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.
13/969,688	08/19/2013	Martyn J. Dawkes	GB920050093US2	3605

30449 7590 07/02/2018

SCHMEISER, OLSEN & WATTS
22 CENTURY HILL DRIVE
SUITE 302
LATHAM, NY 12110

EXAMINER	
CHONG CRUZ, NADJA N	

ART UNIT	PAPER NUMBER
3623	

NOTIFICATION DATE	DELIVERY MODE
07/02/2018	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):

30449@IPLAWUSA.COM

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARTYN J. DAWKES and CHRISTOPHER J. HOLLOWAY

Appeal 2017-002244
Application 13/969,688
Technology Center 3600

Before JASON V. MORGAN, JOSEPH P. LENTIVECH, and SHARON FENICK, *Administrative Patent Judges*.

LENTIVECH, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellants[1] appeal from the Examiner's decision to reject claims 1, 3–8, 10–14, and 16–19. Claims 2, 9, and 15 have been canceled. *See* App. Br. 30–36 (Claims App'x). We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm.

---

[1] According to Appellants, the real party in interest is International Business Machines Corporation. App. Br. 1.

STATEMENT OF THE CASE

Appellants' Invention

Appellants' invention generally relates to architectural modeling tools and determining the progress of adoption of an on-demand capability model by an organization. Spec. 1. Claim 1, which is illustrative, reads as follows with some paragraphing and formatting added:

> 1. A method for determining the progress of adoption of an on-demand capabilities model by an organization, said method comprising:
>
> a computer processor displaying a graph that depicts parameters pertaining to a current state, a modelled state, and a target state for the organization,
>
> wherein the current state pertains to current capabilities of the organization,
>
> wherein the target state pertains to capabilities that the organization wants to possess at an end of a specified period of time, wherein the modelled state is a state of conformity by the organization to required characteristics,
>
> wherein the graph depicts the parameters for each business capability of a plurality of business capabilities, and
>
> wherein the graph comprises a three-dimensional perspective view of an alignment of a business capability of the organization with respect to an information technology (IT) capability of the organization;
>
> said processor determining a first metric equal to a numerical value associated with a degree of change required for the organization to achieve the target state for the business capability in comparison with a degree of change required across the IT capability; and
>
> said processor determining a second metric equal to a numerical value associated with a degree to which a business

> implementation of the on-demand capability lags that of the IT capability,
>
> wherein the graph comprises the first metric and the second metric;
>
> wherein the graph displays the first metric, the second metric, an ideal path in which the business capability equals the IT capability, and a projected path between the modelled state and the target state for the business capability.

Rejection[2]

Claims 1, 3–8, 10–14, and 16–19 stand rejected under 35 U.S.C. § 101 because the claimed subject matter is judicially-excepted from patent eligibility under § 101. Final Act. 16–21.

ANALYSIS

Under 35 U.S.C. § 101, a patent may be obtained for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." The Supreme Court has "long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable." *Alice Corp. v. CLS Bank Int'l*, 134 S.Ct. 2347, 2354 (2014) (quoting *Ass'n for Molecular Pathology* v. *Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). 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, 82–84 (2012), "for distinguishing patents that claim laws of nature,

---

[2] The non-statutory double patenting rejection of claims 1, 3–8, 10–14, and 16–19 has been withdrawn. Ans. 2.

natural phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts." *Alice*, 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," such as an abstract idea. The inquiry often is whether the claims are directed to "a specific means or method" for improving technology or whether they are simply directed to an abstract end-result. *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1311, 1314 (Fed. Circ. 2016). If the claims are not directed to a patent-ineligible concept, 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 the additional elements 'transform the nature of the claim' into a patent-eligible application." *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79–80, 1297). We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

The Examiner finds the claims are directed to "displaying business data as a graph and determining (business) metrics." Final Act. 16; *see also* Ans. 3–4. The Examiner finds that displaying business data as a graph and determining metrics "is a concept involving human activity relating to commercial practices" and, therefore, that the claims are directed to an abstract idea. *Id.* The Examiner further finds the claims do not include additional elements that are sufficient to amount to significantly more than

the abstract idea and, therefore, that the claims are directed to ineligible subject matter under 35 U.S.C. § 101. Final Act. 16–21; Ans. 4–11.

Appellants argue "displaying data as a graph and determining metrics do not organize any human activity, but rather perform data processing activity." App. Br. 11. Appellants further argue the claims require determining a first metric and determining a second metric and these limitations "do not organize any human activity but rather determine numerical values" and the Examiner fails to cite to any evidence demonstrating that these limitations "is one of the ***CERTAIN*** methods of organizing human activities that is an abstract idea." App. Br. 11–12.

We agree with the Examiner that the claims are directed to displaying data as a graph and determining metrics. Final Act. 16; Ans. 3–4. As acknowledged by Appellants, the claims recite limitations for performing a data processing activity and determining numerical values. App. Br. 11–12. When, as is the case here, "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. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1343 (Fed. Cir. 2016).

Turning to the second step of the analysis, Appellants argue the claims recite significantly more than the abstract idea because the limitations recited in independent claims 1, 8, and 14 "facilitate improving the technology of Information Technology (IT) with respect to the IT infrastructure." App. Br. 14.

"The abstract idea exception has been applied to prevent patenting of claims that abstractly cover results where 'it matters not by what process or machinery the result is accomplished.'" *McRO, Inc.*, 837 F.3d at 1314

(quoting *O'Reilly v. Morse*, 56 U.S. 62, 113 (1854)). "'A patent is not good for an effect, or the result of a certain process' because such patents 'would prohibit all other persons from making the same thing by any means whatsoever.'" *Id.* (quoting *Le Roy v. Tatham*, 55 U.S. 156, 175 (1853)). "We therefore look to whether the claims in these patents focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery." *Id.* (quoting *Enfish*, 822 F.3d at 1336).

Here, although the claims require use of a processor, the recited limitations do not cause the claims to be directed to something other than an abstract idea because the claims do not specify a particular means or method that improves the relevant technology. Instead the claims are directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Gottschalk v. Benson*, 409 U.S. 63, 66 (1972)); *see also Enfish*, 822 F.3d at 1336.

For example, claim 1 recites: (1) "displaying a graph that depicts parameters pertaining to a current state, a modelled state, and a target state for the organization;" (2) "determining a first metric equal to a numerical value;" and (3) "determining a second metric equal to a numerical value." Other than requiring the use of generic computer components (e.g., "a computer processor"), "it matters not by what process or machinery the result is accomplished." *McRO*, 837 F.3d at 1314. The remaining limitations merely narrows the abstract idea and do not amount to significantly more than the abstract idea because they do not restrict the "displaying," the "determining a first metric," or the "determining a second

metric" to any particular process or machinery. *See McRO*, 837 F.3d at 1314.

Appellants further argue the claims recite significantly more than the abstract idea because the limitations

> said processor determining a first metric equal to a numerical value associated with a degree of change required for the organization to achieve the target state for the business capability in comparison with a degree of change required across the IT capability; and
>
> said processor determining a second metric equal to a numerical value associated with a degree to which a business implementation of the on-demand capability lags that of the IT capability,
>
> wherein the graph comprises the first metric and the second metric,

as recited in claim 1, and similarly recited in claims 8 and 14, are not well-understood, routine, and conventional in the field of the claimed invention. App. Br. 17–18. Appellants argue that these limitations are not well-understood, routine, and conventional because similar limitations were found to be novel and non-obvious in U.S. Patent Application No. 11/257,824, to which the present application claims priority. App. Br. 18–19; *see also* Reply Br. 7–9.

To the extent Appellants argue because the claims recite novel and non-obvious subject matter the claims recite significantly more than the abstract idea, we find this argument unpersuasive. Although the second step in the *Alice/Mayo* 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*, 134 S.Ct. at 2355. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. 66 (2012). Further, Appellants do not point to, and we are unable to find, where the Specification provides any description or explanation as to how the claimed computer processor performs the claimed limitations. At best, the Specification describes the functions performed by the computer processor in carrying out the recited steps as those that were well-understood, routine, and conventional at the time of Appellants' invention. *See* Spec. 8–12; Fig. 1.

We have also carefully considered Appellants' arguments regarding preemption. App. Br. 22–28; Reply Br. 9. However, although "preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility." *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). Where claims are deemed to recite only patent ineligible subject matter under the two-step *Alice* analysis, as they are here, "preemption concerns are fully addressed and made moot." *Id.*

Because Appellants' claims 1, 3–8, 10–14, and 16–19 are directed to a patent-ineligible abstract concept, and do not recite something "significantly more" under the second prong of the *Alice* analysis, we sustain the Examiner's rejection of these claims under 35 U.S.C. § 101 as being directed to non-statutory subject matter in light of *Alice* and its progeny.

DECISION

We affirm the Examiner's rejection of claims 1, 3–8, 10–14, and 16–19 under 35 U.S.C. § 101.

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