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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL JAMES CARR

Appeal 2018-005890
Application 12/374,372
Technology Center 2100

Before JOSEPH L. DIXON, JAMES R. HUGHES, and ERIC S. FRAHM,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from a rejection of claims 1–19. Claims 21–40 are canceled. We have jurisdiction under 35 U.S.C. § 6(b). This appeal is related to prior appeal 2013-005374 which reversed the Examiner’s prior art rejections.

We reverse.

The claims are directed to methods for surfing the Internet. Claims 1, 10, and 14, reproduced below, is illustrative of the claimed subject matter:

1. A method of surfing the Internet comprising: a. selecting information on a web page; b. clicking on the information as it resides on the web page; and c. in response to the clicking, conducting a web search on the information.

10. A method comprising: a. clicking on information; and b. in response to the clicking, conducting a web search on the information.

14. A method of surfing the Internet comprising: a. positioning a cursor over information to be searched; and b. initiating a web search by clicking on the information.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Ellis	US 2006/0184516 A1	Aug. 17, 2006
Lisa	US 2011/0219291 A1	Sept. 8, 2011

¹ Appellant indicates that the inventors are the real party in interest. (App. Br. 2; the appeal brief does not include pagination. We start our pagination from the cover page as page 1).

REJECTIONS

The Examiner made the following rejections:

Claims 1–19 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. (Final Act. 5).

The Claims 1–19 are an abstract idea of (i) a fundamental economic practice, (ii) a method of organizing human activities, (iii) an idea of itself, or (iv) a mathematical relationship or formula. (Final Act. 6).

Claims 1–19 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more. Claim(s) 1–19 is/are directed to the abstract idea of searching documents and merely implementing this abstract idea on a general purpose computer. (Final Act. 7).

Claims 1, 3, 8–12, 14, 15, 18, and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ellis.

Claims 4–7 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis and further in view of Lisa.

ANALYSIS

35 U.S.C. § 101

The Examiner appears to have set forth two separate rejections under 35 U.S.C. § 101. First, the Examiner finds “Based upon consideration of all the relevant factors with respect to the claim as a whole, claims 1 and 14 deemed to claim an abstract idea (Using a generic computer to perform a search using a mouse click.) and are rejected under § 101.” The Examiner further finds “The Claims 1-19 are abstract idea of (i) a fundamental

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economic practice, (ii) a method of organizing human activities, (iii) an idea of itself, or (iv) a mathematical relationship or formula.” (Final Act. 6). The Examiner goes on to provide a general discussion of patent eligibility without any specific findings or analysis to support the Examiner’s conclusion. As a result, we find the Examiner has not provided sufficient analysis under the 2014 Interim Guidance on Subject Matter Eligibility (2014 IEG) to support the Examiner’s conclusion of a lack of patent ineligible subject matter.

Second, the Examiner finds:

Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more. Claim(s) 1-19 is/are directed to the abstract idea of searching documents and merely implementing this abstract idea on a general purpose computer.

(*Id.* at 7).

The Examiner further finds “claims 1, 10, and 14 recite the activities of selecting information on a web page and conducting a web search on the information associated with clicking on the information. All of the foregoing activities, when viewed as individual activities and/or ordered combination, *constitute human behaviors of merely managing a game of bingo.*” (*Id.*) (emphasis added).

The Examiner’s statement, quoted above, is confusing and appears to be a typographical error—although the statement is unclear, it seems the Examiner is merely referring to the *Planet Bingo* case discussed at page 4 in the July 2015 Update: Subject Matter Eligibility Guidelines. Finally, the Examiner finds that the “claims amount to limitations that are well-understood, routine, and conventional in the field of data retrieval,” but

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provides not evidence to support the finding. (Final Act. 8; *see also* Ans. 3–4).

Appellant sets forth a brief argument for patent eligibility based upon *Enfish* case and argue that the claimed invention improves the functioning of the computer itself. Specifically, Appellant contends:

The claims are clearly not directed to “(i) a fundamental economic practice” (not about economics), nor to “(iii) an idea of itself” (not just an idea), nor to “(iv) a mathematical relationship or formula” (there is no mathematical relationship or formula). While not as clear, the claims are also not directed to “(ii) a method of organizing human activities”, but rather are directed to either *improving the functioning of the computer itself* or *improving an existing technological process*, that is, *improving internet searching technology*. Recently (May 12, 2016), the Federal Circuit noted, *[t]he Supreme Court has suggested that claims “purport[ing] to improve the functioning of the computer itself,” or “improv[ing] an existing technological process” might not succumb to the abstract idea exception. ENFISH, LLC v. Microsoft Corporation, No. 2015-1244, (Fed. Cir. 2016), citing Alice, 134 S. Ct. at 2358-59.*

(App. Br. 8).

The Examiner disagrees and finds:

Firstly, Appellant's claimed invention is an abstract idea of performing a routine and conventional Internet search using clicking. Appellants do not contest that the invention found in present application is directed to an abstract idea. Namely, the three actions found in the present claims are “selecting information on a web page”, “clicking on the information”, and “conducting a web search” all directed to the abstract idea of collecting information, analyzing it, and displaying certain results of the collection and analysis as found in *Electric Power Group. Electric Power Group, LLC v. ALSTOM SA*, 830 F. 3d 1350.

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(Ans. 3–4). Finally, in response to Appellant’s argument that the claims are like those set forth in the *Enfish case*, the Examiner concludes that “Appellant’s invention merely performs a web based search when a user clicks on information without anything more.” (Ans. 4).

We find the Examiner’s statement to be conclusory without providing any substantive support/analysis for the Examiner’s conclusion. We find Appellant’s Specification states:

The inventor of the present inventions discovered that it would be great if he could remove the step of manually copying, cutting/pasting, dragging/dropping or retyping the word or phrase into a search field, and instead simply position the cursor over or otherwise select (e.g., highlight) the word or phrase and click or take some action on it, which click or action would cause a web search on the word or phrase to be conducted on a search engine and the search results to be displayed.

(Spec. ¶ 4). Additionally, the Specification provides a description of a conventional search engine paragraphs 36–37, but “[t]he present invention is directed to a system and method for expediting this search process.” (Spec ¶ 38). The Specification further discloses:

Under a specific embodiment of the present invention, the reader may select the Specific Content information (i.e., the name “Patricia Russo”) for which more information is sought, and then take a predetermined action or actions which will execute a web search on the Specific Content information *in situ*. By *in situ*, it is meant that the search is executed on the Specific Content information from where it originally sits within the General Content information, without having to manually copy, type, or drag-and-drop, the Specific Content information into a search engine search field.

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(Spec. ¶ 39).²

As a result, we find the Examiner’s sweeping reliance upon *Electric Power Group* case to overgeneralize Appellant’s claimed invention. Moreover, the Examiner’s findings with regards to the abstract idea of “performing a routine and conventional Internet search using clicking” to overgeneralize the claimed invention where the combination of the steps reduces the actions required by the user to perform the same result. (Ans. 3). Therefore, we find the Examiner has not provided sufficient required factual findings and analysis under the 2014 and 2015 Patent Subject Matter Eligibility Guidelines.

These same findings and conclusions are required to analyze the Examiner’s rejection under the new 2019 Revised Patent Subject Matter Eligibility Guidance.

Consequently, we find the Examiner’s factual findings regarding the underlying abstract idea to overgeneralize the claimed invention under the patent eligibility guidelines at the time of the rejection in the Final Action and Examiner’s Answer and this same overgeneralized abstract idea similarly does not meet the Examiner’s requisite burden for analysis under the 2019 Revised Patent Subject Matter Eligibility Guidance (<https://www.govinfo.gov/content/pkg/FR-2019-01-07/pdf/2018-28282.pdf>) (*see* USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019)). As a result, we cannot sustain the Examiner’s conclusion of a lack of patent eligible subject matter of independent claims

² We note that the Specification and claims are drafted at a high level with little detail as to how the selected information is parsed and input to a search engine to perform the web/internet search on the selected information. We leave it to the Examiner to evaluate this issue in any further prosecution on the merits.

1, 10, and 14 and their dependent claims based upon the Examiner's same deficient findings in the Final Action and the Examiner's Answer.

35 U.S.C. § 102(b)

With respect to independent claims 1, 10, and 14, the Examiner relies upon paragraphs 37, 38, 62, 107, and 115 of the Ellis reference. (*See* Final Act. 8–10 and rejection of claim 3). We note that the language of independent claims 1 and 14 refer to searching the “Internet” and independent claim 10 refers to a “web search.”

Appellant argues that independent claims 1, 10, and 14 all require a “clicking” on the target information and “in response to the clicking, conducting a web search on the information;” and in contrast, the cumulative cited prior art reference Ellis teaches “clicking” on “hyperlinks” within an “enhanced” document. (App. Br. 8).

From our review of the Ellis reference, we find that the Ellis reference discloses using a document editor 12 to modify a document operates to associate the one or more created compound words with the document to produce an enhanced document. (Ellis ¶ 62). Subsequently, query editor 14 operates to enable a searcher to address the database 11 of enhanced documents with a query. The query editor 14 is operable to receive the query and convert it into one or more searchable compound words that contains contextually relevant information. (Ellis ¶ 62).

Additionally, the Ellis reference discloses that a one click search part of the invention for presentation of links to other documents (*see* Ellis ¶¶ 59, 115).

We find the Ellis reference discloses to a single click searching, but the searching is with respect to the enhanced documents in the database 11

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where the word, phrase, or sentence in the document may be used as a hyperlink to conventional search engines. (Ellis ¶ 115). The Ellis reference further discloses:

This allows every word, phrase or sentence in the document (not only the compound words) to be used as a hyperlink to a conventional search engine to undertake a semantic search as previously described against documents that have already been translated semantically.

...

search terms can be placed on the document, or alternatively to a side of the document as alternative links.

(Ellis ¶ 115). Therefore, the Ellis reference does not disclose the search is performed on the Internet in response to the clicking or selection, but is performed on a local enhanced document repository and uses hyperlinks rather than the information selected by the user. Consequently, we cannot sustain the rejection of independent claims 1, 10, and 14 and their respective dependent claims based upon anticipation under 35 U.S.C. § 102(b).³

35 U.S.C. § 103(a)

With respect to dependent claims 4–7 and 16, the Examiner has not identified how the Lisa reference remedies the noted deficiency in the Ellis

³ We leave it to the Examiner to further consider whether it would have been obvious to extend the limited disclosure of the Ellis reference from searching the enhanced document repository to the Internet and web based searching of additional content.

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reference in the anticipation rejection. (Final Act. 14). As a result, we cannot sustain the Examiner's obviousness rejection of claims 4–7 and 16.

CONCLUSIONS

The Examiner erred in rejecting claims 1–19 based upon a lack of patent eligibility subject matter under 35 U.S.C. § 101; the Examiner erred in rejecting claims 1, 3, 8–12, 14, 15, 18, and 19 based upon anticipation under 35 U.S.C. § 102(b); and the Examiner erred in rejecting claims 4–7 and 16 based upon obviousness under 35 U.S.C. § 103(a).

DECISION

For the above reasons, we reverse the Examiner's patent eligibility rejection of claims 1–19; we reverse the Examiner's anticipation rejection of claims 1, 3, 8–12, 14, 15, 18, and 19; and we reverse the Examiner's obviousness rejection of claims 4–7 and 16.

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

REVERSED