



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.
13/936,674 07/08/2013 Ahmad Naser ABDELRAHMAN 2011-0010US10 1560

74739 7590 03/15/2019
Potomac Law Group, PLLC (Oracle International)
8229 Boone Boulevard
Suite 430
Vienna, VA 22182

Table with 1 column: EXAMINER

DUNHAM, JASON B

Table with 2 columns: ART UNIT, PAPER NUMBER

3684

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

03/15/2019

ELECTRONIC

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):

patents@potomaclaw.com
bgoldsmith@potomaclaw.com
eofficeaction@apcoll.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AHMAD NASER ABDELRAHMAN
and BRIAN JAMES DUECK

Appeal 2017-006099
Application 13/936,674
Technology Center 3600

Before DEBRA K. STEPHENS, NABEEL U. KHAN, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

SZPONDOWSKI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
Final Rejection of claims 1–20. We have jurisdiction under 35 U.S.C.
§ 6(b).

We AFFIRM.

STATEMENT OF THE CASE

Appellants' invention is directed to a service design and order fulfillment system. Spec. ¶¶ 66–67. Claim 1, reproduced below, is representative of the claimed subject matter:

1. A non-transitory computer-readable medium having instructions stored thereon that, when executed by a processor, cause the processor to decouple a product offering from a fulfillment flow, the decoupling comprising:
 - defining the product offering comprising one or more product specifications, wherein each product specification comprises metadata that defines a product that is provided, and wherein the product offering further comprises metadata that defines one or more commercial attributes;
 - selecting a process logic at runtime from a set of selectable process logic;
 - generating a transformation sequence using the selected process logic;
 - dynamically generating a runtime process flow comprising a customized output based on the transformation sequence and the metadata;
 - mapping the one or more product specifications to one or more fulfillment patterns, wherein each fulfillment pattern comprises metadata that defines a set of one or more fulfillment functions and one or more dependencies;
 - generating a customer order comprising one or more customer order lines, wherein each customer order line comprises a product action and a product offering that is based on a product specification; and
 - fulfilling the customer order using a fulfillment flow based on the one or more fulfillment patterns mapped to the one or more product specifications, wherein the product offering is decoupled from the fulfillment pattern such that the product offering can be modified without modifying the fulfillment pattern.

App. Br. 17 (Claims Appendix).

REJECTIONS

Claims 1–20 stand rejected under 35 USC § 101 as being directed to patent-ineligible subject matter.

We review the appealed rejections for error based upon the issues identified by Appellants, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

ANALYSIS

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental

economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine 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.” *Alice*, 573 U.S. at 221 (quotation marks omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance* (“Memorandum”). Under that guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

(3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or

(4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See Memorandum.

The Examiner determines the claims are directed to generating and fulfilling a customer order, which is an idea of itself, and, therefore, abstract, similar to the claims in *Ultramerical, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014). Final Act. 3; Ans. 7. The Examiner further determines the claims are directed to parties entering into a specified agreement to perform certain services (e.g. fulfilling an order), which is a form of creating a contractual relationship and also an abstract idea, similar to the claims in *BuySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014). Final Act. 3–4; Ans. 7. Additionally, the Examiner determines the claims represent “functions performable by a human user, and effectively amount to little more than defining a product, selecting a software application, generating a customized output, mapping the product to a fulfillment pattern, generating a customer order and fulfilling the customer order,” similar to the claims in *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 Fed. Appx. 950, 955 (Fed. Cir. 2014) and *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011). Final Act. 4; Ans. 7.

Appellants argue the claims

are directed to a specific application of a distributed order orchestration system that, *inter alia*, defines the product offering comprising one or more product specifications,

wherein each product specification comprises metadata that defines a product that is provided, dynamically generates a runtime process flow comprising a customized output based on the transformation sequence and the metadata, maps the one or more product specifications to one or more fulfillment patterns, wherein each fulfillment pattern comprises metadata that defines a set of one or more fulfillment functions and one or more dependencies, and wherein the product offering is decoupled from the fulfillment pattern such that the product offering can be modified without modifying the fulfillment pattern.

App. Br. 5. According to Appellants,

[c]ontrary to the Examiner’s unsupported opinion, the claims recite numerous features that are not abstract. 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*. Therefore, the present claims recite patent eligible subject matter.

Id. at 6. Appellants also argue the claims are not similar to those in *Ultramercial*, *BuySAFE*, and *SmartGene*. *Id.* at 6–8. Additionally, Appellants argue “the claimed invention is clearly not directed to a process that a doctor or any other professional can and do perform in their heads” and “the recited claims cannot be performed manually, as elements such as ‘dynamically generating a runtime process flow comprising a customized output based on the transformation sequence and the metadata’ require a computer.” *Id.* at 9.

Appellants, however, do not persuasively argue why the claims are not directed to an abstract idea. For example, although Appellants argue “the claims recite numerous features that are not abstract,” Appellants do not direct our attention to what those features are or explain why they are not

abstract. Rather, Appellants have done little more than merely recite the claim language. We acknowledge Appellants' arguments that their invention is not directed to "using advertising as an exchange or currency," or "creating a transaction performance guaranty," like the claims in *Ultramercial* and *buySAFE* (App. Br. 6–8), respectively; however, the Examiner did not base the rejection on the theory that Appellants' claims were identical to the claims in those cases. Rather, the Examiner cited *Ultramercial* to support the broader proposition that courts have found certain methods of organizing human activity or claims directed to an idea of itself can constitute an abstract idea.

Nor have Appellants persuasively argued why generating and fulfilling a customer order, as identified by the Examiner, is not directed to an abstract idea. Independent claim 1 recites "defining the product offering . . .," "selecting a process logic . . .," "generating a transformation sequence . . .," "dynamically generating a runtime process flow . . .," "mapping the one or more product specifications to one or more fulfillment patterns . . .," "generating a customer order . . .," and "fulfilling the customer order using a fulfillment flow . . ." App. Br. 17. As Appellants state, "[o]rders are a primary mechanism to do business." Spec. ¶ 83. We fail to see why this sequence of steps for generating and fulfilling a customer order cannot properly be described as certain methods of organizing human activity, for example commercial or legal interactions, such as sales activities or behaviors or business relations, as identified in the Office Guidance. *See* Memorandum at 52.

We further agree with the Examiner that the claims are directed to a mental process, and, in that way, are similar to the claims recited in

SmartGene and *Cybersource*. See Final Act. 4; Ans. 7, 10. Appellants have not presented persuasive argument that the steps/limitations of the claims cannot be manually performed. Rather, the series of steps/limitations covered by the claims can be performed by humans without a computer. Cf. *CyberSource*, 654 F.3d at 1373; see also *Mortgage Grader, Inv. v. First Choice Loan Servs.*, 811 F.3d 1314, 1324 (Fed. Cir. 2015); see also *Elec. Power Grp. LLC v. Alstom*, 830 F.3d 1350, 1353-54 (Fed. Cir. 2016) (collecting information and “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, [are] essentially mental processes within the abstract-idea category.”). The mere mention of certain claimed computer components (e.g. “processor,” “process logic,” “runtime process flow,” “metadata,” “memory”) does not impose sufficiently meaningful limitations on claim scope beyond these mental steps. *CyberSource*, 654 F.3d at 1372–73, 1375; *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1318 (Fed. Cir. 2016).

In determining whether the claims are “directed to” the identified abstract ideas, we next consider whether the claims recite additional elements that integrate the judicial exception into a practical application. We discern no additional element (or combination of elements) recited in the claims that integrates the judicial exception into a practical application. See Memorandum at 54–55.

Appellants argue “[a]s in *Enfish*, the claimed invention is directed to an improvement in the functioning of a computer.” App. Br. 10. Specifically, Appellants argue improvements are provided by the decoupling of a product offering from a fulfillment flow. *Id.* at 15. Appellants further argue independent claims 1, 11, and 16 recite “dynamically generating a

runtime process flow comprising a customized output based on the transformation sequence and the metadata,” which “renders claims 1–20 as having significantly more than the abstract idea.” *Id.* at 13. Appellants also argue

The claims further recite *inter alia*, defining the product offering comprising one or more product specifications, wherein each product specification comprises metadata that defines a product that is provided, dynamically generating a runtime process flow comprising a customized output based on the transformation sequence and the metadata, mapping the one or more product specifications to one or more fulfillment patterns, wherein each fulfillment pattern comprises metadata that defines a set of one or more fulfillment functions and one or more dependencies, and wherein the product offering is decoupled from the fulfillment pattern such that the product offering can be modified without modifying the fulfillment pattern[,]

which “are meaningful limitations that add more than generally linking the use of the abstract idea . . . to the Internet, because they solve an Internet-centric problem with a claimed solution that is necessarily rooted in computer technology,” like the claims in *DDR Holdings, LLC v. Hotels.com, L.P., et al.*, 773 F.3d 245 (Fed. Cir. 2014). *Id.* at 14. According to Appellants, “the claimed invention addresses the Internet-centric processing of product offerings in a fulfillment flow.” *Id.* Appellants argue “[a]ssociating fulfillment logic with product specifications can allow a desirable proliferation of commercial offerings while minimizing changes to a fulfillment process.” *Id.* (citing Spec. ¶ 176); *see also* Reply Br. 3–4.

We are not persuaded by Appellants’ arguments and agree with the Examiner’s findings and conclusions. *See* Ans. 7–16. The claims do not constitute an improvement to the functioning of the computer; rather, they

merely adapt the abstract idea of generating and fulfilling an order to an execution of steps performed by a computer. *See id.* at 11. In other words, the claims are directed to the use of the computer merely as a tool to perform the order generation and fulfillment process. Appellants' arguments that the "improvements [are] provided by the decoupling of a product offering from a fulfillment flow" (App. Br. 15) and "[a]ssociating fulfillment logic with product specifications can allow a desirable proliferation of commercial offerings while minimizing changes to a fulfillment process" (App. Br. 15) support that the improvements are to the underlying abstract idea, using the computer merely as a tool, rather than improvements to the computer functionality itself, like the claims in *Enfish*. *See* 822 F.3d at 1336.

Nor are we persuaded by Appellants' arguments that the claims are rooted in computer technology, like the claims in *DDR Holdings*. *See* App. Br. 13–14. In *DDR Holdings*, the disputed claims solved an Internet-specific problem (i.e., third-party merchants luring a host website's visitor traffic away from the host website in response to clicking on a merchant's advertisement link displayed on the host site) with an Internet-based solution (i.e., generating a composite web page displaying product information from the third-party merchant, but retaining the host website's "look and feel") that was "necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks." *DDR Holdings*, 773 F.3d at 1257–1258.

That is not the case here. Appellants have not persuasively explained why the "processing of product offerings in a fulfillment flow" is an Internet-centric problem. *See* App. Br. 14. Rather, we agree with the Examiner that the claims address a business challenge (relating to generating

and fulfilling an order) that is not particular to the Internet or rooted in computer technology. *See* Ans. 15–16.

Therefore, we are not persuaded of error in the Examiner’s determination that the claims are directed to an abstract idea.

Turning to step 2 of the *Alice/Mayo* framework, we look to whether the claims (a) add a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field, or (b) simply append well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. Memorandum at 56.

In addition to arguments discussed above, Appellants further argue

[t]he present claims, as in *Bascom*, are indicative of “an inventive concept [that] can be found in the ordered combination of claim limitations that transform the abstract idea of filtering content into a particular, practical application of that abstract idea,” as indicated by the combination of elements being novel and non-obvious over the prior art.

App. Br. 13.

We are not persuaded by Appellants’ arguments and agree with the Examiner’s findings and conclusions. *See* Final Act. 5–8; Ans. 12–16. Although Appellants cite to *Bascom*, Appellants have not adequately explained how the claims are performed such that they are not routine, conventional functions of a generic computer. We agree with the Examiner that the additional technological elements in the claims, when considered both individually and as an ordered combination, are directed to generic computer components that perform well-understood, routine, and conventional functions. *See* Ans. 12–15.

Appellants' Specification supports this determination. *See, e.g.*, Spec. ¶ 67 (“Processor 22 may be any type of general or specific purpose processor”); *see also* Spec. ¶¶ 68–71, Fig. 1; *see also Electric Power*, 830 F.3d at 1355 (“Nothing in the claims, understood in light of the specification, requires anything other than off-the-shelf, conventional computer, network, and display technology for gathering, sending, and presenting the desired information.”).

In order for the addition of a machine to impose a meaningful limit on the scope of a claim, it must play a significant part in permitting the claimed method to be performed, rather than function solely as an obvious mechanism for permitting a solution to be achieved more quickly, i.e., through the utilization of a computer for performing calculations.

SiRF Tech., Inc. v. Int'l Trade Comm'n, 601 F.3d 1319, 1333 (Fed. Cir. 2010); *see also Bancorp Services, L.L.C. v. Sun Life Assur. Co. of Canada*, 687 F.3d 1266, 1277–78 (Fed. Cir. 2012). Specifically, we agree with the Examiner that “the claimed limitations merely amount to generic computer components, operating in a routine and conventional manner to automate human mental activities.” Ans. 15. Appellants have not persuasively rebutted the Examiner's findings.

Appellants also argue that similar to the claims in *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016), “the present claims are allowable over the prior art, so there is no evidence that the claimed process was previously used either manually, or using a computer.” App. Br. 10. Appellants further argue “as is clear from the lack of a prior art rejection, the present claims do not preempt all systems and methods for performing the abstract idea.” App. Br. 15.

To the extent Appellants maintain that the limitations of the claims necessarily amount to “significantly more” than an abstract idea because the claimed invention is allegedly patentable over the prior art, this argument is not persuasive. *See* Ans. 12. Although the second step in the Alice/Mayo framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, 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*, 573 U.S. 217–218. A novel and nonobvious claim directed to a purely-abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 89–91.

Appellants’ preemption argument is likewise unpersuasive of Examiner error. Although preemption “might tend to impede innovation more than it would tend to promote it, ‘thereby thwarting the primary object of the patent laws’” (*Alice*, 573 U.S. at 216 (citing *Mayo*, 132 S. Ct. at 1293)), “the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”).

Accordingly, for the foregoing reasons, we sustain the Examiner’s 35 U.S.C. § 101 rejection of claims 1–20.

DECISION

We affirm the Examiner’s 35 U.S.C. § 101 rejection of claims 1–20.

Appeal 2017-006099
Application 13/936,674

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