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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GREG R. PROW, MIKKEL WILLIAM LANTZ, and
DOUGLAS WILLIAM BARON

Appeal 2017-002534
Application 12/907,436
Technology Center 3600

Before JOHN A. EVANS, LINZY T. McCARTNEY, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

McCARTNEY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from rejections of claims 1–3, 5–7, 9–11, 13–17, 19, and 20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

CLAIMED INVENTION

Claims 1, 11, and 20 are independent. Claim 1 illustrates the claimed subject matter:

1. One or more non-transitory computer storage media storing computer-useable instructions that, when executed by one or more computing devices, cause the one or more computing devices to perform a method comprising:

storing, by a change memo server, an indication of an electronic reference, the electronic reference being directed to a legal requirement or other guideline that impacts a function of an enterprise resource planning (ERP) system;

accessing, by the change memo server, a current version of the electronic reference from a content server over one or more communication networks;

identifying, by the change memo server, a change in the electronic reference by electronically comparing the current version of the electronic reference with a previous version of the electronic reference;

creating, by the change memo server, a change memo based on the identified change, the change memo comprising a record that includes the identified change;

storing, by the change memo server, the change memo in a change memo data store storing a plurality of change memos;

tracking, by the change memo server, a review status of the change memo during a review process to determine whether the identified change corresponds with a change to the legal requirement or other guideline that requires an update to the ERP system;

receiving, by the change memo server, information identifying one or more additional references confirming the identified change corresponds with a particular change to the legal requirement or other guideline that impacts the ERP system;

validating, by the change memo server, the identified change based on the information identifying the one or more additional references;

receiving, at the change memo server, an indication that the identified change corresponds with the particular change to the legal requirement or other guideline that impacts the ERP system; and

in response to receiving the indication, prompting, by the change memo server, an update to the ERP system based on the particular change to the legal requirement or other guideline that impacts the ERP system.

REJECTIONS

Claims Rejected	Basis	Reference(s)
1-3, 5-7, 9-11, 13-17, 19, 20	§ 101	
1-3, 5-7, 9-11, 13-17, 19, 20	§ 103	Kennis ¹ and Smith ²

DISCUSSION

§ 101 Rejection

Under § 101 of the Patent Act, “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. “[T]his provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014). The Supreme Court

¹ Kennis et al. (US 2006/0212486 A1; Sept. 21, 2006).

² Smith (US 6,996,601 B1; Feb. 7, 2006).

has set forth the following two-step test for determining whether a patent claim falls within one of these exceptions:

First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. If so, we then ask, “[w]hat else is there in the claims before us?” To answer that question, we consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. We have described step two of this analysis as 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 (citations omitted) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 73, 77–79 (2012)).

Applying this test, the Examiner determined claim 1 is directed to the abstract idea of “change memo management.” Relying on the Federal Circuit’s *SmartGene*³ and *Cyberfone*⁴ decisions and Appellants’ written description, the Examiner explained that claim 1 is directed to an abstract idea because the claim recites steps a person can perform mentally or using pen and paper. Ans. 5–7. The Examiner then determined that claim 1 does not recite an “inventive concept” because the recited servers are “nothing more than a generic computer” that perform certain well-understood, routine, and conventional functions. Ans. 7–9.

Appellants argue the Examiner failed to establish claim 1 is directed to an abstract idea. Br. 9. According to Appellants, the Examiner should

³ *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 F. App’x 950, 951 (Fed. Cir. 2014).

⁴ *Cyberfone Sys., LLC v. CNN Interactive Grp., Inc.*, 558 F. App’x 988, 990 (Fed. Cir. 2014).

have relied on “textbooks of computer science, economics, engineering, etc.” to show claim 1 is directed to a “fundamental building block[] of human ingenuity.” Br. 10. Appellants also contend the Examiner failed to consider claim 1 as a whole. Br. 10–14.

We find Appellants’ arguments unpersuasive. Contrary to Appellants’ arguments, the Examiner was not required to cite textbooks to establish claim 1 is directed to an abstract idea. It is sufficient—indeed, generally preferable—for an examiner to rely on court decisions for support. *See, e.g.*, Manual of Patent Examining Procedure § 2106.07(a) (explaining that “[c]iting to an appropriate court decision that supports the identification of the subject matter recited in the claim language as an abstract idea is a best practice”); *Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (“Instead of a definition, then, the 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.”). Here, as noted above, the Examiner relied on the Federal Circuit’s *SmartGene* and *Cyberfone* decisions to show claim 1 is directed to an abstract idea because the claim recites steps a person can perform mentally or using pen and paper. Ans. 5–7. The Examiner also relied on Appellants’ written description. *See* Ans. 6–7 (citing Spec. ¶¶ 35–36). Appellants have not persuasively addressed these cases or the cited paragraphs of Appellants’ written description.

As for Appellants’ argument that the Examiner failed to consider claim 1 as a whole, we see no merit in this argument. The Examiner repeatedly stated that claim 1 was considered as a whole, *see, e.g.*, Final Act.

13; Ans. 9, and nothing in the record suggests otherwise. For the above reasons, agree with the Examiner that claim 1 is directed to an abstract idea.

We turn next to the Examiner's finding that claim 1 does not recite an "inventive concept." Appellants argue the Examiner erroneously found that claim 1 recites well-understood, routine, or conventional computer functions. Br. 15. Appellants assert the recited functions "do not appear in any widely known industry references, standards, or other publications" and "do not hinge on generic computer hardware performing generic computer functions." Br. 16.

We find Appellants' arguments unpersuasive. The Examiner sufficiently supported the finding that certain claim limitations recite well-understood functions by pointing to relevant court decisions. The Examiner observed that courts have recognized receiving, accessing, and storing data are well-understood, routine, or conventional functions. *See* Ans. 8 (citing July 2015 Update: Subject Matter Eligibility 7 (July 30, 2015), <https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf>); *see also* July 2015 Update: Subject Matter Eligibility 7 nn.21, 25 (collecting cases). Based on these cases, the Examiner found claim 1's receiving, accessing, and storing steps are well-understood, routine or conventional functions. Ans. 8. The Examiner also concluded that, in light of Appellants' written description, the recited servers are generic computing devices. *See* Ans. 8–9; *see also* Spec. 38 (explaining that "[t]he invention may be practiced in a variety of system configurations, including hand-held devices, consumer electronics, *general-purpose computers*, more specialty computing devices, etc." (emphasis added)). In light of this, the Examiner's findings on these points have adequate support in the record.

Appellants also argue that claim 1 recites an inventive concept because the claim satisfies the machine prong of the machine-or-transformation test. Br. 17–18. But as Appellants acknowledge, this test requires the claimed process be tied to a *particular* machine or apparatus and impose *meaningful* limits on the claim’s scope. Br. 17; *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014) (determining a claim did not pass the machine-or-transformation test where the claim was “not tied to any particular novel machine or apparatus, only a general purpose computer”). Claim 1 does not satisfy this standard. The recited “computer storage media,” “computing devices,” and “change memo servers” and “content servers” encompass generic technology and are not tied to a particular machine or apparatus. *See, e.g.*, Spec. ¶ 38 (“The invention may be practiced in a variety of system configurations, including hand-held devices, consumer electronics, general-purpose computers, more specialty computing devices, etc.”), ¶ 40 (“Computer storage media includes, but is not limited to . . . any other medium which can be used to store the desired information and which can be accessed by computing device 100.”). This generic technology does not impose any meaningful limitation on claim 1’s scope.

Finally, Appellants contend claim 1 does not risk preempting the abstract idea itself. Br. 20. Even assuming Appellants are correct, this fact does not render claim 1 patent eligible. *See Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”). Simply limiting an abstract idea to a particular environment does not make the idea any less

abstract. *See In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016).

For the above reasons, we sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 101. Because Appellants have not presented separate, persuasive patentability arguments for the Examiner's rejection of claims 2, 3, 5–7, 9–11, 13–17, 19, and 20 on this ground, we also sustain the Examiner's rejection of these claims.

§ 103 Rejections

The Examiner rejected claim 1 as obvious over Kennis and Smith. Final Act. 14–20. Appellants argue this combination fails to teach each limitation recited in claim 1. Br. 21–24.

We find Appellants' arguments unpersuasive. Appellants' arguments generally consist of characterizing what a particular reference is “directed to” or “concerned with” and asserting that reference does not teach the limitation in question. Br. 21–24. Appellants do not mention, much less persuasively address, each section of the art cited by the Examiner. *See* Br. 21–24. This is insufficient to establish the Examiner erred. *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”). Moreover, Appellants' arguments generally address Kennis and Smith individually, despite the Examiner concluding a combination of the references teaches or suggests the subject matter recited in claim 1. “[O]ne cannot show non-obviousness by attacking references individually where, as here, the

rejections are based on combinations of references.” *In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

For the above reasons, we sustain the Examiner’s rejection of claim 1 under 35 U.S.C. § 103. Because Appellants have not presented separate arguments for claims 2, 3, 5–7, 9–11, 13–17, 19, and 20 on this ground, we also sustain the Examiner’s rejection of these claims.

CONCLUSION

Claims Rejected	Basis	Reference(s)	Affirmed	Reversed
1–3, 5–7, 9–11, 13–17, 19, 20	§ 101		1–3, 5–7, 9–11, 13–17, 19, 20	
1–3, 5–7, 9–11, 13–17, 19, 20	§ 103	Kennis and Smith	1–3, 5–7, 9–11, 13–17, 19, 20	
Summary			1–3, 5–7, 9–11, 13–17, 19, 20	

No period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED