target language in paragraphs 9, 19, 26, and 33. Non-Final Act. 14. The Examiner further finds Reitan discloses:

> [M]eshing the user preference order and the application selection order to identify among the languages that are associated with at [least] one resource of the resource set, a selected language (¶ 0026 lines 3–-6: "the system may automatically select" (meshing) "the target language using a browser language setting" (application selection order with) "user profile information" (user's preferred language or his preference order because according to ¶ 0015 line 8 "user's" "profile" "determines the selected language"); ¶ 0041: "In some implementations, the caption translation system receives the target language from a browser query string. In some cases, users may wish to override" (meshing) "their browser's language setting" (application selection order) "and receive captions" (associated with a resource) "in another language" (with a user "language" (i.e. user preference order)) "The system can provide a user interface control or other interface for allowing the user to select another language" (selected by the user)).

Non-final Act. 14.

Appellant contends the Examiner's rejection is in error because Lim and Reitan are unrelated to the specific problem the claimed invention

solves: "*i.e.*, conflicts arising between different sources of information about the selection of resources." Appeal Br. 30. Appellant also argues:

> However, nothing in these portions of Reitan - nor elsewhere in Reitan – is provided a discussion of meshing a user selection order and an application selection order to select a language based on both sources of information. Rather, these portions of Reitan merely indicate that **in different cases**, a device may receive the selection from different sources. Nothing in these portions indicates that the device may concurrently receive such selection from different sources - let alone that such selections may conflict - let alone that meshing together such different orders, based on calculated weights, may enable a selection that addresses the conflict.

Appeal Br. 34. According to Appellant, "'overriding' implies that the selection has been made without meshing - *i.e.*, the operating system selects a language based solely on the browser setting - and the user subsequently chooses to override the browser setting." Reply Br. 17.[8]

Based on our review of Reitan, we are persuaded by Appellant's contention that the Examiner has not explained how overriding a selection by the user meets the disputed claim limitation. We disagree with the Examiner that the alternative language in paragraph 26 of Reitan, as manifested by using "[t]he operator 'or' implies that 'target language' 'select[ion]' is allowed to use a combination (meshing) of the "browser language setting" (application selection order) as well as 'user profile information' (user preference order)." Ans. 15. The cited portion of Reitan discloses "[t]he system may automatically select the target language using a browser language setting, user profile information, source Internet Protocol

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[8] We do not address Appellant's other contentions because this contention is dispositive of the issue on appeal.

(IP) address of the received request, or any other information." Reitan ¶ 26. It is not apparent, and the Examiner does not clearly explain, how selecting the target language based on alternate settings/information would teach or suggest combining those settings or the recited "meshing the user preference order and the application selection." Reply Br. 17.

Therefore, Appellant's arguments have persuaded us of error in the Examiner's position with respect to the rejection of claim 1, and independent claims 19 and 21 which recite similar limitations. The Examiner has not identified any teachings in the other applied prior art that would cure the deficiency of the combination of Lim and Reitan. We, therefore, do not sustain the rejection of claims 1, 19, and 21, as well as claims 2–4, 6–18, and 22, dependent therefrom.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–4, 6–19, 21, 22	101	Eligibility	1–4, 6–19, 21, 22	
1–4, 6–8, 10–14, 17–19, 21, 22	103	Lim, Reitan		1–4, 6–8, 10–14, 17–19, 21, 22
9	103	Lim, Reitan, Etzioni		9
15, 16	103	Lim, Reitan, Gupta		15, 16
Overall Outcome			1–4, 6–19, 21, 22	

TIME PERIOD FOR RESPONSE

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