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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* TERRENCE G. CLARK, PETER J. GILBERT,  
JAMES B. MERCER, and JANNE M.P. KOPONEN

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Appeal 2017-000609  
Application 12/765,947<sup>1</sup>  
Technology Center 3600

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Before TARA L. HUTCHINGS, ROBERT J. SILVERMAN, and  
ALYSSA A. FINAMORE *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> The Appellants identify CA, Inc. as the real party in interest. Appeal Br. 3.

### ILLUSTRATIVE CLAIM

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

storing in a computer system a plurality of characteristics of an activity, the activity contributing to the carbon footprint of an organization, the plurality of characteristics comprising:

a unit of measurement;

an activity category;

a plurality of geographic hierarchical descriptors;

and

a respective multiplier for each one of the plurality of geographic hierarchical descriptors, wherein each respective multiplier is associated with a respective time stamp;

storing in the computer system characteristics of a stakeholder object defining a stakeholder of the organization that is impacted by the activity, the characteristics of the stakeholder object comprising (1) a first indication of an extent to which a stakeholder interest actually aligns with an organizational interest and (2) a second indication of an extent to which the stakeholder interest could potentially be optimally aligned with the organizational interest;

receiving from the computer system data representing a number of the unit of measurement;

receiving from the computer system data representing a first one of the plurality of geographic hierarchical descriptors;

calculating using a processor of a computer unit a carbon emission value based at least in part by multiplying the number of the unit of measurement by the respective multiplier of the first one of the plurality of geographic hierarchical descriptors;

storing in the computer system the carbon emission value;

in response to determining that the first indication of the extent to which the stakeholder interest actually aligns with the

organizational interest differs from the second indication of the extent to which the stakeholder interest could potentially be optimally aligned with the organizational interest by a predetermined amount, transmitting a progress report regarding the activity to the stakeholder;

receiving from the computer system data representing a second one of the plurality of geographic hierarchical descriptors; and

in response to the received data representing the second one of the plurality of geographic hierarchical descriptors, automatically updating the stored carbon emission value with a recalculated carbon emission value, wherein the automatically updating comprises:

determining that the respective multiplier of the second one of the plurality of geographic hierarchical descriptors is out of date based on the associated time stamp;

updating the respective multiplier of the second one of the plurality of geographic hierarchical descriptors; and

multiplying the number of the unit of measurement by the respective multiplier of the second one of the plurality of geographic hierarchical descriptors.

#### CITED REFERENCES

- |   |                    |               |
|---|--------------------|---------------|
| McConnell et al.<br>(hereinafter “McConnell”)   | US 2007/0260405 A1 | Nov. 8, 2007  |
| Kumar et al.<br>(hereinafter “Kumar”)   | US 2008/0270205 A1 | Oct. 30, 2008 |
| Sandor et al.<br>(hereinafter “Sandor”)   | US 2009/0043653 A1 | Feb. 12, 2009 |
| Chan et al.<br>(hereinafter “Chan”)   | US 2010/0114836 A1 | May 6, 2010   |
| Claire Capon, <i>Understanding Organisational Context</i> (2d ed., 2004)<br>(hereinafter “Capon”) |                    |               |

## REJECTIONS

I. Claims 1–20 are rejected under 35 U.S.C. § 101 as ineligible subject matter.

II. Claims 1–20 are rejected under 35 U.S.C. § 112 (pre-AIA), first paragraph,<sup>2</sup> as failing to comply with the written-description requirement.

III. Claims 1–20 are rejected under 35 U.S.C. § 112 (pre-AIA), second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

IV. Claims 1–20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Sandor, McConnell, Chan, Kumar, and Capon.

## FINDINGS OF FACT

The findings of fact relied upon, which are supported by a preponderance of the evidence, appear in the following Analysis.

## ANALYSIS

We begin by addressing the written-description rejection, followed by the indefiniteness rejection, the subject-matter-eligibility rejection, and the obviousness rejection.

### *Written Description*

Claims 1–20 stand rejected under 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written-description requirement, in regard to the following features recited in independent claim 1, for example:

storing in the computer system characteristics of a stakeholder object defining a stakeholder of the organization

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<sup>2</sup> The pre-AIA version of the statute is applied herein, because the Application under review was filed before the effective date of § 4(c) of the Leahy-Smith America Invents Act (AIA) (September 16, 2012). *See, e.g.*, MPEP § 2161(I).

that is impacted by the activity, the characteristics of the stakeholder object comprising (1) a first indication of an extent to which a stakeholder interest actually aligns with an organizational interest and (2) a second indication of an extent to which the stakeholder interest could potentially be optimally aligned with the organizational interest; [and]

in response to determining that the first indication of the extent to which the stakeholder interest actually aligns with the organizational interest differs from the second indication of the extent to which the stakeholder interest could potentially be optimally aligned with the organizational interest by a predetermined amount, transmitting a progress report regarding the activity to the stakeholder.

*See* Final Action 9–10.

The Appellants argue that the Specification adequately describes the identified limitations, referring to the following passage of the Specification:

The stakeholder object may further enable a user or manager application 150 to score the extent to which stakeholder interests align with organizational interests and/or the extent to which such interests may be optimally aligned. In some cases, this information may indicate the volatility of particular stakeholder relationships. For example, if a stakeholder is rated as important and the delta between actual and optimal interest alignment is high, then manager application 150 may suggest taking action to improve the relationship. Manager application 150 may be capable of generating reports that indicate organization activities that have a significant impact on stakeholder interests. Thus, step 218 may include generating a variety of reports logically linked to particular stakeholders, which may be used, for example, to help shape the perception of sustainability efforts and objectives.

In various embodiments, stakeholder objects may be linked to one or more projects. In this manner, stakeholder interests may be a factor considered during the portfolio identification of step 210. Additionally, during the course of a

project, various progress reports and/or dashboards may be generated in step 218 and automatically communicated to stakeholders. The relevant stakeholder identities for each project may be readily determined using the linked stakeholder objects. In addition, as shown in FIGURE 9, the nature of various relationships between stakeholders and projects may be defined. For example, the stakeholder “Building Technologies, Inc.” is shown as having or expected to have a very strong influence over the “building insulation” project. As another example, the stakeholder “Employees” are impacted only minimally by the “several consolidation” project.

Appeal Br. 19 (quoting Spec. 22, ll. 5–26).

To satisfy the written description requirement, the patent disclosure must “reasonably convey[ ] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The Specification must describe the claimed subject matter, although it need not contain the exact wording used in the claim. *See Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

According to the Examiner, the disclosure of the identified portion of the Specification is inadequate:

While the [S]pecification describes the stored ‘indications’ as scores (see [S]pecification Pg. 22, Ln. 5–15 and FIG. 2), ‘indication’ is broad enough to cover any type of data. There is no discussion of what the indications are based upon or how Appellants contemplated comping [sic] up with them other than the indications may indicate volatility of particular stakeholder relationships. The disclosure does not [sic] a sufficient description of the indications to support such a broad claim for any and all indications. There is also no discussion of how differences in the indications (which could be any type of data) would be determined.

Answer 7. Yet, the purported frailties that the Examiner describes do not stem from any uncertainty about whether the Appellants “had possession of the claimed subject matter as of the filing date.” *Ariad*, 598 F.3d at 1351. Rather than possession of the claimed subject matter, the Examiner’s determination that the Specification fails to show “what the indications are based upon” (Answer 7), for example, speak more directly to an inquiry into claim definiteness, under 35 U.S.C. § 112 (pre-AIA), second paragraph, because the Examiner’s concern is whether a person of ordinary skill in the art would be able to understand the meaning of this claim language.

Therefore, we are persuaded that the Examiner has not shown sufficiently that independent claim 1 fails to comply with the written-description requirement. The same reasoning applies to the other independent claims in the Appeal (claims 8 and 15). Accordingly, we do not sustain the rejection of claims 1–20 under 35 U.S.C. § 112 (pre-AIA), first paragraph.

#### *Indefiniteness*

During the Office’s evaluation, under 35 U.S.C. § 112 (pre-AIA), second paragraph, a proposed patent “claim is indefinite when it contains words or phrases whose meaning is unclear,” i.e., “ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention.” *In re Packard*, 751 F.3d 1307, 1310–11 (Fed. Cir. 2014) (per curiam); *see also In re McAward*, No. 2015-006416, 2017 WL 3669566, at \*3, \*5–\*6 (PTAB Aug. 25, 2017) (precedential).

The Examiner rejects claims 1–20, for being indefinite — specifically pointing to the following features of exemplary independent claim 1, as problematic:



(1) a first indication of an extent to which a stakeholder interest actually aligns with an organizational interest and (2) a second indication of an extent to which the stakeholder interest could potentially be optimally aligned with the organizational interest.

*See* Final Action 11. *See also* Answer 8–9. According to the Examiner, the circumstances in which a “stakeholder interest” “actually aligns with an organizational interest” and in which it “could potentially be optimally aligned with the organizational interest” are not clearly defined, and the Specification discloses no technique for measuring these characteristics or for ascertaining whether these limitations might be satisfied. *See* Final Action 11. *See also* Answer 8–9.

The Appellants argue that the identified language of claim 1 is sufficiently clear, pointing out that “[a]ctual alignment describes a current state of alignment or the state of alignment at the last measurement date, while potential optimal alignment is that maximum possible alignment between the stakeholder and organizational interests.” Appeal Br. 20. Further, the Appellants contend that the Specification clearly describes the claim language in question:

For example, the Application as filed, Page 22, Lines 5–26 describes an “extent to which stakeholder interests align with organizational interests and/or the extent to which such interests may be optimally aligned.” The Specification continues to state that “if a stakeholder is rated as important and the delta between actual and optimal interest alignment is high,” then the manager application can suggest taking an action “to improve the relationship.” *Id.* at 22:9–11[.] “[T]he nature of various relationships between stakeholders and projects may be defined.” *Id.* at 22:22–24.

*Id.* at 20–21.

The Appellants' arguments are not persuasive of error in the rejection of claim 1. The Appellants offer alternative expressions for some of the identified claim language — i.e., “a current state of alignment” or “the state of alignment at the last measurement date” (for the recited “actual alignment”), and “maximum possible alignment” (for the recited “potential optimal alignment”). *Id.* at 20. Yet, the Appellants' proposed alternative expressions are no clearer than their corresponding phrases in claim 1. Nor do the Appellants' alternative expressions and citations to the Specification address the Examiner's point that a person of ordinary skill in the art would not be able to evaluate the claimed “align[ment],” so as to determine the scope of the claim. *See* Final Action 11. *See also* Answer 8–9.

In view of the foregoing, we are not persuaded that the rejection of independent claim 1, as being indefinite, is erroneous. This determination also applies to independent claims 8 and 15, which contain language similar to that discussed above, and which the Appellants do not argue separately. Accordingly, we sustain the rejection of claims 1–20 under 35 U.S.C. § 112 (pre-AIA), second paragraph.

#### *Subject-Matter Eligibility*

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. Yet, subject matter belonging to any of the statutory categories may, nevertheless, be ineligible for patenting. The Supreme Court has interpreted § 101 to exclude laws of nature, natural phenomena, and abstract ideas, because they are regarded as the basic tools of scientific and technological work, such that including them within the domain of patent protection would risk inhibiting future innovation premised upon

them. *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013).

Of course, “[a]t some level, ‘all inventions . . . embody, use, reflect, rest upon, or apply’” these basic tools of scientific and technological work. *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (internal citation omitted). Accordingly, evaluating ineligible subject matter, under this judicial exclusion, involves a two-step framework for “distinguish[ing] between patents that claim the buildin[g] block[s] of human ingenuity and those that integrate the building blocks into something more, thereby transform[ing] them into a patent-eligible invention.” *Id.* (internal quotation marks and citation omitted). The first step determines whether the claim in question is directed to judicially excluded subject matter (such as a so-called “abstract idea”); the second step determines whether there are any “additional elements” recited in the claim that (either individually or as an “ordered combination”) amount to “significantly more” than the identified judicially excepted subject matter itself. *Id.* at 2355.

Although “claim construction is not an inviolable prerequisite” to an analysis under § 101, “a full understanding of the basic character of the claimed subject matter” is, nevertheless, needed to evaluate questions of subject-matter eligibility. *Bancorp Servs., LLC v. Sun Life Assur. Co. of Canada (U.S.)*, 687 F.3d 1266, 1273–74 (Fed. Cir. 2012). *See also McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1311 (Fed. Cir. 2016) (“As an initial matter, we note that, in this case, claim construction is helpful to resolve the question of patentability under § 101.”)

In the present Appeal, we are unable to ascertain such an understanding of the claimed subject matter and, therefore, we do not assess

the merits of the rejection under § 101. For the reasons given above, we determine that the claims are indefinite under 35 U.S.C. § 112 (pre-AIA), second paragraph — a problem that affects both the Examiner’s identification of an abstract idea (i.e., the judicial exclusion to which the claims are said to be directed), as well as claim elements that the Appellants allege to constitute significantly more than the abstract idea.

According to the Examiner, in regard to the first *Alice* step, the claims are directed to an abstract idea, described variously as “a method for measuring an activity of an organization and measuring stakeholder interests” (Final Action 3) and “managing organization activities and stakeholders” (*id.* at 6). These characterizations invoke the very claim recitations — i.e., claim 1’s “align[ment]” of “stakeholder” and “organizational” “interests,” as well as the “extent to which” these “interest[s]” “could potentially be optimally aligned” — that engender indefiniteness.

Furthermore, the Appellants argue, under the second *Alice* step, that the same questionable claim language amounts to something “significantly more” than the identified abstract idea:

[A]dditional limitations are recited in the claims such that they amount to significantly more than the mathematical operation itself. For example, Claim 1 recites additional steps of determining that *the first indication of the extent to which the stakeholder interest actually aligns with the organizational interest differs from the second indication of the extent to which the stakeholder interest is optimally aligned with the organizational interest* by a predetermined amount, and transmitting a progress report regarding the activity to the stakeholder. Thus, the claim as a whole does not simply describe the calculation of a pollutant quantity, but combines steps regarding selection of an acceptable pollutant factor for

the location based on the time stamp to calculate the emission value with management of stakeholder interests. The claim goes beyond the mere concept of simply retrieving and combining data using a computer.

Appeal Br. 17–18 (emphasis added).

Under the present circumstances, the rejection under § 101 must fall, *pro forma*, because it is necessarily based upon a speculative assumption as to the meaning of the claims. *See In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (addressing an obviousness rejection). This determination does not reflect on the merits of the underlying rejection based upon § 101.

Therefore, notwithstanding the merits of the rejection, we do not sustain the rejection of claims 1–20 under 35 U.S.C. § 101.

#### *Obviousness*

The Appellants advance two arguments alleging error in the obviousness rejection of claims 1–20.

In the first argument, the Appellants contend that independent claim 1 stands rejected erroneously, because the cited prior art references do not teach or suggest the limitations emphasized below:

storing in the computer system characteristics of a stakeholder object defining a stakeholder of the organization that is impacted by the activity, the characteristics of the stakeholder object comprising (1) a first indication of an extent to which a stakeholder interest actually aligns with an organizational interest and (2) a second indication of an extent to which the stakeholder interest could potentially be optimally aligned with the organizational interest;

receiving from the computer system data representing a number of the unit of measurement;

receiving from the computer system data representing a first one of the plurality of geographic hierarchical descriptors;

calculating using a processor of a computer unit a carbon emission value based at least in part by multiplying the number of the unit of measurement by the respective multiplier of the first one of the plurality of geographic hierarchical descriptors;

storing in the computer system the carbon emission value;

in response to *determining that the first indication of the extent to which the stakeholder interest actually aligns with the organizational interest differs from the second indication of the extent to which the stakeholder interest could potentially be optimally aligned with the organizational interest by a predetermined amount, transmitting a progress report regarding the activity to the stakeholder*[,]

as recited in claim 1, and similarly recited in claims 8 and 15. Appeal Br. 21–22 (Appellants’ emphasis).

The Appellants’ first non-obviousness argument turns on claim language giving rise to claim indefiniteness, as discussed above. Because evaluating this nonobviousness argument would necessarily be based upon speculation as to the meaning of the claims, the rejection cannot stand and is reversed, *pro forma*, herein. See *Steele*, 305 F.2d at 862–63. This determination does not reflect on the merits of the underlying rejection based upon § 103(a).

As to the Appellants’ second argument, the Appellants contend that neither McConnell nor Sandor teach or suggest the following limitation:

automatically updating the stored carbon emission value with a recalculated carbon emission value, wherein the automatically updating comprises:

determining that the respective multiplier of the second one of the plurality of geographic hierarchical descriptors is out of date based on the associated time stamp;

updating the respective multiplier of the second one of the plurality of geographic hierarchical descriptors; and

multiplying the number of the unit of measurement by the respective multiplier of the second one of the plurality of geographic hierarchical descriptors.

*See* Appeal Br. 24–25.

Critical to the Appellants’ position are the assertions that “*McConnell* does not disclose, teach, or suggest each respective multiplier is associated with a respective time stamp” and that “*Sandor* does not cure this deficiency,” such that the claimed features of “determining that the respective multiplier . . . is out of date” and “updating the respective multiplier” are not taught or suggested by the prior art of record. *Id.* at 25.

The Appellants’ second argument is unpersuasive, because the Examiner relies upon Chan for the “time stamp” feature — *not* *McConnell* or *Sandor*. *See* Final Action 16–18. *See also* Answer 13–18.

For the reasons provided above — and notwithstanding the merits of the rejection and the unpersuasiveness of the Appellants’ second argument — we do not sustain the rejection of claims 1–20 under 35 U.S.C. § 103(a).

#### DECISION

We REVERSE, *pro forma*, the Examiner’s decision rejecting claims 1–20 under 35 U.S.C. § 101.

We REVERSE the Examiner’s decision rejecting claims 1–20 under 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written-description requirement.

We AFFIRM the Examiner’s decision rejecting claims 1–20 under 35 U.S.C. § 112 (pre-AIA), second paragraph, for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

We REVERSE, *pro forma*, the Examiner’s decision rejecting claims 1–20 under 35 U.S.C. § 103(a).

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED