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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HELEN T. CHEN, THOMAS R. MAGUIRE, and
JOHN F. SCHUMACHER

Appeal 2019-002127
Application 14/306,940
Technology Center 2100

Before JEAN R. HOMERE, ST. JOHN COURTENAY, III, and
THU A. DANG, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

I.   STATEMENT OF THE CASE[1]

Pursuant to 35 U.S.C. § 134(a), Appellant[2] appeals from the
Examiner's decision to reject claims 33–52. Appeal Br. 1. We have
jurisdiction under 35 U.S.C. § 6(b). We affirm.

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[1] We refer to the Specification, filed June 17, 2014 ("Spec."); Final Office
Action, mailed Jan. 26, 2018 ("Final Act."); Appeal Brief, filed June 26,
2018 ("Appeal Br."); Examiner's Answer, mailed Nov. 15, 2018 ("Ans.");
and Reply Brief, filed Jan. 15, 2019 ("Reply Br.").
[2] We use the word "Appellant" to refer to "Applicant" as defined in
37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as IBM
Corporation. Appeal Br. 1. This appeal relates to Appeal No. 2014-000212
(09/722,526, mailed Jan. 24, 2014) ("'212 Appeal") in which we affirmed
the Examiner's patent eligibility rejection of claims 53–62, and the

II.   CLAIMED SUBJECT MATTER

According to Appellant, the claimed subject matter relates to a computer program product and a hardware storage device including code for creating transformation rule (208) useable to transform a source document containing input data file (212) into a target document containing output data file (214). Spec. ¶ 10, Fig. 2.

Figure 2, reproduced below, is useful for understanding the claimed subject matter:
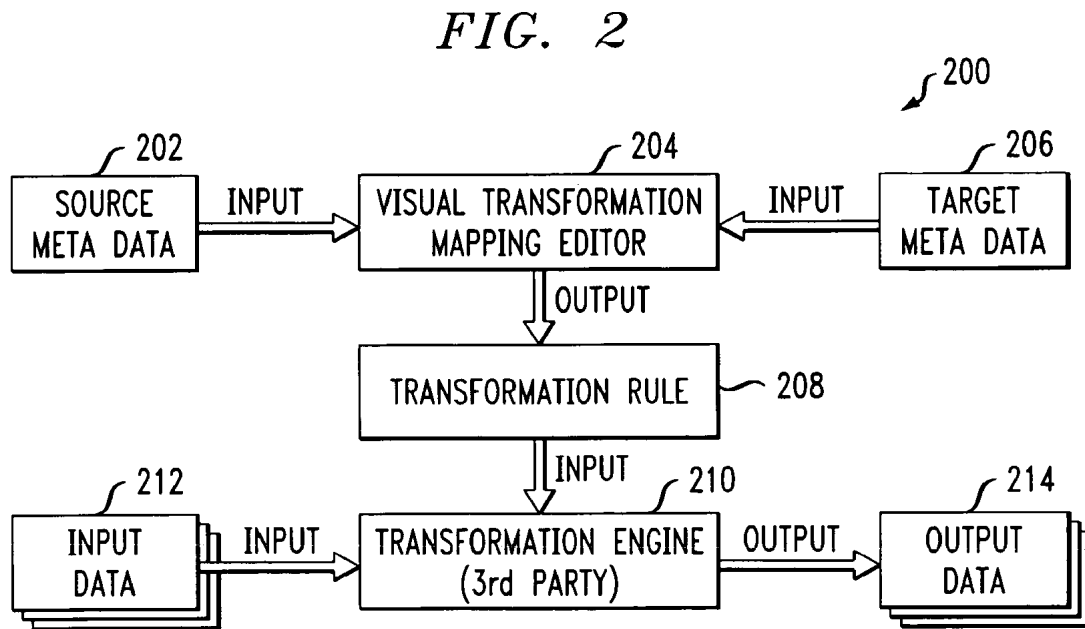
FIG. 2

Figure 2 depicts a flow diagram for enabling visual transformation mapping editor (204) to create transformation rule (208) from source metadata (202) and target metadata (206). Spec. ¶ 13.

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obviousness rejection of claims 42–52, but reversed the obviousness rejection of claims 33–42, and 53–62. Dec. 9.

As depicted in Figure 2 above, upon receiving source data description (202) of a first single field and target data description (206) of a second single field, visual transformation mapping editor (204) creates meta transformation rule (208) for transforming and mapping data between the source document including input data (212) and the target document including output data (214). Spec. ¶¶ 10, 46.

Claims 33 and 43 are independent. Claim 33, reproduced below with disputed limitations emphasized in *italics*, is illustrative:

> 33.   A computer program product, comprising:
> a hardware storage device having stored therein computer usable program code for creating a transformation rule usable to transform an input data file including input data into an output data file including output data,
> the computer usable program code, which when executed by a computer hardware system, causes the computer hardware system to perform
>   *receiving, prior to the transformation rule being generated, a source data description of a single data field of the input data file;*
>   *receiving, prior to the transformation rule being generated, a target data description of a single data field of the output data file*;
>   receiving a meta rule configured to create a transformation rule[3]; and
>   creating the transformation rule using the meta rule with the source data description and the target data description, wherein
>   each data field is to be populated by data having parameters, and
>   each respective data description characterizes the parameters of the data.

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[3] In the event of further prosecution, the Examiner should consider whether the *second* recitation of "a transformation rule" renders the claim indefinite.

Appeal Br. 18, Claims App.

III.   REFERENCES

The Examiner relies upon the following references.[4]

Name	Number	Publ'd/Issued
Williams	US 5,251,314	Oct. 5, 1993
XML Spy 3.0, 1-60 ("XML Spy").	*A*vailable at www.xmispy.com,	2000
Beckett	US 2002/0199034 A1	Dec. 26, 2002

IV.   REJECTIONS

The Examiner rejects claims 1–20 as follows:

1. Claims 33–52 are rejected under 35 U.S.C. § 101 as being directed to patent ineligible subject matter without significantly more. Final Act. 2.

2. Claims 33−52 are rejected under 35 U.S.C. § 103 as being unpatentable over the combination of XML Spy and Beckett. Final Act. 3–8.

3. Claims 33−52 are rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Williams, XML Spy and Beckett. Final Act. 8–13.

V.   ANALYSIS

We consider Appellant's arguments in the order they are presented in the Appeal Brief, pages 4–58, and the Reply Brief, pages 2–18.[5]

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[4] All reference citations are to the first named inventor only.
[5] We have considered in this Decision only those arguments Appellant actually raised in the Briefs. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2014).

1. *Patent Eligibility Rejection*

An invention is patent-eligible if it claims a "new and useful process, machine, manufacture, or composition of matter." 35 U.S.C. § 101. However, the U.S. Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: "[l]aws of nature, natural phenomena, and abstract ideas" are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Court's two-step framework, described in *Mayo* and *Alice*. *Alice*, 573 U.S. at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is "directed to." *See Alice*, 573 U.S. at 219 ("On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk."); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) ("Claims 1 and 4 in petitioners' application explain the basic concept of hedging, or protecting against risk.").

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as "molding rubber products" (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); "tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores" (*Diehr*, 450 U.S. at 182 n.7 (quoting *Corning v.*

Burden, 56 U.S. 252, 267–68 (1853))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Court held that "[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula." *Diehr*, 450 U.S. at 176; *see also id.* at 191 ("We view respondents' claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula."). Having said that, the Court also indicated that a claim "seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment." *Id.* (citation omitted) (citing *Benson* and *Flook*), *id.* at 187 ("It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.").

If the claim is "directed to" an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where "we must examine the elements of the claim to determine whether it contains an 'inventive concept' sufficient to 'transform' the claimed abstract idea into a patent-eligible application." *Alice*, 573 U.S. at 221. "A claim that recites an abstract idea must include 'additional features' to ensure 'that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].'" *Id.* (quoting *Mayo*, 566 U.S. at 77). "[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention." *Id.*

The Office published revised guidance on the application of Section 101. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) ("2019 PEG"). Recently, the Office published an update to that guidance. *October 2019 Patent Eligibility Guidance Update*, 84 Fed. Reg. 55,942 (hereinafter "PEG Update"). Under the 2019 PEG and PEG Update, we first look 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* MPEP § 2106.05(a)–(c), (e)–(h)).[6]

See 2019 PEG, 84 Fed. Reg. at 52, 55–56. 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 exception that is 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 PEG, 84 Fed. Reg. at 56.

We analyze the patent-eligibility rejection with the principles identified above in mind.

Examiner's Findings and Conclusions

In the first part of the *Alice* inquiry, the Examiner determines that claims 33–52 are directed to the abstract idea of creating/using a

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[6] All references to the MPEP are to 9th Ed., Rev. 08.2017 (Jan. 2018).

transformation rule incorporating descriptions of data, wherein the created

rule is never applied, and such creation can be performed in the human

mind. Ans. 16–18. According to the Examiner, the creation of this

transformation rule is similar to mental processes of comparing information

("data descriptions") and creating /using rules to identify options in

SmartGene,[7] and obtaining/comparing intangible data in *Cybersource*.[8]

Final Act. 2.

In the second part of the *Alice* inquiry, the Examiner determines the

claims do not recite additional elements sufficient to amount to significantly

more than the abstract idea. Ans. 18–19. According to the Examiner,

> Claim 33 requires generic computer product such as hardware storage to perform basic computer functions of storing and retrieving information, and/or manipulating that information. Thus, the recited generic computer product performs no more than basic computer functions. This adds nothing that is not already present when the elements are taken individually. Therefore, the claim does not amount to significantly more than the recited abstract idea.
>
> Claim 43 requires generic computer products such a processor to perform basic computer functions of storing and retrieving information, and/or manipulating that information. Thus, the recited generic computer product performs no more than basic computer functions. This adds nothing that is not already present when the elements are taken individually. Therefore, the claim does not amount to significantly more than the recited abstract idea.

 Final Act. 2.

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[7] *SmartGene v. Advanced Biological Labs*, 555 F. App'x 950 (Fed. Cir. 2014).
[8] *Cybersource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366 (Fed. Cir. 2011).

Appellant's Arguments and Contentions

In the first part of the *Alice* inquiry, Appellant argues that the Examiner's prima facie case of patent ineligibility is in error because the Examiner overgeneralized the claimed subject matter, and does not tie the facts thereof to the cited case law. Appeal. Br. 9–13, Reply Br. 5–7. Instead, Appellant argues that the claimed subject matter relates to a novel methodology for transforming data stored in a document/file into data stored in a different type of document/file. Appeal Br. 10. In particular, Appellant alleges that the claimed subject matter pertains to utilizing meta rules, source and target descriptions to generate a transformation rule, which is subsequently used to transform input data into output data. *Id.* According to Appellant, because the recited operations of receiving data and transforming data are to be performed by a computer hardware system, the claimed subject matter cannot be performed in the human mind. *Id.* at 12–13. Therefore, Appellant submits that the claimed subject matter relates to an improvement to computer technology used to transform data in one document/file to another type of document/file. *Id.* at 14.

In the second part of the *Alice* inquiry, Appellant argues that the Examiner failed to identify additional elements in the claimed subject matter, and thereby reached the conclusory statement that the claim does not amount to significantly more than the alleged abstract idea. *Id.* at 15.

Our Review

Applying the guidance set forth in the 2019 Updated PEG and controlling case law, we determine whether the Examiner has erred in rejecting the claims as directed to patent ineligible subject matter.

In revised step 1 of 2019 PEG, we consider whether the claimed subject matter falls within the four statutory categories of patent-eligible subject matter identified by 35 U.S.C. § 101: process, machine, manufacture, or composition of matter. Because independent claim 33 recites a "program product" including a hardware storage device for storing computer usable code, claim 33 falls within the "manufacture" category of patent-eligible subject matter. Because independent claim 43 recites a "computer hardware system" including a processor for performing various functions, claim 43 falls within the "machine" category of patent-eligible subject matter.

In prong 1 of revised step 2A of the 2019 PEG, we determine whether any judicial exception to patent eligibility is recited in the claims. The guidance identifies three judicially-excepted groupings of abstract ideas: (1) mathematical concepts; (2) certain methods of organizing human activity, such as fundamental economic practices; and (3) mental processes. As noted by Appellant, independent claims 33 and 43 recite, *inter alia*, a computer hardware storage device and computer hardware system including processor to create a transformation rule based on received source description data, target description data, and meta rule. Appeal Br. 10. In sum, the cited claim steps involve a processor, which:

1. receives a source metadata of an input data file;
2. receives a target metadata of an output data file;
3. receives a meta rule;
4. creates a transformation rule based on the source input metadata file, target output metadata file, and meta rule.

At an initial matter, we note that independent claims 33 and 43 merely recite creating a transformation rule without detailing any particular

hardware circuitry beyond a processor circuitry performing the operations to execute steps 1 through 4 above. Such a manipulation of the input and output metadata relates to the pre-Internet activity of manipulating data descriptions to generate a mapping rule for converting input data into equivalent output data. Spec. ¶¶ 6–9. As drafted, these claim limitations, under their broadest reasonable interpretation, recite a mental process for organizing information through data mapping and correlation that can be performed in the human mind or using a pen and paper. *See, e.g.*, *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) (determining that a claim whose "steps can be performed in the human mind, or by a human using a pen and paper" is directed to an unpatentable mental process).

We thus agree with the Examiner that the claimed subject matter merely relates to the basic concept of creating a transformation rule incorporating data descriptions, which can be implemented as a mental process for converting input data into equivalent output data. Ans. 16–18. Consequently, we find the record before us adequately supports the Examiner's finding that the claims recite the mental process of generating a transformation rule using received data descriptions. *Id.* Accordingly, we find that independent claims 33 and 43 recite the judicial exception of a mental process.

Having determined that the claims recite a judicial exception, our analysis under the 2019 PEG turns now to determining whether there are "additional elements that integrate the judicial exception into a practical

application." *See* MPEP § 2106.05(a)–(c), (e)–(h).[9] "Integration into a practical application" requires an additional element or a combination of additional elements in the claim to 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 exception. 84 Fed. Reg. at 53.

Appellant's claims 33 and 43 recite computer-related limitations (e.g., computer hardware system, processor). Appellant argues that the claimed creation of a transformation rule pertains to an improvement to computer technology used to transform data in one document/file to another type of document/file. Appeal Br.14.

We do not find the recited computer-related limitations are sufficient to integrate the judicial exception into a practical application. Although the claim nominally requires these steps to be performed by a computer hardware system including a processor, this computer implementation of a mental process is insufficient to take the invention out of the realm of abstract ideas. *Versata Dev. Grp. v. SAP Am., Inc.*, 793 F.3d 1306, 1335

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[9] Specifically, we determine whether the claims recite:

   (i)   an improvement to the functioning of a computer [(or a mobile device)];
  (ii) an improvement to another technology or technical field;
 (iii) an application of the abstract idea with, or by use of, a particular machine;
 (iv) a transformation or reduction of a particular article to a different state or thing; or
  (v) other meaningful limitations beyond generally linking the use of the abstract idea to a particular technological environment.

Id.

(Fed. Cir. 2015) ("Courts have examined claims that required the use of a computer and still found that the underlying, patent-ineligible invention could be performed via pen and paper or in a person's mind."); *Alice*, 573 U.S. at 223 ("Stating an abstract idea while adding the words 'apply it with a computer'" is insufficient to confer eligibility.). Further, the Specification does not provide additional details about the computer hardware system/processor that would distinguish them from any generic processing devices to convert input data from one type to another. Although we do not dispute that the processing circuitry includes specific instructions for performing the recited functions, Appellant has not explained persuasively how the derived content transforms the received data into a new state or thing. *See* MPEP § 2106.05(a). Rather, the claims merely adapt the mental process of generating a data transformation rule for converting an input data into an equivalent output data. *See Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017) ("Our prior cases have made clear that mere automation of manual processes using generic computers does not constitute a patentable improvement in computer technology."); *see also Bancorp Services, L.L.C. v. Sun Life Assurance Co. of Canada (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (A computer "employed only for its most basic function . . . does not impose meaningful limits on the scope of those claims.").

Further, Appellant's identified improvements are to the abstract idea itself, not improvements to a technology or computer functionality. That is, the cited claim limitations do not improve the functionality of the processing devices by performing operations generating a transformation rule for converting input data into equivalent output data, nor do they achieve an

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improved technological result in conventional industry practice. *See McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1316 (Fed. Cir. 2016). Thus, we agree with the Examiner that the claims do not recite an additional element reflecting an improvement in the functioning of a computer, or an improvement to other technology or technical field. Ans. 18.

As correctly noted by the Examiner, the claims do not recite an additional element that implements the abstract idea with a particular machine or manufacture that is integral to the claim. *Id.* Instead, the claim limitations only recite result-based functional steps that do not describe how to achieve the data transformation in a non-abstract way. Prior to the Internet, such activities were widely practiced, and became computerized to facilitate the creation of a transformation rule for converting input data into equivalent output of a different type. *See OIP Technologies, Inc. v. Amazon.com, Inc*., 788 F.3d 1359, 1364 (Fed. Cir. 2015).

Because the claimed subject matter outlined above does not (1) provide any technical solution to a technical problem as required by *DDR Holdings*;[10] (2) provide any particular practical application as required by *BASCOM*; or (3) entail an unconventional technological solution to a

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[10] The Federal Circuit found *DDR's* claims are patent-eligible under 35 U.S.C. § 101 because *DDR's* claims: (1) do not merely recite "the performance of some business practice known from the pre-Internet world" previously disclosed in *Bilski* and *Alice*; but instead (2) provide a technical solution to a technical problem unique to the Internet, i.e., a "solution . . . necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks." *DDR Holdings*, 773 F.3d at 1257.

technological problem as required by *Amdocs*,[11] we agree with the Examiner's determination that Appellant's claims 33 and 43 are directed to an abstract idea that is not integrated into a practical application.

Alice/Mayo—Step 2B (Inventive Concept)

Turning to step 2B of the 2019 PEG, we look to whether the claim: (a) recites a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field; or (b) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. 84 Fed. Reg. 56; *see Alice*, 573 U.S. at 217 ("[W]e consider the elements of each claim both individually and 'as an ordered combination'" to determine whether the claim includes "significantly more" than the ineligible concept); *see also BASCOM*, 827 F.3d at 1350 ("[A]n inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.").

We discern no additional element or combination of elements recited in Appellant's independent claims 33 and 43 that contain any "inventive concept" or add anything "significantly more" to transform the abstract concept into a patent-eligible application. *Alice*, 573 U.S. at 221. We are not persuaded by Appellant's remarks, noted above, alleging the claims are directed to a non-routine and unconventional system because it allegedly recites a new methodology for creating a transformation rule for converting input data into equivalent output data. Appellant has failed to establish on this record how converting input data into equivalent output data is

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[11] *See Amdocs Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016).

distinguished from the conventional processor-implemented creation of a transformation rule to convert input data into output data of a different type.

Further, Appellant does not direct our attention to any portion of the Specification indicating that the claimed processing circuitry performs anything other than well-understood, routine, and conventional functions, such as receiving, processing, and displaying data. *See Elec. Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016) ("Nothing in the claims, understood in light of the [S]pecification, requires anything other than off-the-shelf, conventional computer, network, and display technology for gathering, sending, and presenting the desired information."); *see also Alice*, 573 U.S. at 224–26 (receiving, storing, sending information over networks insufficient to add an inventive concept); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) ("That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive.").

Instead, Appellant's claimed subject matter simply uses a generic processing circuitry to perform the abstract idea of creating a transformation rule for converting input data from one form to another. As noted above, the use of a generic computer does not alone transform an otherwise abstract idea into patent-eligible subject matter. As our reviewing court has observed, "after *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible." *DDR*, 773 F.3d at 1256 (citing *Alice*, 573 U.S. at 223).

Because the discussed claim elements only recite generic computer functions that are well-understood, routine, and conventional, individually and in combination, the claim is devoid of an inventive concept. *See Alice*,

573 U.S. at 217. "[T]he '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 [the Federal Circuit] 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).

Therefore, the computer functions recited in the claims are, in fact, generic, and are met by numerous precedent establishing that using a generic computer to expedite and automate processes traditionally performed manually, or that are otherwise abstract, is a well-understood, routine, and conventional use of such computers. S*ee also, e.g.*, *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d at 1321 (utilizing an intermediary computer to forward information); *Bancorp Services, L.L.C.*, 687 F.3d at 1278 ("The computer required by some of Bancorp's claims is employed only for its most basic function, the performance of repetitive calculations, and as such does not impose meaningful limits on the scope of those claims.").

Therefore, we conclude that claim 33's elements, both individually and as an ordered combination, do not provide an inventive concept. *See* 84 Fed. Reg. 56; *see also Berkheimer*, 881 F.3d at 1370 ("The limitations amount to no more than performing the abstract idea of parsing and comparing data with conventional computer components."); *Bancorp*, 687

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F.3d at 1278 ("[T]he use of a computer in an otherwise patent-ineligible process for no more than its most basic function—making calculations or computations—fails to circumvent the prohibition against patenting abstract ideas and mental processes.").

To the extent Appellant argues the claims necessarily contain an "inventive concept" based on their alleged novelty or non-obviousness over the cited references, Appellant misapprehends the controlling precedent. Although the second part in the *Alice*/*Mayo* framework is termed a search for an "inventive concept," the analysis is not an evaluation of novelty or non-obviousness, but, rather, a search for "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.'" *Alice*, 573 U.S. at 217–218 (quoting *Mayo*, 566 U.S. 72–73). A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90.

In many cases, "relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible." *OIP Techs.*, 788 F.3d at 1363 (citing *Alice*, 573 U.S. at 224) ("[U]se of a computer to create electronic records, track multiple transactions, and issue simultaneous instructions" is not an inventive concept.); *see also, e.g.*, *Intellectual Ventures I LLC v. Capital One Bank*, 792 F.3d at 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."). Therefore, the functions recited in independent claims 33 and 43 do not add meaningful limitations beyond generally linking the abstract idea to the particular technological environment.

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Appellant's arguments asserting that the claims do not block others from using the abstraction do not persuade us that the claims are directed to patent eligible material. Appeal Br. 14. Pre-emption is not a separate test for eligibility.

> To be clear, the proper focus is not preemption *per se*, for some measure of preemption is intrinsic in the statutory right granted with every patent to exclude competitors, for a limited time, from practicing the claimed invention. *See* 35 U.S.C. § 154. Rather, the animating concern is that claims should not be coextensive with a natural law, natural phenomenon, or abstract idea; a patent-eligible claim must include one or more substantive limitations that, in the words of the Supreme Court, add "significantly more" to the basic principle, with the result that the claim covers significantly *less*. *See Mayo*[, 566 U.S. at 72–73]. Thus, broad claims do not necessarily raise § 101 preemption concerns, and seemingly narrower claims are not necessarily exempt.

CLS Bank Int'l v. Alice Corp. Pty. Ltd., 717 F.3d 1269, 1281 (Fed. Cir. 2013) (Lourie, J., concurring), *aff'd*, 573 U.S. 208; *see also Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) ("While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility."). Because we find the claimed subject matter covers patent-ineligible subject matter, the pre-emption concern is necessarily addressed. "Where a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, . . . preemption concerns are fully addressed and made moot." *Ariosa Diagnostics*, 788 F.3d at 1379.

Because Appellant's claims 33 and 43 are directed to a patent-ineligible abstract concept and do not recite something "significantly more"

under the second prong of the *Alice* analysis, we sustain the Examiner's
rejection of independent claims 33 and 43 under 35 U.S.C. § 101.

Regarding dependent claims 34–42 and 44–52, Appellant argues that
the Examiner has not offered any individual analysis to notify Appellant as
to why the additional limitations in the cited claims do not render these
claims patent eligible. Appeal Br. 16. This argument is not persuasive. The
Examiner explains that because the additional limitations recited in the
dependent claims further pertain to the processor circuitry performing
conventional operations to execute steps 1 through 4 discussed above in the
rejection of independent claims 33 and 43, they do not take the claims out of
the realm of patent ineligible subject matter. Ans. 19. We agree with the
Examiner. Accordingly, we sustain the Examiner's 35 U.S.C. § 101
rejection of dependent claims 34–42 and 44–52.

2. *Obviousness Rejections*

a. XML Spy and Beckett

Appellant argues that independent claim 33 in the present appeal is
substantially similar to independent claim 33 in the '212 Appeal. Appeal.
Br. 17–18. According to Appellant, the Board previously reversed the
Examiner's obviousness rejection of claim 33 over the same combination of
XML Spy and Bennett because the cited combination does not teach
receiving both the input metadata and output metadata prior to creating the
transformation rule. *Id.* at 19–21. Appellant submits that because in the
Final Office Action, the Examiner reproduced a nearly identical rejection as
in the '212 Appeal, the board should reverse the rejection for the afore-cited

reasons, which Appellant repeats in the Appeal Brief. *Id.* at 19–55. We agree with Appellant.

At the outset, we note the Examiner does not dispute Appellant's assertions that the rejection and the claims at issue in this appeal are nearly identical to the claims and rejection reversed in the '212 Appeal. Accordingly, we summarily reverse the rejection of claims 32–52 for the same reasons articulated in the '212 Appeal, which are included in the cited pages of Appellant's Appeal Brief.

b. Williams, XML Spy, and Beckett

Appellant argues that Williams does not cure the noted deficiencies of the XML Spy-Beckett combination. Appeal Br. 55–56. According to Appellant, Williams teaches at most receiving a source object, which is transformed into a target object, as opposed to receiving a source metadata and a target metadata to create a transformation rule. *Id.* at 56. We agree with Appellant.

The Examiner relies upon Williams' abstract, and Background, paragraph 3, to teach the cited limitations. Final Act. 8–9. However, as persuasively argued by Appellant, the cited portions of Williams relate to transforming a source object into a target object of a different type. Appeal Br. 56. Because Appellant has shown one reversible error in the Examiner's rejection of claim 33, we do not reach Appellant's remaining arguments.

We likewise reverse the rejection of claims 33–52, which also recite the disputed limitations.

VI.   CONCLUSION

We reverse the Examiner's obviousness rejections of claims 32−52 under 35 U.S.C. § 103. However, we affirm the Examiner's patent eligibility rejection of claims 32–52 under 35 U.S.C. § 101.

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
32–52	101	Eligibility	32–52	
32–52	103	XML Spy, Beckett		32–52
32–52	103	Williams, XML Spy, Beckett		32–52
Overall Outcome			32–52	

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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

<u>AFFIRMED</u>