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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ZBIGNIEW J. BOROWSKI and ROBERT A. PALO¹

Appeal 2017-003423
Application 12/204,517
Technology Center 3600

Before CAROLYN D. THOMAS, IRVIN E. BRANCH, and
JOSEPH P. LENTIVECH, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of claims 1–3, 5, 6, 8–22, and 24–28, all the pending claims in the present application. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

The present invention relates generally to a situational solution for collaborative information technology governance (*see* Spec., Abstract).

¹Appellants name International Business Machines Corporation as the real party in interest (App. Br. 2).

Claim 6 is illustrative:

6. A computer implemented method, which is executable on program code embodied in a computer readable storage medium, for collaborative governance comprising:

entering a situation using a situational environment information technology governance (SEIG) tool;

describing the situation;

choosing one or more applicable teams or subject matter experts using the SEIG tool;

communicating with the one or more applicable teams and the subject matter experts using a collaborative technology of the SEIG tool; and

authenticating, using an authentication solution provided by the SEIG tool, the one or more applicable teams and the subject matter experts before granting access to the communicating,

wherein the entering, the describing, the choosing, the communicating, and the authenticating are performed using a computer device comprising a processor and the describing includes entering at least one question into a field of an entry screen provided by the SEIG tool to facilitate the communicating with the one or more applicable teams and subject matter experts using the collaborative technology, the field describing one or more of an application contact, a situation description, major objectives, an application type, application users, a timeframe for deployment, and questions for the one or more applicable teams or subject matter experts, and

wherein the SEIG tool is a Web client and configured to provide links and interfaces to one or more tools that enable decision making processes in a situational style, and further configured to enable situational governance capabilities for an on demand enterprise, and the links are included in a landing page that provides information for users and a visual representation of the one or more applicable teams or the subject matter experts,

wherein the choosing includes selecting the one or more applicable teams from a plurality of teams via a landing page interface of the SEIG tool,

wherein the landing page interface comprises a virtual representation of the selected one or more teams using the SEIG tool and also comprises a design order identifier associated with each of

the selected one or more applicable teams of the plurality of teams,
and

wherein the design order identifier associated with each
of the selected one or more teams indicates an order in which a design
flow occurs for each of the selected one or more teams.

Appellants appeal the following rejections:

R1. Claims 1–3, 5, 6, 8–22, and 24–28 are rejected under 35 U.S.C.
§ 101 because the claimed invention is directed to non-statutory subject
matter (Final Act. 2–15);

R2. Claims 1–3, 5, 6, 8–10, 16–22, and 24–28 are rejected under
35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), second paragraph, as
being indefinite for failing to particularly point out and distinctly claim the
subject matter which the inventor or a joint inventor, or for pre-AIA the
applicant regards as the invention (Final Act. 15–23);

R3. Claims 16 and 17 are rejected under 35 U.S.C. 112(d) or
pre-AIA 35 U.S.C. 112, fourth paragraph, as being of improper dependent
form (Final Act. 23–24);

R4. Claims 1–3, 5, 6, 8–10, 16–22, and 24–28 are rejected under
35 U.S.C. § 112(a) or 35 U.S.C. 112 (pre-AIA), first paragraph, as failing to
comply with the written description requirement (Final Act. 24–31);

R5. Claims 1–3, 5, 11, 13, 15–18, 20, 21, and 24–28 are rejected
under 35 U.S.C. § 102(b) as being anticipated by Gunasekar (US) (Final
Act. 31–35);

R6. Claims 6, 8–10, 12, 14, 19, and 22 are rejected under 35 U.S.C.
§ 103(a) as being unpatentable over Gunasekar (Final Act. 36–42).

We review the appealed rejections for error based upon the issues
identified by Appellants, and in light of the arguments and evidence

produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

ANALYSIS

Rejection under § 101

Issue 1: Did the Examiner err in finding that the claims are directed to non-statutory subject matter?

Alice Corp. Pty. Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under § 101. According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

In this regard, with respect to independent method claims 6 and 18, and similarly, non-transitory computer-readable medium claims 11 and 28 and system claim 1, the Examiner finds that the claims are directed to the abstract idea of “providing for collaborative information technology governance” (Final Act. 3) and “is fundamental (foundational or basic) to the field of business, and represents a method of organizing human activities” (*id.* at 5; *see also* Ans. 4–5 “such as managing communications between people” and “some methods of organizing human activities can also be economic practices or ‘ideas.’”). The Examiner adds that the “additional claim element(s) do not provide meaningful limitations(s) to transform the abstract idea into a patent eligible application . . . amounts to reciting that the method is to applied by a generic computer, nothing more” (*id.* at 7) and

merely “reciting tools that are well understood, routine, and conventional in the field of electronic communications” (*id.*).

Appellants challenge said findings on four grounds: (a) the claimed invention does not correspond to a concept that the courts have identified as an abstract idea; (b) the claims are not similar to concepts involving a fundamental economic practice; (c) the claimed invention requires certain technology; and (d) the claims are rooted in computer technology.

Regarding argument (a), Appellants contend that “as discussed in the *July 2015 Update* . . . providing for collaborative information technology governance does not correspond to any of the enumerated categories of an idea of ‘itself’” (App. Br. 9–10) and “the alleged abstract idea is not similar to at least one concept that the courts have identified as an abstract idea” (*id.* at 10).

In response, the Examiner finds, and we agree, that “the pending claims were not [actually] discussed or analyzed in the July 2015 guidelines . . . [however] the examples given in the July guidance . . . is non-limiting and not an exhaustive list of all abstract ideas” (Ans. 3–4). The Examiner further finds that “the claimed invention is a method of organizing human activities, which is evidence by the specification itself” (Ans. 4, *citing* Spec. ¶ 2), “because it is a concept that relates to managing interpersonal and intrapersonal activities, such as managing communications between people” (*id.*).

As identified by the Examiner (*see* Ans. 5), courts have similarly determined that various methods of organizing human activity fall “squarely within the realm of ‘abstract ideas.’” *Alice*, 134 S. Ct. at 2357 (discussing methods for risk hedging and intermediated settlement as non-limiting

examples of organizing human activity). In addition, recent cases from the Federal Circuit also have “applied the ‘abstract idea’ exception to encompass inventions pertaining to methods of organizing human activity.” *In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016) (finding the claimed method of classifying and storing images in an organized manner was a well-established basic concept analogous to methods of organizing human activity); *see Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1367 (Fed. Cir. 2015) (finding the claim at issue was directed to the abstract idea of budgeting, which was “not meaningfully different from the ideas found to be abstract in other cases before the Supreme Court and our court involving methods of organizing human activity”). *See also, e.g., Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (finding claims directed to collecting data, recognizing certain data within the collected data set, and storing the recognized data drawn to an abstract idea and noting that “humans have always performed these functions”).

Thus, we find unavailing Appellants’ contention *supra* that “the alleged idea is not similar to at least one concept that the courts have identified as an abstract idea,” given the aforementioned examples.

Regarding argument (b), Appellants contend that “the claimed invention accelerates a decision making process . . . [and] is not a fundamental economic practice long prevalent in our system” (App. Br. 11).

In response, the Examiner highlights that “the [E]xaminer did not state that the claimed invention was a fundamental economic practice” (Ans. 7), instead the Examiner relied upon “organizing human activities” (*id.*). As

such, we agree with the Examiner that such an argument is “a moot point” (*id.*) because it is not directed to the Examiner’s specific findings.

Regarding argument (c), Appellants contend that “the presently claimed invention requires technology to accelerate a decision making process . . . particularly a landing pad to provide visual representations cannot be a mental process” (App. Br. 12).

In response, the Examiner finds, and we agree, that Appellants are “mixing step 2A of the analysis (identifying the abstract idea) with step 2B (significantly more analysis) . . . and [this] is not persuasive to show that the claims are not directed at an abstract idea” (Ans. 7–8). As such, we shall address this argument with our step 2B analysis below.

Regarding argument (d), Appellants contend that “the present claims, like the claims in the *DDR* case, are clearly ‘necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.’ . . . in order to accelerate the decision making process” (App. Br. 13).

In response, the Examiner finds, and we agree, that “there is not even a computer network claimed and nothing is claimed that is unconventional in nature as was the case in *DDR*” (Ans. 11).

In *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1259 (Fed. Cir. 2014), the subject claim was held patent-eligible because it encompassed “an inventive concept” for resolving a “particular Internet-centric problem.” In contrast, we find Appellants’ computer implemented method (claim 6) does not provide a solution “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” *DDR*, 773 F.3d at 1257. Because we find

all claims on appeal merely use generic computer components as tools which are used in the way such components normally function, we conclude claims 1–3, 5, 6, 8–22, and 24–28 fail to impart any discernible improvement upon computer technology, nor do Appellants’ claims solve “a challenge particular to the Internet” as considered by the court in *DDR*, 773 F.3d at 1256-57. Thus, we conclude none of Appellants’ claims are like the claim held patent-eligible by the court in *DDR*, in which the claimed invention was directed to the “challenge of retaining control over the attention of the customer in the context of the Internet,” such that:

Instead of the computer network operating in its normal, expected manner by sending the website visitor to the third-party website that appears to be connected with the clicked advertisement, the claimed system generates and directs the visitor to the above-described hybrid web page that presents product information from the third-party and visual “look and feel” elements from the host website.

DDR, 773 F.3d at 1258–59. Thus, we find unavailing Appellants’ arguments that the claims “are like the claims in the *DDR* case” (App. Br. 13), given that no convincing “inventive concept” for resolving a “particular Internet-centric problem” is identified by Appellants. Thus, we agree with the Examiner that “the reliance upon *DDR* appears to be misplaced and is not persuasive” (Ans. 11) and that “[i]n the pre computer world this issue of communication and collaboration between people in an enterprise . . . existed before computers” (*id.* at 12).

We now turn to the *second step* of the *Alice* framework: “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 (citing *Mayo Collaborative Servs.*, 132 S. Ct. at 1294).

Appellants contend that “the presently claimed invention requires technology to accelerate a decision making process . . . particularly a landing pad to provide visual representations” (App. Br. 12). Appellants also generally contend that “the claimed invention qualify as ‘significantly more’ than the alleged abstract idea” (App. Br. 16).

The Examiner finds that the claims are “reciting nothing more than using generic computing technology This is something that is well understood, routine, and conventional in the realm of computers . . . [and] is considered to be an insignificant extra solution activity” (Final Act. 8–9). The Examiner also finds that Appellants’ “argument is not persuasive because it is nothing more than a general allegation” (Ans. 13). We agree with the Examiner.

“A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Alice*, 134 S. Ct. at 2357 (brackets in original) (quoting *Mayo*, 132 S. Ct. at 1297). The prohibition against patenting an abstract idea “cannot be circumvented by attempting to limit the use of the formula to a particular technological environment or adding insignificant post-solution activity.” *Bilski v. Kappos*, 561 U.S. at 610–11 (citation and internal quotation marks omitted). The recitations in claim 1 pertaining to “a computer device” are analogous to the recitation of a conventional “computer” discussed in *Alice*.

As recognized by the Supreme Court, “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *See Alice*, 134 S. Ct. at 2359 (concluding claims “simply instruct[ing] the practitioner to implement the abstract idea of

intermediated settlement on a generic computer” not patent eligible); *see also Ultramercial*, 772 F.3d at 715–16 (claims merely reciting abstract idea of using advertising as currency as applied to particular technological environment of the Internet not patent eligible); *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (claims reciting “generalized software components arranged to implement an abstract concept [of generating insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer” not patent eligible); and *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) (“[s]imply adding a ‘computer aided’ limitation to a claim covering an abstract concept, without more, is insufficient to render [a] claim patent eligible” (internal citation omitted)).

Limiting such an abstract concept of “providing for collaborative information technology governance” to generic components, such as a computing device, does not make the abstract concept patent-eligible under 35 U.S.C. § 101. Furthermore, Appellants are reminded that “relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.” *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (citing *Alice*, 134 S. Ct. at 2359 (“use of a computer to create electronic records, track multiple transactions, and issue simultaneous instructions” is not an inventive concept)).

Because Appellants’ claims 1, 11, 14, 15 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 as well as respective dependent claims 2, 4, 12, 13,

and 16–19 under 35 U.S.C. § 101 as being directed to non-statutory subject matter in light of *Alice* and its progeny.

Rejection under § 112, second paragraph

Issue 2: Did the Examiner err in finding that the claims are indefinite?

First, the Examiner finds that “the scope of the claimed processes [are] not known and appear[] to be unduly broad . . . It is not clear what is required to be considered infringing the claimed processes” (Final Act. 15–16).

As pointed out by Appellants, and we agree, the breadth of a claim is not to be equated with indefiniteness (*see* App. Br. 48). *In re Miller*, 441 F.2d 689, 693 (CCPA 1971).

Accordingly, we believe that the Examiner concern about the “unduly broad” claims is misplaced because the Examiner has improperly equated breadth with indefiniteness. It is well established that “breadth is not indefiniteness.” *In re Gardner*, 427 F.2d 786, 788 (CCPA 1970).

Second, the Examiner finds that, for **claim 1**, the “claim language is indefinite and it is not clear as to what statutory class of invention the claim is directed to . . . [because claim 1] is reciting structure to a device and a method of using the device in the same claim” (Final Act. 16).

Appellants contend that “one of ordinary skill in the art would understand that claim 1 is directed to a system claim” (App. Br. 49). We are not persuaded by Appellants’ arguments at least because they fail to address the Examiner’s actual rejection. The Examiner’s position is that a single claim which claims both a system (machine) and the method steps of using

the system (process) is indefinite under 35 U.S.C. § 112, second paragraph. *See In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303 (Fed. Cir. 2011). In *Katz*, a claim directed to “a system with an interface means for providing automated voice messages . . . to certain of said individual callers, *wherein said certain of said individual callers digitally enter data*” was determined to be indefinite because the italicized claim limitation is not directed to the system, but rather to actions of the individual callers, which creates confusion as to when direct infringement occurs. *Katz*, 639 F.3d at 1318 (emphasis added) (citing *IPXL Holdings v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005), in which a system claim that recited “an input means” and required a user to use the input means was found to be indefinite because it was unclear “whether infringement . . . occurs when one creates a system that allows the user [to use the input means], or whether infringement occurs when the user actually uses the input means.”).

Here, there is no dispute that the preamble of claim 1 is directed to a system (*see* Appeal Br. 49), but claim 1 also recites, *inter alia*, *the selection process includes receiving a selection of one or more teams from a plurality of teams via a landing page interface of the SEIG tool* (*see* claim 1).

In addition to claiming a system, by requiring manual selection of a team or action from a user via a human machine interface device, claim 1 also invokes the method of using the system, which creates confusion as to when direct infringement occurs. In other words, it is unclear whether claim 1 requires only a system that allows the user to use the landing page interface or instead requires that the user actually use the interface. Because claim 1 recites both a system and the method for using the system, it does

not apprise one of ordinary skill in the art of its scope, therefore, rendering it indefinite.

Accordingly, we sustain the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, because a single claim which claims both a system and the method of using the system is indefinite, as well as sustain the rejection of dependent claims 3, 5, 21, 24–28 for similar reasons.

Third, regarding **claim 2**, the Examiner finds that “[system] claim 2 appears to be reciting nothing but a method step of performing an action, as if the claims were method claims” (Final Act. 18). We agree with the Examiner.

Although Appellants contend that “one of ordinary skill in the art would understand that the SEIG tool is configured to perform a plurality of processes including an entry process” (App. Br. 49), again Appellants’ arguments fail to address the Examiner’s actual rejection, i.e., a single claim which claims both a system and the method of using the system as being indefinite. As such, we find that claim 2 recites both a system and the method for using the system, which does not apprise one of ordinary skill in the art of its scope, therefore, rendering it indefinite.

Fourth, also regarding claim 2,² the Examiner finds that “[i]t is not clear how the entry process can be done using the wiki, white board, and blog at the same time . . . [which] does not appear to be consistent with the original disclosure” (Final Act. 18). In response, Appellants insist that claim 5 is being rejected and argue the same (*see* App. Br. 49), instead of arguing

² Here, the Examiner cites claim 3, instead of claim 2, for this rejection. However, claim 2 includes the claim limitations highlighted by the Examiner, not claim 3. Therefore, we shall treat this as a rejection regarding claim 2.

claim 2 and the relevant “entry process” limitation. As such, we find Appellants’ argument unresponsive to the specific findings presented by the Examiner. If an appellant fails to present arguments on a particular issue – or, more broadly, on a particular rejection – the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection. *Id.* (citing, *inter alia*, *Hyatt v. Dudas*, 551 F.3d 1307, 1313–14 (Fed. Cir. 2008) (the Board may treat arguments appellant failed to make for a given ground of rejection as waived)).

Accordingly, we sustain the rejection of claim 2 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Fifth, regarding claim 6, the Examiner finds that “[i]t is not clear what kinds of tools are those that enable decision making processes in a situational style” (Ans. 19) (emphasis omitted). In response, Appellants direct our attention to paragraphs 19, 30, 32, 61, and 68 in their Specification and contend that “one of ordinary skill in the art would understand that providing the links and interfaces enable decision making processes” (App. Br. 50). We agree with Appellants.

For example, Appellants’ Specification notes that a tool may be implemented as a Web client that facilitate decision making processes by allowing users to communicate across an enterprise (*see* Spec. ¶ 30). The test for definiteness under 35 U.S.C. § 112, second paragraph is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc., v. Safety Travel Chairs*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)(citations omitted). Here, we find that Appellants’ disclosure allows those skilled in the art to understand what is being claimed.

Accordingly, we reverse the rejection of claim 6 under 35 U.S.C. § 112, second paragraph, as being indefinite, as well as claims 8–10, which are dependent thereon.

Sixth, regarding claims 16 and 17, the Examiner finds that “it is not clear what is required to infringe the claim. . . . [because] is it also required that one must have a service provider perform one of the ‘supported, deployed, maintained, and created’ steps” (Final Act. 20), i.e., the step a human being is going to undertake for the computer program product itself. In response, Appellants contend that “claims 16 and 17 are not reciting acts performed by people . . . a service provider is different from a person” (App. Br. 51).

Even if we accept Appellants’ argument that the service provider is different from a person, we find that Appellants fail to address the Examiner’s actual rejection. i.e., that a single claim which claims both a computer program product and the step of a service provider performing steps is indefinite under 35 U.S.C. § 112, second paragraph. *Katz*, 639 F.3d at 1303. For example, claims 16 and 17 include some limitations not directed to the product itself, but rather to actions of the service provider, which creates confusion as to when direct infringement occurs. *Katz*, 639 F.3d at 1318 (citing *IPXL Holdings*, 430 F.3d at 1384, in which a system claim that recited “an input means” and required a user to use the input means was found to be indefinite because it was unclear “whether infringement . . . occurs when one creates a system that allows the user [to use the input means], or whether infringement occurs when the user actually uses the input means.”).

Here, there is no dispute that the preamble of claims 16 and 17 are directed to a computer program product (*see* Claims Appendix), but claim 16 also recites, *inter alia*, *at least one of supported, deployed, maintained, and created by a service provider* (*see* claim 16). Claim 17 includes similar limitations.

Because claims 16 and 17 recite both a computer program product and a service provider for performing actions, we agree with the Examiner that claims 16 and 17 do not apprise one of ordinary skill in the art of its scope, therefore, rendering it indefinite.

Accordingly, we affirm the rejection of claims 16 and 17 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Seventh, regarding claim 18, the Examiner finds that “[t]he body of the claim refers to the application as being ‘deployed’ but the claim is supposed to be directed at the method of deploying the application . . . claim language is contradictory” (Final Act. 21), also “it is not clear what the ‘steps’ are that are being claimed . . . [because claim 18 is] not reciting anything about the steps themselves” (*id.* at 21–22). We agree with the Examiner.

Although Appellants contend that “the body of the claim is directed to a computer device having a processor in order to perform the steps of . . .” (App. Br. 51), we highlight that claim 18 recites “in order to perform a plurality of steps to:” not “in order to perform the steps of,” as proffered by Appellants.

In other words, we agree with the Examiner that claim 18, as written, fails to give any information about the steps themselves, but rather describes

what the unknown steps achieve, i.e., the end result of the steps (*see* Ans. 22).

Accordingly, we affirm the rejection of claim 18 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Eighth, regarding claim 19, the Examiner finds that “[i]t is not clear what this claim language is requiring in terms of the SEIG tool[, i.e.,] [w]hat structure is defined . . . or specific processes” (Final Act. 22). In response, Appellants contend that “the SEIG tool is used to supplement existing corporate processes . . . by integrating with tools that support existing processes” (App. Br. 52, *citing* Spec. 31). We agree with Appellants.

We find that Appellants have sufficiently shown that the specification describes “supplement” as “integrating” with existing processes, thus describing a specific process for the SEIG tool.

Accordingly, we reverse the rejection of claim 19 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Ninth, regarding claim 22, the Examiner finds that “there is no antecedent basis for ‘*the status indicator having first and second states*’” (Final Act. 22). In response, Appellants merely contend that “claim 22 has proper antecedent basis” (App. Br. 52), without providing any evidence of the same.

Given that Appellants have not shown, nor can we find, any antecedent basis for the claimed “status indicator,” we affirm the rejection of claim 22 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Tenth, regarding claim 26, the Examiner finds that “claim 26 is inconsistent with the original disclosure . . . [is] the submission button [] used to view the situation” or submit their situation (Final Act. 23). In

response, Appellants contend that “in the exemplary embodiments, paragraph [0071] . . . the [submission button 820] allows the submitted request to be viewable to users” (App. Br. 52). We agree with Appellants.

For example, Appellants’ Specification in paragraph 71 states that “[o]nce the situation review request is entered, it can be submitted . . . as submission button 820 [and] [t]his allows the submitted request to be viewable to users” (§ 71). Thus, Appellants’ specification clearly spells out that the claimed submission button acts to both submit requests and view the same.

Accordingly, we reverse the rejection of claim 26 under 35 U.S.C. § 112, second paragraph, as being indefinite, and dependent claim 27 for similar reasons.

*Rejection under § 112, fourth paragraph
Claims 16 and 17*

Issue 3: Did the Examiner err in finding that the claims are in improper dependent form?

The Examiner finds that “Claim 16 is not further limiting the computer program product of claim 11, but is reciting acts performed by a service provider (people) that uses or act upon the computer program product of claim 11” (Final Act. 23). We agree with the Examiner.

In response, Appellants merely point out what the claims recites (*see* App. Br. 53) and reiterate the arguments made *supra* regarding the § 112, second paragraph rejection (*id.* at 54), which we found unpersuasive, and are irrelevant here.

A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See*

C.F.R. § 41.37(c)(1)(vii). Here, Appellants fail to persuasively show how the limitations of claims 16 and 17 further limit the computer program product itself.

Accordingly, we affirm the rejection of claims 16 and 17 under 35 U.S.C. § 112, fourth paragraph.

*Rejection under § 112, first paragraph
Claims 1–3, 5, 6, 8–22, and 24–28*

Issue 4: Did the Examiner err in finding that specific features/functions are genus with no support in the specification as originally filed for any species that fall within the genus?

First, regarding claim 26, the Examiner finds that “the specification does not disclose [a submission button] as being used to view a situation . . . [therefore,] claim 26 is considered to contain new matter” (Final Act. 26). We disagree with the Examiner for similar reasons presented *supra* regarding the § 112, second paragraph rejection of claim 26.

Second, regarding claims 1, 6, 11, 18, and 28, the Examiner finds that “the claim language of ‘*wherein the selection process includes . . . via a landing page interface of the SEIG tool*’ . . . is found to be new matter . . . [because in the original specification] a selection occurred in a general and generic sense” (Final Act. 26–27). In response, Appellants contend that “paragraph [0058] . . . discloses that a user can identify and select applicable teams 420 *in a landing page 400*” (App. Br. 56) (emphasis added).

Upon reviewing Appellants’ paragraph [58], we were unable to find the exact language quoted by Appellants. Instead, paragraph [58] merely states “[t]he SEIG Tool allows a user to identify and select applicable teams 420 in which the user can collaborate with and seek advice from” (§ 58).

What is missing is any reference to using a “landing page interface” to make this selection. Thus, we agree with the Examiner that such selection is disclosed generally and in a generic sense using the SEIG Tool.

Third, regarding claims 1, 6, 11, 18, and 28, the Examiner further finds that “it is noted that nothing is explained about how the authentication is occurring” (Final Act. 28) in that “[t]he claim is reciting a genus in the form of any and all manner of authentication . . . including those that are not yet created” (*id.* at 29). Additionally, the Examiner further finds that “nothing at all is disclosed in the specification that is setting forth how the claimed ‘communication process’ works” (Final Act. 29) in that the “claimed tools all represent a genus that is reciting any and all social tagging tools” (*id.* at 30). The Examiner also finds that “with respect to the claimed ‘selection process’ . . . this is not disclosed in the specification to any extent that would reasonably convey possession . . . it is the user that is making the selection, not a computing device” (Final Act. 27).

Regarding authentication, Appellants contend that “the specification does not disclose authentication tools which are not yet created. . . . the specified species of the authentication tools would be custom or existing tools at the filing data of the claimed invention” (App. Br. 57).

We are not persuaded the Examiner erred in asserting that independent claims 1, 6, 11, 18, and 28 recite aspects that fail to comply with the written description requirement. Specifically, we conclude that because the functional claim language “using an authentication solution” recited in each of the independent claims, is a genus, and the Specification does not disclose sufficient species to support the genus, the recited functional claim language does not have sufficient written description

support to satisfy 35 U.S.C. § 112, first paragraph. Appellants' Specification specifically states that the authentication may "comprise any number of authentication solutions known to those in the art" (§ 63), not known at the filing date, as proffered by Appellants.

In essence, Appellants assert that the aforementioned functional claim language has literal support in the Specification at paragraphs [51], [63], and [64] (App. Br. 57). However, the fact that the Specification literally repeats the functional claim language *in ipsius verbis* is not dispositive. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1350 (Fed. Cir. 2010) (en banc); *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002).

Given the identified support in the written description, we next must determine whether the scope of the functional claim language is a genus that covers all species for performing the claimed function. *Ariad*, 598 F.3d at 1349. Factors to consider include (a) whether the claim itself recites limitations as to how the function is performed; and (b) whether the Specification identifies a way of performing the claimed function, such as a specific type of microcomputer or an algorithm, that defines the scope of the functional claim language, without importing limitations from the Specification into the claim. *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1343–46 (Fed. Cir. 2005); *In re Hayes Microcomputer Prods., Inc. Patent Litigation*, 982 F.2d 1527, 1534 (Fed. Cir. 1992). To that end, we note that independent claim 1 does not recite how the function is performed. Accordingly, we find that the scope of "using authentication solutions" is a genus that covers all species for performing the claimed authentication function. And as the Specification does not disclose any

species for “authenticating,” independent claims 1, 6, 11, 18, and 28 fail to meet the written description requirement of 35 U.S.C. § 112, first paragraph. *LizardTech*, 424 F.3d at 1346 (“[T]he description of one method for creating a seamless DWT does not entitle the inventor . . . to claim any and all means for achieving that objective”); *Ariad*, 598 F.3d at 1349 (“the specification must demonstrate that the applicant has made a generic invention that achieves the claimed result and do so by showing that the applicant has invented species sufficient to support a claim to the functionally-defined genus”). Similarly, we also find that the claimed “communication process” and the “selection process” have not been associated with species sufficient to support a claim to the functionally-defined genus, for the reasons set forth by the Examiner (*see* Ans. 27–30).

Fourth, regarding claims 16 and 20, the Examiner find that “nothing is disclosed about how the service provider performs the acts . . . All of these functions are a genus” (Final Act. 31). In response, Appellants direct our attention to paragraphs [28] and [38] of the Specification and contend that the Specification shows possession of the claimed invention (*see* App. Br. 58).

We find that Appellants’ broad response fails to specifically address the species/genus aspect of the Examiner’s rejection. If an appellant fails to present arguments on a particular issue – or, more broadly, on a particular rejection – the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection. *Id.* (citing, *inter alia*, *Hyatt v. Dudas*, 551 F.3d 1307, 1313–14 (Fed. Cir. 2008) (the Board may treat arguments appellant failed to make for a given ground of rejection as waived)).

Accordingly, we affirm the rejection of claims 1–3, 5, 6, 8–22, and 24–28 under 35 U.S.C. § 112, first paragraph. Here, the Examiner has presented multiple basis for rejecting the claims and because at least one rejection encompassing all claims is affirmed, the decision of the Examiner is affirmed.

Rejection under § 102(b)
Claims 1, 3, 11, 13, 15–18, 20, 21, and 24–28

Issue 5: Did the Examiner err in finding that the claims recite non-functional descriptive material?

Appellants contend that Gunasekar does not disclose the claimed design order identifier and that claimed “design order identifier . . . are not printed matter [because] [o]ne of ordinary skill in the art would understand that [t]he landing page interface comprises a virtual representation of the selected one or more teams . . . [and] indicates an order in which a design flow occurs” (App. Br. 60), thus it “performs the function of indicating the order” (*id.*).

In response, the Examiner finds that Appellants are “arguing data makes the claim patentable by virtue of being on the landing page interface[, however,] [t]his is non-functional descriptive material that can be considered to be akin to printed matter” (Ans. 34). We agree with the Examiner.

We refer to, rely on, and adopt the Examiner’s findings and conclusions set forth in the Answer. Our discussions here will be limited to the following points of emphasis.

Non-functional descriptive material refers to data content that does not exhibit a functional interrelationship with the substrate and does not

affect the way the computing processes are performed. *See* MPEP § 2106.01. *See Ex parte Nehls*, 88 USPQ2d 1883, 1887-1888 (BPAI 2008) (precedential). *See also In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004) (stating that “[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability”; finding no functional relationship where the printed matter in no way depends on the substrate and the substrate in no way depends on the printed matter; and holding claimed subject matter anticipated where such printed matter was the only difference between the claimed subject matter and the prior art).

Further, the Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1582-1583 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d at 1339 (nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious). *See also Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (nonprecedential), *aff'd*, 191 Fed.Appx. 959 (Fed. Cir. 2006).

Here, claim 1 recites, *inter alia*, “a design order identifier associated with each of the selected one or more teams of the plurality of teams, and wherein the design order identifier . . . indicates an order in which a design flow occurs” (*see* claim 1). Independent claims 11, 18, and 28 recite similar limitations. However, claim 1, as written, fails to recite executing any design flow. Instead, claim 1 merely indicates/lists an order of a design flow that is not actually being performed.

As such, we agree with the Examiner that claim 1’s *design order identifier* merely recites non-functional descriptive material, amounting to

printed matter that need not be given patentable weight. Thus, we find unavailing Appellants' contention that the claimed design order identifier "performs the function of indicating the order" (*see* App. Br. 60), given that the claimed "indicates an order" merely *reads on* viewing/describing the order as opposed to a functional manipulation of the order, i.e., actually performing the design flow order.

Accordingly, we affirm the Examiner's rejection of claims 1, 3, 11, 13, 15–18, 20, 21, and 24–28 under 35 U.S.C. 102(b) as being anticipated by Gunasekar.

Claim 2

Appellants contend that although "Gunasekar disclose[s] using a collaborative whiteboard . . . Gunasekar does not disclose that the entry process includes entering a situation into the SEIG tool using a wiki and a blog" also (App. Br. 64).

In response, the Examiner finds "claim [2] to be satisfied by the whiteboard of Gunasekar, as all three of the wiki, whiteboard, and blog cannot and are not disclosed as being used at the same time to perform the entry process" (Ans. 36).

In essence, the Examiner interprets claim 2 as requiring entering a situation into the SEIG using *either* a wiki, a white board, or a blog, whereas Appellants appear to interpret claim 2 as requiring using all three components. We agree with Appellants.

Although the Examiner emphasizes that all three components "cannot be used at the same time," which we agree, we highlight that claim 2 does not recite *at the same time*, as proffered by the Examiner. We interpret the

claim as merely having an entry process that is *capable of* using each of a wiki, a white board, and a blog, albeit not at the same time.

Given that the Examiner has not shown that Gunasekar is capable of using each of the wiki, a white board, and a blog, we reverse the Examiner's rejection of claim 2 under 35 U.S.C. 102(b) as being anticipated by Gunasekar.

Claim 5

Appellants contend that while Gunasekar discloses video conferencing, instant messaging, and online communication session (*see* App. Br. 65), "Gunasekar does not disclose wikis" (*id.*).

The Examiner finds that "[b]roadly claiming a wiki is claiming a website, which is disclosed by Gunasekar at paragraphs 034–037 . . . This satisfies the broad term of claiming a 'wiki'" (Ans. 37).

In response to the Answer's findings, Appellants contend that "even *assuming arguendo* that Gunasekar disclose a website, one of ordinary skill in the art would understand that a general website is different from wikis" (Reply Br. 52). We agree with Appellants.

The usual and ordinary meaning of "wiki" is "web pages where all users can add content and edit the content of others." *Dictionary of Computer and Internet Terms*, p. 560 (9th Edition 2006). As such, we agree with Appellants that the Examiner's proffered general website fails to meet this definition.

Accordingly, we reverse the Examiner's rejection of claim 5 under 35 U.S.C. § 102(b) as being anticipated by Gunasekar.

*Rejection under § 103(a)
Claims 6, 8–10, 19, and 22*

Because Appellants have not presented separate patentability arguments or have reiterated substantially the same arguments as those previously discussed for patentability of claim 1 above (*see* App. Br. 66–70), which we find unpersuasive, we are not persuaded the Examiner erred in rejecting claims 6, 8–10, 19, and 22 for the reasons discussed *supra*.

Accordingly, the rejection of claims 6, 8–10, 19, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Gunasekar is affirmed.

Claim 12

Because Appellants have reiterated substantially the same arguments as those previously discussed for patentability of claim 5 above (*see* App. Br. 69), which we find persuasive, we are persuaded the Examiner erred in rejecting claim 12 for the same/similar reasons discussed *supra*.

Accordingly, the rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Gunasekar is reversed.

Claim 14

Because Appellants have reiterated substantially the same arguments as those previously discussed for patentability of claim 2 above (*see* App. Br. 69–70), which we find persuasive, we are persuaded the Examiner erred in rejecting claim 12 for the same/similar reasons discussed *supra*, as the Examiner has not shown that all features are suggested in Gunasekar.

Accordingly, the rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Gunasekar is reversed.

DECISION

We affirm the Examiner's rejection of claims 1–3, 5, 6, 8–22, and 24–28 under 35 U.S.C. § 101.

We affirm the Examiner's § 112, second paragraph, rejection of claims 1–3, 5, 16–18, 20–22, and 24–28.

We reverse the Examiner's § 112, second paragraph, rejection of claims 6, 8–10, and 19.

We affirm the Examiner's § 112, fourth paragraph, rejection of claims 16 and 17.

We affirm the Examiner's § 112, first paragraph, rejection of claims 1–3, 5, 6, 8–10, 16–22, and 24–28.

We affirm the Examiner's § 102(b) rejection of claims 1, 3, 11, 13, 15–18, 20, 21, and 24–28.

We reverse the Examiner's § 102(b) rejection of claims 2 and 5.

We affirm the Examiner's § 103(a) rejection of claims 6, 8–10, 19, and 22.

We reverse the Examiner's § 103(a) rejection of claims 12 and 14.

Because at least one rejection encompassing each claim on appeal is affirmed, the decision of the Examiner 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).

AFFIRMED