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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/097,704	04/13/2016	Brad Lee Campbell	170108-1991	9944

71247   7590   02/03/2020
Client 170101 c/o
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EXAMINER
RUIZ, ANGELICA

ART UNIT	PAPER NUMBER
2158	

NOTIFICATION DATE	DELIVERY MODE
02/03/2020	ELECTRONIC

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PTOL-90A (Rev. 04/07)

UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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Ex parte BRAD LEE CAMPBELL, DANIEL W. HITCHCOCK, and
OWEN G. GRIFFITHS
_____

Appeal 2019-001768
Application 15/097,704
Technology Center 2100
_____

Before JEFFREY S. SMITH, TREVOR M. JEFFERSON, and
AMBER L. HAGY, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part and enter a new ground of rejection.

Illustrative Claim

1.   A non-transitory computer-readable medium embodying a program that, when executed by at least one computing device, causes the at least one computing device to at least:

receive a plurality of standardized data items from a network service

corresponding to a data provider, the plurality of standardized data items corresponding to standardized data types promulgated by a metadata central authority;

determine that a network page including a web form has been requested by a data consumer, the web form requesting a plurality of requested data items;

receive metadata from a network data service, the metadata including a mapping defining a correspondence between the plurality of requested data items requested and the plurality of standardized data items;

generate a subset of the plurality of requested data items requested by the web form based at least in part on the metadata and the plurality of standardized data items; and

execute a service call to the data consumer including the subset of the plurality of requested data items.

Prior Art

| Warren | US 2004/0036718 A1 | Feb. 26, 2004 |
| Cahoon | US 2007/0118394 A1 | May 24, 2007 |

Examiner's Rejections

Claims 1–20 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter. Ans. 3-19.

Claims 1–20 stand rejected under 35 U.S.C. § 103 as unpatentable over Cahoon and Warren. Final Act. 5–17.

ANALYSIS

I. *Section 101 Rejection*[1]

The Examiner rejects all of the pending claims under 35 U.S.C. § 101 as patent-ineligible because they are directed to a judicial exception without significantly more. Final Act. 5–7. Appellant argues that the claims are not directed to an abstract idea, are directed to patent-eligible subject matter, and the Examiner's rejection should be reversed. Appeal Br. 6–17. For the reasons explained below, we are not persuaded of Examiner error in the § 101 rejection, and we, therefore, sustain that rejection.

A. Principles of Law

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 U.S. Supreme Court, however, has 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) (citation omitted).

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[1] With regard to the Examiner's § 101 rejection, Appellant argues all claims together with claim 1 (Appeal Br. 17), and we consider claim 1 representative of the claimed subject matter on appeal. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Court, in *Alice*, reiterated the two-part framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 75–77 (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*, 573 U.S. at 217. The first part in the analysis is to "determine whether the claims at issue are directed to one of those patent-ineligible concepts." *Id.* For example, abstract ideas include, but are not limited to, fundamental economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Id.* at 218–20. The "directed to" inquiry asks not whether "the claims *involve* a patent-ineligible concept," but instead whether, "considered in light of the specification, . . . 'their character as a whole is directed to excluded subject matter.'" *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (internal citations omitted). In that regard, we determine whether the claims "focus on a specific means or method that improves the relevant technology" or are "directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery." *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016).

If, in the first part of the *Alice/Mayo* analysis, we conclude that the claims are not directed to a patent-ineligible concept, they are considered patent eligible under § 101 and the inquiry ends. *Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1047 (Fed. Cir. 2016).

If the claims are directed to a patent-ineligible concept, the second part in the *Alice/Mayo* analysis is to consider the elements of the claims "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." *Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 79, 78). In other words, the second part is to "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 (brackets in original) (quoting *Mayo*, 566 U.S. at 72–73). The prohibition against patenting an abstract idea "'cannot be circumvented by attempting to limit the use of the formula to a particular technological environment' or adding 'insignificant postsolution activity.'" *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (internal citation omitted).

The U.S. Patent and Trademark Office (the "Office") has published revised guidance on the application of 35 U.S.C. § 101. 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50–57 (Jan. 7, 2019) ("2019 Guidance"). Under the 2019 Guidance, the Office first looks 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. *See* 2019 Guidance at 52, 54–55; *see also* MPEP § 2106.05(a)–(c), (e)–(h).[2]

Only if a claim (1) recites a judicial exception, and (2) does not integrate that exception into a practical application, does the Office then look to whether the claim: (3) adds a specific limitation beyond the judicial

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[2] Unless otherwise specified herein, all references to the MPEP are to Rev. 08.2017 (Jan. 2018).

exception that are 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* 2019 Guidance at 56. We follow this guidance here.[3]

In reviewing the Examiner's rejection under § 101, we group claims 1–7 together and claims 8–20 together. 37 C.F.R. § 31.47(c)(1)(iv). Accordingly, claims 2–7 stand or fall with claim 1, and claims 9–20 stand or fall with claim 8.

B. Application of Legal Principles

1. Step 2A of 2019 Guidance

<u>Prong 1: Do Claims 1–20 Recite an Abstract Idea</u>

In applying the framework set out in *Alice/Mayo*, and as the first part of that analysis, the Examiner concludes the claims recite steps amounting to "filling out a form in advance based on known information," which the Examiner determines are analogous to "collecting and comparing known information" determined to be an abstract idea in *Claussen*.[4] Ans. 3–4. According to the Examiner, "a claim whose 'steps can be performed in the

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[3] "All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance." 2019 Guidance at 51; *see also* October 2019 Update: Subject Matter Eligibility, 2 (Oct. 17, 2019) ("October 2019 Update") ("Note, the feedback received was primarily directed to examination procedures and, accordingly, this update focuses on clarifying practice for patent examiners. However, all USPTO personnel are expected to follow the guidance.").

[4] *Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057 (Fed. Cir. 2011).

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human mind, or by a human using a pen and paper', is directed to an 'unpatentable mental process.'" *Id.* at 4.

In challenging the Examiner's determination that the claims recite an abstract idea, Appellant argues that the claim limitations "cannot be performed by the human mind." Reply Br. 11. In particular, Appellant contends a human mind could not perform the recited steps of "receiv[ing] [data] from a network service," "receiv[ing] metadata from a network service," "generat[ing] [data]," and "execut[ing] a service call . . . including [the generated data]." *Id.*

We evaluate the Examiner's § 101 rejection by applying the 2019 Guidance, which uses enumerated groupings of abstract ideas that are rooted in U.S. Supreme Court precedent, as well as Federal Circuit decisions interpreting that precedent. *See* 2019 Guidance at 51–52. By grouping the abstract ideas, the 2019 Guidance synthesizes the holdings of various court decisions to facilitate examination. The 2019 Guidance describes one category of abstract ideas as including "[m]ental processes"; that is, "concepts performed in the human mind (including an observation, evaluation, judgment, opinion)." *Id.* at 52 (footnotes omitted).

The October 2019 Update[5] provides additional clarification on "mental processes" by providing an example of claims that recite mental processes as including "a claim to 'collecting information, analyzing it, and displaying certain results of the collection and analysis,' where the data analysis steps are recited at a high level of generality such that they could practically be performed in the human mind . . . ." October 2019 Update at

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[5] Available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf.

7 (citing *Electric Power Group*[6]). The October 2019 Update also gives as an example of a claim reciting a "mental process" a "claim to collecting and comparing known information . . . , which are steps that can be practically performed in the human mind . . . ." *Id.* at 8 (citing *Classen*).

  We agree with the Examiner that the claims recite steps that fall within the category of mental processes (*see* Ans. 3–12), consistent with the 2019 Guidance. *See* 2019 Guidance at 52; *see also* October 2019 Update at 7–8. In particular, claim 1 recites "receive a plurality of standardized data items from a network service . . . ," "determine that a network page including a web form has been requested . . . ," "receive metadata from a network data service . . . ," "generate a subset of the plurality of requested data items . . . ," and "execute a service call to the data consumer including the subset of [information] . . . ," each of which qualifies as a step of collecting information, analyzing it, comparing it to known information, and/or providing the results. Each of these steps could be performed in the human mind or with the aid of pen and paper; hence, they each fall within the category of mental processes, and, thus, the claim recites an abstract idea. *See* Ans. 3.

  Appellant's reasoning that the steps would not be performed in the human mind in the same way as a processor would perform them is not persuasive, as this is not the proper test. As the 2019 Guidance states, "[i]f a claim, under its broadest reasonable interpretation, covers performance in the mind but for the recitation of generic computer components, then it is still in the mental processes category unless the claim cannot practically be

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[6] *Electric Power Group, LLC v. Alstom S.A.,* 830 F.3d 1350, 1356 (Fed. Cir. 2016).

performed in the mind." *See* 2019 Guidance at 52 n.14 (emphasis omitted).

Here, with the exception of generic computer implemented functions or

steps, there is nothing in the claims themselves that foreclose them from

being performed by a human, mentally or with pen and paper. *See*

Intellectual Ventures I LLC v. Symantec Corp., 838 F.3d 1307, 1318 (Fed.

Cir. 2016) (holding that claims to screening messages in the context of

electronic communications were directed to an abstract idea because they

could, but for the recitation of generic computer-implemented steps, be done

by a human with the aid of pen and paper); *see also* October 2019 Update at

8 ("The courts have found claims requiring a generic computer or nominally

reciting a generic computer may still recite a mental process even though the

claim limitations are not performed entirely in the human mind.").

Thus, under Prong 1 of Step 2A in accordance with the 2019

Guidance, we conclude the claims recite a judicial exception of mental

processes, and we, therefore, agree with the Examiner's conclusions that the

claims recite an abstract idea.

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Prong 2: Do the Claims Integrate the Abstract
Idea Into a Practical Application[7]

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In accordance with Prong 2 of Step 2A of the 2019 Guidance, we

evaluate the claims to determine whether they recite *additional elements*

beyond the abstract idea, and, if so, we evaluate the additional elements to

determine whether they integrate the abstract idea into a practical

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[7] We acknowledge that some of these considerations may be properly
evaluated under the second part of the *Alice/Mayo* analysis (Step 2B of the
2019 Guidance). For purposes of maintaining consistent treatment within
the Office, we evaluate them under the first part of the *Alice/Mayo* analysis
(Step 2A of the 2019 Guidance). *See* 2019 Guidance at 54–55.

application. 2019 Guidance at 54. The 2019 Guidance at page 55 provides exemplary considerations, including whether an additional element:

- "reflects an improvement in the functioning of a computer, or an improvement to other technology or technical field";
- "implements a judicial exception with, or uses a judicial exception in conjunction with, a particular machine or manufacture that is integral to the claim";
- "effects a transformation or reduction of a particular article [or thing] to a different state or thing"; or
- "applies or uses the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment."

The 2019 Guidance also highlights certain examples in which courts have held that "a judicial exception has *not* been integrated into a practical application," such as where the claims "merely use[] a computer as a tool to perform an abstract idea" or the additional element adds "insignificant extra-solution activity" to the abstract idea. 2019 Guidance at 55 (emphasis added); *see also* October 2019 Update at 11–15.

The Examiner determines that the claims recite additional elements beyond the abstract idea, such as "a network service," "promulgated by a metadata central authority," "determine that a network page including a web form has been requested by a data consumer, the web form requesting a plurality of requested data items," "a network data service," "web form," and "execute a service call." Ans. 6.

Appellant argues that the claims are not directed to an abstract idea because they are analogous to claims determined to be patent-eligible in *McRO*. Reply Br. 15. In particular, Appellant argues,

> claims 1-20 are similarly patent eligible because, like claim 1 in *McRo*, they involve a limited approach to achieve an improved technological result in industry practice. Specifically, the present claims are related to improved systems for deterministic form filling by using metadata from a central authority (*e.g.,* network site hosting the form) to map stored data with input form fields.

Id.

We disagree that Appellant's claim 1–7 are analogous to those deemed patent eligible in *McRO*. In *McRO*, the claims described a way of animating characters that represented a technological improvement over the existing, manual 3-D animation techniques. *McRO*, 837 F.3d at 1316. Appellant's claims 1–7, on the other hand, do not produce any improved product, such as a visual animation. Claims 1–7 recite a computer-implemented method of retrieving standardized data and metadata, and mapping the standardized data using the metadata, to generate requested data. In particular, we highlight that Appellant's alleged improved technological result, namely, deterministic form filling, is not recited in claims 1–7.

Claim 1's data-gathering steps reasonably can be characterized as merely constituting insignificant extra-solution activity:

> An example of pre-solution activity is a step of gathering data for use in a claimed process, *e.g.,* a step of obtaining information about credit card transactions [that] is recited as part of a claimed process of analyzing and manipulating the gathered information by a series of steps in order to detect whether the transactions were fraudulent.

 MPEP § 2106.05(g).

Claim 1's other steps entail using a computer to map standardized data using metadata to generate requested data. But the act of mapping constitutes the underlying abstract ideas—the mental processes that, as we determine above, can be performed in the human mind or with pencil and paper. *See 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."); *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) ("[A] claim for a *new* abstract idea is still an abstract idea.") (emphasis omitted); *SAP America, Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1168 (Fed. Cir. 2018) ("What is needed is an inventive concept in the non-abstract application realm.").

Consistent with the Examiner's determination, we determine claims 1–7 do not include an improvement to another technology or technical field or an improvement to the functioning of the computer itself; we also find claims 1–7 do not include a transformation of an article or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment. *See* Ans. 3–6. As the U.S. Supreme Court has explained, "if a patent's recitation of a computer amounts to a mere instruction to 'implemen[t]' an abstract idea 'on . . . a computer,' that addition cannot impart patent eligibility." *Alice*, 573 U.S. at 223 (quoting *Mayo*, 566 U.S. at 84).

In contrast to claim 1, claim 8 recites "cause the plurality of data items to be entered into the form." Appellant's claim 8 is directed to an

improvement in the functioning of a computer or otherwise to a technological improvement, analogous to those deemed patent eligible in *McRO*. Claim 8 recites an additional element that integrates the abstract idea into a practical application, namely, causing a computing device to enter data into a form. *See* 2019 Guidance at 54.

In summary, we conclude the claims 1–7 do not integrate the abstract idea into a practical application so as to remove them from the realm of reciting patent-ineligible abstract ideas, but that claims 8–20 do. Accordingly, in the first part of the *Alice/Mayo* analysis, we conclude that claims 1–7 are directed to an abstract idea, and that claims 8–20 are not directed to an abstract idea. Because claims 8–20 are not directed to an abstract idea, we do not need to analyze claims 8–20 under step 2B. We continue our analysis only for claims 1–7.

2. *Step 2B of 2019 Guidance – Do Claims 1-7 Recite Significantly More Than the Abstract Idea*

Regarding second part of the *Alice/Mayo* analysis, the Examiner finds the elements of the claims, when considered individually or as an ordered combination, do not recite *significantly more* than the abstract idea. Ans. 9. In particular, the Examiner finds claim 1 recites

> the additional elements of a non-transitory computer readable medium, client computing device, and one or more computer devices. Looking at the limitations as an ordered combination adds nothing that is not already present when looking at the elements taken individually. There is no indication that the combination of elements improves the functioning of a computer or improves another technology. Their collective functions merely provide conventional computer implementations.

Ans. 9. We agree.

We find the steps beyond the recited abstract idea, such as "receive [data]" and "execute a service call . . . including [data]," are directed to insignificant extra-solution activity. As our reviewing court has explained, such data gathering and transmissions simply provide data for other method steps. *See, e.g. CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011) ("We have held that mere '[data-gathering] step[s] cannot make an otherwise nonstatutory claim statutory.'" (alterations in original) (quoting *In re Grams*, 888 F.2d 835, 840 (Fed. Cir. 1989))); *see also* 2019 Guidance at 55 (identifying "add[ing] insignificant extrasolution activity to the" abstract idea as an example of when an abstract idea has not been integrated into a practical application).

Appellant argues that claims 1–7 have an inventive concept when considered as an ordered combination, relating to improving a user's interaction with network pages and/or other user interfaces that include form fields by facilitating deterministic form filling, similar to that of *BASCOM Global Internet Services v. AT&T Mobility LLC,* 827 F.3d 1341 (Fed. Cir. 2016). Reply Br. 16–17. In particular, Appellant argues that claim 1 recites "a specific method of (1) receiving standardized data . . . (2) determining that . . . a web form . . . has been requested . . . (3) receiving metadata . . . (4) generating a subset of the requested data . . . (5) executing a service call . . . including the subset of requested data items." Reply Br. 17.

We disagree that the claims are analogous to those determined to be patent-eligible in *BASCOM*. Claim 1 does not improve the performance of the computer system itself. Thus, this case is unlike *BASCOM*, in which an inventive concept was found in the ordered combination of limitations providing for "the installation of a filtering tool at a specific location, remote

from the end users, with customizable filtering features specific to each end user." 827 F.3d at 1350. Here, the claim elements beyond the abstract idea recite only generic computer functions and components that are well-understood, routine, and conventional—that is, receiving, storing, and displaying data; such generic computer functions and components do not convey an inventive concept. *See Alice*, 573 U.S. at 217. Appellant is reminded that in most cases, "relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible." *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (citing *Alice*, 573 U.S. at 224 (holding that "use of a computer to create electronic records, track multiple transactions, and issue simultaneous instructions" is not an inventive concept)); *Intellectual Ventures I LLC v. Capital One Bank*, 792 F.3d 1363, 1370 ("[M]erely adding computer functionality to increase the speed or efficiency of the process does not confer patent eligibility on an otherwise abstract idea.").

To the extent Appellant relies on the particular manipulation of data recited as indicative of an inventive concept, we have determined above that such steps amount to mental processes, which is categorized in the 2019 Guidance as an abstract idea. Appellant is reminded that "the 'inventive concept' [under the second part of the *Mayo/Alice* test] 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). "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." *BSG Tech LLC v.
Buyseasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018).

We determine that the functions recited in Appellant's claims 1–7 do
not add any meaningful limitations beyond generally linking the abstract
idea to the particular technological environment.

Accordingly, we sustain the Examiner's rejection of claims 1–7 under
35 U.S.C. § 101 as patent-ineligible. We do not sustain the rejection of
claims 8–20 as patent-ineligible under 35 U.S.C. § 101.

II.   *Section 103 Rejection*

Claim 1 recites a "web form requesting a plurality of requested data
items" and "receive metadata from a network data service, the metadata
including a mapping defining a correspondence between the plurality of
requested data items requested and the plurality of standardized data items."
The Examiner finds that paragraph 27 of Cahoon teaches this limitation in
describing brand names and incentives that are linked to germane content via
a direct mapping with the generic functional names included in the required
item lists within instructional content. Final Act. 6.

Appellant contends that the germane content of Cahoon does not teach
a "plurality of requested data items" as claimed because the germane content
of Cahoon is not requested by a web form included in a network page
requested by a data consumer, as set forth in claim 1. Appeal Br. 8. The
Examiner does not address this argument in the Answer. *See* Ans. 19–20.

We agree with Appellant for the reasons given in the Appeal Brief.
We do not sustain the rejection of claims 1–7 under 35 U.S.C. § 103 as
unpatentable over Cahoon and Warren.

Claim 8 recites "generate a subset of the plurality of requested data items requested by the web form based at least in part on the metadata and the plurality of standardized data items." The Examiner finds that paragraphs 26 and 27 of Cahoon teach that when content to be experienced by the public is submitted, it will be encoded with resource description framework for serialization and later processing. Final Act. 11. The Examiner also finds that paragraphs 21, 72, and Figures 2–6 of Warren teach displaying a pre-configured view for displaying a data item and a user-accessible utility for altering the pre-configured display item to create user-defined views. *Id.*

Appellant argues that the combination of Cahoon and Warren does not teach "generate the plurality of data items requested by the form" as claimed. Appeal Br. 12–13. We agree with Appellant for the reasons given by Appellant in the Appeal Brief.

We do not sustain the rejection of claims 8–14 under 35 U.S.C. § 103 as unpatentable over Cahoon and Warren.

Claim 15 recites "receiving, via at least one of the one or more computing devices, metadata from a network service, the metadata comprising a mapping of a plurality of standardized data items to the plurality of requested data items." The Examiner finds that paragraph 27 of Cahoon teaches this limitation in describing brand names and incentives that are linked to germane content via a direct mapping with the generic functional names included in the required item lists within instructional content. Final Act. 14.

Appellant contends that the germane content of Cahoon does not teach a "plurality of requested data items" as claimed because the germane content

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of Cahoon is not requested by a web form included in a network page requested by a data consumer, as set forth in claim 1. Appeal Br. 13–14. We agree with Appellant for the reasons given in the Appeal Brief.

We do not sustain the rejection of claims 15–20 under 35 U.S.C. § 103 as unpatentable over Cahoon and Warren.

III.   *New Ground of Rejection – 35 U.S.C. Section 102*

As provided by 37 C.F.R. § 41.50(b), we reject independent claims 1, 8, and 15 under 35 U.S.C. § 102 as anticipated by Markus,[8] and designate this rejection as a new ground.[9]

Claim 1 recites "receive a plurality of standardized data items from a network service corresponding to a data provider, the plurality of standardized data items corresponding to standardized data types promulgated by a metadata central authority." Claim 8 recites "a data store comprising a cache of metadata," where "the metadata including a plurality of standardized data items." Markus discloses these limitations in describing receiving a user's raw data file corresponding to pre-named, standard fields from raw data profile storage. Markus, Abstract, col. 5, ll. 6–9, 45–48, col. 8, ll. 50–58, col. 10, ll. 60–66, col. 13, ll. 49–50, Fig. 3B, Fig. 6.

Claim 1 recites "determine that a network page including a web form has been requested by a data consumer, the web form requesting a plurality

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of requested data items." Claims 8 and 15 recite a similar limitation. Markus discloses these limitations in describing receiving a request from a user to fill in a form on the user's computer. Markus, col. 8, ll. 15–19; *see id.* at col. 6, ll. 39–40, col. 7, ll. 1–8, 41–62, col. 9, ll. 51–54, 66-67, Fig. 4A.

Claim 1 recites "receive metadata from a network data service, the metadata including a mapping defining a correspondence between the plurality of requested data items requested and the plurality of standardized data items." Claims 8 and 15 recite a similar limitation. Markus discloses these limitations in describing receiving a form mapping containing a set of associations between fields in the electronic form and the pre-named fields. Markus, Abstract, col. 5, ll. 2–12, 35–38, 48–52, col. 8, ll. 24–27, col. 8, l. 65–col. 9, l. 18, col. 13, ll. 56–60, Figs. 3A and 3B, Fig. 6.

Claim 1 recites "generate a subset of the plurality of requested data items requested by the web form based at least in part on the metadata and the plurality of standardized data items." Claims 8 and 15 recite a similar limitation. Markus discloses these limitations in describing utilizing a form mapping to attach a data string contained in the user's raw data file to a field in the electronic form. Markus, Abstract, col. 5, ll. 2–12, col. 10, l. 65–col. 11, l. 5, col. 14, ll. 5–28, Figs. 4A and 6.

Claim 1 recites "execute a service call to the data consumer including the subset of the plurality of requested items." Markus discloses this limitation in describing constructing and transmitting an executable software module to a remote computer, where the software module is constructed such that once received by a browser displaying a form, it is executed and user data is automatically inserted into a form. Markus, Abstract, col. 8, ll. 29–34, col. 10, ll. 43–51, col. 11, ll. 7–14, Fig. 4A.

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Claim 8 recites "cause the plurality of data items to be entered into the form." Claim 15 recites a similar limitation. Markus discloses these limitations in describing a software module constructed such that once received by a browser displaying a form, it is executed and user data is automatically inserted into the form. Markus, Abstract, col. 4, ll. 62–65, col. 7, ll. 40–42, col. 8, ll. 22–34, col. 11, ll. 15–27, Figs. 4A and 4B.

Claim 8 recites "submit the form to the network server." Markus discloses this limitation in describing submitting the filled out electronic form to the merchant's web server. Markus, col. 12, ll. 11–14, Fig. 4B.

DECISION

The rejection of claims 1–7 under 35 U.S.C. § 101 is affirmed.

The rejection of claims 8–20 under 35 U.S.C. § 101 is reversed.

The rejection of claims 1–20 under 35 U.S.C. § 103 as unpatentable over Cahoon and Warren is reversed.

Claims 1, 8, and 15 are rejected under 35 U.S.C. § 102.

The rejection of claims 1, 8, and 15 is a new ground of rejection.

CONCLUSION

In Summary:

Claims Rejected	35 U.S.C. §	References(s) Basis	Affirmed	Reversed	New Ground
1–7	101	Judicial Exception	1–7		
8–20	101	Judicial Exception		8–20	
1–20	103	Cahoon, Warren		1–20	
Overall Outcome			1–7	8–20	1, 8, 15

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This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2011). Section 41.50(b) provides that "[a] new ground of rejection . . . shall not be considered final for judicial review."

Section 41.50(b) also provides that Appellants, 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 proceeding 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.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

<u>AFFIRMED-IN-PART</u>
<u>37 C.F.R. § 41.50(b)</u>