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**In The
Supreme Court of the United States**

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C. DOUGLASS THOMAS,
Petitioner,

v.

**ANDREI IANCU, Director,
United States Patent and
Trademark Office,**
Respondent.

◆

*On Petition for Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit*

◆

PETITION FOR WRIT OF CERTIORARI

◆

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QUESTIONS PRESENTED

Contrary to Congress' directives and this Court's guidance, the United States Court of Appeals for the Federal Circuit ("Federal Circuit") fabricated legal theories to unfairly discriminate against software innovations. The Federal Circuit incorrectly held that the Patent Trial and Appeal Board of the United States Patent and Trademark Office ("USPTO") did not commit legal error when, under the guise of following the framework provided in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014) (so called "*Alice/Mayo* framework"), it (i) excessively abstracted the claims, and (ii) ignored claim limitations that were found to be nonobvious when concluding that the claims lacked an inventive concept. The questions presented are:

1. Whether software innovations, simply because they are implemented on a general purpose computer, are ineligible for patenting unless they claim some hardware limitations beyond a general purpose computer that provide an improvement to computer technology.
2. Whether, contrary to *Diehr*, claim limitations can be ignored, under the guise of the *Mayo/Alice* framework, when a claim is evaluated for presence of an inventive concept, even when the ignored claim limitations were found to be nonobviousess.

**PARTIES TO THE PROCEEDING AND
RELATED CASES**

The parties to the proceeding, as identified in the caption, are C. Douglass Thomas, Petitioner, and Andrei Iancu, Director, United States Patent and Trademark Office, Respondent.

There are no other proceedings in other courts that are directly related to the case in this Court.

RULE 29.6 STATEMENT

Pursuant to this Court's Rule 29.6, Petitioner Thomas has no parent company and no publicly held company that owns 10% or more of its stock.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner, C. Douglass Thomas (“Thomas”), respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit (“Federal Circuit”) (Pet. App., *infra*, 1a-2a) rendered judgment without opinion (in accordance with its Rule 36). That opinion was thus unreported. Also, following Petitioner’s petition for rehearing and rehearing en banc, the Federal Circuit chose to deny the petition for rehearing and rehearing en banc (Pet. App., *infra*, 19a-20a). The decisions and judgments of the Patent Trial and Appeal Board (“Board”) are provided in the Appendix (Pet. App., *infra*, 3a-18a, 21a-39a).

JURISDICTION

The jurisdiction of this Court rests on 28 U.S.C. § 1254(1). The judgment of the Federal Circuit was initially entered on March 5, 2020. In response to Thomas’ petition for panel rehearing and rehearing en banc, the Federal Circuit on May 1, 2020, denied said petition. App., *infra*, 19a-20a. This petition is filed within 90 days of the Federal Circuit’s denial of petition for rehearing and rehearing en banc.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

United States Constitution, Article 1, section 8, clause 8 provides:

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

Section 101 of the Patent Act provides: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101.

INTRODUCTION

In the aftermath of *Alice*, the Federal Circuit has once again created massive confusion on patent eligibility under Section 101 of the Patent Act. Without intervention by this Court, the Federal Circuit will upend long-standing and well-settled principles of eligibility and impose a test under which software innovations are treated in a discriminatory fashion so that almost all software is deemed “abstract” and thus patent ineligible. In *Alice*, this Court attempted to clarify patent eligibility, using a two-part test (“*Alice/Mayo* framework”): (1) patent claims must not be drawn to a patent-ineligible concept — such as a law of nature, natural phenomenon, or abstract idea — but (2) if they are, they must contain an “inventive

concept sufficient to transform the claimed abstract idea into a patent eligible application.” *Id.* at 2357. In doing so, this Court, however, did not elucidate what qualifies as an “abstract idea” or precisely how to determine an “inventive concept.” As a result, the Federal Circuit has been left without a legal anchor and has floundered, issuing conflicting decisions and undermining any hope of consistency or predictability. As one commentator has noted, after *Alice*, “great uncertainty remains with respect to what is patent eligible in America.”¹

In this case, the Federal Circuit used the confused state of the law to contravene long-standing precedent from this Court on patent eligibility. The innovation at issue relates to a particularized process that details *how* an on-line survey can be produced through interaction between a requestor and a remote server to *produce* an on-line survey, and then the created on-line survey is provided to an Internet-based survey manager to host the on-line survey and permit various appropriate survey participants to take the on-line survey by interaction with the Internet-based survey manager. The invention easily qualifies as a “new and useful process” or “new and useful improvement thereof” that Congress intended to be eligible under the plain terms of Section 101. 35 U.S.C. § 101.

¹ See, e.g., Gene Quinn, *Alice Five Years Later: Hope Wanes as 101 Legislative Discussions Dominated by Big Tech*, IPWatchdog.com (May 5, 2019), <https://ipwatchdog.com/2019/05/05/alice-five-years-later-gearing-up-to-commemorate-the-deathof-101/id=108926/> (“As the fifth anniversary of the *Alice* decision approaches, great uncertainty remains with respect to what is patent eligible in America.”).

The Federal Circuit, with dogged determination, ignored the claim language and bullied the claim into just “performing surveys,” which it does not. The Federal Circuit then proceeded to ignore all of the actual claim limitations, other than a few hardware limitations, to conveniently conclude that the claims lacked an inventive concept. Having completely corrupted the *Alice* test, the Federal circuit held that the claims at issue were ineligible for patenting under Section 101. This case is yet another clear example of the Federal Circuit’s bias against software innovations.

This conflicts directly with *Diamond v. Diehr*, 450 U.S. 175 (1981), and the long-standing principle that mere incorporation of an abstract idea into an invention does not render a claim patent ineligible. See *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1853). It also conflicts with *Diehr*’s instruction that “[i]n determining the eligibility of respondents’ claimed process for patent protection under § 101, their claims must be considered as a whole.” 450 U.S. at 188. This infidelity to *Diehr* alone warrants certiorari.

The abstract idea exception to Section 101 in the Federal Circuit’s hands, however, is a failed experiment. *Alice* did not provide the clarity the Court envisioned. Instead, the Federal Circuit and various parties have used the chaos that has followed the Court’s decision to eliminate numerous patents. Indeed, after *Alice*, by one estimate, a 914% increase in the number of patents invalidated under

Section 101.² *Alice*’s explicit warning to “tread carefully in construing [the Section 101] exclusionary principle lest it swallow all of patent law,” 134 S. Ct. at 2354, has largely been realized.³

The time has come for this Court to reevaluate the abstract idea exception to Section 101. This exception is entirely a judicial creation, having no basis in the text of the statute. The Court should undertake to implement Section 101’s broad and explicit language. Thus, where, as here, the patents claim a “new or useful process” or new and useful improvement to a process, the inventions should be eligible under Section 101 as Congress intended based on the language of that provision.

The petition should be granted to resolve the conflict with this Court’s precedent, to bring clarity to patent eligibility, and to remand eligibility to the text of Section 101 provided by Congress.

² See Robert Sachs, *Alice: Benevolent Despot or Tyrant? Analyzing Five Years of Case Law Since Alice v. CLS Bank: Part I*, IPWatchdog.com (Aug. 29, 2019), <https://www.ipwatchdog.com/2019/08/29/alice-benevolent-despot-or-tyrant-analyzing-fiveyears-of-case-law-since-alice-v-cls-bank-part-i/id=112722/>.

³ Russell Slifer, *The Federal Circuit Just ‘Swallowed All of Patent Law’ in ChargePoint v. SemaConnect*, IPWatchdog.com (Apr. 2, 2019), <https://www.ipwatchdog.com/2019/04/02/federal-circuit-just-swallowed-patent-law-chargepoint-v-semaconnect/id=107917/>.

STATEMENT OF CASE

I. STATUTORY BACKGROUND AND JUDICIAL EXCEPTIONS

Section 101 declares that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” may obtain a patent. 35 U.S.C. § 101.⁴ The “expansive terms” of Section 101 were intended to give “the patent laws ... wide scope.” *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980). This was intentional because Congress expected Sections 102, 103, and 112 would do the heavy lifting in weeding out invalid patents. *Id.* at 309 (“Congress intended statutory subject matter to ‘include anything under the sun that is made by man.’” (quoting S. Rep. No. 82-1979, at 5 (1952); H.R. Rep. No. 82-1923, at 6 (1952))).

Despite the broad scope of Section 101, this Court crafted an “implicit exception” to this provision: “Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice*, 132 S. Ct. at 2354. According to the Court, this so-called abstract-idea exception creates a “threshold test” for patent eligibility. *Bilski v. Kappos*, 561 U.S. 593, 602 (2010).

A. Origins of the Abstract-Idea Exception

In *Le Roy v. Tatham*, the Court first articulated the principle that, under a predecessor to

⁴ The term “process” is defined as a “process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.” 35 U.S.C. § 100(b).

the current Patent Act, an abstract idea cannot be patented. The Court explained that a “principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.” 55 U.S. at 175. At the same time, the Court noted an important distinction between laying claim to the principle, truth, or motive, and incorporating them into an invention. According to the *Le Roy* Court, “the processes used to extract, modify, and concentrate natural agencies, [may] constitute the invention.” *Id.* For instance, “[a] new property discovered in matter, when practically applied, in the construction of a useful article of commerce or manufacture, is patentable.” *Id.*

In the following Term, the Court applied the principle laid down in *Le Roy* to invalidate part of Samuel Morse’s patent for the telegraph. See *O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 112 (1854). Morse’s patent had broadly claimed “the use of the motive power of the electric or galvanic current, which I call electro-magnetism, however developed for marking or printing intelligible characters, signs, or letters, at any distances, being a new application of that power of which I claim to be the first inventor or discoverer.” *Id.* According to the Court, this went too far. The Court reiterated the distinction between “a patent for a principle” and “a machine, embodying a principle”— that is, patents laying claim to a principle versus those incorporating or applying that principle. *Id.* at 115. Morse’s first claim, the Court

concluded, was “a patent for a principle” because it sought to cover electromagnetism itself. *Id.* at 117.⁵

The Court reiterated the distinction between claiming a scientific principle and claiming an application of it in *The Telephone Cases*, which resolved nearly two decades of litigation over who first patented the telephone in favor of Alexander Graham Bell. *See Dolbear v. Am. Bell Tel. Co. (The Telephone Cases)*, 126 U.S. 1, 534 (1888). In the course of its decision, the Court restated the key holding of *Morse* “that the use of magnetism as a motive power, without regard to the particular process with which it was connected in the patent, could not be claimed,” but the “use [of that power] in that connection could.” *Id.* Bell, unlike Morse, had incorporated electricity into his particular invention, rather than having laid claim to electricity itself. And the possibility “that electricity cannot be used at all for the transmission of speech, except in the way Bell has discovered” would, “if true, show more clearly the great importance of his discovery, but it will not invalidate his patent.” *Id.* at 535.

The Court carried the same eligibility dividing line into the early 20th Century in *Mackay Radio & Tel. Co. v. Radio Corp. of America*, 306 U.S. 86, 94 (1939). There, the patent incorporated a “mathematical formula by which [a particular] desired relationship is secured,” which the patent

⁵ The Court applied the dividing line established in *Le Roy* and *Morse* to process patents as well. *See, e.g., Corning v. Burden*, 56 U.S. (15 How.) 252, 267–68 (1854) (“It is for the discovery or invention of some practicable method or means of producing a beneficial result or effect, that a patent is granted, and not for the result or effect itself.”).

holder “did not invent,” but rather was “published in a scientific journal thirty years before.” *Id.* at 92–93. The Court assumed, without holding, that the claimed invention was patentable, because it was “apparent that if this assumption is correct the invention was a narrow one.” *Id.* at 94. In the course of decision, the Court reaffirmed that, “[w]hile a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.” *Id.*

B. The Modern Abstract-Idea Exception

After World War II, federal courts invalidated patents at an alarming rate, due in large part to the judicially created “invention” requirement—that is, whether the patent evidenced “invention.” See *Athena Diagnostics, Inc. v. Mayo Collaborative Servs., LLC*, 927 F.3d 1333, 1371 (Fed. Cir. 2019) (O’Malley, J., dissenting from denial of rehearing en banc). In response, in 1952, “Congress attempted to address” the “criticisms” of this requirement “by amending the Patent Act to replace the ill-defined and judicially-created invention requirement with the more workable anticipation and obviousness tests codified in Sections 102 and 103.” *Id.* at 1372. Despite Congress’ amendment of the Patent Act, including Section 101, however, this Court continued to look to its earlier case law in developing the current abstract idea exception to Section 101. *Id.*

One example of this is *Gottschalk v. Benson*, 409 U.S. 63 (1972). There, the patent application claimed a method of programming a computer to “convert[] binary coded decimal number

representations into binary number representations.” *Id.* at 73–74. The program consisted of a straightforward application of an algorithm, “[a] procedure for solving a given type of mathematical problem,” *id.* at 65, which consisted of a series of “mathematical procedures” that could “be carried out in existing computers long in use, no new machinery being necessary,” *id.* at 67. The algorithmic steps could “also be performed without a computer.” *Id.* The Court reviewed its prior decisions in *Le Roy*, *Morse*, *Mackay*, and *The Telephone Cases*, among others, and synthesized them into the rule that, under Section 101, “one may not patent an idea.” *Id.* at 71. The invention at issue was so closely related to the underlying algorithm that the patent “in practical effect would be a patent on the algorithm itself.” *Id.* at 72. Accordingly, the supposed invention was unpatentable because it fell within an implicit exception to Section 101.

In *Parker v. Flook*, 437 U.S. 584, 588 (1978), the Court invalidated an application for “a method of updating alarm limits” in a catalytic converter. *Id.* at 585. The Court acknowledged that “[t]he line between a patentable ‘process’ and an unpatentable ‘principle’ is not always clear,” *id.* at 589, that “[t]he plain language of § 101 does not answer the question,” and that “[i]t is true, as respondent argues, that his method is a ‘process’ in the ordinary sense of the word.” *Id.* at 588. But in *Benson*, the Court concluded, “forecloses a purely literal reading of § 101.” *Id.* at 589.

By contrast, in *Diehr*, the Court explained that “in dealing with the patent laws, we have more than once cautioned that ‘courts “should not read

into the patent laws limitations and conditions which the legislature has not expressed.” ’ ’ 450 U.S. at 182 (quoting *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980)). Nonetheless, the Court picked up the thread from its earlier case law to distinguish between patents claiming a principle itself and those that merely incorporate an idea or principle into the invention.

In *Diehr*, the patentee claimed an improved rubber curing process, and one of the steps included a mathematical algorithm. *Id.* at 177–78. The Court found the invention patent eligible under Section 101 even though “in several steps of the process a mathematical equation and a programmed digital computer are used,” because the patent holder sought “only to foreclose from others the use of that equation in conjunction with all of the other steps in their claimed process.” *Id.* at 185, 187. The Court observed that “Obviously, one does not need a ‘computer’ to cure natural or synthetic rubber, but if the computer use incorporated in the process patent significantly lessens the possibility of ‘overcuring’ or ‘undercuring,’ the process as a whole does not thereby become unpatentable subject matter.” *Id.* at 187. The Court warned that “[i]t is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis.” *Id.* at 188. The “claims must be considered as a whole.” *Id.* And, as a whole, the claims at issue were patent eligible.

After *Diehr*, the Court did not address the “abstract idea” exception to Section 101 for 30 years until *Bilski*. There, the Court held that a “business method” patent “that explains how buyers and

sellers of commodities in the energy market can protect, or hedge, against the risk of price changes” fell “outside of § 101 because it claims an abstract idea.” *Id.* at 599, 609.

The Court returned to the Section 101 exception two years later in *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012). The claims in Mayo “purport[ed] to apply natural laws describing the relationships between the concentration in the blood of certain thiopurine metabolites and the likelihood that the drug dosage will be ineffective or induce harmful side-effects.” *Id.* at 72. These claims fell short of patentability. The claims simply “inform[ed] a relevant audience about certain laws of nature; any additional steps consist of well-understood, routine, conventional activity already engaged in by the scientific community; and those steps, when viewed as a whole, add nothing significant beyond the sum of their parts taken separately.” *Id.* at 79–80.

Most recently, the Court in *Alice* distilled *Mayo* into “a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” 134 S. Ct. at 2355. The Court explained that “[f]irst, we determine whether the claims at issue are directed to one of those patent ineligible concepts” — i.e., laws of nature, natural phenomena, or abstract ideas. *Id.* Second, “[i]f so, we then ask, ‘[w]hat else is there in the claims before us?’” *Id.* (quoting *Mayo*, 566 U.S. at 78). This second step is effectively “a search for an ‘inventive concept’ — i.e., an element or combination of elements that is ‘sufficient to ensure that the

patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.” *Id.* (quoting *Mayo*, 566 U.S. at 72–73).

The claimed invention in *Alice* involved “a computer implemented scheme for mitigating ‘settlement risk’ (i.e., the risk that only one party to a financial transaction will pay what it owes) by using a third-party intermediary.” *Id.* at 2351–52. Applying “*Mayo*’s framework,” *id.* at 2357, the Court unanimously invalidated the patents, holding that the claims were “drawn to the abstract idea of intermediated settlement, and that merely requiring generic computer implementation fails to transform that abstract idea into a patent-eligible invention,” *id.* at 2352.

In the course of discussion, the Court reaffirmed *Diehr* and its dividing line between claims incorporating abstract ideas and claims of abstract ideas themselves. The Court recognized that “[a]t some level, ‘all inventions ... embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.’” *Id.* at 2354 (quoting *Mayo*, 566 U.S. at 71). It explained that “an invention is not rendered ineligible for patent simply because it involves an abstract concept.” *Id.* The Court further explained that there is a distinction between “patents that claim the ‘buildin[g] block[s]’ of human ingenuity,” i.e., those claiming an abstract idea, which are not patent eligible, “and those that integrate the building blocks into something more.” *Id.* (alterations in original) (quoting *Mayo*, 566 U.S. at 89).

II. PROCEEDING BELOW

A. The Invention

The claimed invention at issue pertains to improved approaches for producing surveys. The surveys are produced (i.e., created) on-line and able to be directed (i.e., targeted) to appropriate participants. The surveys themselves can be produced at and with assistance of an Internet-based survey manager, such as being built on-line through interaction with the Internet-based survey manager. As a result, the invention enables surveys to be produced in a more effective, less cumbersome way than even before. Additionally, by using pre-registered survey participants, the participants are known to be participants that are willing to complete surveys. The appropriate participants are able to be selected and notified of a world wide web location where a survey electronically resides and is to be performed.

B. Before the U.S. Patent and Trademark Office

Thomas filed a patent application with the USPTO on October 19, 2005, but has a priority date back to July 1, 1997. Examination before the patent examiner proceeded for several years and eventually all claims were finally rejected on August 22, 2011 as obvious under 35 U.S.C. § 103(a). That final rejection was appealed to the Board on January 23, 2012. About 3 years later, on December 22, 2015, the Board issued a decision reversing the patent examiner on all grounds.

Despite that decision from the Board *reversing* the patent examiner, the patent examiner surprisingly

reopened prosecution and issued another Office Action dated April 8, 2016 to again reject all claims. The overzealous patent examiner apparently regarded the Board's reversal "as a challenge" to fabricate another way to reject the patent request, which is improper under USPTO's examination procedures, namely MPEP § 1214.04. This time, the patent examiner only slightly altered the rejections under 35 U.S.C. § 103 that just had been reversed by the Board. The Examiner added in an additional reference to the combination of three other prior art references and added a new ground of rejection under 35 U.S.C. § 101 for patent ineligibility. Thomas then appealed these new rejections back to the Board on June 8, 2016.

The Board issued its decision on the second appeal ("Board's Decision") on October 16, 2018. Pet. App. 3a-18a. In its decision, the Board once again *reversed* the prior art rejections under 35 U.S.C. § 103(a) finding the claims not obvious, but *affirmed* the Examiner's rejection under 35 U.S.C. § 101 as an abstract idea ineligible for patenting. Appellant filed a request for rehearing with the Board on November 16, 2018, which was denied on April 12, 2019. Pet. App. 21a-39a. On June 11, 2019, an appeal was file to the Federal Circuit for review of the Board's Decision.

C. Before the Federal Circuit

An application for a patent is to be approved for patenting unless one of the statutory requirements is shown by the Patent Office to not be satisfied. Here, claims deemed nonobvious, were nevertheless rejected as patent ineligible under

35 U.S.C. § 101. The Federal Circuit summarily affirmed on appeal. Unfortunately, in reaching its decisions, the Federal Circuit distorted the *Alice/Mayo* framework and clearly disregarded numerous claim limitations.⁶ The Federal Circuit, the Board, and the examiner all mistakenly believed that, because a general computing device was used to perform the claimed process, Step 2 of the *Alice/Mayo* framework was not able to be satisfied regardless of the various processing-oriented claim limitations recited in the claim. While that sort of abbreviated, hindsight-driven legal analysis might make patent ineligibility easy to justify, such legal analysis is wrong and unconscionable. At a minimum, it is inconsistent and contrary to both *Diehr* and *Alice*.

REASONS FOR GRANTING THE PETITION

I. CERTIORARI IS WARRANTED BECAUSE THE FEDERAL CIRCUIT'S CORRUPTED APPLICATION OF THE *MAYO/ALICE* FRAMEWORK FOR PATENT ELIGIBILITY IS CONTRARY THIS COURT'S GUIDANCE, AND HAS LED TO EXTENSIVE CHAOS

The Federal Circuit's application of the *Mayo/Alice* framework has created havoc, uncertainty, and unrest. The way in which the *Mayo/Alice* framework is applied at the Federal Circuit is contrary to this Court's decisions in *Alice* and *Diehr*. Undoubtedly, the Federal Circuit is discriminatory against software patents and thus has newly fabricated additional legal hurdles for

⁶ *Infra* p. 18-20.

software patents. These legal hurdles are, however, not in accord with this Court's express guidance in *Alice* or the longstanding principal from *Diehr* stating that claims are considered as written and as a whole. The Federal Circuit's discriminatory efforts clearly bare out in the treatment given not only to Petitioner's software innovation, but also to most other software innovations.

**A. THOMAS' PATENT APPLICATION
CONTAINED CLAIMS THAT WERE
SPECIFIC, DETAILED AND NONOBVIOUS**

The principal claim provides for interaction between a requestor and a remote server to *produce* an on-line survey. The produced on-line survey is then provided to an Internet-based survey manager to host the on-line survey and permit various appropriate survey participants to take the on-line survey by interaction with the Internet-based survey manager. The claim recites particular details of *how* an on-line survey can be produced and hosted, and therefore practically applies any abstract idea that might be present. Not only that, the claim does not concern anything foundational or akin to a basic building block that would create a preemption concern.

The Board and the Federal Circuit panel incorrectly proclaimed that the claim focused just on "performing surveys," and deemed such an abstract idea. Pet. App. 13a, 27a-28a. However, the claim is in fact *producing and creating* an on-line survey. Thus, the alleged abstract idea of *performing* surveys is clearly not correct. For Step 2 of the *Mayo/Alice* framework, the Board and the Federal

Circuit panel considered only hardware-related limitations (see **bolded** limitations below) and improperly ignored all processing-related limitations (see ~~strikethrough~~ limitations below) of the claim. Hence, when analyzing Step 2, the claim was improperly *rewritten* so that only the **bolded** items were considered by the Board and the Federal Circuit panel:

~~A method for producing an on-line survey~~
through interaction with a remote
server from a network browser
operating on a client computer
associated with a requestor of the
on-line survey, the network browser
and the remote server capable of
communicating via a data network,
~~said method comprising:~~

(a) ~~requesting initial survey~~
~~remarks to be provided for the on-line~~
~~survey;~~

(b) ~~receiving, at the remote~~
server, the initial survey remarks from
~~the survey requestor;~~

(c) ~~requesting identification of one~~
~~or more participant groups from a~~
~~plurality of available participant~~
~~groups;~~

(d) ~~receiving, at the remote~~
server, selection from the survey
~~requestor of one or more participants~~
~~groups from the plurality of available~~
~~participant groups;~~

~~(e) requesting at least one survey question;~~

~~(f) receiving, at the remote server, at least one survey question from the survey requestor;~~

~~(g) requesting an answer format for the at least one survey question;~~

~~(h) receiving, at the remote server, the answer format from the survey requestor;~~

~~(i) receiving content for at least one answer choice for the at least one survey question;~~

~~(j) repeating (e) — (i) for one or more additional survey questions;~~

~~(k) requesting subsequent survey remarks to be provided for the on line survey;~~

~~(l) receiving, at the remote server, the subsequent survey remarks from the survey requestor; and~~

~~(m) producing, at the remote server, the on line survey to include the initial survey remarks, the survey questions, the answer choices corresponding to the survey questions and the answer format utilizing the answer formats, and the subsequent survey remarks;~~

~~(n) providing and storing the on-line survey~~ **in an electronic manner to an Internet-based survey manager that hosts the on-line survey; and**

~~(o) thereafter inviting a plurality of survey participants that are classified to be within the selected one or more participant groups to take the on-line survey~~ **by interaction with the Internet-based survey manager.**

See Pet. App 4a-5a (significant emphasis added, including highlighting to elements (c) and (d)).

The Board and the Federal Circuit panel diminished the innovation as computer software performed by a conventional computer or server and then concluded that Step 2 did not yield eligibility. In doing so, all process limitations were improperly ignored, including the highlighted claimed steps (c) and (d) which were found to be nonobvious.⁷

It is axiomatic that *all* claim limitations be considered, both individually and in combination, when determining whether claims are patent eligible. *Diehr*, 450 U.S. at 188 (“In determining the eligibility of respondents’ claimed process for patent protection under § 101, their claims must be considered as a whole.”). Additionally, when evaluating for an inventive concept, the claim elements of a given claim must be considered “individually and as an ordered combination.” *Alice*, 573 U.S. at 217 (internal quotation marks omitted).

⁷ Pet. App. 16a-17a (Board finding claims nonobvious).

Unfortunately, the Federal Circuit panel honored neither of these legal requirements.

Here, the examiner and the Board ignored numerous process limitations recited in the claims and the Federal Circuit panel saw no legal error in doing so. From the colloquially at the oral hearing, it is clear that the panel believed that processing limitations in a computer implemented process are deemed eviscerated as being “affiliated” with any abstract idea in Step 1, and thus not considered in Step 2.⁸ The Federal Circuit panel’s and the Board’s understanding and application of Step 2 is obviously inconsistent with the Supreme Court’s *Alice* decision.

Alice clearly says limitations beyond the abstract idea (identified in Step 1) are to be considered in Step 2. In *Alice*, the Court felt that “the claims at issue are directed to the abstract idea of intermediated settlement.” 573 U.S. at 221. And when considering Step 2, the Court still considered *all limitations* of the claim as “additional limitations” beyond the identified abstract idea. Indeed, the Court in this regard stated:

At *Mayo* step two, 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. 566 U.S., at 72, 80, 132 S. Ct. 1289, 182 L. Ed. 2d 321, 327, 337). A claim that recites an abstract

⁸ See Federal Circuit’s Oral Hearing recording, at 8:35 – 10:00 minutes; see also 18:34 – 20:52 minutes.

idea must include “additional features” to ensure “that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].” *Id.*, at 72, 132 S. Ct. 1289, 182 L. Ed. 2d 321, 327).

Alice, 573 U.S. at 221.

In fact, the Court recognized that the claim at issue in *Alice* recited various processing limitations carried out by a computer. The Court there did not eviscerate all processing limitations as was done in this case. Rather, this Court in *Alice* acknowledged the various recited processing steps, which were summarized as follows:

The representative method claim in this case recites the following steps: (1) “creating” shadow records for each counterparty to a transaction; (2) “obtaining” start-of-day balances based on the parties’ real-world accounts at exchange institutions; (3) “adjusting” the shadow records as transactions are entered, allowing only those transactions for which the parties have sufficient resources; and (4) issuing irrevocable end-of-day instructions to the exchange institutions to carry out the permitted transactions.

Alice, 573 U.S. at 224.⁹

The Court then applied its Step 2 analysis to the various claim limitations. Notably, the Court

⁹ Notable, these summarized processing limitations are directly derived from the processing steps recited in the claim.

expressly considered each of the processing steps of the claim and concluded that they were *purely conventional* and thus failed to yield an “inventive concept” because “all of these computer functions are ‘well-understood, routine, conventional activit[ies]’ previously known to the industry.” *Id.* at 225. Specifically, the Court explained its Step 2 analysis as follows:

In light of the foregoing, see *supra*, at 220-222, 189 L. Ed. 2d, at 307-309, the relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea of intermediated settlement on a generic computer. They do not. Taking the claim elements separately, the function performed by the computer at each step of the process is “[p]urely conventional.” *Mayo*, *supra*, at 79, 132 S. Ct. 1289, 182 L. Ed. 2d 321, 337 (internal quotation marks omitted). Using a computer to create and maintain “shadow” accounts amounts to electronic recordkeeping—one of the most basic functions of a computer. See, e.g., *Benson*, 409 U.S., at 65, 93 S. Ct. 253, 34 L. Ed. 2d 273 (noting that a computer “operates . . . upon both new and previously stored data”). The same is true with respect to the use of a computer to obtain data, adjust account balances, and issue automated instructions; all of these computer functions are “well-understood, routine, conventional activit[ies]” previously

known to the industry. *Mayo*, 566 U.S., at 73, 132 S. Ct. 1289, 182 L. Ed. 2d 321, 327). In short, each step does no more than require a generic computer to perform generic computer functions.

Alice, 573 U.S. at 225.

Hence, in *Alice*, the Court specifically addressed the processing limitations of the claim when evaluating whether each and every such limitation was well-understood, routine and conventional.

The Examiner's rejection, the Board's decision, and the colloquially with the Federal Circuit panel at oral hearing all show a misunderstanding of how Step 2 is to be performed. The Federal Circuit panel incorrectly believes that processing limitations in a claim are necessarily subsumed by an abstract idea (as found in Step 1) and are thus not limitations to be considered in Step 2. That sort of analysis is not mandated by *Alice* and is undoubtedly inconsistent with the Step 2 analysis the Supreme Court performed in *Alice*. Accordingly, the Federal Circuit panel legally erred in ignoring claim limitations that were, according to the panel, subsumed by the abstract idea.

Furthermore, in applying Step 2 of the *Mayo/Alice* framework, the Federal Circuit panel also legally erred by overlooking the fundamental legal principle that patentability (*i.e.*, nonobviousness) encompasses an inventive concept. The Board found the claims patentable (both novel and nonobvious), which is not in dispute. Such a conclusion and finding establishes non-conventionality of at least some of the claim

limitations that were intentionally ignored by the Federal Circuit panel and further establishes that the claim encompasses an inventive concept.

It is undisputed that the involved claims are both novel and nonobvious over the cited prior art at least because the cited art fails to teach or suggest the limitations concerning identification of one or more participant groups from a plurality of available participant groups, which are processing steps (c) and (d) of the claim. As such, these distinguishing claim limitations are necessarily **not** conventional, routine or well-known. Yet, these same distinguishing claim limitations were completely ignored by the Federal Circuit panel in their eligibility analysis.¹⁰

**B. FEDERAL CIRCUIT HAS A MISTAKEN
BELIEF THAT STEP 2 REQUIRES
IMPROVEMENT TO COMPUTER
TECHNOLOGY**

The undercurrent of this and numerous other dubious Federal Circuit decisions denying patent eligibility to software innovations is that there is no improvement to computer technology. Many cases of

¹⁰ The analysis provided by the Board and Federal Circuit panel was necessarily flawed. The Board and Federal Circuit panel erroneously concluded that any inventive concept must be found in a hardware component – specifically, the remote server. The Board and Federal Circuit panel ignored other relevant claim limitations (*i.e.*, processing limitations) and simply concluded that the server’s functionality was “to receive information” and thus was not transformed. The Federal Circuit panel conveniently and erroneously overlooked the fact that the claim recites meaningful limitations that were found patentably distinct over the prior art, and thus not conventional, routine or well-known.

the Federal Circuit have carelessly made a statement to the effect that an improvement to computer functionality is necessary. *See, e.g., Customedia Technologies, LLC v. Dish Network Corp.*, No. 18-2239, 19-1001 (Fed. Cir. 2020) (Erroneously stating: “In sum, “software can make non-abstract improvements to computer technology just as hardware improvements can. But to be directed to a patent-eligible improvement to computer functionality, the claims must be directed to an improvement to the functionality of the computer or network platform itself.” Slip Op. at 11 (citations omitted)).

However, there is also no requirement that the functionality of an implementing computer be improved. In fact and in law, it is not a necessary element of Step 2 to have an improvement to a computer’s (hardware) functionality. That was made clear in *Alice* where the Supreme Court stated:

The method claims do not, for example, purport to improve the functioning of the computer itself. *See ibid.* (“There is no specific or limiting recitation of . . . improved computer technology . . .”); Brief for United States as *Amicus Curiae* 28-30. Nor do they effect an improvement in any other technology or technical field. *See, e.g., Diehr, 450 U.S. at 177-178, 101 S. Ct. 1048, 67 L. Ed. 2d 155.*

Alice, 573 U.S. at 225.

Hence, improved computer technology is but one route towards eligibility. Another separate and

viable path is “an improvement in any other technology or technical field.” Here, the claims concern new and improved processing, which is computer software that is both an improvement in “other technology” as well as a technical field.¹¹ This other viable path was completely ignored by the Federal Circuit.

II. CERTIORARI IS WARRANTED BECAUSE THE FEDERAL CIRCUIT’S DECISION IN THIS CASE CONFLICTS WITH *DIEHR*

The law of patent eligibility after *Alice* is in shambles.¹² By relying on the confused state of the law, the Federal Circuit’s decision in this case now creates a conflict with this Court’s decision in *Diehr* and the long-standing patent-eligibility principle it embodies. Only this Court can dispel this conflict,

¹¹ “Software technology” has been defined as: “A general term covering the development methods, programming languages, and tools to support them that may be used in the development of software.” Oxford Dictionary of Computing (6th ed.), Oxford University Press (2008).

¹² See, e.g., Kevin Madigan & Adam Mossoff, *Turning Gold into Lead: How Patent Eligibility Doctrine Is Undermining U.S. Leadership in Innovation*, 24 Geo. Mason L. Rev. 939, 952 (2017) (“The generality and vagueness in the *Mayo-Alice* test has produced the seemingly perverse effect of it being both indeterminate, as no one is certain how it will be applied in any particular case, and overly restrictive, as it has been applied to invalidate patents covering ‘everything from computer animation to database architecture to digital photograph management and even to safety systems for automobiles.’” (quoting Robert Sachs, *The One Year Anniversary: The Aftermath of #AliceStorm*, Bilski Blog (June 20, 2015), <http://www.bilskiblog.com/blog/2015/06/theone-year-anniversary-the-aftermath-of-alicestorm.html>)).

the confusion and unpredictability created, and the chaos that exists.

In the decision below, the Federal Circuit (agreeing with the Board) found that Thomas' innovation was directed to the abstract idea of "performing surveys" and that the involved processing was done by a general purpose computer. To the Federal Circuit panel, this involvement of an abstract idea rendered the claims patent ineligible under Section 101. This holding conflicts directly with the Court's decision in *Diehr* and the longstanding principle it embodies.

In *Diehr*, this Court held that "when a claim containing [an abstract idea] implements or applies that [idea] in a structure or process" to produce a new machine or process, "then the claim satisfies the requirements of § 101." 450 U.S. at 192. The patentee in *Diehr* claimed an improved rubber curing process, and one of the steps included a mathematical algorithm—the quintessential abstract idea. The Court nonetheless found the claims patent eligible. According to the Court, the claims as a whole claimed an improved process for molding rubber products that incorporated an abstract idea—a mathematical formula—and that were not aimed at patenting the mathematical formula itself. *Id.* at 191. The Court in *Alice* reaffirmed *Diehr* and its dividing line between claims incorporating abstract ideas and claims of abstract ideas themselves. *See* 134 S. Ct. at 2354. The Federal Circuit's decision in this case contravenes this fundamental divide embodied in this Court's Section 101 cases. According to the court below, Thomas' innovation was not patent eligible because the face of the claims

“involve” an abstract idea. As a whole, however, the claims address a particularized approach for creating and then hosting on-line surveys for particular demographic groups. Creation and hosting of on-line surveys are not “[l]aws of nature,” “natural phenomena,” or “abstract ideas.” *Alice*, 134 S. Ct. at 2354. At most, they may incorporate certain principles or ideas, but such incorporation has long, by law, been patent eligible. *See Le Roy*, 55 U.S. at 175 (“[T]he processes used to extract, modify, and concentrate natural agencies, constitute the invention.”). But seriously, is creating an online survey via network-based interaction with a remotely located Internet-based survey manager a “*basic building block*” of society? Even if one were able to convince themselves that it is, surely the particular claims sought for Thomas’ invention certainly are practically applied and present no serious preemption concern.

Indeed, both *Diehr* and *Alice* carried forward the well-established principle distinguishing an ineligible “patent for a principle” and “a machine, embodying a principle.” *Morse*, 56 U.S. at 115. As the Court explained in *Le Roy*, “[t]hrough the agency of machinery a new steam power may be said to have been generated,” but “no one can appropriate this power exclusively to himself.” 55 U.S. at 175. “The same may be said of electricity, and of any other power in nature....” *Id.* However, “the processes used to extract, modify, and concentrate natural agencies, constitute the invention.” *Id.* “The elements of the power exist,” according to the Court, and “the invention is not in discovering them, but in applying them to useful objects.” *Id.* This distinction explains why the telegraph patent in

Morse was invalid, 56 U.S. at 112, but the telephone patent in the *Telephone Cases* survived, 126 U.S. at 534. It accounts for *Mackay*'s approval of a narrowly drawn claim to a novel mechanism for harnessing standing electromagnetic waves. 306 U.S. at 94. And it distinguishes Benson's holding that an algorithm is unpatentable from *Diehr*'s holding that an algorithm *incorporated into a manufacturing process is eligible*. This clearly shows that the Federal Circuit's holding cannot be reconciled with *Diehr* or the cases that preceded it.

The claims here are directed to a particular process for creation and then hosting of online surveys. Hence, these claims cannot be reasonably said to be merely claiming a law of nature or *fundamental building block* that would warrant being deemed an abstract idea.

The Federal Circuit nonetheless justified its decision by rewriting the claim to remove all processing limitations and considering only residual hardware limitations of the claim when analyzing Step 2 of the *Alice/Mayo* framework. They then dismissed the hardware components as conventional. See Pet. App. 10a–11a. But this too conflicts with *Diehr*. In *Diehr*, this Court held that “claims must be considered as a whole.” 450 U.S. at 188. The Court explained that “[i]n order for the dissent to reach its conclusion it is necessary for it to read out of respondents’ patent application all the steps in the claimed process which it determined were not novel or ‘inventive.’” *Id.* at 193 n.15. “That is not the purpose of the § 101 inquiry,” according to this Court, “and conflicts with the proposition ... that a claimed invention may be entitled to patent

protection even though some or all of its elements are not ‘novel.’” *Id.* Moreover, the Court in *Alice* reaffirmed this principle from *Diehr* “that patent claims ‘must be considered as a whole.’” 134 S. Ct. at 2355 n.3 (quoting *Diehr*, 450 U.S. at 188).

Relying on its own precedent, however, the Federal Circuit expressly considered only hardware components of the principal claim, and ignored all processing limitations, regardless of whether new or old. Under the guise of being abstract “data processing,” the court eliminated all processing limitations in Thomas’ claims. The court then assessed whether the residual “physical hardware” components rendered the claim patent eligible. The court’s erroneous explanation was that in Step 2 of the *Mayo/Alice* framework, the process limitations (that were considered to find an “abstract idea”) were subsumed into the abstract idea and then no longer present for consideration in Step 2.¹³

This approach not only conflicts with *Diehr*—and the majority’s explicit repudiation of this approach—but also conflicts with the text of Section 101. According to Section 101, a person may obtain a patent for “any new and useful ... process ... or any new and useful improvement thereof.” 35 U.S.C. § 101. At the Federal Circuit, the court recognized that Thomas’ invention was nonobvious but inexplicitly concluded that there was nothing but conventional components in the claim. Thomas’ invention is a new or improved process, Pet. App. 9a, which under the plain terms of Section 101 should be enough. Yet, the lower court rejected this.

¹³ *Supra* note 8.

The Federal Circuit in this case has deepened the profound confusion and uncertainty surrounding Section 101 by erasing the patent eligibility line that has existed since patent law was created, imperiling new and useful improvements to machines and processes. According to the Federal Circuit, any claim with any abstract ideas, however concretely incorporated, are unpatentable. Such a rule impedes, rather than promotes, “the progress of science and the useful arts.” U.S. Const. art. I, § 8, cl. 8. From the earliest cases on what has become the exception to Section 101, this Court has confirmed that incorporation or involvement of an abstract idea in an invention does **not** render that invention patent ineligible. The Federal Circuit’s decision endangers numerous software patents that industry has long considered eligible under Section 101 — that is, unless this Court grants this certiorari and steps in to correct the Federal Circuit’s error.

III. CERTIORARI IS WARRANTED BECAUSE THE FEDERAL CIRCUIT IS LOST IN DETERMINING PATENT ELIGIBILITY AND HAS REPEATEDLY ASKED THIS COURT FOR ASSISTANCE

Certiorari is warranted to eliminate the harms caused by the confusion arisen in the wake of *Alice*, the deepening confusion that will be caused by the decision in this case, and the waste of judicial resources caused by the abstract idea exception.

This Court in *Alice* warned that courts must “tread carefully in construing” the “exclusionary principle” that “laws of nature, natural phenomena,

and abstract ideas are not patentable,” because otherwise the principal might “swallow all of patent law.” 134 S. Ct. at 2354. Five years later, that warning has become reality. The Federal Courts and the Board have invalidated 914% more patents in the five years since *Alice* than they did in the five years prior.¹⁴ 85% of appeals to the Federal Circuit involve ineligible subject matter challenges to the patents.¹⁵

Sadly, there is no prospect that this situation will improve without this Court’s intervention. In July of this year, the Federal Circuit denied rehearing en banc of a different Section 101 case, and that court’s twelve judges issued a remarkable eight opinions concurring in or dissenting from the denial. *Athena*, 927 F.3d at 1335. The now denied petition for certiorari in that case rightly describes the Federal Circuit as having “issued an unprecedented cry for help from this Court.” Petition for a Writ of Certiorari at 1, *Athena Diagnostics, Inc. v. Mayo Collaborative Servs., LLC*, No. 19-430 (U.S. Oct. 1, 2019). That case involved medical diagnostic method, whereas the present case concerns software technology — a critical component of today’s knowledge economy.

It is painfully obvious that the Federal Circuit is lost and does not know how to apply the *Mayo/Alice* framework. At a minimum, Judges Plager, Linn, and Lourie of the Federal Circuit have expressed a general loss in confidence in their own court’s ability to understand and apply the “law” on

¹⁴ See Sachs, *supra* note 2.

¹⁵ *Id.*

patent eligibility. For example, in a concurring-in-part and dissenting-in-part opinion issued with *Interval Licensing LLC, v. AOL, Inc., Apple, Inc., Google LLC, Yahoo!, Inc.*, Nos. 2016-2502, 2016-2505, 2016-2506 and 2016-2507, (Fed. Cir. July 20, 2018), Judge Plager stated:

My purpose in this discussion is not to critique the Court's handiwork, but rather to highlight the number of unsettled matters as well as the fundamental problems that inhere in this formulation of 'abstract ideas.' I do, however, want to go on record as joining my colleagues who have recently expressed similar views about the current state of our patent eligibility jurisprudence, and to incorporate by reference their wisdom concerning the matter. Judge Richard Linn, concurring and dissenting in *Smart Systems Innovations, LLC v. Chicago Transit Authority*, critiqued at length the 'abstract ideas' idea, both in general and as specifically applied in that case.

There is almost universal criticism among commentators and academicians that the 'abstract idea' idea has created havoc in the patent law. The testimonials in the blogs and elsewhere to the current mess regarding our § 101 jurisprudence have been legion. There has even been a call for abolishing § 101 by the former head of the Patent and Trademark Office.

There is little consensus among trial judges (or appellate judges for that matter) regarding whether a particular case will prove to have a patent with claims directed to an abstract idea, and if so whether there is an ‘inventive concept’ in the patent to save it. In such an environment, from the viewpoint of counsel for the defense, there is little to be lost in trying the § 101 defense. We are left with a process for finding abstract ideas that involves two redundant steps and culminates with a search for a concept--inventiveness--that some 65 years or so ago was determined by Congress to be too elusive to be fruitful. Is it any wonder that the results of this process are less than satisfactory?

When the lawyers and judges bring to the Supreme Court a shared belief in the uselessness of the abstract notion of ‘abstract ideas’ as a criterion for patent eligibility, we can hope that the Court will respond sensibly. In light of the statutory criteria for patent validity established in the Patent Act, there is no need, and indeed no place in today’s patent law, for this abstract (and indefinable) doctrine. Something as simple as a declaration by the Court that the concept of ‘abstract ideas’ has proven unworkable in the context of modern technological patenting, and adds nothing to ensuring patent quality

that the statutory requirements do not already provide, would remove this distraction from the salutary system of patent issuance and enforcement provided by the Congress in the 1952 Patent Act. (emphasis added)

Sitting Federal Circuit Judge Richard Linn has criticized the current state of subject matter eligibility jurisprudence. When interviewed by IPWatchDog about Alice’s application in the Federal Circuit, Patent Office and the District Courts, Judge Linn complained that “[j]udicial decisions certainly do need to be translated in a coherent way so clients can arrange, or rearrange, their affairs.” Gene Quinn, “*Judge Richard Linn, First and Foremost a Patent Attorney*,” Gene Quinn, IPWatchDog.com (November 11, 2014), <https://www.ipwatchdog.com/2014/11/11/judge-richard-linn-first-and-foremost-a-patent-attorney/id=52102/>. In his view, *Alice* and its progeny fail to allow a lawyer to advise his or her client if an invention is patent eligible or ineligible.

On the other end of the spectrum, Federal Circuit Judge Mayer understands *Alice* to mean that *all* software patents (at least if implemented on a standard computer) are patent ineligible. *Intellectual Ventures I LLC v. Symantec Corp. et al.*, 838 F.3d 1307, 1322 (Fed. Cir. 2016) (Mayer, J., concurring). Judge Mayer’s understanding of patent eligibility is far afield from the statute, Congressional intent, and decisions of this Court and the Federal Circuit.

Even former Chief Judge Paul Michaels has voiced his concerns that the *Alice* test of Subject

Matter Eligibility is “Impossible” and “Intolerable.”
Former Chief Judge Michaels recently wrote:

I do not agree with him [Federal Circuit Judge Mayer] that all software-related patents should categorically be held ineligible. But, I do see the status quo as intolerable. National commerce is stymied by the Supreme Court’s incoherent and impractical eligibility law. It has to change. In my opinion, Congress should intervene. After all Section 101 states no ‘exceptions.’ The Supreme Court just made them up, legislating from the bench, undermining the Congressional mandate. And, it did so based on careless pronouncements in ancient Supreme Court decisions. It has trapped itself and the country by continual recitation of vague dicta. Unless the Supreme Court reverses itself, which is very unlikely, only Congress can fix this mess.” (emphasis added)

IAM (Intellectual Property Asset Management) Blog, October 6, 2016, Richard Lloyd, “*No -- the CAFC’s Justice Mayer has not just brought an end to software patents or anything close,*” www.iam-media.com

Just recently, former Chief Judge Paul Michaels again noted the need for repair to the law on patent eligibility, stating: “The courts must review and repair the eligibility law and, in particular, the ‘directed to’ step of the *Mayo*-

Alice test and the definition (or lack thereof) for the judicially made ‘abstract idea’ exception to Section 101.” Judge Paul Michel & John Battaglia, “*It Is Time to Fix the Courts’ Section 101 Tests on ‘Directed to ...’ and ‘Abstract Ideas’—Whether in Chamberlain or Beyond (Part I)*,” IPWatchDog.com (June 9, 2020), <https://www.ipwatchdog.com/2020/06/09/time-fix-courts-section-101-tests-directed-abstract-ideas-whether-chamberlain-beyond-part/id=122302/>.

As another example, in a concurring opinion written by Judge Lourie in *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 890 F.3d 1354, 1360-62 (Fed. Cir. 2018), Judge Lourie stated:

However, I believe the law needs clarification by higher authority, perhaps by Congress, to work its way out of what, so many in the innovation field consider are § 101 problems. Individual cases, whether heard by this court or the Supreme Court, are imperfect vehicles for enunciating broad principles because they are limited to the facts presented. Section 101 issues certainly require attention beyond the power of this court ...

Accordingly, I concur in the decision of the court not to rehear this § 101 case en banc. Even if it was decided wrongly, which I doubt, it would not work us out of the current § 101 dilemma. In fact, it digs the hole deeper by further complicating the § 101 analysis. Resolution of patent-eligibility issues

requires higher intervention, hopefully with ideas reflective of the best thinking that can be brought to bear on the subject.

Similarly, former Director of the Patent Office David Kappos, when addressing the Federal Circuit Judicial Conference, told the assembled judges that subject matter eligibility jurisprudence post-*Alice* was “a real mess.” The former Director of the Patent Office also called for the abolition of Section 101 of the Patent Act, saying decisions like *Alice* on the issue are a “real mess” and threaten patent protection for key U.S. industries. Law360, April 12, 2016, “[Former Director of Patent Office David] Kappos Calls for Abolition of Section 101 of the Patent Act.”

Although the Federal Circuit is lost on eligibility and has requested help from both this Court and Congress, this Court is responsible for the judicial interpretation of the law, specifically patent eligibility under 35 U.S.C. § 101. Hence, certiorari is warranted because it is the responsibility of the judiciary to clean up its own “mess.” The Federal Circuit, having capitulated that it is unable to do so on its own, has requested and should receive further assistance from this Court.

CONCLUSION

The petition for a writ of certiorari should be granted. Should another petition for certiorari concerning patent eligibility be granted after filing but before deciding this petition, then this petition should be held pending until the conclusion of the

prior petition so that this case can then be remanded and corrected.

Respectfully submitted,

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June 24, 2020

APPENDIX

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[ENTERED: March 5, 2020]

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

IN RE: C. DOUGLASS THOMAS,
Appellant

2019-2053

Appeal from the United States Patent and
Trademark Office, Patent Trial and Appeal Board in
No. 11/253,299.

JUDGMENT

C. DOUGLASS THOMAS, TI Law Group, PC, San
Jose, CA, argued pro se.

NICHOLAS THEODORE MATICH, IV, Office of the
Solicitor, United States Patent and Trademark Office,
Alexandria, VA, argued for appellee Andrei Iancu.
Also represented by THOMAS W. KRAUSE, AMY J.
NELSON.

THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (LOURIE, SCHALL, and CHEN,
Circuit Judges).

2a

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

March 5, 2020
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

[ENTERED: October 16, 2018]

UNITED STATES PATENT AND
TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND
APPEAL BOARD

Ex parte C. DOUGLASS THOMAS

Appeal 2017-000438
Application 111253,299¹
Technology Center 3600

Before HUBERT C. LORIN, PHILIP J. HOFFMANN,
and GEORGE R. HOSKINS, Administrative Patent
Judges.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

C. Douglass Thomas (Appellant) seeks our review under 35 U.S.C. § 134(a) of the Final Rejection² of claims 20–46. We have jurisdiction under 35 U.S.C. § 6(b).

¹ The Appellant identifies the inventor as the real party in interest. App. Br. 1.

² We herein refer to the Specification, filed Oct. 19, 2005 (“Spec.”); Non Final Rejection, mailed Apr. 8, 2016 (“Non-final Rej.”); Appeal Brief, filed Jun. 10, 2016 (“App. Br.”); and the Examiner’s Answer, filed Aug. 11, 2016 (“Ans.”). The Reply Brief was filed Oct. 4, 2016. No quotations from the Reply Brief are cited in this decision.

SUMMARY OF DECISION

WE AFFIRM

THE INVENTION

Claim 20, reproduced below, is illustrative of the subject matter on appeal.

20. A method for producing an on-line survey through interaction with a remote server from a network browser operating on a client computer associated with a requestor of the on-line survey, the network browser and the remote server capable of communicating via a data network, said method comprising:

- (a) requesting initial survey remarks to be provided for the on-line survey;
- (b) receiving, at the remote server, the initial survey remarks from the survey requestor;
- (c) requesting identification of one or more participant groups from a plurality of available participant groups;
- (d) receiving, at the remote server, selection from the survey requestor of one or more participants groups from the plurality of available participant groups;
- (e) requesting at least one survey question;
- (f) receiving, at the remote server, at least one survey question from the survey requestor;
- (g) requesting an answer format for the at least one survey question;

- (h) receiving, at the remote server, the answer format from the survey requestor;
- (i) receiving content for at least one answer choice for the at least one survey question;
- (j) repeating (e) - (i) for one or more additional survey questions;
- (k) requesting subsequent survey remarks to be provided for the online survey;
- (l) receiving, at the remote server, the subsequent survey remarks from the survey requestor; and
- (m) producing, at the remote server, the on-line survey to include the initial survey remarks, the survey questions, the answer choices corresponding to the survey questions and the answer format utilizing the answer formats, and the subsequent survey remarks;
- (n) providing and storing the on-line survey in an electronic manner to an Internet-based survey manager that hosts the on-line survey; and
- (o) thereafter inviting a plurality of survey participants that are classified to be within the selected one or more participant groups to take the on-line survey by interaction with the Internet-based survey manager.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Manabe et al., US 5,339,239 Aug. 16, 1994
hereinafter
“Manabe”

Shane US 5,793,972 Aug. 11, 1998
Peters, et al. WO 96/08779 AI Mar. 21, 1996
hereinafter
“Peters”

*Online Market-Research Venture Offers
Freebies to Respondents*, AMERICAN
MARKETPLACE, v. 17, n. 1, ISSN: 0276-2900,
Jan. 11, 1996. [“American Marketplace”]

Scott G. Dacko, *Data collection should not be
manual labor*, MARKETING NEWS, v. 29, n. 18,
ISSN: 0025-3790, Aug. 28, 1995. [“Dacko”]

The following rejections are before us for
review:

Claims 20–46 are rejected under 35 U.S.C.
§ 101 as being directed to judicially-excepted subject
matter.

Claims 20–31 and 34–46 are rejected under 35
U.S.C. § 103(a) as being unpatentable over Peters,
American Marketplace, Dacko, and Shane.

Claims 32 and 33 are rejected under 35 U.S.C.
§ 103(a) as being unpatentable over Peters, American
Marketplace, Dacko, Shane, and Manabe.

ISSUES

Did the Examiner err in rejecting claims 20–46
under 35 U.S.C. §101 as being directed to judicially-
excepted subject matter?

Did the Examiner err in rejecting claims 20–31 and 34–46 under 35 U.S.C. § 103(a) as being unpatentable over Peters, American Marketplace, Dacko, and Shane?

Did the Examiner err in rejecting claims 32 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Peters, American Marketplace, Dacko, Shane, and Manabe?

ANALYSIS

The rejection of claims 20–46 under 35 U.S.C. §101 as being directed to non-statutory subject matter.

The Appellant argued these claims as a group. *See* App. Br. 8–11 and Reply Br. 2–6. We select claim 20 as the representative claim for this group, and the remaining claims 21–46 stand or fall with claim 20. 37 C.F.R. § 41.37(c)(1)(iv).

Alice Corp. Proprietary Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent-eligibility under 35 U.S.C. § 101.

According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

In that regard, the Examiner pointed to various limitations in claim 20 and determined that said “claim limitations [are] directed to an abstract idea.” Non-final Rej. 4.

Step two is “a search for an ‘inventive concept’- i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 US 66, 73 (2012)).

In that regard, the Examiner pointed to various limitations in claim 20 and determined, *inter alia*, that

[t]he additional elements or combination of elements in the claims other than the abstract ideas *per se* amount to no more than: (i) mere instructions to implement the idea on a computer, and/or (ii) recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the pertinent industry. For example, the process claims include the additional elements of a remote server, a network browser operating on a client computer, a data network, and an Internet-based survey manager. ... Viewed as a whole, these additional claim elements do not provide meaningful limitations to transform any of the abstract ideas into a patent eligible application of the abstract ideas such that the claims amount to significantly more than any of the abstract ideas themselves.

Non-final Rej. 5–7.

Given the determinations reached via steps one and two of the *Alice* analytical framework, the

Examiner concluded that the claimed subject matter was directed to an abstract idea and thereby judicially-excepted from patent-eligibility. Non-final Rej. 7.

The Appellant challenges the Examiner's conclusion on a number of grounds. The Appellant does not, however, address the Examiner's *Alice* step one and two determinations by which said conclusion was reached.

First, the Appellant argues that “[t]he nature of the method operations or computer program code recited in these claims is sufficiently tangible, physical and/or functional to satisfy the requirements of 35 U.S.C. § 101.” App. Br. 8. The argument is unclear.

It is true that the claims comply with § 101 in that they fall in the prescribed statutory classes of invention, if that is what the Appellant is arguing. But that is not the question here. The question here is whether the subject matter as claimed is judicially-excepted from patent-eligibility, notwithstanding it is statutorily-acceptable. If the Appellant is arguing that the claimed subject matter is sufficiently “physical” as to not be judicially-excepted from patent-eligibility, then that, too, is unpersuasive as to error in the conclusion that the claimed subject matter is directed to an abstract idea and thereby judicially-excepted from patent-eligibility. This is so because the “physical” condition of claimed subject matter is not dispositive of patent-eligibility. Whether or not something as claimed is “physical” is not the test for determining whether claimed subject matter is judicially-excepted from patent-eligibility. If that

were the case, claims merely reciting a generic computer would necessarily be patent eligible. But that is not the case. *See Alice*, 134 S. Ct. at 2358-59:

The fact that a computer “necessarily exist[s] in the physical, rather than purely conceptual realm” is beside the point. There is no dispute that a computer is a tangible system (in § 101 terms, a “machine”), or that many computer-implemented claims are formally addressed to patent-eligible subject matter. But if that were the end of the § 101 inquiry, an applicant could claim any principle of the physical or social sciences by reciting a computer system configured to implement the relevant concept.

Second, the Appellant argues:

Claims 20, 31 and 34 concern specific improvements to computer functionality so as to provide creation and management of on-line surveys through interaction with a remote server from a network browser operating on a client computer associated with a requestor of the on-line survey.

...

[T]he claims address particular challenges involved in creation and management of on-line surveys in an intelligent computerized manner. The claimed solution is rooted in computer technology, including client-server interactions between such that a survey requestor is able to direct the remote server as to the particulars of the on-line survey to be forms, then producing and storing the on-line

survey at the remote server, and then hosting the on-line survey using an Internet-based survey manager. Survey participants can also be invited to take the on-line survey by interaction with the Internet-based survey manager.

App. Br. 8–9.

While claimed subject matter directed to an improvement in computer functionality may be patent-eligible, we have been unable to discern from the Appellant’s discussion, the claim, and the Specification, the “specific improvements to computer functionality” of which the Appellant speaks.

As the Examiner pointed out, the claimed process involves “interaction with a remote server from a network browser operating on a client computer” and “the remote server capable of communicating via a data network.” Claim 20. These are common information-processing devices. *See* Spec., e.g., pages 6–7. The interactions themselves, as claimed, ask for no more of such common devices than to process information consistent with their known function. For example, claim 20 calls for “receiving, at the remote server, at least one survey question from the survey requestor.” But the function of remote servers is to receive information. The server’s functionality is not improved; it remains the same as it was.

“The ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas v. DirectTV, LLC*, 838

F.3d 1253, 1257 (Fed. Cir. 2016) (*quoting Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *see also Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016), *quoted in Apple, Inc. v. Ameranth, Inc.*, 7842 F.3d 1229, 1241 (Fed. Cir. 2016). In that regard, the Specification begins by explaining that “[c]onventionally, surveys are carried out by telephone or by mail.” Spec. page 1. “There are numerous problems with conventional survey approaches. One major problem with the conventional approach is that carrying out a survey is cumbersome in many ways.” Spec., page 2. The solution is “an automated survey technique that performs surveys over electronic media.” Spec., page 2. To do so, generic computer devices are used. Spec., e.g., pages 6–7. Thus, the focus of the claimed advance over the prior art is in automating a conventional procedure using generic computing devices. Given such a focus (which is not on any improvement in computer functionality), it is reasonable to find that the claim’s “character as a whole” is directed to excluded subject matter. *Cf. buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (stating “[t]hat a computer receives and sends the information over a network—with no further specification—is not even arguably inventive”), and *OIP Techs., Inc. v. Amazon. com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (“relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible”).

If the Appellant is arguing that processing survey-related information necessarily yields “specific improvements to computer functionality,” notwithstanding conventional devices are employed, that, too, is unpersuasive as supporting patent-

eligibility. See *SAP America, Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1167 (Fed. Cir. 2018) (“Contrary to InvestPic’s suggestion, it does not matter to this conclusion whether the information here is information about real investments. As many cases make clear, even if a process of collecting and analyzing information is ‘limited to particular content’ or a particular ‘source,’ that limitation does not make the collection and analysis other than abstract.” (quoting *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016) (citing cases)). Also, *Praxair Distribution, Inc. v. Mallinckrodt Hospital Products IP Ltd.*, 890 F.3d 1024, 1032 (Fed. Cir. 2018) (“[c]laim limitations directed to the content of information and lacking a requisite functional relationship are not entitled to patentable weight because such information is not patent eligible subject matter under 35 U.S.C. § 101.”). Claims to processing survey-related information have been held patent-ineligible. See *SkillSurvey, Inc. v. Chedester LLC*, 178 F.Supp.3d 247 (E.D. Pa. 2016), *aff’d*, 2017 WL 1279345 (Mem) (Fed. Cir. 2017).

Third, the Appellant argues that “the clams are not directed to a mathematical algorithm, a fundamental economic principal or a long standing commercial practice.” App. Br. 9. We disagree. Performing surveys is both a fundamental economic practice as well as a long standing commercial practice. “The need for surveys arises due to various reasons. Some of the major reasons for surveys are market research, elections, public opinions, and legal. The surveys associated with these major reasons are known as market research surveys, electoral polls, public opinion polls, and legal surveys.” Spec., page 1.

Fourth, “the claims at issue do not *preempt* every application of the idea of providing on-line surveys.” App. Br. 9. The difficulty with this argument is that it confuses the pre-emption concern with the level of abstraction the abstract idea to which the claim is directed can be described. With respect to the pre-emption concern, “[w]hat matters is whether a claim threatens to subsume the full scope of a fundamental concept, and when those concerns arise, we must look for meaningful limitations that prevent the claim as a whole from covering the concept’s every practical application.” *CLS Bank Intern. v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269, 1281 (Fed. Cir. 2013) (Lourie, J., concurring). Here, claim limitations simply narrow survey-providing to a particular scheme, so that the survey-providing is described at a lower level of abstraction. It does not render the survey-providing to which the claim is directed any less an abstract idea. Furthermore, pre-emption is not a separate test. Because we find the claimed subject matter covers patent-ineligible subject matter, the pre-emption concern is necessarily addressed. “Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, [] preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015).

Lastly, the Appellant argues, inter alia, (a) “claims 20, 31 and 34 are sufficiently tangible to avoid being considered abstract ideas” (App. Br. 10); (b) “limitations recited in claims 20, 31 and 34 are not only meaningful and concrete but also are tied to use of servers, networks, computers and/ or computer program code” (App. Br. 10); and (c) “independent claims 31 and 34 concerns a ‘non-transitory computer

readable medium’ that stores computer program code which is a statutory class of patentable subject matter under 35 USC §101, namely, an article of manufacture” (App. Br. 11). These arguments are similar to those we have already addressed above, and are unpersuasive as to error in the Examiner’s conclusion, for the same reasons.

We have considered all of the Appellant’s remaining arguments (including those made in the Reply Brief) and find them unpersuasive. Accordingly, because we are not persuaded as to error in the determinations that representative claim 20, and claims 21–46 which stand or fall with claim 20, are directed to an abstract idea and do not present an “inventive concept,” we sustain the Examiner’s conclusion that they are directed to ineligible subject matter under 35 U.S.C. § 101. *Cf LendingTree, LLC v. Zillow, Inc.*, 656 Fed.Appx. 991, 997 (Fed. Cir. 2016) (“We have considered all of Lending Tree’s remaining arguments and have found them unpersuasive. Accordingly, because the asserted claims of the patents in suit are directed to an abstract idea and do not present an ‘inventive concept,’ we hold that they are directed to ineligible subject matter under 35 U.S.C. § 101.”); *see also, e.g., OIP Technologies, Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1364 (Fed. Cir. 2015) and *Fair Warning IP, LLC v. Iatric Systems, Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016).

The rejection of claims 20--31 and 34--46 under 35 U.S.C. § 103(a) as being unpatentable over Peters, American Marketplace, Dacko, and Shane.

The Appellant argues that Examiner has not shown that Peters discloses the claim 20 limitation

“requesting (c) identification of one or more participant groups from a plurality of available participant groups.” App. Br. 18–19. We agree.

The Examiner determined that Peters disclosed said limitation at page 8, lines 33–37, and page 9, lines 22–25. Non-final Rej. 8. Said Peters disclosures are reproduced below:

Page 8, lines 33–37: “The survey questionnaire document or a subset thereof may be stored to enable re-transmission of the survey document at a later stage, as a reminder should any of the pre-selected users not have provided a response document.”

Page 9, lines 22–25: “The survey document may be saved on a respondent users system this enables the remote user (respondent user) to send responses back to the collator when and as often as desired.”

We do not see in these passages any disclosure about “requesting *identification* of one or more participant groups from a plurality of available participant groups” (claim 20, emphasis added). This applies as well to independent claim 31, which includes said limitation, and as to which the Examiner takes the same position. Non-final Rej. 18–19.

Regarding independent claim 34, we agree with the Appellant that claim 34 includes additional limitations not included in either claims 20 and 31, such as, “computer program code for producing a predetermined web page for the on-line survey at the Internet-based survey manager; and computer program code for informing the survey requestor of

the predetermined web page wherein the on-line survey is accessible via the data network.” These limitations do not appear to have been addressed. *See* Non-final Rej. 19. Moreover, we are unable to find these limitations in the cited prior art references, and do not see how the cited prior art combination would lead one to produce a web page from an on-line survey and inform a survey requestor of it, as claimed.

Accordingly, the obviousness rejection of independent claims 20, 31, and 34, and the claims depending therefrom, is not sustained.

The rejection of claims 32 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Peters, American Marketplace, Dacko, Shane, and Manabe.

These claims depend from claim 20. The obviousness rejection is not sustained for the same reasons that the rejection of claim 20 is not sustained.

CONCLUSIONS

The rejection of claims 20–46 under 35 U.S.C. §101 as being directed to non-statutory subject matter is affirmed.

The rejection of claims 20–31 and 34–46 under 35 U.S.C. § 103(a) as being unpatentable over Peters, American Marketplace, Dacko, and Shane is reversed.

The rejection of claims 32 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Peters, American Marketplace, Dacko, Shane, and Manabe is reversed.

18a

DECISION

The decision of the Examiner to reject claims 20-46 is affirmed.

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

AFFIRMED

[ENTERED: May 1, 2020]

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

IN RE: C. DOUGLASS THOMAS,
Appellant

2019-2053

Appeal from the United States Patent and
Trademark Office, Patent Trial and Appeal Board in
No. 11/253,299.

**ON PETITION FOR PANEL REHEARING AND
REHEARING EN BANC**

Before PROST, *Chief Judge*, NEWMAN, LOURIE,
SCHALL*, DYK, MOORE, O'MALLEY, REYNA, WALLACH,
TARANTO, CHEN, HUGHES, and STOLL,
Circuit Judges.

PER CURIAM.

O R D E R

Appellant C. Douglass Thomas filed a
combined petition for panel rehearing and rehearing
en banc. The petition was referred to the panel that

* Circuit Judge Schall participated only in the decision
on the petition for panel rehearing.

heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue on May 8, 2020.

FOR THE COURT

May 1, 2020
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

[ENTERED: April 12, 2019]

UNITED STATES PATENT AND
TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND
APPEAL BOARD

Ex parte C. DOUGLASS THOMAS

Appeal 2017-000438
Application 11/253,299
Technology Center 3600

Before HUBERT C. LORIN, PHILIP J. HOFFMANN,
and GEORGE R. HOSKINS, Administrative Patent
Judges.

LORIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE¹

The Appellant filed two Requests for Rehearing under 37 C.F.R. § 41.52 of the Decision on Appeal. Although the Rule provides for only a “single request,” we have opted to consider both of Appellant’s Requests.

¹ This Decision references the Appellants’ first Request for Rehearing, filed Nov. 16, 2018 (“First Req.”), Appellants’ second Request for Rehearing, filed Feb. 5, 2019 (“Second Req.”), and the Board Decision, mailed Oct. 16, 2018 (“Dec.”).

In the Decision on Appeal, the Board affirmed the rejection of claims 20–46 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter, and reversed the rejections of claims 20–31 and 34–46 under 35 U.S.C. § 103(a) as being unpatentable over Peters, American Marketplace, Dacko, and Shane, and of claims 32 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Peters, American Marketplace, Dacko, Shane, and Manabe.

The Requests only seek reconsideration of the Board’s decision affirming the rejection of claims 20–46 under 35 U.S.C. § 101.

The First Request for Rehearing

The First Request for Rehearing consists of three parts.

In the **first** part (“A. PATENTABLE CLAIMS ARE NOT ABSTRACT”), the Appellant argues that “the Board overlooked the fundamental legal principle that patentability (i.e., novel & nonobvious) encompasses an inventive concept.” First Req. 1. The Appellant derives said “principle” from a statement made by Judge Newman in *Bascom Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), namely that “[i]nitial determination of eligibility often does not resolve patentability, whereas initial determination of patentability issues always resolves or moots eligibility.” *Id.* at 1353.

In *Bascom Global Internet v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), Judge Newman expounded this relevant fundamental legal principal stating a “determination of patentability issues always resolves or moots eligibility.” *Id.* at 1353

(Newman, J., concurring). In this appeal, the claims were determined patentable by the present panel of the Board as well as by an earlier panel of the Board in a prior appeal. Following Judge Newman's logic in *Bascom*, satisfaction of 35 U.S.C. § 101 is moot because the panel concluded that the claims satisfied the patentability requirement of 35 U.S.C. § 103. Accordingly, since the claims are deemed patentable (e.g., under §§ 102, 103 and 112), the claims are necessarily inclusive of an "inventive concept" and, therefore, not directed to an ineligible abstract idea.

First Req. 1-2.

Judge Newman was speaking to the increased efficiency with which District Courts could handle questions of eligibility by directing the *initial* decision to that of patentability rather than to whether "a patent is for an 'abstract idea'." She wrote separately, *inter alia*,

to urge a more flexible approach to the determination of patent eligibility, for the two-step protocol for ascertaining whether a patent is for an "abstract idea" is not always necessary to resolve patent disputes. There is no good reason why the district court should be constrained from determining patentability, instead of eligibility based on "abstract idea," when the patentability/validity determination would be dispositive of the dispute.

That is, instead of an initial evidentiary procedure for determination of eligibility at trial and appeal, followed by another cycle of

patentability litigation when eligibility is found, initial decision directed to patentability may resolve or moot any issue of eligibility. Initial determination of eligibility often does not resolve patentability, whereas initial determination of patentability issues always resolves or moots eligibility.

Bascom 827 F.3d at 1353.

Here an initial determination of patentability was made as to the prior art rejections presently of record, but that did not resolve the question of eligibility for the Examiner.

“Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the [section] 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S.Ct. 2107, 2117 (2013). Accordingly, a finding of novelty does not *necessarily* lead to the conclusion that subject matter is patentable eligible. *See Rapid Litigation Management Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1050 (Fed. Cir. 2016) (“That each of the claims’ individual steps (freezing, thawing, and separating) were known independently in the art does not make the claim unpatentable.”) Nor does a finding of obviousness necessarily lead to the conclusion that claimed subject matter is patentable ineligible. “[P]atent-eligibility does not turn on ease of execution or obviousness of application. Those are questions that are examined under separate provisions of the Patent Act.” *Id.* at 1052 (*citing Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 90 (2012)).

Nonetheless, claim limitations found to be novel and/or nonobvious *can* affect a patent-eligibility

determination. *Cf. Ariosa Diagnostics, Inc., v. Sequenom, Inc.*, 788 F.3d 1371 (Fed. Cir. 2015) (“For process claims that encompass natural phenomenon, the process steps are the additional features that must be new and useful.”). It is a factor to be considered, but only in the second step of the *Alice* analysis. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014). (“[N]ovelty in implementation of the idea is a factor to be considered only in the second step of the *Alice* analysis.”). *Id.*

The question in step two of the *Alice* framework is not whether an additional feature is novel or nonobvious but whether the implementation of the abstract idea involves “more than [the] performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1347–48 (*quoting Alice*, 134 S.Ct. at 2359). “[T]he [section] 101 patent-eligibility inquiry and, say, the [section] 102 novelty inquiry might sometimes overlap,’ [but] a claim for a *new* abstract idea is still an abstract idea.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (*quoting Mayo*, 566 U.S. at 90) (emphasis added).

In that regard, the record does not support the view that representative claim 20 includes novel features that transform the abstract idea (i.e., “[p]erforming surveys,” Dec. 10) into patent-eligible subject matter. The Decision addressed that.

As the Examiner pointed out, the claimed process involves “interaction with a remote server from a network browser operating on a client computer” and “the remote server capable of communicating via a data network.”

Claim 20. These are common information-processing devices. *See* Spec., e.g., pages 6–7. The interactions themselves, as claimed, ask for no more of such common devices than to process information consistent with their known function. For example, claim 20 calls for “receiving, at the remote server, at least one survey question from the survey requestor.” But the function of remote servers is to receive information. The server’s functionality is not improved; it remains the same as it was.

Dec. 8.

The Request does not add any technical details to the discussion that would change our view of claim 20. In our view, claim 20 is directed to implementing a scheme for performing on-line surveys (i.e., a mental process) via a generic remote server. Much like the “data storage unit” and “computer, coupled to said storage unit” in the claims of *Alice* (U.S. Patent 7,149,720, claim 1), “the claims here do [no] more than simply instruct the practitioner to implement the abstract idea[...] on a generic computer.” *Alice*, 573 U.S. at 225.

In the **second** part (“B. PA TENT INELIGIBILITY DUE TO BEING AN ABSTRACT IDEA MUST CLEARLY IDENTIFY THE ABSTRACT IDEA”), the Appellant appears to argue that we have failed to express the abstract idea to which the claims are directed. *See* First Req. 4–5 (“[T]he Examiner and the Board relied on an improper analysis that merely stated that various claim limitations are directed to unspecified abstract ideas.”) (emphasis omitted).

We fully addressed the Examiner's *Alice* step one determination that claim 20 is directed to a patent-ineligible concept. *See* Dec. 5–9. We not only reproduced the Examiner's determination (Dec. 5–6), we also ascertained its propriety in light of the Appellant's arguments challenging that determination. We consulted the Specification to determine the focus of the claimed advance over the prior art, stating that

[i]n that regard, the Specification begins by explaining that “[c]onventionally, surveys are carried out by telephone or by mail.” Spec. page 1. “There are numerous problems with conventional survey approaches. One major problem with the conventional approach is that carrying out a survey is cumbersome in many ways.” Spec., page 2. The solution is “an automated survey technique that performs surveys over electronic media.” Spec., page 2. To do so, generic computer devices are used. Spec., e.g., pages 6-7. Thus, the focus of the claimed advance over the prior art is in automating a conventional procedure using generic computing devices.

Dec. 8–9. We cited a number of decisions in support of our view that performing surveys, *per se*, to which claim 20 is directed has been characterized as an abstract idea. *See* Dec. 9–10. We stated that “[c]laims to processing survey-related information have been held patent-ineligible. *See SkillSurvey, Inc. v. Checkster LLC*, 178 F.Supp.3d 247 (E.D. Pa. 2016), *aff'd*, 2017 WL 1279345 (Mem) (Fed. Cir. 2017).” Dec. 10. We expressly stated that

[p]erforming surveys is both a fundamental economic practice as well as a long standing commercial practice. “The need for surveys arises due to various reasons. Some of the major reasons for surveys are market research, elections, public opinions, and legal. The surveys associated with these major reasons are known as market research surveys, electoral polls, public opinion polls, and legal surveys.” Spec., page 1.

Dec. 10.

Accordingly, we disagree that we have failed to express the abstract idea to which the claims are directed.

The **third** part, “C. PANEL’S FACTUAL FINDINGS OF ‘CONVENTIONAL’ AND ‘NONINVENTIVE CONCEPT’ WENT BEYOND THE RECORD,” variously argues that the Board failed to appreciate “the claim feature ‘an Internet-based survey manager,’ a principal component of the claims” (First Req. 5) (emphasis omitted); “the existence and technical effect of the Internet-based survey manager,” (*id.*, at 6); “particular details [recited in the claim] of how an on-line survey can be produced and then hosted [via the Internet-based survey manager]” (*id.*, at 8); “an ordered combination of limitations of the claims [involving the Internet-based survey manager]” (*id.*, at 8), and that

the claims herein recite a technological solution to a technological problem specific to creation, management and hosting of on-line surveys and offer specifics on how this is achieved. All of these features yields an

unconventional solution using an inventive concept that was an improvement over the prior art.

Id., at. 9. The Appellant also argues that

[i]t appears that the Board and the Examiner considered the claims to be mere automation. Then, by conclusory means, they improperly concluded that there was no inventive concept. However, Appellants respectfully asserts that the claims are more particular and provide specificity that necessitates that they be considered as much more than mere automation.

First. Req. 10.

These arguments are unpersuasive.

The central theme of these arguments is that the claim limitations relative to “the Internet-based survey manager” amount to a technical and unconventional improvement over prior management of on-line surveys. We are unable to discern any such improvement.

As we stated in the Decision, “[w]hile claimed subject matter directed to an improvement in computer functionality may be patent-eligible, we have been unable to discern from the Appellant’s discussion, the claim, and the Specification, the ‘specific improvements to computer functionality’ of which the Appellant speaks.” Dec. 7-8. We have reviewed the record anew in light of the Appellant’s arguments but our opinion remains unchanged. We continue to find that

the Specification begins by explaining that “[c]onventionally, surveys are carried out by telephone or by mail.” Spec. page 1. “There are numerous problems with conventional survey approaches. One major problem with the conventional approach is that carrying out a survey is cumbersome in many ways.” Spec., page 2. The solution is “an automated survey technique that performs surveys over electronic media.” Spec., page 2. To do so, generic computer devices are used. Spec., e.g., pages 6–7. Thus, the focus of the claimed advance over the prior art is in automating a conventional procedure using generic computing devices.

Dec. 8-9.

The Appellant focuses our attention on the “Internet-based survey manager.” It is recited in the last two steps of the claim:

(n) providing and storing the on-line survey in an electronic manner to *an Internet-based survey manager* that hosts the on-line survey; and

(o) thereafter inviting a plurality of survey participants that are classified to be within the selected one or more participant groups to take the on-line survey by interaction with *the Internet-based survey manager*.

Emphasis added. Consulting the Specification to gain insight into what this “Internet-based survey manager” is, we find scant details. It is depicted in

Fig. 2 (reproduced below) of the Specification (item 202).

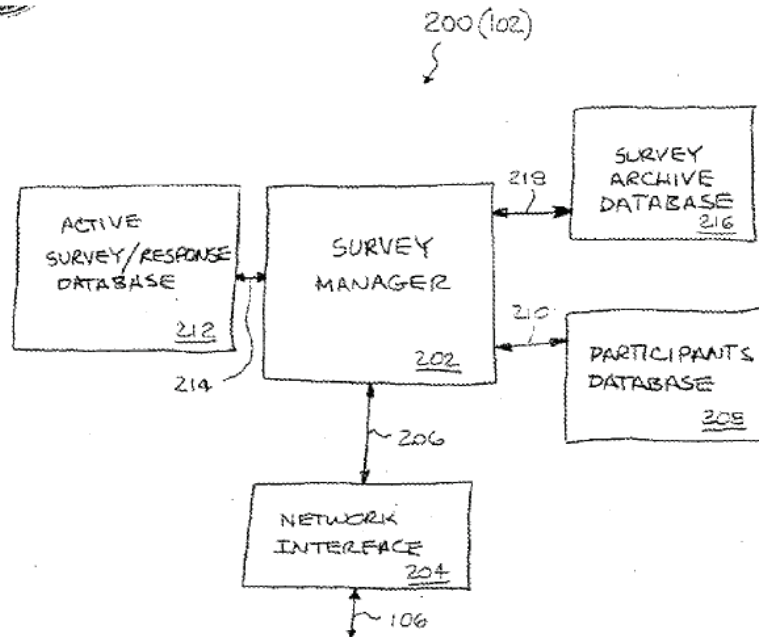


FIG. 2

FIG. 2 is a block diagram of a survey system according to an embodiment of the invention.

The associated disclosure states that “[t]he survey system 200 includes a survey manager 202 that manages and controls all the survey related operations.” Spec. 7.

The survey manager 202 carries out the survey (survey processing) The survey manager 202 selects the participants for a particular survey, and then electronically transmits the survey questions to each of the selected participants. The survey questions may be transmitted as an executable file that

executes locally on a computer, or may by a displayed page (HTML page) transmitted by a server via a network connection.

Id., 7–8. In light of these disclosures, the claimed “Internet-based survey manager” is reasonably broadly construed as a generic remote sever.

The Appellant argues that “[w]hile the Board’s decision included some discussion of a remote server (Bd. Decision, at 8), the Board overlooked the technological roots provided by the Internet-based survey manager that hosts surveys produced using the remote server.” First Req. 5–6.

The Appellant does not explain what those “technological roots” are. We have reviewed the Specification and have been unable to discover the “technological roots” of the claimed “Internet-based survey manager” that would distinguish it from any other generic remote server that was available at the time the application was filed.

Remote servers were well known at the time the application was filed.² See e.g., US 6,701,271 that

² Cf. *Intellectual Ventures I LLC v. Capital One Financial Corporation*, 850 F.3d 1332, 1341 (Fed. Cir. 2017) (“[T]he claims recite[] a generic computer element—a processor.”); *Planet Bingo, LLC v. VKGS LLC*, 576 Fed.Appx. 1005, 1008 (Fed. Cir. 2014) (nonprecedential) (“[T]he claims at issue[] require ‘a computer with a central processing unit,’ ‘a memory,’ ‘an input and output terminal,’ ‘a printer,’ in some cases ‘a video screen,’ and ‘a program ... enabling’ the steps of managing a game of bingo the claims recite a generic computer implementation of the covered abstract idea.”); and *Smariflash LLC v. Apple Inc.*, 680 Fed.Appx. 977, 984 (Fed. Cir. 2017) (nonprecedential) (“[W]e find here that ‘interfaces,’ ‘program stores,’ and ‘processors’ are all generic computer components.”)

was at issue in *ICON Health & Fitness, Inc. v. Octane Fitness, LLC*, 717 Fed.Appx. 1005 (Mem) (Fed. Cir. 2017).

The claim provides no additional structural details that would distinguish the claimed “Internet-based survey manager” from those generic remote servers that were well known at the time the application was filed.³

Rather, claim 20 describes its functionally; that is, the “Internet-based survey manager” is provided with an on-line survey in an electronic manner, stores and hosts the on-line survey, and interacts with survey participants such that they can take the on-line survey. These operations ask nothing of the “Internet-based survey manager” that a generic remote sever would not be expected to do. Providing electronic information, storing and hosting information, and providing a means for interacting with hosted information are routine functions commonly associated with generic remote servers.

The Specification attributes no special meaning to “providing and storing,” “host[ing], and “or inviting a plurality of survey participants that are classified to be within the selected one or more participant groups to take the on-line survey by interaction with the Internet-based survey manager”. Consistent with the Specification, which provides no

³ *Cf Move, Inc. v. Real Estate Alliance Ltd.*, 721 Fed. Appx. 950, 954 (Fed. Cir. 2018) (nonprecedential). “Claim 1 is aspirational in nature and devoid of any implementation details or technical description that would permit us to conclude that the claim as a whole is directed to something other than the abstract idea identified by the district court.”

details, these steps are reasonably broadly construed to cover the common processing functions one of ordinary skill in the art at the time of the invention would have associated with generic remote servers. *Cf. OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015):

Beyond the abstract idea of offer-based price optimization, the claims merely recite “well-understood, routine conventional activit[ies],” either by requiring conventional computer activities or routine data-gathering steps. *Alice*, 134 S.Ct. at 2359 (*quoting Mayo*, 132 S.Ct. at 1294) (alterations in original). . . . For example, claim 1 recites “sending a first set of electronic messages over a network to devices,” the devices being “programmed to communicate,” storing test results in a “machine-readable medium,” and “using a computerized system . . . to automatically determine” an estimated outcome and setting a price. Just as in *Alice*, “all of these computer functions are ‘well-understood, routine, conventional activit[ies]’ previously known to the industry.” *Alice*, 134 S.Ct. at 2359 (*quoting Mayo*, 132 S.Ct. at 1294) (alterations in original); *see also buySAFE[, Inc. v. Google, Inc.]*, 765 F.3d [1350,] 1355 [(Fed. Cir. 2014)] (“That a computer receives and sends the information over a network—with no further [S]pecification—is not even arguably inventive.”).

At best, the claimed “Internet-based survey manager” distinguishes from other generic remote servers in that it processes *surveys* rather than

another type of information. But that difference alone is not patentably consequential. This is so because “[c]laim limitations directed to the content of information and lacking a requisite functional relationship are not entitled to patentable weight because such information is not patent eligible subject matter under 35 U.S.C. § 101.” *Praxair Distribution, Inc. v. Mallinckrodt Hospital Products IP Ltd.*, 890 F.3d 1024, 1032 (Fed. Cir. 2018).

We have reviewed the record anew but still do not find the claim limitations relative the “Internet-based survey manager” amount to a technical and unconventional improvement over prior management of online surveys. The Appellant’s arguments to the contrary are unpersuasive. We are unpersuaded that the record supports the

claims herein recit[ing] a technological solution to a technological problem specific to creation, management and hosting of on-line surveys and offer specifics on how this is achieved.

First Req. 9.

We have considered all the Appellant’s arguments in the First Request and find them unpersuasive.

The Second Request for Rehearing

The Second Request for Rehearing consists of four parts.

In the **first** part (“A. PATENTABLE CLAIMS ARE NOT ABSTRACT”), the Appellant supplements the position taken in the first part of the first Request for Rehearing by additionally arguing that “the

Board's conclusion that the claims are directed to an abstract idea is inconsistent with the USPTO's 2019 Revised Patent Subject Matter Eligibility Guidance ('New Guidelines') [84 Fed. Reg. 50 (Jan. 7, 2019)]." Second Req. 1 (emphasis omitted).

The Appellant contends that "[t]he Board's decision *newly* asserted that the claims are directed to the abstract idea of '[p]erforming surveys is both a fundamental economic practice as well as a long standing commercial practice.' Decision, p. 10." Second Req. 2. Nevertheless, according to the Appellant, "the New Guidelines is expressly limited to specific activities" which does not include performing surveys. Second Req. 2–3.

We disagree.

We clearly indicated in the Decision that the Specification itself recognizes that surveys are known vehicles for market research. *See* Dec. 10:

Performing surveys is both a fundamental economic practice as well as a long standing commercial practice. "The need for surveys arises due to various reasons. Some of the major reasons for surveys are market research, elections, public opinions, and legal. The surveys associated with these major reasons are known as market research surveys, electoral polls, public opinion polls, and legal surveys." Spec., page 1.

It is a fundamental economic practice to perform surveys for, e.g., market research. As such, performing surveys does indeed fall in one of groupings of abstract ideas specifically identified in

the New Guidelines, namely “[c]ertain methods of organizing human activity — fundamental economic practices.” *See* New Guidelines, 52.

Accordingly, we are unpersuaded that the Decision is inconsistent with the New Guidelines on the ground that “performing surveys” does not fall in one of the groupings of abstract ideas identified in the New Guidelines.

In the **second** part (“B. BOARD’S ANALYSIS LACKS CONSIDERATION OF BOTH STEP 2A AND 2B”), the Appellant argues that “[i]t is clear the Board’s decision fails to consider any ‘practical application’ of the claims.” Second Req. 4.

That is not true.

We clearly addressed the Appellant’s apparent argument that “processing survey-related information necessarily yields ‘specific improvements to computer functionality.’” Dec. 9. In doing so, we necessarily satisfied Prong Two ([“If the Claim Recites a Judicial Exception, Evaluate Whether the Judicial Exception Is Integrated Into a Practical Application”]) of Step 2A of the New Guidelines currently in force.

“A claim that integrates a judicial exception into a practical application will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” 2019 Revised 101 Guidance 54. The Appellant argued that the claimed “processing survey-related information” reflected a

technical improvement. See App. Br. 8–9 (reproduced at Dec. 7).

It is true that if “[a]n additional element reflects an improvement in the functioning of a computer, or an improvement to other technology or technical field” (2019 Revised 101 Guidance 55) it may be “indicative that [the] additional element (or combination of elements) may have integrated the exception into a practical application” (*id.*).

The difficulty here is that we have been unable to discern from the record any such improvement. We explained our reasoning in the Decision. Dec. 8. We expanded on that above in addressing the first part of the First Request. For the reasons discussed we do not find the record sufficiently supports the argument that claim 20 recites an improvement in computer functionality. In doing so we have satisfied the argued-over requirement to consider any “practical application” of the claims.

The **third** part (“C. PATENT INELIGIBILITY DUE TO BEING AN ABSTRACT IDEA MUST CLEARLY IDENTIFY THE ABSTRACT IDEA”) repeats what was argued in the second part of the First Request, which is addressed above. Second Req. 5.

The **fourth** part (“D. PANEL’S FACTUAL FINDINGS OF ‘CONVENTIONAL’ AND ‘NONINVENTIVE CONCEPT’ WENT BEYOND THE RECORD”) repeats what was argued in the third part of the First Request, which is addressed above. *Id.*

We have considered all the Appellant's arguments in the Second Request and find them unpersuasive.

CONCLUSION

We have carefully considered the Requests but, for the foregoing reasons, we do not find them persuasive as to error in the Board's decision of October 16, 2018 to affirm the rejection of claims 20-46 under 35 U.S.C. § 101.

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).

DENIED