UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HEATHER COTTINGHAM, ELIZABETH DAWN ABRAHAM,
and BOPINDERJIT SINGH

Appeal 2016-004471[1]
Application 13/251,232[2]
Technology Center 3600

Before PHILIP J. HOFFMANN, CYNTHIA L. MURPHY, and
ALYSSA A. FINAMORE, *Administrative Patent Judges.*

FINAMORE, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellants appeal from the
Examiner's decision to reject claims 1–30. We have jurisdiction under
§ 6(b). We AFFIRM.

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[1] Our Decision references Appellants' Specification ("Spec.," filed Oct. 1,
2011), Appeal Brief ("Appeal Br.," filed Aug. 26, 2015), and Reply Brief
("Reply Br.," filed Mar. 22, 2016), as well as the Examiner's Final Office
Action ("Final Act.," mailed Feb. 11, 2015) and Answer ("Ans.," mailed
Jan. 22, 2016).

[2] Appellants identify Oracle International Corporation as the real party in
interest. Appeal Br. 3.

SUBJECT MATTER ON APPEAL

The invention relates to "implementing expense entries by using mobile devices." Spec. ¶ 33. Claims 1, 11, and 21 are the independent claims on appeal. Independent claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. A method for performing expense item entry on a mobile device, comprising:
>
> using at least one processor that is programmed or configured for performing a process, the process comprising:
>
> identifying an enterprise expense application at a remote server, wherein the enterprise expense application stores a set of enterprise-specific reference data, the set of enterprise-specific reference data corresponding to policies established by an enterprise to govern expenses incurred by one or more employees of the enterprise;
>
> providing a mobile expense application to a user, the mobile expense application interfacing with the enterprise expense application;
>
> periodically downloading, from the enterprise expense application, at least a portion of the set of enterprise-specific reference data to the mobile expense application to perform validation checks on one or more expense entries;
>
> generating an expense entry on the mobile expense application;
>
> capturing, through a location capturing device, location data pertaining to movement of the mobile device to populate at least a portion of required fields of the generated expense entry;
>
> determining another portion of required fields for the expense entry for which data is not entered;
>
> auto-populating additional data for the other portion of required fields for the expense entry from a processing mechanism on the mobile device;
>
> validating the expense entry for policy violations by the mobile device using the downloaded enterprise-specific reference data stored at the mobile device; and

> sending the expense entry to the remote server comprising
> the enterprise expense application, such that the expense entry
> created on the mobile device is uploaded for processing at the
> enterprise expense application.

REJECTIONS

The Examiner rejects the claims on appeal as follows:

claims 1–30 under 35 U.S.C. § 101 as non-statutory subject matter;

claims 1–30 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement;[3] and

claims 1–30 under 35 U.S.C. § 102(a) as anticipated by Dinamani et al. ("Dinamani," US 7,908,191 B1, iss. Mar. 15, 2011).

ANALYSIS

Non-Statutory Subject Matter

Appellants argue claims 1–30 as a group. Appeal Br. 11–19; Reply Br. 2–8. We select independent claim 1 as representative. The remaining claims of the group stand or fall with independent claim 1. 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 implicit

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[3] The Examiner has withdrawn this rejection as to the limitation reciting "identifying an enterprise expense application at a remote server, wherein the enterprise expense application stores a set of enterprise-specific reference data, the set of enterprise-specific reference data corresponding to policies established by an enterprise to govern expenses incurred by one or more employees of the enterprise," in each of the independent claims. Ans. 4.

exceptions: "[l]aws 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) (quoting *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). To "distinguish[] patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts," the Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), which, in the first step, considers whether a claim is directed to a patent-ineligible concept, e.g., an abstract idea, and, if so, considers, in the second step, whether the claim recites an inventive concept—an element or combination of elements sufficient to ensure the claim amounts to significantly more than the abstract idea and transform the nature of the claim into a patent-eligible application. *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 132 S. Ct. at 1294, 1296–98).

In rejecting independent claim 1 under 35 U.S.C. § 101 as non-statutory subject matter, i.e., subject matter judicially excepted from statutory subject matter, the Examiner analyzes the claim using this two-step framework. Final Act. 5. More specifically, pursuant to the first step, the Examiner determines the claim is directed to the concept of "performing expense item entry and generating expense reports," which is a fundamental economic practice and a method of organizing human activities, and, therefore, an abstract idea. *Id.* (emphasis omitted). Under the second step, the Examiner determines the claim does not recite limitations that are significantly more than the abstract because the claim does not recite an improvement to another technology or technical field, an improvement to the

functioning of the computer itself, or meaningful limitations beyond generally linking the use of the abstract idea to a particular technological environment. *Id.* The Examiner further determines that the claim limitations are merely instructions to implement the abstract idea on a computer and require no more than a generic computer to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the industry. *Id.*

Under the first step of the patent-eligibility analysis, Appellants argue "[t]he mere mention of 'expense entries' does not mean that [independent claim 1] comprise[s] patent-ineligible subject matter." Appeal Br. 14–15; Reply Br. 4–5. Appellants also assert that independent claim 1 is not directed to an abstract idea, but rather recites two computing systems that are inextricably tied with a computer based communication and notification scheme interconnecting computers. Reply Br. 2–3. Appellants' arguments do not apprise us of error.

Our reviewing court has instructed that "[u]nder step one of *Mayo/Alice*, the claims are considered in their entirety to ascertain whether *their character as a whole* is directed to excluded subject matter." *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015) (emphasis added). For computer-implemented inventions in particular, such as the present invention, "the first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an 'abstract idea' for which computers are invoked merely as a tool." *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016).

Here, independent claim 1 recites a method for performing expense item entry on a mobile device, and the method comprises the steps of: "identifying an enterprise expense application at a remote server"; "providing a mobile expense application to a user"; "periodically downloading, from the enterprise expense application, at least a portion of the set of enterprise-specific reference data to the mobile expense application"; "generating an expense entry on the mobile expense application"; "capturing . . . location data pertaining to movement of the mobile device to populate at least a portion of the required fields of the generated expense entry"; "determining another portion of required fields for the expense entry for which data is not entered"; "auto-populating additional data for the other portion of required fields for the expense entry"; "validating the expense entry for policy violations by the mobile device using the downloaded enterprise-specific reference data"; and "sending the expense entry to the remote server . . . for processing." Thus, according to independent claim 1, these steps enable expense entries to be generated at one location and sent for processing at another location.

Similarly, the Specification explains that

> [t]he problem with [the conventional] approach is that it ignores the fact that many types of expenses occur while the user is away from his computer, and therefore the prior art architecture of Fig. 1 forces the user to delay entry of the expense lines until the user can later access a workstation or computer 102 that is within the company network.

Spec. ¶ 5. The Specification further describes that "there is a need for an improved approach to allow a user to enter and edit expense entries."
Spec. ¶ 6. The Specification also explains that "[t]he present disclosure

provides an improved method, system, and computer program product for implementing expense entries by using mobile devices." *Id.* ¶ 33.

Independent claim 1 also recites a processor, and, as Appellants point out (Reply Br. 3), the claim further recites two computing systems that communicate with each other, namely a remote server having an enterprise expense application and a mobile device having a mobile expense application. The remote server and mobile device being at different locations enables the processor to generate expense entries at one location and send them to another location for processing. In other words, the claimed invention uses the processor and computing devices as tools to allow expense entries to be generated at one location and processed at another. The focus of the claimed invention is not on an improvement in computer capabilities, but rather on a process for expense item entry for which computing devices are invoked merely as tools. Accordingly, Appellants do not apprise us of error in the Examiner's determination that the character of independent claim 1, as a whole, is directed to "performing expense item entry and generating expense reports."

Appellants further contend that independent claim 1 is directed to "the mobile capture of data, formatting[,] and transmittal of data." Appeal Br. 13. Although we disagree with Appellants that the claim is directed to "the mobile capture of data, formatting and transmittal of data" for the reasons above, Appellants' argument is nonetheless unpersuasive of error. The Federal Circuit has held that claims directed to collecting information, analyzing it, and displaying certain results are directed to an abstract idea. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016). Consequently, even if independent claim 1 is directed

to "the mobile capture of data, formatting[,] and transmittal of data," as Appellants argue, the claim would still be directed to an abstract idea.

Appellants additionally assert that independent claim 1 is not directed to an abstract idea because, like the patent-eligible claims in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256–57 (Fed. Cir. 2014), the claim offers a technologically-rooted solution to a problem specifically arising in the realm of computer networks, namely the inability to accurately capture data for a large number of employees. Appeal Br. 13–14. The inability to accurately capture data for a large number of employees, however, is not a problem unique to computers. Consequently, we see no parallel between independent claim 1 and the claims in *DDR Holdings*, and Appellants' reliance on *DDR Holdings* does not apprise us of error in the Examiner's determination that independent claim 1 is directed to the abstract idea of "performing expense item entry and generating expense reports."

Appellants further argue that independent claim 1 is not directed to a fundamental economic practice or method of organizing human activity. Appeal Br. 13; Reply Br. 5–6. Appellants, however, do not address why "performing expense item entry and generating expense reports" is not a fundamental economic practice or a method of organizing human activity. Accounting for expenses is a fundamental economic practice long prevalent in our system of commerce. Furthermore, we see no meaningful distinction between the concept of "performing expense item entry and generating expense reports" and other methods of organizing human activities that the courts have held to be abstract ideas, such as "budgeting" in *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1367–68 (Fed. Cir. 2015).

Seeing no error in the Examiner's determination that independent
claim 1 is directed to an abstract idea pursuant to the first step of the
patent-eligibility analysis, we turn to Appellants' arguments under the
second step. Appellants allege that independent claim 1 recites significantly
more than the abstract idea because the claim limitations confine the abstract
idea to a particularly useful application, namely the efficient capture,
formatting, and transmittal of data from a mobile device to a server.
Appeal Br. 15–17. Appellants similarly contend that independent claim 1
includes limitations that improve the existing technology of data collection
and organization. *Id.* at 17–19; Reply Br. 8. Appellants also argue that
independent claim 1 includes limitations that go beyond functions of a
general purpose computer because the claim limitations, as an ordered
combination, facilitate accurate capture, validation, and formatting of the
data so that the data can be consumed by a remote server. Appeal Br. 19.
Appellants' arguments are not convincing.

Appellants ostensibly maintain that independent claim 1 recites
significantly more than the abstract idea because the claimed invention
improves the remote capture, validation, and formatting of expense entry
data. There is no indication, however, that the claimed invention improves
the capture, validation, formatting, collection, or organization of data.
Rather, the claimed invention, via the remote capture, validation, and
formatting of expense entry data, improves the accounting of expenses by
enabling a user to enter expenses remotely from a server that processes the
expenses entries. *See, e.g.*, Spec. ¶ 35 ("One key advantage of this approach
is that it allows the user to generate expense entries more in alignment with

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the location/way that many expense [sic] are actually generated, e.g., while the user is away from the office computer.").

Furthermore, there is no indication that the implementation of the claimed steps, including the steps of capturing and validating the expense entry data at the mobile device, requires something other than generic computing components performing generic computing functions that are well-known, routine, and conventional, such as receiving, analyzing, and transmitting data. *See* Spec. ¶¶ 131–136 (describing the system architecture). As such, we fail to see how the claimed invention is something other than the generic computer implementation of an improved business practice, which is insufficient for patent-eligibility. *See DDR Holdings*, 773 F.3d at 1256 ("[T]hese claims [of prior cases] in substance were directed to nothing more than the performance of an abstract business practice on the Internet or using a conventional computer. Such claims are not patent-eligible.").

Appellants additionally argue that independent claim 1 recites significantly more than the abstract idea because it recites limitations that add new information to the gathered data, thereby transforming data. Reply Br. 6–7. Appellants' argument does not apprise us of error.

As an initial matter, the machine-or-transformation is not the standard for determining whether a claim recites significantly more than the abstract idea. *DDR Holdings*, 773 F.3d at 1256 ("[S]atisfying the machine-or-transformation test, by itself, is not sufficient to render a claim patent-eligible, as not all transformations or machine implementations infuse an otherwise ineligible claim with an 'inventive concept.'"). Nonetheless, a transformation of data is not sufficient to meet the transformation prong of

the test. *See Gottschalk v. Benson*, 93 S. Ct. 253, 257 (1972) (holding that a computer-based algorithm that merely transforms data from one form to another is not patent-eligible).

In view of the foregoing, Appellants do not apprise us of error in the Examiner's determination that independent claim 1 is patent-ineligible, i.e., judicially excepted from statutory subject matter. Accordingly, we sustain the rejection of claims 1–30 under 35 U.S.C. § 101.

Written Description

The Examiner finds the disclosure does not provide support for the limitation reciting "periodically downloading, from the enterprise expense application, at least a portion of the set of enterprise-specific reference data to the mobile expense application to perform validation checks on one or more expense entries," in each of independent claims 1, 11, and 21. Final Act. 6. According to the Examiner, although the limitation recites "periodically," the disclosure does not mention a time or a period of downloading, or how long the period is between downloads. Ans. 4–5.

In contrast, Appellants argue the disclosure provides sufficient support for this limitation. Appeal Br. 23–24 (citing Spec. ¶¶ 51, 52); Reply Br. 9–10. We agree with Appellants.

The test for sufficiency of the written description requirement is "whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (citations omitted). As Appellants point out (Appeal Br. 24), paragraph 52 explains "[a]fter the first

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login, whenever the user invokes the mobile application, the user will be navigated to the main interface screen to perform the mobile expense functions . . . [i]n some embodiments, new reference data may be downloaded or synchronized at that time." Paragraph 52 further explains that "[i]f the user accesses the mobile application in a disconnected mode (e.g., without a wireless connection or a VPN/Network connection), the mobile application will not sync any reference data." Given the Specification describes that the mobile application syncs with the server at various times, such as when a user invokes the mobile application or connects to the server, the disclosure reasonably conveys to those skilled in the art that, as of the filing date, the inventors had possession of the claimed subject matter, including "periodically" downloading reference data, as recited in the disputed limitation.

In view of the foregoing, the Examiner has not sufficiently shown that the disputed limitation lacks written description support. We, therefore, do not sustain the Examiner's rejection of independent claims 1, 11, and 21 and dependent claims 2–10, 12–20, and 22–30 under 35 U.S.C. § 112, first paragraph.

Anticipation

Appellants argue that Dinamani does not disclose "validating the expense entry for policy violations by the mobile device using the downloaded enterprise-specific reference data stored at the mobile device," as recited in independent claim 1. Appeal Br. 20–21. According to Appellants, there is no disclosure of using enterprise-specific reference data to validate the expense entry because "'reconciliation' in Dinamani is

performed manually by the user himself to specify 'which of the tracked data is business related and can be applied to business related expense reports.'" *Id.* at 20 (emphasis omitted) (quoting Dinamani 9:35–37). Appellants' argument is convincing.

For disclosing the disputed limitation of independent claim 1, the Examiner relies on Dinamani's teaching of reconciling tracked data. Final Act. 8 (citing Dinamani 9:33–46); Ans. 5. As Appellants' point out Dinamani discloses that reconciliation involves determining which tracking data, i.e., expense entry, is business related. Dinamani 9:33–37; Appeal Br. 20. The cited portion of Dinamani, however, does not disclose how a user determines that the data is business related. In other words, Dinamani does not disclose that reference data is reconciled, i.e., validated, using downloaded enterprise-specific reference data stored at the mobile device, as recited in the disputed limitation.

In view of the foregoing, there is insufficient support for the Examiner's finding that Dinamani discloses "validating the expense entry for policy violations by the mobile device using the downloaded enterprise-specific reference data stored at the mobile device," recited in independent claim 1. Each of independent claims 11 and 21 includes the same limitation, and the Examiner's rejection of independent claims 11 and 21 is based on the same deficient finding. Final Act. 9. Accordingly, we do not sustain the Examiner's rejection of independent claims 1, 11, and 21 and dependent claims 2–10, 12–20, and 22–30 under 35 U.S.C. § 102(a).

DECISION

The Examiner's decision to reject claims 1–30 under 35 U.S.C. § 101 is affirmed.

The Examiner's decision to reject claims 1–30 under 35 U.S.C. § 112, first paragraph, is reversed.

The Examiner's decision to reject claims 1–30 under 35 U.S.C. § 102(a) 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). 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED