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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARYBETH AHERN and MICHAEL J. LAW

Appeal 2014-009332
Application 13/471,867¹
Technology Center 3600

Before HUBERT C. LORIN, CYNTHIA L. MURPHY, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Marybeth Ahern and Michael J. Law (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–22. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and enter a NEW GROUND OF REJECTION.

¹ The Appellants identify International Business Machines Corporation as the real party in interest. App. Br. 2.

THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for providing a service for tracking and managing changes, the method comprising the steps of:

providing a hierarchical visual management tool implemented in a processor and operable to automatically manage and update relational information within a hierarchy, wherein:

the relational information comprises at least one goal, one or more values, one or more strategic capabilities, and one or more resources, and

the relational information are manipulated by a user via a graphical user interface, which is configured to display each level of the hierarchy such that a hierarchy tree is maintained for the user's visual relational comprehension;

establishing the at least one goal for establishing an endpoint of an evolutionary change to an enterprise architecture;

associating the one or more values that define requirements of the evolutionary change with the at least one goal;

affiliating with the one or more values, the one or more strategic capabilities that represent functions that are present to support the one or more values;

identifying the one or more resources that represent enterprise components with the one or more strategic capabilities;

defining one or more metrics to gauge performance for each of the one or more resource's contributions to a parent node within the hierarchy tree comprising the one or more values; and

hierarchically maintaining and updating relationships of the at least one goal, the one or more values, the one or more strategic capabilities and the one or more resources, wherein the hierarchically maintaining and updating the relationships comprises:

assigning weights to each of the one or the one or more resource's contributions to a qualitative value of the parent node;

estimating iteratively the qualitative value of the parent node for various options comprising different combinations of the one or more resources based on the defined one or more metrics and the assigned weights for each of the one or more resources;

selecting the one or more strategic capabilities for delivery of the one or more values based on an optimum qualitative value; and

updating the hierarchy tree to include a hierarchical relationship between at least the parent node comprising the one or more values, the selected one or more strategic capabilities, and the one or more resources that provided the optimum qualitative value.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Bardasz	US 5,689,711	Nov. 18, 1997
Hatcher	US 7,752,070 B2	July 6, 2010
Eder	US 2012/0158633 A1	June 21, 2012

Ricardo Chalmeta, Christina Campos, and Reyes Grangel, *References architectures for enterprise integration*, *Journal of Systems and Software* 57 (2001) 175–191 (hereinafter “Chalmeta”).

Peter Triantafillou et al., *Towards High Performance Peer-to-Peer Content and Resource Sharing Systems*, *CIDR Conference* 1–22 (2003) (hereinafter “Triantafillou”).

Ajit K Patankar and Sadashiv Adiga, *Enterprise integration modelling: a review of theory and practice*, *Computer integrated manufacturing systems* Vol. 8. No.1, 21–34 (1995) (hereinafter “Pankar”).

Sirkka L. Jarvenpaa and Donna B. Stoddard, *Business Process Redesign: Radical and Evolutionary Change*, *Journal of Business Research* 41, 15–27 (1998) (hereinafter “Jarvenpaa”).

The following rejections are before us for review:

1. Claims 1, 3–6, 9–17, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chalmeta, Bardasz, and Triantafillou.
2. Claims 2, 7, 8, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chalmeta, Bardasz, Triantafillou, and Patankar.
3. Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chalmeta, Bardasz, Triantafillou, Eder, and Hatcher.
4. Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chalmeta, Bardasz, Triantafillou, Eder, Hatcher, and Jarvenpaa.

ISSUES

Did the Examiner err in rejecting claims 1, 3–6, 9–17, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Chalmeta, Bardasz, and Triantafillou; claims 2, 7, 8, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Chalmeta, Bardasz, Triantafillou, and Patankar; claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Chalmeta, Bardasz, Triantafillou, Eder, and Hatcher; and claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Chalmeta, Bardasz, Triantafillou, Eder, Hatcher, and Jarvenpaa?

ANALYSIS

The independent claims are claims 1 and 12. Independent claim 1 includes the limitations:

assigning weights to each of the one or the one or more resource's contributions to a qualitative value of the parent node;

estimating iteratively the qualitative value of the parent node for various options comprising different combinations of the one or more resources based on the defined one or more metrics and the assigned weights for each of the one or more resources;

(App. Br. 33, Claims Appendix). Claim 12 contains similar limitations.

The Examiner finds the “assigning” and “estimating” limitations in Triantafillou in phase 3 and phase 4, respectively, described at page 9 (Final Act. 10–11; Ans. 8–9).

The Appellants contend that the cited portions of Triantafillou do not disclose these limitations (App. Br. 7–9). According to the Appellants:

Triantafillou does not calculate a value for the leader node in the cluster (the Examiner's interpretation of a parent node) based on the values of the other nodes (the Examiner's interpretation of one or more resources), nor does Triantafillou estimate qualitative values based on various combinations of the weights for the nodes in the cluster.

(App. Br. 8).

We agree with the Appellants that the cited passages of Triantafillou do not disclose these limitations. Phase 3 of Triantafillou discloses that the leader of a cluster “measures the fairness index value” and compares it to a fairness threshold to determine whether rebalancing (phase 4) is entered. There is no disclosure that the members of a cluster contribute anything to a

“qualitative value” of the cluster leader. Phase 4 of Triantafillou discloses an iterative algorithm for rebalancing the load among clusters by iterating over all clusters “c” and every semantic category “s” and reassigning semantic categories to new clusters (first by doing “dummy reassigns” and then “actually reassign[ing]” the clusters to categories) until a fairness threshold or maximum number of moves is reached. Although this process is iterative and based on the popularity of each cluster, we see no evidence of estimating a qualitative value of a parent node (*i.e.*, leader of a cluster) as required by the claim.

A prima facie case of obviousness has not been made out in the first instance by a preponderance of the evidence. Accordingly, the rejections are not sustained.

NEW GROUND OF REJECTION

Claims 1–22 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Alice Corp. Pty. Ltd. v. CLS Bank Int’l, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under §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. *Id.* at 2355.

Taking claim 1 as representative of the claims on appeal, the claimed subject matter is directed to a method of organizing an enterprise according to goals, values, strategic capabilities, and resources. Organizing an

enterprise according to goals, values, strategic capabilities, and resources is a method of organizing human activity and/or fundamental economic practice. As such it is an abstract idea.

Step two of *Alice* 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.” *Id.* at 2355 (citation omitted).

We see nothing in the subject matter claimed that transforms the abstract idea of organizing an enterprise according to goals, values, strategic capabilities, and resources into an inventive concept.

The method of claim 1 includes seven steps of providing a GUI (“hierarchical visual management tool”), identifying a first information (“establishing the at least one goal”), identifying a second information (“associating the one or more values”), identifying a third information (“affiliating with the one or more value”), identifying a fourth information (“identifying the one or more resources”), identifying a fifth information (“defining one or more metrics”), and “hierarchically maintaining and updating relationships” among the gathered information. Claim 12 is directed to a system that performs similar steps.

All of the claim limitations are well-understood, routine, conventional activities previously known to the industry. The identification steps are known information gathering operations for obtaining desired information about an enterprise (goals, values, strategic capabilities, and resources) and thus add little to patentably transform the abstract idea of organizing an

enterprise. Providing a GUI and maintaining relationships are also well-known, conventional practices.

Furthermore, each of the providing, information gathering, and maintaining steps are themselves abstract ideas. For example, providing a multi-level visual user interface that manipulates business information maintained in a database is an abstract idea. *See Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1339 (Fed. Cir. 2013) (claim to maintaining an “insurance transaction database containing information related to an insurance transaction decomposed into a plurality of levels” and “allowing an authorized user to edit . . . and to update the information related to the insurance transaction” held to be an abstract idea). Maintaining a hierarchy is also an abstract idea. *See Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1333 (Fed. Cir. 2015), cert. denied, 136 S. Ct. 2510 (2016) (“using organizational [. . .] hierarchies to determine a [value] is an abstract idea that has no particular concrete or tangible form or application”). Iteratively updating information in a database is also an abstract idea. *See In re: Mario Villena, Jose Villena*, No. 2016-1062, 2016 WL 5940056 (Fed. Cir. 2016) (repeatedly updating “automatic valuation method” is an abstract idea). Merely combining several abstract ideas does not render the combination any less abstract. *Cf. Shortridge v. Found. Constr. Payroll Serv., LLC*, No. 14-CV-04850-JCS, 2015 WL 1739256, *11 (N.D. Cal. Apr. 14, 2015), *aff’d*, No. 2015-1898, 2016 WL 3742816 (Fed. Cir. July 13, 2016).

Finally, we note that claim 1 calls for the recited instructions to be “implemented in a processor.” Dependent claims 7, 11, and 18 also specify

that the information is maintained in a database. But any general-purpose computer and generic database available at the time the application was filed would have satisfied these limitations. The Specification supports that view. *See, e.g.*, paragraph 41 of the Specification (“the invention may be implemented on various computer platforms and may include various types of database systems to provide for data store and retrieval”). “[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea ‘while adding the words ‘apply it’ is not enough for patent eligibility.” *Alice* at 2358.

For the foregoing reasons, we find that claim 1 covers subject matter that is judicially-excepted from patent eligibility under § 101. The other independent claim – system claim 12 parallels claim 1 – similarly covers claimed subject matter that is judicially-excepted from patent eligibility under § 101. The dependent claims describe various information gathering and maintaining schemes which do little to patentably transform the abstract idea.

Therefore, we enter a new ground of rejection of claims 1–22 under 35 U.S.C. § 101.

CONCLUSIONS

The rejection of claims 1, 3–6, 9–17, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Chalmeta, Bardasz, and Triantafillou is reversed.

The rejection of claims 2, 7, 8, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Chalmeta, Bardasz, Triantafillou, and Patankar is reversed.

The rejection of claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Chalmeta, Bardasz, Triantafillou, Eder, and Hatcher is reversed.

The rejection of claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Chalmeta, Bardasz, Triantafillou, Eder, Hatcher, and Jarvenpaa is reversed.

Claims 1–22 are newly rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

DECISION

The decision of the Examiner to reject claims 1–22 is reversed.

Claims 1–22 are newly rejected.

NEW GROUND

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that the Appellant(s), WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

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(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

REVERSED; 37 C.F.R. § 41.50(b)