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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK CALDWELL, STEVE BRACK,
ROSEMARY BEAUVAIS, BOHDAN HORYN, ROBERT
FRANCIS ROCHE III, THOMAS G. KELLY, J STEVEN
SENNEFF, and RONALD E. MAHAFFEY

Appeal 2017-003571
Application 12/760,285¹
Technology Center 3600

Before St. JOHN COURTENAY III, ERIC S. FRAHM, and
DAVID M. KOHUT, *Administrative Patent Judges*.

KOHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 21–23, 25–30, 41–46, and 48.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellants, the real party in interest is American International Group, Inc. App. Br. 1.

² Claims 1–20, 24, 31–40, and 47 were cancelled. App. Br. 1.

INVENTION

Appellants' invention relates to a system for creating and reviewing incident reports. Spec. 1, ¶ [0001]. Claim 21 is the only independent claim on appeal and is reproduced below.

21. A computer-assisted system for incident reporting, comprising:

an application server on a computer located on a network and communicating with a user computer on the network,

the application server being programmed to present through user interface screens on the user computer an incident report form with data fields for entering information regarding an incident to create an incident report, the data fields including a field for a routing profile for the incident report, the routing profile including a plurality of sequential review steps with an associated reviewer for each review step, and

the application server being programmed to route the incident report to the reviewer associated with the first review step of the routing profile and to sequentially route the incident report to each subsequent reviewer associated with the subsequent review steps of the routing profile upon receiving an indication from the prior reviewer that the incident report is ready for review by the next reviewer, the application server being programmed to route the incident report by sending an electronic notification message to the reviewer indicating the incident report is ready for the reviewer's review; and

a database connected to the application server adapted to store the incident report in an

encrypted format and adapted to store a review status of the incident report;

wherein the application server is programmed to update the review status for the incident report upon completion of each sequential review step of the incident report by each reviewer associated with the routing profile and to update a field for the review status in one of the user interface screens, the field for the review status being adapted to display indicia configured to indicate the current review step and the action to be taken in said current review step.

REFERENCES

Carlson	US 2003/0135378 A1	July 17, 2003
Ouchi	US 7,546,346 B2	June 9, 2009
Voronov	US 7,788,237 B2	Aug. 31, 2010

REJECTIONS AT ISSUE

The Examiner rejected claims 21–23, 25–30, 41–46, and 48 under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more. Final Act. 2–6.

The Examiner rejected claim 25 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter for which the inventor regards as the invention. Final Act. 6–7.

The Examiner rejected claims 21–23, 25–29, 41–45, and 48 under 35 U.S.C. § 103(a) as unpatentable over Carlson in view of Ouchi.

The Examiner rejected claims 30 and 46 under 35 U.S.C. § 103(a) as unpatentable over Carlson, Ouchi, and Voronov.

ISSUES

Did the Examiner err in finding that claims 21–23, 25–30, 41–46, and 48 are directed to a judicial exception without significantly more?

Did the Examiner err in rejecting claim 25 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter for which the inventor regards as the invention?

Did the Examiner err in rejecting claims 21–23, 25–29, 41–45, and 48 under 35 U.S.C. § 103(a) as unpatentable over Carlson in view of Ouchi?

Did the Examiner err in rejecting claims 30 and 46 under 35 U.S.C. § 103(a) as unpatentable over Carlson, Ouchi, and Voronov?

ANALYSIS

35 U.S.C. § 101 rejection

The issue we consider is whether the Examiner erred in rejecting claim 21 and claim 21's dependent claims 22, 23, 25–30, 41–46, and 48 as being directed to patent-ineligible subject matter. Specifically, (1) did the Examiner err in determining that the claims are directed to an abstract idea, and (2) did the Examiner err in determining that claims do not recite additional limitations amounting to significantly more than the claimed abstract idea?

The Examiner performs a two-step analysis to determine patent eligibility as set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1296–97 (2012), and reiterated in *Alice*

Corp. Pty. Ltd. v. CLS Bank International, 134 S. Ct. 2347, 2355 (2014). In the first step, the Examiner determines if the claims are directed to a patent ineligible concept, such as an abstract idea. *Alice*, 134 S. Ct. at 2355. If the claims are directed to an abstract idea, then the Examiner proceeds to the second step. In the second step, the Examiner considers whether the claims, individually and as an ordered combination, recite an inventive concept—an element or combination of elements sufficient to ensure the claims amount to “significantly more” than the abstract idea and transform the nature of the claims into a patent-eligible concept. *Id.* We address each step in turn.

Step 1

The Examiner concludes that “the claim(s) is/are directed to the abstract idea of managing incident reports, more specifically to the creation of incident reports and routing the incident reports to reviewers using predetermine[d] rules.” Final Act. 2. The Examiner finds the acts of presenting an incident report to a user with the ability to define a routing profile, assigning a reviewer to each step, and routing the incident report to the reviewer according to the routing profile are based on an abstract idea that is well understood, routine, and conventional. Final Act. 2–6.

The Examiner further concludes that the claim scope is similar to the concepts previously identified as abstract ideas, such as in *SmartGene, Inc. v. Advanced Biological Lab, SA*, 555 F. App’x 950 (Fed. Cir. 2014) (comparing stored and inputted data with rules to identify treatment options which doctors routinely do in their heads.) Final Act. 3. Like the claims in *SmartGene*, the Examiner concludes the claims relate to the abstract ideas of

using rules to determine to whom and when a report should be sent to the next reviewer, which can be performed as a mental process. *Id.*

Appellants argue the claims are directed to a statutory class of invention, i.e., a machine, and are therefore not an abstract idea. App. Br. 5. In response, we emphasize that the issue of whether a claim is directed to a judicial exception, such as an abstract idea, is separate and independent from whether a claim is directed to statutory subject matter (i.e., “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” — 35 U.S.C. § 101). Claims that fall within one of the four subject matter categories may nevertheless be ineligible if they encompass laws of nature, physical phenomena, or abstract ideas. *See Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980).

Claim 21 recites the steps of receiving information regarding an incident report, receiving a routing profile associated with the incident report, routing the incident report to the appropriate reviewers based on the routing profile, storing the incident report, and updating the status of the incident report. App. Br. 14, Claims App. We agree with the Examiner’s legal conclusion that the steps in claim 21, like in *SmartGene*, are directed to abstract ideas involving an idea of itself, i.e., inputting data (using stored data and inputted data), inputting routing profile information (rules), and comparing the data with the routing profile information to process an incident report (comparing data with rules to identify treatment options), which can be performed as mental processes.

“The § 101 inquiry must focus on the language of the Asserted Claims themselves.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1149 (Fed. Cir. 2016); *see Accenture Global Servs., GmbH v. Guidewire*

Software, Inc., 728 F.3d 1336, 1345 (Fed. Cir. 2013) (admonishing that “the important inquiry for a § 101 analysis is to look to the claim”); *see also Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1346 (Fed. Cir. 2014) (“We focus here on whether the claims of the asserted patents fall within the excluded category of abstract ideas.”). “An abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). As our reviewing court has cautioned, however, characterizing claims at a “high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016); *see Thales Visionix Inc. v. United States*, 850 F.3d 1343, 1347 (Fed. Cir. 2017) (we must “articulate what the claims are directed to with enough specificity to ensure the step one inquiry is meaningful.”).

Appellants do not persuade us that the abstract ideas identified by the Examiner are untethered from the language of and over-generalize the claims. As the Examiner’s analysis shows, the focus of the claims is the abstract idea of an idea of itself. Although the Examiner states at a high level of abstraction that the claims are “directed to the abstract idea of managing incident reports,” and omits the specifics of how each specific step in the claim falls within the category of an abstract idea, we determine that the abstract idea proposed by Examiner still is sufficiently tethered to the language of the claims. As noted *supra*, the Examiner properly and reasonably concluded the claim is directed to an abstract idea involving an idea of itself, i.e., data collection, analysis, and comparisons using inputted routing profile rules. Final Act. 2–4.

Additionally, Appellants argue the claims improve on existing technological processes by addressing the problem of “difficulties encountered in routing the incident report to the correct reviewers and in tracking the progress of the review process.” App. Br. 5–7 (citing *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2358 (2014) (holding claims become patent eligible when “they [improve] an existing technological process”). We disagree with Appellants.

The Specification states the claims address the problem of distributing incident reports and “tracking of the progress of the reviews to ensure timely resolution of the incidents” and solves the problem by using electronic report forms and following routing profiles for each of the reports that will allow for auditing of the reports. Spec. 1–4. However, we do not see, nor do Appellants direct our attention to, where or how the Specification discusses a specialized process for providing recommendations or specific means to improve the relevant technology. Providing a simple and reliable way to create and track incident reports is not a technical improvement in the claimed generic computer-assisted system, application server, or database; rather, it is an abstract idea that merely processes incident reports and/or data using generic computer components. *See* Spec. 1–4.

Additionally, we are not persuaded the claims recites a specific improvement to computer functionality or a computer-related technology, because Appellants have not provided evidence of such. For example, Appellants have not demonstrated how the claims improve computer functionality or improve computer related technology by solving “difficulties encountered in routing the incident report to the correct reviewers and in tracking the progress of the review process.” App. Br. 6.

Based on the foregoing reasons, we determine the claims relate to the concept of managing incident reports, which can be performed as a mental process by a person having access to the reporting requirements and processes.³ Accordingly, we agree with the Examiner that claim 21 and its dependent claims are directed to an abstract idea.

Step 2

Under the second step of the *Alice* framework, the Examiner determines the claims do not recite additional limitations amounting to significantly more than the claimed abstract idea to transform the nature of the claim into a patent-eligible concept. Final Act. 3–6; Ans. 5. The Examiner finds that the additional limitations “amount(s) to no more than a generic computer system comprised of an application server and a database.” Final Act. 5. Specifically, the Examiner determines that the claimed invention uses a conventional computer, functions, and network to present data to a user, obtain data, input rules, and route the data based on the inputted rules and does not add anything significant beyond the basic computer, computer functions, and computer network. Final Act. 3–5; Ans.

³ See *Synopsys*, 839 F.3d at 1146–47 (“While the Supreme Court has altered the § 101 analysis since *CyberSource* in cases like *Mayo* and *Alice*, we continue to ‘treat[] analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.’” (Brackets in original) (quoting *Elec. Power Grp.*, 830 F.3d at 1354)); see also *CyberSource*, 654 F.3d at 1375 (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*.”).

4, 6. The Examiner further finds that the claim elements are conventional in the art and do not provide an improvement to a computer or any other technology. Final Act. 3–5; Ans. 5–6.

Appellants argue that the system is not a generic computer, but rather a “specifically-programmed machine that can provide a system for incident reporting.” App. Br. 6. However, Appellants do not provide sufficient evidence to show how that is the case other than to quote the Specification. App. Br. 5–6.

Accordingly, when the limitations of the claims are considered, individually and as an ordered combination, they amount to nothing more than an attempt to patent the abstract idea embodied in the steps of the claim. *See* Final Act. 3–5; Ans. 4–6. For these reasons, Appellants have not apprised us of error in the Examiner’s determination that the claims are directed to patent-ineligible subject matter. Accordingly, we are not persuaded of error and sustain the Examiner’s rejection of claims 21–23, 25–30, 41–46, and 48 under 35 U.S. C. § 101.

35 U.S.C. § 112, second paragraph rejection

The Examiner rejected claim 25 under 35 U.S.C. § 112, second paragraph, as being indefinite because the claim depends from cancelled claim 24. Final Action. 6–7. Appellants indicate in the Appeal Brief that Appellants meant to have claim 25 depend from claim 21. App. Br. 7. Thus, Appellants request that the Examiner enter an Examiner’s Amendment changing claim 25’s dependency to claim 21 and to, thereby, withdraw the indefiniteness rejection. App. Br. 7. The Examiner did not enter an

Examiner's Amendment. Therefore, the indefiniteness rejection of claim 25 is sustained.

35 U.S.C. § 103 (a) rejections

Claim 21

Claim 21 is a computer-assisted system that requires a routing profile to route the incident report through the review process and an application server that updates the review status of the incident report through the process. The Examiner finds that these limitations are taught by the combination of Carlson and Ouchi. Final Act. 7–13. Appellants argue that the Examiner is in error for several reasons. App. Br. 8–12.

First, Appellants contend that there is no motivation to combine the references. App. Br. 10. Specifically, Appellants contend that the Examiner has not provided a credible reason to combine Carlson's incident reporting system with Ouchi's workflow system. App. Br. 10. We do not find this argument persuasive as it amounts to attorney argument without supporting evidence or explanation. *See In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (stating that attorney's arguments cannot take the place of evidence). Additionally, we do not find this argument persuasive as the Examiner provides a specific motivation to combine the references and Appellants do not address the Examiner's specific finding. Final Act. 10–11.

Second, Appellants contend that Carlson fails to teach a routing profile and that Ouchi does not overcome this deficiency. App. Br. 11. However, the Examiner cited specifically to Ouchi for this limitation where Ouchi teaches a specific workflow process. Final Act. 9. Additionally, as indicated by the Examiner (Ans. 7), Appellants do not provide any reason as

to why either Carlson or Ouchi fails to teach this limitation. Thus, we do not find this argument persuasive.

And, lastly, Appellants contend that the references fail to teach an application server for updating the review status. App. Br. 11. Specifically, Appellants argue that Carlson discloses tracking and updating the status of corrective actions, which is not the same as updating sequential review steps of an incident report. App. Br. 11. Additionally, Appellants contend that Ouchi fails to overcome Carlson's deficiencies. App. Br. 12. We disagree.

The Examiner finds that Carlson teaches a supervisory interface that allows the tracking and updating of corrective actions. Ans. 8–9. Additionally, the Examiner finds that Ouchi teaches a system and method of routing workflow for a particular process. Final Act. 9. Thus, the Examiner finds that it is the combination of Ouchi's process of routing workflow with Carlson's status update of each corrective action (i.e., each workflow step) teaches the disputed limitation. Final Act. 9–12; Ans. 10–11.

On this record, we are not persuaded the Examiner erred, because Appellants have not specifically addressed the Examiner's findings. Instead, Appellants' argument constitutes an attack on the references individually, rather than a challenge to the Examiner's combination of the teachings of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413 (CCPA 1981) (one cannot show nonobviousness by

attacking references individually where the rejections are based on combinations of references).

For the reasons indicated above, then, we sustain the Examiner's rejection of claim 21.

Claims 22, 23, 25–29, 41–45, and 48

Appellants argue that the rejection of claims 22, 23, 25–29, 41–45, and 48 should be reversed for the same reasons as indicated above with respect to independent claim 21. App. Br. 12. As such, we affirm the rejection of these claims for the same reasons indicated above.

Claims 30 and 46

Appellant argues that the rejection of claims 30 and 46 should be reversed for the same reasons indicated above with respect to independent claim 21 and because the Voronov reference used for claims 30 and 46 does not overcome the deficiencies indicated above with respect to Carlson and Ouchi. App. Br. 12–13. Thus, for the same reasons indicated above with respect to claim 21, we affirm the rejection of claims 30 and 46.

CONCLUSIONS

The Examiner did not err in finding that claims 21–23, 25–30, 41–46, and 48 are directed to a judicial exception, without significantly more.

The Examiner did not err in rejecting claim 25 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter for which the inventor regards as the invention.

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The Examiner did not err in rejecting claims 21–23, 25–29, 41–45, and 48 under 35 U.S.C. § 103(a) as unpatentable over Carlson in view of Ouchi.

The Examiner did not err in rejecting claims 30 and 46 under 35 U.S.C. § 103(a) as unpatentable over Carlson, Ouchi, and Voronov.

SUMMARY

We affirm the Examiner’s rejection of claims 21–23, 25–30, 41–46, and 48 under 35 U.S.C. § 101.

We affirm the Examiner’s rejection of claim 25 under 35 U.S.C. § 112, second paragraph.

We affirm the Examiner’s rejection of claims 21–23, 25–30, 41–46, and 48 under 35 U.S.C. § 103(a).

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