



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.
14/586,661	12/30/2014	Ing-Marie Jonsson	1301-055U	1305
112025	7590	01/02/2020	EXAMINER	
Shutts & Bowen LLP Steven M. Greenberg, Esq. 525 Okeechobee Blvd # 1100 West Palm Beach, FL 33401			KYEREME-TUAH, AKOSUA P	
			ART UNIT	PAPER NUMBER
			3623	
			NOTIFICATION DATE	DELIVERY MODE
			01/02/2020	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):

docketing@crgolaw.com
patents@shutts.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ING-MARIE JOHNSON
and MARIA ZOLOTOVA

Appeal 2018-009148
Application 14/586,661
Technology Center 3600

Before: ROBERT E. NAPPI, JOHN A. EVANS, and
JASON J. CHUNG, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant¹ filed a paper under 37 C.F.R. § 41.52 requesting reconsideration of our September 30, 2019, Decision (“Dec.”) in which we affirmed the Examiner’s rejections of claims 1, 6, 7, 12, 13, and 18 under 35 U.S.C. § 101 as being directed to patent ineligible subject matter. Req. Reh’g 2–6.

For the reasons stated below, however, we deny the request to modify our Decision.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. According to Appellant, SugarCRM is the real party in interest. Appeal Br. 2.

APPLICABLE REQUEST FOR REHEARING RULES

Appellants “may file a single request for rehearing within two months of the date of the original decision of the Board.” 37 C.F.R. § 41.52(a)(1). “Arguments not raised, and Evidence not previously relied upon . . . are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) through (a)(4).” *Id.* Permitted new arguments are limited to: (a) new arguments based upon a recent relevant decision of either the Board or a Federal Court; (b) new arguments responding to a new ground of rejection designated pursuant to § 41.50(b); or (c) new arguments that the Board’s decision contains an undesignated new ground of rejection. *See* 37 C.F.R. § 41.52(a)(2)–(4).

Appellant argues that pursuant to the USPTO November 2, 2019 Memorandum of the Deputy Commissioner and the USPTO Commissioner for Patents Memorandum dated Apr. 9, 2018, “Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision” (*Berkheimer v. HP, Inc.*) (hereinafter “*Berkheimer Memo*”), the Decision overlooks that the Examiner fails to provide a prior art reference as evidence to support their finding that the additional elements are well-understood, routine, and conventional. Req. Reh’g 2–6. We disagree with Appellant.

The *Berkheimer* Memo points out that an abstract idea implemented on generic components is found to be well-understood, routine, and conventional only if an examiner expressly finds: (1) a citation to an express statement in the specification; (2) a citation to a court decision noting the well-understood, routine, and conventional nature of the combination of elements; (3) a citation to a publication that demonstrates the well-

understood, routine, and conventional nature of the combination of elements; or (4) a statement of Official Notice of the well-understood, routine, and conventional nature of the combination. *Berkheimer* Memo. Stated differently, from elements (1) through (4) of the preceding sentence, it is sufficient for the Examiner to meet the requirements of merely one element to support their well-understood, routine, and conventional finding. *Id.*

As noted in our Decision, the Examiner finds the abstract idea is implemented on generic components that are well-understood, routine, and conventional. Dec. 6, 9 (citing Final Act 2–3 (citing Spec. ¶¶ 21, 27, 28); Ans. 4 (citing Spec. ¶¶ 21, 27, 28)). That is, the Examiner met the requirement for element number (1) (i.e., a citation to an express statement in the specification) discussed in the preceding paragraph.

In addition, Appellant’s argument that the present claims recite features that were not known previously because there are no obviousness or novelty rejections of the claims, (Req. Reh’g 2–6), Appellant improperly conflates the requirements for eligible subject matter (§ 101) with the independent requirements of novelty (§ 102) and non-obviousness (§ 103). “The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diehr*, 450 U.S. at 188–89; *see also Genetic Techs.*, 818 F.3d at 1376 (stating that, “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”).

Appeal 2018-009148
Application 14/586,661

Accordingly, we have considered Appellant's argument raised in the Request, but this argument does not persuade us that the Decision was in error.

CONCLUSION

Claims	35 U.S.C. §	Reference(s)/Basis	Denied	Granted
1, 6, 7, 12, 13, 18	101	Eligibility	1, 6, 7, 12, 13, 18	

DENIED