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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TERRENCE G. CLARK and JAMES B. MERCER

Appeal 2017-000400¹
Application 12/765,991²
Technology Center 3600

NINA L. MEDLOCK, BRUCE T. WIEDER and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

MEDLOCK, *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 1–21. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellants’ Appeal Brief (“Br.,” filed November 25, 2015) and the Examiner’s Answer (“Ans.,” mailed June 16, 2016) and Final Office Action (“Final Act.,” mailed June 25, 2015).

² Appellants identify Computer Associates Think, Inc. as the real party in interest. Br. 3.

CLAIMED INVENTION

Appellants' claimed invention "relates generally to computer management, and more particularly to a system and method for managing assessments for an organization" (Spec. 1, ll. 6–7).

Claims 1, 8, and 15 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A computer-implemented method for managing assessments for an organization, the method comprising:

storing in a computer system a plurality of instances of an assessment object configured to track progress of a plurality of assessment attributes;

generating, by the computer system, an assessment plan based at least in part on data associated with the plurality of assessment attributes and a template for creating the assessment plan, the assessment plan identifying a subset of the plurality of assessment attributes that each have associated data outside a target threshold for a first time period;

establishing, based at least in part on the subset of assessment attributes, a computer-based logical link between the assessment plan and a first sustainability project of the organization, the first sustainability project impacting interests of a stakeholder;

generating a new sustainability project of the organization, based at least in part on the assessment plan, to improve the interests of the stakeholder;

receiving from the computer system data for each of the subset of assessment attributes, the data indicating measurable performance for a second time period occurring after the first time period;

generating an assessment report based at least in part on the data received during each of the first and second time periods for each of the subset of assessment attributes, the assessment report indicating:

a comparison between the measurable performances during the first and second time periods of each of the subset of assessment attributes; and

progress of the first sustainability project and the new sustainability project; and transferring the assessment report to the stakeholder to modify the stakeholder's perception of the organization's sustainability efforts based on the progress of the first sustainability project and the new sustainability project.

REJECTIONS

Claims 1–21 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–3, 8–10, and 15–17 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ness et al. (US 2005/0209905 A2, pub. Sept. 22, 2005) (hereinafter “Ness”), Benedek et al. (US 2009/0204916 A1, pub. Aug. 13, 2009) (hereinafter “Benedek”), and McMorris III et al. (US 2007/0265897 A1, pub. Nov. 15, 2007) (hereinafter “McMorris”).

Claims 4, 11, and 18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ness, Benedek, McMorris, and McConnell et al. (US 2008/0255899 A1, pub. Oct. 16, 2008) (hereinafter “McConnell”).

Claims 5, 6, 12, 13, 19, and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ness, Benedek, McMorris, and Examiner's Official Notice.

Claims 7, 14, and 21 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ness, Benedek, McMorris, and Roberts (US 2009/0171722 A1, pub. July 2, 2009).

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)).

In rejecting the pending claims under 35 U.S.C. § 101, the Examiner determined that the claims are directed to “managing organizational assessments,” i.e., to organizing human behaviors/actions, and, therefore, to an abstract idea (Final Act. 3). The Examiner also determined that the additional elements or combination of elements in the claims, other than the abstract idea, amounts to “no more than: (i) mere instructions to implement the idea on a computer, and (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”; and that viewed as a whole, these additional claim elements do not provide meaningful limitations to transform the abstract idea into a patent-eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself (*id.* at 3–4).

As an initial matter, we cannot agree with Appellants that the Examiner has oversimplified the claimed invention as directed to “managing assessments,” or that the Examiner has, otherwise, failed to consider the claims as a whole (Br. 13). Instead, in our view, the Examiner’s characterization of the claims as directed to “managing assessments” is fully consistent with the Specification (*see, e.g.*, Spec. 3 (“According to one embodiment, a computer-implemented method for managing assessments for an organization is disclosed”)).

Appellants argue that claim 1, for example, is directed to “the patent-eligible ideas of at least ‘modifying a stakeholder’s perception of the

organization’s sustainability efforts’ and ‘generating a new sustainability project to improve the interests of the stakeholder,’” and that “the claims cannot be characterized as merely being directed to an abstract idea” (Br. 13). But we fail to see how or why, and Appellants do not explain how or why, generating a new sustainability project to improve the interests of a stakeholder, and transferring an assessment report to the stakeholder to modify the stakeholder’s perception of the organization’s sustainability efforts based on the progress of the new sustainability project as compared to a first sustainability project, as called for in claim 1, involve more than collecting, analyzing, and displaying information, without any particular inventive technology — a concept that the courts have repeatedly held is within the realm of abstract ideas. *See, e.g., Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016) (when “the focus of the asserted claims” is “on collecting information, analyzing it, and displaying certain results of the collection and analysis,” the claims are directed to an abstract idea); *see also, e.g., Clarilogic, Inc. v. FormFree Holdings Corp.*, 681 F. App’x 950, 954 (Fed. Cir. 2017) (non-precedential) (holding that claims “for collection, analysis, and generation of information reports, where the claims are not limited to how the collected information is analyzed or reformed, is the height of abstraction”).

Turning to the second step of the *Mayo/Alice* framework, Appellants argue that even if the claims are directed to an abstract idea, the claims are nonetheless patent-eligible because the recited combination of elements in claim 1 amounts to “significantly more” than the abstract idea itself (Br. 13–14). Yet, to the extent Appellants maintain that the claimed invention is patent-eligible, i.e., that claim 1 amounts to “significantly more” than an

abstract idea, and/or that the recited functions are not “well-understood, routine, and conventional activities,” because claim 1 is allegedly novel and/or non-obvious in view of the prior art,³ Appellants misapprehend the controlling precedent.

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 Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (“The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in

³ *See, e.g.*, Br. 14 (“The combination of elements described in, for example, Claim 1, including at least: (1) generating a new sustainability project to improve interests of a stakeholder, and (2) transferring the assessment report to the stakeholder to modify the stakeholder’s perception of the organization’s sustainability efforts based on the progress of sustainability projects, represent precisely the type of meaningful limitations referenced in *Alice Corp.* As evidenced at least by the deficient cited art of record, these features represent limitations that are not well-understood or routine in the field.”).

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 1–21 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection.

Obviousness

Independent Claims 1, 8, and 15

Appellants argue that the Examiner erred in rejecting claims 1, 8, and 15 under 35 U.S.C. § 103(a) because none of Ness, Benedek, and McMorris discloses or suggests “generating a new sustainability project of the organization, based at least in part on the assessment plan, to *improve the interests of the stakeholder*” and “transferring the assessment report to the stakeholder to *modify the stakeholder’s perception of the organization’s sustainability efforts* based on the progress of the first sustainability project and the new sustainability project,” as recited in claim 1 (emphasis added), and similarly recited in claims 8 and 15 (Br. 16–20). Yet, as the Examiner observes, Appellants do not challenge the Examiner’s finding that the cited references, in combination, disclose and/or suggest “generating a new sustainability project of the organization” and “transferring the assessment report to the stakeholder,” as called for in the claims (Ans. 10–11). Instead, Appellants argue that the cited references do not disclose or suggest that the claimed steps are performed to improve the interests of the stakeholder or to modify the stakeholder’s perception of the organization’s sustainability efforts (Ans. 10–11).

We agree with the Examiner that the phrases “to improve the interests of the stakeholder” and “to modify the stakeholder’s perception of the

organization's sustainability efforts based on the progress of the first sustainability project and the new sustainability" do not recite "definable/performed functions" (Final Act. 10). Instead, these phrases amount to no more than statements of purpose or intended use (i.e., the intended effect and hoped for result of generating and executing a new sustainability project and delivering the resultant assessment report (*id.* at 10–11; *see also* Ans. 11)), which do not limit the scope of the claims, and cannot be relied on to distinguish over the prior art for purposes of patentability.

Moreover, even were that not so, we agree with the Examiner that where the performance of an organization is monitored with respect to certain measures; the monitored performance is compared to established benchmarks; and a report is produced and sent to members of the organization, indicating areas of improvement if the company is not meeting goals and/or awards and certifications if the company or organization is meeting or exceeding goals, as disclosed in Ness, "the report is reasonably understood to be intended to modify or improve stakeholder perception of the organization and the plan is reasonably considered to be intended to improve stakeholder interests" (Ans. 11–12).

In view of the foregoing, we sustain the Examiner's rejection of independent claims 1, 8, and 15 under 35 U.S.C. § 103(a).

Dependent Claims 2–7, 9–14, and 16–21

Appellants do not present any arguments in support of the patentability of dependent claims 2–7, 9–14, and 16–21 except to assert that the claims are allowable based on their dependence from independent claims 1, 8, and 15. We are not persuaded, for the reasons set forth above,

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that the Examiner erred in rejecting independent claims 1, 8, and 15 under 35 U.S.C. § 103(a). Therefore, we also sustain the Examiner's rejections of dependent claims 2–7, 9–14, and 16–21.

DECISION

The Examiner's rejection of claims 1–21 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejections of claims 1–21 under 35 U.S.C. § 103(a) are 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)(1)(iv).

AFFIRMED