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ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			AKINTOLA, OLABODE	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VICKI HAMILTON, MELISSA KOEHLER,
MICHELLE MCGUIRE, KAREN PAINTER,
KATHRYN AUFDERHEIDE, JONJIE THRALLS, ALAY MEHTA,
MARK CHERNESKY, SIMIT SHAH, CATHERINE EVANS,
MARK HARTMAN, JENNIFER DAVIDSON, MANISH KHANDURI,
FARAH SPAINHOUR, CATHERINE HAGUE, and SCOTT MURPHY

Appeal 2015-007760
Application 12/651,759
Technology Center 3600

Before BIBHU R. MOHANTY, BRUCE T. WIEDER, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the non-final rejection of claims 1–22 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to systems and methods for prioritizing and tracking one or more investment products (Spec., para. 2). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A computer-implemented method for prioritizing and tracking one or more investment projects, the computer-implemented method comprising:
 - receiving, via one or more processors, input identifying an investment project;
 - assigning, via the one or more processors, a unique identifier to the investment project;
 - receiving, via the one or more processors, input identifying an estimated cost for the investment project;
 - receiving, via the one or more processors, input from a user selecting an expected benefit for the investment project, wherein the expected benefit is selected from a plurality of expected benefits displayed to the user;
 - automatically identifying, via the one or more processors, at least one input request related to the design of the investment project and that is associated with the expected benefit;
 - causing, via the one or more processors, display of a first input request that is related to the design of the investment project and that is associated with the expected benefit;
 - receiving, via the one or more processors, a response to the first input request;
 - causing, via the one or more processors, display of a second input request that is related to the development of the investment project;
 - receiving, via the one or more processors, a response to the second input request;
 - receiving, via the one or more processors, input indicating the investment project has been completed; and
 - in response to receiving input indicating that the investment project has been completed, causing, via the one or more processors, display of a third input request that is related to feedback of the investment project.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 1–22 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
2. Claims 1–6, 9–13, 16–19, and 22 are rejected under 35 U.S.C. § 103(a) as unpatentable over Wescott (US 2003/0036942 A1, published Feb. 20, 2003), Gibler et al. (US 2003/0097309 A1, published May 22, 2003 (hereinafter “Gibler”), and Burritt et al. (US 2004/0059588 A1, published Mar. 25, 2004 (hereinafter “Burritt”).¹
3. Claims 6–8, 14, 15, 20, and 21 are rejected under 35 U.S.C. § 103(a) as unpatentable over Wescott, Gibler, Burritt, and Eder (US 2009/0018891 A1, published Jan. 15, 2009).

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.²

¹ We interpret the Examiner’s inclusion of claims 7, 8, 14, 15, 20, and 21 in the heading of the rejection at page 6 of the non-Final Office Action as inadvertent error, because the Examiner does not address these claims in the body of the rejection and, instead, rejects these claims separately at pages 10–13 of the non-Final Office Action.

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellants argue that the rejection of claim 1 under 35 U.S.C. § 101 is improper because claim 1 is not directed to an abstract idea, fundamental economic practice, or a method of organizing human activities (Reply Br. 1–13). The Appellants also argue that claim 1 is directed to “significantly more” than an abstract idea (App. Br. 13–18).

In contrast, the Examiner has determined that the rejection under 35 U.S.C. § 101 as being directed to non-statutory subject matter is proper (Ans. 2, 3).

We agree with the Examiner. Under 35 U.S.C. § 101, 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 an implicit exception: “laws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In judging whether claim 1 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. If so, we then consider the elements of the claim both individually and as “an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application of the abstract idea. *Id.* 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 Court also stated that “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Id.* at 2358.

Here, we find that the claim is directed to the concept of prioritizing and tracking investment projects. This is a fundamental economic practice long prevalent in our system of commerce and a method of organizing human activities and is an abstract idea beyond the scope of § 101.

We next consider whether additional elements of the claim, both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the abstract idea over using generic computer components. We conclude that it does not.

Considering each of the claim elements in turn, the function performed by the computer system at each step of the process is purely conventional. Each step of the claimed method does no more than require a generic computer to perform a generic computer function.

Here, the claim is not rooted in technology but rather directed to the abstract concept of prioritizing and tracking investment projects and merely performed using generic computer components in a conventional manner.

For these reasons, the rejection of claim 1 is sustained. The Appellants have provided the same arguments for the remaining claims 2–22 and the rejection of these claims is sustained as well.

Rejections under 35 U.S.C. § 103(a)

The Appellants argue that the rejection of claim 1 is improper because the cited prior art fails to disclose the claim limitation for

receiving, via the one or more processors, input from a user selecting an expected benefit for the investment project, wherein the expected benefit is selected from a plurality of expected benefits displayed to the user.

(App. Br. 11–14).

In contrast, the Examiner has determined that the cited claim limitation is disclosed by Burritt at paragraph 31 and that the combination is properly made (Ans. 4, 5).

We agree with the Appellants. Here, the citation to Burritt fails to disclose the above cited claim limitation. For example, while Burritt at paragraph 31 does disclose risk mitigation processes, it fails to specifically disclose “receiving . . . input from a user selecting an expected benefit for the investment project” as the argued claim limitation requires. For this reason, the rejection of claim 1 and its dependent claims is not sustained.

The remaining independent claims 2, 10, and 17 contain a similar limitation, and the rejection of these claims is not sustained for the same reasons given above.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting the claims 1–22 under 35 U.S.C. § 101.

We conclude that Appellants have shown that the Examiner erred in rejecting the claims 1–22 under 35 U.S.C. § 103(a) as listed in the Rejections section above.

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DECISION

The Examiner's rejection of claims 1–22 is sustained.

AFFIRMED