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Hickman Palermo Becker Bingham /LinkedIn/Microsoft
1 Almaden Boulevard, Floor 12
San Jose, CA 95113

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES DUNCAN WORK,
ALLEN J. BLUE, and REID HOFFMAN

Appeal 2018-007229
Application 14/675,723
Technology Center 3600

Before HUBERT C. LORIN, NINA L. MEDLOCK, and CHARLES J. BOUDREAU, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

James Duncan Work, et al. (Appellant)[1] seeks our review under 35 U.S.C. § 134(a) of the Examiner's decision to reject claims 1–20, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM-IN-PART.

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[1] The Appellant identifies Microsoft Corporation as the real party in interest. Appeal Br. 2.

THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

> 1. A computer-implemented method for *matching a plurality of results to a search request and sorting the plurality of results based on determinations of diversity scores representing diversities of networks of a plurality of target members, the diversity scores being usable as components for determining authenticities of profiles of the plurality of target members*, the method comprising:
>
> [1] *storing a plurality of relationships between a plurality of members of a social network, the plurality of members including a searching member and the plurality of target members*;
>
> [2] *receiving the search request, the search request initiated on behalf of the searching member*;
>
> [3] *processing the search request to identify the plurality of results, the plurality of results including profiles of the plurality of target members*;
>
> [4] *analyzing the plurality of relationships to determine the diversity scores representing the diversities of the networks of the plurality of target members*; and
>
> [5] *sorting the plurality of results for providing to the searching member based on the diversity scores*, one or more modules incorporated into a networked system to configure one or more processors of the networked system to perform the storing, receiving, processing, analyzing, and sorting.

THE REJECTION

The following rejection is before us for review:

Claims 1–20 are rejected under 35 U.S.C. § 101 as claiming patent-ineligible subject matter.

ISSUE

Did the Examiner err in rejecting claims 1–20 under 35 U.S.C. § 101 as claiming patent-ineligible subject matter?

ANALYSIS

The rejection of claims 1–20 under 35 U.S.C. § 101 as claiming patent-ineligible subject matter.

Independent claims 1 and 8, and dependent claims 2–7 and 9–14

Representative claim

Our discussion will focus on independent claim 1, as the Appellant relies on the same arguments for independent claim 8. *See, e.g.*, Appeal Br. 19–21. The Appeal Brief separately argues dependent claims 2–7 and 9–14. Appeal Br. 30–32. We will address those arguments after we discuss the merits of the rejection as it relates to the subject matter covered by claim 1.

Preliminary comment

In the briefs, the Appellant refers to prior USPTO guidance. *See, e.g.*, Appeal Br. 10–11 ("2014 Interim Guidance on [Patent] Subject Matter Eligibility [2014 Interim Guidance on Patent Subject Matter Eligibility, 79 Fed. Reg. 74,618–633 (Dec. 16, 2014)]"); *id.* at 19–22 ("Quick Reference Sheet of the July 2015 Update"). Said guidance has been superseded by the 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (hereinafter "2019 Revised 101 Guidance"). *Id.* 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, our analysis will not address the sufficiency of the Examiner's rejection against the cited prior guidance. Rather, our analysis will comport with the 2019 Revised 101 Guidance.

Introduction

35 U.S.C. § 101 provides that "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor."

In that regard, claim 1 covers a "process" and is, thus, statutory subject matter for which a patent may be obtained.[2] This is not in dispute.

However, the § 101 provision "contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable." *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014) (*quoting Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

In that regard, notwithstanding claim 1 covers statutory subject matter, the Examiner has raised a question of patent-eligibility on the ground that claim 1 is directed to an abstract idea. Eligibility is a question of law based on underlying facts. *SAP Am., Inc. v. InvestPic, LLC*, 890 F.3d 1016, 1020 (Fed. Cir. 2018).

[2] This corresponds to Step 1 of the 2019 Revised 101 Guidance, which requires determining whether a "claim is to a statutory category." 2019 Revised 101 Guidance, 84 Fed. Reg. at 53; *see also id.* at 53–54 ("[C]onsider[] whether the claimed subject matter falls within the four statutory categories of patentable subject matter identified by 35 U.S.C. [§] 101 . . . .").

Alice identifies a two-step framework for determining whether claimed subject matter is directed to an abstract idea. *Alice*, 573 U.S. at 217.

Alice step one – the "directed to" inquiry

According to *Alice* step one, "[w]e must first determine whether the claims at issue are *directed to* a patent-ineligible concept." *Id.* at 218 (emphasis added).

The Examiner determined that claim 1 is "directed to collecting and comparing profile data to sort search request results" (Non-Final Act. 2), which the Examiner determined is similar to several other abstract ideas identified by the courts, including "'organizing information through mathematical calculations'. (see *DigiTech*[3])" (*id.* at 4), and "'using categories to organize, store and transmit information' (*Cyberfone*[4])" (*id.* at 5). The Examiner further determined:

> The claims collect and compare data in order to determine results that ***match*** the search request, the matching made by ***comparisons*** among data. These results include ***profile data*** of other users. The claims "analyze" the relationships (relationship data is part of *profile data* typically found in a profile) to determine diversity scores. In order to determine the diversity scores, the profile data of multiple users is ***compared*** in order to determine differences/diversities.

Ans. 6.

[3] *Digitech Image Techs., LLC v. Elecs. For Imaging, Inc.*, 758 F.3d 1344 (Fed. Cir. 2014).
[4] *Cyberfone Systems, LLC v. CNN Interactive Group, Inc.*, 558 F. App'x 988 (Fed. Cir. 2014).

The Appellant contends that "the plain focus of the claims at issue in this case is an improvement to computer functionality." Appeal Br. 22.

Accordingly, there is a dispute over what claim 1 is directed to. Is it directed to "collecting and comparing profile data to sort search request results" (Non-Final Act. 2) or "an improvement to computer functionality" (Appeal Br. 22)?

Claim Construction[5]

We consider the claim as a whole,[6] giving it the broadest reasonable construction[7] as one of ordinary skill in the art would have interpreted it in light of the Specification[8] at the time of filing.

Claim 1 sets forth a method whose objective is "matching a plurality of results to a search request and sorting the plurality of results." The sorting is done "based on determinations of diversity scores." The diversity scores "represent[] diversities of networks of a plurality of target members"

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[5] "[T]he important inquiry for a § 101 analysis is to look to the claim." *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1345 (Fed. Cir. 2013). "In *Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can.*, 687 F.3d 1266, 1273 (Fed. Cir. 2012), the court observed that 'claim construction is not an inviolable prerequisite to a validity determination under § 101.' However, the threshold of § 101 must be crossed; an event often dependent on the scope and meaning of the claims." *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1347–48 (Fed. Cir. 2015).

[6] "In determining the eligibility of respondents' claimed process for patent protection under § 101, their claims must be considered as a whole." *Diamond v. Diehr*, 450 U.S. 175, 188 (1981).

[7] 2019 Revised 101 Guidance, 84 Fed. Reg. at 53 n.14 (If a claim, "*under its broadest reasonable interpretation . . .* ").

[8] "First, it is always important to look at the actual language of the claims. . . . Second, in considering the roles played by individual limitations, it is important to read the claims 'in light of the specification.'" *Smart Sys. Innovations, LLC v. Chicago Transit Authority*, 873 F.3d 1364, 1378 (Fed. Cir. 2017) (J. Linn, dissenting-in-part and concurring-in-part), *citing Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016), among others.

and are "usable as components for determining authenticities of profiles of the plurality of target members." The method for accomplishing this objective calls upon "one or more modules incorporated into a networked system to configure one or more processors of the networked system to perform" five steps, the "one or more modules" and "one or more processors" being a combination of generic devices.[9] *See, e.g.*, Spec., paras. 17–22. The steps are:

1. "storing" Information A;
2. "receiving" Information B;
3. "processing" Information B "to identify" Information C;
4. "analyzing" Information A "to determine" Information D;
5. "sorting" Information C "for providing to the searching member based on" Information D;

Where:

[9] *Cf. Maxon, LLC v. Funai Corp.*, 726 F. App'x 797, 799–800 (Fed. Cir. 2018) (nonprecedential) ("The district court correctly found that the claims recite only generic computing processes using functional language. Analyzing the physical components of the claims, the district court noted that the specifications do not limit the breadth of elements such as 'computer-readable medium,' 'logic,' 'processor,' or 'transceiver.'. . . We agree that the representative claim does not recite anything beyond the application of routine and conventional computer components."); *Smartflash LLC v. Apple Inc.*, 680 F. App'x 977, 984 (Fed. Cir. 2017) (nonprecedential) ("we find here that 'interfaces,' 'program stores,' and 'processors' are all generic computer components . . .").

> Information A is "a plurality of relationships between a plurality of members of a social network, the plurality of members including a searching member and the plurality of target members;"
>
> Information B is "the search request, the search request initiated on behalf of the searching member;"
>
> Information C is "the plurality of results, the plurality of results including profiles of the plurality of target members;" and
>
> Information D is "the diversity scores representing the diversities of the networks of the plurality of target members."

The claim provides no structural details[10] that would distinguish the "one or more modules incorporated into a networked system" and "one or more processors of the networked system" from generic computer systems that were well known at the time the application was filed. For example, there is no recitation of *how* the "one or more modules" are "incorporated into a networked system" in a particular way.

Functionally, claim 1 calls on the "one or more modules incorporated into a networked system" and "one or more processors of the networked system" to perform "storing," "receiving," "processing," "analyzing," and "sorting" various types of information "for providing to the searching member." These are common functions that generic computers are known to perform. The difference between the claimed "one or more modules incorporated into a networked system" and "one or more processors of the networked system" and other well-known computer systems in performing

[10] *Cf. Move, Inc. v. Real Estate Alliance Ltd.*, 721 F. App'x 950, 954 (Fed. Cir. 2018) (nonprecedential) ("Claim 1 is aspirational in nature and devoid of any implementation details or technical description that would permit us to conclude that the claim as a whole is directed to something other than the abstract idea identified by the district court.").

said common functions is that the claimed "one or more modules incorporated into a networked system" and "one or more processors of the networked system" perform said functions on certain types of information. But that difference alone is not patentably consequential. This is so because "[c]laim limitations directed to the content of information and lacking a requisite functional relationship are not entitled to patentable weight because such information is not patent eligible subject matter under 35 U.S.C. § 101." *Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prods. IP Ltd.*, 890 F.3d 1024, 1032 (Fed. Cir. 2018).

Based on the record before us, the claim steps of "storing," "receiving," "processing," "analyzing," and "sorting" various types of information do not ask the "one or more modules incorporated into a networked system" and "one or more processors of the networked system" to go beyond a generic computer system's common information-processing functions. Although computer-based instructions can be patentably significant (*see Enfish* and *Ancora Techs., Inc. v. HTC Am., Inc.*, 908 F.3d 1343 (Fed. Cir. 2018)), here the instant record does not sufficiently support the view that said steps have any non-conventional effect on the generic computer components. To the contrary, the record supports viewing the phrase "one or more modules incorporated into a networked system to configure one or more processors of the networked system" as amounting to a mere instruction to implement the recited searching scheme on a generic computer. *Cf. Alice*, 573 U.S. at 225–26 ("Instead, the claims at issue amount to 'nothing significantly more' than an instruction to apply the

abstract idea of intermediated settlement using some unspecified, generic computer.").

According to the Specification, "[t]he present invention can be implemented by an apparatus for performing the operations described herein," which "may comprise a general-purpose computer, selectively activated or reconfigured by a computer program stored in the computer." Spec. para. 17. The Specification further discloses that "[t]he algorithms and displays presented herein are not inherently related to any particular computer or other apparatus" and "[v]arious general-purpose systems may be used with programs in accordance with the teachings herein . . . ." *Id.* para. 18. And "any of the methods according to the present invention can be implemented . . . by programming a general-purpose processor or by any combination of hardware and software." *Id.* The Specification also discloses that "[t]he methods of the invention may be implemented using computer software" and "the present invention is not described with reference to any particular programming language." *Id.* para. 19. According to the Specification, "[i]t will be appreciated that a variety of programming languages may be used to implement the teachings of the inventions as described herein." *Id.* The Specification also discloses that "[o]ne embodiment of the present invention may be implemented as computer software incorporated as part of an online social networking system" that "operates with a computer system using a Windows, Macintosh, UNIX, Linux or other operating system equipped with a Web browser application, or other Web-enabled device capable of connecting to the Internet or other network system." *Id.* para. 22.

In light of the Specification, we construe the limitation "one or more modules incorporated into a networked system to configure one or more processors of the networked system" as encompassing any software, in any programming language, for programming a general-purpose processor to perform the claimed steps.

Looking at the steps themselves, their combination describes a searching scheme; that is, by "storing," "receiving," "processing," "analyzing," and "sorting" various types of information as claimed, a searching member can be provided with search results.

Accordingly, we reasonably broadly construe claim 1 as being directed to a searching scheme implemented on a generic computer system.

The Abstract Idea[11]

Above, where we reproduce claim 1, we identify in italics the limitations we conclude recite an abstract idea.[12] This is consistent with the Examiner's view. *See* Non-Final Act. at 2–8. Based on our claim construction analysis (above), we determine that the identified limitations describe a type of searching scheme. Searching for information and analyzing information to provide sorted search results involves evaluation of information, which is a mental process and, accordingly, an abstract idea.[13] *Cf. Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1328

[11] This corresponds to Step 2A of the 2019 Revised 101 Guidance. Step 2A determines "whether a claim is 'directed to' a judicial exception," such as an abstract idea. 2019 Revised 101 Guidance, 84 Fed. Reg. at 53. Step 2A is a two prong inquiry.

[12] This corresponds to Prong One (a) of Step 2A of the 2019 Revised 101 Guidance. "To determine whether a claim recites an abstract idea in Prong One, examiners are now to: (a) Identify the specific limitation(s) in the claim under examination (individually or in combination) that the examiner believes recites an abstract idea . . . ." 2019 Revised 101 Guidance, 84 Fed. Reg. at 54.

[13] This corresponds to Prong One ("Evaluate Whether the Claim Recites a Judicial Exception") (b) of Step 2A of the 2019 Revised 101 Guidance. "To determine whether a claim recites an abstract idea in Prong One, examiners are now to: . . . (b) determine whether the identified limitation(s) falls within the subject matter groupings of abstract ideas enumerated in Section I of the [2019 Revised 101 Guidance]." 2019 Revised 101 Guidance, 84 Fed. Reg. at 54. This case implicates subject matter grouping "(c)": (c) Mental processes—concepts performed in the human mind (including an observation, evaluation, judgment, opinion). *Id.* at 52.

(Fed. Cir. 2017) ("[T]he heart of the claimed invention lies in creating and using an index to search for and retrieve data . . . an abstract concept."); *Netflix, Inc. v. Rovi Corp.*, 114 F. Supp. 3d 927, 941 (N.D. Cal. 2015), *aff'd*, 670 F. App'x 704 (Fed. Cir. 2016) (claims are "directed to the abstract idea of filtering search results using selectable categories.")

The method of claim 1 also involves "determining authenticities of profiles." Determining authenticity is a fundamental business practice (e.g., to prevent fraud) and as such is a method of organizing human activity. Accordingly, it is an abstract idea.[14] *Cf. Easyweb Innovations, LLC v. Twitter, Inc.*, No. 11-CV-4550, 2016 WL 1253674, at *28 (E.D.N.Y. Mar. 30, 2016) ("[T]he Court concludes that EasyWeb's patents are directed to an abstract idea of authentication."), *aff'd*, 689 F. App'x 969 (Fed. Cir. 2017). The remaining (i.e., not italicized) limitations do no more than call upon a generic computer system (i.e., "one or more modules incorporated into a networked system to configure one or more processors of the networked system") to be used as a tool to perform this abstract idea, as

[14] *See* 2019 Revised 101 Guidance, 84 Fed. Reg. at 52, subject matter grouping "(b)": (b) Certain methods of organizing human activity—fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions).

discussed below in our analysis under Prong Two of Step 2A of the 2019 Revised 101 Guidance.[15]

Improvement in the Functioning of a Computer[16] *(Appellant's Argument)*

The Examiner's characterization of what the claim is directed to ("collecting and comparing profile data to sort search request results") (Non-Final Act. 2) is similar to our own, albeit our characterization is described at a somewhat higher level of abstraction. *Cf. Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240–41 (Fed. Cir. 2016) ("An abstract idea can generally be described at different levels of abstraction. As the Board has done, the

[15] Because we determine that claim 1 recites a mental process and a method of organizing human activity, we need not address the Examiner's determination that the claims also involve "mathematical calculations" (Non-Final Act. 4) (*citing Digitech*, 758 F.3d 1344) or the Appellant's corresponding arguments that the claims are not directed to mathematical algorithms (Appeal Br. 24).

[16] This corresponds to Prong Two ("If the Claim Recites a Judicial Exception, Evaluate Whether the Judicial Exception Is Integrated Into a Practical Application") of Step 2A of the 2019 Revised 101 Guidance. 2019 Revised 101 Guidance, 84 Fed. Reg. at 54. "A claim that integrates a judicial exception into a practical application will 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." *Id.* One consideration, implicated here, that is "indicative that an additional element (or combination of elements)[] may have integrated the exception into a practical application" (*id.* at 55) as if "[a]n additional element reflects an improvement in the functioning of a computer, or an improvement to other technology or technical field" (*id.*).

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.")

The Appellant disputes the Examiner's characterization. *See* Appeal Br. 18–26. Presumably, the Appellant would equally dispute our characterization.

We have reviewed the record and are unpersuaded as to error in our or the Examiner's characterization of what claim 1 is directed to.

The Appellant argues that "the Examiner failed to establish a *prima facie* case that the claims at issue are directed to patent-ineligible subject matter." Appeal Br. 18. We disagree. The rejection is three pages and includes extensive detail to fully inform the Appellant of Examiner's position. *See* Non-Final Act. 2–4. And the Examiner has provided additional explanation in response to the Appellant's arguments. *See id.* at 4–8; Ans. 5–17. The Appellant responded with 14 pages of rebuttal reflecting an understanding of the Examiner's position. *See* Appeal Br. 18–32. The record shows that the rejection did not fail to comply with the notice requirement of 35 U.S.C. § 132 — the standard by which the sufficiency of the Examiner's rejection is properly assessed. *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (holding 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); *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) ("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.").

The Appellant further argues that

> as with the self-referential table in *Enfish*, the plain focus of the claims at issue in this case is an improvement to computer functionality (e.g., "one or more modules incorporated into a networked system to configure one or more processors of the networked system . . . for matching a plurality of results to a search request and sorting the plurality of results based on determinations of diversity scores representing diversities of networks of a plurality of target members, the diversity scores being usable as components for determining authenticities of profiles of the plurality of target members"), not economic or other tasks for which a computer is used in its ordinary capacity.

Appeal Br. 22–23.

Yet we do not see, and Appellant does not direct us to, any discussion in the Specification of "one or more modules incorporated into a networked system to configure one or more processors of the networked system" that supports the argument that the claimed modules provide an improvement to any computer or computer network. As we pointed out above in our Claim Construction analysis, the claim limitation of "one or more modules incorporated into a networked system to configure one or more processors of the networked system" encompasses any software for programming a general-purpose processor to perform the claimed steps, i.e., generic computer components. The recited modules do not impart any specific structure, but are generic modules for some recited function devoid of implementation details.

> Because the claims are directed to an abstract idea, the claims must include an "inventive concept" in order to be patent-eligible. No such inventive concept is present here. Instead, the claims "add" only generic computer components such as an "interface," "network," and "database." These generic computer components do not satisfy the inventive concept requirement.

Mortg. Grader, Inc. v. First Choice Loan Servs. Inc., 811 F.3d 1314, 1324–1325 (Fed. Cir. 2016) (internal citations and quotation marks omitted). *See also LendingTree, LLC v. Zillow, Inc.*, 656 F. App'x 991, 994 (Fed. Cir. 2016) (holding that a claim reciting a system comprising "a program module, stored in said memory storage device for providing instructions to said processing unit; said processing unit responsive to said instructions of said program module, operable" to receive, filter, and forward data was directed to ineligible subject matter under 35 U.S.C. § 101).

Specific asserted improvements over prior technology, when claimed, can render claimed subject matter not directed to an abstract idea. *Cf. McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1316 (Fed. Cir. 2016) ("When looked at as a whole, claim 1 is directed to a patentable, technological improvement over the existing, manual 3-D animation techniques."). *See also* MPEP § 2106.05(a) ("Improvements to the Functioning of a Computer or To Any Other Technology or Technical Field.") and *Alice*, 573 U.S. at 225–26 ("The method claims do not, for example, purport to improve the functioning of the computer itself. See [*CLS Bank Int'l v. Alice Corp.*, 717 F.3d 1269, 1286 (Fed. Cir. 2013) (Lourie, J., concurring)] ('There is no specific or limiting recitation of . . . improved computer technology . . .'); Brief for United States as *Amicus*

Curiae 28–30. Nor do they effect an improvement in any other technology or technical field. *See, e.g.*, *Diehr*, 450 U.S., at 177–78, 101 S. Ct. 1048."). However, there is insufficient evidence in the record before us that the claimed subject matter reflects an asserted improvement over prior technology.

"The 'abstract idea' step of the inquiry calls upon us to look at the 'focus of the claimed advance over the prior art' to determine if the claim's 'character as a whole' is directed to excluded subject matter.'" *Affinity Labs of Texas v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)); *see also Enfish*, 822 F.3d at 1335, *quoted in Apple*, 842 F.3d at 1241; *see also Ancora*, 908 F.3d at 1347:

> We examine the patent's "'claimed advance' to determine whether the claims are directed to an abstract idea." *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1303 (Fed. Cir. 2018). "In cases involving software innovations, this inquiry often turns on whether the claims focus 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.'" *Id.* (*quoting Enfish*, 822 F.3d at 1335–36); *see BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1285–86 (Fed. Cir. 2018). Computers are improved not only through changes in hardware; "[s]oftware can make non-abstract improvements to computer technology . . . ." *Enfish*, 822 F.3d at 1335. *See Finjan*, 879 F.3d at 1304. We have several times held claims to pass muster under *Alice* step one when sufficiently focused on such improvements.

The Specification, in a section entitled BACKGROUND, explains that "social networks may be regarded as networks of people connected by trust, shared values, and/or a mutual need for cooperation," and "[s]ocial

communities, cooperative business relationships, and professional associations are all examples of social networks." Spec. para. 4. According to the Specification, "[s]ocial networking systems create social networks to find business partners, clients and people with shared interests and values" and "are also used to share knowledge, build and strengthen communities, build teams, and map and analyze complex organizational networks." *Id.* The Specification further discloses that "[t]his concept has expanded to online communities where people share and use these contacts to find new friends, romantic interests, and business partners or employees," which "provides an easier and more organized way to manage and develop one's social network." *Id.* para. 5. "In addition, many of these online communities have some sort of reputation system . . . ," the purpose of which "is to build confidence and trust in and between users in the online community." *Id.* para. 6. According to the Specification, "[s]earchers use these stored references and endorsements to enhance their ability to find others who not only appear to match their requirements, but who have also received positive endorsements." *Id.* The Specification explains that a problem with existing systems is that as "associations get more and more remote, the searcher's confidence level wanes" and "a typical search may return large lists of potential targets that are quite far removed from the searcher's most trusted and reliable contacts . . . ." *Id.* para. 9. The Specification states that "[p]resently available reputation systems for online social network communities are inadequate to provide the appropriate level of confidence and validity and to allow further communication with an

endorser of a person" and that "[t]he present invention addresses these inadequacies." *Id.* para. 11.

Thus, the Specification supports the view that the heart of the invention lies in a searching scheme, not the "one or more modules incorporated into a networked system to configure one or more processors of the networked system," which, as discussed above, are merely generic. It is the searching scheme which appears to be the advance. Rather than being directed to any specific asserted improvement over prior technology, the record supports the view that the claimed subject matter is directed to a searching scheme.[17]

The Appellant next argues that "as with the process for achieving automated lip-synchronization of 3-D characters in *McRO* and the generating of a security profile that identifies suspicious code in *Finjan*, the specific way in which the steps are performed prevents broad preemption of the subject matter" and "different approaches of sorting a plurality of results are not preempted." Appeal Br. 23.

The difficulty with this argument is that it confuses the pre-emption concern with the level of abstraction describing the abstract idea. With respect to the pre-emption concern, "[w]hat matters is whether a claim threatens to subsume the full scope of a fundamental concept, and when

[17] *See* 2019 Revised 101 Guidance, 84 Fed. Reg. at 55 ("The courts have also identified examples in which a judicial exception has not been integrated into a practical application: An additional element merely recites the words 'apply it' (or an equivalent) with the judicial exception, or merely includes instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea.").

those concerns arise, we must look for meaningful limitations that prevent the claim as a whole from covering the concept's every practical application." *CLS Bank Int'l*, 717 F.3d at 1281 (Lourie, J., concurring). Here, the argued-over claim limitations (Appeal Br. 23 ("'analyzing the plurality of relationships to determine the diversity scores representing the diversities of the networks of the plurality of target members' and 'sorting the plurality of results for providing to the searching member based on the diversity scores'")) simply narrow the searching scheme so that it is described at a lower level of abstraction. The limitations do not render the abstract idea to which the claim is directed any less an abstract idea. Pre-emption is not a separate test.

> To be clear, the proper focus is not preemption *per se*, for some measure of preemption is intrinsic in the statutory right granted with every patent to exclude competitors, for a limited time, from practicing the claimed invention. *See* 35 U.S.C. § 154. Rather, the animating concern is that claims should not be coextensive with a natural law, natural phenomenon, or abstract idea; a patent-eligible claim must include one or more substantive limitations that, in the words of the Supreme Court, add "significantly more" to the basic principle, with the result that the claim covers significantly *less*. *See Mayo*[*Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71–72 (2012)]. Thus, broad claims do not necessarily raise § 101 preemption concerns, and seemingly narrower claims are not necessarily exempt.

CLS Bank Int'l, 717 F.3d at 1281 (Lourie, J., concurring). *See also Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) ("While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility."). Because we find the claimed subject matter covers patent-ineligible subject matter,

the pre-emption concern is necessarily addressed. "Where a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, . . . preemption concerns are fully addressed and made moot." *Id*. at 1379.

The Appellant argues that the cases cited by the Examiner are distinguishable from the claims before us. Appeal Br. 24–26. For example, the Appellant argues that the claims are not similar to the claims in *Cyberfone* because "[h]ere, the claims at issue are not directed to a well-established concept like transmitting information according to its classification or protecting against risk." *Id.* at 24. According to the Appellant, "the claims are directed to a particular way of matching a plurality of results to a search request and sorting the plurality of results based on determinations of diversity scores representing diversities of networks of a plurality of target members." *Id.* at 24–25.

The Appellant does not persuasively show that any claim limitation supports viewing the focus of the claims as not directed to an abstract idea but rather rooted in technology. Notwithstanding that claim 1 recites "a particular way of matching . . . and sorting" (*id.* at 24), that does not make the claim any less abstract. *See Mayo*, 566 U.S. at 88–89 ("[O]ur cases have not distinguished among different laws of nature according to whether or not the principles they embody are sufficiently narrow. *See, e.g.*, [*Parker v.*] *Flook*, 437 U.S. 584 [(1978)] (holding narrow mathematical formula unpatentable).")

In the Reply Brief, the Appellant further argues that *Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, 880 F.3d 1356 (Fed. Cir. 2018)

matches this case because "the claims in this case recite a specific improvement over prior systems, particularly the ability to present search results that are sorted by network diversity scores representing authenticated users." Reply Br. 7. But the court in *Core Wireless* held that the claims were patent-eligible because they were directed to a "particular manner of summarizing and presenting information in electronic devices." *Core Wireless*, 880 F.3d at 1362. In particular, the claims required "a specific manner of displaying a limited set of information to the user, rather than using conventional user interface methods to display a generic index on a computer." *Id.* at 1363. In contrast, claim 1 does not require any particular manner of presenting information on any user interface.

We have considered all the Appellant's arguments challenging the Examiner's determination under step one of the *Alice* framework and find them unpersuasive. For the foregoing reasons, the record supports the Examiner's determination that claim 1 is directed to an abstract idea.

Alice step two – Does the Claim Provide an Inventive Concept?[18]

Step two is "a search for an 'inventive concept'—*i.e.*, an element or combination of elements that is 'sufficient to ensure that the patent in

[18] This corresponds to Step 2B of the 2019 Revised 101 Guidance (84 Fed. Reg. at 56) ("[I]f a claim has been determined to be directed to a judicial exception under revised Step 2A, examiners should then evaluate the additional elements individually and in combination under Step 2B to determine whether they provide an inventive concept (*i.e.*, whether the additional elements amount to significantly more than the exception itself).").

practice amounts to significantly more than a patent upon the [ineligible concept] itself.'" *Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 73).

In that regard, the Examiner determined the following:

> The claim(s) does/do not include additional elements that are sufficient to amount to significantly more than the judicial exception. The limitations of *storing data, receiving data, comparing data for matches, searching data, sorting data, analyzing data to determine characteristics, calculating percentage, using degrees of separation, and comparing and grouping profiles*. These are well-known, routine and conventional practices that require no more than a generic computer to perform generic computer functions. (Please refer to July 2015 Update: Subject Matter Eligibility; page 7 for a listing of computer functions found by the courts to be well-understood, routine and conventional.) It should be noted the limitations of the current claims are performed by the generically recited general-purpose computer. (See specification at [0017].)
>
> The claims do not recite an improvement to another technology or technical field, an improvement to the functioning of the computer itself, or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment. For the role of a computer in a computer implemented invention to be deemed meaningful in the context of this analysis, it must involve more than performance of "well-understood, routine, [and] conventional activities previously known to the industry." *Id.* at 2359 (quoting Mayo, 132 S. Ct. at 1294 (internal quotation marks and brackets omitted)). Further, "the mere recitation of a generic computer cannot transform a patent ineligible abstract idea into a patent-eligible invention." *Id.* at 2358. None of the hardware offers a meaningful limitation beyond generally linking the system to a particular technological environment, that is, implementation via computers. Viewed as a whole, the claims do not purport to improve the functioning of the computer itself, or to improve any other technology or technical field. Use of an unspecified, generic computer does not transform an abstract idea into a

> patent-eligible invention. Thus, the claim does not amount to significantly more than the abstract idea itself. *See Alice Corp. v. CLS Bank lnt'l,* 110 USPQ2d 1976 (U.S. 2014).

Non-Final Act. 3–4.

We agree with the Examiner's analysis and determination.

The Appellant cites *BASCOM Global Internet Services Inc. v. AT&T Mobility LLC,* 827 F.3d 1341 (Fed. Cir. 2016) as matching this case. Appeal Br. 27–28. We disagree. Unlike in *BASCOM,* here no improvement in computer functionality has been shown. *See BASCOM,* 827 at 1351 ("[T]he claims may be read to '*improve[ ] an existing technological process.*'") (emphasis added).

The Appellant argues that "the claims at issue recite a specific solution," and the Appellant reproduces various limitations of claim 1. Appeal Br. 27. In particular, the Appellant contends that "the one or more recited modules are not generic modules" and "the one or more modules provide specific non-conventional functionality, as recited and explained in the as-filed specification (see, e.g., reputation system 41 of FIG. 2 and paragraphs [0053], [0080], [0106])." *Id.*

The difficulty with this argument is that we can find no basis for it in the claim or the written description. Claim 1 does not specify any arrangement of the claimed "one or more modules" or the "one or more processors" beyond calling for them to be "incorporated into a networked system" in some unspecified fashion. "Many of [A]ppellant's arguments fail from the outset because, . . . they are not based on limitations appearing in the claims." *In re Self,* 671 F.2d 1344, 1348 (CCPA 1982). Nowhere in the record is there any suggestion that the arrangement of the claimed "one or

more modules" and "one or more processors" is non-conventional and non-generic as the Appellant argues. The Appellant cites Figure 2 and paragraphs 53, 80, and 106 of the Specification. We have reviewed the cited portions and are unable to find any disclosure of any modules, much less "one or more modules incorporated into a networked system" in any particular way. For example, Figure 2 depicts "a software architecture for supporting methods of the present invention" (Spec. para. 12), but we do not see any "modules incorporated into a networked system." Rather, Figure 2 depicts a "Client Personal Computer/Appliance 12" in communication via network 10 with "Server(s) 14, 16." *See id.* para. 25 ("As shown in FIG. 2, client 12 includes a client application program 18, which may make use of a conventional Web browser 20 . . ."); *id.* para. 30 ("server 14 may be a Web server having a server-side database, and client-side Web browsers may interact with server 14 using conventional Internet communication protocols.") *Cf. Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015) ("Rather, the 'interactive interface' simply describes a generic web server with attendant software, tasked with providing web pages to and communicating with the user's computer."). Claim 1 does not recite any client, host, or server. The argument is not commensurate in scope with what is claimed and, because the record does not reflect it, amounts to mere attorney argument. Attorney argument, however, cannot take the place of record evidence. *See In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1581 (Fed. Cir. 1989).

We note that the Specification discloses a software architecture that comprises various agents, such as "personal search agent 26" (Spec. para. 25) and "search agents 34" (*id.* para. 27). However, claim 1 does not recite any agent, and the Appellant does not contend that the claimed "one or more modules" correspond to any of the agents described in the Specification. *See Accenture*, 728 F.3d at 1345 ("[T]he complexity of the implementing software or the level of detail in the specification does not transform a claim reciting only an abstract concept into a patent-eligible system or method."); *see also Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1322 (Fed. Cir. 2016) ("The district court erred in relying on technological details set forth in the patent's specification and not set forth in the claims to find an inventive concept" (citing *Accenture*, 728 F.3d at 1345; *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass'n*, 776 F.3d 1343, 1346 (Fed. Cir. 2014))).

The Appellant further argues that "the recited operations are not conventional operations, as evidenced by the fact that there is not even a novelty (102) or obviousness (103) rejection outstanding in this case." Appeal Br. 27.

Claim limitations found to be novel and/or nonobvious can affect a patent-eligibility determination. *Cf. Ariosa*, 788 F.3d at 1377 ("For process claims that encompass natural phenomenon, the process steps are the additional features that must be new and useful.") Thus, novelty is a factor to be considered when determining "whether the claims contain an 'inventive concept' to 'transform' the claimed abstract idea into patent-

eligible subject matter." *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014).

However, a finding of novelty or nonobviousness does not necessarily lead to the conclusion that subject matter is patentable eligible. "Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry." *Ass'n for Molecular Pathology*, 569 U.S. at 591.

> Indeed, "[t]he '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." *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (emphasis added); *see also Mayo*, 132 S. Ct. at 1303–04 (rejecting "the Government's invitation to substitute §§ 102, 103, and 112 inquiries for the better established inquiry under § 101"). Here, the jury's general finding that Symantec did not prove by clear and convincing evidence that three particular prior art references do not disclose all the limitations of or render obvious the asserted claims does not resolve the question of whether the claims embody an inventive concept at the second step of *Mayo/Alice*.

Intellectual Ventures I v. Symantec, 838 F.3d at 1315.

Nor does a finding of obviousness necessarily lead to the conclusion that subject matter is patent-ineligible. *See also Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1050 (Fed. Cir. 2016) ("That each of the claims' individual steps (freezing, thawing, and separating) were known independently in the art does not make the claim unpatentable."). "[P]atent-eligibility does not turn on ease of execution or obviousness of application. Those are questions that are examined under separate provisions of the Patent Act." *Id.* at 1052 (citing *Mayo*, 566 U.S. at 90).

Notwithstanding that "'the § 101 patent-eligibility inquiry and, say, the § 102 novelty inquiry might sometimes overlap,' . . . a claim for a *new*

abstract idea is still an abstract idea." *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (quoting *Mayo*, 566 U.S. at 90). The question in step two of the *Alice* framework is not whether an additional feature is novel but whether the implementation of the abstract idea involves "more than performance of 'well-understood, routine, [and] conventional activities previously known to the industry.'" *Content Extraction*, 776 F.3d at 1347–48 (quoting *Alice*, 575 U.S. at 2359).

In that regard, the Appellant has not shown novel features that transform the abstract idea into patent-eligible subject matter. The Appellant does not explain what features in the claim would render the subject matter significantly more than the searching scheme we have determined the claim to be directed to. At most, the claimed scheme uses "one or more modules incorporated into a networked system to configure one or more processors of the networked system," but, as we have discussed, that alone adds little to transform the abstract idea into an inventive concept. Accordingly, this argument is unpersuasive.

The Appellant argues that "the claims at issue in this case go beyond 'well-understood, routine, conventional activities,' just as in" *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014). Appeal Br. 28. We disagree. Unlike in that decision, no improvement in computer functionality has been shown here. *See DDR*, 773 F.3d at 1258 ("[T]he claims at issue here specify how interactions with the Internet are manipulated to yield a desired result—a result *that overrides the routine and conventional sequence of events* ordinarily triggered by the click of a hyperlink.") (emphasis added). Much like the "data storage unit" and

"computer, coupled to said storage unit" in the claims of *Alice* (US 7,149,720, claim 1), the claims here do not "do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer." *Alice*, 573 U.S. at 225. For the reasons discussed above, we are unpersuaded that the record supports interpreting the searching scheme recited in the claim as yielding any improvement in technology as the Appellant has argued.

On page 28 of the Appeal Brief, the Appellant cites *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016), but the Appellant does not provide any particular argument or explanation of how that case is relevant, and accordingly the argument is not persuasive of Examiner error.

The Appellant argues that "especially in view of *Berkheimer* [*v. HP Inc*., 881 F.3d 1360 (Fed. Cir. 2018)], the Examiner was required to provide an acceptable form of evidence that each of the following elements, recited in each of the independent claims at issue, are well-understood, routine, or conventional, both individually and in combination" and then Appellant reproduces every limitation of claim 1. Reply Br. 2–3.

We cited the Specification in our discussion as intrinsic evidence that the claimed element, "one or more modules incorporated into a networked system to configure one or more processors of the networked system," encompasses a generic computer system. In doing so, we have followed "Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP Inc*.," USPTO Memorandum, Robert W. Bahr, Deputy Commissioner For Patent

Examination Policy, April 19, 2018 (the "*Berkheimer* Memo")). The court in *Berkheimer* held that "[t]he patent eligibility inquiry may contain underlying issues of fact." *Berkheimer*, 881 F.3d at 1365 (quoting *Mortg. Grader*, 811 F.3d at 1325 ("The § 101 inquiry '***may*** contain underlying factual issues."')). But the court also held that "[w]hen there is *no genuine issue of material fact* regarding whether the claim element or claimed combination is well-understood, routine, [and] conventional to a skilled artisan in the relevant field, this issue can be decided on summary judgment as a matter of law." *Id.* at 1368 (emphasis added). This qualification has been subsequently reiterated.

> If there is a genuine dispute of material fact, Rule 56 requires that summary judgment be denied. In *Berkheimer*, there was such a genuine dispute for claims 4–7, but not for claims 1–3 and 9 . . . . [I]n accordance with *Alice*, we have repeatedly recognized the absence of a genuine dispute as to eligibility for the many claims that 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, 1371–74 (Fed. Cir. 2018) (Moore, J., concurring). Here, the Specification indisputably shows the claimed "one or more modules incorporated into a networked system to configure one or more processors of the networked system" covers a generic computer system that was conventional at the time of filing. Accordingly, no genuine issue of material fact exists as to the well-understood, routine, or conventional nature of the claimed "one or more modules incorporated into a networked system to configure one or more processors of the networked system," individually or in the combination as claimed.

No other persuasive arguments having been presented, we conclude that no error has been committed in the determination under *Alice* step two that claim 1 does not include an element or combination of elements circumscribing the patent-ineligible concept it is directed to so as to transform the concept into an inventive application.

We have considered all of the Appellant's remaining arguments (including those made in the Reply Brief) and find them unpersuasive. Accordingly, we sustain the Examiner's rejection of independent claim 1, and independent claim 8, which is not separately argued, for being judicially excepted from 35 U.S.C. § 101. *Cf. LendingTree*, 656 F. App'x at 997 ("We have considered all of LendingTree's remaining arguments and have found them unpersuasive. Accordingly, because the asserted claims of the patents in suit are directed to an abstract idea and do not present an 'inventive concept,' we hold that they are directed to ineligible subject matter under 35 U.S.C. § 101."); *see, e.g., OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1364 (Fed. Cir. 2015); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016).

Dependent claims 2–7 and 9–14

On pages 30–32 of the Appeal Brief, the Appellant reproduces claim language from six groupings of dependent claims: claims 2, 9, and 16; claims 3, 10, and 17; claims 4, 11, and 18; claims 5, 12, and 19; claims 6, 13, and 20; and claims 7 and 14 . The argument is identical for each group:

> With respect to the *Mayo* step one analysis, these additional elements further distinguish the concept to which the claims are directed from any of the cases cited by the Examiner. Additionally, these additional elements further limit the preemption concerns. With respect to the *Mayo* step two

> analysis, these additional elements go beyond any alleged abstract idea with even further specificity than the additional elements discussed above with respect to the independent claims.

Id. at 30–32 (repeated for each of the six groups). As we have explained above, preemption is not a separate test for patent-eligibility. As to the argument that the dependent claims add "even further specificity," in the absence of any persuasive argument as to how any particular limitation amounts to more than the abstract idea of searching recited in the independent claims, we are not persuaded of error in the rejection. We also note that the Appellant has not raised any genuine of issue of material fact as to any dependent claim. Accordingly, we sustain the Examiner's rejection of dependent claims 2–7 and 9–14 for being judicially excepted from 35 U.S.C. § 101 for the same reasons as for independent claims 1 and 8 from which they depend.

Independent claim 15 and dependent claims 16–20

Claim 15 recites five means-plus-function limitations: "means for storing," "means for receiving," "means for processing," "means for analyzing," and "means for sorting." Means-plus-function claim language must be construed in accordance with 35 U.S.C. § 112(f) by "look[ing] to the specification and interpreting] that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure." *In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc).

> Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

Id. at 1194–95. *See also* MPEP § 2181, subsection I ("If a claim limitation recites a term and associated functional language, the examiner should determine whether the claim limitation invokes 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph.") (citing *Donaldson*). There is no indication in the record that the required analysis was performed.

Because the Examiner has not performed the required claim construction analysis in the first instance to enable us to determine whether the corresponding structure integrates the judicial exception into a practical application, we do not sustain the Examiner's rejection of independent claim 15 and claims 16–20 which depend therefrom.

CONCLUSION

In summary:

Claims Rejected	Basis	Affirmed	Reversed
1–20	§ 101	1–14	15–20

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-IN-PART