UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte ADAM T. CLARK, JOHN S. MYSAK, ASPEN L. PAYTON,
JOHN E. PETRI, and MICHAEL D. PFEIFER

_____

Appeal 2018-007807[1]
Application 14/584,128[2]
Technology Center 3700

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Before MICHAEL C. ASTORINO, PHILIP J. HOFFMANN, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

HUTCHINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final
rejection of claims 19–30. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] Our decision references Appellants' Appeal Brief ("App. Br.," filed
Apr. 2, 2018) and Reply Brief ("Reply Br.," filed July 23, 2018), and the
Examiner's Answer ("Ans.," mailed June 5, 2018) and Final Office Action
("Final Act.," mailed Dec. 4, 2017).
[2] Appellants identify International Business Machines Corporation as the
real party in interest. App. Br. 1.

CLAIMED INVENTION

The Appellants' claimed invention relates generally to "evaluating presentation data" and, more particularly to "evaluating presentation techniques pertaining to a subject matter topic." Spec. ¶ 1.

Claims 19 and 20 are the independent claims on appeal. Claim 19, reproduced below with bracketed notations added, is illustrative of the claimed subject matter:

> 19. A non-transitory computer program product for evaluating presentation data, the nontransitory computer program product comprising a non-transitory computer readable medium having program instructions embodied therewith, wherein the program instructions are executable by a processor to cause the processor to perform a method comprising:
>
> [(a)] monitoring a presentation, using a set of monitoring devices, to collect presentation data from the presentation;
>
> [(b)] analyzing the presentation data to extract context information from the presentation data;
>
> [(c)] determining, based on the context information for the presentation, a subject matter topic for the presentation and a presentation technique for the presentation;
>
> [(d)] analyzing, based on the subject matter topic, the context information for the presentation to identify a concept within the subject matter topic;
>
> [(e)] retrieving, from a corpus of presentation techniques for the subject matter topic, a subset of presentation techniques for the concept; and
>
> [(f)] generating, by comparing first feedback data for a determined presentation technique and second feedback data from the corpus of presentation techniques for the subject matter topic, an evaluation of the presentation technique pertaining to the concept;
>
> [(g)] wherein generating the evaluation of the presentation technique pertaining to the concept comprises:

[(h)] collecting the first feedback data, the first feedback data associated with a communication made by a user regarding the presentation;

[(i)] comparing first content of the first feedback data with second content of the presentation using a natural language processing technique configured to analyze syntactic and semantic elements of the first feedback data and the presentation;

[(j)] determining accuracy of the first feedback data based on similarity of the first content to the second content;

[(k)] determining an effectiveness of the presentation based on the accuracy and amount of time spent using the presentation technique for the presentation;

[(l)] retrieving from a storage device previously evaluated presentation techniques and a computed effectiveness of the previously evaluated presentation techniques;

[(m)] comparing the effectiveness of the presentation with the computed effectiveness of the previously evaluated presentation techniques to determine a respective rank for the presentation technique of the presentation and a respective rank for each of the previously evaluated presentation techniques; and

[(n)] displaying, on a graphical user interface, the presentation technique for the presentation with one or more of the previously evaluated presentation techniques in an order based on the respective rank of the presentation technique for the presentation and the respective rank of the one or more of the previously evaluated presentation techniques.

REJECTION

Claims 19–30 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

ANALYSIS

Appellants argue the pending claims as a group. App. Br. 4–11. We select independent claim 19 as representative. The remaining claims stand or fall with claim 19. *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 Servs. v. Prometheus Labs., 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).

The Court acknowledged in *Mayo*, that "all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas." *Mayo*, 566 U.S. at 71. Therefore, the Federal Circuit has instructed that claims are to be considered in their entirety to determine "whether their character as a whole is directed to excluded subject matter." *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312

(Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

In rejecting the pending claims under 35 U.S.C. § 101, the Examiner determined that limitations (a) through (n), as recited in claim 19, recite a process for analyzing data. Final Act. 2–8. The Examiner determined that these limitations, under their broadest reasonable interpretation, are analogous to claims that have been held to be directed to an abstract idea of collecting and analyzing information, and displaying results of the collection and analysis. *Id.* at 2–3 (*citing Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016)). The Examiner further determined that claim 1 recites additional elements, including a "non-transitory computer readable medium having program instructions embodied therewith, wherein the program instructions are executable by a processor," a "set of monitoring devices," a "graphical user interface," and a "storage device." *Id.* at 8 (emphasis omitted). But the Examiner determines that these elements are not sufficient to amount to significantly more than the abstract idea. *Id.*

Judicial Exception

The Federal Circuit has explained that "the 'directed to' inquiry applies a stage-one filter to claims, considered in light of the [S]pecification, based on whether 'their character as a whole is directed to excluded subject matter.'" *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp.*, 790 F.3d at 1346). Appellants argue that the Examiner erred by "applying high level generalizations which oversimplify the limitations and ignore specific details of the claims in determining that the present claims are directed to an

abstract idea." App. Br. 6; *see also* Reply Br. 1–4. We are not persuaded of Examiner error.

Here, Appellants' Specification is titled "EVALUATING PRESENTATION DATA." The Background section of the Specification describes difficulty "conveying information to engage an audience such that information is retained." Spec. ¶ 1. For example, it can be difficult "determining which techniques are effective techniques for conveying specific topics can be difficult." *Id.* Accordingly, the Specification describes "a need to effectively engage audiences and convey information in a more efficient manner." *Id.* The Summary section of the invention describes a method for evaluating presentation data includes collecting presentation data, determining a subject matter topic and a presentation technique using natural language processing, comparing the presentation technique and a corpus of presentation techniques, and generating an evaluation of a presentation technique. Spec. ¶ 2.

Claim 19 recites the following limitations: "monitoring a presentation . . . to collect presentation data from the presentation" (limitation (a)); "analyzing the presentation data to extract context information from the presentation data" (limitation (b)); "determining, based on the context information for the presentation, a subject matter topic for the presentation and a presentation technique for the presentation" (limitation (c)); "analyzing, based on the subject matter topic, the context information for the presentation to identify a concept within the subject matter topic" (limitation (d)); "retrieving, from a corpus of presentation techniques for the subject matter topic, a subset of presentation techniques for the concept" (limitation (e)); "generating, by comparing first feedback data for a

determined presentation technique and second feedback data from the corpus

of presentation techniques for the subject matter topic, an evaluation of the

presentation technique pertaining to the concept" (limitation (f)); "wherein

generating the evaluation of the presentation technique pertaining to the

concept comprises [limitations (h)–(n)]" (limitation (g)); "collecting the first

feedback data, the first feedback data associated with a communication made

by a user regarding the presentation" (limitation (h)); "comparing first

content of the first feedback data with second content of the presentation

using a natural language processing technique configured to analyze

syntactic and semantic elements of the first feedback data and the

presentation" (limitation (i)); "determining accuracy of the first feedback

data based on similarity of the first content to the second content"

(limitation (j)); "determining an effectiveness of the presentation based on

the accuracy and amount of time spent using the presentation technique for

the presentation" (limitation (k)); "retrieving . . . previously evaluated

presentation techniques and a computed effectiveness of the previously

evaluated presentation techniques" (limitation (l)); "comparing the

effectiveness of the presentation with the computed effectiveness of the

previously evaluated presentation techniques to determine a respective rank

for the presentation technique of the presentation and a respective rank for

each of the previously evaluated presentation techniques" (limitation (m));

and "displaying . . . the presentation technique for the presentation with one

or more of the previously evaluated presentation techniques in an order

based on the respective rank of the presentation technique for the

presentation and the respective rank of the one or more of the previously

evaluated presentation techniques" (limitation (n)). These limitations, under

their broadest reasonable interpretation in light of the Specification, recite a method for evaluating presentation data, including observation, evaluation, and judgement, that could be performed in the human mind, i.e., a mental process and, thus, an abstract idea. *See* 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50, 52 (Jan. 7, 2019) ("Revised Guidance").

Practical Application

Under the Revised Guidance, if a claim recites a judicial exception (e.g., a mental process), then it must be analyzed to determine whether the recited judicial exception is integrated into a practical application of that exception. *Id.* at 54. Specifically, we identify whether there are any additional elements recited in the claim beyond the judicial exception, and evaluate the additional elements individually and in combination to determine whether they integrate the exception into a practical application. *Id.* at 54–55. Here, claim 19 additionally recites "non-transitory computer readable medium having program instructions embodied thereon, wherein the program instructions are executable by a processor to cause the processor to perform a method comprising [limitations (a)–(n)]" (preamble); a "set of monitoring devices" (limitation (a)); a "storage device" (limitation (l)); and a "graphical user interface" (limitation (n)).

We find no indication in the record that attributes these additional elements to an improvement in computer technology and/or functionality to the claimed invention, to implementing the abstract idea with a particular machine that is integral to the claim, that effects a transformation or reduction of a particular article to a different state or thing, that applies the abstract idea in some other meaningful way beyond linking the use of the

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abstract idea to a particular technological environment, 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 54–55.

Appellants argue that claim 19 recites "a *specific* improvement over prior systems to enable a system to perform things it could not do before," namely, "perform[ing] the function of automating identification of effective presentation techniques without requiring subjective user analysis of the effectiveness of the presentation techniques." App. Br. 7; *see also* Reply Br. 4–6. For example, Appellants assert that claim 19 "does not need user evaluation of the feedback to determine a respective effectiveness of the various presentations techniques." *Id.* at 8. According to Appellants, "[s]imilar to *McRO*, the present claims do not simply automate a process employed by humans," and instead use "specific rules which enable the computer to determine the effectiveness [of a presentation] based on objective comparison without prior knowledge of correct or desired answers." *Id.* at 8–9. Specifically, the method looks for similarities between feedback content and presentation content, and on the amount of time spent on the presentation. *Id.* at 9.

Yet, the claims in *McRO* used a combined order of specific rules to provide an improvement over manual three-dimensional computer animation. *McRO*, 837 F.3d at 1315–16. In contrast, claim 19 uses a processor to implement a set of rules to evaluate effectiveness of a presentation, which amounts to an implementation of a mental process using a generic computer. *See* Revised Guidance 55 (merely using a computer as

a tool to perform an abstract idea does not integrate the abstract idea into a practical application).

We also are not persuaded by Appellants' argument regarding preemption. *See* App. Br. 9–10. Appellants' argument is not persuasive, at least because preemption is not 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). Although "preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility." *Id.*

Inventive Concept

Appellants argue that claim 19's limitations (i) through (k) recite significantly more than the abstract idea. App. Br. 10–11; *see also* Reply Br. 7. Yet, these limitations, even if novel and non-obvious, recite no elements beyond 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, Appellants have not identified, and we do not find, any additional elements recited in claim 19 that, individually or in combination,

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provide significantly more than the abstract idea. Instead, the additional elements recite generic computer elements for executing the abstract idea.

Accordingly, we sustain the rejection of independent claim 19 under 35 U.S.C. § 101. We also sustain the rejections of claims 20–30, which fall with claim 19.

DECISION

The Examiner's rejection of claims 19–30 under 35 U.S.C. § 101 is affirmed.

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