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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SANDEEP TIWARI and SU-MING WU

Appeal 2018-006857
Application 14/070,871
Technology Center 3600

Before ERIC S. FRAHM, JENNIFER L. McKEOWN, and MICHAEL T. CYGAN, *Administrative Patent Judges.*

McKEOWN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Pursuant to 37 C.F.R. § 41.52, Appellant[1] requests rehearing of our Decision dated August 02, 2019 ("Decision"), where we affirmed the Examiner's decision to reject claims 1–5, 7–13, and 15–22 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Request for Rehearing, dated September 30, 2019 ("Request"). We have reconsidered the Decision in light of Appellant's comments in the Request and, for the reasons noted below, we deny the request to modify our Decision.

Appellant requests reconsideration in view of the recent Decision *Ex*

[1] We use the word Appellant to refer to "applicant" as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Oracle International Corporation. Appeal Br. 2.

parte Smith[2] and on the basis that the Decision does not sufficiently provide evidence as required by *Berkheimer*.[3] Request 2–5. In particular, Appellant explains *Smith* found that the additional limitation, which limited the conventional practice of automatically executing matching orders by including a timing mechanism to delay execution, integrated the exception into a practical application. Request 2. According to Appellant, the present case is similar in that the claimed invention includes "novel functionality for estimating attribute weights to overcome the problems in the prior art and therefore beyond the conventional functionality to integrate any alleged judicial exception into a practical application." Request 3.

We find this argument unpersuasive. Notably, the alleged novel estimating step explicitly recites a calculation using a mathematical formula. As such, this limitation recites *mathematical concepts*, which constitute an abstract idea. *See, e.g.*, October 2019 Update: Subject Matter Eligibility 3–4, available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf; *Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266 (Fed. Cir. 2012). Appellant draws an analogy to the technological improvement described in *Ex Parte Smith*. Request 3. However, although Appellant characterizes the claimed invention as "reciting novel functionality for estimating attribute weights to overcome the problems in the prior art," Appellant does not explain how the claimed elements additional to the abstract idea provide a technological improvement. *Id.* While the claimed method may be an improved

[2] Appeal 2018-000064 (PTAB Feb. 1 2019) (designated: Mar. 19, 2019) (applying 2019 Revised Patentable Subject Matter Eligibility Guidance).
[3] *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018).

mathematical calculation, this is merely an improved abstract idea, not a technological improvement. *See also* Spec. ¶ 12 (describing the claimed invention addresses "is critical to many business processes."); Spec. ¶¶ 13–14 (discussing that the claimed item to item similarity may be used in various business for demand transference and optical product pricing analysis). As such, we determine that the additional limitations, alone or in combination, do not integrate the judicial exception into a practical application.

We similarly disagree that the Examiner fails to provide sufficient evidence that the additional limitations are well understood, routine, and conventional. *See* Request 4. As noted in the Decision, in addition to the recited judicial exception, the claimed invention includes a processor, "receiving attribute values for each product in the category and product-store-week sales units for each product in the category," and "providing the item-to-item similarity as an input to generate a Consumer Decision Tree (CDT), wherein the CDT provides a visual representation of a tree for the category indicating consumer choices for the category." Decision 8. In other words, the claimed invention additionally recites a processor, receiving values, and generating or displaying a visual representation of a consumer decision tree or results.

The Examiner, in particular, identifies Specification paragraphs 16 through 19 as factual support that the claimed additional limitations are generic and conventional. *See* Ans. 6 (noting that the claimed invention "simply use a computer for doing algorithms for behavioral modelling which, as applicant's own specification discussed in para [0016]-[0019], is accomplished by generic and conventional functionality."); *see also* Spec ¶

17 ("Processor 22 may be any type of general or specific purpose processor."); Spec. ¶ 19 ("Processor 22 is further coupled via bus 12 to a display 24, such as a Liquid Crystal Display ('LCD'."). The Examiner additionally cites MPEP § 2106.05 to show "similar examples of technology that were considered conventional by the courts as evidence that appellant's claims do not have elements that are significantly more than the abstract idea." Ans. 6; *see also* MPEP § 2106.05(d) (noting that courts have found certain activities as well understood, routine, and conventional, including receiving or transmitting data over a network, to perform repetitive calculations, electronic recordkeeping, and storing and retrieving information in memory).

Moreover, as discussed in the Decision, the steps of receiving data, such as receiving attribute values, and displaying processed data, such as generating the consumer decision tree, are insignificant extra-solution activity. Decision 9; *see also, e.g.*, Ans. 5 ("At best, this 'wherein' clause is an output of a mathematical relationship which is common in calculus and algebra and also just extra solution activity for the abstract idea of similarity analysis."). The claimed invention receives, processes, and displays data – this is merely conventional data gathering and analysis. *See buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) ("That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive."); *In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 614 (Fed. Cir. 2016) (server that receives data, extracts classification information from the received data, and stores the digital images insufficient to add an inventive concept); *Alice*, 573 U.S. at 225–26 (receiving, storing, sending information over networks insufficient

to add an inventive concept); *OIP Techs., Inc., v. Amazon.com, Inc.*, 788 F.3d 1359, 1363-4 (Fed. Cir. 2015) (noting that gathering statistics and presenting results to a customer "are well-understood, routine, conventional data-gathering activities that do not make the claims patent eligible."); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (stating that "merely selecting information, by content or source, for collection, analysis, and display does nothing significant to differentiate a process from" ineligible subject matter).

Appellant does not persuasively identify any error in the Examiner's determination. Moreover, relying on the Specification and prior Federal Circuit cases is wholly consistent with *Berkheimer* and the *Berkheimer* memorandum.[4] *See also* MPEP § 2106.05(d)(II). As such, while we have considered the arguments raised by Appellant in the Request, we find them not persuasive to identify error in the original Decision. Based on the record before us now and in the original appeal, we are still of the view that the Examiner did not err in rejecting claims 1–5, 7–13, and 15–22 as being directed to patent-ineligible subject matter.

REHEARING DENIED

[4] USPTO Memorandum, Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (Berkheimer v. HP, Inc.), 3–4 (April 19, 2018), available at https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF