UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HOWARD W. OLSEN, NANCY D. OLSEN, ERICA J. OLSEN, JOHNATHAN WAGONER, and RUSSEL PERSSON

Appeal 2016-008056
Application 13/650,004[1]
Technology Center 3600

Before HUNG H. BUI, KARA L. SZPONDOWSKI, and JOYCE CRAIG, *Administrative Patent Judges*.

BUI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of claims 18–34 and 36–42, which are all the claims pending in the application. Claims 1–17 and 35 have been cancelled. Ans. 6. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.[2]

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[1] According to Appellants, the real party in interest is M3 Planning, LLC. App. Br. 1.

[2] Our Decision refers to Appellants' Appeal Brief ("App. Br.") filed June 24, 2015; Reply Brief ("Reply Br.") filed August 22, 2016; Examiner's Answer ("Ans.") mailed June 22, 2016; Final Office Action ("Final Act.") mailed May 23, 2015; and original Specification ("Spec.") filed October 11, 2012.

STATEMENT OF THE CASE

Appellants' invention relates to "an automated strategic planning system" [e.g., software tool] that is "highly interactive and leads the user through a series of stages to develop a strategic plan and/or manage execution or modification of a strategic plan." Spec. ¶ 17; Abstract. According to Appellants, "the system can automatically organize the user's responses to queries in order to provide strategic planning output or manage execution or modification of the plan." *Id.*

Claims 18, 24, and 28 are independent. Claim 18 illustrates the subject matter at issue, as reproduced below with disputed limitations in italics:

> 18. An automated strategic planning method comprising, through a computer system and a strategic planning computer software program running on the computer system:
>
> (A) providing an *automated first user-interface computer page display* requesting user identification on the first user-interface page of *a plurality of hierarchy level actions for an organization including a first hierarchy level action and a second hierarchy level action*;
>
> (B) providing a second *user-interface computer page display* (i) automatically identifying *the first hierarchy level action* among the plurality of hierarchy level actions for the organization and (ii) requesting user identification on the second user-interface page of *a first sub-entity action for a first sub-entity among a plurality of sub-entities within the hierarchy level of the organization*; and
>
> (C) providing an *automated project management user-interface computer display* (i) automatically identifying *the first sub-entity action* and (ii) including *an action item execution tracking section*.

App. Br. 29 (Claims App'x.).

Examiner's Rejections and References

(1)   Claims 18–34 and 36–42 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Ans. 2–6.[3]

(2)   Claims 18, 19, 24, 25, 28, and 29[4] stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muell (US 2006/0178920 A1; published Aug. 10, 2006). Final Act. 4–7.

(3)   Claims 20–23, 26, 27, and 30–42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muell and Bowen (US 2004/0260588 A1; published Dec. 23, 2004). Final Act. 7–11.

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[3] Claims 18–34 and 36–42 were newly rejected in the Examiner's Answer. Ans. 2–6. The Examiner explained that, because the Answer contains a new ground of rejection, Appellants were required, within two months from the date of the Answer, either (1) to reopen prosecution before the primary examiner by filing a reply under 37 C.F.R. § 1.111 relevant to the new ground of rejection or (2) to maintain their appeal by filing a reply brief under 37 C.F.R. § 41.41 addressing the new ground of rejection, in order to avoid *sua sponte* dismissal of the appeal as to all claims subject to the new ground of rejection. *Id.* at 14–15; *see* 37 C.F.R. § 41.39(b). In response thereto, Appellants filed a Reply Brief within the allotted two-month period, addressing the § 101 rejection of claims 18–34 and 36–42. As such, we discern no procedural error in the Examiner's rejection of claims 18–34 and 36–42 under 35 U.S.C. § 101.

[4] The Examiner identified claims 20 and 21 in both obviousness rejections. The Examiner, however, discusses claims 20 and 21 only in the body of the obviousness rejection of claims 20–23, 26, 27, and 30–42 over Muell and Bowen. We consider the Examiner's inclusion of claims 20 and 21 in the § 103 rejection over Muell alone to be harmless error, and we present the correct claim listing for clarity.

ANALYSIS

§ 101 Rejection of Claims 18–34 and 36–42

In *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014), the Supreme Court reiterates an analytical two-step framework previously set forth in *Mayo Collaborative Servs. v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 79 (2012), "for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts." *Alice*, 134 S. Ct. at 2355. The first step in the analysis is to "determine whether the claims at issue are directed to one of those patent-ineligible concepts," such as an abstract idea. *Id.* If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims "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.* (citing *Mayo*, 566 U.S. at 78–79). In other words, the second step is to "search for an 'inventive concept'—*i.e.*, 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.'" *Id.* (citing *Mayo*, 566 U.S. at 72–73).

In rejecting claims 18–34 and 36–42 under 35 U.S.C. § 101, the Examiner finds these claims are directed to an abstract idea of "using categories to organize, store and transmit information, specifically strategic planning." Ans. 2–3. The Examiner also finds that:

> Taken as an ordered combination, the limitations . . . are not enough to qualify as significantly more when recited in a claim with an abstract idea include, as a non-limiting or non-exclusive examples: (i) mere instructions to implement the idea

> on a computer, and/or (ii) recitation of generic computer
> structure that serves to perform generic computer functions that
> are well-understood, routine, and conventional activities
> previously known to the pertinent industry.
>
> Viewed as a whole, these additional claim element(s) do
> not provide meaningful limitation(s) to transform the abstract
> idea into a patent eligible application of the abstract idea such
> that the claim(s) amounts to significantly more than the abstract
> idea itself.

Ans. 5–6.

Appellants do not dispute the Examiner's findings that claims 18–34 and 36–42 are directed to an abstract idea. Instead, Appellants present several arguments, including: (1) the Examiner has not shown that "any of the Claims are directed to well understood, routine, or conventional activities"; (2) the Supreme Court's rulings in *Alice* are limited to "a fundamental (and thus prior art) economic practice" as an "abstract idea"; (3) Appellants' "claimed data collection, processing, and display actions — that is, as actually stated in the claims — has not been shown, or even contended, to be old much less directed to an old, fundamental practice of any type"; and (4) Appellants' claims 18–34 and 36–42 are directed to patent eligible subject matter — "to a new machine that provides entirely new and advantageous data collection, processing, and display techniques." Reply Br. 9–10.

Appellants' arguments are misplaced and do not address the requirements under *Alice*. At the outset, we note the Supreme Court's rulings in *Alice* are not limited to "a fundamental economic practice" as an "abstract idea." Instead, the Supreme Court's *Alice* two-step framework is applicable to all claims that are directed to an abstract idea. As correctly recognized by the Examiner, Appellants' claims 18–34 and 36–42, when

considered in light of the Specification, are directed to an abstract idea of "using categories to organize, store and transmit information, specifically strategic planning." Ans. 2–3. For example, all the steps recited in Appellants' method claim 18, including: (1) "providing an automated first user-interface computer page display requesting user identification on the first user-interface page of a plurality of hierarchy level actions for an organization"; (2) "providing a second user-interface computer page display (i) automatically identifying the first hierarchy level action among the plurality of hierarchy level actions for the organization and (ii) requesting user identification on the second user-interface page of a first sub-entity action for a first sub-entity among a plurality of sub-entities within the hierarchy level of the organization"; and (3) "providing an automated project management user-interface computer display (i) automatically identifying the first sub-entity action and (ii) including an action item execution tracking section" are abstract processes of collecting, arranging, and analyzing information of a specific content. Nevertheless, information as such is intangible. *See Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 451 n.12 (2007). Information collection and analysis, including when limited to particular content, is within the realm of abstract ideas. *See, e.g., Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1349 (Fed. Cir. 2015); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011).

Turning now to the second step of the *Alice* inquiry, we find nothing in Appellants' independent claims 18, 24, and 28 that adds "significantly more" to transform the abstract concept of collecting, arranging, and

analyzing information into a patent-eligible application. *Alice*, 134 S. Ct. at 2357. Appellants do not argue any of the steps recited in claims 18, 24, and 28 are individually inventive. Nor do Appellants argue the ordered combination of these elements is inventive. Reply Br. 9–10. Instead, Appellants' claims 18–34 and 36–42 simply incorporate a general-purpose computer and generic components such as "storage medium" and "computer displays" to perform the abstract concept of collecting, arranging, and analyzing information.

Limiting the abstract concept of collecting, arranging, and analyzing information to a general purpose computer having generic elements, such as the processor, memory, and computer readable storage medium recited in Appellants' claims 18–34 and 36–42, does not transform the abstract idea into a patent eligible invention under 35 U.S.C. § 101. As recognized by the Supreme Court, "the mere recitation of a generic computer cannot transform a patent ineligible abstract idea into a patent-eligible invention." *See Alice*, 134 S. Ct. at 2358, 2359 (concluding claims "simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer" are not patent eligible); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (Fed. Cir. 2014) (concluding claims merely reciting abstract idea of using advertising as currency as applied to particular technological environment of the Internet are not patent eligible); *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (concluding claims reciting "generalized software components arranged to implement an abstract concept [of generating insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer" are not patent eligible); *Dealertrack,*

Inc. v. Huber, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) ("[s]imply adding a 'computer aided' limitation to a claim covering an abstract concept, without more, is insufficient to render [a] claim patent eligible").

Separately, we note that Appellants' claims 18–34 and 36–42 can further be considered as a series of *mental steps* or "mental processes." *See Gottschalk v. Benson*, 409 U.S. 63 (1972). All the functions or steps recited in claims 18, 24, and 28 can be performed in the human mind, or by a human using pen and paper.

Lastly, we also note that none of the steps recited in Appellants' claims 18, 24, and 28 provides, and nowhere in the Specification can we find, any description or explanation as to how these data manipulation steps are intended to provide, for example: (1) a "solution . . . necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks," as explained by the Federal Circuit in *DDR Holdings, LLC v. Hotels.com, L.P.,* 773 F.3d 1245, 1257 (Fed. Cir. 2014); (2) "a specific improvement to the way computers operate," as explained by the Federal Circuit in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016); or (3) an "unconventional technological solution . . . to a technological problem" that "improve[s] the performance of the system itself," as explained by the Federal Circuit in *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1306, 1302 (Fed. Cir. 2016); *see also Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1352 (Fed. Cir. 2016); *Thales Visionix Inc. v. United States*, 850 F.3d 1343, 1347, 1349 (Fed. Cir. 2017).

Because Appellants' claims 18–34 and 36–42 are directed to a patent-ineligible abstract concept, and do not recite something "significantly more"

under the second prong of the *Alice* analysis, we sustain the Examiner's rejection of these claims under 35 U.S.C. § 101 as being directed to non-statutory subject matter in light of *Alice* and its progeny.

§ 103(a) Rejection of Claims 18–21, 24–25, and 28–29 based on Muell

Independent claim 18 recites an automated strategic planning method comprising three separate user-interface computer page displays, including: (A) "an automated first user-interface computer page display requesting user identification on the first user-interface page of a plurality of hierarchy level actions for an organization"; (B) "a second user-interface computer page display (i) automatically identifying the first hierarchy level action among the plurality of hierarchy level actions for the organization and (ii) requesting user identification . . ." and (C) "a second user-interface computer page display (i) automatically identifying the first hierarchy level action among the plurality of hierarchy level actions for the organization and (ii) requesting user identification."

Independent claim 24 is similar to claim 18, but recites "a plurality of computer displays" including: (A) "an automated entity strategic planning section" including various user input fields; (B) "an automated department strategic planning section" that automatically displays various items; and (C) "an automated team member strategic planning section" that automatically displays different items.

Independent claim 28 is narrower than claims 18 and 24. Claim 28 contains similar limitations of claim 18, but further recites the "second automated user-interface page display" to request "user identification . . . of a department goal and an action items for each among a plurality of

departments in the organization, including (a) a first department goal and a first department action item and (b) a second department goal and a second department action item.

In support of the obviousness rejection of independent claim 28, the Examiner finds Muell teaches an automated strategic planning method including all the elements and the "separate page displays", except for specific information shown or entered on what page display. Final Act. 4–6 (citing Muell ¶¶ 28–32, 50, 85, 93, Fig. 2C). Based on Muell's disclosures, the Examiner concludes "it would have been obvious . . . to modify Muell to include separate page displays for each hierarchical level of the strategy development." *Id.* at 6.

Appellants acknowledge "Muell describes and illustrates a complex, awkward method that instructs the user to analyze and determine a strategy based on goals determined by function within the organization rather organizational entity within the organization." App. Br. 11 (citing Muell ¶¶ 6, 29, and 91) (emphasis added). In this regard, Appellants argue Muell discloses "the awkward, complex, functionally — *not organizationally* — centric strategic planning interface." *Id.*

Appellants also argue: (1) "paragraphs 28–32 [of Muell] only discuss high level, functional strategic planning theory of the application" and "make no reference to a user interface page display, much less one providing the identification and request for user identification, much less as further claimed in claim 28" and (2) "'[p]aragraph 85 references two screen shoots, but it includes no disclosure of a 'department number goal,' much less either [(1)] for 'a first department entity among a plurality of department entities in the department' or [(2)] 'requesting user identification on the third user-

interface page.'" *Id.* at 12. Appellants also argue the Examiner has provided insufficient reasoning to modify Muell and improperly used hindsight. App. Br. 9–10, 12–14.

We do not find Appellants' arguments persuasive. Instead, we find the Examiner provides a comprehensive response to Appellants' arguments supported by a preponderance of evidence. Ans. 6–14. As such, we adopt the Examiner's findings and explanations. *Id.* For example, as recognized by the Examiner, Muell discloses the hierarchical nature of an organization, shown in Figure 1, including the top level (corporate level), the second level (functional unit level), the third level (task level), and the bottom level (individual step). Ans. 7. Muell also describes the functional unit level as the level of strategy formulation typically associated with a functional unit of a corporation, such as marketing, finance, and production. Muell ¶ 29. According to Muell, these units are "various narrower organizational units [e.g., various departments] within a corporation." Muell ¶ 36.

Moreover, we note Appellants' claim 28 is very broad and simply requires three separate user-interface computer page displays provided with different types of information items, which are non-functional descriptive material and, as such, does not distinguish Appellants' claimed invention relative to various computer page displays disclosed by Muell. *See In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994). Relevant case law and our precedential decisions on the appropriate handling of claims that differ from the prior art only based on "nonfunctional descriptive material" include: (1) *Ex parte Nehls*, 88 USPQ2d 1883, 1889 (BPAI 2008) (precedential) ("[T]he nature of the information being manipulated does not lend patentability to an otherwise

unpatentable computer-implemented product or process."); (2) *Ex parte Mathias*, 84 USPQ2d 1276, 1279 (BPAI 2005) (informative) ("[N]onfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art."), *aff'd*, 191 Fed. App'x. 959 (Fed. Cir. 2006) (Rule 36); and (3) *Ex parte Curry*, 84 USPQ2d 1272, 1274 (BPAI 2005) (informative) ("Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious."), *aff'd*, No. 06-1003 (Fed. Cir. June 12, 2006) (Rule 36).

With respect to independent claim 18, Appellants present similar arguments that Muell does not teach the hierarchical structure of an organization, i.e., "a plurality of hierarchy level actions for an organization including a first hierarchy level action and a second hierarchy level action" provided at the "user-interface computer page display" as recited in claim 18. App. Br. 16–17. Appellants also argue, with respect to independent claim 24, that Muell does not teach various sections provided on "computer displays" including: "(A) an automated entity strategic planning section" including various input fields; "(B) an automated department strategic planning section" displaying "an entity action item"; and "(C) an automated team member strategic planning section" displaying "a department action item" as recited in claim 24. App. Br. 18–19.

We are not persuaded by Appellants' arguments for the same reasons discussed relative to claim 28. For example, as shown in Muell's Figure 1, various hierarchy level actions are required to formulate a corporate strategy. *See* Muell ¶¶ 29, 36. Planning sections for an organization, including its various departments and teams are shown in Figures 3A–3C, 4A–4M, and

6A–6B. Moreover, various information items recited in Appellants' claims 18 and 24 are nothing more than nonfunctional descriptive material and, as such, do not distinguish Appellants' claimed invention relative to various computer page displays disclosed by Muell.

For these reasons, Appellants have not persuaded us of error in the Examiner's obviousness rejection of independent claims 18, 24, and 28. Accordingly, we sustain the Examiner's obviousness rejection of claims 18, 24, and 28. We also sustain the Examiner's obviousness rejection of dependent claims 19, 25, and 29, for which Appellants make no additional, substantive arguments. *See* App. Br. 14, 16, 17, 19.

With respect to dependent claims 20–23, 26, 27, 35, and 36–42, Appellants reiterate the same arguments presented against claim 28. App. Br. 21–21. For the same reasons discussed above, we also sustain the Examiner's obviousness rejection of claims 20–23, 26, 27, 35, and 36–42 based on Muell and Bowen.

With respect to dependent claims 30–34, 36, and 41, Appellants argue Muell does not teach (1) the "automated learning user-interface page display" recited in claim 30 (App. Br. 21–22); (2) "merely combining Muell and Bowan to reject claims 31–34 [reciting the "automated financial assessment user-interface page display"] would involve the improper application of hindsight by use of the applicant's inventive contribution" (App. Br. 23–25); (3) "a report of all goals and action items entered during the automated strategic planning method" as recited in claim 36 (App. Br. 26–27); and (4) "user-interface page displays include a strategic plan development progress report" as recited in claim 41 (App. Br. 27). We disagree and adopt the Examiner's explanations provided on pages 13–14 of

the Examiner's Answer. Moreover, these page displays including various types of information items are nothing more than non-functional descriptive material and, as such, do not distinguish Appellants' claimed invention relative to various computer page displays disclosed by Muell.

CONCLUSION

On the record before us, we conclude Appellants have not demonstrated the Examiner erred in rejecting claims 18–34 and 36–42 under 35 U.S.C. § 101 and § 103(a).

DECISION

As such, we affirm the Examiner's rejection of claims 18–34 and 36–42 under 35 U.S.C. § 101 and § 103.

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