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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/493,390	06/11/2012	Keyvan Rafei	11-199-US	5817
98804	7590	01/29/2020	EXAMINER	
Reed Smith LLP P.O. Box 488 Pittsburgh, PA 15230			GARCIA-GUERRA, DARLENE	
			ART UNIT	PAPER NUMBER
			3683	
			NOTIFICATION DATE	DELIVERY MODE
			01/29/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KEYVAN RAFEI, ALEX TARANENKO,
SALEH AL-GHAFARI, DERAR ALI, and JENNIFER LOPATIN

Appeal 2019-001378
Application 13/493,390
Technology Center 3600

Before HUBERT C. LORIN, NINA L. MEDLOCK, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s rejection of claims 1–30. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED INVENTION

Appellant’s claimed invention “relates to a system and method for determining the level of influence of a group of persons” (Spec. ¶ 2).

Claims 1, 11, and 21 are the independent claims on appeal. Claim 1, reproduced below with bracketed notations added, is illustrative of the claimed subject matter:

1. A computer-implemented method executed by one or more computing devices for determining the level of influence of a group of persons, comprising:

[(a)] populating, by at least one of the one or more computing devices, biographical data for at least one member of the group of persons by searching a plurality of network sources for information relevant to the at least one member of the group of persons, scraping the information relevant to the at least one member of the group of persons, and storing the information relevant to the at least one member of the group of persons in at least one data structure;

¹ We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Our decision references Appellant’s Appeal Brief (“Appeal Br.,” filed June 18, 2018) and Reply Brief (“Reply Br.,” filed December 5, 2018), and the Examiner’s Answer (“Ans.,” mailed October 5, 2018) and Non-Final Office Action (“Non-Final Act.,” mailed May 17, 2017). Appellant identifies Geographic Services, Inc. as the real party in interest. Appeal Br. 1.

[(b)] determining, by at least one of the one or more computing devices, a level of influence score for the at least one member of a group of persons based on the biographical data corresponding to the at least one member of the group of persons stored in the at least one data structure;

[(c)] aggregating, by at least one of the one or more computing devices, the level of influence scores for the at least one member of the group of persons;

[(d)] determining, by at least one of the one or more computing devices, a composite level of influence for the group of persons based on the aggregate level of influence score;

[(e)] monitoring, by at least one of the one or more computing devices, the plurality of network sources for additional information relevant to the at least one member of the group of persons; and

[(f)] in response to detecting additional information relevant to the at least one member of the group of persons, updating, by at least one of the one or more computing devices, the at least one data structure, the level of influence score for the at least one member of a group of persons, the aggregate level of influence score, and the composite level of influence for the group of persons.

REJECTION

Claims 1–30 are rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.

ANALYSIS

Appellant argues the pending claims as a group (Appeal Br. 4–17). We select independent claim 1 as representative. The remaining claims, thus, stand or fall with claim 1. *See* 37 C.F.R. §41.37(c)(1)(iv).

Under 35 U.S.C. § 101, an invention is patent eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101

to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp.*, 573 U.S. at 217. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78). This is “a search for an ‘inventive concept’ — *i.e.*, 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.’” *Id.* at 217–18 (alteration in original).

We are not persuaded, as an initial matter, by Appellant’s argument that the Examiner has failed to establish a *prima facie* case of patent eligibility (Appeal Br. 6–10). The Federal Circuit has observed repeatedly that “the *prima facie* case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). The court has, thus, held that the USPTO carries its

procedural burden of establishing a prima facie case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for the rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (alteration in original). Thus, what is required of the Office is that it sets forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. *Id.*; *see also Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (“Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

Here, in rejecting the pending claims under 35 U.S.C. § 101, the Examiner analyzed the claims in accordance with the *Mayo/Alice* two-step framework, and consistently with the USPTO guidance in effect at the time the Non-Final Office Action was mailed. The Examiner, thus, notified Appellant that claim 1 is directed to “determining the level of influence of a group of persons,” i.e., to a method of organizing human activity, an idea of itself, and/or a mental process, and, therefore, to an abstract idea (Non-Final Act. 8–10) and that the claim does not include additional elements that are sufficient to amount to significantly more than the abstract idea itself (*id.* at 10–12). The Examiner explained that claims 2–30 are patent ineligible based on the same rationale (*id.* at 12).

The Examiner, in our view, set forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of 35 U.S.C. § 132. And we find that, in doing so, the Examiner established a prima facie case of patent ineligibility.

After Appellant’s briefs were filed, and the Examiner’s Answer mailed, the U.S. Patent and Trademark Office (the “USPTO”) published revised guidance on January 7, 2019 for use by USPTO personnel in evaluating subject matter eligibility under 35 U.S.C. § 101. 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50, 57 (Jan. 7, 2019) (the “2019 Revised Guidance”). That guidance revised the USPTO’s examination procedure with respect to the first step of the *Mayo/Alice* framework by (1) “[p]roviding groupings of subject matter that [are] considered an abstract idea”; and (2) clarifying that a claim is not “directed to” a judicial exception if the judicial exception is integrated into a practical application of that exception. *Id.* at 50. The 2019 Revised Guidance, by its terms, applies to all applications, and to all patents resulting from applications, filed before, on, or after January 7, 2019. *Id.*^{2,3}

Step One of the Mayo/Alice Framework (2019 Revised Guidance, Step 2A)

The first step in the *Mayo/Alice* framework, as mentioned above, is to determine whether the claims at issue are “directed to” a patent-ineligible

² The 2019 Revised Guidance supersedes MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) § 2106.04(II) and also supersedes all versions of the USPTO’s “Eligibility Quick Reference Sheet Identifying Abstract Ideas.” *See* 2019 Revised Guidance, 84 Fed. Reg. at 51 (“Eligibility-related guidance issued prior to the Ninth Edition, R-08.2017, of the MPEP (published Jan. 2018) should not be relied upon.”). Accordingly, Appellant’s arguments challenging the sufficiency of the Examiner’s rejection will not be addressed to the extent those arguments are based on now superseded USPTO guidance.

³ The USPTO issued an update on October 17, 2019 (the “October 2019 Update: Subject Matter Eligibility,” available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf) clarifying the 2019 Revised Guidance in response to comments solicited from the public.

concept, e.g., an abstract idea. *Alice Corp.*, 573 U.S. at 217. This first step, as set forth in the 2019 Revised Guidance (i.e., Step 2A), is a two-prong test; in Step 2A, Prong One, we look to whether the claim recites a judicial exception, e.g., one of the following three groupings of abstract ideas: (1) mathematical concepts; (2) certain methods of organizing human activity, e.g., fundamental economic principles or practices, commercial or legal interactions; and (3) mental processes. 2019 Revised Guidance, 84 Fed. Reg. at 54. If so, we next consider whether the claim includes additional elements, beyond the judicial exception, that “integrate the [judicial] exception into a practical application,” i.e., that apply, rely on, or use 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 (“Step 2A, Prong Two”). *Id.* at 54–55. Only if the claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application do we conclude that the claim is “directed to” the judicial exception, e.g., an abstract idea.

We are not persuaded here that the Examiner overgeneralized the claims as directed to “determining the level of influence of a group of persons” or that the Examiner otherwise failed to consider the claims as a whole (Appeal Br. 5–6; *see also id.* at 9). Instead, Examiner’s characterization is, in our view, fully consistent with the Specification, as described below, including the claim language. That the claims include more words than the phrase the Examiner used to articulate the abstract idea, and that the Examiner, thus, articulates the abstract idea at a higher level of abstraction than would Appellant is an insufficient basis to persuasively argue that the claim language has been mischaracterized or that the

Examiner has failed to consider the claims as a whole. *See Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240–41 (Fed. Cir. 2016) (“An abstract idea can generally be described at different levels of abstraction. As the Board has done, the claimed abstract idea could be described as generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location. It could be described in other ways, including, as indicated in the specification, taking orders from restaurant customers on a computer.”).

We also are not persuaded that the Examiner erred in determining that claim 1 is directed to an abstract idea. The Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). It asks whether the focus of the claims is on a specific improvement in relevant technology or on a process that itself qualifies as an “abstract idea” for which computers are invoked merely as a tool. *See id.* at 1335–36. Here, the Specification (including the claim language) makes clear that the claims focus on an abstract idea, and not on any improvement to computer technology and/or functionality.

The Specification is entitled “METHOD, APPARATUS, AND COMPUTER-READABLE MEDIUM FOR THE DETERMINATION OF LEVELS OF INFLUENCE OF A GROUP” and describes, in the Background section, that conducting operations, e.g., construction projects, business operations, political events, military operations, humanitarian aid,

or other activities, in a foreign country can be a complicated endeavor at least because in many situations, there are no clear cut rules concerning how to operate or from whom to obtain appropriate authorization (Spec. ¶ 3). The Specification, thus, describes that “a failure to recognize and communicate with those who wield influence can lead to disastrous consequences” (*id.*).

The claimed invention is ostensibly intended to address this issue by providing a system and method that “allow users unfamiliar with a geopolitical landscape to quickly understand and quantify the levels of influence wielded by groups of people in a particular geographic area” (*id.* ¶ 4). Claim 1, thus, recites a method for determining the level of influence of a group of persons comprising: (1) receiving and storing biographical data relevant to one or more members of the group, i.e.,

populating, by at least one of the one or more computing devices, biographical data for at least one member of the group of persons by searching a plurality of network sources for information relevant to the at least one member of the group of persons, scraping the information relevant to the at least one member of the group of persons, and storing the information relevant to the at least one member of the group of persons in at least one data structure

(step (a)); (2) determining, based on the biographical data, a level of influence for each of the one or more group members, i.e.,

determining, by at least one of the one or more computing devices, a level of influence score for the at least one member of a group of persons based on the biographical data corresponding to the at least one member of the group of persons stored in the at least one data structure

(step (b)); (3) aggregating the level of influence scores and determining a composite level of influence for the group based on the aggregated scores, i.e.,

aggregating, by at least one of the one or more computing devices, the level of influence scores for the at least one member of the group of persons; [and]

determining, by at least one of the one or more computing devices, a composite level of influence for the group of persons based on the aggregate level of influence score

(steps (c) and (d)); and (4) monitoring information sources for additional information relevant to one or more group members and updating the level of influence score for the one or more group members and the aggregate level of influence score and composite level of influence for the group, i.e.,

monitoring, by at least one of the one or more computing devices, the plurality of network sources for additional information relevant to the at least one member of the group of persons; and

in response to detecting additional information relevant to the at least one member of the group of persons, updating, by at least one of the one or more computing devices, the at least one data structure, the level of influence score for the at least one member of a group of persons, the aggregate level of influence score, and the composite level of influence for the group of persons

(steps (e) and (f)). These limitations, when given their broadest reasonable interpretation, recite determining a level of influence for a group of persons by collecting and analyzing biographical information.

Claim 1 recites that the method steps are performed by “one or more computing devices” and that the biographical data are collected by searching network sources. Yet, the underlying processes recited in the claim are all acts that, as the Examiner observes (*see* Non-Final Act. 4), could be

performed by a human, e.g., mentally or manually, using pen and paper, without the use of a computer or any other machine. For example, a person, using pen and paper, could collect biographical information regarding one or more members of group and, using data, like that included in Table 1 of the Specification (*see* Spec. ¶ 45), could determine, either mentally or using pen and paper, level of influence (“LOI”) scores for the one or more group members. A person performing calculations in his or her head or using pen and paper, also could determine an aggregate LOI score, which the Specification describes “may take the form of a sum, a product, an average, a median, or some other statistical or mathematical means of combining each of the LOI scores,” and could compare the aggregate score to various threshold values to determine a composite LOI for the group (*see id.* ¶ 22). Such a person also could monitor information sources for additional information and update the scores, as appropriate, again either mentally or using pen and paper. Simply put, claim 1 recites a mental process, i.e., a concept performed in the human mind, including an evaluation or judgment, and, therefore, an abstract idea. *See* 2019 Revised Guidance, 84 Fed. Reg. at 52. *See also CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) (holding that method steps that can be performed in the human mind, or by a human using a pen and paper, are unpatentable mental processes).

Having concluded that claim 1 recites a judicial exception, i.e., an abstract idea (Step 2A, Prong One), we next consider whether the claim recites additional elements that integrate the judicial exception into a practical application (Step 2A, Prong Two).

The only additional elements recited in claim 1, beyond the abstract idea, are the “one or more computing devices”; “at least one data structure”; and “a plurality of network sources” —elements that, as the Examiner observed, are recited at a high level of generality (Non-Final Act. 11; *see also id.* at 5–6), i.e., as generic components (*see, e.g.*, Spec. ¶¶ 53–61). We find no indication in the Specification that the operations recited in claim 1 require any specialized computer hardware or other inventive computer components, i.e., a particular machine, invoke any assertedly inventive programming, or that the claimed invention is implemented using other than generic computer components to perform generic computer functions. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”).

We also find no indication in the Specification that the claimed invention effects a transformation or reduction of a particular article to a different state or thing. Nor do we find anything of record that attributes an improvement in technology and/or a technical field to the claimed invention or that otherwise indicates that the claimed invention integrates the abstract idea into a “practical application,” as that phrase is used in the 2019 Revised Guidance.⁴

⁴ The 2019 Revised Guidance references MPEP § 2106.05(a)–(c) and (e) in describing the considerations that are indicative that an additional element or combination of elements integrates the judicial exception, e.g., the abstract idea, into a practical application. 2019 Revised Guidance, 84 Fed. Reg. at 55. If the recited judicial exception is integrated into a practical

Appellant argues that the claims cannot be properly classified as an abstract idea because “the claims recite several features that must necessarily be performed by a computer in a computer network” (Appeal Br. 7). Yet, the mere fact that claim 1 requires a computer is not a persuasive reason to argue that the claim is not directed to an abstract idea. Indeed, a substantially similar argument was expressly rejected by the Court in *Alice*. Thus, although the claimed invention in *Alice* involved a computer system acting as a third-party intermediary between two parties: “As stipulated, the claimed method requires the use of a computer to create electronic records, track multiple transactions, and issue simultaneous instructions; in other words, ‘[t]he computer is itself the intermediary,’” *Alice Corp.*, 573 U.S. at 224, the Court held that “the claims at issue amount to ‘nothing significantly more’ than an instruction to apply the abstract idea of intermediated settlement using some unspecified, generic computer.” *Id.* at 225–26. *See also In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016) (“[N]ot every claim that recites concrete, tangible components escapes the reach of the abstract-idea inquiry.”). Although “a method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101,” *CyberSource*, 654 F.3d at 1373, it does not automatically follow that methods that arguably cannot be performed entirely in the human mind or manually, using pen and paper, are, therefore, not directed to abstract ideas.

We also are not persuaded by Appellant’s argument that the pending claims are analogous to those held patent eligible in *DDR Holdings* (Appeal

application, as determined under one or more of these MPEP sections, the claim is not “directed to” the judicial exception.

Br. 11–14; *see also* Reply Br. 5–6). There, the claims were directed to retaining website visitors, and in particular to a system that modified the conventional web browsing experience by directing a user of a host website, on clicking an advertisement, to a “store within a store” on the host website, rather than to the advertiser’s third-party website. *DDR Holdings*, 773 F.3d at 1257–58. The court determined that “the claims address a business challenge (retaining website visitors) [that] is a challenge particular to the Internet.” *Id.* at 1257. The court also determined that the invention was “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks,” and that the claimed invention did not simply use computers to serve a conventional business purpose. *Id.* Rather, there was a change to the routine, conventional functioning of Internet hyperlink protocol. *Id.*

Appellant argues here that, as in *DDR Holdings*, the present claims are “necessarily rooted in computer technology” because the claims overcome the problem of accurately quantifying influence (a problem that Appellant characterizes as “specifically arising in the realm of computer networks (Appeal Br. 12)) by “allowing the dynamic identification, scraping, and integration of information from a plurality of network sources into data structures which are used to determine influence” and, additionally, “through the use of network source monitoring, detection of relevant information pertaining to persons for whom influence is determined, and dynamic updating of level of influence metrics based on new information” (*id.* at 13). Yet, unlike the situation in *DDR Holdings*, where the computer network, rather than operating in its normal, expected manner (i.e., by sending the website visitor to the third party website connected to the

clicked advertisement), generates and directs the visitor to a hybrid web page on the host website — a result that “overrides the routine and conventional sequence of events ordinarily triggered by the click of a hyperlink,” *DDR Holdings*, 773 F.3d at 1258 — there is no indication here that the claimed “one or more computing devices” are used other than in their normal, expected, and routine manner for receiving, storing, and processing information.

We also are not persuaded that identifying and accurately quantifying the level of influence of a particular person or group of persons is a challenge specifically arising in the realm of computer networks; instead, it is a business problem that existed before, and still exists, outside the realm of computers and the Internet. It has long been known to be beneficial in any undertaking, and particularly in business ventures, to identify and communicate with individuals and groups who are in a position to exercise influence — in fact, Appellant, in the Background section of the Specification, concedes as much (*see* Spec. ¶ 3 (disclosing that in conducting business operations, a failure to recognize and communicate with those who wield influence can lead to disastrous consequences)).

Appellant’s contention that claim 1 is patent eligible because it recites a patent-eligible transformation of data into a new and useful purpose (Appeal Br. 14–17; *see also* Reply Br. 6) is similarly unpersuasive. The Federal Circuit has recognized that the machine-or-transformation test,⁵

⁵ Under the machine-or-transformation test, a claimed process is patent eligible if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008), *aff’d Bilski v. Kappos*, 561 U.S. 593 (2010).

although not the only test, “can provide a ‘useful clue’” to patent eligibility under the *Mayo/Alice* framework. *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014) (quoting *Bilski v. Kappos*, 561 U.S. 593, 594 (2010)). As such, satisfying either prong of that test may integrate an abstract idea into a practical application. *See* 2019 Revised Guidance, 84 Fed. Reg. at 55 nn.27–28 (citing MPEP § 2106.05(b), (c)).

Appellant argues here that the claims recite the transformation of biographical information relevant to members of a group of persons, which is stored on network sources, into a composite level of influence for the group of persons, and that this transformation effects a change in the function of the data, i.e., the biographical information is designed to provide information about a particular person while the composite level of influence data reflects the influence exerted by a group of which the person is a member (Appeal Br. 15). But, this alleged “transformation” is, at best, merely a manipulation of data, which is not sufficient to meet the transformation prong under 35 U.S.C. § 101. *See Gottschalk v. Benson*, 409 U.S. 63, 71–72 (1972) (a computer based algorithm that merely transforms data from one form to another is not patent-eligible).

We conclude, for the reasons outlined above, that claim 1 recites a mental process, i.e., an abstract idea, and that the additional elements recited in the claim are no more than generic components used as tools to perform the recited abstract idea. As such, they do not integrate the abstract idea into a practical application. *See Alice Corp.*, 573 U.S. at 223–24 (“[W]holly generic computer implementation is not generally the sort of ‘additional featur[e]’ that provides any ‘practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.’” (quoting

Mayo, 566 U.S. at 77)). Accordingly, we agree with the Examiner that claim 1 is directed to an abstract idea.

Step Two of the Mayo/Alice Framework (2019 Revised Guidance, Step 2B)

Having determined under step one of the *Mayo/Alice* framework that claim 1 is directed to an abstract idea, we next consider under Step 2B of the 2019 Revised Guidance, the second step of the *Mayo/Alice* framework, whether claim 1 includes additional elements or a combination of elements that provides an “inventive concept,” i.e., whether an additional element or combination of elements adds specific limitations beyond the judicial exception that are not “well-understood, routine, conventional activity” in the field (which is indicative that an inventive concept is present) or simply appends well-understood, routine, conventional activities previously known to the industry to the judicial exception. 2019 Revised Guidance, 84 Fed. Reg. at 56.

Specifically referencing steps (a), (e), and (f), as recited in claim 1, Appellant argues that the § 101 rejection cannot be sustained because the Examiner has failed to provide “any support for the conventionality or routineness of these steps, as required by *Berkheimer* and the Berkheimer Memo” (Appeal Br. 7–8; *see also* Reply Br. 3–5).

There is no dispute that an examiner must show — with supporting facts — that certain claim elements are well-understood, routine, and conventional when the examiner has made such a finding. *See Berkheimer v. HP, Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018) (holding that the question of whether a claim element or combination of elements is well-understood, routine, and conventional to a skilled artisan in the relevant field is a question of fact). Indeed, shortly after the Federal Circuit issued its decision

in *Berkheimer*, the USPTO issued an April 19, 2018 Memorandum to the Patent Examining Corps entitled, “Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*)” (i.e., the “Berkheimer Memo” that Appellant references),⁶ in which the Office revised the procedures set forth MPEP § 2106.07(a) (Formulating a Rejection For Lack of Subject Matter Eligibility) and § 2106.07(b) (Evaluating Applicant’s Response). The Patent Examining Corps was, thus, instructed that “in a step 2B analysis [i.e., an analysis under step two of the *Mayo/Alice* framework], an additional element (or combination of elements) is not well-understood, routine or conventional unless the examiner finds and expressly supports a rejection in writing with one or more of” (1) a “citation to 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) a “citation to 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 “citation to a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s)”; and (4) a “statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s).” *Berkheimer Memo* at 3–4.

Appellant contends here that the Examiner must provide evidentiary support for the conventionality or routineness of steps (a), (e), and (f), as recited in claim 1 (Appeal Br. 11). But, that argument fails at least because

⁶ Available at <https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF>.

it is not commensurate with the more limited scope of the Examiner’s findings.

Appellant references steps (a), (e), and (f), as recited in claim 1. Yet, these steps are part of the abstract idea itself; they are not additional elements to be considered when determining whether claim 1 includes additional elements or a combination of elements that is sufficient to amount to significantly more than the judicial exception.

It could not be clearer from *Alice*, that under step two of the *Mayo/Alice* framework, the elements of each claim are considered both individually and “as an ordered combination” to determine whether the additional elements, i.e., the elements *other* than the abstract idea itself, “transform the nature of the claim” into a patent-eligible application. *Alice Corp.*, 573 U.S. at 217 (internal quotations and citation omitted); *see Mayo*, 566 U.S. at 72–73 (requiring that “a process that focuses upon the use of a natural law also contain *other* elements or a combination of elements, sometimes referred to as an ‘inventive concept,’ sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the natural law itself” (emphasis added) (internal citation omitted)). In other words, the inventive concept under step two of the *Mayo/Alice* framework cannot be the abstract idea itself:

It is clear from *Mayo* that the “inventive concept” cannot be the abstract idea itself, and *Berkheimer* . . . leave[s] untouched the numerous cases from this court which have held claims ineligible because the only alleged “inventive concept” is the abstract idea. *Berkheimer v. HP, Inc.*, 890 F.3d 1369, 1374 (Fed. Cir. 2018) (Moore, J., concurring); *see also BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018) (“It has been clear since *Alice* that a claimed

invention’s use of the ineligible concept to which it is directed cannot supply the inventive concept that renders the invention ‘significantly more’ than that ineligible concept.”) (internal citation omitted).

The Examiner determined here, and we agree, that the only claim elements beyond the abstract idea are the “one or more computing devices”; “at least one data structure”; and “a plurality of network sources,” i.e., generic computer components used to perform generic computer functions (Non-Final Act. 11; *see also id.* at 5–6) — a determination amply supported by, and fully consistent with the Specification (*see, e.g.*, Spec. ¶¶ 53–61).⁷

We are not persuaded, on the present record, that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection of independent claim 1, and claims 2–30, which fall with claim 1.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–30	101	Eligibility	1–30	

⁷ The Berkheimer Memo, as described above, expressly directs that an examiner may support the position that an additional element (or combination of elements) is well-understood, routine or conventional with “[a] citation to an express statement in the specification . . . that demonstrates the well-understood, routine, conventional nature of the additional element(s)” (*id.* at 3).

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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