UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/847,589	07/30/2010	John W. Alcorn	AUS920100166US1	4220

87220 7590 02/03/2020

Walder Intellectual Property Law (END)
C/O Walder Intellectual Property Law, P.C.
1701 N. Collins Blvd.
Suite 2100
Richardson, TX 75080

EXAMINER	
GURSKI, AMANDA KAREN	

ART UNIT	PAPER NUMBER
3623	

MAIL DATE	DELIVERY MODE
02/03/2020	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

Ex parte JOHN W. ALCORN and JOACHIM H. FRANK

_____

Appeal 2018-004759
Application 12/847,589
Technology Center 3600

_____

Before ANTON W. FETTING, MICHAEL C. ASTORINO, and TARA L. HUTCHINGS, *Administrative Patent Judges*.

HUTCHINGS, *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 1–21. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

[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 July 3, 2017) and Reply Brief ("Reply Br.," filed Apr. 2, 2018), and the Examiner's Answer ("Ans.," mailed Feb. 5, 2018) and Final Office Action ("Final Act.," mailed Mar. 3, 2017). Appellant identifies International Business Machines Corporation as the real party in interest. Appeal Br. 2.

CLAIMED INVENTION

Appellant's claimed invention "relates generally to an improved data processing apparatus and method and more specifically to mechanisms for providing self-extending monitoring models that learn based on the arrival of new data." Spec. ¶ 1.

Claims 1 and 15 are the independent claims on appeal. Claim 1, reproduced below with bracketed notations added, is illustrative of the claimed subject matter:

> 1. A method, in a computing system, for monitoring a process executing on a data processing system, comprising:
>
> [(a)] receiving, in the computing system, a notification of an event comprising information regarding the event and identifying a process executing in the data processing system that generated the event;
>
> [(b)] determining, by the computing system, whether one or more key performance indicators (KPIs) have been defined, for an element corresponding to the process identified in the notification, in a model of the data processing system;
>
> [(c)] in response to determining that one or more KPIs have not been defined for the element in the model corresponding to the process, automatically generating, by a model extension engine executing in the computing system, new KPI definitions for the element in the model corresponding to the process, based on default KPIs specified in the computing system, wherein the new KPI definitions constitute an extension of the model of the data processing system to thereby generate an extended model of the data processing system; and
>
> [(d)] monitoring, by a system monitor executing in the computing system, the system monitor being specifically configured to implement the extended model of the data processing system, an operation of the data processing system based on the extended model of the data processing system.

REJECTION

Claims 1–21 are rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.

ANALYSIS

Appellant argues the independent claims 1 and 15 together. Appeal Br. 4–28. We select independent claim 1 as representative. Claim 15 stands or falls 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 claims under 35 U.S.C. § 101, the Examiner determined that the claims recite steps for "receving event notification, determining whether key performance indicators ["KPIs"] have been defined corresponding to the notification, generating new KPI definitions constituting an extension of the model . . . , and monitoring an operation based on the extended model." Final Act. 4–5. Therefore, the Examiner found that the claims recite steps that could be performed by a human mentally and/or with pen and paper for extending models through key performance indicators. *Id.* at 5 ("A user can create and extend models and also define key performance indicators with only pen to paper actions and/or mental calculation."). The Examiner, thus, found that the claims recite a mental process, which is an abstract idea. *Id.* The Examiner also determined that these claims do not include additional elements that are sufficient to amount to more than the judicial exception. *Id.* at 5–6.

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. That guidance "extracts and synthesizes key concepts identified by the courts as abstract ideas to explain that the abstract idea exception includes" the following three groupings: (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 PATENT SUBJECT

MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50, 52 (Jan. 7, 2019) (the "Revised Guidance").

Under the Revised Guidance, in determining whether a claim is patent-eligible, we first look to whether the claim recites a judicial exception, including one of the enumerated groupings of abstract ideas ("Step 2A, Prong One"). *Id.* 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., apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim 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 then look to whether the claim "[a]dds a specific limitation or combination of limitations" that is not "well-understood, routine, conventional activity in the field" or simply "appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception" ("Step 2B"). *Id.* at 56.

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

We are not persuaded by Appellant's argument that the Examiner oversimplified the claimed invention, improperly expanded the scope of the claims to include an abstract idea, or otherwise erred in determining that claim 1 recites an abstract idea. Appeal Br. 5–10; *see also id.* at 18–19 (arguing that, even though it is a limitation of claim 1, claim 1 is not directed

to extending a model with KPIs; but instead, monitors an operation of the data processing system based on the extended model of the data processing system).

Appellant's Specification is titled "SELF-EXTENDING MONITORING MODELS THAT LEARN BASED ON ARRIVAL OF NEW DATA," and states that the disclosure relates, in particular, "to mechanisms for providing self-extending monitoring models that learn based on the arrival of new data." Spec. ¶ 1. The Background section describes that, for some time now, business decision makers have used key performance indicator ("KPI") applications to monitor the health of their business. *Id.* ¶ 4. These applications retrieve specific data to calculate a KPI value, and display the calculated KPI value, a threshold associated with the KPI, and a graphical indication of performance based on a comparison of the KPI value and threshold. *Id.* Known KPI applications, however, require selection of KPIs to monitor, and knowledge of the relevant database schema required to gather the data needed to calculate the KPI values. *Id.* ¶ 5.

The process of customizing the KPI application for monitoring employee productivity and managing operations is costly and time consuming. *See id.* ¶¶ 15–16. A business would prefer an alternative approach that does not require customized monitoring models for each business process, and that has the ability to customize the monitoring model to see important business measures at the necessary level of detail without the need for IT professionals. *Id.* ¶ 17. To remedy this problem, Appellant's invention provides a self-extending monitoring model that learns based on the arrival of new data. *Id.* ¶ 18. A generic monitoring model that is not customized, in response to an event, extends the model's defined KPI for a

particular process, such as a loan approval process. *Id.* The extension is through an analysis of the event that could be automatic, semi-automatic, or manual. *Id.*

Consistent with this disclosure, claim 1 recites a method for monitoring a process on a data processing system by: (1) receiving an event notification, i.e. "receiving . . . a notification of an event comprising information regarding the event and identifying a process . . . that generated the event" (step (a)); (2) determining whether one or more KPIs have been defined for an element corresponding to the identified process, i.e., "determining . . . whether one or more key performance indicators (KPIs) have been defined, for an element corresponding to the process identified in the notification, in a model . . . ." (step (b)); (3) generating new KPI definitions for the element based on default KPIs, i.e.,

> in response to determining that one or more KPIs have not been defined for the element in the model corresponding to the process, . . . generating . . . new KPI definitions for the element in the model corresponding to the process, based on default KPIs. . . , wherein the new KPI definitions constitute an extension of the model . . . to thereby generate an extended model . . .

(step (c)); and (4) monitoring an operation based on the extended model, i.e., "monitoring . . . an operation . . . based on the extended model . . . ." (step (d)). These limitations, given their broadest reasonable interpretation, recite steps for generating an extended model and monitoring an operation based on the extended model. Although claim 1 recites that the steps are performed by a "computing system," the underlying steps recited in the claim are all acts that, as the Examiner observes (*see* Final Act. 5), could be performed by a human mentally or manually, using pen and paper, without the use of a computer or any other machine. For example, a person could

receive a notification of an event comprising information regarding the event and identifying a process that generated the event, and determine whether one of more KPIs have been defined for the element corresponding to the process. Upon determining that KPIs have not been defined, the user could perform calculations in his or her head or using pen and paper, and create new KPI definitions for the element in the model corresponding to the process to generate an extended model. The user could then monitor an operation based on the extended model. Simply put, claim 1 recites a concept, including an observation, evaluation, or judgment, that can be performed in the human mind, which is a mental process and, therefore, an abstract idea. *See* Revised Guidance, 84 Fed. Reg. at 52. *See also CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) (holding that method steps that can be performed in the human mind, or by a human using a pen and paper, are unpatentable mental processes).

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

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).

Beyond the abstract idea, claim 1 recites a "computer system," a "data processing system," a "model extension engine" that executes step (c) in the computer system, and a "system monitor" that executes step (d) in the computer system and is configured to implement the extended model of the data processing system. But these elements are described in the

Specification at a high level of generality, i.e., as a generic computer components. *See, e.g.*, Spec. ¶¶ 26, 43, 67.

Appellant argues that generic computers cannot perform the steps recited in claim 1. *See* Appeal Br. 10–17; *see, e.g.*, *id.* at 11 ("[t]hese operations are clearly not generic computing functions as generic computers do not perform such evaluations of a model of a data processing system"), 13 ("one cannot simply buy a computer at the local computer store, plug it in, and it would miraculously perform the operations recited in the present claims"). However, contrary to Appellant's suggestion, the question is not whether the claim uses a computer in its ordinary capacity to implement the abstract idea. Instead, the Federal Circuit has explained that the question is "whether the focus of the claim[] is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an 'abstract idea' for which computers are invoked merely as a tool." *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, 1335–36 (Fed. Cir. 2015)).

Here, we find no indication in the Specification, nor do Appellant direct us to any indication, that the operations recited in claim 1 invoke any assertedly inventive programming, require any specialized computer hardware or other inventive computer components, i.e., a particular machine, or that the claimed invention is implemented using other than generic computer components to perform generic computer functions (e.g., receiving data (step (a)), and processing data (steps (b)–(d))). And "after *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible." *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014).

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 that attributes an improvement in computer 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 Revised Guidance.[2]

Appellant argues that

> [t]he claims and the present specification clearly demonstrate the invention to be an improvement in computer technology directed to the manner by which a computer system may monitor a process executing on a data processing system and specifically when KPIs are not defined, in a model of the data processing system, for an element of the data processing system that generates an event received by the computing system.

Appeal Br. 19; *see also id.* at 19–20 ("[c]learly[,] the focus of the claimed improvement is directed to an improvement in computer technology with regard to the monitoring of a process executing on a data processing system"), 22 ("[c]learly, the present claims effect an improvement in the technological field of monitoring process execution of a data processing system" that "eliminates the need for manual intervention and provides

[2] The Revised Guidance references the MANUAL OF PATENT EXAMINING PROCEDURE ("MPEP") §§ 2106.05(a)–(c) and (e)–(h) 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. 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.

customizability through a self-extending mechanism that was previously not available prior to the claimed invention").

Yet, no "improvement in computer technology" is apparent in claim 1. Although claim 1 recites "generating . . . new KPI definitions for the element in the model corresponding to the process . . . to thereby generate an extended model of the data processing system" (step (c)) and "monitoring . . . an operation of the data processing system based on the extended model of the data processing system" (step (d)), the claim provides no technical details for achieving those results. For example, claim 1 does not specify *how to* generate "new KPI definitions for the element in the model corresponding to the process based on default KPIs," or *how to* monitor "an operation of the data processing system based on the extended model of the data processing system." Instead, "the claim language here provides only a result-oriented solution with insufficient detail for how a computer accomplishes it. Our law demands more." *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1342 (Fed. Cir. 2017).

We also are not persuaded by Appellant's argument that claim 1 "solves the problems associated with the monitoring processes executing in a data processing system" by performing the steps recited in claim 1. *See* Appeal Br. 22. Specifically, Appellant contends that "the present specification clearly sets forth numerous improvements made by the claimed invention with regard to the automatic extension of the monitoring capabilities of the system monitor as information about the data processing system learned through the generation of events by elements of the data processing system." *Id.* Appellant concludes an application of *Enfish* would lead to a determination that the present claims are not directed to an abstract idea. *Id.*

Appellant's Specification may well identify purported benefits of and/or problems purportedly overcome by Appellant's invention. *See, e.g.*, Spec. ¶¶ 16–18. However, as indicated above, limitations (a)–(d) of claim 1 each recites results-based-functional language without providing sufficient technological detail for how to achieve the desired result. For example, limitation (c) recites "automatically generating" and limitation (d) recites "monitoring" but no particular manner of generating or monitoring is recited that would indicate an improvement to technology. The same holds true for the other recited limitations.

We do not see a parallel between Appellant's claim 1 and the claims at issue in *Enfish*. In *Enfish*, the Federal Circuit rejected a § 101 challenge at the step one stage of the *Mayo*/*Alice* analysis because the claims at issue focused on "a specific type of data structure [i.e., a self-referential table for a computer database] designed to improve the way a computer stores and retrieves data in memory." *Enfish*, 822 F.3d at 1339. There, a representative claim recited a data storage and retrieval system for a computer memory having a means for configuring a memory according to a logical table that included rows, columns, and a means for indexing data. *Id.* at 1336. The means for configuring required a four-step algorithm, and the third step of that algorithm (i.e., "[f]or each column, store information about the column in one or more rows"), rendered the table self-referential. *Id.* The court noted that the specification identified additional benefits conferred by the self-referential table (e.g., increased flexibility, faster search times, and smaller memory requirements), which further supported the court's conclusion that the claims were directed to an improvement of an existing technology. *Id.* at 1337 (citation omitted).

Here, in contrast, Appellant's claim 1 does not focus on a particular data structure analogous to *Enfish*'s self-referential table. Claim 1 also does not focus on an improvement to technology in generating an extended model and/or monitoring techniques — at least because claim 1 covers any manner of generating and montoring that achieves the result-based functional limitations. Instead, claim 1 focuses on the abstract idea itself (i.e., a mental process) that is implemented using generic computers in their ordinary capacity.

Appellant argues that claim 1 is similar to the claims held patent eligible in *McRO, Inc. v. Bandai Namco Games America, Inc.*, 837 F.3d 1299 (Fed. Cir. 2016). Appeal Br. 23–24. In particular, Appellant asserts that claim 1 automates a significant part of a monitoring process and automatically extends its knowledge of the system being monitored. *Id.* at 23. Appellant asserts these techniques are different from those that previously have been produced manually. *Id.* However, the Federal Circuit in *McRO* did not find the claims at issue to be patent-eligible merely because a process was automated, and the automated process differed from the manual process.

Instead, in *McRO* the claims at issue used "rules to automatically set a keyframe at the correct point to depict more realistic speech, achieving results similar to those previously achieved manually by animators." *McRO*, 837 F.3d at 1307. These rules "allow[ed] computers to produce 'accurate and realistic lip synchronization and facial expressions in animated' characters that previously could only be produced by human[s]" (*id.* at 1313 (citation omitted), effecting an improvement to technology in 3-D animation techniques (*id.* at 1316). We do not see any parallel between the rules described in *McRO* that result in an improvement to technology in 3-D

animation technniques, and the result-based, functional limitations recited in Appellant's claim 1.

We also are not persuaded of Examiner error by Appellant's argument regarding preemption. Appeal Br. 9–10. There is no dispute that the Supreme Court has described "the concern that drives [the exclusion of abstract ideas from patent-eligible subject matter] as one of pre-emption." *Alice Corp.*, 573 U.S. at 216. Yet, characterizing preemption as a driving concern for patent eligibility is not the same as characterizing preemption as the sole test for patent eligibility. "The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability" and "[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis." *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice Corp.*, 573 U.S. at 216). "[P]reemption may signal patent ineligible subject matter [but] the absence of complete preemption does not demonstrate patent eligibility." *Id.*

We find nothing 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 Revised Guidance. *See* Revised Guidance, 84 Fed. Reg. at 55. At best, the additional elements recited in claim 1, considered individually and as an

ordered combination, do no more than implement the abstract idea using generic computer components.

Accordingly, we are not persuaded that the Examiner erred in determining that claim 1 is directed to an abstract idea.

Step Two of the Mayo/Alice Framework (*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 Revised Guidance, the second step of the *Mayo*/*Alice* framework, whether claim 1 adds any additional element or combination of elements that provides an "inventive concept," i.e., whether the additional elements amount to "significantly more" than the judicial exception itself or simply appends well-understood, routine, conventional activities previously known to the industry to the judicial exception. Revised Guidance, 84 Fed. Reg. at 56.

Appellant argues that claim 1 recites additional element that demonstrate that Appellant is claiming significantly more than the abstract idea. *See* Appeal Br. 25–27. Specifically, Appellant identifies a "computing system . . . identifying a process executing in the data processing processing system" (step (a)); "computing system . . . a model of the data processing system" (step (b)); "the model corresponding to the process, automatically generating by a model extension engine executing in the computing system . . . an extension of the model of the data processing system to thereby generate an extended model of the data processing system" (step (c)); and "monitoring, by a system monitor executing in the computing system, the system monitor being specifically configured to implement the extended model of the data processing system, an operation of the data processing

system based on the extended model of the data processing system" (step (d)) as the additional elements. *Id.* at 25.

Appellant contends that these additional elements indicate a "specific ordered combination of operations performed in a specific computing environment and which involve multiple systems in that computer environment, i.e., a computing system and a data processing system." *Id.* at 25–26. For example, Appellant contends that the claimed monitoring of step (d) is "based on a specific configuration of the system monitor, i.e., a specific configuration to implement an extended model of the data processing system." *Id.* at 26. Appellant also disputes that the claimed operations are generic computer functions performed by a generic computer, at least because they require a specially configured computing system to perform the operations. *Id.* Appellant further argues that claim 1 modifies the computing system itself by generating new KPI definitions to extend the model of the data processing system. *Id.*

Appellant's arguments are unpersuasive, at least because Appellant identifies elements that are part of the abstract idea itself 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 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." *BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018) (internal citation omitted).

As described above, the claim elements beyond the abstract idea include a "computer system," a "data processing system," a "model extension engine" that executes step (c) in the computer system, and a

"system monitor" that executes step (d) in the computer system and is configured to implement the extended model of the data processing system. But these elements are described in the Specification at a high level of generality, i.e., as a generic computer components used to perform generic computer functions (e.g., receiving and processing data). *See, e.g.*, Spec. ¶¶ 26, 43, 67. 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 v. HP, Inc.*, 890 F.3d 1369, 1373 (Fed. Cir. 2018) (Moore, J., concurring) (citations omitted); *see also BSG Tech. LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1291 (Fed. Cir. 2018) ("BSG Tech does not argue that other, non-abstract features of the claimed inventions, alone or in combination, are not well-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.").

Citing the Federal Circuit's holding, in *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), that an inventive concept can be found in the non-conventional and non-generic arrangement of known conventional pieces, Appellant argues that even if claim 1 is directed to an abstract idea, the claim is nonetheless patent eligible because it includes significantly more than an abstract idea. Appeal Br. 27–28. Appellant asserts that claim 1 recites "an ordered combination of elements that set[s] forth a technology-based solution to a computer-based problem, namely the monitoring of the extension of a process in a data processing system or the operation of the data processing system by way of a

self-extending system monitor." *Id.* at 28. And Appellant argues that "[t]his technology based solution rooted in computer technology involves the ordered combination of operations discussed above which specifically address problems associated with manual human based KPI generation as well as overly generic general global systems." *Id.* Appellant's argument is not persuasive.

In *BASCOM*, the Federal Circuit determined that the claimed installation of a filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each end user provided an inventive concept in that it gave the filtering tool both the benefits of a filter on a local computer and the benefits of a filter on the ISP server. *BASCOM*, 827 F.3d at 1350. The court, thus, held that the second step of the *Mayo*/*Alice* framework was satisfied because the claimed invention "represents a 'software-based invention[ ] that improve[s] the performance of the computer system itself.'" *Id.* at 1351 (stating that like *DDR Holdings*, where the patent "claimed a technical solution to a problem unique to the Internet," the patent in *BASCOM* claimed a "technology-based solution . . . to filter content on the Internet that overcomes existing problems with other Internet filtering systems . . . making it more dynamic and efficient") (internal citations omitted). Here, we do not find in Appellant's claim 1 any analogous "non-conventional and non-generic arrangement" of generic or conventional pieces that results in a technology-based solution.

Appellant argues that the reversal of a rejection under 35 U.S.C. § 103 in a prior appeal demonstrates that the nature of the operations recited in claim 1 are not well-known or routine. Appeal Br. 17. Yet, the operations recited in claim 1, as set forth above, are part of the abstract idea. 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 (alteration in original). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90.

Here, Appellant has not identified, and we do not find, any additional elements recited in claim 1 that, individually or in combination, provide significantly more than the abstract idea. Instead, the additional elements recite generic computer elements for executing the abstract idea.

We are not persuaded, on the present record, that the Examiner erred in rejecting independent claim 1 and dependent claims 2, 4, 5, 7–9, 11, 12, and 14 under 35 U.S.C. § 101. We also are not persuaded that the Examiner erred in rejecting independent claim 15, which falls with claim 1, and dependent claims 16, 18, 19, and 21 under 35 U.S.C. § 101.

With respect to dependent claims 3, 10, and 17, Appellant asserts that the additional limitations recited in these claims "cannot be generic computer functions." Appeal Br. 29. And with respect to dependent claims 6, 13, and 20, Appellant asserts that these limitations "further tie the claimed invention to a specific computing environment and further illustrate that Appellant[] [is] not claiming the abstract idea." *Id.* However, these steps further describe the abstract idea with additional results-based functional limitations for receiving and processing data. Therefore, we are not persuaded that the Examiner erred in rejecting dependent claims 3, 6, 10, 13, 17, and 20 under 35 U.S.C. § 101.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1–21	101	Eligibility	1–21	

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