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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* AMANDA E. CHESSELL and KAMORUDEEN L. YUSUF

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Appeal 2016-005402  
Application 13/356,571  
Technology Center 3600

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Before JOHN A. EVANS, JAMES W. DEJMEK, and  
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

EVANS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants<sup>1</sup> seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of Claims 6–15. App. Br. 1. Claims 1–5 are canceled. App. Br. 10.

We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.<sup>2</sup>

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<sup>1</sup> The Appeal Brief identifies International Business Machines Corporation as the real party in interest. App. Br. 2.

<sup>2</sup> Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed June 29, 2015, "App. Br."), the Reply Brief (filed May 2, 2016, "Reply Br."), the Examiner's Answer (mailed March 2, 2016, "Ans."), the Final Action (mailed January 6, 2015, "Final Act."), and the Specification (filed January 23, 2012, "Spec.") for their respective

## STATEMENT OF THE CASE

The claims relate to a system and computer program product for modeling and validating a user process. *See Abstract.*

## INVENTION

Claims 6 and 11 are independent. An understanding of the invention can be derived from a reading of exemplary Claim 6, which is reproduced below with some formatting added:

6. A business process modeling and validation data processing system comprising:
  - a computer with at least one processor and memory coupled to a data store of business process models;
  - a modeling tool executing in the memory of the computer; and,
  - a validation module comprising program code enabled upon execution in the memory of the computer to link in the memory of the computer a task of an activity modeled within a business process model in the data store to a defined role specifying information accessible to end users associated with the defined role,
    - to additionally link in the memory of the computer the task of the activity to an object model specifying information required by an end user to complete a corresponding task,
    - to generate a mapping from the linkings, and
    - to validate the business process by determining from the mapping whether or not an end user associated with the role can access information necessary to perform the task.

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details.

*References*

The Examiner relies upon the prior art as follows:

Matsakis <i>et al.</i>	US 2005/0273772 A1	Dec. 8, 2005
Goodman <i>et al.</i>	US 2006/0059253 A1	Mar. 16, 2006

*Final Rejection*

1. Claims 11–15 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Final Act. 2–5.
2. Claims 6–9 and 11–14 stand rejected under 35 U.S.C. § 102(b) as anticipated by Goodman. Final Act. 5–9.
3. Claims 10 and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Goodman and Matsakis. Final Act. 9–11.

*New Ground of Rejection<sup>3</sup>*

Claims 6–15 are newly rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Ans. 11–12.

ANALYSIS

We have reviewed the rejections of Claims 6–15 in light of Appellants’ arguments that the Examiner erred. We have considered in this Decision only those arguments Appellants actually raised in the Brief. Any other arguments which Appellants could have made but chose not to make in

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<sup>3</sup> “Appellants recognize the right to re-open prosecution under 37 C.F.R. 41.39, however, Appellants instead opt to maintain the present appeal by filing the present Reply Brief as set forth in 37 C.F.R. 41.41.” Reply Br. 5 n.1.

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the Brief are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

We provide the following explanation to highlight and address specific arguments and findings primarily for emphasis. We consider Appellants' arguments *seriatim*, as they are presented in the Appeal Brief, pages 4–9.

#### CLAIMS 11–15: NON-STATUTORY SUBJECT MATTER (I)

Claim 11 recites, *inter alia*, “[a] computer readable [storage] medium comprising computer executable instructions.” The Examiner interprets this limitation as “a computer data signal embedded in a digital data stream (carrier wave).” Final Act. 2–3. The Examiner finds Appellants' definition of “a computer readable storage medium” encompasses “*a signal*.” Ans. 13–14 (citing Spec., ¶ 27).

Appellants contend their Specification differentiates a signal medium from a storage medium. App. Br. 5 (citing Spec., ¶ 27)<sup>4</sup>. We disagree with Appellants.

Appellants provide separate examples for a “computer readable storage medium” and a “computer readable signal medium” in paragraphs 25 and 26 of the Specification, respectively. However, the Specification merely describes a “computer readable storage medium may be, for example, *but not limited to*,” certain media, and “specific examples (*a non-exhaustive list*) of the computer readable storage medium would include”

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<sup>4</sup> The Examiner (Final Act. 3; Ans. 13) and Appellants (App. Br. 5; Reply Br. 3) refer to Specification paragraph [0027]. However, in our copy of the Record, the cited text appears in Specification Paragraph 25.

certain other media. Spec. ¶ 33) (emphases added). Additionally, the Specification mentions program code “may also be stored in a computer readable medium,” but contrary to Appellants’ assertions, does not limit the claimed computer readable storage medium to a non-transitory embodiment of a “computer readable medium.” See Spec. ¶27. Accordingly, Appellants’ Specification does not limit the claimed “computer readable storage medium” to a non-transitory embodiment. Similarly, the Board in *Mewherter* did “not find any limitation on the form of the ‘machine-readable storage medium’ in Appellants’ Specification.” *Ex parte Mewherter*, 107 USPQ2d 1857, 1859 (PTAB 2013) (precedential). Absent such express limitation on the claimed “computer readable storage medium,” the relevant body of extrinsic evidence compels a finding that “the ordinary and customary meaning of ‘computer readable storage medium’ to a person of ordinary skill in the art [is] broad enough to encompass both non-transitory and transitory media.” *Id.* at 1860.

For the reasons discussed *supra*, we are not persuaded the Examiner erred in rejecting claim 20 as non-statutory.<sup>5</sup>

#### CLAIMS 6–15: NON-STATUTORY SUBJECT MATTER (II)

The Examiner finds the claims are directed to the abstract idea of organizing and comparing information. Ans. 11. The Examiner finds the

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<sup>5</sup> A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation “non-transitory” to the claim. See David J. Kappos, Subject Matter Eligibility of Computer Readable Media, 1351 *Official. Gaz. Pat. Off.* 212 (Feb. 23, 2012).

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claimed “linking,” “mapping,” and “validating” steps are analogous to steps of using categories to organize, store, and transmit information that have previously been found to be directed to abstract ideas. *Id.*

Appellants discuss the jurisprudence of 35 U.S.C. § 101. *See* Reply Br. 5–14 (citing *CLS Bank v. Alice Corp. Pty. Ltd.*, 134 S. Ct 2347 (2014) and surveying subsequent Federal Circuit and Board decisions). Appellants conclude that **“an innovative concept reflected in a claim rejected under 35 U.S.C. § 101 must be restricted by the claim language itself in terms of how the innovative concept is achieved so as to realize patentable subject matter”** Reply Br. 10 (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1348 (Fed. Cir. 2015)) (emphasis added).

The Supreme Court has set forth a two-step process for evaluating whether claims are valid under § 101. *See Alice*, 134 S. Ct. at 2355. The “decisional mechanism” applied by the courts “is to examine earlier cases in which a similar or parallel descriptive nature can be seen.” *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016).

Appellants’ survey of the caselaw reveals that “[a]bsent a restriction in the claim language as to how the innovative concept is achieved, however, the claim may be rightfully rejected as being directed to non-statutory subject matter.” Reply Br. 10–11 (citing *Internet Patents*, 790 F.3d at 1349).

Appellants recite the claim language, e.g., “the business process is validated by determining from the mapping whether or not an end user associated with the role can access information necessary to perform the task.” Reply Br. 13. Appellants argue “Applicants’ claim language expressly provides how the concept of ‘modeling and validating a user process’ is achieved.” *Id.*

We are not persuaded. We find nothing in the claim recitation that, facially, explains how the validating step is performed. Nor do Appellants direct our attention to where the Specification may provide the required specificity.

CLAIMS 6–9 AND 11–14: ANTICIPATION BY GOODMAN

AND

CLAIMS 10 AND 15: OBVIOUSNESS OVER GOODMAN AND MATSAKIS.

Appellants (App. Br. 8) and the Examiner (Ans. 14) discuss the rejections of Claims 6–15 under §§ 102 and 103 as a group in view of the limitations of Claim 6 and the disclosure of Goodman.

Claim 6 recites, *inter alia*, “determining from the mapping whether or not an end user associated with the role can access information necessary to perform the task.”

Appellants contend Goodman fails to disclose whether an end user can access the information required for that user’s role. App. Br. 7.

The Examiner finds Goodman discloses a “quality verification **process owner** may not be responsible for executing the V-model, but is responsible for making sure that the V-model is in place and complied with.” Ans. 14 (citing Goodman, ¶ 185). The Examiner interprets this as equivalent to linking a task, modeled within a business process model in the data store, to a defined role specifying information accessible to end users associated with the defined role. *Id.* at 15.

We do not find that responsibility “for making sure that the V-model is in place and complied with,” as disclosed by Goodman, is the equivalent to “specifying information accessible to end users,” as claimed. Hence, we



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do not sustain the anticipation rejection of claims 6–9 and 11–14 or the obviousness rejection of claims 10 and 15.

#### DECISION

The rejections of Claims 11–15 under 35 U.S.C. § 101 (computer readable storage medium) are AFFIRMED.

The rejections of Claims 6–15 under 35 U.S.C. § 101 (abstract idea) are AFFIRMED.

The rejections of Claims 6–15 under 35 U.S.C. §§ 102 and 103 are REVERSED.

Because we affirm at least one ground of rejection for each claim on appeal, we affirm the Examiner’s decision rejecting all of the claims on appeal.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED