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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JONATHAN WILLIAM ADAMS,
GEORGE M. GALAMBOS, SRINIVAS KOUSHIK, and
GURUPRASAD CHITRAPUR VASUDEVA

Appeal 2015-007294¹
Application 11/621,852
Technology Center 3600

Before: MEREDITH C. PETRAVICK, MICHAEL W. KIM, and
NINA L. MEDLOCK *Administrative Patent Judges.*

KIM, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 3–7. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6.

The invention relates to methods and systems for the architectural designing of e-business solutions. Spec. ¶ 2.

¹ The Appellants identifies “International Business Machines Corporation.” as the real party in interest. Appeal Br. 2.

Independent claim 3 is illustrative:

3. A computer readable storage medium including computer readable code executable on a computer for designing an architecture for an e-business solution, the computer readable medium comprising:

computer readable code for developing a business description of the e-business solution;

computer readable code for developing a pictorial representation of the business description;

computer readable code for establishing one or more business patterns that are identifiable within the pictorial representation, each business pattern being indicative of each grouping of one or more actors and one or more business functions based on a nature of the interaction among the one or more actors and the one or more business functions;

computer readable code for establishing one or more integration patterns that are identifiable within the pictorial representation, each integration pattern being indicative of an integration of two or more business patterns;

computer readable code for establishing one or more composite patterns that are identifiable within the pictorial representation, each composite pattern being indicative of a grouping of a recurring combination of one or more business patterns and one or more integration patterns;

computer readable code for establishing one or more application patterns that are identifiable within the pictorial representation, each application pattern being indicative of a partitioning of an application logic and a data together with styles of interaction among a plurality of logical tiers; and

computer readable code for depicting each business pattern within the pictorial representation.

Claims 3–7 are rejected under 35 U.S.C. § 101 as failing to recite statutory subject matter.

We AFFIRM.

ANALYSIS

We are unpersuaded the Examiner erred in asserting that claims 3–7 do not recite patent-eligible subject matter under 35 U.S.C. § 101. App. Br. 13–20; Reply Br. 1–6.

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In determining whether a claim falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. *See Alice*, 134 S. Ct. at 2356 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (“Analyzing respondents’ claims according to the above statements from our cases, we think that a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter.”); *Parker v. Flook*, 437 U.S. 584, 594–595 (1978) (“Respondent’s application simply provides a new and presumably better

method for calculating alarm limit values.”); *Gottschalk v. Benson*, 409 U.S. 63, 64 (1972) (“They claimed a method for converting binary-coded decimal (BCD) numerals into pure binary numerals.”).

If the claim is “directed to” a patent-ineligible abstract idea, we then consider the elements of the claim—both individually and as an ordered combination—to assess whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2355. This is a search for an “inventive concept”—an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.*

The Examiner asserts that the claims are directed to “the abstract idea of developing an architecture (model) for an e-business solution” (“the results of the invention appear to be establish a plurality of business patterns identified from the description of the business solution, which is fundamental economic practice”). Final Rej. 7–8; emphasis omitted. In the alternative, the Examiner asserts that the claims are directed to a method of organizing human activities. Final Rej. 9. The Examiner asserts further that the recitations of computer structure are generic. Final Rej. 10–14.

The Appellants assert that independent claim 3 is directed to a computer readable storage medium with computer readable code for implementing steps on a computer, which is statutory. App. Br. 15–16. We agree with and adopt the Examiner’s findings and rationales concerning this assertion. Ans. 3–5.

The Appellants assert further that “claim 3, is better characterized as computer aided design part or computer. As such, the reliance on many concrete terms, dealing in computer readable medium and computer, in sum,

make claim 3 concrete and not abstract.” App. Br. 16, 18; Reply Br. 1–4. In doing so, the Appellants analogize the inputs concerning business descriptions of claim 3 to the input measured in microvolts of a patient’s heart function in *Arrhythmia Research Technology, Inc., v. Corazonix Corporation*, 958 F.2d 1053, 1059 (Fed. Cir. 1992), where the claims were determined to be patent-eligible. As an initial matter, we note claim 3 does not recite “inputs concerning business descriptions,” instead reciting “developing a business description.” Additionally, we note that *Arrhythmia* is a case from 1992 that applies the *Freeman–Walter–Abele* protocol for determining statutory subject matter. In any case, however, we are unpersuaded the analogy is apt, in that we are unpersuaded that the functioning of a patient’s heart, a physical object whose function can be readily observed, is analogous to inputs concerning business descriptions, where discerning whether something inputted is a “business description” can only be performed by the human mind. Instead, we are persuaded that the portions of the Specification cited by the Appellants (¶¶ 24, 25, 36, 39, Fig. 5B) concerning “business descriptions” are properly accounted for by the Examiner’s formulations of what the claims are directed to, and that such formulations do indeed concern patent-ineligible abstract ideas, fundamental economic practices, and methods of organizing human activity. Our analysis is the same for the Appellants’ similar assertions concerning “business patterns,” “integration patterns,” “composite patterns,” and “e-business solutions.” App. Br. 16–18.

Relatedly, the Appellants assert that the Examiner has not provided evidence to support the proposition that any of the above formulations are an abstract idea. Reply Br. 3. In this regard, there is no requirement that

examiners must provide evidentiary support in every case before a conclusion can be made that a claim is directed to an abstract idea. *See, e.g.*, para. IV “July 2015 Update: Subject Matter Eligibility” to 2014 Interim Guidance on Subject Matter Eligibility (2014 IEG), 79 Fed. Reg. 74618 (Dec. 16, 2014)

The courts consider the determination of whether a claim is eligible (which involves identifying whether an exception such as an abstract idea is being claimed) to be *a question of law*. Accordingly, courts do not rely on evidence that a claimed concept is a judicial exception, and in most cases resolve the ultimate legal conclusion on eligibility without making any factual findings.

(*Id.* (emphasis added)). We agree that evidence may be helpful in certain situations where, for instance, facts are in dispute. We are unpersuaded, however, that such is the case here.

Instead, we need only look to other decisions where similar concepts were previously found abstract by the courts. *See Amdocs (Israel) Limited v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (“Instead of a definition [for what an ‘abstract idea’ encompasses], then, the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.”)

To that end, we discern that “developing an architecture (model) for an e-business solution” and “establish a plurality of business patterns identified from the description of the business solution” is in the same analogous substantive area as the concept of “[u]sing organizational and product group hierarchies to determine a price,” held to be patent-ineligible in *Versata Development Group, Inc. v. SAP America, Inc.*, 793 F.3d 1306

(Fed. Cir. 2015), and “collecting information, analyzing it, and displaying certain results of the collection and analysis,” held to be patent-ineligible in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016).

The Appellants assert additionally that independent claim 3 does not preempt an entire field. App. Br. 18; Reply Br. 4–5. The assertion is misplaced, for, as noted in the Federal Circuit decision cited by both the Appellants and the Examiner, “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the Mayo framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015).

The Appellants assert also the following:

Similarly, claim 3, above, by relying on computer readable code for establishing one or more application patterns that are identifiable within the pictorial representation, each application pattern being indicative of a partitioning of an application logic and a data together with styles of interaction among a plurality of logical tiers - necessarily depends on a computer to accomplish its purpose, which is to depict each business pattern within the pictorial representation. Like *DDR Holdings*, the problem is rooted in a computer environment, namely, computer aided design.

App. Br. 19–20. We disagree, as we are unpersuaded that either “developing an architecture (model) for an e-business solution” or “establish[ing] a plurality of business patterns identified from the description of the business solution” is related to computer-aided design. Indeed, we discern that these concepts, by their own words, only concern business, which we have no trouble classifying as abstract. And insofar as the Appellants may be asserting that the manner in which these concepts are implemented on a computer concerns improvements in computer-aided

design, although that may be the case, we are unpersuaded that the claim language is commensurate with such an assertion. For example, independent claim 3 recites “computer readable code for establishing one or more integration patterns that are identifiable within the pictorial representation, each integration pattern being indicative of an integration of two or more business patterns.” The language does not deviate much from an articulation of the “establishing” step, and then the instruction to “apply it” via computer-readable code. The Specification does not provide much more illumination, as Figure 4A is a generic flowchart of the “establishing” step, and corresponding paragraphs 34–37, although providing some conceptual guidance, do not provide any indication that the claims concern computer-aided design.

The Appellants assert further that the Board’s previous reversal of the prior art rejections constitutes a definitive rebuttal of the Examiner’s assertion that “such a step, embodied in the computer readable medium is . . . well-understood, routine, and conventional.” App. Br. 19–20. The Appellants’ assertions are misplaced, as the proper question is whether “the representative method claim does no more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice*, 134 S. Ct. at 2351. We are unpersuaded that the Examiner erred in asserting that it does not, for the same reasons as set forth in the previous paragraph.

The Appellants assert finally that the Examiner erred in failing to examine claim 4 on its own merits. App. Br. 20; Reply Br. 5–6. We agree with and adopt the Examiner’s findings and rationales concerning this assertion. Ans. 9.

Appeal 2015-007294
Application 11/621,852

We sustain the rejection of claims 3–7.

DECISION

We AFFIRM the rejection of claims 3–7 under 35 U.S.C. § 101.

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

AFFIRMED