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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAUL V. MORINVILLE

Appeal 2016-003311
Application 13/244,561¹
Technology Center 3600

Before DEBRA K. STEPHENS, ADAM J. PYONIN, and
DAVID J. CUTITTA II, *Administrative Patent Judges*.

PYONIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

STATEMENT OF THE CASE

Introduction

The Application is directed to “systems and methods for automating and increasing the efficiency of business processes using a role structure

¹ The real party in interest is identified as Paul V. Morinville. *See App. Br. 4.*

which is preferably hierarchical.” Spec. ¶ 19. Claims 1, 8, and 15 are independent. Claim 1 is reproduced below for reference (emphasis added):

1. A method comprising computer-implemented automatic steps including:

a business processor engine in a computer receiving a user request for access to a business process and initiating a first event in response to the user request;

the first event initiating one or more secondary events, wherein each of the secondary events has a plurality of states that are maintained by the computer and wherein each of the plurality of states has an associated status that is maintained by the computer, and wherein one or more of the first event and secondary events access data stored in a data source coupled to the business processor engine;

the first event monitoring the state and associated status of each of the secondary events while the first event and secondary events are pending; and

the first event controlling access by the user to the business process based on the state and associated status of each of the secondary events.

References and Rejections

Claims 1–20 stand rejected under 35 U.S.C. § 101 for being directed to patent-ineligible subject matter. Final Act. 2.

Claims 1–5, 7–12, and 14–19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Elkin (US 2001/0044738 A1; Nov. 22, 2001). Final Act. 3.

Claims 6, 13, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Elkin and Kim (US 2002/0065701 A1; May 30, 2002). Final Act. 8.

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellant’s arguments. We have considered in this Decision only those arguments Appellant actually raised in the Briefs. Any other arguments Appellant could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

A. 35 U.S.C. § 101

Appellant does not separately argue the claims with respect to the 35 U.S.C. § 101 rejection. *See* App. Br. 12. We select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv).

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: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (internal citation and quotation marks omitted). The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 566 U.S. 66, 79 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” e.g., to an abstract idea. *Id.* If the claims are directed to a patent-ineligible concept, the inquiry proceeds to the second step, where the elements of the claims are considered “individually

and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78).

The Court acknowledged in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology, or instead are directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

Appellant argues “the Examiner has given a conclusory opinion, but has provided no evidence or showing to support the conclusion that the claims recite only an abstract idea, which is insufficient to establish a prima facie case of patent ineligibility.” App. Br. 16. Further, Appellant “submits that the recited interaction with the user, particularly the controlling of the user’s access to the requested business process, goes beyond the abstract idea,” as “controlling the user’s access to the business process in this manner is significantly more than the abstract idea of executing a business process.” *Id.* at 14–15.

We are not persuaded the Examiner errs. In rejecting the claims under 35 U.S.C. § 101, the Examiner finds the claimed invention is unpatentable pursuant to the two-step framework of *Alice*. *See* Ans. 5–6. The Examiner finds the claimed invention is directed to the abstract idea of “controlling access by a user to a business process,” which is “similar to concepts involving organizing information . . . that have been found by the courts to be abstract ideas.” Ans. 5. The Examiner further finds the “claim(s)

does/do not include additional elements that are sufficient to amount to significantly more than the judicial exception” (Final Act. 2), as the claims do not recite “any improvement to another technology or technical field, or the functioning of the computer itself. Moreover, there are not any meaningful limitations beyond generally linking the abstract idea to a particular technological environment, i.e., implementation via a computer system” (Ans. 6). We agree with, and adopt as our own, the Examiner's findings and analysis with respect to 35 U.S.C. § 101. *See* Final Act. 2–3; Ans. 4–7.

In particular, Appellant does not persuade us the Examiner's analysis is in error. Our reviewing court has held certain fundamental economic and conventional business practices to be abstract ideas. *See, e.g., Accenture Global Services, GmbH v. Guidewire Software*, 728 F.3d 1336, 1344 (Fed. Cir. 2013) (generating task based rules based on an event); *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015) (tailoring information presented to a user based on specific conditions); *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362 (Fed. Cir. 2015) (Methods of offer-based price optimization in an e-commerce environment); *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1333 (Fed. Cir. 2015), cert. denied, 136 S. Ct. 2510, 195 L. Ed. 2d 841 (2016) (using organizational and product group hierarchies to determine a price); *Prism Techs. LLC v. T-Mobile USA, Inc.*, No. 2016-2031, 2017 WL 2705338, at *1-2 (Fed. Cir. June 23, 2017) (non-precedential) (providing restricted access to resources.). We agree with the Examiner that the claims of the present application are directed to a business practice, which is similarly abstract: claim 1, for example, recites a computer implemented

method which “control[s] access by the user to the business process based on the state and associated status of each of the secondary events.” *See* Final Act. 9–10.² Thus, we do not find the Examiner errs in determining claim 1 is abstract. *See id.*

We are also not persuaded claim 1 recites elements that transform the nature of the claim into a patent-eligible application. As correctly noted by the Examiner, “the data [of the claims] is merely being monitored,” and “no more than a software platform, performing generic computer functions that are well-understood, routine, and conventional activities previously, known to the pertinent industry, is required by the claims.” Ans. 6. That an abstract idea may be described in greater detail does make the idea any less abstract. The limitations comprise, at most, insignificant post-solution activities that do not support the invention having an inventive concept. *See, e.g., Mayo*, 566 U.S. at 72–73 (“[T]he prohibition against patenting abstract ideas cannot be circumvented by . . . adding insignificant post-solution activity”) (internal citations and quotation marks omitted); *see also Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1328–29 (Fed. Cir. 2017) (“[w]hile limiting the index to XML tags certainly narrows the scope of the claims, in this instance, it is simply akin to limiting an abstract idea to one field of use or adding token post solution components that do not convert the otherwise ineligible concept into an inventive concept”).

² This finding is fully consistent with the Specification. *See, e.g.,* Spec. ¶ 4 (“organizations must efficiently control the way people, resources and information technology interact. This can be referred to as Business Process Management (BPM)”), ¶ 35 (“Various rights (e.g., access rights or authorization rights) are associated with the different roles or levels to enable positions which are associated with the roles to have particular access to certain business processes (e.g., purchasing or hiring)”).

Additionally, although Appellant contends “the claims do not risk disproportionately tying up all applications of the underlying idea of controlling access by a user to a business process,” Appellant has not provided persuasive evidence or reasoning to support these arguments. Reply Br. 5. That is, Appellant describes the claim recitations, but has not adequately explained why claim 1 does not preempt the identified abstract idea. *See id.*; App. Br. 15. In any event, even if we were to agree that claim 1 does not attempt to preempt every application of the idea, such fact would not necessarily make the claim patent eligible. *See Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”); *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.”). For the above reasons, we agree with the Examiner that the claims do not include limitations that qualify as significantly more than the abstract idea. *See Ans. 7.*

Accordingly, we agree with the Examiner that the claims are directed to an abstract idea, and fail to recite inventive concepts sufficient to transform the abstract idea into a patent eligible invention. *See Ans. 4–7.*

B. 35 U.S.C. § 102

Appellant argues the Examiner erred in finding Elkin discloses the limitations of claim 1, because “Elkin does not disclose [] that the first event/process monitors the second event/process while both events/processes

are still pending.” App. Br. 20. Appellant argues that, rather, Elkin discloses “that the first event/process (process 120) is *NOT* still pending at the same time as the second event/process (event 102, a.k.a. result 106). Because the first event/process has completed, it cannot monitor the state of the second event/process as recited in the claim.” *Id.*

We are persuaded by Appellant’s arguments. Claim 1 requires controlling access to a business process based on first and secondary events, with the first event monitoring the secondary event. The Examiner finds Elkin discloses the recited first and secondary events, because Elkin states “[e]ach process 120 is triggered by an event 102,” and “[i]n addition to being triggered by an event 102, each process 120 also creates a new event 102 when the process 120 is completed.” Final Act. 4 (citing Elkin ¶ 44). The Examiner further finds Elkin discloses the first event monitoring the secondary event, because Elkin discloses “the process server 500 must maintain the status of each process 120 and task 130.” Ans. 8 (citing Elkin ¶¶ 174, 201). However, the Examiner does not identify, nor do we find, that Elkin discloses a secondary event monitored by a first event. Thus, we are persuaded that Elkin does not disclose every element of the claimed invention. *See Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (“Every element of the claimed invention must be literally present, arranged as in the claim.”); *see also* App. Br. 19–20.

Therefore, based on the record before us, we are persuaded the Examiner has not established that Elkin discloses “the first event monitoring the state and associated status of each of the secondary events,” as recited by

independent claim 1. Independent claims 8 and 15³ recite similar limitations which we find similarly not disclosed by the reference. We do not sustain the Examiner's rejection of these claims, or the claims that depend therefrom.

DECISION⁴

The Examiner's decision rejecting claims 1–20 under 35 U.S.C. § 101 is affirmed.

The Examiner's decision rejecting claims 1–20 under 35 U.S.C. §§ 102(e) and 103 is reversed.

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

³ We note claim 15 recites the monitoring step without including “while the first event and secondary events are pending,” unlike independent claims 1 and 8.

⁴ Should there be further prosecution, the Examiner may wish to consider whether the independent claims are indefinite (e.g., how the event (such as a business process request) monitors a state or status) under 35 U.S.C. § 112. The Examiner may further consider whether sufficient written description as required under 35 U.S.C. § 112, is present in the Specification for “the first event monitoring the state and associated status of each of the secondary events,” as recited in claims 1 and 15 and similarly recited in claim 8, which Appellant identifies as being described in paragraphs 31, 40 49, and 57 of the Specification. *See* App. Br. 8.