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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ZACHARY DAWSON, REBECCA ADLER,
PATRIA S. KUNDE, JOHN TREADWELL, WEIFENG WU,
and ERIC ROSENBLATT

Appeal 2020-002652
Application 14/095,475
Technology Center 3600

Before CARL W. WHITEHEAD JR., DAVID M. KOHUT, and
IRVIN E. BRANCH, *Administrative Patent Judges*.

BRANCH, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the
Examiner’s decision to reject claims 75–88. Appeal Br. 1; Non-Final Act. 1.
We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use “Appellant” to reference the applicant as defined in
37 C.F.R. § 1.42. Appellant identifies the real party in interest as
“Fannie Mae.” Appeal Br. 6.

STATEMENT OF THE CASE

Appellant's Invention

Appellant's invention is "an automated collateral fraud and risk detection application . . . [for] determin[ing] whether a final appraised value of an appraisal was correctly reconciled from comparable properties listed on the appraisal." Spec., Abst. Claims 75–77 recite the subject matter argued on appeal and are reproduced below, with emphases and bracketed letters (claim 75) added to be consistent with the Examiner (Non-Final Act. 6).

[A] 75. A computer program product embodied on a non-transitory computer-readable data storage device in a manner that the computer program product is executable by a host computing device, the computer program product comprising:

[B] computer code for electronically **receiving**, by the host computing device via a communication infrastructure, **an instruction from a client** computing device that commands the host computing device **to acquire an appraisal form data file, wherein the appraisal form data file is an electronic version of an appraisal form;**

[C] computer code for electronically **acquiring**, by the host computing device via the communication infrastructure, **the appraisal form data file from a database** after the host computing device receives the instruction from the client computing device, *wherein the client computing device is at a physical location other than where the database is sited;* and

[D] computer code for electronically **extracting**, by the host computing device, reconciliation data from a **reconciliation section of the appraisal form data file after the host computing device acquires the appraisal form data file** from the database, *wherein the computer program product utilizes pointers to reference a location within the appraisal form data file in which the reconciliation data is obtained,*

[E] *wherein the computer program product utilizes data types to reference a location of adjusted and indicated values in other sections of the appraisal form data file when the adjusted and indicated values are not located within the reconciliation section of the appraisal form data file.*

76. The computer program product of claim 75, further comprising:

computer code for electronically applying, by the host computing device, a routine to the reconciliation data in a manner that permits the host computing device to detect a condition in the reconciliation data after the host computing device extracts the reconciliation data from the appraisal form data file.

77. The computer program product of claim 76, further comprising:

computer code for electronically applying, by the host computing device, a heuristic to the condition in a manner that permits the host computing device to determine whether or not a final appraised value for a subject property is correctly reconciled from properties that are comparable to the subject property.

Appeal Br., Claims App.

Rejections

Claims 77–88 stand rejected under 35 U.S.C. § 112(a) as failing to comply with the written description requirement. Non-Final Act. 3–4.

Claims 75–88 stand rejected under 35 U.S.C. § 101 as being directed to a judicial exception. Non-Final Act. 4–9.

Claims 75 and 76 stand rejected under 35 U.S.C. § 102(a)(1) as being anticipated by Graboske (US 2011/0258127 A1; published Oct. 20, 2011(hereinafter “Graboske ’127”). Non-Final Act. 9–15.

Claims 77–81, 83, and 85–88 stand rejected under 35 U.S.C. § 103 as being unpatentable over Graboske '127 and Graboske (US 2008/0004893 A1; published Jan. 3, 2008 (“hereinafter “Graboske '893”). Non-Final Act. 16–25.

Claims 82 and 84 stand rejected under 35 U.S.C. § 103 as being unpatentable over Graboske '127, Graboske '893, and Coon (US 2008/0162224 A1; published July 3, 2008). Non-Final Act. 25–29.

WRITTEN DESCRIPTION

Claims 77–88 stand rejected under 35 U.S.C. § 112(a). Claim 77, which is a base claim of claims 78–88, recites the following disputed limitation: “computer code for electronically applying, by the host computing device, a heuristic to the condition in a manner that permits the host computing device to determine whether or not a final appraised value for a subject property is correctly reconciled from properties that are comparable to the subject property.” The Examiner concludes the claimed heuristic “encompasses a broad genus of possible ways to apply the heuristic” and the Specification’s disclosed examples of heuristics do not show possession of the genus. Non-Final Act. 3–4. Specifically, the Examiner states (*in toto*):

The limitation encompasses a broad genus of possible ways to apply the heuristic, and a genus of possible heuristics. In other words, the claims encompass any and all ways to perform the application of any heuristic. This is a generic recitation of how the result or outcome is achieved.

Generic claim language in the original disclosure does not satisfy the written description requirement if it fails to support the scope of the genus claimed. . . . Here, the scope of the

genus is any and all applications of any and all heuristics. Claims 69–74 do not further narrow the scope of the heuristic or how it is applied and therefore cover the same genus as the independent claims.

. . . The genus is too broad and the specification has not disclosed a sufficient number of species to show one of skill in the art that Applicant had possession of the entire genus of ways to perform those actions.

Id.

Appellant contends the Examiner’s determinations lack fact-findings about the Specification. Reply Br. 3. Specifically, Appellant contends the Examiner avoids the following question of fact: “This test involves an inquiry into the four corners of the specification from the perspective of a person of ordinary skill. . . . [It] is a question of fact that necessarily varies depending on the context.” Reply Br. 3 (quoting *In re Global IP Holdings LLC*, 927 F.3d 1373, 1377 (Fed. Cir. 2019)). We agree with Appellant.

To establish a *prima facie* case of unpatentability based on a lack of written description, the Examiner must “present[] evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.” *In re Alton*, 76 F.3d 1168, 1175 (Fed. Cir. 1996) (quoting *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976)). A procedural caveat is stated by a judicially-adopted portion of the Manual of Patent Examining Procedure (“MPEP”), as follows:

A general allegation . . . is not a sufficient reason to support a rejection for lack of adequate written description, but a simple statement such as ‘Applicant has not pointed out where the new (or amended) claim is supported, nor does there appear to be a written description of the claim limitation . . . in the application as filed’ may be sufficient[.]

Hyatt v. Dudas, 492 F.3d 1365, 1370 n.4 (Fed. Cir. 2007) (stating MPEP § 2163.04(I)(B) is a “lawful formulation of *prima facie* standard for a lack of written description rejection”); *see also* MPEP § 2163.04(I)(B) (Rev. 08.2017, Jan. 2018) at 2100-321 (presenting the statements quoted by *Hyatt*). As shown above, this caveat comes with the caution that the statement “may be sufficient.” *Id.* Further, it comes with the condition that “the claim is a new or amended claim . . . and applicant has not pointed out where the limitation is supported.” *Id.*

We find the Examiner’s statements are tantamount to the above “simple statement.” We also find the “simple statement” is insufficient here, because Appellant has presented Specification paragraphs (cited and quoted with emphasis) believed to provide written description support (Appeal Br. 12–17). Accordingly, the Examiner must provide reasons why an ordinarily skilled artisan would not recognize, in the presented paragraphs, a description of the invention that shows possession of the full claim scope. That is, the Examiner must do more than categorically state claim 77 “encompasses a broad genus of possible ways to apply the heuristic” (Non-Final Act. 3–4) and the Specification lacks sufficient examples to show possession of the genus (*id.* at 4). The Examiner must—but does not here—present corresponding findings of fact and support them with evidence or reasoning.

Furthermore, the Examiner does not provide a claim scope for consideration against the Specification, but rather states “[t]he limitation encompasses a broad genus of possible ways to apply the heuristic, and a genus of possible heuristics” (Non-Final Act. 3–4). *Compare In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (“Before it can be held that the claims on

appeal cover ‘a wide range of compositions,’ it is essential to know what the claims do in fact cover.”). Because the rejection lacks a clear construction of the limitation in question, we could only speculate whether the limitation is sufficiently described by the presented Specification paragraphs. We decline to do so.

Accordingly, for the foregoing reasons, we do not sustain the rejection of claims 77–88 under 35 U.S.C. § 112(a).

To facilitate prosecution, we add that the Examiner’s description of the claimed “heuristic” is indicative of means-plus-function (“MPF”) claiming. Ans. 6. The Examiner states: “The [Specification’s] description of ‘heuristic’ is merely expected results . . . [and] akin to a ‘black box’ in that one would understand what inputs go in the system and the expected result, but there is no description of what is happening inside the ‘black box’.” *Id.* at 6 (citing Spec. ¶ 37). The Examiner is stating that, in the context of Appellant’s Specification, “heuristic” is used as a nonce word. This was a principle issue in the Federal Circuit decision discussed by the Appeal Brief and Answer—*Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286 (Fed. Cir. 2014). *See id.* at 1301 (“Depending upon the circumstances, [‘]heuristic[’] is not necessarily a generic, structureless ‘nonce word or a verbal construct’ without any meaning, such as ‘mechanism,’ ‘means,’ ‘element,’ or ‘widget.’”); Appeal Br. 9–11; Ans. 4–5. If claim 77 uses “heuristic” as a nonce word, then claim 77 likely constitutes an MPF feature (for the reasons below) and thus only encompasses its corresponding structure disclosed by the Specification; i.e., it is interpreted under 35 U.S.C. § 112(f). In that case, claim 77 cannot implicate the written description requirement of § 112(a). *See, e.g., In re Dossel*, 115 F.3d 942,

946 (Fed. Cir. 1997) (An MPF feature does not implicate the written description requirement.).

The claimed heuristic arises from the following limitations of claim 77 and intervening claim 76: “detect a condition in the reconciliation data after the host computing device extracts the reconciliation data from the appraisal form data file” (claim 76); and “applying . . . a heuristic to the condition . . . to determine whether or not a final appraised value for a subject property is correctly reconciled from properties that are comparable to the subject property” (claim 77). The limitations only require that the claimed heuristic determine, from a detected condition of the extracted reconciliation data, whether the appraised value of a property was correctly reconciled from comparable properties. Thus, if “heuristic” is used as a nonce word, the limitations “merely state[] the expected result and not how the system goes about determining” the result. Ans. 5. That is, the limitations would only require the above “determine” function—not any steps or structure for achieving the function. *See* Manual of Patent Examining Procedure (MPEP) § 2181 (9th ed. 2018) (in-depth instructions for identifying an MPF feature).

The possible MPF drafting of claim 77 is further apparent from the *Apple* decision. *Apple*’s claimed “heuristics” limitations were not construed as MPF features, but only because of the claim’s and Specification’s descriptions of the recited heuristics (757 F.3d at 1301–03) and a now-defunct “strong presumption” against MPF claiming (*id.* at 1300, 1304). *See also Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349 (Fed. Cir. 2015) (“[We] expressly overrule [*Apple*’s] characterization of the presumption[—a limitation lacking the word ‘means’ is not an MPF

feature—]as ‘strong.’ We also overrule the strict requirement of ‘a showing that the limitation essentially is devoid of anything that can be construed as structure.’”² Because of the descriptions, the *Apple* court could discern “the limitation’s operation” when construing it in view of the Specification. *Id.* at 1300; *see also id.* at 1301 (“We need not decide here whether the term ‘heuristic,’ by itself, connotes sufficient structure to maintain the presumption against means-plus-function claiming[.] . . . [T]he claim language and specification disclose the heuristics’ operation . . . , including the inputs, outputs, and how certain outputs are achieved.”).

The Examiner should consider whether claim 77, in view of the Specification, requires sufficient structure for performing the claimed heuristic’s function. *See, e.g.,* Spec. ¶ 79 (“With regard to the . . . heuristics, . . . the descriptions . . . should in no way be construed so as to limit the claims.”). The Examiner should also consider whether claim 77 recites the “heuristic” in a manner similar to instances where courts have interpreted claimed logic, modules, etc., as MPF features. *See, e.g., Williamson*, 792 F.3d at 1348–51 (Fed. Cir. 2015) (overruling the “strong presumption” of *Apple* and then interpreting a claimed “distributed learning control module” as a MPF feature); *Grecia v. Samsung Electronics America, Inc.*, 780 Fed. Appx. 912 (2019) (interpreting a claimed “customization module” as an MPF feature in view of *Williamson* and *Apple*); *Thought, Inc. v. Oracle Corp.*, No. 12-CV-05601-WHO, 2014 WL 5408179, at *18–19

² Expressly overruling the corresponding determinations of *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1358 (Fed. Cir. 2004), *Inventio AG v. ThyssenKrupp Elevator Americas Corp.*, 649 F.3d 1350, 1358 (Fed. Cir. 2011), *Flo Healthcare Solutions, LLC v. Kappos*, 697 F.3d 1367, 1374 (Fed. Cir. 2012), and *Apple*, 757 F.3d at 1297 (Fed. Cir. 2014).

(N.D. Cal. Oct. 22, 2014), *aff'd*, 698 F. App'x 1028 (Fed. Cir. 2017) (interpreting claimed “computer logic” as an MPF feature in view of *Apple* and citing similar lower-court interpretations of claimed logic and modules).

ELIGIBILITY

All claims (75–88) stand rejected under 35 U.S.C. § 101 as being directed to a judicial exception. We select claim 75 as representative. 37 C.F.R. § 41.37(c)(1)(iv) (representative claims); Appeal Br. 18 (“[C]laims 75–88 stand or fall together.”). For the following reasons, we are unpersuaded of error in this rejection of claim 75.

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. However, the 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) (citation omitted).

In determining whether a claim falls within an excluded category, we are guided by the Supreme 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” (*id.* 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 Supreme 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 187; *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 Supreme 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.* (citing *Benson* and *Flook*); *see, e.g., 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 (citation omitted). “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.*

PTO Guidance

The PTO provides guidance for 35 U.S.C. § 101. USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”). Under the Guidance, 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 activities such as a fundamental economic practice, and mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

84 Fed. Reg. at 52–55. Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then conclude the claim is directed to a judicial exception (*id.* at 54) and 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.

Id. at 56.

Step 1: Does Claim 75 Fall Within a Statutory Category?

There is no dispute that the claimed subject matter falls within a 35 U.S.C. § 101 category of patentable subject matter. *See* Guidance, 84 Fed. Reg. at 53–54 (“Step 1”); Non-Final Act. 6 (“[C]laims 75–88 are directed to a manufacture.”).

Step 2A(1):³ Does Claim 75 Recite Any Judicial Exceptions?

We agree with the Examiner that claim 75 recites—and, more particularly, describes—judicial exceptions. *See* October 2019 Patent Eligibility Guidance Update at 1 (meaning of “describe”), *available at* https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf; *see also* 84 Fed. Reg. 55942 (Oct. 18, 2019) (notifying the

³ The Guidance separates the enumerated issues (1) to (4) (*see supra* 6–7) into the following Steps 2A(1), 2A(2), and 2B:

[T]he revised procedure . . . focuses on two aspects [of whether a claim is “directed to” a judicial exception under the first step of the *Alice/Mayo* test (USPTO Step 2A)]: (1) [w]hether the claim recites a judicial exception; and (2) whether a recited judicial exception is integrated into a practical application. [W]hen a claim recites a judicial exception and fails to integrate the exception into a practical application, . . . further analysis pursuant to the second step of the *Alice/Mayo* test (USPTO Step 2B) . . . is needed . . . in accordance with existing USPTO guidance as modified in April 2018.[footnote omitted]

84 Fed. Reg. at 51.

public of the Guidance Update). Specifically, we agree the bold portions of claim 75 (as reproduced *supra* 2–3) encompass “instructions from a client to acquire appraisal data . . . and extract reconciliation information from the appraisal data” (Non-Final Act. 6). We further agree the bold portions thereby encompass “a fundamental economic practice . . . of mitigating the risk of erroneous appraisal reports[] and a commercial or legal interaction based on the appraisal form” (*id.*). We add that these concepts fall under the following judicial exception recognized by the Guidance: “(b) Certain methods of organizing human activity—fundamental economic principles or practices (. . . mitigating risk); commercial or legal interactions (. . . marketing or sales activities or behaviors; business relations).” Guidance 84 Fed. Reg. at 52.

We further add that the italicized portions of claim 75’s [D] and [E] limitations (*supra* 2–3) encompass mental processes to the extent appraisers must mentally (e.g., when working ‘pen-and-paper’) “reference a location within the appraisal form . . . in which the reconciliation data is obtained” and “reference a location of adjusted and indicated values in other sections of the appraisal form . . . when the adjusted and indicated values are not located within the reconciliation section of the appraisal form data file.” These concepts fall under the following judicial exception recognized by the Guidance: “(c) Mental processes—concepts performed in the human mind (. . . observation, evaluation, judgment, opinion).” Guidance 84 Fed. Reg. at 52 (footnote omitted); *see also id.* at n.14 (addressing “pen and paper” processes).

*Step 2A(2): Are the Recited Judicial Exceptions
Integrated Into a Practical Application?*

We agree with the Examiner that claim 75's additional elements do not integrate the above judicial exceptions into a practical application. *See* Guidance, 84 Fed. Reg. at 53 (describing a “practical application” as a “meaningful limit on the [recited judicial exceptions], such that the claim is more than a drafting effort designed to monopolize the [exceptions]”); *id.* at 55 (“exemplary considerations . . . indicative [of] a practical application”). Specifically, we agree the non-bold limitations of reproduced claim 75 (*supra* 2–3) add the following features:

[The computer program product] of limitation A[,] as well as [the] communication infrastructure and client computing device [of] limitation B, . . . are recited at a high level of generality.

The portions of limitations . . . D[] and E that have been formatted in italics . . . do not limit the claim scope because they do not require any steps or functions to be performed[.]
...

Furthermore, the claim as a whole . . . instruct[s] generic computing devices to carry out [operations that] are shown to be [judicial exceptions].

As such, the claim as a whole read[s] as an instruction to perform [judicially-expected activity] by “applying it” on the generic devices. As an ordered combination (along with modifiers such as “electronic” version of the appraisal form)[,] the additional elements establish a technological environment, but . . . ha[ve] no meaningful impact on the [judicially-expected activity].

Non-Final Act. 7 (paragraphing added).

We add that the italicized portions of claim 75's [D] and [E] limitations (*supra* 2–3) recite mere printed matter of the computer program product (and, as stated for Step 2A(1), also recite a mental process). *See*

In re Distefano, 808 F.3d 845, 850–51 (Fed. Cir. 2015) (Printed matter, i.e., “claimed for what it communicates,” has no patentable weight unless functionally or structurally related to the claimed invention.); *Praxair Distribution, Inc. v. Mallinckrodt Hosp. Prod. IP Ltd.*, 890 F.3d 1024, 1033 (Fed. Cir. 2018) (“Because claim limitations directed to mental steps may attempt to capture informational content, they may be considered printed matter lacking patentable weight[.]”). The italicized portions do not restrict a claimed operation, but rather only recite that a “pointer” and “data types” reference a location. There is no claimed processing of the pointer or data types. Compare *In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (“The printed matter cases have no factual relevance where . . . the claims *require*[] that the information be processed . . . by a machine, [i.e.,] the computer.” (internal quotation mark omitted)). The pointer and data types are merely information stored by the computer program product. See *id.* (“Lowry does not claim merely the information content of a memory.”).

We also add our disagreement with the Examiner’s finding that the italicized portion of claim 75’s [C] limitation (*supra* 2) does not carry patentable weight. Non-Final Act. 7. This portion, by reciting “the client computing device is at a physical location other than where the database is sited,” restricts the claimed acquiring step by restricting where the host acquires the appraisal form data file. See *Distefano*, 808 F.3d at 851 (“[T]he Board erred in finding that the origin of the web assets constituted printed matter . . . and erred in assigning the origin no patentable weight.”). However, as explained in our below discussion of MPEP § 2106.05(a)–(c) and (e)–(h), the italicized portion of claim 75’s [C] limitation adds only a ubiquitous feature a client/server-database architecture and is accordingly

inconsequential. *See* Guidance 84 Fed. Reg. at 55, nn.25, 27–32 (citing these MPEP sections).

1. MPEP § 2106.05(a)

MPEP § 2106.05(a) concerns “Improvements to the Functioning of a Computer or To Any Other Technology or Technical Field.” MPEP at 2100-50. Specifically, it concerns “whether the claim purports to improve computer capabilities or, instead, invokes computers merely as a tool.” *Id.* at 2100-51–52. Having reviewed Appellant’s claim 75, Specification, and arguments, we find no indication that the invention improves computer capabilities. And rather, we find the claimed computer technology merely allocates the claimed operations to a ubiquitous client/server-database architecture. *See Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324–25 (Fed. Cir. 2016) (“[T]he claims add only generic computer devices such as an interface, network, and database[, which] . . . do not satisfy the inventive concept requirement.” (quotation marks and citations omitted)). Specifically, the claimed host is a server computer that provides services; it acquires a real estate appraisal form and then extracts the form’s reconciliation data. *See* Spec. ¶¶ 1–15 (invention’s purpose). The claimed client is a remote client computer that instructs the host/server to acquire the appraisal form. The claimed database is the storage location of the appraisal form and not part of the client computer (it is ostensibly, though not claimed as such, a database of the host). Accordingly, and consistent with the claim’s generic (i.e., nondescript) recitations of the host (“host computing device”), client (“client computing device”), database (“database”), and their connectivity (“communication infrastructure”), the

claimed computer technology is merely a generic client/server-database architecture.

Appellant contends the claimed computer devices operate in an unconventional manner and, in support, compares claim 75 to a patent-eligible claim of *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016). Appeal Br. 18–20. We are unpersuaded because, though *Amdocs* found a collection of generic computer devices was patent-eligible because it operated in an unconventional manner (*id.* at 1300–01), Appellant does not show claim 75’s computer devices operate in an unconventional manner. Appellant merely identifies some similarities between claim 75 and the *Amdoc*’s claim—never explaining how these similarities show that claim 75’s computer devices operate in an unconventional manner. As *Amdocs* explains with respect to its compared claim 1 (841 F.3d at 1299), the Federal Circuit has found ***both eligibility and ineligibility of “somewhat facially-similar claims”*** (*id.* at 1300) and the eligibility of *Amdoc*’s claim 1 turned on a narrow interpretation of its terms that embodied an unconventional use of computer technology (*id.* at 1300–01). Appellant’s arguments show, at most, claim 75 and the compared *Amdoc*’s claim are also somewhat facially-similar (which, as stated, is not alone persuasive).

Appellant also contends the Examiner “wantonly disregards the express structural electronic devices and networks . . . [of] claim 75” (Appeal Br. 21) and “fails to provide any objective evidence sufficient to define a ‘generic computer’” (*id.* at 23) in finding the claimed computer devices “amount[] to no more than an instruction to use . . . generic computers and [a] network as a tool to carry out the judicial exception” (*id.*

at 22 (quoting Non-Final Act. 7)). We are unpersuaded because, as the Examiner finds, the claimed computer devices are indeed generic (i.e., nondescript). Non-Final Act. 7. Also, as the Examiner further finds, the Specification provides generic examples of the claimed computer devices and even indicates the inventors did not contemplate specific (much less unconventional) computer technology. *Id.* (citing Spec. ¶¶ 16–20); *see also*, e.g., Spec. ¶ 20 (“[T]he exemplary components . . . are not intended to be limiting.”). There is simply no indication that claim 75 sets forth unconventional computer technology. *See Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1322 (Fed. Cir. 2016) (“The district court erred in relying on technological details set forth in the patent’s specification and not set forth in the claims[.]”).

2. MPEP § 2106.05(b) and (c)

MPEP § 2106.05(b) and (c) respectively concern use of a “Particular Machine” and “Particular Transformation.” MPEP at 2100-54, 56 (transformation must be “of an article”). We find no indication, and Appellant does not contend, the invention uses a particular machine or performs a particular transformation.

3. MPEP § 2106.05(e)

MPEP § 2106.05(e) concerns “Other Meaningful Limitations.” MPEP at 2100-62. Specifically, it concerns whether the claim “limitations [go] beyond generally linking the use of the judicial exception to a particular technological environment.” *Id.* It also describes, as an example of limitations falling short of this threshold, a “data processing system and communications . . . [that] merely linked the use of the abstract idea to . . . computers[.]” *Id.* (citing *Alice*, 573 U.S. at 226). We find the claimed

computer technology merely links the invention to data processing and communication—namely, to a client, server, and database.

4. MPEP § 2106.05(g)

MPEP § 2106.05(g)⁴ concerns “Insignificant Extra-Solution Activity.” MPEP at 2100-67–69. Specifically, it concerns whether “the additional elements add more than . . . activities incidental to the primary process or product.” *Id.* at 2100-67. We find the claimed computer technology is merely incidental to the invention’s primary aim of “determining whether a final appraised value reflects a value indicated by comparable properties” (Spec. ¶ 11). For example, the claimed allocation of activities to a host, client, and database is a natural consequence of offering e-commerce services. *See Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1329 (Fed. Cir. 2017) (addressed by MPEP § 2106.05(g) at 2100-68)) (describing “token post solution components” as a “natural consequence of carrying out the abstract idea in a computing environment”).

5. MPEP § 2106.05(h)

MPEP § 2106.05(h) concerns “Field of Use and Technological Environment.” MPEP at 2100-69. Specifically, it concerns whether an industry-specific claim limitation is “integrated into the claim” or rather does “not alter or affect how the process steps of calculating . . . were performed.” *Id.* at 2100-70. We find no indication that claim 75’s industry-specific limitations alter how the invention performs the claimed operations. For example, we find no difference between the claimed “extracting . . . [of] reconciliation data from a reconciliation section of the

⁴ Because part (f) recommends to first address the other considerations (*id.* at 2100-64), we address part (f) after parts (g) and (h).

appraisal form data file” and extracting other types of information from forms and files.

6. MPEP § 2106.05(f)

MPEP § 2106.05(f) concerns “Mere Instructions To Apply An Exception.” MPEP at 2100-63. Specifically, it concerns the “particularity or generality of the application of the judicial exception.” *Id.* at 2100-66–67. We address this consideration with reference to *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016), which is twice cited by MPEP § 2106.05(f) and addresses a patent-eligible software implementation of an abstract idea (*McRO*, 837 F.3d at 1307, 1316). Equating an abstract idea to a “result,” *McRO* held the claim patent-eligible because it recites a “means” sufficiently specific to prevent preemption. *Id.* at 1314 (“The preemption concern arises when the claims are not directed to a specific invention and instead . . . abstractly cover results where it matters not by what process or machinery the result is accomplished.”). In holding the claim overcame this concern, *McRO* identified a claimed means (“first set of rules”) that applied unconventional data (“a keyframe at a point that no phoneme is being pronounced,” i.e., at a “phoneme sub-sequence”) to the abstract idea (use of “morph-weights” to lip-synchronize animation) and thereby prevented preemption of the abstract idea. *Id.* at 1306–07, 1311, 1314–15. Whereas this means of *McRO*’s claim prevented preemption of the recited abstract idea, we find no indication that claim 75 prevents preemption of the recited judicial exceptions. And rather, there is a plain risk that claim 75 would preempt use of a client/server-database architecture—a basic tool of modern commerce—to acquire an appraisal form and extract reconciliation data from the form.

Step 2B: Does Claim 75 Recite Anything That Is Beyond the Recited Judicial Exceptions and Not a Well-Understood, Routine, Conventional (“WURC”) Activity?

We agree with the Examiner that claim 75 does not recite any feature that neither constitutes a judicial exception nor is WURC. 84 Fed. Reg. at 56. Specifically, we agree:

The generality of the [claimed] additional elements is consistent with Applicant’s specification at 0016-22[,] . . . amount[ing] to no more than an instruction to use the generic computers and network as a tool to carry out the judicial except[ed activities].

. . . The same analysis applies here in 2B, i.e., mere instructions to apply an exception on a generic computer cannot integrate judicial exception into a practical application at Step 2A or provide an inventive concept in Step 2B.

Non-Final Act. 8. We also agree that, even assuming the italicized portions of claim 75’s [D] and [E] limitations carry patentable weight, the included “pointers” and “data types” are recited only as a “generic technological element.” Ans. 9 (citing Spec. ¶ 47 and an “IBM definition” of a “pointer”); *see also* Spec. ¶ 47 (stating “data types[] such as pointers” and thereby teaching the claimed “data type” may be a “pointer”). Because all of the claimed additional elements are generic computer devices and data, we further agree there is no need for evidence that the claimed additional elements were WURC. Ans. 9.

We add that the claimed additional elements perform only basic computer functions such as processing data, storing data, executing instructions, and receiving or transmitting data over a network. Per MPEP § 2106.05(d), these basic functions are WURC when claimed in a merely generic manner as here. *See* MPEP § 2106.05(d)(II) at 2100-60–61 (list of computer functions judicially-recognized as WURC); *see also Bascom Glob.*

Internet Servs., Inc. v. AT&T Mobility LLC, 827 F.3d 1341, 1349 (Fed. Cir. 2016) (mere use of a local client computer, remote server, and Internet network is WURC); *Berkheimer Memorandum* § III.A.2 (stating MPEP § 2106.05(d)(II) is sufficient evidence that a computer function is WURC).

Appellant contends the claimed “pointer” is neither generic nor WURC, but rather “connotes a specific type of data recall mechanism” that is not a generalized use of a computer as a tool. Appeal Br. 26 (quoting *Ex parte Shaouy*, Appeal 2016-002093 (PTAB 2017)). In support, Appellant cites *Bascom Global Internet Services v. AT&T Mobility*, 827 F.3d 1341 (Fed. Cir. 2016), *Enfish, LLC v. Microsoft Corp.*, 822 F. 3d 1327 (Fed. Cir. 2016) and *Trading Technologies International, Inc. v. CQG, Inc.*, 675 F. App’x 1001, 1004 (Fed. Cir. 2017). Appeal Br. 24–26.

We are unpersuaded. First, as discussed *supra*, the claimed pointer does not carry patentable weight. Second, even assuming the claimed pointer carries patentable weight, Appellant does not identify the alleged “specific . . . mechanism” of a pointer (Appeal Br. 26), much less overcome the Examiner’s evidence that “pointer” is merely a generic term for data providing the address of other data (Ans. 9). *See also In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant[.]”). Third, the cited case law merely shows that the claimed pointer is not “specific” for purposes of § 101 unless specific enough to prevent preemption of the claimed judicial exceptions, which Appellant does not show. *See Bascom*, 827 F.3d at 1352 (The claims “do not preempt . . . filtering content,” but rather “carve out a specific location for the filtering

system (a remote ISP server.)”); *Enfish*, 822 F.3d at 1339 (The claims “recited . . . a specific type of data structure . . . confirm[ing] . . . the § 101 analysis has not been deceived by the ‘draftsman’s art.’” (quoting *Alice*, 573 U.S. at 226)); *Trading Techs.*, 675 F. App’x at 1004–05 (“[S]pecific technologic modifications . . . **generally** produce patent-eligible subject matter.” (emphasis added)).

Accordingly, for the foregoing reasons, we sustain the rejection of claims 75–88 under 35 U.S.C. § 101.

ANTICIPATION, OBVIOUSNESS REJECTIONS

Claims 75–78 stand rejected under 35 U.S.C. §§ 102(a)(1) and 103. Appellant argues only claim 75 (Appeal Br. 27–37) and contends the remaining claims “stand or fall” therewith (*id.* at 38). For the following reasons, we are unpersuaded of error in the rejection of claim 75.

Appellant contends “Graboske ‘127 . . . fails to teach that the processing apparatus (18) receives an instruction from a computing device (16) that commands the processing apparatus (18) to acquire an appraisal form data file” (Appeal Br. 29) and thus fails to teach the claimed “receiving, by the host computing device . . . , an instruction from a client computing device that commands the host computing device to acquire an appraisal form data file” (*id.* at 28). We agree with the Examiner’s response:

Graboske ‘127 teaches that “a computing device 16 may send the necessary information to the processing apparatus 18, and the apparatus 18 may then use the information to create an appraisal report” [0030]. The “instruction” is that computing device sending the necessary information to the processing apparatus and the “acquire” aspect is that the apparatus uses the information to create an appraisal report.

Ans. 10–11. Appellant does not address the Examiner’s response.

Reply Br. 8–12 (addressing the § 102(a)(1) rejection).

Appellant also contends the Examiner cannot rely on multiple embodiments of Graboske ‘127 as teaching the claimed “acquiring, by the host computing device . . . , the appraisal form data file from a database.” *Id.* at 30–31. We agree with the Examiner’s response:

Graboske ‘127 does disclose “embodiments” but the embodiments discussed build off of each other within the same scope (a system to fill out appraisal forms) building off of each other. Paragraphs [0022-0029] all have a central concept that Graboske builds upon each other throughout.

Ans. 11. Appellant only replies that any reliance on a reference’s multiple embodiments is an “untenable position” for a finding of anticipation (Reply Br. 9), which is simply incorrect. A reference’s mere use of the word “embodiment” does not preclude a reference from directing a person of ordinary skill in the art to use features of those labeled embodiments in a single device, system, etc.; the reference can nonetheless disclose “the possible combinability of the embodiments.” *Chamberlain Grp., Inc. v. Techtronic Indus. Co.*, 935 F.3d 1341, 1350 (Fed. Cir. 2019) (“Because Weik’s disclosure as to the possible combinability of the embodiments . . . is less than clear, we agree . . . the jury’s no-anticipation verdict was not supported by substantial evidence.”); *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1343 (Fed. Cir. 2016) (“This case is distinguishable from *Net MoneyIN* because . . . [the reference] explicitly contemplates the combination of the disclosed functionalities. In addition, . . . [there is a] factual determination that one of skill in the art would read the reference as disclosing the ability to combine the tools[.]”). Appellant does not address the Examiner’s finding that Graboske ’127 directs an artisan to start with a

central concept and then optionally “build off” the central concept by adding features of the disclosed embodiments.

Appellant also contends “paragraphs [0022] and [0024] of Graboske ‘127 fail to recite a processing apparatus (18) extracting data from an appraisal form data file” (Appeal Br. 34) and thus fails to teach the claimed “electronically extracting, by the host computing device, reconciliation data from a reconciliation section of the appraisal form data file” (*id.* at 32).

We agree with the Examiner’s determination:

When . . . a discrepancy exists between the database entries and URAR version 1 and URAR version 2, it . . . triggers the reporting function to the appraiser[.] . . . This . . . shows that the system is extracting data from an appraisal form data file (. . . Uniform Residential Appraisal Report (URAR) form)[.] . . . [A]s well[,]. . . the system acquires the mapped information from the form (extracting data) in order . . . to auto-populate the database information.

Ans. 12. Appellant only replies that “this assertion in the Examiner’s Answer has been addressed in the Appellant’s [Appeal] Brief on pages 32–34.” Reply Br. 10. The cited Appeal Brief pages 32–34 do not address the Examiner’s finding, but rather merely quote the finding, quote Graboske ‘127’s applied paragraphs 22 and 24, and then summarily conclude paragraphs 22 and 24 “fail to recite a processing apparatus (18) extracting data from an appraisal form data file” (Appeal Br. 34). These statements do not amount to an argument for consideration on appeal, much less a response to the Examiner’s finding that Graboske ‘127’s determination and reporting of discrepancies in the Appraisal Report would be understood as extracting data from the report.

Appellant also contends the Examiner errs by construing the italicized

portions of claim 75's limitations [D] and [E] as lacking patentable weight because "a functional limitation must be evaluated" inasmuch that "the prior art apparatus must be capable of performing the claimed function."

Appeal Br. 35. We are unpersuaded because Appellant does not address the Examiner's determination that the italicized portions "do not require any . . . functions to be performed" (Non-Final Act. 13). Moreover, we conclude the italicized portions indeed do not carry patentable weight (*see supra* 13–14).

Appellant also contends the Examiner errs by failing to construe the claimed pointer as a "specific type of data recall mechanism" (*id.* at 36) and thus failing to show Graboske '127 teaches such a pointer (*id.* at 36–37). We are unpersuaded for each of three reasons. First, the claimed pointer does not carry patentable weight. *See supra* 13–14. Second, Appellant does not identify the claimed pointer's "specific . . . mechanism" for our consideration. *See In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (affirming the anticipation rejection because the appellant "merely argued that the claims differed from [the prior art], and chose not to proffer a serious explanation of this difference."); *Baxter*, 952 F.2d at 391 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art."). Third, we agree with the Examiner's determination that: "Graboske '127 discloses[] 'the data in the real estate database 12 may be pre-coded to match certain fields in electronic appraisal forms[.]' [This] . . . is the function of a pointer[—]to reference a location within the form." Ans. 13 (citing Graboske '127 ¶ 29).

Accordingly, for the foregoing reasons, we sustain the rejections of claims 75–88 under 35 U.S.C. §§ 102(a)(1) and 103.

CONCLUSION

For the foregoing reasons, we affirm the Examiner’s decision to reject claims 75–88.⁵

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
77–88	112(a)	Written Description		75–88
75–88	101	Eligibility	75–88	
75, 76	102(a)(1)	Graboske ’127	75–76	
77–81, 83, 85–88	103	Graboske ’127, Graboske ’893	77–81, 83, 85–88	
82, 84	103	Graboske ’127, Graboske ’893, Coon	82, 84	
Overall Outcome			77–88	

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

⁵ “The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.” 37 C.F.R. § 41.50.