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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/565,467	08/02/2012	ASIT DAN	CAM920120016US2_8150-0274	9120
52021	7590	06/02/2020	EXAMINER	
Cuenot, Forsythe & Kim, LLC 20283 State Road 7 Ste. 300 Boca Raton, FL 33498			JASMIN, LYNDA C	
			ART UNIT	PAPER NUMBER
			3629	
			NOTIFICATION DATE	DELIVERY MODE
			06/02/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ASIT DAN and MIKE A. MARIN

Appeal 2018-008252
Application 13/565,467
Technology Center 3600

Before PHILIP J. HOFFMANN, KENNETH G. SCHOPFER, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

HUTCHINGS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant¹ filed a Request for Rehearing (“Req. Reh’g”), pursuant to 37 C.F.R. § 41.52, on May 20, 2020, seeking reconsideration of our Decision on Appeal mailed March 31, 2020 (“Decision”), in which we affirmed the Examiner’s rejection of claims 36–45 under 35 U.S.C. § 101 as

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 March 15, 2018).

directed to a judicial exception without significantly more.² We have jurisdiction over the Request under 35 U.S.C. § 6(b).

DISCUSSION

Appellant argues that the Board, in affirming the Examiner’s rejection under 35 U.S.C. § 101, presents new findings and rationales than those presented by the Examiner. *See* Req. Reh’g 2–6. Therefore, Appellant requests that the Board designate its rejection as a new ground of rejection to provide Appellant a fair opportunity to respond. *Id.* In view of Appellant’s argument, we designate our affirmance of the rejection under 35 U.S.C. § 101 as a new ground of rejection.

Additionally, Appellant “request[s] that the Board clarify what specific elements recited in independent claim 36 recite rules that are comparable to fundamental economic practices.” *Id.* at 7. Appellant also asks “that the Board clarify what specific elements are alleged as reciting a mental process.” *Id.* at 8. To recap, the Decision did not find that any of the limitations recited in independent claim 36 are comparable to fundamental economic practices. Instead, the Decision quotes portions³ of limitations (a) through (i) that, “when given their broadest reasonable interpretation, recite a method for developing a model for a business process that integrates with a separate decision making model.” Decision 12–13.

² We also reversed the Examiner’s rejection of claims 36–45 under 35 U.S.C. § 112, second paragraph. Appellant seeks reconsideration only of the affirmed rejection under § 101. *See* Req. Reh’g 2.

³ For clarity, the omitted portions of quoted limitations (a) through (i), identified by ellipses, indicate subject matter that is not considered part of the abstract ideas. Decision 12.

We categorized this concept as managing relationships or interactions between people, including following rules or instructions, i.e., a certain method of organizing human activity. *Id.* at 13; *see also* REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50, 52 (Jan. 7, 2019) (“Revised Guidance”); October 2019 Update: Subject Matter Eligibility 6, *available at* https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf (“October 2019 Update”). To the extent Appellant understands this category as encompassing only “rules that are comparable to fundamental economic practices” based on footnote 13 of the Revised Guidance (*see* Req. Reh’g 7), Appellant is mistaken. *See, e.g.*, October 2019 Update 5 (identifying “fundamental economic principles” and “managing . . . relationships or interactions between people” as distinct subgroupings for the “certain methods of organizing human activity” grouping).

We additionally, or alternatively, found the same quoted portions of limitations (a) through (i) to fall in the category of mental processes. Decision 13–14. Notably, the limitations of claim 36 quoted at page 12 of the Decision are recited at such a high level of generality that they practically could be performed in the human mind. *See* October 2019 Update 7–8.

Finally, we remind Appellant that the Revised Guidance “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.” *See* Revised Guidance, 84 Fed. Reg. at 51. But the “guidance does not constitute substantive

rulemaking and does not have the force and effect of law.” *Id.* Instead, “[r]ejections will continue to be based upon the substantive law[.]” *Id.*

CONCLUSION

Outcome of Decision on Rehearing:

Claims Rejected	35 U.S.C. §	Basis	Granted	Denied
36–45	101	Eligibility	36–45	

Final Outcome of Appeal After Rehearing:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed	New Ground
36–45	101	Eligibility			36–45

37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground 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 proceeding 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. The request for rehearing must

Appeal 2018-008252
Application 13/565,467

address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in MPEP § 1214.01.

GRANTED; 37 C.F.R. § 41.50(b)