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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/573,519	10/05/2009	Adrian Envin How	12587-0176001 / OP2040/U3	6307
26212	7590	03/09/2018	EXAMINER	
FISH & RICHARDSON P.C. (ACCENTURE) P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			CHAKRAVARTI, ARUNAVA	
			ART UNIT	PAPER NUMBER
			3693	
			NOTIFICATION DATE	DELIVERY MODE
			03/09/2018	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ADRIAN ENVIN HOW, JASMINE MEI PING KUA,
KIN YIP LAU, and MING HON WONG

Appeal 2016-003209
Application 12/573,519
Technology Center 3600

Before MURRIEL E. CRAWFORD, NINA L MEDLOCK, and
PHILIP J. HOFFMAN, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 21–26, 29–35, 38, and 39. We have jurisdiction over the appeal under 35 U.S.C. § 6(b). Appellants appeared for oral hearing on January 30, 2018.

BACKGROUND

Appellants' invention is directed to a system and method of generating data relating to products and/or services. The invention is particularly useful for generating configuration data relating to new tariff and/or billing plans for products for a telecommunication service provider.

Spec. 1

Claim 21 is illustrative:

21. A computer-implemented method comprising:

providing, by one or more computers, a user interface which displays representations of hierarchically arranged packages that each represent a service that is available for inclusion in a proposed configuration of a billing plan for services to be offered to customers, wherein (i) each package is associated with one or more products, (ii) each product is associated with one or more components, (iii) each component has one or more attributes, and (iv) each attribute has a label, and a value, and wherein the proposed configuration of the billing plan for services to be offered to customers is not yet available to customers, and is proposed for testing as a candidate billing plan for services to be offered to customers;

receiving, by the one or more computers through the user interface, a user selection of a particular package for inclusion by a service provider in a proposed configuration of a billing plan for services to be offered to customers;

in response to receiving the user selection of the particular package, determining that a category of customer for which the configuration of the billing plan is proposed is consistent with a category of customer corresponding to the particular package;

in response to determining that the category of customer for which the configuration of the billing plan is proposed is consistent with the category of customer corresponding to the particular package, providing, by the one or more computers, for display in the user interface a hierarchically arranged representation of one or more products associated with the particular package, one or more components associated with

each of the one or more products for display in the user interface, and an indication that the category of customer for which the configuration of the billing plan is proposed is consistent with the category of customer corresponding to the particular package;

in response to providing for display in the user interface the hierarchically arranged representation of one or more products associated with the particular package, the one or more components associated with each of the one or more products for display in the user interface, and the indication that the category of customer for which the configuration of the billing plan is proposed is consistent with the category of customer corresponding to the particular package,

receiving, by the one or more computers through the user interface, a user selection of a particular component associated with a particular product;

receiving, by the one or more computers through the user interface, a user-input value for a particular attribute of the particular component associated with the particular product;

updating, by the one or more computers, the proposed configuration of the billing plan for services to be offered to customers based on the user-input value for the particular attribute of the particular component associated with the particular product;

receiving, by the one or more computers through the user interface, a user input that causes the service provider to commit the proposed configuration of the billing plan for deployment as a test configuration for the billing plan for services to be offered to customers, wherein the billing plan of the test configuration is not yet available to customers; and

testing, by the one or more computers, the test configuration for the billing plan for services to be offered to customers before offering the billing plan to one or more customers in a production environment.

The Examiner relies on the following prior art references as evidence of unpatentability:

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Hanagan	US 2004/0133487 A1	July 8, 2004
Walker	US 2006/0014535 A1	Jan. 19, 2006

Appellants appeal the following rejections:

Claims 21–26, 29–35, 38, and 39 under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 21–26, 29–35, 38, and 39 under 35 U.S.C. § 103(a) as unpatentable over Hanagan and Walker.

PRINCIPLES OF LAW

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, 594–95 (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.”).

The patent-ineligible end of the spectrum includes fundamental economic practices, *Alice*, 134 S. Ct. at 2357; *Bilski*, 561 U.S. at 611; mathematical formulas, *Parker*, 437 U.S. at 594–95; and basic tools of scientific and technological work, *Gottschalk*, 409 U.S. at 69. On the patent-eligible side of the spectrum are physical and chemical processes, such as curing rubber, *Diamond*, 450 U.S. at 182 n.7, “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores,” and a process for manufacturing flour, *Gottschalk*, 409 U.S. at 69.

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.*

In addition, 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.”).

ANALYSIS

Rejection under 35 U.S.C. § 101

The Examiner held that the claims are directed to generating tariff and/or billing plans for telecommunications providers, which is a fundamental economic practice, and, therefore, are directed to an abstract idea. Final. Act. 2. The Examiner further determined that generating billing plans for consumers is an intrinsic part of fundamental economic activity in utilities and telecommunications business, and that displaying hierarchical subscription packages on a graphical user interface and receiving user selections are methods of organizing human activities. Ans. 2.

The Examiner found that the additional elements or combination of elements in the claims, other than the abstract idea, does not amount to more than mere instructions to implement the idea on a computer and/or recitations of generic computer structure that serves to perform generic computer functions that are well-understood, routine and conventional activities previously known to the pertinent industry. Final. Act. 3. The Examiner found that when viewed as a whole, these additional claim elements do not provide meaningful limitations to transform the abstract idea into patent eligible subject matter. Final. Act. 3. The Examiner further found that the technological environment recited in the claims invokes or contains no more than purely functional, routine and generic components for

providing interfaces, receiving user selections, determining associations between products and packages, updating, testing, etc. without any meaningful limitations. Ans. 3.

Appellants argue that the claims include one or more elements or a combination of elements that is sufficient to ensure that the claims amount to significantly more than any alleged abstract idea. App. Br. 6–7. This argument is not persuasive because the Appellants do not state what these elements or combination of elements is or explain how they are significantly more. In addition, we agree with the Examiner that the claims include no more than routine and generic components and steps such as providing interfaces, receiving user selections, determining associations between products and packages, updating, and testing, and, therefore, do not amount to significantly more than the abstract idea.

We are not persuaded of error on the part of the Examiner by Appellants’ argument that the claims do not attempt to preempt all uses of the alleged abstract idea. App. Br. 7. “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”). And, “[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*, 788 F.3d at 1379.

We are not persuaded of error on the part of the Examiner by Appellants' argument that the claims require a graphical user interface to overcome particular technological problems (App. Br. 7), because the Appellants do not explain what these technological problems are and how the graphical user interface overcomes these problems. In addition, we agree with the Examiner's response to this argument found on pages 2–3 of the Answer and adopt it as our own. Appellants argue in the Reply Brief that the claim limitations improve the functioning of the basic display function of the computer itself and are necessarily rooted in computer technology. Reply Br. 2. We find these arguments untimely. We note that these new arguments were raised by Appellants for the first time in the Reply Brief, and they are not in response to a new issue brought up by the Examiner in the Answer. Appellants are reminded that:

[T]he purpose of a reply brief is to ensure the Appellant the opportunity to have the last word on an issue raised by the Examiner. The reply brief enables the Appellant to address any new grounds of rejection the Examiner may have raised in the answer, or to address changes or developments in the law that may have occurred after the principal brief was filed. The reply brief is *not* an opportunity to make arguments that could have been made during prosecution, but were not. Nor is the reply brief an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not.

Giving cognizance to belated arguments in a reply would vitiate the force of the requirement in Board Rule 37(c)(1)(vii) that

“[a]ny arguments or authorities not included in the brief ... will be refused consideration by the Board, unless good cause is shown.” The reference in that section to the “reply brief filed pursuant to § 41.41” does not create a right for the Appellant to raise an argument in the reply brief that could have been raised in the principal brief but was not. Rather, that reference merely puts Appellants on notice that arguments that could be made in the reply brief, but are not, are waived.

Ex parte Borden, 93 USPQ2d 1473, 1474 (BPAI 2010). We, therefore, consider Appellants’ argument raised in the Reply Brief to be waived.

In view of the foregoing, we will sustain this rejection as it is directed to claim 21. We will sustain the rejection as it is directed to the remaining claims because the Appellants do not argue the separate patent eligibility of these claims.

Rejection under 35 U.S.C. § 103(a)

The Appellants argue that the applied prior art does not describe or suggest providing a graphical user interface for display of an indication that the category of customer for which the configuration of the billing plan is proposed is consistent with the category of customer corresponding to the particular package. App. Br. 8. We agree.

It is not clear from the Final Rejection what reference is relied on for teaching this step of claim 21. The Examiner relies on Walker for teaching displaying and modifying subscription packages but is not clear if Walker is also relied on for disclosing providing an indication on the user’s graphical

user interface that the billing plan is consistent with the category of customer corresponding to the package. Final. Act. 11.

In response to Appellants' argument in the Appeal Brief that this subject matter is not disclosed in the prior art, the Examiner explains that Hanagan teaches different categories of customers, such as wireline and wireless customers, and that the wireless products may have different graphics beside them to denote a wireless product. Ans. 5. The Examiner concludes that it would have been obvious to have different graphics for residential and business customers in order to distinguish them from each other and, thus, it would have been possible to determine whether a customer is a residential or business user and whether a billing package is consistent with the category. Ans. 5.

The problem with the Examiner's analysis is that although it may be true that it is possible in the Hanagan system to use different graphics for residential and business customers, the Examiner has not established that Hanagan discloses doing so. In addition, the Examiner has not established that Hanagan or the other applied prior art teaches providing an indication of whether a customer is residential or business in response to determining the category of customer as required by claim 21.

In view of the foregoing, we will not sustain this rejection as it is directed to claim 21, and claims 22–26 and 29 dependent therefrom. We will not sustain the rejection as it is directed to the remaining claims for the same reason.

DECISION

We affirm the Examiner's § 101 rejection.

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We do not affirm the Examiner's § 103 rejection.

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2009).

ORDER

AFFIRMED