

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

BETTER FOOD CHOICES LLC,
Patent Owner.

Case CBM2015-00071
Patent 5,841,115

Before MICHAEL P. TIERNEY, GLENN J. PERRY, and MINN CHUNG,
Administrative Patent Judges.

CHUNG, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 328(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

In this covered business method patent review, instituted pursuant to 35 U.S.C. § 324, Petitioner Google Inc. (“Petitioner”) challenges the patentability of claims 1–20 (the “challenged claims”) of U.S. Patent No. 5,841,115 (Ex. 1001, “the ’115 patent”), owned by Better Food Choices LLC (“Patent Owner”). The Board has jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73. With respect to the grounds instituted in this trial, we have considered the papers submitted by the parties and the evidence cited therein. For the reasons discussed below, we determine Petitioner has shown by a preponderance of the evidence that claims 1–20 of the ’115 patent are unpatentable.

A. Procedural History

On February 4, 2015, Petitioner filed a Petition (Paper 1, “Pet.”) requesting a covered business method patent review of claims 1–20 of the ’115 patent under Section 18 of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 329 (2011) (“AIA”). Patent Owner filed a Preliminary Response (Paper 8, “Prelim. Resp.”). On August 20, 2015, we instituted a covered business method patent review based on the following specific grounds (Paper 10, “Dec. on Inst.,” 30–31):

Claims Challenged	Statutory Basis	Ground
1–20	§ 101	Lack of patent-eligible subject matter
1–10	§ 112, ¶ 2	Indefiniteness

After institution of trial, Patent Owner filed a Patent Owner Response (Paper 14, “PO Resp.”), to which Petitioner filed a Reply (Paper 18, “Pet. Reply”). The parties also briefed whether certain exhibits submitted by Patent Owner should be excluded from the record. See Papers 21, 25, 27.

An oral hearing was held on May 19, 2016. A transcript of the hearing is included in the record as Paper 34 (“Tr.”).

B. Related Proceedings

Petitioner indicates that the ’115 patent has been asserted against Petitioner in the following patent infringement case: *Better Food Choices, LLC v. MyNetDiary, Inc.*, No. 14-cv-00204-CWD (D. Idaho). Pet. 4. According to Petitioner, the case has been transferred to the United States District Court for the Northern District of California as Case No. 3:15-cv-00198-EDL. *Id.*

Patent Owner indicates that the ’115 patent is also the subject of the following patent infringement case: *Better Food Choices, LLC v. Amazon, Inc.*, No. 3:15-cv-00198 (N.D. Cal.). Paper 9, 2.

II. THE ’115 PATENT

A. Described Invention

The ’115 patent describes a computerized method and system to provide personalized nutritional information to consumers. Ex. 1001, Abstract, col. 5, ll. 40–43. The computerized apparatus and method correlate personal data—such as age, height, weight, medical conditions, nutritional preferences, and demographic data—with the food products the person seeks to purchase or consume, or has purchased or consumed. *Id.* at col. 5, ll. 43–48. In an embodiment, personal data may be provided or

entered by using a magnetic card reader, a barcode reader, a keypad entry device, or a touch screen entry system. *Id.* at col. 5, ll. 60–63. The data input regarding an individual may include the individual’s age, gender, and weight; the existence of dietary regulated conditions such as high cholesterol level or diabetes; and the existence of medical conditions such as heart disease. *Id.* at col. 5, l. 64–col. 6, l. 3. In another embodiment, a shopper at a supermarket may provide personal and product information by using a barcode scanner available on a shopping cart to scan a user identification card and the barcodes on packaged food. *Id.* at col. 7, ll. 16–19. The system accesses a nutritional database (NDB)—which contains a listing of foods, the UPC barcode number for prepackaged food products, and nutritional information regarding those foods—and correlates the personal data input by the individual with the nutritional data pertaining to the food products the individual intends to purchase. *Id.* at col. 6, ll. 24–28; col. 7, ll. 19–26. The correlated data output may include information and/or recommendations regarding the particular food choices of the individual—e.g., if an individual is a diabetic, the system will inform the person whether any of the chosen food items contain sugars or glucose. *Id.* at col. 6, ll. 37–41. By using the claimed system, the food shoppers can obtain individualized nutritional information while they shop, allowing them to make better informed food choices. *Id.* at col. 7, ll. 31–35.

In another embodiment, the claimed system may provide personalized nutritional information at the check-out counter of a food market. *Id.* at col. 7, ll. 64–66. The information provided to the shopper would be in the form of a printed report the shopper receives at the time of purchase, and

may be based on a single purchase of food items or based upon weekly food purchases. *Id.* at col. 7, ll. 66–67; col. 8, ll. 4–5.

B. Illustrative Claim

Of the challenged claims, claims 1, 4, and 11 are independent.

Claims 1 and 11 are illustrative of the challenged claims and are reproduced below:

1. Apparatus for generating personalized nutritional information for a shopper comprising:

(a) means for inputting personal data relating to an individual;

(b) barcode means for inputting data identifying at least one food product which said shopper has selected or specified, or has purchased or consumed;

(c) processor means under the control of a prestored computer program for correlating the personal data with prestored nutritional data, including a barcode address, pertinent to the at least one food product which said shopper has selected or specified, or has purchased or consumed; and

(d) means for outputting information pertinent to the at least one food product and the personal data of the individual.

11. A method for providing a shopper with personalized nutrition information regarding food purchased or consumed, or food selected or specified by said shopper, comprising the following steps:

(a) inputting personal data relating to an individual;

(b) selecting or specifying at least one food product which said shopper is interested in, or has purchased or consumed, and inputting data identifying said food product;

(c) correlating the personal data with prestored nutritional data including a barcode address, pertinent to the at least one food product which said shopper has specified or selected, or has purchased or consumed; and

(d) outputting information pertinent to the at least one food product and the personal data of the individual.

III. ANALYSIS

A. Standing

Section 18 of the AIA limits filing of petitions for a covered business method patent review to persons or their privies that have been sued or charged with infringement of a covered business method patent. AIA, § 18(a)(1)(B); see 37 C.F.R. § 42.302(a). A “covered business method patent” is a patent that “claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” AIA § 18(d)(1); see 37 C.F.R. § 42.301(a). For the reasons described below, we determine that Petitioner has standing to file the Petition for covered business method patent review of the ’115 patent.

1. Sued for Infringement

As discussed above, Petitioner represents, and Patent Owner does not dispute, that Petitioner has been sued for infringement of the ’115 patent in *Better Food Choices, LLC v. MyNetDiary, Inc.*, No. 14-cv-00204-CWD (D. Idaho). Pet. 4; Paper 9, 2. Thus, Petitioner has been sued for infringement for purposes of AIA § 18(a)(1)(B).

2. Whether the ’115 Patent is a Covered Business Method Patent Subject to Covered Business Method Patent Review

Petitioner asserts that the ’115 patent is a covered business method patent as defined in Section 18(d)(1) of the AIA. Pet. 5–18. Patent Owner

disagrees and asserts that the '115 patent is not subject to covered business method patent review. *See* Prelim. Resp. 3–4, 6–9. In the Decision on Institution, we determined, upon considering the arguments and evidence submitted by the parties, Petitioner has met its burden of demonstrating that the '115 patent is a covered business method patent under AIA § 18(d)(1) and is eligible for review under the transitional covered business method patent program. Dec. on Inst. 6–14. We determined that Petitioner has demonstrated sufficiently that claims 1, 4, and 11 of the '115 patent recite a method or apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, as required by Section 18(d)(1) of the AIA (*id.* at 6–11) and that the '115 patent is not a patent for a technological invention under Section 18(d)(1) of the AIA (*id.* at 11–14). Patent Owner and Petitioner do not dispute whether the '115 patent is subject to covered business method patent review in the Patent Owner Response and Petitioner's Reply, and we do not perceive any reason or evidence that compels deviation from our earlier determination. Accordingly, we adopt our previous analysis for purposes of this Final Written Decision. *See id.* at 6–14.

In paragraph 41 of the Declaration of Kenneth J. Shepley (Ex. 2005) submitted during trial, Mr. Shepley, the inventor of the '115 patent, asserts that our Decision on Institution did not consider the remarks by Senator Kyl in the legislative history of the AIA reproduced below.

As the proviso at the end of the definition makes clear, business methods do not include “*technological inventions*.” In other words, the definition applies only to abstract business concepts and their implementation, whether in computers or otherwise, but does not apply to inventions relating to computer operations

for other uses or the application of the natural sciences or engineering.

157 Cong. Rec. S1379 (daily ed. Sept. 8, 2011) (statement of Sen. Kyl) (emphasis added). Paragraph 41 of the Shepley Declaration is not referenced or discussed in the Patent Owner Response. Nonetheless, Mr. Shepley's assertion does not change our analysis because, contrary to Mr. Shepley's assertion and as discussed in the Decision on Institution, in promulgating rules for covered business method reviews, the Office considered the legislative intent and history behind the AIA's definition of "covered business method patent." Dec. on Inst. 6–7 (citing Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention; Final Rule, 77 Fed. Reg. 48,734, 48,735–36 (Aug. 14, 2012)). Following Congress's instructions, the promulgated rules include the definition of "technological inventions." See AIA § 18(d)(2). In the Decision on Institution, we applied the definition provided in the final rules to determine that the '115 patent is not a patent for a technological invention. See Dec. on Inst. 11–14.

For purposes of this Final Written Decision, we adopt Petitioner's contentions as summarized in the Decision on Institution. See Dec. on Inst. 7–8, 11–13. For instance, the record supports, and we adopt, Petitioner's contention that the '115 patent admits that the claimed technological features were generic, well-known, existing, and conventional at the time of invention. See Dec. on Inst. 11–12 (citing Pet. 13–17). The record also supports, and we adopt, Petitioner's contention that the '115 patent does not solve a technical problem because the problem addressed by the '115 patent is "sift[ing] through possible misleading health claims, other advertising

influences and complicated food label information to make a wise choice” when shopping for groceries, which does not present a technical problem. *See id.* at 13 (citing Pet. 17–18). Hence, we determine for the reasons discussed in the Decision on Institution and notwithstanding Mr. Shepley’s assertion or Patent Owner’s arguments in the Preliminary Response, that Petitioner has demonstrated sufficiently that the ’115 patent is not a patent for a technological invention under Section 18(d)(1) of the AIA. *Id.* at 11–14. As discussed in the Decision on Institution, we have determined, notwithstanding Patent Owner’s arguments in the Preliminary Response, the claims of ’115 patent recite activities that are, at a minimum, complimentary or incidental to a financial activity—i.e., purchase of food by a shopper. *Id.* at 6–11. Therefore, the challenged claims recite a method or apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, as required by Section 18(d)(1) of the AIA. *Id.* at 11. Accordingly, we determine Petitioner has demonstrated sufficiently that the ’115 patent is a covered business method patent under AIA § 18(d)(1) and is eligible for review under the transitional covered business method patent program. *See Dec. on Inst.* 6–14.

B. Claim Construction

Petitioner asserts that it is not necessary to construe any claim limitations of the ’115 patent for the purposes of the patentability analysis under 35 U.S.C. § 101. Pet. 21. Nonetheless, Petitioner asserts that the limitations of claims 1 and 4 reciting the word “means” should be interpreted as means-plus-function limitations under 35 U.S.C. § 112, ¶ 6, especially for the purposes of determining definiteness of claims 1–10 under

35 U.S.C. § 112, ¶ 2.¹ Pet. 23–25, 37–38. In particular, Petitioner asserts that the term “processor means under the control of a prestored computer program for correlating the personal data with prestored nutritional data” recited in claims 1 and 4 should be construed as a means-plus-function limitation subject to § 112, ¶ 6. *Id.* at 37–38. In the Decision on Institution, we preliminarily determined that this term is a means-plus-function limitation and that § 112, ¶ 6 applies. Dec. on Inst. 27–28. Patent Owner disagrees and argues that this term should not be construed according to § 112, ¶ 6. PO Resp. 39–40. We will address the construction under § 112, ¶ 6 in Section III.D below for the purposes of determining definiteness of claims 1–10 under § 112, ¶ 2. No express construction is necessary for any other claim term of the ’115 patent. *See, e.g., Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (only those terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy).

C. Asserted Ground Based on 35 U.S.C. § 101

Petitioner asserts that claims 1–20 of the ’115 patent are unpatentable under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Pet. 19–36. Upon review of all of the parties’ papers and supporting evidence discussed in those papers, we are persuaded that Petitioner has demonstrated, by a preponderance of evidence, that claims 1–20 are unpatentable under 35 U.S.C. § 101.

¹ Section 4(c) of the AIA re-designated 35 U.S.C. § 112, ¶¶ 2 and 6, as 35 U.S.C. § 112 (b) and (f), respectively. Because the ’115 patent has a filing date prior to September 16, 2012, the effective date of § 4(c) of the AIA, we refer to the pre-AIA version of 35 U.S.C. § 112. *See* AIA § 4(e).

Section 101 provides 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 therefor, subject to the conditions and requirements of this title.” The Supreme Court has “long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013) (internal quotation marks and brackets omitted)). “The ‘abstract ideas’ category embodies the longstanding rule that ‘[a]n idea of itself is not patentable.’” *Alice*, 134 S. Ct. at 2355 (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (quotations omitted)). Notwithstanding that an abstract idea, by itself, is not patentable, the practical application of an abstract idea may be deserving of patent protection. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293–94 (2012). To be patent-eligible, a claim cannot simply state the abstract idea and add the words “apply it.” *Id.* at 1294. The claim must incorporate enough meaningful limitations to ensure that it claims more than just an abstract idea and is not merely a “drafting effort designed to monopolize the [abstract idea] itself.” *See id.* at 1297.

The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Alice*, 134 S. Ct. at 2355. If so, a second step in the analysis is warranted to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132

S. Ct. at 1298, 1297). In other words, the second step is to “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 on the [ineligible concept] itself.’” *Id.* (alteration in original) (quoting *Mayo*, 132 S. Ct. at 1294). The prohibition against patenting an abstract idea “cannot be circumvented by attempting to limit the use of the formula to a particular technological environment or adding insignificant postsolution activity.” *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (citation and internal quotation marks omitted). Following this framework, we analyze Petitioner’s asserted ground of unpatentability based on § 101.

As an initial matter, Patent Owner asserts that Petitioner has not met its burden of proof because Petitioner relies only on the ’115 patent and its prosecution history to argue unpatentability and does not present any other evidence, such as a witness. PO Resp. 6–7, 13–20. Patent Owner argues that Petitioner has presented no evidence of unpatentability because the ’115 patent and its file history “shows the Patent Owner has a valid, issued patent and nothing more.” *Id.* at 7. We are not persuaded because, as discussed below, in this case we need to look only to the ’115 patent and its prosecution history to support a finding of unpatentability under §§ 101 and 112. *See In re TLI Comm. LLC Patent Litig.*, 823 F.3d 607, 613–14 (Fed. Cir. 2016) (the patent alone is sufficient to sustain a finding of unpatentability under § 101).

1. Abstract Idea

Petitioner asserts that the challenged claims are “directed to the abstract idea of providing shoppers with information about their potential food purchases that is relevant to their own personal nutritional needs.” Pet.

25. Analyzing claim 11 as a representative claim, Petitioner discusses the steps recited in the claim and the corresponding disclosure in the Specification and argues that the recited steps are, viewed as a whole, directed to an awareness of personal information, shopping for food, and correlating personal needs with the characteristics of the food, and, hence, “cover the abstract idea of paying attention to nutrition while grocery shopping.” *Id.* at 25–27. Petitioner argues that claim 11 recites nothing more than “the typical, routine nutritional analysis that grocery shoppers have been performing on their own for decades.” *Id.* at 2. According to Petitioner, “shoppers have selected groceries based upon their nutritional needs and goals for at least as long as there have been nutritional labels” and that “this fundamentally abstract concept” is unpatentable under § 101. *Id.* at 27–28. Petitioner asserts that a district court has reached a similar conclusion in a case concerning customized meal-planning using a food database. *Id.* at 28 (citing *DietGoal Innovations LLC v. Bravo Media LLC*, 33 F. Supp. 3d 271, 283–84 (S.D.N.Y. 2014), *aff’d*, 599 F. App’x 956 (Fed. Cir. 2015)).

Petitioner further asserts that the challenged claims recite data operations that replicate a series of tasks that could be otherwise accomplished with the human mind and a pen and paper and are, therefore, directed to an abstract idea because claims covering nothing more than receiving, storing, processing, and/or transmitting data, are inherently abstract. Pet. Reply 6–7 (citing *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1349–51 (Fed. Cir. 2014)). Petitioner additionally argues that “providing personalized nutritional information of food products to shoppers based on their nutritional needs” can be performed

with a pen and paper and/or in the human mind and that claims directed to human activities that can be accomplished with pen and paper have been found to be abstract by several courts. *Id.* at 7 (citing *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1371–72 (Fed. Cir. 2011); *OpenTV, Inc. v. Apple, Inc.*, No. 14-cv-1622, 2015 WL 1535328, at *4 (N.D. Cal. Apr. 6, 2015)). Petitioner also asserts that the challenged claims are drawn to “method[s] of organizing human activity” or longstanding practices, and, therefore, are abstract. *Id.* (citing *Alice*, 134 S. Ct. at 2356).

Petitioner contends that claims 1 and 4 are drawn to the same abstract idea as method claim 11, “differing only insofar as they attempt to expressly tie the idea to a computerized environment using generic means-plus-function claiming.” Pet. 31. Petitioner argues claims 1 and 4 meet the first part of the *Alice* test because adding common components claimed in means-plus-function form to the underlying abstract idea does not make the claims less abstract. *Id.* (citing *Indeed, Inc. v. Career Destination Development, LLC*, Case CBM2014-00068, slip. op. at 16–17 (PTAB Aug. 20, 2014) (Paper 11)).

Patent Owner criticizes Petitioner’s choice of claim 11 as a representative claim as being arbitrary and focuses instead on claim 1 as the “primary reference claim.” PO Resp. 32 & n.15. Patent Owner also disputes Petitioner’s characterization of the challenged claims and asserts that determining whether the claims are directed to an abstract idea at step one of the *Alice* framework requires identifying the “core invention” of the ’115 patent. *Id.* at 30. Patent Owner asserts that this “core invention” must include “three essential primary elements,” defined by Patent Owner as “#1 a barcode entry device, #2 personal data related to the individual, and #3

prestored nutritional data.” *Id.* at 31. Hence, Patent Owner argues that claim 1 is directed to “the combination of a barcode entry device, personal data related to the individual, and prestored nutritional data, combined and correlated to allow a shopper to avoid relying on product labels for nutritional information.” *Id.* Patent Owner asserts that the claim is, therefore, not drawn to a long prevalent practice because “the number of shoppers carrying a barcode reader and their own data into a store is a very small number.” *Id.* at 24. Patent Owner argues that Petitioner’s challenge under § 101 fails at step one because Petitioner has provided no evidence that the “core invention,” as defined by Patent Owner, is directed to an abstract idea or a prevalent practice. *Id.* at 52.

Patent Owner further asserts that the use of a barcode reader and “prestored nutritional data” must be considered in step one of the *Alice* analysis because these elements are part of the purported “core invention” as defined by Patent Owner. Patent Owner asserts that Petitioner subjectively recasts the claimed invention overly broadly by leaving out these elements to favor a finding of abstractness. PO Resp. 47–49. Patent Owner argues our consideration of these elements in step two, rather than step one, of the *Alice* framework in the Decision on Institution was unfair and erroneous. *Id.* at 27, 50–51.

As noted by Petitioner, the Specification describes the barcode reader as one of the well-known systems for data entry. Ex. 1001, col. 5, ll. 61–63; Pet. 15. The Specification also describes “prestored nutritional data” and “personal data related to [an] individual” as well-known and conventional in the Background of the Invention section. *See, e.g.*, Ex. 1001, col. 3, ll. 39–41 (“Variations of these three primary methods [of collecting nutrition

intake data] also exist. Some of these include *personal*-, telephone-, and mail-assisted *reporting*, with retrospective and prospective variations of each.”), 54–64 (“Most of these methods usually convert food consumption information into nutrient intake data via the coding of various foods for entry into computer programs. . . . Variations in the *nutrient databases* used to define the nutrient composition of foods pose another problem in assessing data.”) (emphases added).

Including these well-known and conventional components does not render the claims any less abstract for purposes of step one of the *Alice* analysis. See *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1367 (Fed. Cir. 2015) (noting that including technical elements does not render the claims any less abstract). For example, in *Content Extraction and Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343 (Fed. Cir. 2014), although the patentee argued that the claims at issue require a scanner and therefore are distinguishable from the claims found to be abstract in *Alice*, the Federal Circuit nonetheless determined that the claims were directed to the abstract concept of data recognition and storage that is patent ineligible. *Id.* at 1347–48. The patentee in *Content Extraction* conceded that the use of a scanner was well-known at the time of filing, similar to the barcode reader and other components of the “three essential primary elements” defined by Patent Owner in this case. *Id.* at 1348. Whether these conventional components, individually or as an ordered combination, transform the claims into patent-eligible subject matter is a question to be considered in step two of the *Alice* analysis. *Alice*, 134 S. Ct. at 2355. Accordingly, we are not persuaded by Patent Owner’s argument that the challenged claims are not directed to an abstract idea predicated

upon Patent Owner’s definition of the purported “core invention” of the ’115 patent.

Moreover, Patent Owner’s “core invention” analysis is inconsistent with the Supreme Court and Federal Circuit precedents on step one analysis under the *Alice* framework. In step one of the *Alice* analysis, to determine whether the challenged claims are directed to an abstract idea, the inquiry is to ask, considered in light of the Specification, whether “their character as a whole” is directed to an abstract idea, not, as Patent Owner contends, identifying the “core invention” of the patent. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). Relying on the distinction made in *Alice* between, on one hand, computer-functionality improvements and, on the other, uses of existing computers as tools in aid of processes focused on “abstract ideas,” the court in *Enfish* clarified that a relevant inquiry in step one of the *Alice* framework is to ask whether the “focus” of the claims is on the specific asserted improvement in computer capabilities or, instead, on a process that qualifies as an “abstract idea” for which computers are invoked merely as a tool. *Enfish*, 822 F.3d at 1335–36 (citing *Alice*, 134 S. Ct. at 2358–59). In this inquiry, claims “directed to an improvement in the functioning of a computer” are contrasted with claims “simply adding conventional computer components to well-known business practices” or “generalized steps to be performed on a computer using conventional computer activity.” *See TLI*, 823 F.3d at 612 (quoting *Enfish*, 822 F.3d at 1338). The Federal Circuit further clarified recently and described the first-stage inquiry as “looking at the ‘focus’ of the claims, their ‘character as a whole.’” *Elec. Power Grp., LLC v. Alstom S.A.*, No. 2015-

1778, ___ F.3d ___, 2016 WL 4073318, at *3 (Fed. Cir. Aug. 1, 2016) (citing *Enfish*, 822 F.3d at 1335–36; *Internet Patents*, 790 F.3d at 1346).

Under the approach described in *Alice* and clarified in *Enfish*, *TLI*, and *Electric Power Group*, the challenged claims in this case, contrary to Patent Owner’s assertion, are *not* directed to a barcode entry device, personal data related to the individual, and prestored nutritional data, because the claims are not focused on any specific improvement in the functioning of a barcode reader or a nutritional database. The Specification does not describe a new barcode reader or new database technology. Rather, as discussed above, the Specification describes the barcode reader as one of the well-known systems for data entry. Ex. 1001, col. 5, ll. 61–63. The Specification also describes “prestored nutritional data” and “personal data related to [an] individual” as well-known and conventional components. *See, e.g.*, Ex. 1001, col. 3, ll. 39–41. Moreover, the Specification does not provide any technical details for the barcode reader, the nutritional database, the processor, or correlating personal data with nutritional data, but instead mostly describes the system and the method in purely functional terms. *See* Ex. 1001, col. 5, l. 56–col. 6, l. 63.

Based on the disclosure in the Specification and the claim language, we determine that the “focus” of the challenged claims in this proceeding, including claims 1 and 11,² is on collecting and correlating information—i.e., collecting personal data of a shopper and data identifying selected food

² We note that, in this case, whether the claim is drafted as a method claim or in a means-plus-function format is immaterial in evaluating the “focus” of the claims or their “character as a whole.” Hence, for purposes of step one of the *Alice* analysis in this proceeding, we consider both claims 1 and 11 as representative claims.

products, correlating the collected information with prestored nutritional data, and presenting the results of the data collection and correlation. In other words, the focus of the challenged claims is on collecting and correlating information, a process that qualifies as an “abstract idea” for which conventional components, such as a barcode reader, data input devices, a processor, and a nutritional database, are merely invoked as tools used in their ordinary and conventional manner. The court in *Electric Power Group* explained as follows:

Information as such is an intangible. . . . Accordingly, we have treated collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas. . . . In a similar vein, we have treated analyzing information by steps people go through in their minds . . . without more, as essentially mental processes within the abstract-idea category. . . . And we have recognized that merely presenting the results of abstract processes of collecting and analyzing information, without more . . . , is abstract as an ancillary part of such collection and analysis.

2016 WL 4073318, at *3 (citations omitted); *see also Content Extraction*, 776 F.3d at 1347 (finding that “1) collecting data, 2) recognizing certain data within the collected data set, and 3) storing that recognized data in a memory” was an abstract idea because “data collection, recognition, and storage is undisputedly well-known” and “humans have always performed these functions”). Thus, the challenged claims are focused on the combination of abstract-idea processes of collecting and correlating specific types of information—i.e., personal data of a shopper, data identifying selected food products, and nutritional data—and presenting the results of collecting and correlating the information. The advance Patent Owner

purports to make is a process of gathering and analyzing information of a specified content and not any particular inventive technology for performing those functions. The challenged claims are, therefore, directed to an abstract idea.

This analysis is consistent with Petitioner's assertion that the challenged claims recite data operations that replicate a series of tasks that could be otherwise accomplished with the human mind and a pen and paper and are, therefore, directed to an abstract idea. Pet. Reply 6–7. We also agree with Petitioner that the challenged claims apply the recited data operations to the human activity of “providing personalized nutritional information of food products to shoppers based on their nutritional needs” and, therefore, are abstract as being drawn to “method[s] of organizing human activity.” *Id.* at 7; *see also TLI*, 823 F.3d at 613 (“we have applied the ‘abstract idea’ exception to encompass inventions pertaining to methods of organizing human activity”); *Intellectual Ventures I*, 792 F.3d at 1367 (finding the claim at issue “not meaningfully different from the ideas found to be abstract in other cases before the Supreme Court and our court involving methods of organizing human activity”). Based on the foregoing, we determine that the challenged claims are directed to the abstract idea of collecting and correlating information to provide personalized nutritional information of food products to shoppers.

Patent Owner asserts that the challenged claims are distinguishable from the claims at issue in *Alice*, *Bilski*, and *DietGoal*, because the '115 patent claims are not directed to computer implementation of known processes or methods. PO Resp. 43–44. Rather, Patent Owner argues that a proper question to ask in a correct inquiry at step one in this proceeding is

whether the challenged claims directed to a new and unobvious process of “identifying a product at the time of shopping, correlating with an objective nutritional database (not under the control of the manufacturer like a product label is), and then correlating that result with nutritional information personal to the shopper, producing a ‘buy-don’t buy’ result, in the retail store for the benefit of the shopper” are patent eligible. PO Resp. 54–55. Patent Owner’s characterization of the challenged claims in this instance is not materially different from our discussion above of the “focus” of the claims and their “character as a whole.” Thus, the challenged claims, as described by Patent Owner, are directed to a combination of abstract-idea processes of collecting and correlating specific types of information and presenting the results of collecting and correlating the information. Therefore, the challenged claims are directed to an abstract idea for the reasons discussed above.

To the extent that Patent Owner argues the challenged claims are not abstract because the claims are novel and unobvious, Patent Owner’s argument is unpersuasive because, as the Federal Circuit explained, “the addition of merely novel or non-routine components to the claimed idea [does not] necessarily turn[] an abstraction into something concrete.” *Ultramercial, Inc. v. Hulu LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014), *cert. denied sub nom. Ultramercial, LLC v. WildTangent, Inc.*, 135 S. Ct. 2907 (2015). Rather, “any novelty in implementation of the idea is a factor to be considered only in the second step of the *Alice* analysis.” *Id.* As discussed below in the second step of our analysis, the limitations of the challenged claims merely implement the recited abstract idea with routine, conventional activity, and, therefore, are insufficient to transform the patent-ineligible abstract idea discussed above into patent-eligible subject matter. *See*

Ultramercial, 772 F.3d at 716 (“[E]ach of those eleven steps merely instructs the practitioner to implement the abstract idea with routine, conventional activities, which is insufficient to transform the patent-ineligible abstract idea into patent-eligible subject matter. That some of the eleven steps were not previously employed in this art is not enough—standing alone—to confer patent eligibility upon the claims at issue.” (citation omitted) (internal quotation marks omitted)).

The rest of Patent Owner’s arguments are also unpersuasive. For example, Patent Owner argues the claimed invention cannot be performed manually by using nutritional labels from product packaging because the point of the ’115 patent is to avoid reading product packaging labels. PO Resp. 50. Petitioner responds that the challenged claims do not recite avoiding food labels or require considering the barcode input only. Pet. Reply. 6. We agree with Petitioner and find Patent Owner’s argument based on unclaimed features unpersuasive.

On this record, we are persuaded, based on the Specification and the claim language, that the challenged claims are directed to an abstract idea.

2. Inventive Concept

Turning to the second step in our analysis, we find that the challenged claims fail to recite any elements that individually or as an ordered combination transform the abstract idea of collecting and correlating information to provide personalized nutritional information of food products to shoppers into a patent-eligible application of that idea. It is well-settled that mere recitation of concrete, tangible components is insufficient to confer patent eligibility to an otherwise abstract idea. *TLI*, 823 F.3d at 613. Rather, the recited components must involve more than performance of “well-

understood, routine, conventional activit[ies]’ previously known to the industry.” *Alice*, 134 S. Ct. at 2359 (quoting *Mayo*, 132 S. Ct. at 1294).

Claims 1, 4, and 11

Petitioner asserts that, although claim 11 recites terms generally associated with computer implementations, such as “inputting,” “data,” and “outputting,” they at best involve “generic computer components configured to implement the [abstract] idea,” and, therefore, cannot transform the abstract idea recited by the claim into patent-eligible subject matter. Pet. 29–30 (citing *Alice*, 134 S. Ct. at 2360). Petitioner argues that the limitation reciting “correlating the personal data with prestored nutritional data” does not render the claim patentable, either, because computer components such as a computer database or nutritional database were “notoriously well-known . . . in the art” at the time of invention, as the Examiner pointed out in the Office Action dated June 19, 1996, which rejected the originally filed claims of the ’115 patent that expressly recited such a database. *Id.* at 30 (citing Ex. 1002, Prosecution History, Paper 4, 15). Hence, Petitioner asserts that none of the limitations of claim 11 add “significantly more” to the abstract idea set forth in the claim. *Id.*

Similar to claim 11, Petitioner asserts claim 1 recites “a handful of generic computer components configured to implement the [abstract] idea.” *Id.* at 32 (citing *Alice*, 134 S. Ct. at 2360). Petitioner argues claim 1 merely dresses up the recited abstract idea with means-plus-function limitations drawn to “well-known” computer input hardware, “conventional” computer processors, and generic output devices such as a “printer” or a “CRT display.” Pet. Reply 13 (citing Ex. 1001, col. 5, ll. 60–64; col. 6, ll. 20–24, 29–31, 60–64; col. 7, ll. 10–14, 22–30). Petitioner further asserts that the

Specification describes “means for inputting personal data” as a “*well known* system for data entry,” such as a magnetic card reader, keypad entry device, touch screen entry system, or barcode reader (Pet. 15 (citing Ex. 1001, col. 5, ll. 60–63) (emphasis by Petitioner)); “barcode means for inputting data” as a “*well known*” barcode reader (*id.* at 15, 23–24 (citing Ex. 1001, col. 6, ll. 17–19, 60–63)); and “means for outputting information” as a printer, audible message speaker, CRT display, LED display, or LCD display, which were also well known (*id.* at 15–16, 24 (citing Ex. 1001, col. 6, ll. 35–36, 60–64; col. 7, ll. 10–14)). Petitioner also asserts that the Specification describes the “processor means” as conventional and well-known devices, such as Intel 8086, 80286, 80386, or 80486 processor, Motorola 68000 series processor, or equivalent processor. *Id.* at 16 (citing Ex. 1001, col. 6, ll. 20–24). Petitioner argues that these limitations do not transform the abstract idea of claim 1 into patent-eligible subject matter because they merely “recite a handful of generic computer components configured to implement the [abstract] idea.” *Id.* at 31–32 (internal quotation marks omitted) (citing *Alice*, 134 S. Ct. at 2360).

During the Oral Hearing, Petitioner argued that the ’115 patent describes these components, including the CRT monitor, for their generic functionality, similar to the way a server was described in the patent at issue in the *TLI* case. Tr. 70:3–10. Noting that the court in *TLI* found such a generic functional description to be insufficient to confer patentability in step two of the *Alice* framework, Petitioner argued that similar descriptions of generic functionality in the ’115 patent similarly do not add “substantially more” required for patent eligibility. *See id.* at 70:17–24, 71:15–23.

Regarding claim 4, Petitioner asserts that claim 4 only adds a “support housing” limitation to claim 1, which is “an insignificant post-solution limitation” that cannot transform the abstract idea claimed in the ’115 patent into a patent-eligible invention. See Pet. 34.

The record supports, and we adopt, Petitioner’s contentions as summarized above.

Patent Owner asserts that step two of the *Alice* analysis is “inapplicable because the ‘core invention’ is not abstract under Part 1” and does not respond to Petitioner’s arguments with specificity. PO Resp. 56. The only argument advanced by Patent Owner as to step two of the *Alice* analysis is that the challenged claims necessarily provide “significantly more” than an abstract concept because the Office allowed the claims and Patent Owner successfully licensed technology covered by the claims. *Id.* at 56–57. In response, Petitioner argues that every patent at issue in a post-grant proceeding was once allowed by the Office and that Patent Owner’s arguments are irrelevant for purposes of patentability analysis under § 101. Pet. Reply 12–13. We agree with Petitioner’s argument and find Patent Owner’s arguments at step two of the *Alice* framework to be unpersuasive.

Although it remains Petitioner’s burden to prove unpatentability by a preponderance of the evidence, in our Scheduling Order, we cautioned Patent Owner that “any arguments for patentability not raised in the response will be deemed waived.” See Paper 11, 4. Aside from its unpersuasive arguments discussed above, Patent Owner elected not to respond separately, with specificity, to Petitioner’s arguments regarding step two of the *Alice* analysis. Thus, we consider only Petitioner’s arguments and evidence at step two of the *Alice* framework.

Upon considering all of the evidence of record, we agree with, and adopt as our own, Petitioner's explanation of why claims 1, 4, and 11 fail to recite any elements that individually or as an ordered combination transform the abstract idea of collecting and correlating information to provide personalized nutritional information of food products to shoppers into a patent-eligible application of that idea.

Dependent Claims 2, 3, 5–10, and 12–20

Petitioner asserts that none of the dependent claims of the '115 patent add any significant limitations to independent claims 1, 4, or 11 to confer patentability. *See* Pet. 35–36. Petitioner argues that limitations recited in a group of dependent claims add only that the abstract idea recited in independent claims is carried out on well-known hardware. *Id.* at 35. For example, Petitioner asserts that claims 2, 8, and 9 recite that the means for outputting information is a CRT monitor or a printer, which are well-known output hardware. *Id.* According to Petitioner, claims 5, 6, and 7 recite well-known “support housings,” such as a kiosk, a check-out unit, and a hand-held unit, whereas claims 18, 19, and 20 recite well-known input hardware such a “magnetically coded card,” a “barcode reader,” and a “keypad entry device.” *Id.*

With respect to these dependent claims, i.e., claims 2, 5–9, and 18–20, we agree with Petitioner that these claims do not include any additional features sufficient to transform the abstract idea claimed in the '115 patent into patent-eligible subject matter because the additional limitations further recited beyond their respective base claims merely recite well-known and conventional hardware as discussed with respect to claim 1, or recite

insignificant post-solution limitations as discussed above with respect to claim 4. *See id.* at 35–36.

Petitioner asserts that another group of dependent claims provides examples of what types of information can be used as input or output in the method or system recited in their base claims. *Id.* at 35. For instance, claims 12–16 recite the types of information to be output by the method of claim 11, such as optional food choices or an individual’s nutrition intake status report. Claims 3, 10, and 17 recite that the input personal data includes an individual’s “medical condition, height, weight, age, gender, nutritional preferences, demographic data or dietary regulated condition.”

With respect to these dependent claims, i.e., claims 3, 10, and 12–17, we agree with Petitioner that these claims are equally abstract and unpatentable as their base claims (*id.* at 35–36) because “merely selecting information, by content [i.e., information type] or source, for collection, analysis, and display does nothing significant to differentiate a process from ordinary mental processes, whose implicit exclusion from § 101 undergirds the information-based category of abstract ideas.” *Elec. Power Grp.*, 2016 WL 4073318, at *4.

3. Conclusion

Upon considering all of the evidence of record, we determine that Petitioner has demonstrated, by a preponderance of evidence, that claims 1–20 are unpatentable under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

D. Asserted Ground Based on 35 U.S.C. § 112

Claims 1 and 4 recite “processor means under the control of a prestored computer program for correlating the personal data with prestored nutritional data, including a barcode address, pertinent to the at least one food product which said shopper has selected or specified, or has purchased or consumed” (“processor means limitation”). Petitioner asserts this processor means limitation is subject to 35 U.S.C. § 112, ¶ 6 and that claims 1–10 are unpatentable as being indefinite under 35 U.S.C. § 112, ¶ 2 because the Specification fails to disclose a sufficient algorithm for performing the “correlating” function recited in the processor means limitation. Pet. 36–39.

1. Whether 35 U.S.C. § 112, ¶ 6 Applies

The use of “means” in a limitation, as is the case here, triggers a rebuttable presumption that the limitation is written in a means-plus-function format under 35 U.S.C. § 112, ¶ 6. *TriMed, Inc. v. Stryker Corp.*, 514 F.3d 1256, 1259 (Fed. Cir. 2008) (citation omitted). If, in addition to the word “means” and the functional language, the claim recites sufficient structure for performing the described functions in their entirety, the presumption is overcome, and § 112, ¶ 6 does not apply. *Id.* “Sufficient structure exists when the claim language specifies the exact structure that performs the functions in question without need to resort to other portions of the specification or extrinsic evidence for an adequate understanding of the structure.” *Id.* at 1259–60.

Petitioner asserts that the processor means limitation recited above should be construed as a means-plus-function limitation under 35 U.S.C. § 112, ¶ 6 because nothing in claims 1 and 4 conveys any structure for performing the recited function, which is “correlating the personal data with

prestored nutritional data, including a barcode address, pertinent to the at least one food product which said shopper has selected or specified, or has purchased or consumed.” Pet. 37–38. Petitioner argues the “processor means,” instead, is defined only in terms of the functions it performs. *Id.* at 38.

Patent Owner asserts that “the disputed claim is sufficiently content rich that it falls outside 35 U.S.C. § 112, ¶ 6.” PO Resp. 39. The only “structure” Patent Owner identifies, however, is “a general purpose computer.” *Id.* at 39–40. Patent Owner comments that the use of the word “means” in claims 1 and 4 was “an unfortunate syntactic choice by the patentee” and offers new claim language written by Mr. Shepley that does not use the word “means” to argue that the processor means limitation need not be construed under § 112, ¶ 6 because a reasonable alternative exists that is not drafted in a means-plus-function format. *Id.* at 39–40 & n.18 (citing Ex. 2005 ¶ 38).³

Patent Owner’s argument is unpersuasive because Patent Owner fails to identify “the exact structure [specified in the claim language] that performs the functions in question without need to resort to other portions of the specification or extrinsic evidence for an adequate understanding of the

³ The absence of the word “means” in a claim term does not necessarily guarantee § 112, ¶ 6 does not apply, but, rather, merely triggers a rebuttable presumption that § 112, ¶ 6 does not apply. *Apex Inc. v. Raritan Comp., Inc.*, 325 F.3d 1364, 1371–72 (Fed. Cir. 2003). That presumption against means-plus-function treatment can be overcome “if the challenger demonstrates that the claim term fails to ‘recite sufficiently definite structure’ or else recites ‘function without reciting sufficient structure for performing that function.’” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349 (Fed. Cir. 2015) (en banc in relevant part) (citation omitted).

structure.” See *TriMed*, 514 F.3d at 1259–60. Contrary to Patent Owner’s contention, we discern no “general purpose computer” recited in the processor means limitation. Rather, the “general purpose computer” identified by Patent Owner is at best the corresponding structure described in the Specification. Thus, Patent Owner’s argument does not overcome the presumption in favor of means-plus-function treatment. By this finding, we do not suggest that Patent Owner bears the burden of showing patentability of the claims by proving that the term is not subject to § 112, ¶ 6. The burden of demonstrating unpatentability remains with and never shifts from Petitioner. We find merely that Patent Owner’s argument fails show that the presumption for means-plus-function treatment is overcome because Patent Owner does not present sufficient evidence to support its argument. We, on the other hand, agree with Petitioner’s explanation that the presumption in favor of means-plus-function treatment is maintained. On this record, we are persuaded that the limitation at issue is a means-plus-function limitation because the term “means” is modified by functional language, and the term “means” is not modified by sufficient structure recited in the claims to perform the recited function. Consequently, this means-plus-function limitation requires construction under 35 U.S.C. § 112, ¶ 6.

2. Indefiniteness

Construing a means-plus-function limitation requires first defining the particular function of the limitation and then identifying the corresponding structure for that function in the specification. *Golight Inc. v. Wal-Mart Stores Inc.*, 355 F.3d 1327, 1333–34 (Fed. Cir. 2004). The corresponding structure of a means-plus-function limitation, however, must be “more than simply a general purpose computer or microprocessor” to avoid

impermissible functional claiming. *Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008). If the function is performed by a general purpose computer or microprocessor, the specification, in general, must disclose the algorithm that the computer performs to accomplish that function. *Media Rights Techs., Inc. v. Capital One Financial Corp.*, 800 F.3d 1366, 1374 (Fed. Cir. 2015) (citing *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1367 (Fed. Cir. 2008)); *Triton Tech of Texas, LLC v. Nintendo of Am., Inc.*, 753 F.3d 1375, 1378 (Fed. Cir. 2014) (citing *Aristocrat*, 521 F.3d at 1333). Failure to disclose the corresponding algorithm for a computer-implemented means-plus-function term generally renders the claim indefinite under 35 U.S.C. § 112, ¶ 2. *Media Rights*, 800 F.3d at 1374–75; *Triton Tech*, 753 F.3d at 1378 (citing *Ergo Licensing LLC v. CareFusion 303, Inc.*, 673 F.3d 1361, 1363 (Fed. Cir. 2012)); *Aristocrat*, 521 F.3d at 1331, 1333, 1337–38.

Petitioner asserts that the Specification describes the “processor means” recited in the limitation at issue as nothing more than a “conventional” processor. Pet. 37–38 (citing Ex. 1001, col. 6, ll. 20–24). Petitioner argues claims 1–10 are, therefore, indefinite unless the Specification describes an algorithm for performing the recited function. *Id.* at 38. Petitioner asserts that the ’115 patent Specification contains no disclosure at all regarding how the conventional processor and the prestored program “correlat[e] the personal data with prestored nutritional data, including a barcode address.” *Id.* (internal quotation marks omitted). According to Petitioner, the Specification contains no flow chart, mathematical function, or prose describing what steps the processor means should perform to accomplish the recited correlating function. *Id.* Petitioner

asserts that the '115 patent does not disclose a “step-by-step procedure” teaching how a processor might be programmed to correlate the personal data with prestored nutritional data. *Id.* at 39 (citing *Triton Tech*, 753 F.3d at 1378–79 (requiring a “step-by-step procedure”)). Therefore, Petitioner asserts that claims 1–10 are indefinite under § 112, ¶ 2 because they lack algorithmic support for the processor means limitation required under § 112, ¶ 6. *Id.* at 39–40.

As an initial matter, Patent Owner asserts that *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014) controls and that no disclosure of an algorithm for performing the claimed function is required for computer-implemented functions, such as the “correlating” function recited in the processor means limitation of claims 1 and 4. *See* PO Resp. 58–63. Petitioner disagrees and cites a post-*Nautilus* Federal Circuit case for the proposition that the requirement for algorithmic support, where a patent is drawn to a general purpose computer performing certain functions, remains unchanged after *Nautilus*. Pet. Reply 16–19 (citing *EON Corp. IP Holdings LLC v. AT & T Mobility LLC*, 785 F.3d 616, 623 (Fed. Cir. 2015)). We agree with Petitioner that *Nautilus* did not change this requirement. In *Media Rights*, the Federal Circuit evaluated the definiteness requirement of § 112, ¶ 2 as interpreted by *Nautilus*, and required algorithmic support for computer-implemented functions recited in a mean-plus-function limitation subject to § 112, ¶ 6. *Media Rights*, 800 F.3d at 1374–75.

Next, Patent Owner asserts that, even if disclosure of an algorithm is required, the Specification describes the algorithm for performing the correlating function. PO Resp. 66–67 (quoting Ex. 1001, col. 6, ll. 21–42). The passages quoted by Patent Owner are reproduced below:

The processor 18 correlates the personal data input by the individual with prestored nutritional data pertinent to the food product which the individual intends to purchase pursuant to a prestored computer program. . . . This information is stored in a relational nutritional database (NDB) to be described in greater detail below.

Ex. 1001, col. 6, ll. 24–30.

The correlated data output will include information and/or recommendations regarding the particular food choices of the individual. For example, if an individual is a diabetic, the system will inform him or her whether any of the chosen foods contain sugars or glucose. The system can be utilized to provide a variety of nutritional information.

Id. at col. 6, ll. 37–42. Patent Owner asserts that, because “the crux of the invention” is the “identification of the three elements to be correlated, and not the precise manner of correlation”—that is, “knowing *what to correlate*,” rather than how to correlate—identification of the three elements, combined with the term “correlating,” is a “sufficiently explicit algorithm.” PO Resp. 66–67 & n.31.

Petitioner asserts that Patent Owner’s Response points to nothing in the Specification that recites an algorithm for performing the correlating function. Pet. Reply 16. Petitioner argues that the passages quoted by Patent Owner describe “what the missing algorithm’s *input* or *output* might be,” but nothing in the passages explains how the “processor means” accomplishes the correlating function. *Id.* at 16–17. We agree with Petitioner’s analysis of the passages reproduced above. We also note Patent Owner acknowledges that what is described in those passages is “what to correlate,” not how to correlate. PO Resp. 67 n.31. In other words, what is described is the input and output of the correlating function, treating the

correlating function basically as a black box. We agree with Petitioner that this black box does not disclose a sufficient algorithm. Pet. Reply 17, 19. Contrary to Patent Owner's argument, the '115 patent's description of "what to correlate" does not constitute sufficient disclosure of an algorithm instructing how to perform the correlating function. See *Media Rights*, 800 F.3d at 1375 (finding that the specification did not disclose sufficient algorithm for the "monitoring" function because the cited portion of the specification provided no detail about the rules of the algorithm).

Next, Patent Owner asserts that a person of ordinary skill in the art would know how to perform the correlating function as long as he or she knows what to correlate. PO Resp. 67–68 & n.31. In support of its argument, Patent Owner offers the testimony of Mr. Shepley, the inventor of the '115 patent. PO Resp. 67–68 (citing Ex. 2005 ¶¶ 31, 32, 43). In addition, Patent Owner cites Mr. Shepley's grant proposal to the U.S. Department of Health and Human Services' Small Business Innovation Research (SBIR) program as evidence of how one of ordinary skill in the art would know "what steps are require[d]" to perform the correlating function. PO Resp. 59–60, 67 n.31 (citing Ex. 2003).

Regarding the testimony of Mr. Shepley, Petitioner asserts that "a person of ordinary skill in the art plays no role whatsoever in determining whether an algorithm must be disclosed as structure for a functional claim element." Pet. Reply 17–18 (citing *EON*, 785 F.3d at 623).

We give little or no weight to the testimony of Mr. Shepley because he is not a neutral declarant uninterested in the outcome of this proceeding. In fact, the Shepley Declaration (Ex. 2005) does not state he has no stake in the outcome of this proceeding or any related litigation or proceedings.

Furthermore, in paragraphs 31 and 32 of the Shepley Declaration cited by Patent Owner, Mr. Shepley merely states that the algorithm specified in the claims and the Specification is sufficiently clear to him but does not identify or describe what the specified algorithm is. See Ex. 2005 ¶¶ 31, 32. Thus, these two paragraphs are unpersuasive even if we were to give them weight. In paragraph 43, Mr. Shepley makes an argument as “Patent Owner” that “the patent’s present algorithm is clear enough” in the context of “the whole invention and the scope of the industry at that time.” *Id.* at ¶ 43. Hence, we accord no weight to paragraph 43 of the Shepley Declaration because it is a party argument from Patent Owner, not opinion testimony. As discussed above, we agree with Petitioner that the Specification does not disclose a sufficient algorithm for performing the correlating function. Nothing in the Shepley Declaration compels changing this assessment.

With respect to Exhibit 2003, Mr. Shepley’s SBIR grant proposal, Petitioner argues that extrinsic evidence such as Exhibit 2003 cannot be used to show sufficient disclosure of an algorithm because it must be shown that “*the specification* contains a sufficiently precise description of the corresponding structure” to satisfy § 112 ¶ 6. Paper 21 at 5–6 (citing *EON*, 785 F.3d at 623). We agree with Petitioner’s argument and determine that Exhibit 2003 does not demonstrate sufficient disclosure of an algorithm in the Specification under § 112, ¶ 6.

Patent Owner next asserts that the claims are not indefinite because the *Katz* exception applies. PO Resp. 68–69. Patent Owner argues that, like *Katz*, the “correlating” of the various elements by a general purpose computer need not be further explained by a detailed algorithm to one skilled in the art. *Id.* at 69.

Petitioner asserts that the *Katz* exception does not apply because it applies only when where the function can be achieved by merely “plugging in a general-purpose computer,” and not where “special programming” is required. Pet. Reply 19–20 (citing *Ergo Licensing, LLC v. CareFusion 303, Inc.*, 673 F.3d 1361, 1365 (Fed. Cir. 2012)). Petitioner argues that, in this case, the claims expressly require “processor means under the control of a *prestored computer program*,” i.e., the claim language requires explicitly a special computer program that is preloaded on the general purpose computer. *Id.* at 20.

We are persuaded by Petitioner’s argument that the claims require explicitly a special computer program to perform the correlating function and, therefore, the *Katz* exception does not apply. Furthermore, under *Katz*, a microprocessor (such as the “processor means” described in the ’115 patent) can serve as structure for a computer-implemented function (i.e., disclosure of an algorithm is not necessary) only where the claimed function is “coextensive” with a microprocessor itself, such as “receiving” data, “storing” data, and “processing” data. *In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303, 1316 (Fed. Cir. 2011). Patent Owner cites no credible evidence to show the “correlating” function is “coextensive” with the processor itself. We determine that the “correlating” function is not “coextensive” with the “conventional” processor described in the Specification (Ex. 1001, col. 6, ll. 20–28) because, as noted by Petitioner, the claims explicitly require a prestored computer program to perform the correlating function.

Therefore, we are persuaded that that the Specification does not disclose a sufficient algorithm for performing the correlating function to

satisfy § 112, ¶ 6. Accordingly, upon considering all of the evidence of record, we determine that Petitioner has demonstrated, by a preponderance of evidence, that claims 1–10 are unpatentable as being indefinite under 35 U.S.C. § 112, ¶ 2.

E. Petitioner’s Motion to Exclude Evidence

Petitioner moves to exclude portions of Exhibit 2005 and Exhibits 2001 and 2003 in their entirety. *See* Paper 21. As the movant, Petitioner bears the burden of proof to establish that it is entitled to the relief requested—namely, that the material sought to be excluded is inadmissible under the Federal Rules of Evidence. *See* 37 C.F.R. §§ 42.20(c), 42.62(a).

We find it unnecessary to consider Petitioner’s objections to the admissibility of Exhibits 2001, 2003, and 2005. As discussed above, even taking Patent Owner’s challenged exhibits into account, we have determined that Petitioner has demonstrated, by a preponderance of the evidence, that the challenged claims of the ’115 patent are unpatentable. Therefore, the evidentiary issues raised by Petitioner regarding the challenged exhibits are moot. Accordingly, Petitioner’s Motion to Exclude Evidence is *dismissed* as moot.

IV. CONCLUSION

Petitioner has met its burden of proof, by a preponderance of the evidence, in showing that claims 1–20 of the ’115 patent are unpatentable based on the following grounds of unpatentability:

A. Claims 1–20 as being directed to patent-ineligible subject matter under 35 U.S.C. § 101; and

B. Claims 1–10 as indefinite under 35 U.S.C. § 112, second paragraph.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–20 of the '115 patent are unpatentable;

FURTHER ORDERED that Petitioner's Motion to Exclude Evidence is *dismissed* as moot; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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CBM2015-00071

Patent 5,841,115

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