



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/824,712	06/28/2010	ROMELIA H. FLORES	CHA920100010US1_8134-0125	1381
73109	7590	10/01/2019	EXAMINER	
Cuenot, Forsythe & Kim, LLC			DICKERSON, TIPHANY B	
20283 State Road 7			ART UNIT	
Ste. 300			PAPER NUMBER	
Boca Raton, FL 33498			3624	
			NOTIFICATION DATE	
			DELIVERY MODE	
			10/01/2019	
			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ibmptomail@iplawpro.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROMELIA H. FLORES, CHARLET N. GIVENS, and
SHIJU MATHAI

Appeal 2018-008429
Application 12/824,712
Technology Center 3600

Before KARA L. SZPONDOWSKI, SCOTT B. HOWARD, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 23–37, which constitute all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as IBM Corporation. Appeal Br. 1.

THE INVENTION

The disclosed and claimed invention is directed “to the field of business process management and, more particularly, to a video-based analysis workflow proposal tool.” Spec. ¶ 1.²

Claim 23, reproduced below, is illustrative of the claimed subject matter:

23. A computer-implemented method, comprising:
- receiving video data, generated by a video capture device, representing a workflow;
 - analyzing the video data to identify a workflow pattern including a series of steps;
 - analyzing the workflow pattern to generate performance data for each of the steps within the workflow pattern;
 - comparing the analyzed video data with a pattern library of workflows;
 - comparing, upon identifying a match within the pattern library, the performance data of the workflow pattern with performance data of the match;
 - identifying, based upon the comparison between the performance data of the workflow pattern and the performance data of the match, a workflow improvement; and
 - causing, using a computer hardware system, the workflow improvement to be implemented.

² We refer to the Specification filed June 28, 2010 (“Spec.”); Final Office Action mailed Aug. 24, 2017 (“Final Act.”); Appeal Brief filed Apr. 5, 2018 (“Appeal Br.”); Examiner’s Answer mailed June 27, 2018 (“Ans.”); and the Reply Brief filed Aug. 22, 2018 (“Reply Br.”).

REJECTIONS

Claims 23–37 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written-description requirement. Final Act. 4.

Claims 23–37 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter. Final Act. 5.

ANALYSIS

35 U.S.C. § 112, First Paragraph, Rejection

The Examiner finds that “causing, using a computer hardware system, the workflow improvement to be implemented,” as recited in claim 23, lacks written description. Final Act. 4–5; *see* Ans. 4–5. Specifically, the Examiner finds that the “disclosure does not demonstrate that the inventor intended to describe *implementing* an improvement to a workflow, but rather to *reporting recommendations* by generating a document based on an analysis.” *Id.*

Appellant argues that Appellant “had possession of the additional aspect of implementing an improvement to a workflow.” Appeal Br. 10. Specifically, Appellant argues that the Specification describes “the workflow proposal tool 115 making recommendations and being used to make improvements.” Appeal Br. 10 (citing Spec. ¶ 26). According to Appellant, the “claimed invention only requires that the computer-implemented tool gives rise to an action (i.e., causes) the recommendation is implemented,” and “the actual implementation of the recommendations is not being claimed.” Reply Br. 3.

We are not persuaded by Appellant’s arguments. To satisfy the written-description requirement, a patent specification must describe the

claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *See, e.g., Moba, B.V. v. Diamond Auto., Inc.*, 325 F.3d 1306, 1319 (Fed. Cir. 2003); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). “[T]he test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art,” where “the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The exact level of detail required depends upon “the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Id.* Factors for “evaluating the adequacy of the disclosure” may include “the existing knowledge in the particular field, the extent and content of the prior art, the maturity of the science or technology, [and] the predictability of the aspect at issue.” *Id.* (alteration in original) (quoting *Capon v. Eshhar*, 418 F.3d 1349, 1359 (Fed. Cir. 2005)).

Here, the claim recites “causing, using a computer hardware system, the workflow improvement to be implemented.” As a result, the claim requires that the improvement is *implemented* by the computer hardware system. The Specification describes “defin[ing] a series of steps based on analyzing video content,” which “correspond to patterns” and “can be further analyzed to make recommendations, improvements, or to monitor compliance of actual processes versus documented ones.” Spec. ¶ 26. We agree with the Examiner that this passage supports *making recommendations for improvements*, but does *not* support “using a computer hardware system”

to “*caus[e] . . . the workflow improvement to be implemented*” as recited in claim 23. Appeal Br. 26 (Claim App.) (emphasis added).

Accordingly, we sustain the Examiner’s 35 U.S.C. § 112, first paragraph, rejection of claims 23–37.

35 U.S.C. § 101 Rejection

An invention is patent eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g., Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts

determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “a claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 187; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (internal quotation marks omitted). “A claim that recites an abstract idea must include ‘additional

features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (alterations in original) (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of § 101. 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Memorandum”). Under that guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* Manual of Patent Examining Procedure (“MPEP”) §§ 2106.05(a)–(c), (e)–(h) (9th ed. rev. 08.2017 Jan. 2018)).

See Memorandum, 84 Fed. Reg. at 52, 54–55. Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

- (3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or
- (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See id. at 56.

Furthermore, the Memorandum “extracts and synthesizes key concepts identified by the courts as abstract ideas to explain that the abstract idea exception includes the following groupings of subject matter, when

recited as such in a claim limitation(s) (that is, when recited on their own or per se)”:

(a) Mathematical concepts—mathematical relationships, mathematical formulas or equations, mathematical calculations;

(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); and

(c) Mental processes—concepts performed in the human mind (including an observation, evaluation, judgment, opinion).

Id. at 52 (footnotes omitted).

USPTO Step 2A, Prong 1

The Examiner determines that the claims are directed to “collecting information, analyzing it, and displaying certain results of the collection and analysis.” Final Act. 6 (citing *Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016)); *see* Final Act. 5; Ans. 5.

Appellant contends that the Examiner overgeneralizes the claimed invention and does not address Appellant’s arguments of record. Appeal Br. 18; *see* Reply Br. 5. Specifically, Appellant contends that the claimed “causing, using a computer hardware system, the workflow improvement to be implemented” is “beyond merely ‘the collection, analysis, and display of available information in a particular field.’” Appeal Br. 14; *see* Reply Br. 6. According to Appellant, there is “no explanation as to how the invention, as

claimed, can be performed as a mental process.” Reply Br. 8.

We are not persuaded by Appellant’s arguments that the Examiner erred.

Representative claim 23—with emphasis added—is reproduced below:

23. A computer-implemented method, comprising:
- receiving video data, generated by a video capture device, representing a workflow;*
 - analyzing the video data to identify a workflow pattern including a series of steps;*
 - analyzing the workflow pattern to generate performance data for each of the steps within the workflow pattern;*
 - comparing the analyzed video data with a pattern library of workflows;*
 - comparing, upon identifying a match within the pattern library, the performance data of the workflow pattern with performance data of the match;*
 - identifying, based upon the comparison between the performance data of the workflow pattern and the performance data of the match, a workflow improvement; and*
 - causing, using a computer hardware system, the workflow improvement to be implemented.*

As relevant here, the Memorandum explains that mental processes include “concepts performed in the human mind,” such as “an observation, evaluation, judgment, [or] opinion.” Memorandum, 84 Fed. Reg. at 52.

The emphasized limitations above are steps of observation, evaluation, and judgment that can be practically performed by a human, either mentally or with the use of pen and paper. Specifically, the claim limitations identified above are directed to (i) receiving captured video data (collecting information), (ii) analyzing the video data and the resulting

workflow patterns, generating performance data, comparing the analyzed video data with a pattern library and comparing performance data for the matched video data (comparing the collected information against stored information, algorithms, and rules), and (iii) based on the comparison of the performance data, identifying a workflow improvement to be implemented (using rules to identify to improve a workflow).

Each of those steps, both individually and as a combination, can be performed by a human, either mentally or with the aid of paper and pencil, which is similar to the claims found patent ineligible as mental processes in *SmartGene*. See *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 F. App'x 950, 955 (Fed. Cir. 2014) (“[T]he claim at issue here involves a mental process excluded from section 101: the mental steps of comparing new and stored information and using rules to identify medical options” and “calls on a computer to do nothing that is even arguably an advance in physical implementations of routine mental information-comparison and rule-application process”); see also *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) (“Thus, claim 3’s steps can all be performed in the human mind. Such a method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101. Methods which can be performed entirely in the human mind are unpatentable not because there is anything wrong with claiming mental method steps as part of a process containing non-mental steps, but rather because computational methods which can be performed *entirely* in the human mind are the types of methods that embody the ‘basic tools of scientific and technological work’ that are free to all men and reserved exclusively to none.”) (quoting *Benson*, 409 U.S. at 67) (footnote omitted));

Intellectual Ventures I LLC v. Symantec Corp., 838 F.3d 1307, 1318 (Fed. Cir. 2016) (“[W]ith the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper.”); *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1335 (Fed. Cir. 2015) (“Courts have examined claims that required the use of a computer and still found that the underlying, patent-ineligible invention could be performed via pen and paper or in a person’s mind.”).

Accordingly, we conclude that claim 23 recites a method of observation, evaluation, and judgment that can be practically performed in the human mind, which is a mental process identified in the Memorandum, and thus an abstract idea.

USPTO Step 2A, Prong 2

In determining whether claim 23 is “directed to” the identified abstract ideas, we next consider whether claim 23 recites additional elements that integrate the judicial exception into a practical application. For the reasons set forth below, we discern no additional element (or combination of elements) recited in claim 23 that integrates the judicial exception into a practical application. *See* Memorandum, 84 Fed. Reg. at 54–55.

The Examiner concludes that the claimed additional elements (i.e., “a hardware processor and a machine-readable storage medium executed on a hardware computer system”) are each “a general-purpose device performing its usual computer function,” and are “generic and used in a conventional manner that [does] not impose meaningful limitations on the claimed invention.” Final Act. 7. The Examiner further concludes that there is “no indication that the combination of elements improves the functioning of a

computer or improves any other technology,” and that the “collective functions merely provide conventional computer implementation of the abstract concepts.” Final Act. 7–8. The Examiner determines that “the language is broad enough to cover actions ranging from conveying the improvements to be implemented, recoding a workflow process in a workflow system, or physically managing the implementation of workflow by human actors.” Ans. 7.

Appellant contends that the “the claimed invention recites that a computer hardware system causes the identified workflow improvement,” which is an “improvement to technology” and “not . . . directed to an abstract idea.” Appeal Br. 16; *see* Appeal Br. 17. Appellant also argues that the “claims require specific tools (e.g. a video capture device) and most of the claimed limitations necessarily involve the use of a computer system,” and are “not steps that can be performed in the human mind alone.” Appeal Br. 17.

Claim 23 does not constitute an improvement to computer technology; rather, it merely adapts the abstract idea of analyzing video data and comparing the video data to the data in a pattern library to identify and implement workflow improvements to an execution of steps performed by computers. *See* Spec. ¶¶ 25–36 (the “workflow proposal tool 115 can represent a software application configured to process the workflow video data 110 for a workflow process into one or more workflow proposal documents” and “define a series of steps based on analyzing the video content” that “correspond to patterns, which can be further analyzed to make recommendations, improvements, or to monitor compliance.”).

Relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible. *See Alice*, 573 U.S. at 224 (“use of a computer to create electronic records, track multiple transactions, and issue simultaneous instructions” is not sufficient to confer patent eligibility); *Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Can.* (U.S.), 687 F.3d 1266, 1278 (Fed. Cir. 2012) (a computer “employed only for its most basic function . . . does not impose meaningful limits on the scope of those claims”); MPEP § 2106.05(f)(2) (“Use of a computer or other machinery in its ordinary capacity for economic or other tasks (*e.g.*, to receive, store, or transmit data) or simply adding a general purpose computer or computer components after the fact to an abstract idea (*e.g.*, a fundamental economic practice or mathematical equation) does not provide significantly more.”). Moreover, the “mere automation of manual processes using generic computers does not constitute a patentable improvement in computer technology.” *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017).

Appellant further analogizes the claims here to the claims in *Enfish*. Appeal Br. 16 (citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016)). Specifically, Appellant contends that the limitations “link the claimed invention to an improvement being implemented on an existing process (i.e., workflow).” Appeal Br. 19.

Appellant misplaces its reliance on *Enfish*. In *Enfish*, the Federal Circuit decided that the claims satisfied § 101 under *Mayo/Alice* step one because they recited a “specific improvement to the way computers operate,” i.e., an improved database configuration that permitted faster and more efficient searching. *Enfish*, 822 F.3d at 1330–33, 1336, 1339. Further,

the Federal Circuit has explained that the claims in *Enfish* “did more than allow computers to perform familiar tasks with greater speed and efficiency” and “actually permitted users to launch and construct databases in a new way.” *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1305 (Fed. Cir. 2018); *see also Secured Mail Sols. LLC v. Universal Wilde, Inc.*, 873 F.3d 905, 910 (Fed. Cir. 2017) (explaining that the claims in *Enfish* “focused on an improvement to computer functionality itself”).

Unlike the claims in *Enfish*, the claims here do not improve computer functionality itself. *See* Final Act. 7–8; Ans. 6–7. For instance, the claims do not recite an advance in hardware or software that causes a memory itself or a processor itself to operate faster or more efficiently. As the Examiner properly reasons, the claimed additional elements (i.e., “a hardware processor and a machine-readable storage medium executed on a hardware computer system”) are each “a general-purpose device performing its usual computer function,” and are “generic and used in a conventional manner that [does] not impose meaningful limitations on the claimed invention.” Final Act. 7. Instead, the claims utilize a “computer hardware system [that] merely applies instructions to implement the judicial exception on a computer.” Ans. 6.

Accordingly, we are not persuaded of error in the Examiner’s determination that claim 23 is directed to an abstract idea, and we find the claimed additional elements do not integrate the abstract idea into a practical application.

USPTO Step 2B

Turning to step 2B of the USPTO Guidance, we look to whether claim 23 (a) adds a specific limitation or combination of limitations that are

not well-understood, routine, conventional activity in the field, or (b) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. Memorandum, 84 Fed. Reg. at 56.

The Examiner concludes that the claimed “video capture, recognition, and storage using a generic camera device and processing devices and video extraction software are . . . well-understood, routine and conventional activities common in the industry.” Final Act. 7.

Appellant argues that the “claims require specific tools (e.g., a video capture device) and most of the claimed limitations necessarily involve the use of a computer system.” Appeal Br. 17. Specifically, Appellant argues that the “claimed video capture device” is “a specific tool” and the “video capture device is not a generic computing device.” Reply Br. 8.

We are not persuaded by Appellant’s argument that the Examiner erred. As discussed above, claim 23 is directed to analyzing video data and comparing the video data to the data in a pattern library to identify and implement workflow improvements to an execution of steps practically performed by computers. Similarly, the additional elements in the claim amount to no more than mere instructions to apply the abstract idea using generic computer components, which is insufficient to provide an inventive concept. Specifically, the Specification describes the computer elements as generic computer elements, including “video capture devices” that “can represent a variety of electronic devices capable of video recording, such a video camera.” Spec. ¶ 25. The Specification further describes that the “workflow proposal tool 115 can represent a software application,” and the “workflow proposal engine 120 can correspond to a software component of

the workflow proposal tool.” Spec. ¶¶ 26, 30. As another example, the “data store 125 can be a physical or virtual storage space configured to store digital information” and “can be physically implemented within any type of hardware” as a “stand-alone storage unit as well as a storage unit formed from a plurality of physical devices.” Spec. ¶ 38. The computer includes a “processor” and can be “a general purpose computer, special purpose computer, or other programmable data processing apparatus.” Spec. ¶ 21. Accordingly, we agree with the Examiner that the additional claim limitations besides the abstract idea are well-understood, routine, and conventional elements.

Appellant does not direct our attention to anything in the Specification that indicates the computer components perform anything other than well-understood, routine, and conventional functions, such as receiving information (i.e., receiving video data), and analyzing the information to identify workflow improvements to be implemented (i.e., analyzing the video data and subsequently identified workflow pattern to generate performance data, comparing the analyzed video data with a library, comparing the performance data of matched workflows, and identifying workflow improvements based on the comparison of the performance data). *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); *CyberSource Corp.*, 654 F.3d at 1370 (use of Internet to verify credit card transaction does not add enough to abstract idea of verifying the transaction); *see also* MPEP § 2106.05(d) (“Courts have held computer-implemented processes not to be significantly more than an abstract idea (and thus ineligible) where the claim as a whole amounts to nothing more than generic computer functions merely used to implement an abstract idea, such as an idea that could be done by a human analog (i.e., by hand or by merely thinking).”).

Further, Appellant’s argument that the pending claims are patent eligible because they are otherwise novel and non-obvious (*see* Reply Br. 5–6) is not persuasive because it improperly conflates the requirements for eligible subject matter (§ 101) with the independent requirements of novelty (§ 102) and non-obviousness (§ 103). Although the second step in the *Alice* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness. *Alice*, 573 U.S. at 217–18. A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent ineligible. *See Mayo*, 566 U.S. at 78–79. Further, “under the *Mayo/Alice* framework, a claim directed to a newly discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the novelty of that discovery for the inventive concept necessary for patent eligibility.” *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016).

Conclusion on Section 101 Rejection

Accordingly, we sustain the Examiner’s rejection of claim 23 as being directed to patent-ineligible subject matter, as well as independent claims 28

Appeal 2018-008429
Application 12/824,712

and 33 with commensurate limitations, and dependent claims 24–27, 29–32, and 34–37, not separately argued.

DECISION

We affirm the Examiner’s § 101 rejection of claims 23–37.

We affirm the Examiner’s § 112, first paragraph, rejection of claims 23–37.

In summary:

Claims Rejected	Basis	Affirmed	Reversed
23–37	§ 101	23–37	
23–37	§ 112, first paragraph	23–37	
Overall Outcome		23–37	

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED