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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PATRICK J. ALLIN, MATEEN KHADIR,
and FRANCO TURRINELLI

Appeal 2017-006239
Application 13/833,249
Technology Center 3600

Before CARL W. WHITEHEAD JR., JEFFREY S. SMITH, and
AARON W. MOORE, *Administrative Patent Judges*.

WHITEHEAD JR., *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellants¹ are appealing the final rejection of claims 1–3, 5–7 and 9–27 under 35 U.S.C. § 134(a). Appeal Brief 5. We have jurisdiction under 35 U.S.C. § 6(b) (2012).

We affirm.

Introduction

The invention is directed to “[a] system . . . that provides a single dashboard that organizes and displays all invitations-to-bid that have been

¹ According to Appellants, the real party in interest is Oracle International Corporation. Appeal Br. 2.

received by a user from all of their various bid opportunity sources.”

Abstract.

Illustrative Claim

1. A system for managing invitations to bid on construction projects, the system comprising a processor and memory, the memory storing logic that, when executed by the processor, cause the system to:

transmit a first user interface to a first user terminal at which the first user interface is displayed to a first participant on a first display screen, the first user interface comprising a plurality of project opportunity identifiers and a selectable link for each of the project opportunity identifiers, wherein each project opportunity identifier identifies an opportunity for the first participant to respond to an invitation message, and the invitation message indicates that the first participant is requested to submit a bid package for a construction project,

wherein a project opportunity identifier included in the project opportunity identifiers identifies a first project opportunity corresponding to a first invitation message from a second participant requesting the first participant to submit a first bid package for a first construction project to be conducted by the second participant, wherein the first participant is a subcontractor and the second participant is a general contractor;

transmit a second user interface to the first user terminal at which the second user interface is displayed to the first participant on the first display screen, wherein the second user interface includes bid preference data;

receive automatic approval criteria data from the first user terminal, the automatic approval criteria data entered through the second user interface;

match the automatic approval criteria data with project data included in the first invitation message in response to receipt of the first invitation message through a third user interface or through a system external to the system for managing invitations;

determine that the first project opportunity satisfies the automatic approval criteria data for the first participant based on the match; and

transmit a notification to a second user terminal for the second participant, the notification indicating that the first participant will be submitting the first bid package for the first project opportunity in response to the determination that the first project opportunity satisfies the automatic approval criteria data.

Rejection on Appeal

Claims 1–3, 5–7, and 9–27 stand rejected 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. Final Action 10–11.

ANALYSIS

Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed September 19, 2016), the Reply Brief (filed January 30, 2017), the Examiner’s Answer (mailed November 30, 2016), and the Final Office Action (mailed April 20, 2016) for the respective details.

35 U.S.C. § 101 Rejection

The Supreme Court has set forth an analytical “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71–73 (2012)). In the first step of the analysis, we determine whether the claims at issue are “directed to” a judicial exception, such as an abstract idea. *Alice*, 134 S. Ct. at 2355. If not, the inquiry ends. *Thales*

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Visionix Inc. v. U.S., 850 F.3d 1343, 1346 (Fed. Cir. 2017); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016). If the claims are determined to be directed to an abstract idea, then we consider under step two whether the claims contain an “inventive concept” sufficient to “transform the nature of the claim into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (internal quotations and citation omitted).

Noting that the two stages involve “overlapping scrutiny of the content of the claims,” the Federal Circuit has described “the first-stage inquiry” as “looking at the ‘focus’ of the claims, their ‘character as a whole,’” and “the second-stage inquiry (where reached)” as “looking more precisely at what the claim elements add—specifically, whether, in the Supreme Court’s terms, they identify an ‘inventive concept’ in the application of the ineligible matter to which (by assumption at stage two) the claim is directed.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (internal citations omitted). In considering whether a claim is directed to an abstract idea, we acknowledge, as did the Court in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71.

Step One: Whether the Claims Are Directed to a Patent-Ineligible Concept (Abstract Idea)

The Examiner finds the claims are directed to an abstract idea because:

Applicant acknowledges that the claimed automated process of analyzing the invitation-to-bids to determine if the one or more invitation-to-bids matches a user’s defined criteria to automatically approve or reject the invitations and transmit notifications of approval or denial is in fact can be done by a

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human operator “as a part of human activity” related to the commercial practice of either accepting or rejecting an invitation-to-bid an opportunity.

Final Action 5.

Assuming the claims do involve the context of “prioritizing invitations-to-bid,” Appellants argue “the claims clearly do not monopolize all ways of performing this functionality. For example, over twenty (20) references were considered by the examiner and the examiner admitted that none of them teach or suggest the present claims.” Appeal Brief 8.

Appellants contend that, for example, “a system that is not configured to ‘transmit a notification to a second user terminal for the second participant, the notification indicating that the first participant will be submitting the first bid package for the first project opportunity’ could not infringe claim 1.” Appeal Brief 11. Appellants also argue the “existing technology (in other words, existing systems for managing invitations to bid on construction projects such as email-based systems) introduce problems with managing communication within a construction project, which the claims of the present application aim to solve.” Appeal Brief 16.

The Federal Circuit has repeatedly confirmed since *Alice* that the category of abstract ideas embraces “fundamental economic practice[s] long prevalent in our system of commerce,” including “longstanding commercial practice[s]” and “method[s] of organizing human activity.” *See, e.g., Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1313 (Fed. Cir. 2016) (internal quotations and citation omitted). Our reviewing court has explained that claims directed to “the mere formation and manipulation of economic relations” and “the performance of certain financial transactions” are properly held to be directed to abstract ideas. *Content*

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Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n, 776 F.3d 1343, 1347 (Fed. Cir. 2014); *see also, e.g., Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014) (finding computer-implemented system for “using advertising as a currency . . . [on] the Internet” to be ineligible); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1352, 1355 (Fed. Cir. 2014) (finding computer-implemented system for guaranteeing performance of an online transaction to be ineligible); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011) (finding computer-implemented system for “verifying the validity of a credit card transaction over the Internet” to be ineligible).

Also, our reviewing court has repeatedly held that information collection and analysis, including when limited to particular content, is within the realm of abstract ideas. *See, e.g., Elec. Power Grp.*, 830 F.3d at 1353 (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent-ineligible concept”); *Fair Warning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (claims directed to collecting information and analyzing it according to certain rules were directed to an abstract idea); *CyberSource*, 654 F.3d at 1370 (computer-implemented system for “verifying the validity of a credit card transaction over the Internet” was patent-ineligible).

We agree the Supreme Court has described “the concern that drives this exclusionary principle [, i.e., the exclusion of abstract ideas from patent eligible subject matter,] as one of pre-emption.” *Alice*, 134 S. Ct. at 2354. But characterizing pre-emption as a driving concern for patent eligibility is not the same as characterizing preemption as the sole test for patent eligibility. As our reviewing court has explained, “[t]he Supreme Court has

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made clear that the principle of preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice*, 134 S. Ct. at 2354). And although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Id.* Moreover, “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the [*Alice/Mayo*] framework . . . , preemption concerns are fully addressed and made moot.” *Id.*; see also *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 701 (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”).

As the Federal Circuit has explained, “[a] claim for a *new* abstract idea is still an abstract idea.” *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1163 (Fed. Cir. 2018) (*quoting Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016)). Even assuming the technique claimed was “innovative, or even brilliant,” that would not be enough for an abstract idea to be patent eligible. *Id.* (internal citation omitted).

Throughout the Briefs, Appellants cite various Patent Trial and Appeal Board rulings that are not designated as Precedential and, therefore, are not binding on this Panel. See Appeal Brief 13, 18; Reply Brief 2, *for example*. Appellants argue that, “[t]he claimed solution is not abstract because it satisfies the machine-or-transformation test.” Appeal Brief 13 (*citing Ex parte Krampe*, Appeal No. 2013-010784 (PTAB Mar. 31, 2016) (Non-Precedential)). Appellants contend that, “claim 1 is tied to at least one particular device, namely the first user terminal, the first display screen, and

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the second user terminal” and, “[t]herefore, claim 1 satisfies the first prong of the machine-or-transformation test and, consequently, is not abstract and does not require further analysis.” Appeal Brief 14. The Supreme Court, however, has held that “if a patent’s recitation of a computer amounts to a mere instruction to ‘implemen[t]’ an abstract idea ‘on . . . a computer,’ *Mayo*, [132 S. Ct. at 1301], that addition cannot impart patent eligibility.” *Alice*, 134 S. Ct. at 2358. Claim 1 merely uses generic computer components to implement the claimed solution, and tying the abstract idea to generic components does not make it patent eligible.

Appellants further argue, “the Office Action’s assertion that the claims are directed to an ‘abstract idea’ is not properly supported.” Appeal Brief 19. Appellants contend the Office Action:

[F]ails to show that this assertion relies on “knowledge generally available to those in the art, on the case law precedent, on Appellant’s own disclosure, or on evidence” as required by the Supplemental Guidance (p. 6). Instead, the Office Action asserts that paragraph [0042] of the publication of the application is an acknowledgement by the Appellant that “the claimed process” can be performed by a human. (Office Action, p. 5.)

Appeal Brief 20 (emphasis omitted).

The Federal Circuit has repeatedly noted that “the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). The court has, thus, held that the Office carries its procedural burden of establishing a prima facie case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for rejection, “together with such information and references as may be useful in judging of the propriety of

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continuing the prosecution of [the] application.” *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (internal quotations and citation omitted).

Accordingly, we agree with the Examiner, at step one of the *Alice* analysis, that the claims are directed to one or more abstract ideas. Accordingly, we turn to the second step of the *Alice* analysis, in which we determine whether the additional elements of the claims transform them into patent-eligible subject matter.

Step Two: Whether Additional Elements Transform the Idea into Patent-Eligible Subject Matter

The Examiner finds:

[T]he concept of [] prioritizing invitations-to-bid to a user/sub-contractor from a general contractor based upon the user defined criteria and if the invitations-to-bid requirement match with the user defined criteria provide notification of approval or denial is itself a fundamental form of human activity and the use of computing devices amount to mere generic use of computers in performing generic computer functions, as analyzed supra.

Final Action 10.

Appellants contend, “even assuming for the pure sake of argument that the pending claims are directed to an abstract idea, the claims still recite patentable subject matter under 35 USC § 101 because the claims include ‘significantly more’ as required under the second step of the analysis set forth in the Interim Guidance.” Appeal Brief. 25. Appellants argue, “[c]laim 1 contains an ‘inventive concept’ in its ordered combination of limitations because the combination is not found in the prior art.” Appeal Brief 26. Appellants further argue, “[f]urthermore, the specific details recited in the claims qualify as the required ‘something more’ because the details define an improvement over existing invitations-to-bid systems.”

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Appeal Brief 28. As we stated above, novelty is not enough for the claimed abstract idea to be patent eligible. *See SAP Am.*, 898 F.3d at 1163 (internal citation omitted).

Appellants contend, “[j]ust because a claim may make use of a generic computer device does not automatically classify a claim ineligible for patent protection” as, [f]or example, the claims in DDR recited only generic data storage devices and computer processors, but these claims were still held to recite patentable-eligible subject matter.” Appeal Brief 26. Appellants conclude, “[a]ccordingly, like the claims in DDR and unlike the claims in Alice, the claims of the present application specify how interactions with devices (operated by participants) are carried out to achieve a result that overrides the conventional sequence of events.” Appeal Brief 26.

Appellants’ assertion that a claim reciting a general purpose computer device can be patent-eligible is not persuasive. We find Appellants’ claims are distinguished from those claims that our reviewing court has found to be patent eligible because the claims in those cases were found eligible by virtue of reciting technological improvements to a computer system. *See, e.g., DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1249, 1257 (Fed. Cir. 2014) (holding that claims reciting computer processor for serving “composite web page” were patent eligible because “the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks”). Appellant’s claims recite a business process performed on a conventional computer, not an improvement to the computer itself.

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We agree with the Examiner's findings that the claims do not amount to significantly more than the abstract idea itself. Accordingly, we sustain the Examiner's 35 U.S.C. § 101 rejection of claims 1-3, 5-7 and 9-27.

DECISION

The Examiner's 35 U.S.C. § 101 rejection of claims 1-3, 5-7 and 9-27 is affirmed.

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). *See* 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED