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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* RENEE M. DARRAGH, ADAM E. KENNEY, JOHN S. RYAN,  
JOSEPH W. KAYE JR., JEFFREY A. KESEK, SHILPA KOMMIDI, and  
BRANDON E. VARILONE

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Appeal 2017-06252  
Application 13/724,297<sup>1</sup>  
Technology Center 3600

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Before ALLEN R. MacDONALD, CARL W. WHITEHEAD JR., and  
NABEEL U. KHAN, *Administrative Patent Judges*.

KHAN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1–26. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> The Applicant is Camelot UK Bidco Limited and Appellants identify Thomson Reuters Global Resources as the real party in interest. App. Br. 2.

## BACKGROUND

### THE INVENTION

According to Appellants, the invention relates to “an automated computer implemented system and method that eliminates or at least reduces the possibility that rights associated with a piece of IP, such as a patent, trademark, patent application, and/or trademark application will be forfeited due to failure to pay a maintenance fee or annuity.” Abstr.

Exemplary independent claim 1 is reproduced below.

1. An automated computer implemented method comprising:  
identifying a time period;

generating a set of payment questions for which at least some of a set of payment answers are due and are associated with the time period, the set of payment questions being associated with a set of intellectual property;

identifying a subset of payment questions of the set of payment questions, the subset of payment questions being associated with a subset of intellectual property of the set of intellectual property and a subset of payment answers affirmatively indicating a desire to prevent the subset of intellectual property from lapsing;

generating an electronic non-transitory signal indicative of the set of payment questions, the electronic non-transitory signal being characterized in that the electronic non-transitory signal prohibits entry of an instruction permitting the lapsing of a piece of intellectual property from the subset of intellectual property and the electronic non-transitory signal requests a second subset of payment answers associated with a second subset of payment questions, the second subset of payment questions being associated with a second subset of intellectual property, the subset of intellectual property being mutually exclusive from the second set of intellectual property; and

transmitting the electronic non-transitory signal.

#### REFERENCES AND REJECTIONS

1. Claims 1–26 stand rejected under 35 U.S.C. § 101. Final Act. 7–12.
2. Claims 1–10 and 14–23 stand rejected under 35 U.S.C. § 102(b) as anticipated by Grainger (WO 02/43306 A2, May 30, 2002). Final Act. 12–18.
3. Claims 11–13 and 24–26 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Grainger, Gunning (US 2009/0133027 A1, May 21, 2009) and Zee (US 2002/0178015 A1, Nov. 28, 2002). Final Act. 19–24.
4. Claims 1–26 stand rejected under 35 U.S.C. § 112, first paragraph (pre-AIA) for failing the written description requirement. Ans. 2–3.
5. Claims 1–26 stand rejected under 35 U.S.C. § 112, second paragraph (pre-AIA) as being indefinite. Ans. 3.

#### DISCUSSION

##### REJECTION UNDER 35 U.S.C. § 101

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “long held that this provision 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 *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). The Supreme Court in *Alice* reiterated the two-step framework previously

set forth 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. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. The Court acknowledged 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. We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016). If the claims are not directed to an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination,’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78–79).

#### *Step One of Alice/Mayo Framework*

Under the first step of the *Alice/Mayo* framework, the Examiner finds the claims are directed to a “method for scheduling and making annuity and maintenance payments on intellectual property portfolios,” which the Examiner finds is an abstract idea falling in the categories of a fundamental economic practice, a method of organizing human activities, and a method that can be performed by mental processes. Final Act. 8. The Examiner additionally finds the claims abstract because they are directed to

“generating tasks based on rules to be completed upon the occurrence of an event” or to “comparing and stored [sic] information and using rules to identify options.” Final Act. 9 (citing *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336 (Fed. Cir. 2013); *Smartgene, Inc. v. Advances Biological Labs., SA*, 555 Fed. Appx. 950 (Fed. Cir. 2014)).

Appellants argue that by characterizing the claims as “scheduling and making payment of annuity an[d] maintenance fees” (App. Br. 8 (quoting Final Act. 10)) the “Examiner has oversimplified the claim and its limitations” (App. Br. 8). Instead, Appellants describe their invention as “focus[ing] on an automated computer implemented method and an annuity management system for ensuring pieces of IP does not mistakenly become abandoned.” App. Br. 8. Appellants also argue the claims are directed to an improvement of existing technology that addresses technical problems and prevents IP lapsing due to a mistake. App. Br. 8.

We are unpersuaded by Appellants’ arguments and instead agree with the Examiner’s finding that the claims are directed to the abstract idea of “scheduling and making annuity and maintenance payments on intellectual property portfolios.” Final Act. 8. Appellants’ own characterization of the claimed invention, as “an automated computer implemented method and an annuity management system for ensuring pieces of IP does not mistakenly become abandoned” supports the Examiner’s finding that the claims are directed to an abstract idea. For example, “ensuring pieces of IP does not mistakenly become abandoned,” as Appellants characterize their invention, is consistent with the Examiner’s finding that the claims are directed to “scheduling and making annuity and maintenance payments on intellectual property portfolios.” Further the fact that the method is “automated” or

“computer implemented” is not, on its own, sufficient to indicate the claims are patent eligible. *See Alice*, 134 S. Ct. at 2358 (“[I]f a patent’s recitation of a computer amounts to a mere instruction to ‘implemen[t]’ an abstract idea ‘on . . . a computer,’ . . . that addition cannot impart patent eligibility”); *see also OIP Techs. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (“relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible”).

Although Appellants contend the claims are directed to improvements in existing technology or that they address technical problems, Appellants description of the problem addressed by their invention, that of managing large IP portfolios so as to prevent the lapse of IP due to a mistake (*see* App. Br. 9), is not technical in nature. And the claimed solution of an automated computer implement method for “prohibit[ing] entry of an instruction permitting the lapsing of a piece of intellectual property” is, as the Examiner finds, directed to a method of organizing human activity rather than a technical improvement.

#### *Step Two of Alice/Mayo Framework*

Under step two the Examiner finds claims 1–13 “do not include any additional elements to add structure to the claimed invention.” Final Act. 10. As for claims 14–26, the Examiner finds these claims “include the additional elements of a processor and a memory” but that these “elements serve to perform generic computer functions such as data gathering and storing, display, and transmission . . . .” Final Act. 10–11. Thus, the Examiner finds the claims do not offer “significantly more” than the abstract idea. Final Act. 11.

Appellants analogize the claims to those in *Diamond v. Diehr*, 450 U.S. 175 (1981) and argue the claims are directed to significantly more because they involve the “input of data and performance of a calculation of that data by a computer to transform a patent ineligible abstract idea into a patent eligible application of that idea.” App. Br. 11.

We disagree. The fact that the claims require inputting of data and performance of calculations on that data is not sufficient to transform the claim to something significantly more than an abstract idea. Indeed claims that involve the collection of data and subsequent analysis of that data, similar to Appellants’ characterization here about their own claims, have been found by the Federal Circuit to be patent ineligible. *See Electric Power Group, LLC, v. Alstom*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (“The focus of the asserted claims . . . is on collecting information, analyzing it, and displaying certain results of the collection and analysis.”)

Accordingly, we sustain the Examiner’s rejection of claims 1–26 under 35 U.S.C. § 101.

#### REJECTION UNDER 35 U.S.C. §§ 102 AND 103

The Examiner finds Grainger teaches or suggests an “electronic non-transitory signal prohibits entry of an instruction permitting the lapsing of a piece of intellectual property.” Final Act. 14 (emphasis omitted). Specifically, the Examiner finds Grainger discloses an annuity management system that allows the user to select via certain user interface fields, options to instruct the system to pay the annuity or maintenance fee for intellectual property. Final Act. 12–15. By allowing the user to “pay the fee,” the Examiner finds Grainger teaches prohibiting the entry of an instruction permitting the lapsing of a piece of IP. Final Act. 15.

Appellants argue that “the ability to pay an annuity fee is [not] analogous to a prohibited instruction that is intended to prevent the lapsing of a set of intellectual property.” App. Br. 13. Appellants indicate that Grainger gives the user options to either “pay the fee, *not pay the fee* or put the decision on hold until a later date.” App. Br. 13 (quoting Grainger ¶ 153). According to Appellants, the ability of the system to not pay the fee demonstrates that Grainger’s system allows the IP to lapse by not paying the fee. App. Br. 13.

We are persuaded by Appellants’ arguments. The Examiner relies on paragraph 153 of Grainger as teaching that Grainger “prohibits entry of an instruction permitting the lapsing of a piece of intellectual property.” Final Act. 14–15. Paragraph 153 of Grainger states that “the client system can select via fields 1838 to pay the fee, not pay the fee or put the decision on hold until a later date.” We agree with the Appellants that the ability to pay a fee is not analogous to prohibiting entry of an instruction permitting the lapsing of a piece of intellectual property. Although selecting the “pay the fee” option will lead to the payment of maintenance fees and thus prevent IP from lapsing, there is no evidence that it will prevent the entry of an instruction to not pay the maintenance fee. In other words, the user appears to still be able to select the do not pay option even after selecting the pay option, thus allowing for inadvertently missing payment.

Accordingly, we do not sustain the Examiner’s rejection of claims 1–10 and 14–23 under 35 U.S.C. § 102. For the same reasons, we also do not sustain the Examiner’s rejection of dependent claims 11–13 and 24–26 under 35 U.S.C. § 103, which were made on the same basis. *See* Final Act. 19.

REJECTION UNDER 35 U.S.C. § 112

The Examiner finds “there is no support in the original disclosure” for the recitation of “non-transitory signals.” Ans. 3–4. Therefore, the Examiner finds, the Appellants did not have possession of the invention as claimed and have not satisfied the written description requirement of 35 U.S.C. § 112. Further the Examiner finds that the term “non-transitory signal” is contradictory because “non-transitory” refers to tangible media and not propagating signals. Ans. 4–5. The Examiner, therefore, finds the term “non-transitory signal” would not be readily understood by the ordinary artisan and is thus indefinite under 35 U.S.C. § 112.

Appellants point to the Specification’s disclosure of the Annuity Management System being comprised of a processor, memory, as well as a communication bus and database, as providing “a written description of how to generate, store and transmit an ‘electronic non-transitory signal’ . . . .” Reply Br. 3–4. Based on this description, Appellants also argue that one of ordinary skill in the art would have understood the term “non-transitory signal.”

We are unpersuaded by Appellants’ arguments. Claim 1, for example, recites “generating an electronic non-transitory signal” and “transmitting the electronic non-transitory signal.” Thus, as claimed, the electronic signal appears to be a propagating electronic signal capable of transmission. This is supported by Appellants’ citations to the Specification summarizing the claimed subject matter, describing the transmission of the electronic signal as sending an extraction file via email or other technique. *See* App. Br. 4 (citing Spec. 10:19–25; 11:19–23). One of ordinary skill in the art would understand such a signal to be transitory. Thus, we agree that one of

ordinary skill in the art would not be able to discern from the claimed language the meaning and bounds of the term “non-transitory signal.”

Similarly, we agree with the Examiner that the Specification does not support the recitation of non-transitory signals. The disclosure of a processor, memory, communication bus, and database would not be understood by one of ordinary skill in the art as describing non-transitory signals. Memory itself is non-transitory, but it is not understood to be a signal. Similarly, signals transmitted over the communication bus would be considered transitory rather than non-transitory.

Accordingly, we sustain the Examiner’s rejection of claims 1–26 under 35 U.S.C. § 112, first and second paragraphs.

#### DECISION

The Examiner’s rejection of claims 1–26 under 35 U.S.C. § 101 is affirmed.

The Examiner’s rejection of claims 1–10 and 14–23 under 35 U.S.C. § 102(b) is reversed.

The Examiner’s rejection of claims 11–13 and 24–26 under 35 U.S.C. § 103(a) is reversed.

The Examiner’s rejection of claim 1–26 under 35 U.S.C. § 112, first paragraph is affirmed.

The Examiner’s rejection of claim 1–26 under 35 U.S.C. § 112, second paragraph is affirmed.

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

AFFIRMED