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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN DUECK

Appeal 2017-001320
Application 13/315,692
Technology Center 3600

Before ALLEN R. MacDONALD, IRVIN E. BRANCH and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–21. We have jurisdiction under 35 U.S.C. § 6(b).

Representative Claim

Representative claim 9 under appeal reads as follows (formatting, emphases and bracketed material added):

9. A computer-implemented method, comprising:
 - [A.] electronically receiving, at an order management system, a modify order from an order capture system while an in-flight order is being executed by the order management system;
 - [B.] suspending, by a processor, a first orchestration plan that corresponds to the in-flight order, the first orchestration plan comprising
 - [i.] a first metadata-driven executable orchestration process that comprises one or more process steps that fulfill the in-flight orderand further comprising
 - [ii.] one or more order components,wherein the first orchestration plan manages fulfillment of the in-flight order by one or more fulfillment systems that interface with the order management system using a computer network, an order component of the first orchestration plan comprising one or more order lines of the in-flight order,wherein the first orchestration plan comprises one or more order line dependencies between the one or

¹ According to Appellant the Real Party in Interest is Oracle International Corporation. App. Br. 2.

more order lines of the one or more order components, and

the one or more order line dependencies are based on a fulfillment flow comprising one or more fulfillment functions and one or more dependencies;

[C.] generating, by the processor, a second orchestration plan that corresponds to the modify order, the second orchestration plan comprising

[i.] a second metadata-driven executable orchestration process that comprises one or more process steps that fulfill the modify order

and further comprising

[ii.] one or more order components,

an order component of the second orchestration plan comprising one or more order lines of the modify order;

[D.] comparing, by the processor, the first orchestration plan with the second orchestration plan to determine differences between the first orchestration plan and the second orchestration plan,

wherein the differences between the first orchestration plan and the second orchestration plan comprise differences between the order components of the first orchestration plan and the order components of the second orchestration plan;

[E.] **identifying**, by the processor, one or more **compensation types** based on the differences between the order components of the first orchestration plan and the order components of the second orchestration plan;

[F.] **generating**, by the processor, **a modify order orchestration plan** using, in part, the differences between the first orchestration plan and the second orchestration plan, the modify order orchestration plan comprising

[i.] a third metadata-driven executable orchestration process that comprises one or more process steps that modify the in-flight order

and further comprising

[ii.] one or more order components,

an order component of the modify order orchestration plan compensating an order component of the original orchestration plan,

wherein the one or more order components of the modify order orchestration plan are generated based on the compensation types,

wherein the modify order orchestration plan comprises a compensation plan that compensates a portion of the first orchestration plan that has already been executed before the first orchestration plan was suspended,

wherein the one or more dependencies of the fulfillment flow corresponding to the first orchestration plan are applied to a fulfillment flow of the modify order orchestration plan; and

[G.] executing, by the processor, the modify order orchestration plan by sending a corresponding command from the order management system to the one or more fulfillment providers via the computer network interface.

Rejection on Appeal

The Examiner rejected claims 1–21 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. That is, the claims are directed to patent ineligible subject matter because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more.²

Issue on Appeal

Did the Examiner err in rejecting claim 9 as being directed to patent-ineligible subject matter?

ANALYSIS

We have reviewed the Examiner’s rejection in light of Appellant’s arguments that the Examiner has erred.

A. Section 101

Eligibility under 35 U.S.C. § 101 is determined using the *Alice/Mayo* framework. *Alice Corp. Pty. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014). The first step involves determining whether the claims at issue are directed to a patent-ineligible concept. *Id.* at 2355. The second step involves determining whether the elements of the claim contain an inventive concept sufficient to transform a claimed abstract idea into a patent-eligible application. *Id.* at 2357. The “inventive concept” may arise in one or more of the individual

² We select claim 9 as representative for claims 1–21. Appellant does not argue separate patentability for claims 1–21. Therefore, our claim 9 decision is determinative as to this § 101 rejection of these claims. Except for our ultimate decision, we do not discuss claims 1–8 and 10–21 further herein.

claim limitations or in the ordered combination of the limitations. *Alice*, 134 S. Ct. at 2355.

In *Bascom*, the Federal Circuit deferred consideration of the specific claim limitations' narrowing effect for *Alice* step two. *Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349 (Fed. Cir. 2016). The Federal Circuit held that determining, whether the claimed inventive concept is a technical improvement, can aid in evaluating the second step in the *Alice/Mayo* framework:

The district court thus concluded [wrongly] that BASCOM had not asserted adequately that the claims disclose an inventive concept because the limitations, “considered individually, or as an ordered combination, are no more than routine additional steps involving generic computer components and the Internet, which interact in well-known ways to accomplish the abstract idea of filtering Internet content.” [*District Court Order*, 107 F. Supp.3d at 655.]

We agree with the district court that the limitations of the claims, taken individually, recite generic computer, network and Internet components, none of which is inventive by itself. BASCOM does not assert that it invented local computers, ISP servers, networks, network accounts, or filtering. Nor does the specification describe those elements as inventive.

However, we disagree with the district court's analysis of the ordered combination of limitations. . . . As is the case here, an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.

[T]he patent *describes how its particular arrangement of elements is a technical improvement* over prior art ways of filtering such content.

Bascom, 827 F.3d at 1349–50, bracket and emphasis added.

B. *Alice/Mayo* – Step 2

As to step 2 of the *Alice/Mayo* Analysis the Examiner concluded:

[W]hile the claims recite hardware or software elements, such as processors, memory, or software units, generator modules/components, these limitations are not enough to qualify as “significantly more” being recited in the claims along with the abstract idea. ***Claimed limitations do not provide*** {i} specific applications or specific improvements to a specific technology, {ii} improvements to the functioning of the computer itself or {iii} meaningful limitations do more than generally linking the use of the abstract idea to a particular technological environment.

Final Act. 3 (emphasis added).

As to claim 9, Appellant contends the combination of elements is ***substantially more*** than the alleged abstract idea because:

Even if it is determined that claims 1-21 are directed to an abstract idea (which is not admitted by Applicant), Applicant respectfully submits that each of claims 1-21 amounts to “significantly more” than the alleged abstract idea.

App. Br. 10.

[C]laim [9] of the instant application recites [step A.] electronically receiving, at an order management system, a modify order from an order capture system while the in-flight order is being executed by the order management system and [step G.] executing the modify order orchestration plan by sending a corresponding command from the order management system to the one or more fulfillment providers via the computer network interface. Accordingly, at least these features render claims 1-21 as having significantly more than the abstract idea.

These are meaningful limitations that add more than generally linking the use of the abstract idea to a generic computer because they solve a problem that is necessarily rooted in computer technology.

App. Br. 13.

The Examiner responds:

Appellants argued that the remaining elements of [claim 9] would provide substantially more to transform the claims to be eligible under 35 U.S.C. 101. Examiner [] disagrees with this assertion. . . . Appellant's argument is unpersuasive since ***Appellant has failed to identify*** {i} specific applications or specific improvements to a specific technology, Appellant has also failed to identify {ii} improvements to the functioning of the computer itself or {iii} meaningful limitations do more than generally linking the use of the abstract idea to a particular technological environment. The concept of receiving/executing/processing a modify/change order to an order in-flight/being processed is nothing more than simply receiving/comparing/modifying data/tasks involved in an order fulfillment process.

Ans. 5 (emphasis added). The Examiner further responds:

As per claims 1-21, [the] ***remaining detailed functions and elements of the invention*** regarding details of the order such as
components/lines, and
orchestration plans and
details of how the modify order is generated and executed,
use of networked computers and software modules such as
order management system to receive the modify
order and to communicate the actions required by
fulfillment systems to execute the modify order
orchestration plan

do not fall under exceptions {i}, {ii} or {iii} provided above and thus would not transform the abstract idea into eligible subject matter. It is ***routine and conventional*** to use networked computer systems along with a software module such as a resource planning module to create/modify orders and communicate the changes to all parties involved in the fulfillment of that order.

Ans. 5–6 (formatting and emphasis added).

Although we are unpersuaded by Appellant's argument that the receiving/executing features (steps A and G) render claim 9 as having significantly more than the abstract idea, our § 101 review under the second step of the *Alice/Mayo* analysis is not limited to these two argued limitations. Rather, we consider all the additional claim 9 limitations (steps B through F) individually and as an ordered combination to determine whether the additional limitations transform the nature of the claim into a patent-eligible application. *See Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78–79 (2012).

Additionally, as to claim 9 steps B through F, we disagree with Examiner's conclusion that these steps are routine and conventional. These steps recite specific limitations that require the Examiner to undertake a more specific analysis to show they are routine and conventional. We do not find such specific analysis in the rejection on appeal. That is, we conclude the Examiner has provided insufficient analysis with support to show steps B through F are routine and conventional. Therefore, in turn there is insufficient support for a conclusion that the detailed functions and elements of the claimed invention do not transform the abstract idea into eligible subject matter.

The Examiner concludes Appellant's argument is unpersuasive because Appellant has failed to identify an exception (above reproduced {i}, {ii}, and {iii}) which applies to the claimed invention. We find no such burden on Appellant. Rather, the burden is on the Examiner to show that the claimed arrangement does not constitute a non-conventional arrangement thus showing it does not present a sufficiently inventive concept to transform the claims into patent-eligible subject matter. *See BASCOM Glob. Internet*

Appeal 2017-001320
Application 13/315,692

Servs., 827 F.3d at 1350 (“[A]n inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.”). For claim 9, steps B through F, we do not find such an Examiner showing in the rejection on appeal before us.

CONCLUSIONS

(1) Appellant has established that the Examiner erred in rejecting claims 1–21 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

(2) On this record, claims 1–21 have not been shown to be unpatentable.

DECISION

The Examiner’s rejection of claims 1–21 is reversed.

REVERSED