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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GEOFFRY A. WESTPHAL

Appeal 2020-000636
Application 15/214,946
Technology Center 3600

Before RICHARD M. LEBOVITZ, FRANCISCO C. PRATS, and
ULRIKE W. JENKS, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–11 and 13. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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

STATEMENT OF THE CASE

The Specification discloses “a system and method . . . for using purchasing history data to automatically create a personalized product list, particularly a personalized product list for products or services that are to be fulfilled according to a recurrence pattern.” Spec. 3.

“For example, the system may create a listing of some or all products that the system has discerned are purchased in a recurring pattern on or around a common date, dates, day, days, month, months, etc.” Spec. 8. The system may also add to a created listing of products “additional product[s] (which may be limited to those of the same category, e.g., cleaning supplies, or as otherwise filtered) that might have been discerned by the system as having a similar recurring purchasing pattern but which product is often purchased on or around different dates, days, months, etc.” *Id.*

The Specification explains that, when the system includes an additional product in a personalized product listing based on a similar purchasing pattern, “the [system] user . . . might be able to order the [additional] product with other products having a similar recurring purchasing pattern and thereby might be eligible for cost saving associated with shipping, discounts, etc.” Spec. 8–9. “In addition, the system . . . may pre-select one or more proposed purchasing dates - in keeping with the recurrence pattern - for the products within the listing which dates may also be user editable as desired.” *Id.* at 10.

Appellant’s claim 1, the only independent claim on appeal, is representative. Appellant’s claim 1 reads as follows, with the claim steps annotated with bracketed numbering:

1. A non-transitory, computer-readable medium having stored thereon computer executable instructions for generating by a product vendor server a personalized product listing for a user, the instructions performing steps, when executed by a processing device, comprising:

[1] gathering from an electronic data repository associated with the product vendor server prior product purchasing history of the user;

[2] analyzing the gathered prior product purchasing history of the user to discern if one or more products have been repeatedly purchased in the past by the user on a first recurring calendar day according to a recurrence pattern and to discern if one or more products have been repeatedly purchased in the past by the user on a second recurring calendar day according to the recurrence pattern wherein the second recurring calendar day is different than the first recurring calendar day;

[3] automatically generating a webpage form for display on a client computer, wherein the webpage form is prepopulated with the one or more products from the product vendor that have been repeatedly purchased on the first recurring calendar day according to the recurrence pattern, the one or more products from the product vendor that have been repeatedly purchased on the second recurring calendar day according to the recurrence pattern, and a recurring reorder calendar day for the one or more products from the product vendor that have been repeatedly purchased on the first recurring calendar day according to the recurrence pattern and the one or more products from the product vendor that have been repeatedly purchased on the second recurring calendar day according to the recurrence pattern that is set to the second recurring calendar day; and

[4] causing the webpage form to be sent to the client computer via use of a logical connection between the product vendor server and the client computer, the webpage form further having one or more graphical user interface input elements for allowing the user to edit the one or more products that are included within the webpage form and/or the recurring

reorder calendar day when the webpage form is caused to be displayed by the client computer prior to a submission of the webpage form to the product vendor server, whereupon the product vendor server facilitates order fulfillment of the one or more products according to the recurring reorder day upon receiving the webpage form from the client computer.

Appeal Br. 10–11.

The following rejections are before us for review:

(1) Claims 1–11 and 13, under 35 U.S.C. § 101, as being directed to subject matter not eligible for patenting (Ans. 3–5); and

(2) Claims 1–11 and 13, under 35 U.S.C. § 103(a) as being unpatentable over Kerker,² Gupta,³ Glynias,⁴ Dolezal,⁵ and official notice (Ans. 5–14).

ELIGIBILITY FOR PATENTING

The Examiner's Position

The Examiner determined that a number of the steps executed according to the instructions on the claimed computer-readable medium invention recite “an abstract idea in the field of commercial interactions.” Ans. 3; *see also id.* at 4 (“The claims recite performing steps of a commercial interaction.”).

The Examiner determined that the claims do not integrate the abstract idea into a practical application because “us[ing] a computer as a tool to perform an abstract idea, is not indicative of integration into a practical application, nor is linking the use of the judicial exception to a particular

² US 2011/0258072 A1 (published Oct. 20, 2011).

³ US 8,583,512 B1 (issued Nov. 12, 2013).

⁴ US 2011/0078028 A1 (published Mar. 31, 2011).

⁵ US 2006/0265418 A1 (published Nov. 23, 2006).

technological environment or field of use (*Mayo* test, Step 2A, Prong 2).”

Ans. 4. In particular, the Examiner reasoned:

Adding insignificant extra-solution activity to the judicial exception (e.g., causing a webpage form to be sent to a client computer) is also not indicative of integration into a practical application. The claims do not recite improvements to the functioning of a computer or to any other technology or technical field. The claims do not recite applying or using a judicial exception to effect a particular treatment or prophylaxis for a disease or medical condition. The claims do not recite applying the judicial exception with, or by the use of, a particular machine. The claims do not recite effecting a transformation or reduction of a particular article to a different state or thing. The claims do not recite applying or using a judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception (*Mayo* test, Step 2A, Prong 2).

Ans. 4.

The Examiner further determined that there are “no additional elements recited in the claims to raise them to significantly more than the judicial exception. In particular, the claims do not add a specific limitation other than what is well-understood, routine, and conventional activity in the field (*Mayo* test, Step 2B).” Ans. 5. The Examiner reasoned further:

The specific steps of the claims, such as gathering prior product purchasing history of a user, analyzing the gathered prior product purchasing history, generating a webpage form, and causing the webpage form to be sent to a client computer, etc., do not qualify, alone or in combination, to raise the claimed method to significantly more than an abstract idea.

Id.

Principles of Law

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 has long interpreted 35 U.S.C. § 101 to include implicit exceptions, however: “[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).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo Collaborative Services v. Prometheus Laboratories., Inc.*, 566 U.S. 66 (2012) and *Alice*, 573 U.S. at 217–18 (citing *Mayo*, 566 U.S. at 75–77). 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.”).

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 v. Kappos*, 561 U.S. 593, 611 (2010)); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)).

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 (quotation marks omitted).

Early in 2019, the PTO published revised guidance on the application of § 101. USPTO, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (January 7, 2019) (“2019 Office Guidance” or “Office Guidance”). In light of comments received in response to the Office Guidance, the PTO subsequently issued the *October 2019 Update: Subject Matter Eligibility* (“October 2019 Update”).⁶ “All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.” *Id.* at 51; *see also* October 2019 Update at 1.

Following the Office Guidance and the October 2019 Update, under Revised Step 2A, we first look to whether the claim recites the following:

- (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)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look, under Step 2B of the Office Guidance, to whether the claim:

- (3) adds specific limitations beyond the judicial 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 Office Guidance (84 Fed. Reg. at 56).

⁶ https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf.

Analysis

Claim 1 recites a “non-transitory, computer-readable medium having stored thereon computer executable instructions.” Appeal Br. 10. We find, therefore, that the subject matter recited in claim 1 is an article of manufacture, which falls within one of the broad statutory categories of patent-eligible subject matter under 35 U.S.C. § 101. Accordingly, we proceed to Step 2A, Prong One, of the Office Guidance to determine the claim’s subject matter eligibility in accordance with guidance under *Mayo/Alice*.

Office Guidance—Revised Step 2A, Prong 1

Applying Revised Step 2A, Prong 1, of the 2019 Office Guidance, we agree with the Examiner that Appellant’s claim 1 recites judicial exceptions, in the form of mental processes and methods of organizing human activity, which are abstract ideas. *See* Office Guidance (84 Fed. Reg. at 52 (abstract ideas include “(c) Mental processes—concepts performed in the human mind (including an observation, evaluation, judgment, opinion”); *id.* (abstract ideas include “(b) Certain methods of organizing human activity—fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations”) (citations omitted)).

The first two steps of Appellant’s claim 1 recite [1] gathering a user’s product purchasing history data from a product vendor, and [2] analyzing that data to determine whether the user, i.e., customer, has repeatedly purchased one or more products according to a recurring pattern on different first and second recurring calendar days. *See* Appeal Br. 10. While claim 1

requires the analyzing step to be performed by a processing device, a human mind is also able to analyze data to determine whether a user has repeatedly purchased one or more products according to a recurring pattern.

Accordingly, the analyzing step recited in claim 1 is a mental process, which constitutes an abstract idea. *See* Office Guidance, 84 Fed. Reg. at 52 n.14 (“If 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 performed in the mind.”).

Step [3] of Appellant’s claim 1 recites generating a webpage form that is prepopulated with (a) one or more products that the user has repeatedly purchased according to a recurring pattern on different first and second calendar days, and (b) a recurring reorder calendar day for ordering the products, wherein the recurring reorder calendar day is set to the second recurring calendar day. *See* Appeal Br. 10–11. Step [4] of Appellant’s claim 1 recites sending the prepopulated webpage form to the user, and specifies that the webpage has graphical user interface input elements that allow the user, i.e., the customer, to edit the products that are included in the webpage form, and also to edit the recurring calendar day on which the form is displayed on the user’s computer, before the user submits the form to the product vendor. *See id.* at 11.

Because steps [3] and [4] of claim 1 involve generating a product order form, and sending the form to a customer, we agree with the Examiner that claim 1 recites marketing and sales activities, which are methods of organizing human activity, ultimately constituting abstract ideas. *See* Office Guidance (84 Fed. Reg. at 52 (abstract ideas include “(b) [c]ertain methods

of organizing human activity— . . . commercial or legal interactions (including . . . marketing or sales activities or behaviors”))).

Office Guidance—Revised Step 2A, Prong 2

Having determined under Revised Step 2A, Prong 1, of the Office Guidance that Appellant’s claim 1 recites judicial exceptions, we turn to Revised Step 2A, Prong 2, of the Office Guidance to determine whether claim 1 recites additional elements that integrate the judicial exceptions into a practical application. *See* Office Guidance (84 Fed. Reg. at 54–55). We find that Appellant’s claim 1 does not recite additional elements sufficient to integrate the judicial exceptions into a practical application.

As noted above, step [2] of Appellant’s claim 1 recites the abstract mental process of analyzing data, and steps [3] and [4] recite the abstract sales activity of generating a product order form and sending the form to a customer. The remaining step [1] of Appellant’s claim 1 recites gathering sales data, which is insufficient to integrate the abstract ideas into a practical application. *See* Office Guidance (84 Fed. Reg. at 55 n.31 (additional element that merely adds insignificant extra-solution activity to a judicial exception includes “mere data gathering such as a step of obtaining information about credit card transactions so that the information can be analyzed in order to detect whether the transactions were fraudulent”))).

We are not persuaded by Appellant’s argument that the Examiner oversimplified the elements of the graphical user interface, or that the elements of the graphical user interface are sufficient to integrate the recited abstract ideas into a practical application. *See* Appeal Br. 5–6 (citing *Trading Techs. Int’l, Inc. v. CQG, Inc.*, 675 Fed. App’x 1001 (Fed. Cir.

2017) (nonprecedential)); *see also* Reply Br. 2–3 (citing *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016)).

Rather than requiring a specific configuration, the graphical user interface input elements of step [4] of claim 1 are recited entirely in terms of their functionality: “allowing the user to edit the one or more products that are included within the webpage form and/or the recurring reorder calendar day when the webpage form is caused to be displayed by the client computer prior to a submission of the webpage form to the product vendor server.”

Appeal Br. 11 (claim 1). The step does not recite how the graphical interface input elements are implemented to enable the user to edit the page.

Thus, rather than requiring specific structures or reciting limited rules that improve computer function or some other technological field, the input elements recited in Appellant’s claim 1 are merely generic computer input elements that allow a customer to select the products it wishes to buy, and the desired time for that purchase. Such generic computer elements are insufficient to integrate the abstract sales activity into a practical application. *See* Office Guidance (84 Fed. Reg. at 55 (example in which a judicial exception is *not* integrated into a practical application includes situation in which a claim “merely includes instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea”)).

Even assuming, for the sake of argument, that the process of Appellant’s claim 1 reflects an improvement in sales strategies, an improvement in an abstract idea is insufficient to establish eligibility for patenting. *See In re BRCA1- and BRCA2-Based Hereditary Cancer Test Patent Litig.*, 774 F.3d 755, 759 (Fed. Cir. 2014) (Even if Appellants “made

a “[g]roundbreaking, innovative, or even brilliant discovery,” . . . that is not enough” to establish patent eligibility.) (citing *Ass’n for Molecular Pathology v. Myriad*, 569 U.S. 576, 591 (2013)).

Appellant’s claim 1, moreover, does not recite any steps directed to delivering goods. Appellant does not persuade us, therefore, that the claimed invention “provide[s] benefits not only to the user but also to a vendor, a transport company, and the environment.” Appeal Br. 5; Reply Br. 3.

Office Guidance—Step 2B

For the reasons discussed above, we are persuaded that Appellant’s representative claim 1 recites judicial exceptions (abstract ideas in the form of mental processes and methods of organizing human behavior) under Revised Step 2A, Prong 1, of the 2019 Office Guidance, and does not integrate those judicial exceptions into a practical application under Revised Step 2A, Prong 2. Accordingly, we turn to Step 2B of the Office Guidance to determine whether (a) claim 1 recites specific limitations beyond the judicial exceptions that are not well-understood, routine, or conventional in the field, or (b) whether claim 1 simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. *See* Office Guidance (84 Fed. Reg. at 56).

In the present case, as discussed above, steps [2]–[4] of Appellant’s representative claim 1 recite performing activities that involve abstract ideas in the form of a mental process and sales activity. The only other step beyond the judicial exceptions recited in representative claim 1, step [1],

recites gathering a user's (i.e., a customer's) product purchasing history data from a product vendor.

As the Examiner found, each of Kerker, Gupta, and Glynias discloses that it was known in the art of sales activity to gather data about a customer's product purchasing history. *See* Kerker ¶ 76 (disclosing that “the vendor . . . accesses the transaction history interface . . . to determine recurring patterns within that particular vendor's . . . consumer . . . base”); Gupta Abstract (“Item-level electronic transaction data is analyzed to determine purchase intervals of items and estimate when the consumer will purchase the items again.”); Glynias Abstract (disclosing an “interactive online website . . . [which] provides a prepopulated order sheet displaying at least some sales history of products or services previously purchased by a website user”).

Given multiple disclosures in the cited prior art showing that gathering a customer's purchasing history was a known practice in sales activities, the evidence of record supports the Examiner's finding that gathering a customer's purchasing history was in widespread use in the sales art, and therefore was a well-understood, routine, conventional activity. Accordingly, we agree with the Examiner that the overall process recited in representative claim 1, viewed as an ordered combination and as a whole, simply appends well-understood, routine, conventional activities previously known to the industry (gathering purchasing history), specified at a high level of generality, to the judicial exceptions recited in the claim (analyzing the purchasing history, generating a webpage product order form based on the analysis, and sending the order form to the customer).

Viewing the steps of representative claim 1's process individually, we come to the same conclusion. As noted above, claim 1's step [1] involves the well-understood, routine, conventional activity of gathering a customer's purchasing history in electronic data form. *See* Kerker ¶ 76; Gupta Abstract; Glynias Abstract. As discussed above, step [2] of claim 1 involves the entirely mental process of analyzing the collected data, and therefore does not provide any elements beyond the abstract idea itself.

As also discussed above, steps [3] and [4] of claim 1 recite elements involved in abstract sales activity and therefore do not recite elements beyond the recited abstract ideas. In addition, the Examiner identified evidence, expressly noted (and undisputed) by Appellant (*see* Reply Br. 2 (citing Ans. 18)), to support a finding that automatically generating webpages for display (step [3]), and sending the webpage to a client computer (step [4]) were well-known, routine, and conventional. *See* Ans. 18 (citing Jallad⁷ and Bullock⁸). In determining that the elements of steps [3] and [4] recite conventional elements, the Examiner also cited to the rejection under § 103 discussed below (*see* Final Act. 4), in which the Examiner took official notice, undisputed by Appellant, that that graphical user interfaces with input elements were well known. *See* Final Act. 8. We note, in addition, that Glynias, cited in the obviousness rejection below, teaches that it was known in the art to prepare prepopulated product order forms for customers, the order forms including graphical user interface input elements allowing the user to edit the products included in webpage form, as

⁷ US 2011/0119484 A1 (published May 19, 2011).

⁸ US 7,475,346 B1 (issued Jan. 6, 2009).

well as the recurring reorder calendar day, thus supporting the Examiner's undisputed assertion of official notice in that regard. *See* Glynias Fig. 1. Given all of the above, we find that the evidence of record supports the Examiner's finding that the elements of steps [3] and [4] of claim 1 were well-known, routine, and conventional activities previously known to the industry, specified at a high level of generality, even considering the fact that those elements are directly involved in the abstract sales activity recited in the claim.

Appellant's arguments as to this issue do not persuade us of reversible Examiner error. Appellant argues:

[B]ecause the Office has failed to point to any particular section of any prior art reference to demonstrate or otherwise evidence that the other claimed elements, i.e., those claimed elements that may have been "mentioned" in the final rejection as well as those that have been ignored, are, when considered in the entirety as required, well-known, routine, and/or conventional, the rejection of the claim under 35 U.S.C. § 101 must be withdrawn. *See, e.g., Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018).

Reply Br. 2.

We note initially that Appellant's argument relating to the *Berkheimer* case is presented for the first time in the Reply Brief. As explained in 37 C.F.R. § 41.37(c)(1)(iv), except in certain circumstances not applicable here, "any arguments or authorities not included in the appeal brief will be refused consideration by the Board for purposes of the present appeal."

We are not persuaded, therefore, that the new argument relating to *Berkheimer* is properly presented for the first time in the Reply Brief, such that we should consider it. *See also* 37 C.F.R. § 41.41(b)(2) ("Any argument raised in the reply brief which was not raised in the appeal brief, or is not

responsive to an argument raised in the examiner’s answer, including any designated new ground of rejection, will not be considered by the Board for purposes of the present appeal, unless good cause is shown.”); *Ex parte Borden*, 93 USPQ2d 1473, 1477 (BPAI 2010) (The reply brief is not “an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner’s rejections, but were not.”) (“Informative”).

In its argument relating to *Berkheimer*, moreover, Appellant fails to explain specifically which particular claim elements, beyond the abstract ideas recited in claim 1, the Examiner failed to establish as being well-known, routine, and conventional activities. *See* Reply Br. 2. Absent some specific explanation as to how the Examiner reversibly erred, and the claim elements involved, we are not persuaded that Appellant’s general assertion of error is sufficient to establish any particular deficiency in the Examiner’s analysis. To the contrary, for the reasons discussed above, we agree with the Examiner that the evidence of record establishes that, whether considered as an ordered combination or as individual elements, representative claim 1 simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exceptions recited in the claim.

Eligibility for Patenting—Conclusion

As discussed above, we are persuaded that Appellant’s claim 1 recites judicial exceptions under Revised Step 2A, Prong 1, of the 2019 Office Guidance, and does not integrate those judicial exceptions into a practical application under Revised Step 2A, Prong 2. As also discussed above, we are persuaded that claim 1 simply appends well-understood, routine,

conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

Accordingly, applying the relevant legal principles enunciated by the Supreme Court and Federal Circuit as set forth in the 2019 Office Guidance and October 2019 Update, we find that the preponderance of the evidence supports the Examiner's determination that Appellant's claim 1 is directed to subject matter that is ineligible for patenting. We, therefore, affirm the Examiner's rejection of claim 1 on that ground. Because they were not argued separately, claims 2–11 and 13 fall with claim 1.

See 37 C.F.R. § 41.37(c)(1)(iv) (2018).

OBVIOUSNESS

The Examiner's Position

In rejecting claims 1–11 and 13 for obviousness, the Examiner cited Kerker as describing a process for generating a personalized product listing for a user, and cited Gupta as evidence that it would have been obvious to create a non-transitory computer readable medium with instructions to perform Kerker's process. Ans. 6.

The Examiner also cited Gupta as evidence that it would have been obvious to modify Kerker's process to discern if the user had repeatedly purchased one or more products on first and second recurring calendar days, in a recurrence pattern in which the second recurring calendar day is different than the first recurring calendar day. *See* Ans. 7.

The Examiner cited Kerker as disclosing preparation of a webpage order form, and sending that form to a client computer. Ans. 7–8. The Examiner cited Gupta as evidence that it would have been obvious for the webpage form

to have a recurring reorder calendar day for the one or more products from the product vendor that have been purchased on the first and second recurring calendar days according to the recurrence pattern, for the obvious advantage of arranging for the user to reorder at appropriate times, and avoid running out of recurrently purchased products.

Id. at 8.

The Examiner cited Glynias as evidence that it would have been obvious for Kerker's webpage form to be prepopulated with the one or more products from the product vendor that have been repeatedly purchased according to the recurrence pattern, "for the obvious advantage of aiding the user in conveniently reordering those products." Ans. 9.

The Examiner cited Dolezal as evidence that it would have been obvious to automatically generate Kerker's webpage form, and took official notice of the fact that graphical user interfaces with input elements were well known, and also took official notice that it was well known for orders to be placed by a webpage form that was filled out and sent or submitted to a server. Ans. 9.

Analysis

Appellant argues, among other things, that the Examiner did not explain sufficiently why the cited references suggest generating a webpage that is prepopulated with products repeatedly purchased on first and second recurring calendar days, wherein the form also includes a "recurrence pattern that is set to the second recurring calendar day as claimed" in representative claim 1. Appeal Br. 8.

Specifically, Appellant argues, the Examiner's conclusion that it would have been obvious to set the recurrence pattern to the second calendar day is based on improper hindsight "because Gupta expressly describes a

system that is intended to generate multiple shopping lists that are segregated according to their pre-determined or selected shopping date (See, e.g., Figs. 1 and 3, Col. 7, line 62-Col. 8, line 15).” Appeal Br. 8.

The Examiner responds:

Even supposing, *which Examiner does not concede*, that Gupta does not precisely teach the exact claim language which is admittedly not disclosed by Kerker, the teachings of Gupta at least make the modification of Kerker to meet the claim limitations a product of ordinary skill and common sense, not patentable innovation.

Ans. 22.

Moreover, the Examiner argues:

[T]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413 . . . (CCPA 1981).

Ans. 23.

Having carefully considered all of the evidence and arguments advanced by Appellant and the Examiner, we agree with Appellant that the Examiner has not explained sufficiently why the cited references would have suggested generating the prepopulated webpage form required by Appellant’s claim 1. In particular, Appellant’s claim 1 recites generating a webpage form prepopulated with (a) the one or more products purchased according to a recurrence pattern on different first and second calendar days, and (b) “recurring reorder calendar day for the one or more products . . . *that is set to the second recurring calendar day.*” Appeal Br. 10–11 (emphasis added).

We acknowledge, as the Examiner points out, that Gupta discloses analyzing data regarding recurring purchases made on different recurring calendar days. *See* Gupta 12:39–44 (“In the illustrated example [shown in Fig. 6A], purchase intervals 251b,c of Cereal 2 (RAISIN BRAN) and Diapers (PAMPERS) are the same even though RAISIN BRAN and PAMPERS s were purchased at different times due to considering the average number of items 212s purchased over the same time.”); *see also id.* at Fig. 6A (showing different recurring purchase dates for RAISIN BRAN, PAMPERS, and BRAWNY).

As Appellant points out, however, the shopping lists generated according to Gupta are set to the next estimated calendar day on which the items are needed to be purchased, segregated either by day, or by merchant. *See* Gupta Figs. 7–11; *see also id.* at 8:8–13 (disclosing “determin[ing] which items 212 were estimated by purchase interval program 254a to be needed or purchased again within a predetermined time or by a certain date” and in response to that determination “generat[ing] multiple shopping lists 253m segregated according to pre-determined criteria”).

Thus, on the current record, Gupta teaches that shopping lists should be set to the next estimated day on which items are expected to be needed. We are not persuaded, therefore, that the Examiner has explained sufficiently why Gupta (even when combined with the other cited references), would have suggested generating a prepopulated product order form for a customer, the form including a list of multiple products, where the form is prepopulated with a recurring reorder calendar day that is *set to the second recurring calendar day* on which products are repeatedly purchased, as recited in Appellant’s claim 1.

We acknowledge, as the Examiner contends, that evaluation of obviousness *requires* consideration of common sense. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (“Rigid preventative rules that deny factfinders recourse to common sense . . . are neither necessary under our case law nor consistent with it.”).

As our reviewing court has pointed out, however, ordinary creativity and/or common sense “cannot be used as a wholesale substitute for reasoned analysis and evidentiary support, especially when dealing with a limitation missing from the prior art references specified.” *DSS Tech. Mgmt., Inc. v. Apple Inc.*, 885 F.3d 1367, 1374 (Fed. Cir. 2018) *see also id.* at 1374–75 (“In cases in which common sense is used to supply a missing limitation, as distinct from a motivation to combine, . . . *our search for a reasoned basis for resort to common sense must be searching.*”) (internal quotations omitted; emphasis added).

In the present case, the Examiner did not explain specifically *why* ordinary creativity and/or common sense would have led a skilled artisan to generate a prepopulated product order form for a customer, the form including a list of multiple products, where the form is prepopulated with a recurring reorder calendar day that is set to the *second* recurring calendar day on which products are repeatedly purchased, as recited in Appellant’s claim 1. Nor are we persuaded that the Examiner explained sufficiently why any teaching in any of the cited references, or knowledge generally available to skilled artisans, would have suggested generating a prepopulated product order form for a customer, where the form is prepopulated with a recurring reorder calendar day that is set to the *second* recurring calendar day, as recited in Appellant’s claim 1. Accordingly, because we are not persuaded

that the Examiner has explained sufficiently why a skilled artisan would have prepared a computer-readable medium having all of the features recited in Appellant's claim 1, we reverse the Examiner's obviousness rejection of claim 1, and its dependent claims.

CONCLUSION

In summary:

| Claims Rejected | 35 U.S.C. § | Reference(s)/Basis | Affirmed | Reversed |
|------------------------|--------------------|--|-----------------|-----------------|
| 1-11, 13 | 101 | Eligibility | 1-11, 13 | |
| 1-11, 13 | 103(a) | Kerker, Gupta, Glynias, Dolezal, Official Notice | | 1-11, 13 |
| Overall Outcome | | | 1-11, 13 | |

TIME PERIOD FOR RESPONSE

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