



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/020,058	12/21/2004	Daniel DeFolo	82185464	4459
56436	7590	10/16/2018	EXAMINER	
Hewlett Packard Enterprise 3404 E. Harmony Road Mail Stop 79 Fort Collins, CO 80528			NGUYEN, TAN D	
			ART UNIT	PAPER NUMBER
			3689	
			NOTIFICATION DATE	DELIVERY MODE
			10/16/2018	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

hpe.ip.mail@hpe.com
chris.mania@hpe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DANIEL DEFOLO and
CATHRIN CALLAS

Appeal 2017-000564
Application 11/020,058¹
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
ALYSSA A. FINAMORE, Administrative Patent Judges.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Daniel DeFolo, et al. (Appellants) seek our review under 35 U.S.C. § 134(a) of the Final Rejection of claims 1–6, 8–13, and 15–18. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

¹ The Appellants identify Hewlett Packard Enterprise Development LP as the real party in interest. Br. 3.

THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A computer-implemented method for managing a partially completed dynamic process execution (PCDPE), said PCDPE stored in a database and representing a dynamic process that is partially completed by a user, comprising:

ascertaining in a computing system whether a change has occurred to at least one of a prompt component in the database and a response component in the database associated with said dynamic process, which is partially completed by said user;

if said change has occurred, performing a) and b) as:

a) ascertaining whether a completed process step in the database of said PCDPE requires updating responsive to said change, wherein said PCDPE is stored in the database and represents said dynamic process; and

b) if said completed process step requires updating, performing an update action in the database on said completed process step;

wherein if said change occurred with respect to said prompt component, displaying an updated prompt component that resulted from said change, obtaining an updated response to said updated prompt component from said user, and wherein performing the update action on the database further comprises performing the obtained updated response on the database.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Satoh	US 2001/0020295 A1	Sept. 6, 2001
Kanie	US 2002/0002567 A1	Jan. 3, 2002
Troyansky	US 2004/0189682 A1	Sept. 30, 2004
Kraft	US 2005/0120061 A1	June 2, 2005

Hunter

US 2005/0209903 A1

Sept. 22, 2005

“ AAPA, as cited on 1111 [0001-0007] and Figs. 1 A (Prior Art), 1 B (Prior Art), and 1 C (Prior Art), 2A (Prior Art) and 2B (Prior Art), fairly teaches:

(1) the type of dynamic process execution (OPE), i.e. a partially completed OPE and prompt and response component.” (AAPA)

The following rejections are before us for review²:

Claims 1–6, 8–13, and 15–18 are rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

Claims 1, 2, 5, 6, 8, 9, 12, 13, and 15–18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft, Kanie, Hunter, AAPA, and Satoh.

Claims 3, 4, 10, and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft, Kanie, Hunter, AAPA, Satoh, and Troyansky.

ISSUES

Did the Examiner err in rejecting claims 1–6, 8–13, and 15–18 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter?

Did the Examiner err in rejecting claims 1, 2, 5, 6, 8, 9, 12, 13, and 15–18 under 35 U.S.C. § 103(a) as being unpatentable over Kraft, Kanie, Hunter, AAPA, and Satoh?

² Examiner has withdrawn the rejection of claims 1, 2, 5, 5, 8, 9, 12, 13, and 15–18 under 35 U.S.C. § 103(a) as being unpatentable over Kraft, Kanie, Hunter, and Satoh, and the rejection of claims 3, 4, 10, and 11 under 35 U.S.C. § 103(a) as being unpatentable over Kraft, Kanie, Hunter, Satoh, and Troyansky. Ans. 3.

Did the Examiner err in rejecting claims 3, 4, 10, and 11 under 35 U.S.C. § 103(a) as being unpatentable over Kraft, Kanie, Hunter, AAPA, Satoh, and Troyansky?

ANALYSIS

The rejection of claims 1–6, 8–13, and 15–18 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

The Appellants argued these claims as a group. *See* Br. 7–12. We select claim 1 as the representative claim for this group, and the remaining claims 2–6, 8–13, and 15–18 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

Alice Corp. Proprietary Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under 35 U.S.C. § 101.

According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

In that regard, the Examiner determined the claims are directed to “managing a business process execution (i.e. approving an invoice)” which the Examiner determined to be an abstract idea. Final Rej. 5 (emphasis omitted).

The Appellants argue that

the Examiner’s assertion that the claims are directed to the abstract idea of “a business process execution (i.e. approving an invoice)” is improper. The claims must be considered as a whole, and claims 1-6, 8-13, and 15-18 pertain to a computer database-driven system for

managing structural changes to databases on a prompt-by-prompt level instead of a process level, rather than “a business process execution (i.e. approving an invoice)”. A computer database-driven system for managing changes to a database is not an abstract idea of “approving an invoice.”

Br. 9–10. *See also* Br. 10 (“A computer-implemented database-driven system for managing structural changes to databases is not an abstract idea of an organized human activity.”).

The Appellants’ argument that the claims are directed to a “computer database-driven system for managing structural changes to databases on a prompt-by-prompt level” rather than what the Examiner has characterized the claims as being directed to (i.e., “managing a business process execution (i.e. approving an invoice)”) is unpersuasive for the following reasons.

The Appellants’ argument implicates the “directed to” inquiry.

The “directed to” inquiry . . . cannot simply ask whether the claims involve a patent-ineligible concept, because essentially every routinely patent-eligible claim involving physical products and actions involves a law of nature and/or natural phenomenon—after all, they take place in the physical world. *See Mayo*, 132 S.Ct. at 1293 (“For all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.”) Rather, the “directed to” inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether “their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015); *see Genetic Techs. Ltd. v. Merial L.L.C.*, 2016 WL 1393573, at *5 (Fed. Cir. 2016) (inquiring into “the focus of the claimed advance over the prior art”).

Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1335 (Fed. Cir. 2016).

With respect to computer-enabled claimed subject matter, it can be helpful to determine whether “the claims at issue . . . can readily be

understood as simply adding conventional computer components to well-known business practices” or not. *Id.* at 1338. *See also Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

In *Enfish*, for example, the court noted that “[s]oftware can make non-abstract improvements to computer technology just as hardware improvements can.” 822 F.3d at 1335. The court put the question as being “whether the focus of the claims is on [a] specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Id.* at 1335–36. In *Enfish*, the court found that the “plain focus of the claims” there was on “an improvement to computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity.” *Id.* at 1336.

“In determining the eligibility of respondents’ claimed process for patent protection under § 101, their claims must be considered as a whole.” *Diamond v. Diehr*, 450 U.S. 175, 188 (1981). The question is whether the claims as a whole “focus on a specific means or method that improves the relevant technology” or are “directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016).

The preamble of the claim states “[a] computer-implemented method for managing a partially completed dynamic process execution (PCDPE).” According to the Specification:

a dynamic process document relates to an expert system that is database-driven and provides guidance as the user works through a

process to complete a task. A dynamic process document, when executed, may be able to determine subsequent steps that are relevant to the user's task based on the user's earlier response(s). To facilitate discussion, prior art Fig. 1A shows an example of a 5-step process. In this example, depending upon how the user responds to step 102, the dynamic process may display steps 104, 104a, 104b, and 104c or the dynamic process may bypass those steps entirely and proceed to step 2.2. Functionally speaking, the dynamic process provides navigation support as the user goes through a process. As a result, the process may incorporate more steps and conditions without placing the burden on the user to determine the steps that are essential to complete a task.

Spec., para. 29. Also,

On the whole, the dynamic process represents an effective mechanism for guiding a user through a process, especially a complex one. However, managing changes to a dynamic process while the user has only partly completed that dynamic process has been challenging in the prior art, especially for a partially completed dynamic process execution (PCDPE). As discussed herein, a PCDPE relates to a dynamic process that is partially completed by a user.

Spec., para. 40.

In light of these passages, the preamble “[a] computer-implemented method for managing a partially completed dynamic process execution (PCDPE)” reasonably broadly directs the claim to a scheme for managing a known system (i.e., “[M]anaging changes to a dynamic process while the user has only partly completed that dynamic process has been challenging in the prior art, especially for a partially completed dynamic process execution (PCDPE).” Spec., para. 40); that is, “for guiding a user through a [partially completed] process” (Spec., para. 29).

The Specification uses invoice approval as an example.

Consider for example the task of approving an invoice for goods purchased. If the invoice is for a relatively small amount (e.g., five dollars) and the employee executing the invoice approval process

is a high-level manager, the invoice approval task may involve only a few steps. However, if the invoice is for a large amount (e.g., over a million dollars), the invoice approval task may involve additional steps, such as verifying that the goods have been satisfactorily received and that funds are actually available for paying the invoice once the invoice is approved. As another example, if the employee executing the invoice approval process is a low-level employee, additional steps may also be required to ensure that the employee in fact has sufficient authority to approve the invoice.

Spec., para. 2.

With respect to the aforementioned invoice approval task, an invoice approval dynamic process document may have twenty steps. If the invoice amount to be approved is small, steps 3, 5, and 20 may be required, for example. In this case, prompts pertaining to steps 3, 5, and 20 may be displayed in sequence, and the user may respond to the prompts to complete the approval task of a small invoice. If the invoice amount to be approved is large, steps 3, 7, 9, 11, 13, 15, 16, 17, and 20 may be required, for example. In this latter case, prompts pertaining to steps 3, 7, 9, 11, 13, 15, 16, 17, and 20 may be displayed in sequence, and the user may respond to these prompts to complete the approval task of the larger invoice.

Spec., para. 4. In this example, the 20-step invoice approval process contains “prompts” calling for a user to perform a certain tasks. The “prompts” guide the user through the invoice approval process. A user may be unable to complete the approval process (e.g., because “[f]rom time to time, an organization may wish to revise its processes” (Spec., para. 5)), in which case a user is faced with a partially completed process.

As illustrated by the examples above, incorporating updates into a partially completed process may be a daunting task for a user in the prior art. What is needed is a mechanism to determine when a change impacts a particular user and automatically updates a user’s response based on the criteria of the changes. Also, the mechanism needs to have the ability to identify the items that cannot be

automatically updated and to guide the user through these changes so that the completed process reflects the most updated version.

Spec., para. 8.

The mechanism, as set forth in claim 1, involves

- “ascertaining . . . whether a change has occurred to at least one of a prompt component in the database and a response component in the database associated with said dynamic process, which is partially completed by said user”;
- if a change has occurred
 - “ascertaining whether a completed process step in the database . . . requires updating responsive to said change”; and
 - “if said completed process step requires updating, performing an update action in the database on said completed process step”;
 - “wherein performing the update action on the database further comprises performing the obtained updated response on the database”;
- wherein if said change occurred
 - “displaying an updated prompt component that resulted from said change,” and
 - “obtaining an updated response to said updated prompt component from said user.”

Given all this, it is reasonable to characterize claim 1 as a whole as being focused on updating a process to address a change to the process. The claim is not drafted to reflect as being directed to a “computer database-driven system for managing *structural changes to databases on a prompt-*

by-prompt level” as the Appellants argue. The system is known, as the Specification discloses. The focus, as claimed, is performing certain operations to update a process, not the (well-known) system. *Cf. In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016) (holding that the claims’ focus “was not on an improved telephone unit or an improved server”).

“The ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Tex.*, 838 F.3d at 1257 (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)); *see also Enfish*, 822 F.3d at 1335, quoted in *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1241 (Fed. Cir. 2016).

In that regard, via the disclosed invoice-approval-process example, the Background section of the Specification discusses the problem, which is “incorporating updates into a partially completed process may be a daunting task for a user in the prior art.” Spec., para. 8. According to the Specification, the inventors solved the problem by “a mechanism to determine when a change impacts a particular user and automatically updates a user’s response based on the criteria of the changes.” Spec., para. 8. In light of Specification’s description of the problem and solution, the advance over the prior art by the claimed invention is updating a partially completed process. This is the heart of the invention. *Cf. Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1328 (Fed. Cir. 2017)

("[T]he heart of the claimed invention lies in creating and using an index to search for and retrieve data . . . an abstract concept.").

Given the focus of the claims as a whole is on updating a process to address a change to the process and, in light of the Specification, the heart of the invention is updating a partially completed process, the claims are properly characterized as being "directed to" updating a partially completed process. The Examiner's characterization (i.e., "managing a business process execution (i.e. approving an invoice)") is not incorrect. It simply describes the concept to which the claims are directed to at a different level of abstraction. *Cf. Apple, Inc. v. Ameranth, Inc.*, 842 F.3d at 1240–41 ("An abstract idea can generally be described at different levels of abstraction. As the Board has done, the claimed abstract idea could be described as generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location. It could be described in other ways, including, as indicated in the specification, taking orders from restaurant customers on a computer.").

We now turn to the question of whether updating a partially completed process or, as the Examiner puts it, "managing a business process execution (i.e. approving an invoice)," which the claims are "directed to" is a patent-ineligible abstract idea.

In that regard, the Appellants argue that

the Examiner concludes, without supporting evidence, that the claims are directed to an abstract idea. The burden is initially on the Examiner to provide a prima facie showing that the claimed invention constitutes an abstract idea, and without such showing, the burden does not shift to the Appellant to prove the claimed invention does not constitute an abstract idea. The Examiner's mere reliance on

conclusory statements that the claims are directed to an abstract idea does not shift the burden to the Appellant. As indicated above, the Supreme Court appears to have characterized abstract ideas as fundamental, long prevalent, and well-known and used for hundreds of years. The Examiner has provided no evidentiary support to establish that the claims are directed to an abstract idea as characterized by the Supreme Court.

Br. 9. The argument is unpersuasive.

Section 132 sets forth a more general notice requirement whereby the applicant is notified of the reasons for a rejection together with such information as may be useful in judging the propriety of continuing with prosecution of the application. *See, e.g., In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (citing 35 U.S.C. § 132). We disagree that, in this case, the Examiner has failed to provide an adequate explanation to meet said notice requirement.

The Examiner explained “the concept of managing a business process execution (i.e. approving an invoice) is an economic practice long prevalent in our system of commerce and squarely within the realm of abstract ideas. The concept is similar to the Alice Corp. case invalidated by the Court.” Final Rej. 5. We agree with that assessment. “[B]oth this court and the Supreme Court have found it sufficient to compare claims at issue to those claims already found to be directed to an abstract idea in previous cases.” *Enfish*, 822 F.3d at 1334. In that regard, we see little difference between updating a partially completed process or, as the Examiner puts it, “managing a business process execution (i.e. approving an invoice)” and “intermediated settlement” (*Alice*), the latter having been determined to be a fundamental economic practice and, as such, an abstract idea. The case law is replete with examples of business practices determined to be akin to

fundamental economic practices and thereby abstract ideas. The claimed subject matter to which the claims here are directed to (whether updating a partially completed process or, as the Examiner puts it, “managing a business process execution (i.e. approving an invoice)”) are akin to claimed subject matter previously determined to be abstract ideas such as “creating an index and using that index to search for and retrieve data” (*Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d at 1327); “organizing, displaying, and manipulating data of particular documents” (*Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017)); and, “[u]sing organizational and product group hierarchies to determine a price” (*Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1333 (Fed. Cir. 2015)).

Step two is “a 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.’” *Alice*, 134 S. Ct. at 2355 (*quoting Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 73 (2012)).

In that regard, the Examiner determined that “[v]iewed 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.” Final Rej. 6.

The Appellants argue that “the claims are believed to be novel and nonobvious over the cited prior art and, as a result, cannot be directed to an

abstract idea that is considered fundamental, long prevalent, and well-known and used for hundreds of years.” Br. 9. That is not a persuasive argument.

Notwithstanding that “the § 101 patent-eligibility inquiry and, say, the § 102 novelty inquiry might sometimes overlap,” “a claim for a *new* abstract idea is still an abstract idea.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (*quoting Mayo*, 566 U.S. at 90). The question in step two of the *Alice* framework is not whether an additional feature is novel but whether the implementation of the abstract idea involves “more than the performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1347–48 (*quoting Alice*, 134 S. Ct. at 2359).

Finally, the Appellants argue that “[c]laims 1-6, 8-13, and 15-18 address the problem caused by modifications to information stored in a computer database. The claims are generally directed to dynamically protecting the integrity of the information in a computer database in response to database modifications.” Br. 11. Similarly, the Appellants argue that “[c]laims 1-6, 8-13, and 15-18 recite elements that are clearly technical in nature and clearly go well beyond the alleged abstract idea.” Br. 12. This is not a persuasive argument.

We see nothing in the claim about “dynamically protecting the integrity of the information in a computer database in response to database modifications.” The difficulty here is the claim has been drafted so that as a whole it provides a result-oriented solution without any computer-centric details for accomplishing it. The Appellant raises such details via an

argument in support of the invention being “clearly technical.” But the claim does not now reflect those details. *Cf. Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d at 1342 (explaining that “[o]ur law demands more” than claim language that “provides only a result-oriented solution, with insufficient detail for how a computer accomplishes it”) and *Elec. Power Grp.*, 830 F.3d at 1354 (explaining that claims are directed to an abstract idea where they do not recite “any particular assertedly inventive technology for performing [conventional] functions”).

We have considered all of the Appellants’ remaining arguments (including those made in the Reply Brief) and find them unpersuasive. Accordingly, because we are not persuaded as to error in the determinations that representative claim 1, and claims 2–6, 8–13, and 15–18 which stand or fall with claim 1, are directed to an abstract idea and do not present an “inventive concept,” we sustain the Examiner’s conclusion that they are directed to patent-ineligible subject matter for being judicially-excepted from 35 U.S.C. § 101. *Cf. LendingTree, LLC v. Zillow, Inc.*, 656 F. App’x. 991, 997 (Fed. Cir. 2016) (“We have considered all of LendingTree’s remaining arguments and have found them unpersuasive. Accordingly, because the asserted claims of the patents in suit are directed to an abstract idea and do not present an ‘inventive concept,’ we hold that they are directed to ineligible subject matter under 35 U.S.C. § 101.”); *see also, e.g., OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1364 (Fed. Cir. 2015) and *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016).

The rejection of claims 1, 2, 5, 6, 8, 9, 12, 13, and 15–18 under 35 U.S.C. § 103(a) as being unpatentable over Kraft, Kanie, Hunter, AAPA, and Satoh.

The Examiner’s position is that Kraft discloses all that is claimed in independent claims 1, 8, and 15, but for

- (1) the type of dynamic process execution (OPE), i.e. a partially completed OPE,
- (2) the type of data object: at least one of a prompt component and a response component,
- (3) determination of the updating of the partially completed step, and
- (4) the “wherein clause” with displaying “update guidance” and “updated prompt component”.

Final Rej. 15; *see also id.* at 24. Kanie is relied upon for disclosing (4) (*id.* at 15–17), Hunter for (2) (*id.* at 17–18), AAPA for (1) (*id.* at 24), and Satoh for (1) and (3) (*id.* at 18–19, 24–25). According to the Examiner, it would have been obvious over Kraft and Kanie to include (4) (*id.* at 17); over Kraft, Kanie and Hunter to include (2) (*id.* at 18); over Kraft, Kanie, Hunter, and AAPA to include (1) (*id.* at 24), and, over Kraft, Kanie, Hunter, AAPA, and Satoh to include (1) and (3) (*id.* at 19, 25).

The Appellants argue, *inter alia*, that “[t]he Examiner clearly erred in asserting that Kanie teaches [(4)] displaying an updated prompt component and an updated response to the updated prompt component.” Br. 15.

The “wherein” clause of claim 1 recites:

wherein if said change occurred with respect to said prompt component, displaying an updated prompt component that resulted from said change, obtaining an updated response to said updated prompt component from said user, and wherein performing the update action on the database further comprises performing the obtained updated response on the database.

The other independent claims recite similar subject matter.

According to the Examiner,

[i]n a similar document processing system, comprising a computer 1 connected to a network 8 which is a document management server having a **difference extraction function program** 61 for structured documents, **KANIE ET AL.** is cited concept of **monitoring multi-version documents** by displaying the contents of the version V1 in its display area, Fig. 22, area 221, and the contents of version V2 in its display area 222, and comparing the contents line by line for any difference. The **difference information** (change or modification) is then **displayed** for monitoring purpose. The document management system also comprises a process for updating multi-version document if desired. {see Figs. 22, 23, and ¶¶ [0010, 0012, 0013, 0048, 0081-0083 and 0085-0088]}.

Final Rej. 15.

The difficulty with Examiner's position is that the subject matter of said "wherein" clause is directed to "[the] change [that] has occurred to at least one of a prompt component *in the database* and a response component *in the database* associated with said dynamic process, which is partially completed by said user" (claim 1 (emphasis added)). Kanie, by contrast, is directed to a "method for generating a multi-version document using an original version and a revised version of a structured document." Kanie 7 (claim 1). The problem Kanie is solving is that "the conventional method for indicating difference information displays difference information obtained as a result of comparing only two versions: a reference version and each target version." *Id.* at para. 10. "[T]he present invention is capable of expressing changes made to a specific version selected from among a plurality of versions, using a single multi-version document." *Id.* at para. 17. As the Appellants point out, "Kanie generally describes displaying textual changes that are made to versions of a document." Br. 16. We do not see

Kanie disclosing or suggesting the subject matter of said “wherein” clause. Furthermore, we do not see, and the Examiner does not adequately explain, how one of ordinary skill given Kraft’s disclosure of “techniques for updating a local cache database of an application system in a multiple-system environment” (para. 4) and Kanie’s method of creating a single multi-version document reach the claimed subject including that which is in the claim’s wherein clause.

For the foregoing reasons, the rejections are not sustained.

The rejection of claims 3, 4, 10, and 11 under 35 U.S.C. § 103(a) as being unpatentable over Kraft, Kanie, Hunter, AAPA, Satoh, and Troyansky.

These claims which depend from the independent claims whose rejection we do not sustain for the reasons above, and whose rejection relies on the position taken with respect to the independent claims (Final Rej. 22 and 26) is not sustained for the same reasons.

CONCLUSIONS

The rejection of claims 1–6, 8–13, and 15–18 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter is affirmed.

The rejection of claims 1, 2, 5, 6, 8, 9, 12, 13, and 15–18 under 35 U.S.C. § 103(a) as being unpatentable over Kraft, Kanie, Hunter, AAPA, and Satoh is reversed.

The rejection of claims 3, 4, 10, and 11 under 35 U.S.C. § 103(a) as being unpatentable over Kraft, Kanie, Hunter, AAPA, Satoh, and Troyansky is reversed.

Appeal 2017-000564
Application 11/020,058

DECISION

The decision of the Examiner to reject claims 1–6, 8–13, and 15–18 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)(1)(iv).

AFFIRMED