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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/019,528	02/02/2011	William D. Goldberg	RSW920040016US2	1639

43168 7590 08/01/2017
LAW OFFICE OF MARCIA L. DOUBET, P. L.
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EXAMINER

ANDERSON, FOLASHADE

ART UNIT	PAPER NUMBER
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3623

NOTIFICATION DATE	DELIVERY MODE
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08/01/2017

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM D. GOLDBERG, WILLIAM E. HUTSON,
and CHRISTOPHER H. WICHER

Appeal 2015-006930
Application 13/019,528
Technology Center 3600

Before: MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and
MICHAEL W. KIM, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE¹

Appellants seek our review under 35 U.S.C. § 134 from the
Examiner's final rejection of claims 1, 4–6, 9–11, and 14–18.

We affirm.

¹ The Appellants identify International Business Machines Corp. the real party in interest. Appeal Br. 4.

THE CLAIMED INVENTION

Appellants' claims are generally directed to "making resource placement decisions in an objective manner." Spec. para. 3.

Claim 1 is illustrative of the claimed subject matter:

1. A method of validating placement of product resources in a selected location, comprising:

using computer-readable program code executed by a computer to programmatically create a product profile for the product resources, the product profile specifying an importance value assigned to each of a first plurality of assessment criteria and to each of a second plurality of the assessment criteria, the assessment criteria usable for assessing placement of product resources for a product in an arbitrary location, as if the selected location had not been selected, the first plurality pertaining to locally-available skills for the product and the second plurality pertaining to a marketplace of the product;

using computer-readable program code executed by the computer to programmatically create a geography profile for the selected location, the geography profile specifying a score assigned to each of the first plurality of the assessment criteria and to each of the second plurality of the assessment criteria, each score in the geography profile assigned to indicate how well the selected location meets the assessment criterion to which the score is assigned;

using computer-readable program code executed by the computer to programmatically compute a skills gap score for the selected location, further comprising:

computing a plurality of skills gap values for the selected location by subtracting, for each of the first plurality of the assessment criteria, the score assigned to the assessment criterion in the geography profile from the importance value assigned to the assessment criterion in the product profile, and setting any negative differences of the computed skills gap values to zero; and

summing each of the computed skills gap values to yield the skills gap score;

using computer-readable program code executed by the computer to programmatically compute an opportunity gap score for the selected location, further comprising:

computing a plurality of opportunity gap values for the selected location by subtracting, for each of the second plurality of the assessment criteria, the importance value assigned to the assessment criterion in the product profile from the score assigned to the assessment criterion in the geography profile, and setting any negative differences of the computed opportunity gap values to zero; and

summing each of the computed opportunity gap values to yield the opportunity gap score;

comparing the programmatically-computed skills gap score to a benchmark skills gap score in previously-determined benchmark values and the programmatically-computed opportunity gap score to a benchmark opportunity gap score in the previously-determined benchmark values; and

generating a recommendation to place the product resources in the selected location if the comparing determines that the previously-determined benchmark values are met.

REJECTION

The following rejection is before us for review. The Examiner rejected claims 1, 4–6, 9–11, and 14–18 under 35 U.S.C. § 101 as reciting ineligible subject matter in the form of an abstract idea.

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence.

1. The Specification describes “a set of assessment criteria are determined.” (Spec. para. 43).
2. The Specification describes the “relative importance to the product under evaluation, or the relative significance or strength, of appropriate ones of the criteria is preferably determined (Block 305), and a numeric

value is preferably assigned accordingly, thereby forming what is referred to herein as a ‘product profile’.” (*Id.* para. 45).

3. The Specification describes “objective measurements for each criterion are determined” and that “the set of values assigned to each candidate location are referred to herein as a ‘geography profile’.” (*Id.* para. 46).
4. The Specification describes “a set of skill gap numbers is computed by subtracting each geography profile value from the corresponding product profile value for each criteria that pertains to local skills.” (*Id.* para. 69).
5. The Specification describes that “a set of opportunity gap numbers is computed by subtracting a product profile value from the corresponding geography profile value for each criteria that pertains to the marketplace.” (*Id.* para. 78).
6. The Specification describes that “a single location may be compared against benchmark values that represent (for example) a hypothetical location or a location in which resources for this product have already been placed.” (*Id.* para. 91).
7. The Specification describes that “each block of the flowchart illustrations and/or block diagrams, and combinations of blocks in the flowchart illustrations and/or block diagrams, can be implemented by computer program instructions. These computer program instructions may be provided to a processor of a general purpose computer.” (*Id.* para. 95).

ANALYSIS

The Examiner finds the claims “are directed to the abstract idea of a method of organizing human activities (decisions regarding resource placement) around a fundamental economic practice (market expansion) using a mathematical relationship or formula (skills and opportunity gaps).”
Final Act. 3.

Appellants argue the “claims do not recite a mathematical relationship or formula, nor do they recite a fundamental or long-standing commercial or economic practice,” but instead recite a “detailed and specific way of solving a specific problem,” and “the Office Action fails to demonstrate that the[] claimed invention, as recited in the independent claims, was in any way considered ‘long-prevalent’.” (Appeal Br. 21–24, emphasis omitted). Appellants also argue the claims are not a method of organizing human activities, because “the Office Action fails to cite any source establishing that it was known for humans to perform these specific subtractions, sums, comparisons, and generation of recommendations recited in Appellants' independent claims.” (*Id.* 23).

We are not persuaded by Appellants’ arguments.

Exemplary claim 1 recites “method of validating placement of product resources.” That method involves a number of steps, such as creating product and geography profiles, computing and summing skills gaps for particular locations, comparing the computed value to a benchmark value, and generating a recommendation if the benchmark values are met by the computed value.²

² These limitations are also recited in independent claims 6 and 11 in one form or another.

Appellants argue claim 1 is directed to:

validating placement of product resources in a selected location by analyzing assessment criteria information stored in a product profile and in a geography profile, computing gaps in skills and opportunity, and recommending to place the resources in the location only if the computed gaps meet respective predetermined benchmark values.

Id. 20.

In both cases, the claims involve directing a particular analysis that may lead to making a recommendation based on the analysis, which we are persuaded is a method of organizing human activities, as asserted by the Examiner.

In addition, except for the recitation of “using computer-readable program code executed by the computer to programmatically” execute each step in the method, each step could otherwise be performed entirely through mental thought. Specifically, each of the steps of determining (FF 1–3), computing using subtraction and addition (FF 4, 5), and comparing (FF 6) that are described in the Specification, and recited in the claims, involve no more than basic mental steps.

The Federal Circuit has held that if a method can be performed by human thought alone, or by a human using pen and paper, it is merely an abstract idea and is not patent-eligible under § 101. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) (“[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.”). Additionally, mental processes, e.g., computing a score, as recited in claim 1, remain unpatentable even when automated to reduce the burden on the user of what once could have been done with pen and paper. *Id.* at 1375 (“That purely mental processes can be

unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*, [409 U.S. 63 (1972)].”).

Notwithstanding, claim 1 results in “generating a recommendation to place the product resources in the selected location if the comparing determines that the previously-determined benchmark values are met.” We are persuaded that successful allocation of product resources is a fundamental economic practice, because it is based on the sound business practice of insuring a successful value chain. *See Alice Corp., Pty. Ltd. v CLS Bank Intl*, 134 S.Ct. 2355-57 (2014).

We, thus, are persuaded that claim 1 is directed to an abstract idea.

Turning to the second step of the *Alice* analysis, because we find that claim 1 is directed to an abstract idea, the claim must include an “inventive concept” in order to be patent-eligible, i.e., there must be an element or combination of elements that is sufficient to ensure that the claim in practice amounts to significantly more than the abstract idea itself.

Appellants argue the claim recites “significantly more” than an abstract idea because it recites specific, unconventional steps, and how to perform them, beyond what the claim is allegedly directed to, and “provide an improvement to validating resource placement which can now use specific computations.” Appeal Br. 25–31.

Other than the steps of claim 1, each of which could be performed by mental thought, the claim merely recites that the steps be performed “using computer-readable program code executed by the computer to programmatically.” The Specification, however, describes that each step in the method could be performed using a generic computer. (FF 7). However,

“after *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible. The bare fact that a computer exists in the physical rather than purely conceptual realm is beside the point.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (internal citations and quotation marks omitted).

Nothing in claims 1–10 purports to improve computer functioning or “effect an improvement in any other technology or technical field.” *Alice*, 134 S. Ct. at 2359. Nor do claims solve a problem unique to the Internet. *See DDR Holdings*, 773 F.3d at 1257. The claims also are not adequately tied to “a particular machine or apparatus.” *Bilski v. Kappos*, 561 U.S. 593, 601 (2010).

Because claim 1 is directed to an abstract idea, and nothing in the claim adds an inventive concept, we are persuaded that the claim is not patent-eligible under § 101. Therefore, we sustain the Examiner’s rejection of claim 1 under 35 U.S.C. § 101. In addition, because dependent claims 4, 5, and 16–18 do not alter the analysis, we sustain the rejection of these dependent claims under 35 U.S.C. § 101 as well.

We find no meaningful distinction between independent method claim 1, and either independent system claim 6 or independent medium claim 13. The claims all are directed to the same underlying invention. Therefore, we also sustain the rejection of independent claims 6 and 13 under § 101. As the Federal Circuit has made clear, “the basic character of a process claim drawn to an abstract idea is not changed by claiming only its performance by computers, or by claiming the process embodied in program instructions on a computer readable medium.” *See CyberSource*, 654 F.3d at 1375-76

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(citing *In re Abele*, 684 F.2d 902 (CCPA 1982)). Because we find that dependent claims 9, 10, 14, and 15 lack additional elements that would render the claims patent-eligible, we also sustain the rejection under § 101 of these dependent claims on the same basis as the independent claims from which they depend.

CONCLUSIONS OF LAW

The Examiner did not err in rejecting claims 1, 4–6, 9–11, and 14–18 under 35 U.S.C. § 101 as reciting ineligible subject matter.

DECISION

For the above reasons, the Examiner’s rejection of claims 1, 4–6, 9–11, and 14–18 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)(1)(iv).

AFFIRMED