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Potomac Law Group, PLLC (Oracle International) 8229 Boone Boulevard Suite 430 Vienna, VA 22182			DELICH, STEPHANIE ZAGARELLA	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* RAJU ADDALA, ALOK SINGH, LEAK REED, ZEESHAN  
BUTT, SARITA SRIDHARAN, and SUNITA DATTI

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Appeal 2017-005192  
Application 12/718,475  
Technology Center 3600

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Before ALLEN R. MacDONALD, BRADLEY W. BAUMEISTER, and  
AARON W. MOORE, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection<sup>2</sup> of claims 1–18. Notice of Appeal 1. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

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<sup>1</sup> Appellants indicate the real party in interest is Oracle International Corporation. App. Br. 2.

<sup>2</sup> All citations herein to the “Final Action” are to the Final Action mailed on January 15, 2016.

*Illustrative Claim*

Illustrative claim 7 under appeal reads as follows (emphasis and bracketed materials added):

7. A computer-implemented method for configuring for a distributed order orchestration system, the computer-implemented method comprising:

[A.] receiving, at an orchestration system, metadata encapsulating one or more instructions for creating a business process;

[B.] defining a cost of change value for the business process, wherein the *cost of change value represents a cost required to adjust the business process*;

[C.] executing an executable orchestration process that is generated from the business process, wherein the executable orchestration process orchestrates an order *by dynamically invoking one or more services stored within a service library configured to control task execution of an external fulfillment system*;

[D.] receiving, at the orchestration system, a change request from a client device, wherein the change request comprises an adjustment of the business process;

[E.] determining, by a processor, whether the cost of change value is greater than an upper threshold value;

[F.] when the *cost of change value* is not greater than the upper threshold value, initiating the change request and automatically adjusting the steps of the executable orchestration process that have already been executed; and

[G.] when the *cost of change value* is greater than the upper threshold value, not initiating the change request.

*Rejection*<sup>3</sup>

The Examiner rejects claims 1–18 under 35 U.S.C. § 101 “because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more,” i.e., because the claimed invention is patent-ineligible subject matter. Final Act. 5.

Appellants argue claims 1–18 as a group. App. Br. 6–15. We select claim 7 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv). Except for our ultimate decision, we do not discuss this rejection of claims 1–6 and 8–18 further herein.

*Issues on Appeal*

Has the Examiner erred in rejecting claim 1 as being patent-ineligible subject matter?

ANALYSIS<sup>4</sup>

We have reviewed the Examiner’s rejections in light of Appellants’ arguments (Appeal Brief and Reply Brief) that the Examiner has erred. We disagree with Appellants’ conclusions. Except as noted below, we adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner’s Answer in response to Appellants’ Appeal Brief. We

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<sup>3</sup> The Examiner has withdrawn the rejections of claims 1–18 under 35 U.S.C. § 103(a). Ans. 2.

<sup>4</sup> All MPEP citations herein are to MPEP Rev. 08.2017, January 2018.

concur with the conclusions reached by the Examiner. We highlight the following additional points.

A.

Appellants raise the following argument in contending that the Examiner erred in rejecting claim 1 as being patent-ineligible subject matter.

Although some court cases are cited by the Examiner, a comparison of the alleged abstract idea to the abstract ideas identified by the courts shows that there are **no similarities**.

The Examiner compares the alleged abstract idea to *SmartGene, Inc. v. Advanced Biological Labs., SA*, No. 2013-1186 (Fed. Cir. 2014) (unpublished). . . .

However, in contrast to *SmartGene*, the claimed invention is clearly not directed to a process that a doctor or any other professional can and do perform in their heads.

App. Br. 8.

[I]n the instant application, improvements to the functioning of the computer are provided. For example, the claims taken as a whole are directed toward particular techniques that overcome the problems caused by differences between actual business models and implementations of such models by information technology designers. See Specification at ¶ [0003], for example.

App. Br. 10.

Should the Examiner continue to allege that the claims are directed to an abstract idea, Applicant respectfully requests supporting evidence.

App. Br. 11.

In response, at pages 2–7 of the Answer, the Examiner points to further case law (i.e., supporting evidence) and provides further analysis. We agree with the Examiner’s response except as to the point that the full paragraph at page 7 of the Answer does not explicitly recognize that the

Examiner has already provided supporting evidence (case law citations) on pages 3–6 of the Answer as to step 1 of the *Alice/Mayo* analysis.

Particularly, we agree with the Examiner that:

The difference between an actual business process and a model or plan for a business process does not illustrate a technical solution to a technical problem. It merely invokes a computerized tool to perform analysis and implement the abstract idea thus improving a business process.

Ans. 6–7. Stated differently, we conclude that Appellants do not set forth a technological solution to a technological problem, but rather a business solution to a business problem. *See also* MPEP § 2106.04(a)(2)II.

B.

Appellants also raise the following argument in contending that the Examiner erred in rejecting claim 1 as being patent-ineligible subject matter.

Even if the claims are considered to be directed to an abstract idea (which is not admitted by Applicant), the claims can include an “inventive concept” or additional elements so that the abstract idea is transformed into a patent-eligible application. *See Alice* at 2357. For at least the reasons discussed below, the claims do include patentable inventive concepts.

App. Br. 11.

[Claim 7 recites] receiving, at an orchestration system, metadata encapsulating one or more instructions for creating a business process and execute an executable orchestration process that is generated from the business process, wherein the executable orchestration process orchestrates an order by dynamically invoking one or more services stored within a service library configured to control task execution of an external fulfillment system. These features are neither “conventional” nor “specified at a high level of generality,” and render the claims patent eligible pursuant to *Alice*.

Moreover, these are meaningful limitations that add more than generally linking the use of the abstract idea to a generic

computer because they solve a problem that is necessarily rooted in computer technology. The claimed invention addresses the problems caused by differences between actual business models and implementations of such models by information technology designers.

App. Br. 13.

In response, at pages 7–9 of the Answer, the Examiner provides further analysis as to step 2 (the not significantly more analysis) of the *Alice/Mayo* analysis.

We are unpersuaded by Appellants’ argument. First, we agree with the Examiner that the “dynamically invoking one or more services” is recited at “a high level of generality.” Ans. 7.<sup>5</sup> Second, as previously discussed, we conclude that Appellants do not set forth a technological solution to a technological problem, but rather a business solution to a business problem. Third, as to the claimed “metadata encapsulating one or more instructions for creating a business process,” we conclude the record shows this to be conventional. Appellants acknowledge that typically an “IT designer uses an orchestration language, such as business process execution language (“BPEL”), to code the business process. BPEL processes are typically created in a BPEL editor and a deployed BPEL process is invoked.” Spec. ¶ 3. Further, Bournas at paragraphs 103 and 106 shows that “normally” BPEL includes metadata representing the production process.

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<sup>5</sup> We note the following typographical error at the last line of page 7 of the Answer: “generated” should read —generality—.

C.

Appellants furthermore raise the following arguments in contending that the Examiner erred in rejecting claim 1 as being patent-ineligible subject matter.

[T]he present claims will not preempt all systems and methods for performing the alleged abstract idea.

App. Br. 15.

The Examiner now admits that the claims are allowable over the prior art. *See* 12/23/16 Examiner's Answer at p. 2. As no anticipatory or obviousness rejection is pending, the pending claims contain an inventive concept.

Reply Br. 5.

1.

Appellants' pre-emption argument overlooks that the Court's *Alice/Mayo* two-step (abstract idea/significantly more) analysis is the Court's framework for determining pre-emption.

[W]e set forth a frame-work 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; *see also* MPEP § 2106.04 I.

Moreover, "the absence of complete preemption does not demonstrate patent eligibility." *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) ("Where a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, [] preemption concerns are fully addressed and made moot."). Contrary to Appellants' arguments, the Examiner correctly applied the *Alice/Mayo* framework.

2.

Appellants’ “allowable over the prior art” argument does not persuade us of Examiner error. Although the second step in the *Alice/Mayo* analysis includes 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 at 71). A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 at 89–91; *see also* MPEP § 2106.05 I.

Further, “under the *Mayo/Alice* framework, a claim directed to a newly discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the novelty of that discovery for the inventive concept necessary for patent eligibility.” *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016).

## CONCLUSIONS

- (1) The Examiner has not erred in rejecting claims 1–18 under 35 U.S.C. § 101, as being patent-ineligible subject matter.
- (2) Claims 1–18 are not patentable.

## DECISION

The Examiner’s rejection of claims 1–18 under 35 U.S.C. § 101, as being patent-ineligible subject matter, is **affirmed**.

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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