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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KRISTINE LOIS VAN DER PLOEG,
SIVAKUMAR SUNDARESAN, JOHN HSIEH, KIRAN MUNDY,
SATYA ANUR, PRIYANKA SHETYE, MARGARET WASOWICZ,
WILLIAM CAINE, and BORMI SHIN

Appeal 2016-005266
Application 13/314,910¹
Technology Center 3600

Before BIBHU R. MOHANTY, JAMES A. WORTH, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134(a) of the final rejection of claims 1–20 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

¹ The Appellants identify Oracle International Corporation as the real party in interest (App. Br. 3).

THE INVENTION

The Appellants' claimed invention is directed to updating a project plan with input received from a user (Spec., para. 5). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method of updating a project plan in accordance with input received from a user account, the method comprising:
 - storing a master version of the project plan, wherein the master version of the project plan is stored as live data in a database;
 - receiving, from an administrative account, a threshold value;
 - dividing, using the threshold value, a range of possible values related to changes to the project plan into first and second non-overlapping sets of values such that the first set of values represents types of changes that may be made to the master version of the project plan in real-time without an approval from the administrative account;
 - after receiving the threshold value from the administrative account, receiving, from the user account, a change to the project plan; wherein:
 - the user account can access the master version of the project plan but has limited privileges to update the master version of the project plan in real-time; and
 - the administrative account has more privileges to update the master version of the project plan in real-time than the user account;
 - deriving a change value of the same type as the threshold value that corresponds to the change in the project plan;
 - determining that the change value does not violate the threshold value if the change value is included in the first set of values; and
 - in response to determining that the change value does not violate the threshold value, updating the master version of the project plan in real-time to reflect the change in the project plan.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 1–20 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
2. Claims 1, 4–11, 14, 15, and 17 are rejected under 35 U.S.C. § 103(a) as unpatentable over Abrams (Abrams et al., US 7,305,392 B1, issued Dec. 2007, hereinafter “Abrams”) and Kano (Kano et al., US 2008/0033700 A1, published Feb. 2008, hereinafter “Kano”).
3. Claims 2, 3, 12, 13, 16, and 18–20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Abrams, Kano, and Pederson (US 2010/0251247 A1 published Sept. 30, 2010).

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.²

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellants argue that the rejection of claim 1 is improper because claim 1 is not directed to an abstract idea (Reply Br. 2–5). The Appellants also argue that the claim is “significantly more” than any alleged abstract idea (Reply Br. 5–10).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

In contrast, the Examiner has determined that rejection is proper (Ans. 2–4).

We agree with the Examiner. Under 35 U.S.C. § 101, 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 an implicit exception: “laws 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).

In judging whether claim 1 falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. If so, we then consider the elements of the claim both individually and as “an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application of the abstract idea. *Id.* This is a search for an “inventive concept” an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.* The Court also stated that “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Id.* at 2358.

Here, we determine that the claim is directed to the concept of updating a project plan based on a threshold value. This is a method of organizing human activities or an idea in itself and is an abstract idea beyond the scope of § 101. The Specification at para. 5 indicates that the invention

relates to “updating a project plan in accordance with input received from a user.” Similarly, the preamble of the claim indicates that the claim is directed to a method of “updating a project plan in accordance with input received from a user account.”

We next consider whether additional elements of the claim, both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the abstract idea over the using generic computer components. We conclude that it does not.

Considering each of the claim elements in turn and as an ordered combination, the function performed by the computer system at each step of the process is purely conventional. For example, the Specification at paragraph 22 describes using known available software. The Specification at paragraphs 73–76 describes using known software, computer components, and communication networks. Each step of the claimed method does no more than require a generic computer to perform a generic computer function.

We note the point about pre-emption (App. Br. 8). While pre-emption “might tend to impede innovation more than it would tend to promote it, ‘thereby thwarting the primary object of the patent laws’” (*Alice*, 134 S. Ct. at 2354 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012)), “the absence of complete preemption does not demonstrate patent eligibility” (*Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015)). See also *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015), cert. denied,

136 S. Ct. 701, 193 (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.”).

For these reasons the rejection of claim 1, and its dependent claims which were not separately argued is sustained. Claims 17–20 are directed to similar subject matter and the rejection of these claims is sustained as well.

We reach the same conclusion as to system claims 11–16. Here, as in *Alice*, “the system claims are no different in substance from the method claims. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea.” *Alice* 134 S. Ct. at 2351. “[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea ‘while adding the words ‘apply it’ is not enough for patent eligibility.” *Id.* at 2358 (quoting *Mayo*, 132 S. Ct. at 1294).

Rejection under 35 U.S.C. § 103(a)

The Appellants argue that the rejection of claim 1 is improper because the cited prior art does not disclose or suggest the claim limitations for:

receiving, from an administrator account, a threshold value . . . [that] represents types of changes that may be made to the master version of the project plan in real-time without an approval from the administrative account

receiving, from the user account, a change to the project plan . . .

deriving a change value of the same type as the threshold value that corresponds to the change in the project plan; [and]

determining that the change value does not violate the threshold value.

(App. Br. 6, emphasis added).

In contrast, the Examiner has disclosed the cited claim limitation in Abrams at Fig. 4, col. 7:41–57, 8:38–52, col. 13:14–16; and Kano at paras. 83–87 (Final Act. 6, Ans. 7, 8).

We agree with the Appellants. For example, in Abrams at col. 13:14–16 the claimed “threshold value” is not disclosed by the citation to a “shared value sum” which is disclosed as a “numerical indication of who the user has selected to be able to access the data” in the manner claimed. The citations to Kano at paras. 83–87 fail to disclose the claimed “threshold value” in the manner claimed as well. Regardless, there is no articulated reasoning with rational underpinnings for combining the references to meet the argued claim limitation without impermissible hindsight. For these reasons this rejection of claim 1 is not sustained.

The remaining claims contain a similar limitation and the rejection of these claims is not sustained as well.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1–20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1, 4–11, 14, 15, and 17 under 35 U.S.C. § 103(a) as unpatentable over Abrams and Kano.

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We conclude that Appellants have shown that the Examiner erred in rejecting claims 2, 3, 12, 13, 16, and 18–20 under 35 U.S.C. § 103(a) as unpatentable over Abrams, Kano, and Pederson.

DECISION

The Examiner's rejection of claims 1–20 is sustained.

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