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jngross@pacbell.net

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN N. GROSS

Appeal 2018-008890
Application 13/551,454
Technology Center 3600

Before ROBERT E. NAPPI, MARC S. HOFF, and
JOYCE CRAIG, *Administrative Patent Judges*.

CRAIG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant¹ filed a Request for Rehearing (hereinafter “Request”) dated January 29, 2020, seeking reconsideration of our Decision, mailed January 28, 2020 (“Decision”), in which we affirmed the rejection of claims 16–46 under 35 U.S.C. § 101.

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 for this appeal as “the John Nicholas and Kristin Gross Trust U/A/D April 13, 2010.” Appeal Br. 3.

ANALYSIS

Appellant's Request is limited to one issue, i.e., Appellant asks the Board to designate its decision as a new ground of rejection. *See* Request 2. We grant the Request.

An appellant may include such a request in a request for rehearing before the Board:

(c) Review of undesignated new ground of rejection. Any request to seek review of a panel's failure to designate a new ground of rejection in its decision must be raised by filing a request for rehearing as set forth in §41.52. Failure of appellant to timely file such a request for rehearing will constitute a waiver of any arguments that a decision contains an undesignated new ground of rejection.

37 C.F.R. § 41.50(c).

In its Request, Appellant asserts that the Board's formulation of the abstract idea was different than the Examiner's formulation of the abstract idea for claims 16–26. Request 1–2. In particular, Appellant states that “the Examiner distilled the claim down to ‘collecting . . . analyzing . . . and displaying,’” while the Board affirmed the § 101 rejection on the basis that the claims are directed to mental processes. *Id.* (citing Non-Final Act. 3, Decision 7).

We agree with this characterization of the Examiner's determinations with regard to claims 16–26 in the Non-Final Action. *See* Non-Final Act. 3. In addition, we note that the Examiner stated in the Final Action that the abstract idea was “collecting data associated with an e-commerce site operations by testing item delivery performance of items ordered from an ecommerce site with a computing system.” *Id.* With regard to claims 27–34 and 42–46, the Examiner characterized the abstract idea as “a mathematical

relationship relating to the performance of a provider of items.” Non-Final Act. 6.

Appellant states that the Board describes the abstract idea as “processes that can be performed in the human mind or practically with pen and paper.” Request 2. This was indeed what the Board determined. Decision 7–8. The Decision relied on the category of mental processes, whereas the Examiner relied on the concepts of collecting, analyzing, and displaying information (Non-Final Act. 3, citing *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016)) and a mathematical relationship (Non-Final Act. 6). The Board also provided additional analysis of the claims under the current § 101 guidance, which we do not reproduce at this time. *See* Decision 5–22.

Appellant argues that the Board’s formulation was not based on the Examiner’s formulation and included new language. Request 2. On the facts of this case, we determine that it is reasonable to designate the Decision as containing a new ground of rejection. Accordingly, we grant the request.

DECISION

In view of the foregoing, the panel has granted Appellant’s Request. In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/ Basis	Granted	Denied	New Ground
16–46	101	Eligibility	16–46		16–46

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 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 prosecution 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. . . .

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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).

GRANTED; 37 C.F.R. § 41.50(b)