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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL SANDOVAL and OLIVER BRUCE DOWNS

Appeal 2018-008664
Application 12/392,908
Technology Center 3600

Before BIBHU R. MOHANTY, CYNTHIA L. MURPHY, and
AMEE A. SHAH, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–38 and 40–46. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

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 Veritone, Inc. Appeal Br. 2.

CLAIMED SUBJECT MATTER

The Appellant's claimed invention relates to computing systems and software for the collection, development, analysis, and use of profile attributes (Spec., para. 2). Claim 27, reproduced below with the italics added, is representative of the subject matter on appeal.

27. A method for providing selected content from a provider to an entity, the method comprising:

storing electronic profiles in profile storage of a profiling system, each of the electronic profiles including a plurality of preferences for each respective entity and at least one profile attribute for a respective entity;

receiving, at the profiling system, *information identifying an entity and search criteria*;

accessing selected ones of the plurality of preferences of the electronic profile associated with the entity, wherein the selected preferences are based, at least in part, on a context of the receipt of the search criteria;

computing a degree of at least one of relevance, irrelevance, or combinations thereof of provider content stored at a provider system, different from the profiling system, according to the search criteria and the selected ones of the plurality of preferences of the entity to provide scoring results to the provider system, wherein the electronic profile associated with the entity is not directly accessible to the provider system;

analyzing the scoring results for the provider content; and
providing, by the provider system, *selected content to the entity in accordance with the scoring results*.

THE REJECTION

The following rejection is before us for review:

Claims 1–38 and 40–46 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.²

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellant argues that the rejection of claim 27 is improper because the claim is not directed to an abstract idea (Appeal Br. 20–24, 44–46; Reply Br. 4–8). The Appellant argues further that the claim is “significantly more” than the alleged abstract idea (Appeal Br. 24–26, 46; Reply Br. 8–14).

In contrast, the Examiner has determined that the rejection of record is proper (Final Action 2–10; Ans. 3–11).

We agree with the Examiner. 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*. *Alice*, 573 U.S. at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

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, 67 (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 (1853))); 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.”).

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) (“Guidance”). Under the 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, i.e., evaluate whether the claim “appl[ies], rel[ies] on, or use[s] 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.” (*see* Guidance, 84 Fed. Reg. at 54; *see also* MPEP § 2106.05(a)–(c), (e)–(h)).

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 Guidance.

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 (citation 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 Specification at paragraph 2 states that the invention generally relates to computing systems and software for the collection, development, analysis, and use of profile attributes. Here, the Examiner has determined that the claim sets forth “[c]omparing new user information with stored content information and user profile information and using rules to identify the relevance of the stored content information with the user profile information and provide scoring results for the scored content information” and is an abstract concept similar to “collecting and comparing known information” (Final Act. 3) (emphasis omitted). We substantially agree with the Examiner. We determine that the claim sets forth the subject matter in italics above which describes the concept of matching profiles with search criteria to compute scoring results to determine which results to provide a user which is a certain method of organizing human activities, i.e., a judicial exception. *See Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016) where collecting information, analyzing it, and displaying results from certain results of the collection and analysis was held to be an abstract idea. Courts have also found claims directed to collecting, recognizing, and storing data in a computer memory to be directed to an abstract idea. *Content Extraction and Transmission LLC v. Wells Fargo*

Bank, National Association, 776 F.3d 1343 (Fed. Cir. 2014). A system, like the claimed system, that implements “a process that employs mathematical algorithms to manipulate existing information to generate additional information is not patent eligible.” *Digitech Image Techs, LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014). In *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369 (Fed. Cir. 2015), tailoring content on a website based on a user’s location and time of day was held to be a fundamental economic practice and directed to an abstract idea. Thus, we determine that the claim relates to the judicial exception identified above.

We next determine whether the claim recites additional elements in the claim to integrate the judicial exception into a practical application. *See* Guidance, 84 Fed. Reg. at 54–55. The Revised Guidance references the MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) §§ 2106.05(a)–(c) and (e)–(h).

Here, the claims do not improve computer functionality, improve another field of technology, utilize a particular machine, or effect a particular physical transformation. Rather, we determine that nothing in the claims imposes a meaningful limit on the judicial exception, such that the claims are more than a drafting effort to monopolize the judicial exception.

For example, in claim 27 the steps of [1] “storing electronic profiles,” [2] “receiving . . . information identifying an entity and search criteria,” [3] “accessing selected ones of the plurality of preferences of the electronic profile associated with the entity,” [4] “computing a degree of at least one of relevance, irrelevance, or combinations thereof of provider content stored at a provider system,” [5] “analyzing the scoring results for the provider

content,” and [6] “providing . . . selected content to the entity in accordance with the scoring results” are merely steps performed by a generic computer that do not improve computer functionality. That is, these recited steps [1]–[6] “do not . . . purport to improve the functioning of the computer itself” but are merely generic functions performed by a conventional processor. *Alice*, 573 U.S. at 255. Likewise, these same steps [1]–[6] listed above do not improve the technology of the technical field and merely use generic computer components and functions to perform the steps. Also, the recited method steps [1]–[6] above do not require a “particular machine” and can be utilized with a general purpose computer, and the steps performed are purely conventional. In this case, the general purpose computer is merely an object on which the method operates in a conventional manner. Further, the claim as a whole fails to effect any particular transformation of an article to a different state. The recited steps [1]–[6] fail to provide meaningful limitations to limit the judicial exception and rather are mere instructions to apply the method to a generic computer.

Considering the elements of the claim both individually and as “an ordered combination” the functions performed by the computer system at each step of the process are purely conventional. Each step of the claimed method does no more than require a generic computer to perform a generic computer function. Thus, the claimed elements have not been shown to integrate the judicial exception into a practical application as set forth in the Revised Guidance which references the MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) §§ 2106.05(a)–(c) and (e)–(h).

Turning to the second step of the *Alice* and *Mayo* framework, we determine that the claim does not contain an inventive concept sufficient to “transform” the abstract nature of the claim into a patent-eligible application. Considering the claim both individually and as an ordered combination fails to add subject matter beyond the judicial exception that is not well-understood, routine, and conventional in the field. Rather the claim uses well-understood, routine, and conventional activities previously known in the art and they are recited at a high level of generality. The Specification, at paragraphs 26–31 for example, describes using conventional computer components such as a processor, memory, cell phone, and personal computer in a conventional manner. The claim specifically includes recitations for computers to implement the method, but these computer components are all used in a manner that is well-understood, routine, and conventional in the field. The Appellant has not shown these claimed generic computer components which are used to implement the claimed method are not well-understood, routine, or conventional in the field. Here, the claim has not been shown to be “significantly more” than the abstract idea.

The Appellant at page 21 of the Appeal Brief and page 6 of the Reply Brief has also cited to *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016), but the claims in that case are distinguished from this case in being directed to rules for lip sync and facial expression animation.

For these above reasons the rejection of claim 27 is sustained. The remaining independent claims are directed to similar subject matter for which similar arguments have been presented and the rejection of these claims is sustained as well.

With respect to claims 7, 24, 25, 37, 40–42, 44, 46, the Appellant argues that specific limitations in each claim improve the operation of the computing systems (Appeal Br. 27, 33, 35, 39, 42, 44, 46, 47; Reply Br. 15, 16). We have reviewed these arguments but determine that these claims are substantially similar in scope to claim 27 as addressed above and the rejection of these claims is sustained. Here, the separately argued claim limitations are conventional computer operations and fail to transform the abstract nature of the claim into “significantly more.” For example, in claim 24, providing access to multiple content items in the manner claimed is considered to be a conventional computer operation and fails to transform the abstract nature of the claim. Similarly in claim 45, having an interface configured to communicate with a profiling system is conventional computer operation and fails to transform the abstract nature of the claim. In claim 46, the claim limitations drawn to access if “permissions” are met is also considered a conventional computer operation and fails to transform the abstract nature of the claim.

The Appellant has provided the same arguments for the remaining claims which are drawn to similar subject matter as claim 27 addressed above and the rejection of these claims is sustained for the same reasons given above.

CONCLUSIONS OF LAW

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 1–38 and 40–46 under 35 U.S.C. § 101.

DECISION SUMMARY

In summary:

| Claims Rejected | 35 U.S.C. § | Reference(s)/Basis | Affirmed | Reversed |
|------------------------|--------------------|---------------------------|-----------------|-----------------|
| 1-38, 40-46 | 101 | Eligibility | 1-38, 40-46 | |

TIME PERIOD FOR 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