UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,260	10/16/2006	John Colgrave	GB920030007US1	5696

141836   7590   07/03/2018
IBM Poughkeepsie
C/O: Fabian VanCott
215 South State Street
Suite 1200
Salt Lake City, UT 84111

EXAMINER
COPPOLA, JACOB C

ART UNIT	PAPER NUMBER
3621	

NOTIFICATION DATE	DELIVERY MODE
07/03/2018	ELECTRONIC

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

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@fabianvancott.com

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

Ex parte JOHN COLGRAVE

_____

Appeal 2016-004678
Application 10/561,260[1]
Technology Center 3600

_____

Before HUBERT C. LORIN, ANTON W. FETTING and
NINA L. MEDLOCK, *Administrative Patent Judges.*

LORIN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

John Colgrave (Appellant) seeks our review under 35 U.S.C. § 134(a)
of the Final Rejection of claims 17–20 and 27–32. We have jurisdiction
under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

---

[1] The Appellant identifies International Business Machines Corporation as
the real party in interest. App. Br. 2.

THE INVENTION

Claim 17, reproduced below, is illustrative of the subject matter on appeal.

17. A method for a registry of business entity definitions to handle user requests to access business entity definitions, the method comprising:

receiving a request in a processor associated with said registry from a user to access a business entity definition comprising a plurality of information elements, each of said information elements having permission details associated therewith;

obtaining the identity of the user from data associated with the request with said processor;

determining with said processor, for each of said information elements, whether the user has permission to access that said information element based on the permission details associated with that said information element and said identity of the user; and

with said processor, denying the user access to those information elements for which it is determined that the user does not have permission.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

| Nykanen | US 2002/0174117 A1 | Nov. 21, 2002 |
| Keen et al. | WO 01/22299 A1 | Mar. 29, 2001 |

The following rejections are before us for review:

1. Claims 17–20 and 27–32 are rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

2. Claims 17–20 and 27–32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nykanen and Keene.

3. Claims 17–20 and 27–32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Keene and Nykanen.

ISSUES

Did the Examiner err in rejecting claims 17–20 and 27–32 under 35 U.S.C. §101 as being directed to judicially-excepted subject matter?

Did the Examiner err in rejecting claims 17–20 and 27–32 under 35 U.S.C. § 103(a) as being unpatentable over Nykanen and Keene?

Did the Examiner err in rejecting claims 17–20 and 27–32 under 35 U.S.C. § 103(a) as being unpatentable over Keene and Nykanen?

ANALYSIS

The rejection of claims 17–20 and 27–32 under 35 U.S.C. §101 as being directed to judicially-excepted subject matter.

The Appellant argued these claims as a group. We select claim 17 as the representative claim for this group, and the remaining claims 18–20 and 27–32 stand or fall with claim 17. 37 C.F.R. § 41.37(c)(1)(iv).

Alice Corp. Proprietary Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent-eligibility under 35 U.S.C. § 101.

According to *Alice* step one, "[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept," such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

In that regard, the Examiner determined "[t]he claims are directed to the abstract idea of controlling access to business entity definitions." Final Rej. 2.

The Appellant agrees that claim 17 is directed to, more generally, the concept of controlling access to data. "[I]t would seem that the 'abstract idea' at issue is controlling access to data." App. Br. 11.

The Appellant then argues that "the claimed subject matter is significantly more than the abstract idea of 'controlling access to data'" (*id.* at 12) because:

> "[C]ontrolling access *to business entity definitions*" is a specific application of the larger idea of "controlling access to data"[ ] [and] Appellant's claims are a specific method of controlling access to business entity definitions including all of the following: requiring that a business entity definition be divided into a plurality of information elements, each of which has separate permission details associated therewith, and requiring that it is the identity of the user, and not some other characteristic or classification, that determines, on an element-by-element basis, whether access will be granted.

Id. at 11–12 (emphasis added).

This is an unpersuasive argument.

Focusing on "business entity definitions" as the type of data to which access is controlled does not render the abstract idea "controlling access to data" any less abstract. Limiting "data" to which access is controlled to "business entity definitions" simply limits the "controlling access to data" abstract idea to a particular environment; that is, to business entity definitions. *Cf. Return Mail, Inc. v. United States Postal Service*, 868 F.3d 1350, 1368 (Fed. Cir. 2017) ("'[L]imit[ing] the abstract idea to a particular environment," here a mail processing system with generic computing

technology, "does not make the claims any less abstract for the step 1 analysis.'") (quoting *In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016)). *See also Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) ("collecting information, including when limited to particular content (which does not change its character as information), [is] within the realm of abstract ideas."). It still is an abstract idea but one described at a lower level of abstraction. *Cf. Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240–41 (Fed. Cir. 2016) ("An abstract idea can generally be described at different levels of abstraction. As the Board has done, the claimed abstract idea could be described as generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location. It could be described in other ways, including, as indicated in the specification, taking orders from restaurant customers on a computer.")

Step two is "a 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.'" *Alice,* 134 S. Ct. at 2355 (quoting *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 566 U.S. 66, 73 (2012)).

In that regard, the Examiner determined that

[t]he additional elements or combination of elements in the claims other than the abstract idea per se amount to no more than: (i) mere instructions to implement the idea on a computer, and/or (ii) recitation 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. Viewed as a whole, these additional claim elements do not provide meaningful limitations to transform the

abstract idea into a patent eligible application of the abstract
idea such that the claims amount to significantly more than the
abstract idea itself. For example, claim 17 recites a "processor"
performing well-understood, routine, and conventional
activities such as denying a user access to data if they do not
have permission to the data. Also, for example, claim 31
recites a "server computer ... wherein the server is programmed
for," which is merely a generically recited computer structure
with software for performing routing operations, such as
"receiving a request .... "

Final Rej. 2–3.

The Appellant argues that claim 17 presents something novel. "[I]t
cannot be reasonably argued at this point that Appellant's claims are to an
abstract idea because they present nothing novel, nothing that is not well-
known and conventional." App. Br. 12.

"[N]ovelty in implementation of the idea is a factor to be considered
only in the second step of the *Alice* analysis." *Ultramercial, Inc. v. Hulu,
LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014). [N]ovelty is a factor to be
considered when determining "whether the claims contain an 'inventive
concept' to 'transform' the claimed abstract idea into patent-eligible subject
matter." *Id*. However, a finding of novelty or nonobviousness does not
necessarily lead to the conclusion that subject matter is patentable eligible.
"Groundbreaking, innovative, or even brilliant discovery does not by itself
satisfy the § 101 inquiry." *Ass'n for Molecular Pathology v. Myriad
Genetics, Inc.*, 569 U.S. 576, 591 (2013). The question in step two of the
Alice framework is not whether an additional feature is novel but whether
the implementation of the abstract idea involves "more than the performance
of 'well-understood, routine, [and] conventional activities previously known
to the industry.'" *Content Extraction and Transmission LLC v. Wells Fargo*

Bank, Nat. Ass'n, 776 F.3d 1343, 1347–48 (quoting *Alice*, 134 S. Ct. at 2359).

In that regard, the Appellant has not shown the novel features transform the abstract idea into patent-eligible subject matter. The method claimed involves the use of a "processor" which the Specification suggests covers generic processors (*see* Spec. 5:24–27 ("any such client/server . . . has a processor"). As claimed, the processor performs certain information processing steps such as "receiving," "obtaining," determining," and "denying" that generic processors are known to perform.

The Appellant further argues pre-emption. "It should be clear that Appellant's claims do not monopolize the idea of controlling access to data." App. Br. 13.

> Appellant's claims apply only if the use of business entity
> definitions that comprising multiple elements each of which has
> separate permission details associated therewith for controlling
> access. Appellant's claims apply only if the identity of the
> requestor, and not some other characteristic or classification, is
> considered against the permission details on an element-by-
> element basis for granting or denying access to a specific
> element of the business entity definition.

Id.

A difficulty with this argument is that it appears to confuses the pre-emption concern with the level of abstraction describing the abstract idea. With respect to the pre-emption concern, "[w]hat matters is whether a claim threatens to subsume the full scope of a fundamental concept, and when those concerns arise, we must look for meaningful limitations that prevent the claim as a whole from covering the concept's every practical application." *CLS Bank Intern. v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269,

1281 (Fed. Cir. 2013) (Lourie, J., concurring). Here, said relied-on claim limitation simply narrows the abstract idea so that it is described at a lower level of abstraction. It does not render the abstract idea to which the claim is directed to any less an abstract idea. Pre-emption is not a separate test.

> To be clear, the proper focus is not preemption *per se,* for some measure of preemption is intrinsic in the statutory right granted with every patent to exclude competitors, for a limited time, from practicing the claimed invention. *See* 35 U.S.C. § 154. Rather, the animating concern is that claims should not be coextensive with a natural law, natural phenomenon, or abstract idea; a patent-eligible claim must include one or more substantive limitations that, in the words of the Supreme Court, add "significantly more" to the basic principle, with the result that the claim covers significantly less. *See Mayo* 132 S. Ct. at 1294. Thus, broad claims do not necessarily raise § 101 preemption concerns, and seemingly narrower claims are not necessarily exempt.

Id.; see also 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."). Because we find the claimed subject matter covers patent-ineligible subject matter, the pre-emption concern is necessarily addressed. "Where a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, [] preemption concerns are fully addressed and made moot." *Ariosa Diagnostics*, 788 F.3d at 1379.

Finally, Appellant relies on *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014) to argue that "the present claims are necessarily rooted in computer technology and describe subject matter to address issues specifically arising in the realm of computer networks." App. Br. 14.

However, there is no mention of computer networks in claim 17 and the computer technology that claim 17 does mention is a "processor" which the Specification suggests covers any generic processor. *Cf. Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012) ("Simply adding a 'computer aided' limitation to a claim covering an abstract concept, without more, is insufficient to render the claim patent eligible."). "[T]he claims at issue [in *DDR*] specif[ied] how interactions with the Internet are manipulated to yield a desired result—a result that overrides the routine and conventional sequence of events ordinarily triggered by the click of a hyperlink." *DDR*, 773 F.3d at 1257. In contrast, here, claim 17 covers a generic processor performing information processing steps such as "receiving," "obtaining," "determining," and "denying" that generic processors are known to perform, albeit involving specific types of information which as such do not add significantly more to the controlling access data abstract idea claim 17 is directed to. *See Bancorp Services, L.L.C. v. Sun Life Assur. Co. of Canada (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) ("[T]he use of a computer in an otherwise patent-ineligible process for no more than its most basic function—making calculations or computations—fails to circumvent the prohibition against patenting abstract ideas and mental processes.").

The Appellant separately argues that "claim 31 recites a machine, which is an expressly permitted category of patentable subject matter under 35 U.S.C. § 101." App. Br. 15. But the question is not whether claim 31 is statutory. It is. The question is whether it is judicially-excepted from patent-eligibility for being directed to an abstract idea without adding

significantly more to transform it into an inventive concept. In that regard, claim 31 tracks claim 1 and therefore the Examiner's position that claim 1 is patent-ineligible applies to claim 31 as well.

We have considered all of the Appellant's remaining arguments and have found them unpersuasive. Accordingly, because representative claim 17, and claims 18–20 and 27–32 which stand or fall with claim 17, are directed to an abstract idea and do not present an "inventive concept," we sustain the Examiner's determination that they are directed to ineligible subject matter under 35 U.S.C. § 101. *Cf. LendingTree, LLC v. Zillow, Inc.*, 656 F. App'x. 991, 997 (Fed. Cir. 2016) ("We have considered all of LendingTree's remaining arguments and have found them unpersuasive. Accordingly, because the asserted claims of the patents in suit are directed to an abstract idea and do not present an "inventive concept," we hold that they are directed to ineligible subject matter under 35 U.S.C. § 101.").

The rejection of claims 17–20 and 27–32 under 35 U.S.C. § 103(a) as being unpatentable over Nykanen and Keene.

The Examiner's position is that Nykanen discloses all that is claimed but

> does not directly disclose: each of said information elements having permission details associated therewith; determining with said processor, for each of said information elements, whether the user has permission to access that said information element based on the permission details associated with that said information element and said identity of the user; and with said processor, denying the user access to those information elements for which it is determined that the user does not have permission.

Final Rej. 4. Keene is relied on as disclosing said missing disclosure. Final Rej. 4–5. The Examiner argues, *inter alia*, that "it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the process of Nykanen to include having permission details associated with each element, as taught by Keene, and to modify the process of Nykanen to include determining whether the user has permission to access each element, also taught by Keene." Final Rej. 5.

The difficulty with the Examiner's position is that it does explain how the combination of Nykanen and Keene would lead one of ordinary skill in the art, first, to include "a plurality of information elements, each of said information elements having permission details associated therewith" in a business entity definition, and then, second, to determine for each of said information elements, whether the user has permission to access that said information element based on the permission details associated with that said information element and said identity of the user; and deny the user access to those information elements for which it is determined that the user does not have permission, as claimed. We agree with the Appellant that

> Keene is merely describing that groups of data or objects may
> have access codes associated therewith and that an authorized
> user is granted access to that group or object. Keene does not
> teach or suggest different access privileges for different
> information elements within a business entity definition as
> claimed. None of the cited references teach or suggest this
> idea.

App. Br. 17. We agree that "[n]either reference, nor any combination of the two, teaches or suggests that a particular user may have access [to] some elements within the business entity definition and not to others: 'determining with said processor, *for each of said information elements, whether the user*

11

has permission to access that said information element based on the
permission details associated with that said information element and said
identity of the user.' (Claim 17) (emphasis added)." App. Br. 18.

The rejection is not sustained.

*The rejection of claims 17–20 and 27–32 under 35 U.S.C. § 103(a) as being
unpatentable over Keene and Nykanen.*

The Examiner's position is that Keene discloses all that is claimed but
for "that the record is a business entity definition," for which Nykanen is
relied on. Final Rej. 9. "[I]t would have been obvious to one of ordinary
skill in the art, at the time the invention was made, to modify the records of
Keene to include business entity definitions, as taught by Nykanen." Final
Rej. 10.

But this has a similar difficulty. The claims do not simply call for
information elements having permission details as Keene is said to disclose
and a business entity definition as Nykanen is said to disclose. Rather, the
claims call for "a business entity definition comprising a plurality of
information elements, each of said information elements having permission
details associated therewith." How one of ordinary skill in the art given
Keene's information elements having permission details and Nykanen's
business entity definition would be led first, to include "a plurality of
information elements, each of said information elements having permission
details associated therewith" in a business entity definition, and then,
second, to determine for each of said information elements, whether the user
has permission to access that said information element based on the
permission details associated with that said information element and said

identity of the user; and deny the user access to those information elements for which it is determined that the user does not have permission, as claimed, is not adequately explained.

The rejection is not sustained.

CONCLUSIONS

The rejection of claims 17–20 and 27–32 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter is affirmed.

The rejection of claims 17–20 and 27–32 under 35 U.S.C. § 103(a) as being unpatentable over Nykanen and Keene is reversed.

The rejection of claims 17–20 and 27–32 under 35 U.S.C. § 103(a) as being unpatentable over Keene and Nykanen is reversed.

DECISION

The decision of the Examiner to reject claims 17–20 and 27–32 is affirmed.

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