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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GREGORY JAMES LIPINSKI and RICHARD GEORGE KENDERS

Appeal 2018-008463
Application 14/982,857
Technology Center 2100

Before ROBERT E. NAPPI, JENNIFER S. BISK, and BETH Z. SHAW, *Administrative Patent Judges.*

SHAW, *Administrative Patent Judge.*

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant,[1] appeals from the Examiner's decision to reject claims 1–20. Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] We use the word "Appellant" to refer to "Applicant" as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as CA, Inc. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The claims are directed to detecting "flapping" in resource measurements. Spec. ¶¶ 1, 2. Claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. A method comprising:
>
> determining a series of differences between successive resource measurements over a time window, wherein each of the resource measurements corresponds to a different time instant;
>
> determining a sum of each series of differences in a same direction;
>
> determining whether any of the sums have a magnitude that satisfies a first threshold; and
>
> in response to a determination that one or more of the sums have a magnitude that satisfies the first threshold, indicating that flapping of a resource has occurred in the time window, wherein the resource corresponds to the resource measurements.

Appeal Br. 14 (Claims Appendix).

REJECTION

Claims 1–20 are rejected under 35 U.S.C. § 101. Final Act. 4.

OPINION

Appellant argues the pending claims as a group. *See* Appeal Br. 6–12. As permitted by 37 C.F.R. § 41.37, we decide the appeal based on claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2016).

Section 101 of the Patent Act provides that "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" is patent eligible. 35 U.S.C. § 101. But the Supreme Court has long recognized an implicit exception to this section: "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)). To determine whether a claim falls within one of these excluded categories, the Court has set out a two-part framework. The framework requires us first to consider whether the claim is "directed to one of those patent-ineligible concepts." *Alice*, 573 U.S. at 217. If so, we then examine "the elements of each claim both individually and 'as an ordered combination' to determine whether the additional elements 'transform the nature of the claim' into a patent-eligible application." *Alice*, 573 U.S. at 217 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78, 79 (2012)). That is, we examine the claims for an "inventive concept," "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*, 573 U.S. at 217–18 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

The Patent Office recently issued guidance about this framework. *See* 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) ("2019 Eligibility Guidance"). Under the guidance, to decide whether a claim is "directed to" an abstract idea, we evaluate whether the claim (1) recites an abstract idea grouping listed in the guidance *and* (2) fails to integrate the recited abstract idea into a practical application. *See* 2019 Eligibility Guidance, 84 Fed. Reg. at 51. If the claim is "directed to" an abstract idea, as noted above, we then determine whether the claim recites an inventive concept. The 2019 Eligibility Guidance explains that when making this determination, we should consider whether the additional claim elements add "a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field" or "simply

append[] well-understood, routine, conventional activities previously known to the industry." 2019 Eligibility Guidance, 84 Fed. Reg. at 56.

With these principles in mind, we turn to the Examiner's § 101 rejection.

Abstract idea

Turning to Step 2A, Prong 1, the claimed method includes the following calculations:

> *determining a series of differences between successive resource measurements over a time window, wherein each of the resource measurements corresponds to a different time instant;*
> *determining a sum of each series of differences in a same direction;* and
> *determining whether any of the sums have a magnitude that satisfies a first threshold*.

The claim also recites, "in response to a determination that one or more of the sums have a magnitude that satisfies the first threshold," "indicating that flapping of a resource has occurred in the time window, wherein the resource corresponds to the resource measurements."

Claim 1 recites an abstract idea grouping listed in the 2019 Eligibility Guidance: "mental processes." *See* 2019 Eligibility Guidance, 84 Fed. Reg. at 52, 53 (listing "[m]ental processes—concepts performed in the human mind (including an observation, evaluation, judgment, opinion)" as one of the "enumerated groupings of abstract ideas" (footnote omitted)). The guidance explains that "mental processes" include acts that people can perform in their minds or using pen and paper, even if the claim recites that a generic computer component performs the acts. *See* 2019 Eligibility Guidance, 84 Fed. Reg. at 52 n.14 ("If a claim, under its broadest reasonable interpretation, covers performance in the mind but for the recitation of

generic computer components, then it is still in the mental processes category unless the claim cannot practically be performed in the mind."); *see also 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."), *quoted in* 2019 Eligibility Guidance, 84 Fed. Reg. at 52 n.14; *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d. 1314, 1324 (Fed. Cir. 2016) (holding that computer-implemented method for "'anonymous loan shopping'" was an abstract idea because it could be "'performed by humans without a computer'"); *quoted in* 2019 Eligibility Guidance, 84 Fed. Reg. at 52 n.14.

The method recited in claim 1 executes steps that people can perform in their minds or using pen and paper. A person can perform each of the steps of claim 1 by using his or her mind (or pen and paper) in the claimed manner. For example, a person can determine "a series of differences between successive resource measurements over a time window, wherein each of the resource measurements corresponds to a different time instant," using his or her mind or pen and paper. A person can determine "a sum of each series of differences in the same direction" using his or her mind or pen and paper. A person can determine "whether any of the sums have a magnitude that satisfies a first threshold" using his or her mind or pen and paper. Accordingly, claim 1 recites a mental process, and thus an abstract idea.

Turning to Step 2A, Prong 2, there are no remaining elements recited in claim 1 that could integrate the abstract idea into a practical application.

Moreover, as the Examiner points out, claim 1 does not recite any computer related technology. *See* Ans. 8.

Thus, the claims do not integrate the judicial exception into a practical application. The claims do not (1) improve the functioning of a computer or other technology, (2) are not applied with any particular machine (except for a generic computer), (3) do not effect a transformation of a particular article to a different state, and (4) are not applied in any meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception. *See* MPEP §§ 2106.05(a)–(c), (e)–(h).

Inventive Concept

Because we determine claim 1 is "directed to" an abstract idea, we consider whether claim 1 recites an "inventive concept." Appellant contends "the claims have the aspect of being directed to determining sums of monotonic series of differences of resources measurements." Reply Br. 3; Appeal Br. 9. But these elements form part of the recited abstract idea, and thus are not "additional elements" that "'transform the nature of the claim' into a patent-eligible application." *Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 78); *see also* 2019 Eligibility Guidance, 84 Fed. Reg. at 55 n.24 ("USPTO guidance uses the term 'additional elements' to refer to claim features, limitations, and/or steps that are recited in the claim *beyond the identified judicial exception*." (emphasis added)).

Appellant contends the Examiner erred in rejecting the claims under 35 U.S.C. § 101, because the claims do not preempt others from using the abstract idea. Appeal Br. 11–12. We are not persuaded of Examiner error by this argument. Preemption is a driving concern when determining patent

eligibility. *See Alice*, 573 U.S. at 216–17. Patent law cannot inhibit further discovery by improperly tying up the future use of the building blocks of human ingenuity. *See id.* (citing *Mayo*, 566 U.S. at 85–86). Although preemption is characterized as a driving concern for patent eligibility, preemption itself is not the test for patent eligibility. "Where a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot." *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." *Id.*

Appellant argues in the Reply Brief that the Examiner must provide support for elements that are dismissed as "well-understood, routine, or conventional." Reply Br. 3–4. Appellant refers to the *Berkheimer* memorandum.[2] *Id.* However, this argument is unavailing because Appellant does not provide evidence to support this argument and persuade us of error. Appellant does not point us to any place in the record where the Examiner determined any elements were well-understood, routine, or conventional.

For at least the above reasons, we agree with the Examiner that claim 1 is directed to an abstract idea and does not recite an inventive concept. Accordingly, we sustain the Examiner's rejection of claims 1–20 under 35 U.S.C. § 101.

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

DECISION

The Examiner's rejection is affirmed.

SUMMARY

Claims Rejected	Basis	Affirmed	Reversed
# 1–20	§ 101	# 1–20	

FINALITY AND RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED