



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes sub-tables for EXAMINER, ART UNIT, PAPER NUMBER, NOTIFICATION DATE, and DELIVERY MODE.

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

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@crgolaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SANDRA L. KOGAN, ERIC M. WILCOX, and
CHARLES R. HILL

Appeal 2017-004872
Application 11/612,975¹
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BRUCE T. WIEDER, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 9–13 and 15–19.² We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to Appellants, the real party in interest is International Business Machines Corporation. (Appeal Br. 2.)

² Appellants state that they “appeal from the Examiner’s rejection of claims 1 through 20.” (Appeal Br. 1.) However, on page 1 of Appellants’ Pre-Appeal Brief Request for Review,” filed May 23, 2016, Appellants acknowledge that “claims 9 through 13 and 15 through 19 are pending in the Patent Application.” Moreover, only claims 9–13 and 15–19 are rejected in the Final Action from which this appeal is taken. (*See* Final Action 5–15.) Therefore, we treat Appellants’ statement that this is an appeal from the rejection of claim 1–20 as inadvertent error.

CLAIMED SUBJECT MATTER

Appellants' claimed invention relates "to project management in a collaborative computing environment." (Spec. ¶ 1.) More specifically, it relates to a project management system that can "integrate external ad-hoc communications among task nodes of an activity hierarchy modeling a project plan." (*Id.* ¶ 9.)

Claims 9 and 15 are the independent claims on appeal. Claim 9 is illustrative. It recites:

9. A method for integrating external ad-hoc communications in a project plan in a project management tool, the method comprising:
 - selecting an instance of an external ad-hoc communication in an activity-centric project management tool executing in memory of a host computing platform;
 - displaying an activity map in the tool, loading a project plan into the memory and rendering the project plan in the activity map, the project plan comprising a display of a hierarchy of task nodes;
 - creating a task node in the hierarchy for the selected instance;
 - associating the instance of the external ad-hoc communication with task meta data in the task node; and,
 - inserting the task node under an associated task in the hierarchy of task nodes representative of the project plan.

REJECTIONS³

Claims 9–13 and 15–19 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

³ The rejections of claims 9–13 and 15–19 under 35 U.S.C. § 103(a) have been withdrawn. (*See Answer 8.*)

Claims 9–13 and 15–19 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

ANALYSIS

The § 101 rejection of claims 9–13 and 15–19

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. Section 101, however, “contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

Alice applies a two-step framework, earlier set out in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355.

Under the two-step framework, it must first be determined if “the claims at issue are directed to a patent-ineligible concept.” *Id.* If the claims are determined to be directed to a patent-ineligible concept, then the second step of the framework is applied to determine if “the elements of the claim . . . contain[] an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Id.* at 2357 (citing *Mayo*, 566 U.S. at 72–73, 79).

With regard to step one of the *Alice* framework, the Examiner determines that “[c]laims 9-13 and 15-19 are . . . directed to an abstract idea of inserting external ad-hoc communications in a project plan.” (Final Action 5.) In particular, the Examiner determines that “[t]he steps related to selecting, displaying, creating, associating and inserting all illustrate organizing data for a display in a particular manner.” (*Id.*) The Examiner further determines that “[t]his ability to select data, display it in a particular form, create a node hierarchy, associate instances with meta data and insert the node into a hierarchy . . . is similar to the abstract idea . . . set forth in [*Cyberfone Sys., L.L.C. v. CNN Interactive Grp., Inc.*, 558 F. App’x 988 (Fed. Cir. 2014)].” (*Id.* at 6.)

Appellants disagree and argue both that the “Examiner repeats the claim language of Appellants’ claims and concludes that the entirety of the claim language is directed to the abstract idea of ‘organizing human activities and a method of organizing data’” and that the “Examiner appears to have succumbed to the very analysis warned against by Enfish and the Deputy Commissioner for Patent Examination Policy – “describing a claim at a high level of abstraction untethered from the language of the claim when determining the focus of the claimed invention” (Appeal Br. 7.) Appellants then argue that claim 1, which is not on appeal, supports these arguments.

Under step one of the *Alice* framework, we “look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)).

The Specification provides evidence as to what the claimed invention is directed. In this case, the Specification discloses that the invention relates “to project management in a collaborative computing environment.” (Spec. ¶ 1.) More specifically, it relates to a project management system that can “integrate external ad-hoc communications among task nodes of an activity hierarchy modeling a project plan.” (Id. at ¶ 9.) Claim 9 provides further evidence. Claim 9 recites “[a] method for integrating external ad-hoc communications in a project plan . . . comprising: selecting an instance of an external communication,” “displaying . . . the project plan,” “creating a task node . . . for the selected instance,” “associating the instance . . . with . . . meta data in the task node,” “and, inserting the task node under an associated task.”

Although we and the Examiner describe, at different levels of abstraction, to what the claims are directed, it is recognized that “[a]n abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). That need not and, in this case does not, “impact the patentability analysis.” See *id.* at 1241. In view of the above, we do not agree that the Examiner’s determination that “[c]laims 9-13 and 15-19 are . . . directed to an abstract idea of inserting external ad-hoc communications in a project plan” (Final Action 5), is “untethered” from the language of claim 9.

In this case, as in *Alice*, we need not labor to delimit the precise contours of the “abstract ideas” category. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concepts of “using categories to organize, store, and transmit information,” *Cyberfone*, 558 F. App’x at 992, and “integrat[ing] external ad-hoc

communications among task nodes of an activity hierarchy modeling a project plan” (Spec. ¶ 9). Both are squarely within the realm of “abstract ideas” as the Court has used that term. *See Alice*, 134 S. Ct. at 2357. Also, we note that we have treated collecting, analyzing, and displaying information, without more, such as using a particular tool for presentation, “as within the realm of abstract ideas.” *Elec. Power Grp.*, 830 F.3d at 1353–54. Moreover, here, the limitations do not recite implementation details. Instead, they recite functional results to be achieved. In other words, the claims do not recite “a particular way of programming or designing the software . . . , but instead merely claim the resulting [method].” *Apple, Inc.*, 842 F.3d at 1240.

In view of the above, we agree with the Examiner that claim 9 is directed to an abstract idea.

Step two of the *Alice* framework has been described “as 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 (quoting *Mayo*, 566 U.S. at 72–73).

Appellants argue the “claims are directed to a process driven improvement to the functionality of a computer.” (Appeal Br. 9, emphasis omitted.)

The Examiner determines that

[n]either the claims nor the specification expressly disclose how the activity-centric project management tool impacts the functioning of the computer in any way. The ability to organize the tasks in a hierarchy of tasks in a project is directed to improving the business aspect of project management and does

not illustrate any improvement to how the computer itself functions

(Answer 10–11.)

Appellants do not explain *how*, in this instance, the steps of selecting data, displaying data, creating a task node, associating data, and inserting data, improves the functionality of a computer. Appellants do not indicate where the Specification discloses an improvement to the functionality of a computer itself. Nor do Appellants indicate where in the Specification anything other than a generic computer programmed to perform the steps of the invention is disclosed. Indeed, the Examiner finds that Appellants' Specification discloses that a general purpose computer can be used to implement the claimed method. (Final Action 6–7, citing Spec. ¶¶ 23–27.) The claims “do not require an arguably inventive set of components or methods, such as measurement devices or techniques.” *Elec. Power Grp.*, 830 F.3d at 1355. The introduction of a computing platform to implement the claimed steps does not alter the analysis at step two. In short, “these claims in substance [are] directed to nothing more than the performance of an abstract business practice . . . using a conventional computer. Such claims are not patent-eligible.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014).

In view of the above, we are not persuaded that the Examiner erred in determining that claim 9 is directed to a judicial exception without significantly more. Claims 10–13 and 15–19 are not separately argued and fall with claim 9. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The § 112, first paragraph, rejection of claims 9–13 and 15–19

With regard to independent claim 9, the Examiner finds that “[t]he specification provides no details of how the instance of an external ad-hoc communication is selected. Instead the specification merely restates the claimed step: [0023] ‘block 330, the external ad-hoc communications can be selected for inclusion in the hierarchy.’” (Final Action 8.) “[T]he lack of disclosure of how Applicant’s invention was intended to be implemented would not inform a skilled artisan that Applicant was in possession of the claimed invention as a whole at the time the application was filed.” (*Id.* at 9.) The Examiner makes similar findings for the limitations “associating the instance of the external ad-hoc communication with task meta data in the task node,” and “inserting the task node under an associated task.” (*Id.* at 8–9.) The Examiner similarly rejects independent claim 15, which contains similar language, and dependent claims 10–13 and 16–19. (*Id.* at 10.)

Appellants disagree and argue “that the Examiner has not met the burden of articulating how the amended claims 9 and 15 . . . are not adequately described in Applicants’ specification so as to prevent a person skilled in the art at the time the application was filed to recognize that the Appellants were in possession of the claimed invention.” (Appeal Br. 12.) “Indeed, 35 U.S.C. § 112(a) does not require that the Appellants claim a specific way of achieving a claimed methodology so long as the claimed methodology itself is disclosed as part of the specification.” (*Id.* at 13, emphasis omitted.) Appellants further argue that “all three steps are present in Figure 3 and paragraphs [0023] and [0024] of the originally presented specification.” (*Id.* at 12.)

The test for sufficiency of a written description is “whether the disclosure clearly ‘allow[s] persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.’” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed.Cir.2010) (en banc) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562–63 (Fed.Cir.1991)). The disclosure must “reasonably convey[] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* at 1351. Possession means “possession as shown in the disclosure” and “requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Id.*

Crown Packaging Tech., Inc. v. Ball Metal Beverage Container Corp., 635 F.3d 1373, 1380 (Fed. Cir. 2011).

If . . . the specification contains a description of the claimed invention, albeit not in *ipsis verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient. [*In re Wertheim*, 541 F.2d 257, 264 (CCPA 1976)]. Once the examiner or Board carries the burden of making out a prima facie case of unpatentability, “the burden of coming forward with evidence or argument shifts to the applicant.” [*In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)]. To overcome a prima facie case, an applicant must show that the invention as claimed is adequately described to one skilled in the art.

In re Alton, 76 F.3d 1168, 1175 (Fed. Cir. 1996).

Here, the Examiner has provided a reason why one of ordinary skill would not have considered the description sufficient, i.e., because “the lack of disclosure of how Applicant’s invention was intended to be implemented would not inform a skilled artisan that Applicant was in possession of the claimed invention as a whole at the time the application was filed.” (Final Action 9.) In other words, “because a myriad of ways exist to perform the

function [of the claimed invention], one of ordinary skill . . . could not have known how the inventor intended the function to be performed.”

(Answer 11; *see also Ariad Pharm, Inc.*, 598 F.3d at 1345 (“A description of the claimed invention allows the [USPTO] to examine applications effectively; . . . and the public to understand and improve upon the invention and to avoid the claimed boundaries of the patentee’s exclusive rights.”).)

Thus, the burden shifts to Appellants to “show that the invention as claimed is adequately described to one skilled in the art.” *Alton*, 76 F.3d at 1175.

Appellants, however, merely argue that “all three steps are present in Figure 3 and paragraphs [0023] and [0024] of the originally presented specification.” (Appeal Br. 12.) Appellants do not adequately show or explain that one of ordinary skill at the time would have considered the disclosures in Figure 3 and paragraphs 23–24 sufficient to recognize that the inventors invented what is claimed. In short, Appellants do not address the Examiner’s finding that “the lack of disclosure of how Applicant’s invention was intended to be implemented would not inform a skilled artisan that Applicant was in possession of the claimed invention as a whole at the time the application was filed.” (*See* Final Action 9.)

Therefore, we are not persuaded that the Examiner erred in rejecting claims 9–13 and 15–19 under § 112, first paragraph.

DECISION

The Examiner’s rejection of claims 9–13 and 15–19 under 35 U.S.C. § 101 is affirmed.

The Examiner’s rejection of claims 9–13 and 15–19 under 35 U.S.C. § 112, first paragraph is affirmed.

Appeal 2017-004872
Application 11/612,975

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED