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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TOLGA ORAL and ANDREW L. SCHIRMER

Appeal 2018-006769
Application 12/141,435[1]
Technology Center 3600

Before MURRIEL E. CRAWFORD, MICHAEL C. ASTORINO, and TARA L. HUTCHINGS, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant[1] filed a Request for Rehearing ("Req. Reh'g"), pursuant to 37 C.F.R. § 41.52, on August 27, 2020, seeking reconsideration of our Decision on Appeal mailed June 29, 2020 ("Decision"), in which we affirmed the Examiner's rejection of claims 21–40 under 35 U.S.C. § 101 as directed to an abstract idea without significantly more. We have jurisdiction over the Request under 35 U.S.C. § 6(b).

We note at the outset that a Request for Rehearing "must state with particularity the points believed to have been misapprehended or overlooked

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[1] According to Appellant's, the real party in interest is IBM Corporation Appeal Br. 1.

by the Board." 37 C.F.R. § 41.52(a). A Request for Rehearing is not an opportunity to rehash arguments raised in the Appeal Brief or in the Reply Brief. Neither is it an opportunity to merely express disagreement with a decision without setting forth points believed to have been misapprehended or overlooked. Arguments not raised in the briefs before the Board and evidence not previously relied on in the briefs also are not permitted except in the limited circumstances set forth in §§ 41.52(a)(2) through (a)(4). *Id.*

DISCUSSION

To recap, in the Decision, we determined under Step 2A, Prong One of the *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50, 50–57 (Jan. 7, 2019) ("Guidance") that the claims are directed to collecting and analyzing information and therefore the claims recite a judicial exception. Decision 5. Turning to Prong Two of Step 2A of the Guidance, we found, that the additional elements include a "computer hardware system." *Id.* We concluded that the computer hardware system, considered alone and as part of a combination, is no more than a generic computer system operating in its ordinary capacity to implement the abstract idea. *Id.* at 6.

Turning to Step 2B, we considered whether any additional elements, alone and as part of a combination, are not well-understood, routine, conventional activity in the field and, thus, indicative of an inventive concept. We decided that the recited computer hardware system was well-understood, routine and conventional. Dec. 7–9. We concluded that the claims recite an abstract idea without significantly more. Dec. 12.

Appellant argues that the Examiner did not perform an integration analysis to find whether the claims are integrated into a practical application pursuant to Prong Two of the Guidance. Appellant argues that the ultimate criteria as to whether new grounds should be designated in the decision by the Board is whether Appellant had a fair opportunity to react to the thrust of the rejection. Appellant argues that they have not been afforded this opportunity. Req. Reh. 7.

As an initial matter, the Revised Guidance does not reflect any change in law regarding subject matter eligibility. *See* Revised Guidance, 84 Fed. Reg. at 51 ("This guidance does not constitute substantive rulemaking and does not have the force and effect of law."); *see also id.* ("Rejections will continue to be based upon the substantive law[.]"). Instead, it "sets out agency policy with respect to the USPTO's interpretation of the subject matter eligibility requirements of 35 U.S.C. § 101 in view of decisions by the Supreme Court and the Federal Circuit." *Id.* ("Failure of USPTO personnel to follow the guidance . . . is not, in itself, a proper basis for either an appeal or a petition.").

Nonetheless, we designate our affirmance of the rejection under 35 U.S.C. § 101 as a new ground of rejection. 37 C.F.R. § 41.50(b). Our analysis in the Decision, and findings of the record related thereto, are hereby adopted for this new ground of rejection.

CONCLUSION

The Appellant's Request for Rehearing is GRANTED.

Outcoe of Decision on Rehearing:

Claims	35 U.S.C §	Reference(s)/Basis	Denied	Granted
21–40	101	Eligibility		21–40

Final Outcome of Appeal after Rehearing:

Claims	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
21–40	101	Eligibility	21–40	

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection under 37 C.F.R. § 41.50(b) which provides that a new ground of rejection "shall not be considered final for judicial review." WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, the Appellant must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the prosecution will be remanded to the Examiner;

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record.

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) (2014).

REHEARING GRANTED