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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALISTAIR P. BARROS

Appeal 2017-004816
Application 12/788,084
Technology Center 3600

Before JEAN R. HOMERE, AMBER L. HAGY, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant[1] appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–20, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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[1] Appellant identifies the real party in interest as SAP SE. (App. Br. 1.)

STATEMENT OF THE CASE

Introduction

Appellant's disclosure relates to "brokered service delivery." (Spec. ¶ 1.) By way of background, the Specification states that "[t]he brokering of goods and services is a time-honored technique of facilitating commerce." (*Id.* ¶ 2.) In particular, the Specification describes brokering as a broker taking on the responsibility from a manufacturer or provider of services to locate purchasers and to conduct and consummate sales, in exchange for receiving "a share of the purchase price or some other fee or payment." (*Id.*) The Specification further states that "these general concepts" have been adopted "[i]n the computer, network, and software realm(s) . . . for the delivery of goods and services, e.g., over the Internet." (*Id.* ¶ 3.) The Specification notes that "[i]n theory, the intersection of brokering and software services . . . is conceptually straight-forward." (*Id.* ¶ 5.) The Specification states, however, that "many services are conventionally difficult or impossible to deliver as part of a brokered service delivery scenario." (*Id.* ¶ 6.) Purportedly to address that difficulty, the Specification describes a system "for providing service delivery management for brokered service delivery" that includes "an explicit, dedicated platform for service delivery management which enables complex service delivery models to support the run-time brokerage of groups of long-running, multi-session services, some or all of which may be hosted by different, otherwise-incompatible service providers." (*Id.* ¶ 39.)

Exemplary Claim

Claims 1, 4, 10, and 16 are independent. Claim 1, reproduced below, is exemplary of the claimed subject matter:

> 1. A computer system including instructions stored on a nontransitory computer-readable storage medium, the computer system comprising:
>
> a service regulator configured to cause at least one processor to transform a service interface of at least one service of at least one service provider into service states and transitions between the service states to create a coordination model, the service states corresponding to distinct forms to be exchange with a user as part of an execution of the at least one service, the transitions representing action requests and responses on the at least one service;
>
> a broker consumer gateway configured to cause the at least one processor to interface with a service consumer of a computing device consuming the at least one service of the at least one service provider based on the coordination model, each of the service states represented as at least one distinct form that is requested, filled-in, and submitted in association with the user via the service consumer of the computing device; and
>
> a service delivery manager configured to cause the at least one processor to mediate delivery of each of the service states modeled with the coordination model of the at least one service to the service consumer of the computing device via the broker consumer gateway including invoking the at least one distinct form for each of the service states during execution of the at least one service, the service delivery manager including:
>
> a consumer session manager configured to cause the at least one processor to create at least one consumer session in association with the user during which to execute at least a portion of the at least one service, including transitioning through one or more of the service states of the at least one service according to the coordination model, a consumer instance manager

> configured to cause the at least one processor to create at least one instance of the at least one service within the at least one consumer session, the at least one instance being associated with the at least one service including representing each of the service states with the at least one distinct form that is requested, filled-in, and submitted in association with the user via the service consumer of the computing device, and
>
> a service coordinator configured to cause the at least one processor to coordinate and track each of the service states during delivery of the at least one service from the at least one service provider within the at least one consumer session and the at least one instance of the at least one service, the service coordinator configured to cause the at least one processor to track and advance a current state of each executing service to a next service state using the coordination model characterizing the at least one service in which each of the distinct forms are associated with corresponding ones of the service states of the at least one service and in which the transitions between each of the service states are executed based on the at least one distinct form exchanged with the service consumer during each service state.

REJECTIONS[2]

1. Claims 1, 4, 10, 14, 16, and 20 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1, 5, 6, 10, and 18 of copending Application No. 12/788,087 ("the '087 Application") and further in view of D'Angelo, U.S. Patent No. 7,917,124 B2, issued Mar. 29, 2011 ("D'Angelo") and Kumaran, Pub. No. US 2009/0024514 A1, published Jan. 22, 2009 ("Kumaran"). (Final Act. 10-21.)

[2] Claims 1–20 were rejected also under 35 U.S.C. § 103 in the Final Action (Final Act. 23–62), but the Examiner withdraws these rejections in the Answer. (Ans. 16.)

2. Claims 1–20 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter (abstract idea). (Final Act. 3–7, 21–23.)

ANALYSIS

A. Provisional Rejection for Obviousness-Type Double Patenting

The Examiner provisionally rejects claims 1, 4, 10, 14, 16, and 20 on the ground of nonstatutory obviousness-type double patenting over claims 1, 5, 6, 10, and 18 of the '087 Application and further in view of D'Angelo and Kumaran. (Final Act. 10–21.)

As Appellant points out (Reply Br. 12), the '087 Application has since been abandoned (as of March 11, 2016). Accordingly, the Examiner's provisional obviousness-type double patenting rejection over the '087 application in combination with D'Angelo and Kumaran is now moot.

B. § 101 Rejection

The Examiner rejects the claims as being directed to patent-ineligible subject matter under 35 U.S.C. § 101.[3] The Examiner determines the claims are directed to the abstract idea of "facilitating service delivery." (Ans. 15.) The Examiner further finds the claims do not amount to significantly more than the abstract idea because "Appellant has not shown that the computer technology utilized in the claims performs anything more than court-recognized examples of *well-understood, routine, and conventional*

[3] The Examiner rejects claims 2–20 on the "same rationale" as claim 1. (Final Act. 23.) Appellant generally argues the rejection of all claims collectively with regard to claim 1 (*see* App. Br. 9–17), while presenting additional arguments with regard to claims 4, 14, and 20 (*id.* at 17–19). We select claim 1 as representative pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(iv).

functions, including 'receiving, processing, storing and transmitting data.'" (*Id*. at 23 (emphasis added).)

Appellant argues the Examiner erred because, *inter alia*, the claimed solution "employs novel and inventive computer functions for delivering software services via a broker, which serves as a central point between specific software services running on remote, backend systems of the service provider(s) and consumer computing devices executing an instance of the software service(s) within a browser application." (App. Br. 10.) In particular, Appellant argues claim 1

> specif[ies] in very specific technical terms how the performance of the system itself is improved to yield a desired result - allowing multi-step, long-running software services to be deployed, configured, and executed via a broker through the use of the coordination model, e.g., sending forms to the consuming applications, receiving submitted forms containing actions for execution, and adapting and invoking the back-end service applications. The above-identified limitations of claim 1 are meaningful limitations that add more than generally linking the use of the abstract idea to a generic computer, because they solve a network-centric problem with a claimed solution that is necessarily rooted in computer technology, similar to the additional elements in *DDR Holdings*.

(App. Br. 16 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014).)

It is the Examiner's burden to show—with supporting facts—that the recited limitations are well-understood, routine, and conventional where, as here, the Examiner relies on such a basis for the ineligibility rejection. *See Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018) ("Whether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination"). The prima facie case is

a procedural tool of patent examination, allocating the respective burdens between the Examiner and an applicant. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). First, the Examiner bears the initial burden of presenting a prima facie case of unpatentability. *Id.* (*citing In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984)). If the Examiner meets that burden, the burden then shifts to the applicant to rebut the prima facie case with evidence or argument. *Oetiker*, 977 F.2d at 1445. Then, patentability is determined on the totality of the record by a preponderance of evidence with due consideration of persuasiveness of argument. *Id.*; *accord* MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 2106.07 (9th ed. Rev. 08.2017, Jan. 2018) (noting that the initial burden of establishing a prima facie case of ineligibility under § 101 is on the Examiner to explain clearly and specifically why claims are ineligible, so that the applicant has sufficient notice and can respond effectively).

Under the new examination procedure published online by the USPTO on April 19, 2018, entitled "Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*)" (hereinafter "*Berkheimer* Memorandum"), there is a new fact finding requirement for Examiners, as applicable to rejections under § 101. Specifically, Examiners must now provide specific types of evidence to support a finding that claim elements (or combinations of elements) are well-understood, routine, and conventional.

Here, the Examiner's determinations that the claims are directed to an abstract idea and do not amount to significantly more than the abstract idea are predicated, at least in part, on unsupported findings that

> Appellant's claims are devoid of any discernible change, transformation, or improvement to any process, technology, or computer, but instead are directed to creating a coordination model at least in part by using service states and transitions to identify brokered service delivery scenarios, accompanied by general-purpose or at least conventional computing elements that merely tie the idea to a particular operating environment, along with high-level descriptive claim language that describes *well-known, routine, and conventional activities in the art.*

(Ans. 24 (emphasis added).) The Examiner also finds, without citing evidentiary support, that "creating a coordination model, mediat[ing] delivery of service states, creat[ing] a consumer session, coordinat[ing] and track[ing] each service state merely involve well-understood, routine, and conventional activities in the art, and even when implemented by a computer, [and] involve nothing more than automating mental/manual and conventional activities in the art." (*Id.* at 27.)

We determine that the Examiner did not satisfy the initial burden of establishing a prima facie case of ineligibility under § 101 by providing the requisite factual support for limitations that are said to be well-understood, routine, and conventional; consequently, the burden never shifted to Appellant to rebut that case. We are, therefore, constrained on this record to reverse the Examiner's 35 U.S.C. § 101 rejection of claim 1 as well as claims 2–20 rejected on the same basis and argued collectively by Appellant.

DECISION

The Examiner's obviousness-type double patenting rejection of claims 1, 4, 10, 14, 16, and 20 is determined to be moot.

The Examiner's 35 U.S.C. § 101 rejection of claims 1–20 is reversed.

REVERSED