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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MILTON H. HERNANDEZ, HANI T. JAMJOOM,  
ARJUN NATARAJAN, THIRUMAL R. NELLUTLA,  
SREERAM RAMAKRISHNAN, DEBANJAN SAHA,  
RAMENDRA K. SAHOO, ANEES A. SHAIKH,  
and MITHKAL M. SMADI

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Appeal 2017-003505<sup>1</sup>  
Application 12/015,020<sup>2</sup>  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, BRADLEY B. BAYAT, and  
TARA L. HUTCHINGS, *Administrative Patent Judges*.

BAYAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1, 3, 4, 7, 8, 12–17, 19–21, and 23, which are all the pending claims in the application. We have jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> Our Decision references Appellants’ Appeal Brief (“App. Br.,” filed Sept. 2, 2016), Reply Brief (“Reply Br.,” filed Dec. 30, 2016), the Examiner’s Answer (“Ans.,” mailed Nov. 1, 2016), and the Final Office Action (“Final Act.,” mailed Apr. 14, 2016).

<sup>2</sup> The Appellants identify International Business Machines Corporation as the real party in interest. App. Br. 1.

### CLAIMED INVENTION

The claimed invention relates to “information technology (IT) related processes.” Spec. 1:4–5. Claims 1, 8, 15, 19, and 23 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for creating an interactive mechanism, comprising the steps of:
  - preparing one or more lean principles as a process model;
  - annotating the process model with multiple items of process information comprising at least (i) one or more tasks associated with the process, (ii) one or more accounts associated with the process, (iii) one or more clusters associated with the process, (iv) one or more links associated with the process, (v) information pertaining to one or more role players associated with the process comprising contact information with one or more links to each of the one or more role players, (vi) an input requirement associated with the process, (vii) an output requirement associated with the process, and (viii) one or more desired functions associated with the process; and
  - creating an interactive mechanism based on the annotated process model, wherein the interactive mechanism comprises an interactive journal that generates and displays a user interface to enable user feedback pertaining to the annotated process model, wherein said user feedback comprises (i) comments pertaining to the process and (ii) suggestions for future implementation of the process based on the user's role in the process, wherein the interactive journal further records the identity of the user providing the user feedback via one or more visible logs, and wherein creating the interactive mechanism further comprises using a set of multiple necessary and sufficient requirements for the process as one or more pre-requisites and one or more co-requisites for creating the interactive mechanism; andwherein the steps are performed by at least one hardware device.

App. Br. 14 (Claims App'x).

## ANALYSIS

The Examiner rejected claims 1, 3, 4, 7, 8, 12–17, 19–21, and 23 under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more. Final Act. 3–4. In contesting the rejection, Appellants argue claims 1, 3, 4, 7, 8, 12–17, 19–21, and 23 as a group. App. Br. 9–13; Reply Br. 2–6. We select independent claim 1 as representative for this group. Thus, claims 3, 4, 7, 8, 12–17, 19–21, and 23 stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

In determining whether the claims on appeal are directed to patent-ineligible subject matter, the Examiner applied the now common two-step framework introduced in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012) and further explained by the Supreme Court in *Alice Corp. Pty. v. CLS Bank International*, 134 S. Ct. 2347 (2014). The first step in that analysis is to determine whether the claim at issue is directed to a patent-ineligible concept such as an abstract idea. *Alice*, 134 S. Ct. at 2355. If so, the inquiry proceeds to step two to look at the claim for “something more” by “examin[ing] the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Id.* at 2354, 2357 (quoting *Mayo*, 566 U.S. at 72, 80). This inventive concept must do more than simply recite “well-understood, routine, conventional activity.” *Mayo*, 566 U.S. at 79.

Applying this framework, and as the first step of that analysis, the Examiner determined that the claims are

directed to the abstract idea of creating an interactive mechanism comprising the steps of preparing one or more lean

principles as a process model, annotating the process model with multiple items of process information comprising tasks associated with the process, accounts, clusters, links, information pertaining to one more role players comprising contact information with one more links to role players, input requirements, output requirements, desired functions and creating the annotated process model and identifying multiple annotation attributes comprising at least a goal, indication of who performs the process, an indication where the process is performed and how to validate. The claims can be considered analogous to organizing human activities because enterprise processes can be considered human activities and modeling is a type of organization of such data.

Final Act. 4.

Appellants argue: (1) “the Examiner’s characterization that ‘the claims *involve* management of human activities’ is in error”; and (2) “the specific limitations of the pending claims affirmatively include ‘an improvement in computer capabilities,’ per the appropriate inquiry put forth in *Enfish*,<sup>3</sup> and thereby satisfy the first part of the *Alice/Mayo* framework as being directed to patent-eligible subject matter.” App. Br. 10–11 (quoting Spec. 8:27–9:8, 9:23–26).

Responding to Appellants’ arguments, the Examiner asserts: (1) [t]he claims can be considered analogous to organizing human activities because enterprise processes can be considered human activities and modeling is a type of management and organization of such data. The modeling of data and the presentation of such in the form of an interactive journal is also

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<sup>3</sup> *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016).

similar to how obtaining and comparing intangible data was an abstract idea in *Cybersource*<sup>4</sup>;  
and (2) “that this language [in the Specification] merely shows an improvement to the abstract idea. If there is any support for use of computers related to this section of the [S]pecification, it would be for merely using a computer to automate a process.” Ans. 3–4.

We are not persuaded of Examiner error because Appellants do not advance any arguments that explain why the Examiner’s actual determination of the abstract idea is flawed. In fact, Appellants merely disagree with an abstract idea (“the claims *involve* management of human activities” (App. Br. 9, 10)) that was not proffered by the Examiner. *Cf.* Final Act. 4. In the Reply Brief, Appellants assert that “the Examiner fails to significantly discuss the active and physical step of” the *creating* step of claim 1. Reply Br. 3. But, it is clear from the Examiner’s description of the abstract idea that the *creating* step was considered by the Examiner. Moreover, the “directed to” inquiry applies a stage-one filter to the claim, which is based on whether the character of the claim as a “whole is directed to excluded subject matter,”<sup>5</sup> instead of a piecemeal itemization of each of the claim limitations.

We also find unpersuasive Appellants’ argument (2) that the Specification describes an improvement in computer capabilities, because

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<sup>4</sup> *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366 (Fed. Cir. 2011)

<sup>5</sup> *See Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015); *see also Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016); and *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016).

Appellants simply reproduce portions from the Specification without any explanation as to how those disclosures reflect an improvement to computer capabilities in relation to the claimed subject matter. Furthermore, Appellants did not contest the Examiner's interpretation of those cited sections of the Specification or rebut the Examiner's response in their Reply Brief. *See* Ans. 4 (interpreting the Specification as using a computer to automate a process).

Indeed, the Specification describes improvements in speed, time, and effort, which are a direct result of automation. *See, e.g.*, Spec. 4:11–12 (“Existing approaches to implement lean in an IT organization have several limitations and inefficiencies.”), 4:17–19 (“[E]xisting approaches require manual processing”), 9:1–2 (“[T]he techniques described herein significantly cut down the time needed to implement lean”), 5:7–8 (“consolidated view of measureable improvements resulting in a decrease in deployment time”), 9:15–16 (“Structured data, tightly coupled processes, roles, accounts, and competencies enhance automatic tracking and on-demand report generation.”), 9:23–26 (“Applying lean principles as transformed enterprise processes accelerates the operations with continuous improvement, and significantly cuts down the time taken to implement lean through standardized step by step evaluation, annotation and review techniques.”). “[R]elying 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). In short, Appellants have not persuasively

shown how the cited passages in the Specification demonstrate an improvement to computer capabilities or functionality.

Turning to the second step of *Alice*, we agree with the Examiner and conclude that claim 1 does not contain an inventive concept sufficient to “transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (citation omitted). For example, claim 1 merely requires that “the steps are performed by at least one hardware device” and the Specification discloses generic devices for performing the claimed invention. *See* Spec. 16:4–19 (Examples of a suitable device include “general purpose processors” or “general-purpose computer or workstation”). The introduction of a generic computer into a claim does not alter the analysis.

Appellants argue

that if a set of “specific limitations” has been deemed not to be anticipated, taught, or even suggested by a field of available art, (as is the case with the instant claims) then the same set of “specific limitations” cannot plausibly be simultaneously argued as being “well-understood, routine and conventional in the field.”

App. Br. 12. We disagree.

Although the second step in the *Alice* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or nonobviousness, 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 (quoting *Mayo*, 566 U.S. at 73). A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See*



*Mayo*, 566 U.S. at 90. An abstract idea is not transformed into an inventive concept just because the Examiner has not found prior art that discloses or suggests it. Indeed, “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981). “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2117 (2013).

The wording of the steps in claim 1 is such that they describe certain objectives sought to be accomplished without providing any of the technical details that may be necessary to accomplish them. The claim simply provides the instruction toward achieving a result. The desired result is unconnected to how the “preparing, annotating, and creating” as recited in claim 1 should be performed to achieve it. “Generally, a claim that merely describes an ‘effect or result dissociated from any method by which [it] is accomplished’ is not directed to patent-eligible subject matter.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1244 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1348 (Fed. Cir. 2015)). “[S]imply appending conventional steps, specified at a high level of generality, to . . . abstract ideas cannot make those . . . ideas patentable.” *Mayo*, 566 U.S. at 72. None of these individual steps, viewed “both individually and ‘as an ordered combination,’” transform the nature of the claim into patent-eligible subject matter. *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78–79). It is well-settled by now that stating an abstract

idea “while adding the words ‘apply it’” is not enough for patent eligibility.” *Alice*, 134 S. Ct. at 2358 (quoting *Mayo*, 566 U.S. at 72).

In view of the foregoing, we are not persuaded of Examiner error, and, therefore, we sustain the rejection of independent claim 1 under 35 U.S.C. § 101, including claims 3, 4, 7, 8, 12–17, 19–21, and 23, which fall with claim 1.

#### DECISION

The decision of the Examiner to reject claims 1, 3, 4, 7, 8, 12–17, 19–21, and 23 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).

AFFIRMED