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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* ALAN D. BRAUN, ISAAC J. GRAF, and  
SHOEL D. PERELMAN

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Appeal 2016-006528<sup>1</sup>  
Application 11/763,547<sup>2</sup>  
Technology Center 3600

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Before JOSEPH A. FISCHETTI, NINA L. MEDLOCK, and  
JAMES A. WORTH, *Administrative Patent Judges*.

WORTH, *Administrative Patent Judge*.

DECISION ON APPEAL  
STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s Final Rejection of claims 1–12, 14, and 15, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. §§ 134 and 6(b).

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<sup>1</sup> Our Decision refers to the Appellants’ Appeal Brief (“Appeal Br.,” filed Feb. 24, 2016) and Reply Brief (“Reply Br.,” filed June 7, 2016), and the Examiner’s Final Office Action (“Final Act.,” mailed Sept. 24, 2015) and Answer (“Ans.,” mailed Apr. 7, 2016).

<sup>2</sup> According to Appellants, the real party in interest is IBM Corporation (Appeal Br. 1).

We AFFIRM.

*Introduction*

Appellants' application relates "to the field of computers, and specifically to software [and even more specifically to] dynamically creating a service model of computing resources." (Spec. ¶ 1).

Claims 1, 4, and 5 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the subject matter on appeal:

1. A computer-implemented method for dynamically creating a service model, comprising:

presenting a plurality of service model templates;

receiving an input that selects one of the service model templates for construction of a selected service model, wherein the selected service model represents real-time relationships and characteristics of depicted resources;

identifying external data sources that are used to describe the real-time relationships and characteristics of the depicted resources; and

constructing, using a processor, the selected service model using the identified external data sources, wherein

the input is an event that is received from a plurality of data sources, wherein the event describes changes to the plurality of data sources.

(Appeal Br., Claims App'x)

*Rejection on Appeal*

The Examiner maintains, and Appellants appeal, the following rejection:

Claims 1–12, 14, and 15 stand rejected under 35 U.S.C. § 101 as being directed to an abstract idea without significantly more. *See* Final Act. 4–5.

#### ANALYSIS

##### *Claims 1–12, 14, and 15*

The Court in *Alice* emphasized the use of a two-step framework for analysis of patentability under 35 U.S.C. § 101:

First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. If so, we then ask, “[w]hat else is there in the claims before us?” To answer that question, we consider the elements of each 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.

*See Alice Corp. Pty. Ltd. v CLS Bank Intl*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012)).

The Examiner determines that claims 1–3, 6–12, 14, and 15 are directed to creating a service model which represents real-time relationships and characteristics of depicted resources, and that describing the relationships and characteristics of resources is a long-standing method of organizing human activities, and thus an abstract idea. *See* Final Act. 4. As an example, the Examiner finds that the US military relies on “Tables of Organization and Equipment.” *Id.* The Examiner also states that comparing new and stored information and using rules to identify options is an abstract idea. *Id.* at 4–5. The Examiner makes similar determinations with respect to independent claims 4 and 5, which are directed to methods for creating a service model. Final Act. 6–7.

The Examiner analyzes the additional elements of the claimed invention as follows:

The additional physical element is a computer (i.e. computer-implemented), while the additional method elements are displaying data (i.e. presenting a plurality of service model templates), receiving data (i.e. receiving an input that selects one of the service model templates, identifying external data sources); and a description of one of those elements (wherein the input is an event that is received from a plurality of data sources, wherein the event describes changes to the plurality of data sources).

*Id.* at 5. Of these additional elements, the Examiner finds that the physical elements comprise generically recited computer elements that do not add a meaningful limitation to the abstract idea because they would be routine in any computer implementation and the method elements are insignificant extra-solution steps of displaying, receiving and describing data. *Id.* The Examiner determines that “the claimed invention does not constitute an improvement in another technology or in the computer itself, does not transform an article into another state or thing, nor are there any unconventional steps.” *Id.*

The first issue is what, if any, is the idea to which the claimed invention is directed. The Examiner recognized that the claimed invention is “directed to creating a service model.” Final Act. 4. Appellants argue that the Examiner’s characterization of the claimed invention is an oversimplification, and represents neither an idea nor an abstract idea. *See* Appeal Br. 7. Appellants argue that the Examiner fails to appreciate the difference between a claim being “directed to” an abstract idea and a claim that implicates in some manner an abstract idea. Reply Br. 2.

We agree with the Examiner that the claims are directed to “dynamically creating a service model” based on the terms of claim 1. The Examiner determines that claimed creation of a service model was a method of organizing human activities because it “represents real-time relationships and characteristics of depicted resources.” Final Act. 4. We agree with the Examiner that assessing resource characteristics is a longstanding method of organizing human activity and is thus abstract.

Appellants argue that creating a service model is neither an idea nor abstract because an action is performed, using a computer, to create a specific computer data structure which is not a fundamental economic practice, a certain method of organizing human activities, an idea “of itself,” or a mathematical relationships/formula. Appeal Br. 7. Appellants argue that the Examiner has not presented any explanation to support the Examiner’s assertion that “creating a service model” is a “method of organizing human activities.” *Id.* at 8. Nevertheless, the Examiner’s characterization is based on a direct quotation of one of the recited steps of independent claim 1, i.e., “identifying external data sources that are used to describe the real-time relationships and characteristics of the depicted resources.”

The Examiner refers to the military’s inventory system as evidence that taking stock of resources is a longstanding practice. *See* Final Act. 4. Appellants contest the Examiner’s reference to US military “Tables of Organization and Equipment” because the Examiner does not supply a written document and because such a Table would be static and would not represent real-time relationships and characteristics of depicted resources. Appeal Br. 7–8. However, the example is merely illustrative and

is only one part of the Examiner's reasoning. Even putting aside US military "Tables of Organization and Equipment," we agree with the Examiner's determination that taking stock of resources is a method of organizing human activity.

Further, the Examiner determines that the claimed invention is abstract for an additional reason, i.e., because it compares new and stored information and then uses rules to identify options. Final Act. 4–5. We agree with the Examiner that the claimed invention is abstract for this additional reason as well, i.e., because it relates to data processing and displaying of information without programmatic structure. Ans. 3, 5 (citing *SmartGene, Inc. v. Advanced Biological Labs.*, 555 F. App'x 950 (Fed. Cir. 2014)).

Appellants further argue that the claimed invention is unlike that in *SmartGene* in which every step could be performed by a doctor "in their heads." Appeal Br. 8. The Examiner reasons that the templates on which Appellants rely upon are not necessarily computer structures because they can be created using pen and paper, and in any event, are unclaimed. Ans. 5. Appellants argue that the service model is necessarily a data structure, and an improvement in computer functionality. Reply Br. 5.

We agree with the Examiner because the claims are not directed to any one particularized data structure. Rather, the claim simply recites the selection of a template, without providing a specific template. Neither the claims nor the Specification further detail what this template is. The only detailed examples are found in Figure 5, which designates a low performance entity and a communication failure. However, we determine that these diagrams do not provide particularized computer structures. As

such, the claim is directed to a method of selecting a design (without implementing instructions), which is an attempt to claim the fundamental building blocks of human ingenuity. *See, e.g., Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1139 (Fed. Cir. 2016) (claims directed to abstract idea of translating a functional description of a logic circuit into a hardware component description of the logic circuit).

Moreover, the claimed invention resembles the type of invention at issue in *Electric Power Group. v. Alstom S.A.*, where the Federal Circuit found a method of gathering, analyzing, and displaying information without any particular inventive technology to be abstract. *Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (citations omitted) (“In a similar vein, we have treated analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category. And we have recognized that merely presenting the results of abstract processes of collecting and analyzing information, without more (such as identifying a particular tool for presentation), is abstract as an ancillary part of such collection and analysis.”). *See also* Ans. 7–8 (discussing the displaying, receiving, and describing of data).

Appellants argue that the claimed invention is not directed to displaying, receiving, and describing data because the claim identifies external data sources as well. Reply Br. 9. However, even under this argument, the claimed invention resembles that at issue in *Electric Power Group*, which related to the display of information relating to measurements of grid data and non-grid data from data sources. *See Electric Power Grp.*, 830 F.3d at 1351.



The Examiner also determines that the claimed invention is similar to *Classen* and *CyberSource* because it collects and compares information. Ans. 3–4 (citing *Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057 (Fed. Cir. 2011); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372 (Fed. Cir. 2011)). Appellants argue that this is a new ground of rejection, but have not petitioned for designation of a new ground of rejection. Reply Br. 3. As such, this argument is waived. See 37 C.F.R. § 41.40(a). Appellants argue that the claimed invention here is unlike that in *Classen* because the invention in *Classen* did not have a practical use. Reply Br. 3. However, this is an argument that goes to utility rather than abstractness and does not make the claimed invention less abstract as in *Mayo*, where information for optimizing therapeutic efficiency of 6-thioguanine was designed to improve patient care, but was found unpatentable. *Mayo*, 566 U.S. at 71.

Appellants argue that the Examiner misstates the holding of *CyberSource* which is limited to claims drawn to mental processes. Reply Br. 4–5 (citing *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372 (Fed. Cir. 2011)). However, as above, generic data processing functions, such as receiving and displaying information, may be patent ineligible as well. See *Electric Power Grp.*, 830 F.3d at 1351.

Under step two of *Alice* inquiry, Appellants argue that the Examiner has not explained why the additional elements do not add significantly more to the claimed invention, e.g., “constructing . . . the selected service model,” “a plurality of service model templates,” “receiving an input that selects one of the service model templates,” and “using the identified external data sources” when constructing the selected service model. Appeal Br. 9–

10. Appellants argue that the Board cannot affirm the Examiner on the proposed basis if the Examiner's fails to provide concrete evidence in support. Appeal Br. 9–13 (citing *In re Sang-Su Lee*, 277 F.3d 1338, 1344–45 (Fed. Cir. 2002)). However, the Examiner analyzed the additional limitations and determined that they related to conventional computer functions. Final Act. 4, *id.* at 5; Ans. 6–7. We agree with the Examiner's determination because the Specification, which constitutes intrinsic evidence, refers to generic computer functions (*see* Spec. ¶¶ 14 (including general purpose computer and data sources), 20 (operating system and application programs), 21 (Internet), 26 (data source), Figs. 1, 3), and because the claims do not provide a specific template. Accordingly, we determine that the additional limitations taken individually and as whole do not add significantly more to the abstract idea of creating a service model based on analyzing resources.

Finally, Appellants argue that the claimed invention does not tie up the alleged abstract idea because of its additional limitations. Appeal Br. 9. However, a showing of pre-emption is not required for a determination that an idea is directed to non-patentable subject matter. *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1377 (Fed. Cir. 2015) (“Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.”).

Therefore, we sustain the Examiner's rejection under § 101 of claim 1. We have reviewed the additional recitations of claims 2–12, 14, and 15, and determine that they are directed to the same abstract idea of creating a service model based on analyzing resources without significantly

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more. We sustain the Examiner's rejection under § 101 of claim 2–12, 14, and 15, for similar reasons as independent claim 1.

#### DECISION

The Examiner's decision to reject claims 1–12, 14, and 15 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED