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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANDREW WILLIAM BERGSTROM and NIGEL GAY

Appeal 2016-004107
Application 12/333,564
Technology Center 3600

Before CAROLYN D. THOMAS, HUNG H. BUI, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–24, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.²

¹ Appellants identify FoundationIP, LLC as the real party in interest. App. Br. 1.

² Our Decision refers to the Examiner's Final Office Action mailed March 14, 2014 ("Final Act."); Appellants' Appeal Brief filed April 10, 2015 ("App. Br."); the Examiner's Answer mailed September 28, 2015 ("Ans."); and the original Specification filed December 12, 2008 ("Spec").

STATEMENT OF THE CASE

Appellants' invention "relates to an interface between two applications through a web service," and "more specifically, . . . to interfacing an annuity application with an asset management application." Spec. 1.

Claims 1 and 13 are independent. Independent claim 1, reproduced below with disputed limitations in italics, is illustrative of the subject matter on appeal:

1. A computer system comprising:

a first server comprising a first processor in communication with a first data storage medium to store intellectual property asset data;

a first application to serve as an interface for said first storage and in communication with the first processor, wherein the first application is directed to docket intellectual property assets;

a second server comprising a second processor in communication with a second data storage device to store annuity data;

a second application to serve as an interface for said second storage medium and in communication with the second processor, wherein the second application is directed to manage annuity data for intellectual property assets;

a third application local to the first server and in communication with the first application via a local communication protocol and in communication with the second application via a web service, wherein the third application communicates annuity related instructions and requests for retrieving annuity information received from the first application to the second application and the corresponding annuity related information received from the second application to the first application;

a plurality of queues accessible by the first and the third application, wherein each of the annuity related instructions, the requests, and the corresponding annuity related information is stored in the plurality of queues before they are communicated to the first or the second application; and

a scheduler in communication with the third application, wherein the scheduler prompts the third application to periodically release the annuity related instructions, the requests, and the corresponding annuity related information from the plurality of queues to one of the first application and the second application.

App. Br. 24 (Claims App'x).

EXAMINER'S REJECTIONS

Claims 1–24 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Ans. 3.

Claims 1–24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Frank et al. (US 2006/0080135 A1; published Apr. 13, 2006) (“Frank”) and Larue et al. (US 2002/0156798 A1; published Oct. 24, 2002) (“Larue”). Final Act. 2–12.

ANALYSIS

Rejection under 35 U.S.C. § 101

In a new ground of rejection set forth in the Answer, the Examiner rejected claims 1–24 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Ans. 3. The Examiner finds, in particular, that claims 1–24 are directed to an abstract idea (i.e., managing intellectual property asset data, a method of organizing human activity) and do not

include additional elements that are sufficient to amount to significantly more than such abstract idea. *Id.* The Examiner further finds that the limitations of the instant claims are carried out by generic servers and processors and

are merely instructions to implement the abstract idea on a computer and require no more than a generic computer to perform generic computer functions (such as interfacing data storage to an application; using application to communicate instructions and requests; storing request and the corresponding information; using a scheduler to prompt periodic release of instruction, request and information) that are well-understood, routine and conventional activities previously known to the industry.

Id.

The Examiner further explains that, because the Answer contains a new ground of rejection, Appellants were required, within two months from the date of the Answer, either (1) to reopen prosecution before the primary examiner by filing a reply under 37 C.F.R. § 1.111 relevant to the new ground of rejection or (2) to maintain their appeal by filing a reply brief under 37 C.F.R. § 41.41 addressing the new ground of rejection, in order to avoid *sua sponte* dismissal of the appeal as to all claims subject to the new ground of rejection. *Id.* at 12; *see* 37 C.F.R. § 41.39(b).

The record does not indicate that Appellants filed a reply under 37 C.F.R. § 1.111 or a reply brief under 37 C.F.R. § 41.41 within the allotted two-month period, and all of pending claims 1–24 are subject to the stated new ground of rejection. Accordingly, Appellants’ appeal as to all claims is subject to *sua sponte* dismissal. 37 C.F.R. § 41.39(b). Nonetheless, we discern no error in the Examiner’s rejection of claims 1–24 under 35 U.S.C. § 101.

The Supreme Court has long held that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). The Court previously made clear, for example, that “[p]henomena of nature, . . . mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.” *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972). Following that guidance, the Federal Circuit similarly has held that mental processes are not patent-eligible subject matter and that methods that “can be performed *entirely* in the human mind are the types of methods that embody the ‘basic tools of scientific and technological work’ that are free to all men and reserved exclusively to none.” *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011).

In *Alice*, the Supreme Court reiterated a two-step framework, previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1300 (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 the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* (citing *Mayo*, 132 S. Ct. at 1296–97). If so, the second step requires consideration of the elements of the claims “individually and ‘as an ordered combination’” to determine whether the additional elements “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1297–98). In other words, the second step is to “search for an ‘inventive

concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (alteration in original) (quoting *Mayo*, 132 S. Ct. at 1294). 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*, 132 S. Ct. at 1293. We, therefore, look to whether the claims “focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

In view of these principles, we agree with the Examiner that claims 1–24 are directed to patent-ineligible subject matter. In contrast with precedential cases in which the Federal Circuit has found claims directed to computer-implemented methods to be patent-eligible under the *Alice* framework, the instant claims do not provide, for example, (1) a “solution [] necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks” (*see DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014)); (2) “a specific improvement to the way computers operate” (*Enfish*, 822 F.3d at 1336; *see also McRO*, 837 F.3d at 1303; *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1259 (Fed. Cir. Aug. 15, 2017)); or (3) an “unconventional technological solution . . . to a technological problem” that “improve[s] the performance of the system itself” (*Amdocs (Israel) Ltd. v. Openet Telecom, Inc.* 841 F.3d 1288, 1302, 1306 (Fed. Cir. 2016); *see also*

Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC, 827 F.3d 1341, 1352 (Fed. Cir. 2016); *Thales Visionix Inc. v. United States*, 850 F.3d 1343, 1347, 1349 (Fed. Cir. 2017). Rather, the instant claims are analogous to those addressed in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016), where the court explained that the asserted claims fell “a familiar class of claims ‘directed to’ a patent-ineligible concept,” specifically, “collecting information, analyzing it, and displaying certain results of the collection and analysis.” *Id.* at 1353. As in that case, the “advance [the claims] purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions.” *Id.* at 1354. Further, where the court in that case explained that “[n]othing in the claims, understood in light of the specification, requires anything other than off-the-shelf, conventional computer, network, and display technology for gathering, sending, and presenting the desired information” (*id.* at 1355), similarly here nothing in the instant claims understood in light of the specification requires anything other than off-the-shelf, conventional computer, storage, and communication technology. Accordingly, we affirm the Examiner’s rejection of claims 1–24 under 35 U.S.C. § 101.

Rejection under 35 U.S.C. § 103(a)

The Examiner finds Frank teaches all elements of independent claim 1, except for using one set of server and storage medium set to docket intellectual property assets and a separate set of server and storage medium to manage annuity data, whereas Larue teaches synchronizing two different

server and database sets. Final Act. 2–4 (citing Frank ¶¶ 53, 60, 95, 129, 138, 141, 227, 290, Fig. 4; Larue ¶ 137). Based on these teachings, the Examiner concludes it “would have been obvious for one of ordinary skill in the art at the time of the invention to modify the system for managing intellectual property assets taught by Frank with teachings from LARUE to del[eg]ate two different intellectual property assets tasks to two different systems and synchronize both,” and that one of ordinary skill would have been motivated to make such a modification “as it reduces work load on one particular system.” *Id.* at 4. The Examiner relies on essentially the same findings with respect to independent claim 13. *Id.* at 7–9.

Appellants dispute the Examiner’s findings regarding Frank and Larue. In particular, Appellants contend that Frank fails to disclose the recited “third application” limitation; that neither Frank nor Larue teaches the recited “plurality of queues” and “scheduler” limitations; and that Frank and Larue “cannot be fairly combined” absent impermissible hindsight. App. Br. 6–22.

We agree with Appellants that the portions of Frank and Larue cited by the Examiner do not teach or suggest “a plurality of queues accessible by the first and the third application, wherein each of the annuity related instructions, the requests, and the corresponding annuity related information is stored in the plurality of queues before they are communicated to the first or the second application,” as recited in claim 1, or the similar limitation recited in claim 13. With respect to those limitations, the Examiner cites paragraphs 53, 60, and 129 of Frank as disclosing a “docketing system” that “suggests queues” and further cites paragraph 246 of Frank as “regarding pipeline.” Final Act. 3.

In response to Appellants' arguments, the Examiner explains that, under the broadest reasonable interpretation standard, "queue" is interpreted as "temporary storing format in certain order, storing annuity related information that accessible by multiple applications within the system," and "Franks teaches storing of annuity related information in the database accessible by docketing and tracking applications. *Id.* at 14 (citing Frank ¶¶ 53, 60, 129); *see also* Ans. 7 (repeating the same explanation). The Examiner further finds "[a] 'docket' is known in the art as 'a calendar or list of cases for trial or people having cases pending', while a queue is known in the art as 'a line or sequence of people or vehicles awaiting their turn to be attended to or to proceed.'" Final Act. 14; *see also* Ans. 7 (repeating the same finding and further adding that "[t]he listing and pending aspect of a docket is equivalent to the linear and sequential aspect of a queue.>"). According to the Examiner, "[a] 'docket' and a 'queue' are analogous in which both are defined as a temporary storing medium for cases pending." Final Act. 14; Ans. 7–8. Thus, according to the Examiner:

Given Frank[']s teaching on a IP docketing system accessible by multiple applications in a system and that a docket and a queue being analogous in the art of document processing, Frank in view of Larue teaches ["a plurality of queues accessible by the first and the third application, wherein each of the annuity related instructions, the requests, and the corresponding annuity related information is stored in the plurality of queues before they are communicated to the first or the second application"].

Final Act. 14; Ans. 8. The Examiner does not rely on Larue as teaching or suggesting these limitations.

Whether or not a "docket" and a "queue" may be analogous in certain aspects, we are not persuaded that Frank's docket teaches or suggests "a

plurality of queues” in which “annuity related instructions,” “requests,” and “annuity related information” are stored “before they are communicated to” Frank’s IP utilization system 7000—i.e., the component of Frank that the Examiner relies on as teaching the “first application” and the “second application” in the manner recited in claims 1 and 13. *See* Ans. 5. Although paragraph 141 of Frank discloses that IP utilization system 7000 can receive certain information from IP asset management system 6000, that same paragraph discloses that “information related to decisions to abandon an IP asset (e.g., to forego paying a maintenance fee)”—i.e., the information relied upon by the Examiner as teaching annuity related information (*see* Ans. 5)—is stored by IP utilization system 7000 itself.

Accordingly, we do not sustain the Examiner’s rejection of independent claims 1 and 13 and their respective dependent claims 2–12 and 14–24 under 35 U.S.C. § 103(a) as being unpatentable over Frank and Larue.

DECISION

The rejection of claims 1–24 under 35 U.S.C. § 101 is affirmed.

The rejection of claims 1–24 under 35 U.S.C. § 103(a) is reversed.

Because one rejection of each of the appealed claims is sustained, the decision of the Examiner is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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).

AFFIRMED