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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DOUGLAS N. BREAUX, MICHAEL F. CIPRIANI,
RICHARD C. JAWORSKI, STEVEN L. MARTIN, and
MICHAEL L. WILLIAMS

Appeal 2016-005087¹
Application 13/861,494²
Technology Center 3600

Before NINA L. MEDLOCK, BRADLEY B. BAYAT, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

BAYAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–11 and 13–18 under 35 U.S.C. § 101 as directed to non-statutory subject matter. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellants’ Appeal Brief (“App. Br.,” filed Aug. 20, 2015) and Reply Brief (“Reply Br.,” filed Apr. 18, 2016), and the Examiner’s Answer (“Ans.,” mailed Mar. 11, 2016) and Final Office Action (“Final Act.,” mailed May 5, 2015).

² Appellants identify “International Business Machines Corporation” as the real party in interest. App. Br. 1.

STATEMENT OF THE CASE

Claimed Subject Matter

Appellants' claimed "invention relates to electronic order processing." Spec. ¶ 2. Claims 1, 7, and 14 are the independent claims on appeal. Claim 7, reproduced below, is illustrative of the claimed subject matter.

7. A computer-implemented method of processing an order, comprising:
 - a computer processor receiving an order request at an input system;
 - the computer processor selecting one of a plurality of request handlers in a request system based on a type of the order request;
 - the computer processor processing the order request using the selected request handler; and
 - the computer processor generating an order receipt based on the processed order request at a receipt system, wherein the generating the order receipt includes:
 - the computer processor selecting one of a plurality of receipt format handlers based on a format of the order request, wherein each receipt format handler generates an order receipt having a format that is unique from each of the other output handlers; and the computer processor generating the order receipt using the selected receipt format handler.

App. Br. 10–11, Claims Appendix.

ANALYSIS

The Supreme Court, in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014), reiterated the two-step framework previously set forth in *Mayo*³ "for distinguishing patents that claim laws of nature, natural

³ *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 82 (2012).

phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Alice Corp.*, 134 S. Ct. at 2355. If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 78–79).

Applying the framework in *Alice*, and as the first step of that analysis, the Examiner maintains that independent claims 1, 7, and 14 are “directed to the fundamental economic practice of ‘order processing system that generates an order receipt based on an order request’, which is considered an abstract idea.” Ans. 2. Proceeding to the second step in the analysis, the Examiner determines that:

The claim(s) does/do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the generically-recited computer elements (e.g. a computing device having a processor, an input system having an input interface and a plurality of input handlers, wherein the input system selects, automatically by the processor ; a request system in communication with the input system, wherein the request system has a plurality of request handlers, and wherein the request system selects, automatically by the processor ; a receipt system in communication with the request system, wherein the receipt system has a plurality of output handlers for generating a receipt for the order request and for transmitting the receipt to the user, wherein the receipt system selects, automatically by the processor ; and etc.) do not add a meaningful limitation to the abstract idea because the actions,

functions, and/or steps performed by the generically-recited computer elements would be routine and conventional in any computer implementations.

Id. at 2–3.

As an initial matter, we note that Appellants argue independent claims 1, 7, and 14 as a group. App. Br. 7. We select independent claim 7 as representative. Thus, claims 1 and 14 stand or fall with claim 7. *See* 37 C.F.R. § 41.37(c)(1)(iv). Addressing these arguments, in turn, we do not find any to be persuasive of error in the rejection thereof.

Turning to the first step of *Alice*, Appellants argue that the Examiner erred in rejecting the independent claims under 35 U.S.C. § 101 because “it is an error to deem the claimed invention an abstract idea as it does not seek a monopolization of the concept of order processing as urged by the Office. Accordingly, Appellant[s] submit[] that the claimed invention is not directed to an abstract idea.” App. Br. 6. But preemption is not a separate test under § 101.⁴ There is no dispute that the Supreme Court has described “the concern that drives this exclusionary principle [i.e., the exclusion of abstract

⁴ 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*, 566 U.S. at 72–73. Thus, broad claims do not necessarily raise § 101 preemption concerns, and seemingly narrower claims are not necessarily exempt. *CLS Bank Int’l. v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269, 1281 (Fed. Cir. 2013) (Lourie, J., concurring).

ideas from patent eligible subject matter] as one of pre-emption.” *Alice Corp.*, 134 S. Ct. at 2354. But characterizing pre-emption as a driving concern for patent eligibility is not the same as characterizing pre-emption as the sole test for patent eligibility. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice Corp.*, 134 S. Ct. at 2354). Yet, although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Id.*; see also *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015), cert. denied, 136 S. Ct. 701 (2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”). Thus, Appellants’ argument fails to apprise us of error as to the Examiner’s determination under step one of *Alice*.

Turning to the second step of *Alice*, Appellants argue that the claimed invention recites an element or combination of elements that sufficiently ensure that the claims amount to significantly more than the abstract idea because “the current claims are allowable over the previously cited prior art due to the inventiveness of the invention.” App. Br. 6. But to the extent that Appellants maintain that the elements of the claims necessarily amount to “significantly more” than the abstract idea because the claimed process is allegedly patentable over the prior art, Appellants misapprehend the controlling precedent. Although the second step in the *Alice* framework is termed a search for an “inventive concept,” the analysis is not an evaluation

of novelty or non-obviousness, but rather, a search for “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 Corp.*, 134 S. Ct. at 2355. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90. Thus, an abstract idea does not transform into an inventive concept just because the Examiner has not found prior art that discloses or suggests it. Indeed, “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–189 (1981).

Appellants next assert “that improving upon the technology or technical field of processing orders as recited in claims 1, 7, and 14 ensure that the claimed invention amounts to significantly more than the purported abstract idea of performing order processing.” App. Br. 7. But Appellants do not provide any further explanation or technical reasoning in support of their assertion.

And finally, we are unpersuaded by Appellants’ contention that:

In the instant case, as stated in the background, the creation of internet “shopping carts” has created a need for the solution offered by features of the invention. Accordingly, the solution offered in embodiments of the invention are [sic] not to be considered abstract ideas, as the need was created by the technology, and the problem and solution are both tied to computer implemented methods.

Id. Similarly here, Appellants present no persuasive argument or explanation to support their position. Nor, for that matter, do Appellants even identify the problem that the claimed invention allegedly solves.

We also note that Appellants' Reply Brief merely duplicates arguments discussed above from the principal brief.

Accordingly, we are not persuaded for the reasons set forth above that the Examiner erred in rejecting independent claim 7 under 35 U.S.C. § 101. Therefore, we sustain the Examiner's rejection of claim 7, including independent claims 1 and 14, which fall with claim 7. We also sustain the Examiner's rejection of dependent claims 2–6, 8–11, 13, and 15–18, which are not argued separately.

DECISION

The Examiner's rejection of claims 1–11 and 13–18 under 35 U.S.C. § 101 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