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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* DAVID GRAVES, ADRIAN JOHN BALDWIN,  
YOLANTA BERESNEVICHIE, PHILIPPE LAMY, and  
SIMON KAI-YING SHIU

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Appeal 2017-000670<sup>1</sup>  
Application 11/739,839<sup>2</sup>  
Technology Center 3600

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Before ANTON W. FETTING, BIBHU R. MOHANTY, and  
TARA L. HUTCHINGS, *Administrative Patent Judges*.

HUTCHINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 1, 3–6, 11–19, and 21–27. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> Our decision references Appellants’ Appeal Brief (“App. Br.,” filed Feb. 11, 2016) and Reply Brief (“Reply Br.,” filed Oct. 12, 2016), the Examiner’s Answer (“Ans.,” mailed Aug. 12, 2016) and the Final Office Action (“Final Act.,” mailed Sept. 24, 2015), and the Board’s Prior Decision (“Prior Dec.,” Mar. 5, 2015).

<sup>2</sup> Appellants identify Hewlett Packard Enterprise Development LP as the real party in interest. App. Br. 1.

### CLAIMED INVENTION

Claims 1, 15, and 22 are the independent claims. Claim 1, reproduced below with bracketed annotations, is illustrative of the subject matter on appeal:

1. A method comprising:

[(a)] receiving, by a computer, audit exceptions indicative of instances of noncompliance of an information system under evaluation relative to a policy or standard;

[(b)] in response to receiving the audit exceptions, consulting, by the computer, a remediation recommendation database storing remediation recommendations, each remediation recommendation to provide instructions to resolve an associated condition that results in noncompliance of the particular policy or standard should the condition occur;

[(c)] automatically identifying, from the remediation recommendations stored in the remediation recommendation database and by the computer, remediation recommendations that are relevant to the audit exceptions and that indicate how to correct conditions that caused the instances of noncompliance indicated by the audit exceptions;

[(d)] automatically providing, by the computer, the identified remediation recommendations to an automated remediation utility to cause the automated remediation utility to correct the conditions to bring the information system into compliance with the policy or standard by which the information system was under evaluation; and

[(e)] temporarily suppressing, by the computer, for a predetermined time or until a predetermined event has occurred, notification of an audit exception and associated remediation recommendation when an associated priority is below a predetermined threshold.

### REJECTION

Claims 1, 3–6, 11–19, and 21–27 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

## ANALYSIS

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).

Here, in rejecting independent claims 1, 15, and 22 under 35 U.S.C. § 101, the Examiner analyzes the claim using this two-step analysis. Final Act. 5–7; *see also id.* at 2–5; Ans. 2–9. More specifically, pursuant to the first step, the Examiner determines the claim is directed to the abstract idea of “identifying remediation recommendations for noncompliant systems and providing those remediation recommendations to an automated

remediation utility,” which is a method of organizing human activities and an abstract idea. Final Act. 6. The Examiner determines that the claims are similar to claims involving comparing information and using rules to identify that our reviewing court has held to be abstract. *Id.* (citing *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 Fed. App’x 950, 954 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 58 (2014)). Turning to the second step, the Examiner determines that the elements of the claim, considered individually and as an ordered combination, do not amount to significantly more than the abstract idea. *Id.* at 6–7. In particular, the Examiner determines that the additional elements (e.g., processors, database, storage) comprise generically recited computer, and the steps of receiving and transmitting data are basic functions of a computer that are well-understood, routine, and conventional. *Id.* at 6. The Examiner also determines that the claims do not purport to improve the functioning of the computer or to improve any other technology or technical field, does not transform an article into another state or thing, and does not recite any unconventional steps. *Id.*

Appellants argue that, in determining what claim 1 is directed to, the Examiner oversimplifies and mischaracterizes independent claim 1. App. Br. 8; Reply Br. 5–7. In particular, Appellants repeat limitations (a) and (c)–(e), as recited in claim 1, and charges “[i]t is error for the Examiner to characterize the subject matter of claim 1 as merely constituting ‘comparing new and stored information and using rules to identify options.’” App. Br. 8. Appellants also assert that claim 1 is “significantly different from the claim at issue in the **non-precedential** *SmartGene* decision.” *Id.* In this regard, Appellants contend that “the key to the finding in *SmartGene*

that the claim at issue is directed to patent-ineligible subject matter is that the steps of the claim are **routine** steps that can be performed mentally by humans (i.e., doctors).” *Id.* at 9. Yet, claim 1, “[u]nlike the claim in *SmartGene*,” “includes more than just routine steps that can be performed mentally by humans,” because it recites allowable subject matter under § 103. *See id.* (citing Board Dec. 11–12 (reversing the § 103 rejection of certain dependent claims, the subject matter of which is now recited in the independent claims)). For similar reasons, Appellants take issue with the Examiner’s characterization of the claim as a “long-standing” method of organizing human activities, asserting that at least one element of claim 1 is not taught by the art of record. *Id.* at 10. Appellants’ arguments do not apprise us of error in the Examiner’s step one analysis.

As set forth above, the Examiner determines that independent claim 1 is directed to “identifying remediation recommendations for noncompliant systems and providing those remediation recommendations to an automated remediation utility.” Final Act. 6. We agree with the Examiner that this characterization fairly represents the character of the claim as a whole. *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015) (“Under step one of *Mayo/Alice*, the claims are considered in their entirety to ascertain whether their character as a whole is directed to excluded subject matter.”).

For example, independent claim 1 recites the steps of: (a) receiving audit exceptions, (b) consulting a remediation recommendation database storing remediation recommendations, (c) identifying relevant remediation recommendations, (d) providing the remediation recommendation, and (e) temporarily suppressing notification of an audit exception and associated

remediation recommendation when its priority is below a threshold. Independent claim 1, thus, recites steps for providing remediation recommendations that includes collecting data (e.g., limitation (a)), analyzing the data (e.g., limitations (b) and (c)), and providing the results of the collection and analysis (e.g., limitation (d) and (e)).

This concept is similar to other concepts that the courts have held to be abstract ideas. *See Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (“[T]he decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.”). For example, in *Electric Power Group*, the Federal Circuit held that claims focused “on collecting information, analyzing it, and displaying certain results of the collection and analysis” are directed to an abstract idea. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). Stating that “[i]nformation as such is an intangible,” the Federal Circuit in *Electric Power Group* noted that the Federal Circuit has “treated collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.” *Id.* (internal citations omitted). The Federal Circuit pointed out that “[i]n a similar vein, . . . [it has] treated analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Id.* at 1354.

Like the claims in *Electric Power*, the advance Appellants’ claims “purport to make is a process of gathering and analyzing information of a specified content, then . . . [transmitting] the results, and not any particular

assertedly inventive technology,” i.e., an abstract idea. *Elec. Power Grp.*, 830 F.3d at 1354. Moreover, instead of focusing on the technical implementation details of these claimed functions, claim 1 recites no more than the result of the functions. Such claims are drawn to an abstract idea because they claim the desired functionality, not a particular way of performing that function. *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1258–59 (Fed. Cir. 2016). Appellants’ claims manipulate data but fail to do so in a non-abstract way. That the claims may recite a feature that is novel and non-obvious does not “avoid the problem of abstractness.” *Id.* at 1263.

Appellants also argue that claim 1 is not directed to an abstract idea because they recite “specific interactions among various physical entities, including a computer, an information system that is under evaluation, a remediation recommendation database, and an ‘automated remediation utility.’” App. Br. 12. Yet, Appellants do not identify, and we do not see, any parameters for these “specific interactions” dictating how any of the interactions are performed. At best, claim 1 requires the use of generic technological environment in which to carry about the recited abstract idea, but that is not sufficient for patent eligibility. *See In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016) (holding that, despite reciting “concrete, tangible components,” the claims were directed to an abstract idea where the “physical components merely provide[d] a generic environment in which to carry out the abstract idea.”).

In the Reply Brief, Appellants argue that claim 1 does not preempt the concept of “comparing new and stored information and using rules to identify options.” Reply Br. 7–8. 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 pre-emption 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*, 134 S. Ct. at 2354). “[P]reemption may signal patent ineligible subject matter, [but] the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

Seeing no legal error in the Examiner’s determination that the claims are directed to an abstract idea pursuant to the first step of the patent-eligibility analysis, we turn to Appellants’ arguments under the second step. Appellants argue that the Examiner erred in determining that limitation (e), as recited in claim 1, does not include an inventive concept sufficient to transform the subject matter of claim 1 into a patent-eligible application. App. Br. 14 (citing Prior Dec. 11–12 (reversing rejection under § 103 of dependent claims reciting the subject matter of limitation (e)); *see also* Reply Br. 10. However, eligibility under § 101 and obviousness under § 103 are separate inquiries. *Affinity Labs*, 838 F.3d at 1263. 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 (citation omitted).

Here, the claim 1’s limitation (e) recites “temporarily suppressing, by the computer, for a predetermined time or until a predetermined event has occurred, notification of an audit exception and associated remediation recommendation when an associated priority is below a predetermined threshold.” Yet, temporarily suppressing the notification when the audit exception has a low priority is no more than an abstract data processing step, which is insufficient to transform the abstract idea. *See, e.g.*, Spec. 17:16–18 (describing that notification of a relatively minor infraction may be temporarily suppressed until higher priority issued are address or a predetermined number of days have passed). The claim language does not recite what is inventive about limitation (e) or about the technology used to perform the step, and Appellants have not pointed us to, and we do not see, any portion of the Specification that fills this gap. Here, Appellants do not explain, and we fail to see, how the implementation of limitation (e) requires something other than a generic “computer” performing well-understood, routine and conventional computer functions, such as processing data.

Appellants argue that the claimed invention improves “the functioning of an information system . . . by addressing conditions that result in noncompliance of a policy or standard.” App. Br. 15; *see also id.* at 18 (the claimed invention improves the field of information system management); Reply Br. 10–11. Yet, the claimed solution, as described by Appellants, improves a business process for complying with a policy or standard, and does not result in an improvement to the functioning of the computer itself or to some other technology or technical field.

Appellants assert that independent claims 15 and 22 are directed to patent-eligible subject matter for reasons similar to claim 1. App. Br. 19. However, we are not persuaded by any of arguments with respect to claim 1, and thus, find these arguments equally unpersuasive with respect to claims 15 and 22. Appellants do not separately argue any of the dependent claims. *Id.* at 18–19.

In view of the foregoing, Appellants do not apprise us of error in the Examiner’s determination that the claims are judicially excepted from statutory subject matter. We, therefore, sustain the rejection of the claims under 35 U.S.C. § 101.

#### DECISION

The Examiner’s rejection of claims 1, 3–6, 11–19, and 21–27 under 35 U.S.C. § 101 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) (2009).

AFFIRMED