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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MARK EDWARD SHEPHERD,  
MICHAEL JAMES ANDREW SMITH, GEORGE COMNINOS, and  
GAVIN MURRAY PEACOCK

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Appeal 2018-008904  
Application 13/829,844  
Technology Center 2100

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BEFORE ROBERT E. NAPPI, JOHN A. EVANS, and  
LINZY T. McCARTNEY, *Administrative Patent Judges*.

McCARTNEY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> seeks review under 35 U.S.C. § 134(a) of the Examiner's final rejection of claims 1 and 3–20. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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<sup>1</sup> Appellant identifies the real party in interest as Adobe Systems Incorporated. Appeal Brief 4, filed March 27, 2018 (“App. Br.”).

## BACKGROUND

This patent application concerns visually combining instrumentation and sampling data. *See* Specification ¶¶ 1, 26, filed March 14, 2013

(“Spec.”). Claim 1 illustrates the claimed subject matter:

1. A computerized method of visually depicting instrumented and sampled data, the method comprising:

accessing a first stream of instrumented data, the instrumented data collected via execution of code contained in a user-scriptable engine;

accessing a second stream of sampled data, the sampled data collected by monitoring execution of code contained in scripts executed by the user-scriptable engine;

simultaneously displaying an aggregated version of a portion of the instrumented data and an aggregated version of a first portion of the sampled data in one or more viewing regions;

receiving a user interaction directly selecting a displayed native function associated with a subset of the aggregated version of the portion of the instrumented data; and

in response to receiving the user interaction selecting the native function, filtering the aggregated version of the first portion of the sampled data to change to depict only an aggregated version of a second portion of the sampled data that corresponds to sampled data taken while executing the native function.

App. Br. 37.

REJECTIONS<sup>2</sup>

Claims	35 U.S.C. §	References
1, 3–11, 14–20	101	
1, 3–11, 14–18, 20	103(a)	Reilly, <sup>3</sup> Fanning <sup>4</sup>
19	103(a)	Reilly, Fanning, Smith <sup>5</sup>

DISCUSSION

We have reviewed the Examiner’s rejections and Appellant’s arguments, and we agree with Appellant that the Examiner has not shown that claims 1, 3–11, and 14–20 are directed to an abstract idea under § 101 or would have been obvious under § 103. We address these rejections in turn.

Section 101 Rejection

The Examiner determined that claims 1, 3–11, and 14–20 are “directed to the abstract idea of merely aggregating data for a presentation in a view.” Final Office Action 10–11, mailed September 25, 2017 (“Final Act.”). The Examiner determined that the additional elements recited in these claims perform well-understood, routine, and conventional activities but cited no evidence in support of this determination. *See* Final Act. 3; Ans. 22.

Appellant argues that claims 1, 3–11, and 14–20 are patent eligible

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<sup>2</sup> The Examiner withdrew the rejections of claim 12 under § 101 and § 103. Examiner’s Answer 3, mailed July 25, 2018 (“Ans.”). Because claim 13 depends from claim 12, we understand the Examiner to also have withdrawn the rejections of claim 13 under § 101 and § 103.

<sup>3</sup> Reilly (US 8,074,207 B1; Dec. 6, 2011).

<sup>4</sup> Fanning et al. (US 2013/0249917 A1; Sept. 26, 2013).

<sup>5</sup> Smith (US 2005/0067498 A1; Mar. 31, 2005).

because they are similar to the patent-eligible claims in the *McRO*,<sup>6</sup> *DDR*,<sup>7</sup> and *Core Wireless*<sup>8</sup> decisions. *See* App. Br. 7–13. Appellant also contends that the Examiner failed to provide the required evidence that the recited additional elements perform well-understood, routine, and conventional activities. *See* Reply Brief 3–5, filed September 19, 2018 (“Reply Br.”).

Appellant has persuaded us that the Examiner erred. 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 [the] 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 claim for an “inventive concept,” “an element or combination of elements

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<sup>6</sup> *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016).

<sup>7</sup> *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014).

<sup>8</sup> *Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, 880 F.3d 1356 (Fed. Cir. 2018).

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 has revised its guidance about this framework. *See* 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Revised Guidance”); *see also* USPTO, 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> (“Berkheimer Memo”). As relevant here, the Revised Guidance explains that, when determining whether a claim has an inventive concept, an examiner 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 specified at a high level of generality.” Revised Guidance, 84 Fed. Reg. at 56.

Whether additional claim elements add well-understood, routine, conventional activities is a factual determination that an examiner must support in at least one of the ways specified in the Berkheimer Memo. *See* Berkheimer Memo 2–4. The specified ways include citing (1) “an express statement in the specification or to a statement made by an applicant during prosecution that demonstrates the well-understood, routine, conventional nature of the additional element(s),” (2) “one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine,

conventional nature of the additional element(s),” (3) “a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s),” or (4) “taking official notice of the well-understood, routine, conventional nature of the additional element(s).” Berkheimer Memo 3, 4.

Here, the Examiner has not adequately supported the finding that the additional elements recited in claims 1, 3–11, and 14–20 add well-understood, routine, and conventional activities. The Examiner determined that the recited additional elements include “a computer infrastructure, a processor, a computer usable storage device, and a computer system comprising a CPU, a computer readable memory and a computer readable storage media.” Final Act. 3. The Examiner found that these elements perform well-understood, routine, and conventional activities, but the Examiner cited no support for this finding, much less provided the support required by the Berkheimer Memo. *See* Final Act. 3; Ans. 3. As a result, we do not sustain the Examiner’s § 101 rejection of claims 1, 3–11, and 14–20.

#### Section 103 Rejection

Claim 1 recites “receiving a user interaction directly selecting a displayed native function associated with a subset of the aggregated version of the portion of the instrumented data” and “in response to receiving the user interaction selecting the native function, filtering the aggregated version of the first portion of the sampled data to change to depict only an aggregated version of a second portion of the sampled data that corresponds to sampled data taken while executing the native function.” App. Br. 37. Appellant argues that the Examiner’s combination of Reilly and Fanning does not teach or suggest these limitations. *See* App. Br. 20–25. According

to Appellant, the Examiner acknowledged that Reilly does not explicitly teach or suggest these limitations. *See* App. Br. 21–22. Appellant contends that the cited portions of Fanning do not teach or suggest depicting only the recited second portion of the sampled data in response to a user selecting a native function associated with the recited portion of the instrumented data as required by the disputed limitations. *See* App. Br. 20–25.

Appellant has persuaded us that the Examiner erred. The Examiner found that Reilly “may not explicitly teach” the disputed limitations but Fanning remedies these deficiencies. *See* Final Act. 7–15; Ans. 26–29. The Examiner found that Fanning discloses, for example, that “native functions . . . are checked with associated visual depictions synchronized provided” in respective windows and that “‘native functions’ . . . as diagnostic messages are selectable with visual depictions . . . synchronized upon selection.” *See* Ans. 27, 28; *see also* Final Act. 8–9, 14–15. The Examiner also found that Fanning discloses that a user can create a query that returns filtered results. *See* Ans. 28; *see also* Final Act. 8–9, 14–15. Even if Fanning adequately supports these general teachings, as argued by Appellant, the Examiner has not adequately explained how these disclosures teach or suggest “in response to receiving the user interaction selecting the native function [associated with a subset of the aggregated version of the portion of *the instrumented data*], filtering the aggregated version of the first portion of *the sampled data* to change to depict *only* an aggregated version of a second portion of *the sampled data that corresponds to sampled data taken while executing the native function*” as recited in claim 1. As a result, we do not sustain the Examiner’s obviousness rejection of claim 1 and its dependent claims. Because the Examiner’s obviousness rejections of independent

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claims 9 and 15 and their respective dependent claims suffer from similar flaws, we also do not sustain the Examiner's rejections of these claims.

CONCLUSION

<b>Claims</b>	<b>35 U.S.C. §</b>	<b>References</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 3-11, 14-20	101			1, 3-11, 14-20
1, 3-11, 14-18, 20	103(a)	Reilly, Fanning		1, 3-11, 14-18, 20
19	103(a)	Reilly, Fanning, Smith		19
<b>Overall Outcome</b>				1, 3-11, and 14-20

REVERSED