



# 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.
13/244,610	09/25/2011	Paul Morinville	IBIG1110-6	5170
42671	7590	10/30/2017	EXAMINER	
LAW OFFICES OF MARK L. BERRIER 1715 S. Capital of Texas Hwy. Suite 200-E Suite 200-E AUSTIN, TX 78746			BOYCE, ANDRE D	
			ART UNIT	PAPER NUMBER
			3623	
			MAIL DATE	DELIVERY MODE
			10/30/2017	PAPER

**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.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* PAUL MORINVILLE

---

Appeal 2016-004886  
Application 13/244,610  
Technology Center 3600

---

Before THU A. DANG, ELENI MANTIS MERCADER, and  
MATTHEW J. McNEILL, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

I. STATEMENT OF THE CASE

Appellant has filed a Request for Rehearing under 37 C.F.R. § 41.52 (hereinafter “Request”) on September 26, 2017 for reconsideration of affirmance of the Examiner’s rejections of claims 1–20 in a Decision mailed July 31, 2017 (hereinafter “Decision”). The Decision affirmed the rejection of claims 1–20 under 35 U.S.C. § 101; the rejection of claims 1–8, 10–18, and 20 under 35 U.S.C. § 102(e) over Elkin; and the rejection of

claims 9 and 19 under 35 U.S.C. § 103(a) over the teachings of Elkin and Kim.

We have reconsidered our Decision regarding the claims in light of Appellant's comments in the Request (Req. Reh'g 4–16). We grant the Rehearing Request to the extent that we consider the Appellant's arguments *infra*, but DENY the request to modify our Decision. We incorporate our earlier Decision herein by reference. *See* 37 C.F.R. § 41.52(a)(1).

## II. ISSUES

The issues we address in this Request are whether Appellant has persuasively identified that the Board misapplied the relevant law or misapprehended Appellant's arguments set forth in the Appeal Brief in finding no error with the following:

1. The Examiner's finding that the claimed method is directed to ineligible subject matter, wherein the method comprises the steps of a user "providing input" to a computer, the computer "initiating a management event," the management event "initiating one or more transactional events," a first transaction event "performing a transaction," "generating" and "providing resulting" transactional information, and the management event "controlling the user's access" based on the resulting transactional information (claim 1 ); and
2. The Examiner's rejection of claim 1 over Elkin, by finding Elkin teaches a management event "accepting the user input," and a "transactional" event initiated by the management event "generating resulting transactional information" and "providing the *resulting*

*transactional information to the management* event while the management event remains pending” (*id.*, emphasis added).

### III. ANALYSIS

#### *35 U.S.C. § 101*

Appellant contends that the Board misapprehended and/or overlooked the Examiner’s failure to establish a *prima facie* case of patent ineligibility. See Req. Reh’g 4. In particular, Appellant argues “the Examiner did not identify each individual element of claim 1 (or any of the other claims), and did not identify *any* ordered combination of claim elements for any of the claim,” but instead, “considered only 6 of the 132 words in claim 1.” *Id.* at 5. Appellant argues “[t]he Examiner’s boilerplate rejection does not amount to an *explanation* of why the lone six-word element of claim 1 identified by the Examiner sets forth a judicial exception.” *Id.* at 6.

In addition, Appellant argues “the Board misapprehended and/or overlooked the Examiner’s failure to consider whether the claims solve a technology-based problem.” *Id.* at 7. In particular, Appellant argues “the invention addresses problems that existed in the prior art” wherein the claims, “when considered as an ordered combination of the claim limitations, recite particular, practical applications of the methods . . . that improve the performance of the computers in which they are implemented.” *Id.* at 9.

We are not persuaded. The Federal Circuit has repeatedly noted “the *prima facie* case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (*citing In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). The Federal Circuit has, thus, held the USPTO carries its procedural burden

of establishing a *prima facie* case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” See *In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011). Thus, all that is required is that the Office set forth the statutory basis of the rejection in a sufficiently articulate and informative manner so as to meet the notice requirement of § 132. *Id.*

Here, as set forth in our Decision, we agreed with the Examiner’s conclusion that the claims are directed to “the abstract idea of completing execution of a business process.” Decision 6. That is, the claims merely recite steps of a user “providing input” to a computer, the computer “initiating a management event,” the management event “initiating one or more transactional events,” a first transaction event “performing a transaction,” “generating” and “providing resulting transactional information,” and the management event “controlling the user’s access” based on the resulting transactional information (claim 1 ), which are merely steps directed to “the abstract idea of completing execution of a business process.” Decision 6.

As we noted in our Decision, our reviewing courts have held fundamental economic and conventional business practices as being abstract ideas (*Id.*, citing *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015) and *Bascom Glob. Internet Svcs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016)). Here, we found that the concept of executing a business process (“initiating” a management event, “performing” a transaction, and “controlling” access

based on “resulting transaction information”) is a fundamental business practice long prevalent in our system of commerce. *Id.* Thus, we agreed with the Examiner that completing the execution of a business process is an “abstract idea” beyond the scope of § 101. *Id. citing Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2356. Thus, in our Decision, we found that the Examiner has set forth the statutory basis of the rejection in a sufficiently articulate and informative manner so as to meet the notice requirement of § 132, and, therefore, has established a prima facie case as to step one of *Alice*. *Id.* at 7.

Although Appellant contends that the claims improve the performance of the computers in which they are implemented.” Req. Reh’g at 9., as we noted in our Decision, “the relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” Decision at 6, citing *Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2359. Here, we concluded that they do not. *Id.*

As we found in our Decision, taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. *Id.* That is, “[u]sing a computer to receive user input and generate information from the user input to provide the resulting information (to control the user’s access) are the most basic functions of a computer.” *Id.* Thus, we agreed with the Examiner conclusion’s that “no more than a general purpose computer, performing generic computer functions that are well-understood, routine, and conventional activities previously known to the pertinent industry is required by the claims” (*Id.* citing Ans. 5).

As the Examiner finds, “there isn’t any improvement to another technology or technical field, or the functioning of the computer itself” and “there are not any meaningful limitations beyond generally linking the

abstract idea to a particular technological environment” (Ans. 5). Thus, we agreed with the Examiner that the claims at issue amount to nothing significantly more than executing a business process using some unspecified, generic computer, which is not enough to transform an abstract idea into a patent-eligible invention. Decision 8, *citing Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2360.

On this record, Appellant has not identified that the Board has misapplied the relevant law or misapprehended Appellant’s arguments.

*35 U.S.C. § 102(e)*

Appellants also contend that “the Board misapprehended the Appellant’s arguments as to the distinctions between the claims and the cited prior art (Elkin).” Req. Reh’g 10. Appellants contend “[t]here is no teaching in Elkin that the completed first process somehow reverts to an incomplete, pending state at a later time.” *Id.* at 12. Appellants contend “the claims requires that the management event (the first event) and the transactional event (the second event) be pending at the same time” wherein “[t]his is a parallel relationships” rather than “a serial relationship” which “preclude the serial relationship explicitly taught by Elkin” (*Id.* at 13).

As we noted in our Decision, we give the claim its broadest reasonable interpretation consistent with the Specification, but will not read limitations from the Specification into the claims. Decision 8–9, *citing In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) and *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citations omitted). As we pointed out in our Decision, the claims merely require a “transactional event” initiated by a “management event” that generates “resulting transactional information,” wherein “the resulting transactional information” is provided to the

management event while the management event remains pending (Decision 9, citing claim 1). Given the broadest reasonable interpretation of the claims, we concluded the claims merely require a “management event” that comprises any event that initiates a transactional event and then receives the resulting transactional information (*id.*). That is, contrary to Appellant’s contention that the claims “preclude the serial relationship explicitly taught by Elkin” (Req. Reh’g 13), nothing in the claims precludes a “management event” that initiates a transactional event and then receives the resulting transactional information in a serial relationship.

Although Appellant contends that “[t]here is no teaching in Elkin that the completed first process somehow reverts to an incomplete, pending state at a later time” (Req. Reh’g. 12), the claims do not require that the a completed process “reverts” back to “an incomplete, pending state at a later time.” (See claim 1). As we noted in our Decision, nothing in the claims requires that the “*management* event” be interpreted to be the completed process 102 of Elkin (Decision 9) which is then reverted to an incomplete pending state. Instead, the claims merely require that a *transactional* event initiated by the management event provides the resulting information to the pending (not completed) *management* event.

As we found in our Decision, Elkin discloses a control flow model which, upon receipt of a user input, triggers the claim handling process, and the result is provided *back* to the control flow model to trigger further processes (*id.* at 10). Thus, we agreed with the Examiner’s finding that Elkin’s control flow model comprises multiple actions and results, wherein the results of one process is connected to the action of another process in the flow (*Id.* citing Ans. 6). We agreed that, in Elkin, the *same* control flow

model both triggers the transactional event and then receives the resulting information for further pending processes (*id.*). As the Examiner points out, the process result being provided to the rest of the control flow model in Elkin “is the same concept described in Appellant’s specification” in describing a “management element” that is “still pending” (*id.*).

Based on the record before us, we were unpersuaded the Examiner erred in finding Elkin teaches the contested limitations. *Id.* Thus, Appellant’s Request does not persuade us of any points we misapprehended or overlooked in the Decision.

On this record, Appellant has not identified that the Board has misapplied the relevant law or misapprehended Appellant’s arguments.

## V. CONCLUSION AND DECISION

We have considered the arguments raised by Appellant in the Request for Rehearing. Although we have considered our prior Decision in light of the Request for Rehearing, we decline to modify our prior Decision in any respect.

We therefore maintain our affirmance of the Examiner’s rejections of claims 1–20.

REHEARING DENIED