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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* JEFFREY P. LEVENTHAL

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Appeal 2017-000342<sup>1</sup>  
Application 10/755,569<sup>2</sup>  
Technology Center 3600

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Before JOSEPH A. FISCHETTI, NINA L. MEDLOCK, and  
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–12, 14–27, 29, 30, and 37–45. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> Our decision references Appellant’s Appeal Brief (“Br.,” filed March 3, 2016), and the Examiner’s Answer (“Ans.,” mailed July 27, 2016) and Final Office Action (“Final Act.,” mailed February 27, 2015).

<sup>2</sup> Appellant identifies Onforce, Inc. as the real party in interest. Br. 3.

### CLAIMED INVENTION

Appellant's claimed invention "relates generally to a system and method for managing requests for services" (Spec. 1, ll. 11–12).

Claims 1, 15, and 30 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A third party system for managing service requests comprising:

a system memory storing executable instructions; and

a processing unit, in communication with the system memory, for executing the instructions, wherein executing the instructions on the processing unit causes the third party system to perform steps comprising:

populating a registry with a plurality of service providers;

initiating an electronic transfer of funds from an account of a service requestor to an account maintained by the third party system based on at least one of a request and authorization from the service requestor;

creating a work order from a service request received from the service requestor, the work order specifying a needed service and a spend limit for the needed service;

routing the work order to one or more service providers selected from the registry for the purpose of having one or more of the selected service providers indicate an acceptance of at least a portion of the needed service;

providing functionality for the one or more service providers selected from the registry to request from the service requestor an increase in the spend limit when the one or more service providers must obtain additional resources to complete the work order, the request for the increase in the spend limit being made via message exchanges through the third party system;

providing functionality for the service requestor to authorize the requested increase in the spend limit, to agree that the work order prior to the increase in the spend limit is completed for purposes of accounting, and to issue a further service request for the purpose of having the service completed in actuality;

assigning at least a portion of the needed service to an assigned service provider selected from the registry;

annotating acceptance, assignment, and completion of the accepted portion of the needed service; and

initiating an electronic transfer of at least a portion of the funds in the account maintained by the third party system to an account of the assigned service provider upon receipt of the annotated acceptance, assignment, and completion and based on at least one of a request and authorization from the service requestor.

### REJECTIONS<sup>3</sup>

Claims 1–12, 14–27, 29, 30, and 37–45 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–4, 6–10, 12, 14–19, 22–25, 27, 29, 30, and 37–45 are rejected under 35 U.S.C. § 103(a) as unpatentable over dePinto et al. (US 2002/0194112 A1, pub. Dec. 19, 2002) (hereinafter “dePinto”), McCormick (US 2002/0040352 A1, pub. Apr. 4, 2002), and McGuire et al. (US 4,404,639, iss. Sept. 13, 1983) (hereinafter “McGuire”).

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<sup>3</sup> After the mailing of the Examiner’s Answer on July 27, 2016 in this case, U.S. Application Serial No. 11/979,243 was abandoned on February 1, 2017. Application Serial No. 11/979,243 was used to provisionally reject claims 1–12, 14–27, 29, 30, and 37–45 in this appeal on the ground of nonstatutory double patenting (Final Act. 13–14); its abandonment renders the rejection moot.

Claims 5, 11, and 26 are rejected under 35 U.S.C. § 103(a) as unpatentable over dePinto, McCormick, McGuire, and Miles (US 2002/0111842 A1, pub. Aug. 15, 2002).

Claims 20 and 21 are rejected under 35 U.S.C. § 103(a) as unpatentable over dePinto, McCormick, McGuire, and Beaudoin et al. (US 7,096,193 B1, iss. Aug. 22, 2006) (hereinafter “Beaudoin”).

## ANALYSIS

### *Non-Statutory Subject Matter*

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: “[l]aws 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).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (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 Corp.*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* 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 79, 78).

The Court acknowledged in *Mayo* that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. Therefore, the Federal Circuit has instructed that claims are to be considered in their entirety to determine “whether their character as a whole is directed to excluded subject matter.” *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

Here, in rejecting the pending claims under 35 U.S.C. § 101, the Examiner determined that the claims are directed to “managing service requests,” i.e., to a fundamental economic practice, and, therefore, to an abstract idea; and that the claims “do not include additional elements that are sufficient to amount to significantly more than the judicial exception because there are no meaningful limitations that transform the exception into a patent eligible application” (Final Act. 3).

Appellant argues that the Examiner erred in rejecting the claims under § 101 because the claims do not seek to preempt the use of service request management in all fields such that allowing the claims to issue would effectively grant a monopoly over managing service requests (Br. 6–9). That argument is not persuasive at least because preemption is not the sole test for patent-eligibility.

There is no dispute that the Supreme Court has described “the concern that drives [the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption.” *Alice Corp.*, 134 S. Ct. at 2354. But

characterizing preemption 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). Although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Id.* See also *OIP Technologies, Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 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.”).

Appellant further argues that the pending claims, like the claims at issue in *Diamond v. Diehr*, 450 U.S. 175 (1981), “improve an existing technological process by providing a solution the industry had not previously been able to obtain” (Br. 9–10). That argument is likewise unpersuasive.

Appellant asserts that organizations with disparate geographic locations previously were unable to obtain IT support services without either using an expensive and inflexible national vendor (e.g., IBM, EDS, CSC, etc.) or researching, contacting, evaluating, negotiating with, and maintaining separate relationships with disparately located IT support vendors (*id.* at 10). And Appellant ostensibly maintains that the claimed invention provides a solution in the form of the third party system for

managing service requests, i.e., facilitating a relationship between a customer and one or more vendors (*id.* at 7).

Yet, we are not persuaded that “researching, contacting, evaluating, negotiating with, and maintaining separate relationships with disparately-located IT support vendors” is a technological process. Indeed, as the Examiner observes, these activities “could be performed by humans speaking to one another or through other non-technological means such as pen and paper” (Ans. 4). We also are not persuaded that providing a third party system to manage service requests, i.e., to facilitate the establishment of customer/vendor relationships, is a technical solution, as opposed to a commercial solution.

Rather than being akin to the claims in *Diehr*, which was directed to a specific industrial process, i.e., “a physical and chemical process for molding precision synthetic rubber products,” *Diehr*, 450 U.S. at 184, the claims here merely recite a computer-implemented method for managing service requests, i.e., facilitating relationships between a customer and one or more vendors, which, as the Examiner observes (Ans. 4), is an abstract idea. *Cf. buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1353–54 (Fed. Cir. 2014) (holding that creating and managing a contractual relationship between two entities is a fundamental economic practice, i.e., an abstract idea). The only portion of the pending claims that can reasonably be considered “technological” is the claimed “processing unit.” And it is clear from the Specification that this processing unit is no more than a generic computer component (*see* Spec. 6 (“Although not required, the system and method will be described in the general context of computer executable instructions being executed by one or more processing devices such as a

personal computer, mainframe computer, personal-digital assistant (‘PDA’), cellular telephone, or the like.”)), which is not enough for patent-eligibility. *See Alice Corp.*, 134 S. Ct. at 2358 (“[I]f a patent’s recitation of a computer amounts to a mere instruction to ‘implemen[t]’ an abstract idea ‘on . . . a computer,’ that addition cannot impart patent eligibility.”) (internal citations omitted).

We also are not persuaded of Examiner error to the extent that Appellant argues that the claims are patent-eligible because the claims are allegedly non-obvious over the cited prior art (Br. 10). A finding of novelty or non-obviousness does not automatically lead to the conclusion that the claimed subject matter is patent-eligible. Although the second step in the *Mayo/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. “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90; *see also Diehr*, 450 U.S. at 188–89 (“The ‘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.”).

We are not persuaded, on the present record, that the Examiner erred in rejecting claims 1–12, 14–27, 29, 30, and 37–45 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection.

*Obviousness*

*Independent Claims 1, 15, and 30 and Dependent Claims 4, 6–10, 12, 14, 16–19, 22–25, 27, 29, and 37–45*

We are persuaded by Appellants’ argument that the Examiner erred in rejecting independent claims 1, 15, and 30 under 35 U.S.C. § 103(a) because McGuire, on which the Examiner relies, does not disclose or suggest “providing functionality for the service requestor . . . to agree that the work order prior to the increase in the spend limit is completed for purposes of accounting, and to issue a further service request for the purpose of having the service completed in actuality,” as recited in independent claim 1, and similarly recited in independent claims 15 and 30 (Br. 10–11).

The Examiner cites McGuire at column 9, lines 5–14 as disclosing the argued limitation (Final Act. 5). But we find nothing there that discloses or suggests a third party computer system providing functionality for a customer to perform the recited steps, i.e., agree that a work ordered is completed for accounting purposes prior to an increase in the spend limit, and issue a further service request for having the service completed in actuality. Instead, McGuire merely states:

As an option, the dealer can run a subtotal on all parts and labor to date to verify that the original estimate has not been exceeded. Both the customer and the dealer may wish to be aware that an estimate has or may be exceeded so as to avoid conflict with consumer protection legislation which has been enacted in several states of the United States.

McGuire, col. 9, ll. 5–14.

Therefore, we do not sustain the Examiner's rejection of independent claims 1, 15, and 30 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the rejection of dependent claims 4, 6–10, 12, 14, 16–19, 22–25, 27, 29, and 37–45. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

*Dependent Claims 5, 11, 20, 21, and 26*

Claims 5, 11, 20, 21, and 26 each depends, directly or indirectly, from one of claims 1 and 15. The rejections of these dependent claims do not cure the deficiency in the Examiner's rejection of independent claims 1 and 15. Therefore, we sustain the Examiner's rejections of claims 5, 11, 20, 21, and 26 under 35 U.S.C. § 103(a).

DECISION

The Examiner's rejection of claims 1–12, 14–27, 29, 30, and 37–45 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejections of claims 1–12, 14–27, 29, 30, and 37–45 under 35 U.S.C. § 103(a) are reversed.

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