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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JULIANA FREIRE, CLAUDIO T. SILVA,
LOUIS BAVOIL, STEVEN P. CALLAHAN,
EMANUELE SANTOS, CARLOS E. SCHEIDEGGER,
and HUY T. VO

Appeal 2016-004798
Application 11/697,922¹
Technology Center 3600

Before HUBERT C. LORIN, PHILIP J. HOFFMANN and
MATTHEW S. MEYERS, Administrative Patent Judges.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Juliana Freire, et al., (Appellants) seek our review under 35 U.S.C. § 134(a) of the Final Rejection of claims 1–5, 7–16, and 18–25. We have jurisdiction under 35 U.S.C. § 6(b).

¹ The Appellants identify The University of Utah Research Foundation as the real party in interest. Br. 3.

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Claim 3, reproduced below, is illustrative of the subject matter on appeal.

3. A method of presenting a plurality of workflows that describe an evolutionary workflow process associated with creating a result, the method comprising:

receiving a first workflow by a first computing device, wherein the first workflow comprises a first plurality of modules, wherein a first module of the first plurality of modules is configured to apply a first mathematical function to data input to the first module to form a first result input to a second module of the first plurality of modules, wherein the second module is configured to apply a second mathematical function to the first result to form a second result;

receiving a modification of the first workflow by the first computing device, wherein the received modification comprises an action indicator indicating an action taken by a user in modifying the first workflow to create a second workflow, wherein the second workflow comprises a second plurality of modules configured to form a third result; and

presenting an evolutionary workflow process by a presentation device of a second computing device, the evolutionary workflow process comprising a first indicator indicating the first workflow and a second indicator indicating the second workflow, the evolutionary workflow process further indicating that the second workflow was created by modifying the first workflow.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Charisius	US 2002/0075293 A1	June 20, 2002
Aron	US 2006/0229924 A1	Oct. 12, 2006
Carson	US 2007/0088957 A1	Apr. 19, 2007

The following rejections are before us for review:

1. Claims 1–5, 7–16, and 18–25 are rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.
2. Claims 4, 12, and 16 are rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention.
3. Claims 1–5, 7–16, 18–21, 23, and 24 are rejected under 35 U.S.C. §102(b) as being anticipated by Charisius.
4. Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Charisius and Aron.
5. Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Charisius and Carson.

ISSUES

Did the Examiner err in rejecting claims 1–5, 7–16, and 18–25 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter?

Did the Examiner err in rejecting claims 4, 12, and 16 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention.

Did the Examiner err in rejecting claims 1–5, 7–16, 18–21, 23, and 24 under 35 U.S.C. §102(b) as being anticipated by Charisius?

Did the Examiner err in rejecting claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Charisius and Aron?

Did the Examiner err in rejecting claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Charisius and Carson?

ANALYSIS

The rejection of claims 1–5, 7–16, and 18–25 under 35 U.S.C. §101 as being directed to non-statutory subject matter.

The Appellants argued these claims as a group. See Br. 23–29. We select claim 3 as the representative claim for this group, and the remaining claims—claims 1, 2, 4, 5, 7–16, and 18–25—stand or fall with claim 3. 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 that “the claims are directed to the abstract idea of receiving and presenting workflow data.” Final Rej. 9.

The Appellants disagree, arguing

The claims are not directed to receiving and presenting workflow data. Thus, at the outset, the Examiner has not properly identified an abstract idea from which any determination of “significantly more” can be determined. Appellants respectfully submit that the purpose of the claims is to present an evolutionary workflow process not a workflow itself even if the workflow itself is presented in a way that shows how it was created by modifying a previous workflow.

Br. 23.

The Examiner’s characterization of what claim 3 is directed to aligns with what claim 3 describes. The preamble of the claim recites “a method of presenting a plurality of workflows that describe an evolutionary workflow process associated with creating a result.” This parallels somewhat with the Appellants’ “present[ing] an evolutionary workflow process” characterization. (“[W]e see no error here in the district court citing to the preamble in its review of whether the claims are directed to an abstract idea. *Two-Way Media Ltd. v. Comcast Cable Communications, LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017).) But the remaining steps call for “receiving a first workflow by a first computing device,” “receiving a modification of the first workflow by the first computing device,” and, “presenting an evolutionary workflow process by a presentation device of a second computing device,” each of which necessarily involves workflow-related data. While the preamble supports the Appellants’ characterization, the body of the claim supports the Examiner.

Irrespective of how the concept to which the claim is directed is expressed – whether as “receiving and presenting workflow data” as the Examiner articulates it or as “present[ing] an evolutionary workflow process” as the Appellants characterize it or even as a combination of these concepts (which would more accurately characterize the claim as a whole) –

claim 3 is directed to an abstract idea. The Appellants do not dispute that if the concept to which the claim is directed is expressed as “receiving and presenting workflow data” it is directed to an abstract idea. Claim 3 is no less directed to an abstract idea by expressing the concept to which it is directed to alternatively as “present[ing] an evolutionary workflow process” or even the combination of presenting an evolutionary workflow process via receiving and presenting workflow data. When “the focus of the asserted claims” is “on collecting information, analyzing it, and displaying certain results of the collection and analysis,” the claims are directed to an abstract idea. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1343 (Fed. Cir. 2016).

The Appellants argue that “[e]ven if ‘presenting an evolutionary workflow process’ is properly considered an abstract idea, independent Claims 1–3 recite limitations that add significantly more to the abstract idea and are more than a mere computer implementation of the abstract idea.” Br. 23–24.

In that regard, 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 Servs. v. Prometheus Labs., Inc.*, 566 US 66, 73 (2012)).

The Examiner determined that

the claims do not include additional elements or a combination of elements that amount to significantly more than the judicial exception because the additional elements are merely directed to instructions to implement the idea on a computer and/or computer implemented

functions that are well-understood, routine, and conventional activities previously known to the art.

Final Rej. 5 (citing para. 49 of the Specification for support as an example).

“Appellants respectfully disagree that the claim limitations are ‘well-understood, routine, and conventional in the art (e.g., *modules, workflow, modifying the workflow, action indicator*)’. As discussed in Section IV and V below, the claim limitations are not well-understood, routine, or conventional in the art.” Br. 25.

This is not a persuasive argument that claim 3 includes limitations sufficient to ensure that the claimed process in practice amounts to significantly more than to be upon the abstract idea itself (however, the abstract idea is expressed). The basis for the argument that claim 3 includes limitations that are not well-understood, routine, and conventional in the art is that *they are novel and nonobvious*. See “Section IV and V” of the Appeal Brief. 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.*, 133 S. Ct. 2107, 2117 (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, claim 3 calls for two receiving steps and one presenting step, the receiving steps

involving the use of a “first computing device” and the “presenting step” involving a “second computing step.” Said “device”s cover generic hardware. Spec. ¶¶ 40–46. Receiving and presenting information per se are functions commonly associated with conventional processors, for example.

Claim 3 does further require the data received and presented by the “first computing device” and “second computing device,” respectively, to have particular content; that is, “receiv[ing] a first workflow [] compris[ing] a first plurality of modules ...”; “receiv[ing] a modification of the first workflow [] compris[ing] an action indicator indicating an action taken by a user ...”; and, “presenting an evolutionary workflow process [] comprising a first indicator indicating the first workflow and a second indicator indicating the second workflow, the evolutionary workflow process further indicating that the second workflow was created by modifying the first workflow.” The recited modules, workflow, modifying the workflow, and action indicator describe particular content for the information the computing devices are to receive and present. But receiving and presentation information, including when limited to particular content – whether or not the content of the information would have been known, is within the realm of abstract ideas. *See, e.g., Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1349 (Fed. Cir. 2015); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); and *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011). *Cf. SAP America, Inc. v. Investpic, LLC*, 890 F.3d 1016, 1022 (Fed. Cir. 2018) (“Contrary to InvestPic’s suggestion, it does not matter to this conclusion whether the information here is information about real

investments. As many cases make clear, even if a process of collecting and analyzing information is “limited to particular content” or a particular “source,” that limitation does not make the collection and analysis other than abstract.” (*Quoting Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016) (citing cases).).

The Appellants also argue that

The current claims are directed to a system that summarizes workflow information about how computational tasks . . . evolve over time during the trial and error process of generating a final data product. The claimed invention supports both exploration and re-use of workflows as well as a visualization of how the workflows evolved over time.

Br. 26. The difficulty with this argument is that it is not commensurate in scope with what is claimed. Claim 3 does not describe summarizing workflow information about how computational tasks evolve over time during the trial and error process of generating a final data product. Furthermore, even assuming *arguendo* that claim 3 included a summarizing step limited to summarizing such a particular type of information, we do not see how that renders the process any less abstract. While such a claim would be described at a lower level of abstraction, it would still be abstract. *Cf. Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240–1241 (Fed. Cir. 2016) (An abstract idea can generally be described at different levels of abstraction.)

The Appellants also argue that

The claimed subject matter is an improvement to the functioning of a computer in presenting an evolutionary workflow process because it presents the information to a user in a more meaningful way by determining when a workflow is modified (“receive a modification of the first workflow”) and

by indicating “that the second workflow was created by modifying the first workflow” so that the user better understands how the workflow has evolved through user interaction.

Br. 27. According to the Appellants, “the claimed solution amounts to an inventive concept for resolving [] particular computer-centric problems and improves numerous technical fields, such as image analysis, rendering the claims patent-eligible.” Br. 28. But presenting information in a more meaningful way so that a user can better understand it is not only not mentioned in the claim but the claim does not reflect any particular computer-centric solution for achieving it. The claim covers generic computing devices in order to receive and present information, albeit a certain type of information. The devices as claimed, individually and in the ordered combination as claimed, operate as they normally would be expected to. Save for the type of information being processed – which is not patentably consequential - the claimed process does not reflect an improvement to the functioning of a computer. Rather, claim 3 recites a scheme “relate[d] to the capture and modeling of provenance information associated with the evolutionary development of workflows to streamline the discovery process” (Spec. ¶2) involving the generalized use of computers as tools to conduct said scheme. Claim 3 does not provide any details which can be interpreted as inventive technology for performing the functions as claimed. *Cf. Credit Acceptance Corp. v. Westlake Services, LLC*, 859 F.3d 1044, 1057 (Fed. Cir. 2017):

Significantly, the claims do not provide details as to any non-conventional software for enhancing the financing process. *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1342 (Fed. Cir. 2017) (explaining that “[o]ur law demands more” than

claim language that “provides only a result-oriented solution, with insufficient detail for how a computer accomplishes it”); Elec. Power Grp., 830 F.3d at 1354 [Elec. Power Grp., LLC v. Alstom S.A., 830 F.3d 1350, 1354 (Fed. Cir. 2016)]; (explaining that claims are directed to an abstract idea where they do not recite “any particular assertedly inventive technology for performing [conventional] functions”).

We have considered all of the Appellants' remaining arguments and have found them unpersuasive. *Cf. LendingTree, LLC v. Zillow, Inc.*, 656 Fed.Appx. 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.

Accordingly, because representative claim 3, and claims 1, 2, 4, 5, 7–16, and 18–25 that stand or fall with claim 3, 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. The rejection is sustained.

The rejection of claims 4, 12, and 16 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention.

Claim 4 further limits claim 3 so that “the second computing device is the first computing device.”

The Examiner argues that

The term “second computing device” in claim 4 is used by the claim to mean “first computing device”, while the

accepted meaning for referring to a “second computing device” is that the second device is another device (hence the additional language distinguishing a “first device” from a “second device” in the first place). The term is indefinite because the specification does not clearly redefine the term.

Final Rej. 7.

The Appellants disagree, arguing that “[c]laim 4 merely makes clear, and in fact, unambiguous[,] that the two devices in Claim 3 may not be separate and distinct devices.” Br. 18.

We think the evidence, on balance, more strongly supports the Appellants’ position. We do not see in the original Specification the claimed first and second computing devices being defined as representing two individual machines physically independent of each other. As long as a computing device (labeled “first” and “second”) performs the steps as claimed, the method as claimed is practiced. As reasonable broadly construed in light of the Specification, the same device could perform said steps *as* both the “first” and “second” device. Accordingly, “the second computing *device* [can be] the first computing *device*.” Claim 4 (emphasis added).

For similar reasons, we do not find that a preponderance of the evidence supports the Examiner’s narrow construction of claim 12 (“wherein the second user is the user”) as having “the accepted meaning for referring to a “second user” [whereby] the second user is another user (hence the additional language distinguishing a “second user” from “a user” in the first place).” Final Rej. 8. We agree with the Appellants that, in light of the Specification claim 12 is reasonably broadly construed such that the two users refer to the same “user” (i.e., the same person). Br. 20.

For similar reasons, we do not find that a preponderance of the evidence supports the Examiner’s narrow construction of claim 16 (“wherein the second presentation device is the presentation device”) as having “the accepted meaning for referring to a “second presentation device” [whereby] the second presentation device is another presentation device (hence the additional language distinguishing a “second presentation device” from “the presentation device” in the first place).” Final Rej. 9. We agree with the Appellants that, in light of the Specification claim 16 is reasonably broadly construed such that the two presentation devices refer to the same “presentation device” (i.e., the same machine). Br. 21.

The rejection is not sustained.

The rejection of claims 1–5, 7–16, 18–21, 23, and 24 under 35 U.S.C. §102(b) as being anticipated by Charisius.

We agree with the Appellants that “[n]owhere does the Examiner indicate where Charisius provides any teaching related to ‘wherein the received modification comprises an action indicator indicating an action taken by a user in modifying the first workflow to create a second Workflow’ [independent claims 1–3].” Br. 30.

The Examiner does not specifically treat said limitation. Rather, the Examiner makes the following finding (for claims 1–3) with respect to the claim step that contains said limitation.

receive a modification of the first workflow, wherein the received modification comprises an action indicator indicating an action taken by a user in modifying the first workflow to create a second workflow, wherein the second workflow comprises a second plurality of modules configured to form a third result (paragraphs 14-17, 184-186, 191-192 and Figs. 91-92: e.g., the tool 200 allows a user to store the

modifications made to a plan. and allows the user to view the changes made to a plan over time; See also. paragraph 74: FIG. 88 depicts the workflow of FIG. 82 with a revision; See also. paragraphs 180 and 184: e.g. may view the changes made to a plan or workflow over time. or may view the various plans created from a given workflow over time);

Final Rej. 12–13. Where in Charisius the action indicator as claimed is expressly or inherently described is not explained. We have reviewed the cited disclosures but have been unable to find it.

In response, the Examiner maintains that one skilled in the art would recognize Charisius as teaching this in at least paragraphs 14-17, 74, 180, 184-186, 191–192, and Figs. 82, 88, 91-92, wherein Charisius’s teaching of features that allow for storing modifications and allowing a user to view changes (i.e., action indicators that modify the workflow)

Ans. 13. But the question under §102 is not whether one skilled in the art would *recognize* Charisius as teaching the action indicator as claimed but whether Charisius *in fact* describes it. Since that has not been shown in the first instance, the rejection is not sustained.

The rejection of claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Charisius and Aron.

The rejection of claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Charisius and Carson.

Claims 22 and 25 depend from claim 2 and include the limitation as to the action indicator discussed above. The Examiner relies on the finding (reproduced above) that one skilled in the art would recognize Charisius as teaching the action indicator as claimed. Final Rej. 19–21. Because it has not been established in the first instance that Charisius in fact describes the

action indicator or renders it obvious these rejections are similarly not sustained.

CONCLUSIONS

The rejection of claims 1–5, 7–16, and 18–25 under 35 U.S.C. §101 as being directed to non-statutory subject matter is affirmed.

The rejection of claims 4, 12, and 16 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention is reversed.

The rejection of claims 1–5, 7–16, 18–21, 23, and 24 under 35 U.S.C. §102(b) as being anticipated by Charisius is reversed.

The rejection of claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Charisius and Aron is reversed.

The rejection of claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Charisius and Carson is reversed.

DECISION

The decision of the Examiner to reject claims 1–5, 7–16, and 18–25 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