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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/490,927	06/07/2012	Russell ZUMWALT	2011-0162US01	6549
74739	7590	03/20/2019	EXAMINER	
Potomac Law Group, PLLC (Oracle International) 8229 Boone Boulevard Suite 430 Vienna, VA 22182			SCHEUNEMANN, RICHARD N	
			ART UNIT	PAPER NUMBER
			3624	
			NOTIFICATION DATE	DELIVERY MODE
			03/20/2019	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RUSSELL ZUMWALT and NICOLE DALESSIO

Appeal 2017-003432
Application 13/490,927¹
Technology Center 3600

Before J. JOHN LEE, CYNTHIA L. MURPHY, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1, 2, 4–8, 10–14, 16–20, 25, and 26. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ The Appellants identify Oracle International Corporation as the real party in interest. Appeal Br. 3.

ILLUSTRATIVE CLAIM

1. A non-transitory computer readable medium having instructions stored thereon that, when executed by a processor, cause the processor to update a project management system, the updating comprising:

storing project management data for a plurality of projects in a database coupled to a server coupled to a network;

receiving, at the server, a request for a list of assigned tasks to a user, from a user computer coupled to the network, the request comprising a first email from an email address of the user, a subject line of the first email including an assigned task status, a time period and a time period value, the assigned task status indicating whether a task assigned to the user is active, due, overdue, completed, or starting, and the time period indicating whether the time period value precedes the date of the email for an active, overdue, or completed assigned task status, or succeeds the date of the email for an active, due, or starting assigned task status;

in response to the request,

applying a filter to the database to determine the list of assigned tasks to the user based on the assigned task status, the time period and the time period value, each task in the list of assigned tasks being associated with a project,

creating a second email including the list of assigned tasks to the user, a body of the second email including at least one project section, each project section including a project name and at least one task from the list of assigned tasks, each task including at least one of a start date value, a finish date value, a finished status value or an activity percent completed value, and

sending, from the server to the user email address, the second email;

receiving, at the server, a third email from the user email address, a body of the third email including at least one updated project section including at least one updated task, each updated

task including at least one updated start date value, finish date value, finished status value or activity percent completed value;

 parsing the third email body to retrieve the updated values in each updated task in each updated project section;

 applying the updated values from each updated task to each associated project stored in the database;

 creating an acknowledgement email based on the updated values applied to each associated project stored in the database, a body of the acknowledgement email including at least one updated project section, each updated project section including the project name and at least one updated task, each updated task including at least one updated start date value, finish date value, finished status value or activity percent completed value; and

 sending, from the server to the user email address, the acknowledgement email.

REJECTION²

Claims 1, 2, 4–8, 10–14, 16–20, 25, and 26 are rejected under 35 U.S.C. § 101 as ineligible subject matter.³

FINDINGS OF FACT

The findings of fact relied upon, which are supported by a preponderance of the evidence, appear in the following Analysis.

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.”

² The Final Office Action (pages 7–35) also included rejections under 35 U.S.C. §§ 103 and 112. These rejections are withdrawn. Answer 2–3.

³ The identified rejected claims reflect the changes in Appellants’ Amendment After Final Action (dated March 11, 2016), which the Examiner has entered, per the Advisory Action (dated April 13, 2016).

35 U.S.C. § 101. Yet, subject matter belonging to any of the statutory categories may, nevertheless, be ineligible for patenting. The Supreme Court has interpreted § 101 to exclude laws of nature, natural phenomena, and abstract ideas, because they are regarded as the basic tools of scientific and technological work, such that including them within the domain of patent protection would risk inhibiting future innovation premised upon them. *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013).

Of course, “[a]t some level, ‘all inventions . . . embody, use, reflect, rest upon, or apply’” these basic tools of scientific and technological work. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014) (internal citation omitted). Accordingly, evaluating ineligible subject matter, under these judicial exclusions, involves a two-step framework for “distinguish[ing] between patents that claim the buildin[g] block[s] of human ingenuity and those that integrate the building blocks into something more, thereby transform[ing] them into a patent-eligible invention.” *Id.* (internal quotation marks and citation omitted). The first step determines whether the claim is directed to judicially excluded subject matter (such as a so-called “abstract idea”); the second step determines whether there are any “additional elements” recited in the claim that (either individually or as an “ordered combination”) amount to “significantly more” than the identified judicially excepted subject matter itself. *Id.* at 217–18.

The USPTO recently published revised guidance on the application of § 101, in accordance with judicial precedent. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50, 52 (Jan. 7, 2019) (“*2019 Revised Guidance*”). Under the *2019 Revised Guidance*, a claim is “directed

to” an abstract idea, only if the claim recites any of (1) mathematical concepts, (2) certain methods of organizing human activity, and (3) mental processes — without integrating such abstract idea into a “practical application,” i.e., without “apply[ing], rely[ing] on, or us[ing] the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *Id.* at 52–55. A claim so “directed to” an abstract idea constitutes ineligible subject matter, unless it recites an additional element (or combination of elements) amounting to significantly more than the abstract idea. *Id.* at 56.

With regard to the first step of the *Alice* framework, the Examiner states that “the claims are directed to updating a project management system,” which the Examiner regards as an abstract idea, because it is among “certain methods of organizing human activity, such as processing loan information, [that] are ineligible abstract ideas.” Final Action 6. Further, the Examiner states that the claimed subject matter “could be executed mentally or on paper.” Answer 4. As to the second step of the *Alice* framework, the Examiner states that the claims do not include additional elements amounting to significantly more than the identified abstract idea. Final Action 6–7, Answer 5–6.

Notwithstanding the propriety of the Examiner’s determination as to whether the claims are directed to the identified abstract idea, we agree with the Appellants’ argument that the Examiner fails to show adequately that the additional elements would not amount to significantly more than the abstract idea. *See* Appeal Br. 11–15, Reply Br. 4–5.

The inquiry into whether additional claim elements — i.e., claim elements other than those that describe any judicial exception to which a claim might be directed — amount to significantly more than the judicial exception itself considers whether the claim limitations “involve more than performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347–48 (Fed. Cir. 2014) (quoting *Alice*, 573 U.S. at 225). Further, this step “requires more than recognizing that each claim element, by itself, was known in the art,” because “an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.” *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016). Notably, “[w]hether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018).

Although the Examiner states that the claims call for additional elements that, individually, “perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry” (Final Action 7), the Examiner has not sufficiently supported a determination that the claimed ordered combination of these additional elements fails to constitute significantly more than the abstract idea itself (*see* Answer 5–6).

With regard to the second step of the *Alice* framework (Step 2B in the parlance of the *2019 Revised Guidance*), the Final Office Action refers to the following particular “limitations of exemplary claim 1”:

“storing project management data,” “receiving a request for a list,” “applying a filter to the database,” “creating a second email,” “sending . . . the second email,” “receiving . . . a third email,” “parsing the third email body,” “applying the update[d] values,” “creating an acknowledgement email,” and “sending . . . the acknowledgment email[,]”

and states that “[t]hese limitations are steps for creating a list of tasks and communicating the tasks that do not add significantly more than the abstract idea of updating a project management system.” Final Action 6–7.

The Appellants argue that the Examiner “has failed to consider the combination of these additional elements” and quote the USPTO’s Guidance Memorandum of May 4, 2016 (*May 2016 Guidance*), which states:

It is important to remember that a new combination of steps in a process may be patent eligible even though all the steps of the combination were individually well known and in common use before the combination was made ([*Diamond v. Diehr*, 450 U.S. 175 (1981)]). Thus, it is particularly critical to address the combination of additional elements, because while individually-viewed elements may not appear to add significantly more, those additional elements when viewed in combination may amount to significantly more than the exception by meaningfully limiting the judicial exception.

Appeal Br. 13–14 (quoting *May 2016 Guidance* at 3).

In response, the Examiner’s Answer states: “Although the Appellant contends that the limitations, when taken together, meaningfully limit the alleged abstract idea, the idea is still abstract.” Answer 6. Yet, in the second step of the *Alice* framework, the proper inquiry does not ask whether “the [abstract] idea is still abstract,” as the Examiner states (*id.*); indeed, such an assertion would be established by the first step of the *Alice* framework. Rather, the inquiry of the second *Alice* step focuses on whether any additional claim elements — considered individually and in combination —

constitute more than well-understood, routine, and conventional features.

See Content Extraction, 776 F.3d at 1347–48. Critically, the USPTO Guidance dated April 19, 2018 (*April 2018 Guidance*) addresses the requisite factual determinations for such a rejection, explaining that

an additional element (or combination of elements) is not well-understood, routine or conventional unless the examiner finds, and expressly supports a rejection in writing with, one or more of the following:

1. A citation to an express statement in the specification or to a statement made by an applicant during prosecution that demonstrates the well-understood, routine, conventional nature of the additional element(s). A specification demonstrates the well-understood, routine, conventional nature of additional elements when it describes the additional elements as well-understood or routine or conventional (or an equivalent term), as a commercially available product, or in a manner that indicates that the additional elements are sufficiently well-known that the specification does not need to describe the particulars of such additional elements to satisfy 35 U.S.C. § 112(a). A finding that an element is well-understood, routine, or conventional cannot be based only on the fact that the specification is silent with respect to describing such element.
2. A citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s).
3. A citation to a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s). An appropriate publication could include a book, manual, review article, or other source that describes the state of the art and discusses what is well-known and in common use in the relevant industry. It does not include all items that might otherwise qualify as a “printed publication” as used in 35 U.S.C. § 102. Whether something is disclosed in a document that is

considered a “printed publication” under 35 U.S.C. § 102 is a distinct inquiry from whether something is well-known, routine, conventional activity. A document may be a printed publication but still fail to establish that something it describes is well-understood, routine, conventional activity. . . . The nature of the publication and the description of the additional elements in the publication would need to demonstrate that the additional elements are widely prevalent or in common use in the relevant field, comparable to the types of activity or elements that are so well-known that they do not need to be described in detail in a patent application to satisfy 35 U.S.C. § 112(a). For example, while U.S. patents and published applications are publications, merely finding the additional element in a single patent or published application would not be sufficient to demonstrate that the additional element is well-understood, routine, conventional, unless the patent or published application demonstrates that the additional element are widely prevalent or in common use in the relevant field.

4. A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s). This option should be used **only** when the examiner is certain, based upon his or her personal knowledge, that the additional element(s) represents well-understood, routine, conventional activity engaged in by those in the relevant art, in that the additional elements are widely prevalent or in common use in the relevant field, comparable to the types of activity or elements that are so well-known that they do not need to be described in detail in a patent application to satisfy 35 U.S.C. § 112(a). Procedures for taking official notice and addressing an applicant’s challenge to official notice are discussed in MPEP § 2144.03.

April 2018 Guidance at 3–4 (footnote omitted). In the present Appeal, the rejection lacks sufficiently supported findings, and thus is unable to satisfy the above-identified portion of the *April 2018 Guidance*. A sustainable

rejection must demonstrate that the identified ordered combination of additional claim elements (*see* Final Action 6) — being considered in the second *Alice* step — exists in one or more of the enumerated evidentiary sources (*see April 2018 Guidance* at 3–4) in order to establish such combination as well-understood, routine or conventional. For example, an adequately supported rejection should consider whether the combination of claim 1’s recited “applying a filter to the database,” “creating a second email,” “parsing the third email body,” “applying the updated values from each updated task to each associated project stored in the database,” and “creating an acknowledgement email based on the updated values applied to each associated project stored in the database” together are, as a factual matter, well-understood, routine or conventional.

Accordingly, we are persuaded that the Examiner has not adequately established that the claims on appeal would not survive the second step of the *Alice* framework. Therefore, we do not sustain the rejection of claims 1, 2, 4–8, 10–14, 16–20, 25, and 26 under 35 U.S.C. § 101.

DECISION

We REVERSE the Examiner’s decision rejecting claims 1, 2, 4–8, 10–14, 16–20, 25, and 26 under 35 U.S.C. § 101.

REVERSED