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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK DUQUETTE, SRI VYTHESWARAN, and
KEVIN J. WILLIAMS

Appeal 2017-006441
Application 13/483,337¹
Technology Center 3600

Before JAMES R. HUGHES, JOHN D. HAMANN, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

McNEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–12 and 14–21, which are all the claims pending in this application. Claim 13 is canceled. App. Br. 23. 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. App. Br. 3.

STATEMENT OF THE CASE

Introduction

Appellants' application relates to estimating a new project schedule based on user-provided high level parameters and historic project data.

Spec. ¶ 2. Claims 1 and 9 illustrate the appealed subject matter and read as follows:

1. A computer implemented method for generating a product development schedule comprising:

one or more computers, comprising at least one processor executing program instructions of a non-transitory storage medium, maintaining a data warehouse for historic projects, wherein said data warehouse comprises a plurality of different artifacts per project, human and organizational resources consumed while producing each of the different artifacts, inter-artifact temporal dependencies, and timelines for producing each of the artifacts;

one or more computers, comprising at least one processor executing program instructions of a non-transitory storage medium, receiving a set of parameters for a new project, wherein said parameters define a scope of the new project at a level of abstraction above an artifact level;

one or more computers, comprising at least one processor executing program instructions of a non-transitory storage medium, establishing without a user intervention a set of key artifacts and stages needed for completing the new project, where the set of key artifacts and stages are consistent with the set of parameters;

one or more computers, comprising at least one processor executing program instructions of a non-transitory storage medium, determining a set of at least two historic projects having data that is maintained in the data warehouse, wherein the at least two historic projects have at least one artifact similar to one of the key artifacts or have at least one stage similar to one of the stages of the new project, wherein similarity determination is

based on metadata associated with the set of at least two historic projects;

one or more computers, comprising at least one processor executing program instructions of a non-transitory storage medium, evaluating without the user intervention each historic artifact and historic stage associated with the set of at least two historic projects to determine an approximate timeline for the key artifacts and the stages for the new project; and

one or more computers, comprising at least one processor executing program instructions of a non-transitory storage medium, generating a schedule for the new project, wherein the schedule breaks down the new project by the stages and the key artifacts and provides the estimated timeline.

9. A computer implemented method for generating a project schedule comprising:

one or more computers, comprising at least one processor executing program instructions of a non-transitory storage medium, receiving a set of high level parameters as user input for a new project;

one or more computers, comprising at least one processor executing program instructions of a non-transitory storage medium, querying a data warehouse maintaining records for a plurality of historic projects to determine a subset of the historic projects having statistically defined similarities to the new project, said similarities being based on a correspondence between the set of high level parameters and details of the subset of the historic projects;

one or more computers, comprising at least one processor executing program instructions of a non-transitory storage medium, generating a schedule for the new project having a plurality of stages, wherein a plurality of artifacts are to be generated in the stages, wherein the stages and the artifacts are not defined by the user input, the high level parameters, or by any other manual input entered for the new project, wherein the stages and artifacts are heuristically determined from specifics

maintained in the data warehouse for the subset of historic projects, wherein the schedule details timelines for each of the stages and artifacts, wherein said timelines are heuristically determined in a data driven manner from data of the subset of historic projects.

The Examiner's Rejections

Claims 1–8, 10, and 18 stand rejected under 35 U.S.C. § 112(b) or pre-AIA 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventors regard as the invention. Final Act. 2–3.

Claims 1–12 and 14–21 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 3–4.

Claims 1–3, 5, 9–11, 15, and 21 stand rejected under 35 U.S.C. § 103 as unpatentable over Gordon et al. (US 2013/0024231 A1; Jan. 24, 2013), Carlson et al. (US 2013/0132440 A1; May 23, 2013), Kayahara et al. (US 2005/0278209 A1; Dec. 15, 2005), and Richardson et al. (US 7,069,229 B1; June 27, 2006). Final Act. 3–25.

The Examiner adds Thywissen (US 2008/0235155 A1; Sept. 25, 2008) to reject claim 4 (Final Act. 25–26); O’Cull et al. (US 2006/0200372 A1; Sept. 7, 2006) to reject claims 6–8 (Final Act. 27–29); Hirano et al. (US 2004/0128189 A1; July 1, 2004) to reject claim 12 (Final Act. 29–30); Sparago et al. (US 7,350,185 B2; Mar. 25, 2008) to reject claim 14 (Final Act. 30); Bugayenko (US 2011/0196798 A1; Aug. 11, 2011) to reject claim 16 (Final Act. 31); Yurekli et al. (US 2008/0066072 A1; Mar. 13, 2008) to reject claim 17 (Final Act. 32); Ugai (US 2008/0027927 A1; Jan. 31, 2008) to reject claim 18 (Final Act. 33–34); and Cantor et al. (US 2009/0299782 A1; Dec. 3, 2009) to reject claims 19 and 20 (Final Act. 34–37).

Claims 1–12 and 14–21 stand provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 18 and 21–38 of co-pending Application No. 13/401,913. Final Act. 38.

ANALYSIS

Indefiniteness

Appellants do not argue the Examiner erred in rejecting claims 1–8, 10, and 18 under 35 U.S.C. § 112(b) as indefinite. App. Br. 11. Instead, Appellants proposed an amendment to claim 1 concurrently with the Appeal Brief to address the indefiniteness rejection. *Id.* The Examiner did not enter the proposed amendment. September 2, 2016 Advisory Action. Accordingly, the claims stand as rejected under 35 U.S.C. § 112(b). We, therefore, summarily sustain the indefiniteness rejection of claims 1–8, 10, and 18.

Patent-Ineligible Subject Matter

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. 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. Assuming that a claim nominally falls within one of the statutory categories of machine, manufacture, process, or composition of matter, the first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* For example, abstract ideas include, but are not limited to, fundamental economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Id.* at 2355–57. If the claim is directed to a judicial exception, such as an abstract idea, the second step is to determine whether additional elements in the claim “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* at 2355 (quoting *Mayo*, 566 U.S. at 78). This second step is described as “a search for an “‘inventive concept’”—*i.e.*, an element or combination of elements that is ‘. . . significantly more than . . . the [ineligible concept] itself.’” *Id.* (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

Alice Step One

“[T]he first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016). “The abstract idea exception prevents patenting a result where ‘it matters not by what process or machinery the result is accomplished.’” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *O’Reilly v. Morse*, 56 U.S. 62 (1853)). “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.” *McRO*, 837 F.3d at 1314.

Appellants argue the Examiner’s rejection under 35 U.S.C. § 101 is unclear because it appears that two different and distinct abstract ideas are presented. App. Br. 11. The Examiner finds claim 1 is directed to the abstract ideas of project schedule modeling, comparing new and stored information, and using rules to identify options. Final Act. 3. Appellants’ argument that the Examiner erred is unpersuasive because combining several abstract ideas does not render the combination any less abstract.

RecogniCorp, LLC v. Nintendo Co., 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“Adding one abstract idea . . . to another abstract idea . . . does not render the claim non-abstract.”); *see also FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (determining the pending claims were directed to a combination of abstract ideas).

Appellants do not provide any other argument regarding the “abstract idea” prong of the *Alice* test. Accordingly, Appellants have not persuaded us the Examiner erred in finding claim 1 is directed to an abstract idea.

Alice Step Two

The second step in the *Alice* analysis requires a search for an “inventive concept” that “must be significantly more than the abstract idea itself, and cannot simply be an instruction to implement or apply the abstract idea on a computer.” *Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349 (Fed. Cir. 2016). There must be more than “computer functions [that] are ‘well-understood, routine, conventional

activit[ies]’ previously known to the industry.” *Alice*, 134 S. Ct. at 2359 (second alteration in original) (quoting *Mayo*, 566 U.S. at 73).

Appellants argue the claims are directed to an improvement to the technical field of generating schedules for computing projects and, therefore, amount to “significantly more” than an abstract idea. App. Br. 11–13.

Appellants argue the claimed process generates a new artifact, a project schedule estimate, that did not exist prior to the execution of the claimed steps. *Id.* at 12. Appellants argue only situations where no new artifact has been created have been found to be ineligible under 35 U.S.C. § 101.

Appellants have not persuaded us of Examiner error. Claim 1 is generally directed to a computer implemented method for generating a product development schedule. The method includes maintaining a data warehouse that stores data on historic projects. The method also includes receiving data regarding a new project and comparing the received data to similar historic projects in the data warehouse. The data regarding the historic projects is used to determine an approximate timeline for the new project and that timeline is used to generate a schedule for the new project.

Thus, claim 1 recites a business method for generating a product development schedule using historic project data. The computer limitations in claim 1 are merely tools to achieve this method. The Federal Circuit in *DDR Holdings* found claims necessarily rooted in computer technology to be patent eligible, but issued a relevant warning:

We caution, however, that not all claims purporting to address Internet-centric challenges are eligible for patent. For example, in our recently-decided *Ultramercial* opinion, the patentee argued that its claims were “directed to a specific method of advertising and content distribution that was previously unknown and never employed on the Internet before.” But this

alone could not render its claims patent-eligible. In particular, we found the claims to merely recite the abstract idea of “offering media content in exchange for viewing an advertisement,” along with “routine additional steps such as updating an activity log, requiring a request from the consumer to view the ad, restrictions on public access, and use of the Internet.”

DDR Holdings, LLC v. Hotels.com, L.P., 773 F.3d 1245, 1258 (Fed. Cir. 2014) (citations omitted).

The claims in *DDR Holdings* addressed a problem unique to the Internet in a manner that was “not merely the routine or conventional use of the Internet.” *Id.* at 1259. In particular, rather than the expected behavior of simply sending the website visitor to a third-party website, the claimed invention behaved in a manner different than expected by sending a website visitor to a hybrid web page presenting information from a third-party with the look and feel of the host website. *Id.* at 1258–59. In contrast, Appellants have not identified any unconventional behavior by the recited computer limitations in claim 1. Instead, claim 1 recites using conventional computer techniques such as retrieving data from a database, comparing data, and making determinations based on these comparisons. The nature of claim 1 as a whole is not to define a specific technological improvement, but to recite the steps necessary to perform the abstract idea itself. Claim 1 employs “generic processes and machinery” to achieve results, and is not focused on “a specific means or method that improves the relevant technology.” *McRO*, 837 F.3d at 1314.

Appellants’ argument that the claims generate a new artifact and, therefore, cannot be patent ineligible is also unpersuasive. Appellants have not cited (*see* App. Br. 11–13), nor have we found, any case that states that a

method that creates a new artifact is automatically patent eligible. To the contrary, other cases have found claims that created new “artifacts” (such as a product development schedule here or the financing packages in *Credit Acceptance*) to be patent-ineligible. Accordingly, we are not persuaded by Appellants’ argument.

Our reviewing court has also “made clear that mere automation of manual processes using generic computers does not constitute a patentable improvement in computer technology.” *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017). Like the claims in *Credit Acceptance*, the focus of the claims is on the business practice, “and the recited generic computer elements ‘are invoked merely as a tool.’” *Id.* (citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016)); *see also Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1334 (Fed. Cir. 2015) (collecting cases).

Appellants also argue the “numerous” references cited against the claims in the prior art rejections show the claims recite limitations that improve upon conventional systems in a meaningful way. App. Br. 13. Although the second step of the *Alice* 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 Corp.*, 134 S. Ct. at 2355. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 89–90. Accordingly, even if the claims were not rejected as obvious (which is not the case here where the claims stand rejected as obvious under 35

U.S.C. § 103), the claims could nonetheless be directed to patent-ineligible subject matter. Appellants' argument is, therefore, unpersuasive.

For these reasons, we agree with the Examiner that the claims do not recite an "inventive concept" sufficient to transform the claims from an abstract idea to a patent eligible application. We, therefore, sustain the patent-ineligible subject matter rejection of claim 1. We also sustain the rejection of independent claims 9 and 21, for which Appellants provide no separate argument. *See* App. Br. 11–13; Reply Br. 2–3. We also sustain the rejection of dependent claims 2–8, 10–12, and 14–20, for which Appellants provide no separate argument. *See id.*

Obviousness

Claim 1

The Examiner finds Gordon teaches

determining a set of at least two historic projects having data that is maintained in the data warehouse, wherein the at least two historic projects have at least one artifact similar to one of the key artifacts or have at least one stage similar to one of the stages of the new project, wherein similarity determination is based on metadata associated with the set of at least two historic projects.

Final Act. 6–7.

Appellants argue the Examiner erred because Gordon teaches determining whether a project type for a received project matches a previously stored project and automatically determining tasks based on the project type. App. Br. 14. Appellants argue Gordon is silent regarding determining whether historic projects have at least one data artifact or stage similar to a new project based on metadata associated with the historic

projects, and any similarity determination is based solely on the project type.
Id.

The Examiner finds Gordon teaches using a historic project to estimate similar task duration in a new project and, therefore, teaches the recited “determining” step. Ans. 3 (citing Gordon ¶ 43). The Examiner finds the claimed “metadata” is merely “data that provides information about other data” and the historic task data is metadata because it provides information about historic projects. *Id.*

Appellants have persuaded us of Examiner error. The Examiner finds the historic projects, which are identified based on the project type in Gordon, have similar tasks to the current project. *See* Ans. 3. Although that may be true, the Examiner’s findings do not address the requirement that the “similarity determination is based on metadata associated with the set of at least two historic projects” where the similarity is between a historic project and the current project’s artifacts or stages.

We, therefore, do not sustain the obviousness rejection of independent claim 1. We also do not sustain the obviousness rejection of independent claim 21, which recites commensurate limitations, or dependent claims 2–8 and 20, which depend from claim 1.

Claim 9

Appellants argue the Examiner erred in finding Gordon teaches querying a data warehouse maintaining records for a plurality of historic projects to determine a subset of the historic projects having statistically defined similarities to the new project, said similarities being based on a correspondence between the set of high level parameters and details of the subset of the historic projects,

as recited in claim 9. App. Br. 17–18.

The Examiner notes the Specification does not define the term “statistically defined similarities” and concludes this term covers a similarity determined quantitatively. Ans. 5. The Examiner finds Gordon teaches the disputed limitation, including the statistically defined similarities, by disclosing comparing a project type for a new project against project types for historic projects to identify relevant tasks for the new project. *Id.* (citing Gordon ¶ 27).

Appellants argue the Examiner erred because Gordon is silent regarding “statistically defined similarities” between the new project and historic projects. We agree with Appellants that the Examiner has failed to establish that Gordon teaches the disputed limitation. The Examiner concludes “statistically defined similarities” includes “quantitatively” determining a similarity, but the Examiner has failed to explain how Gordon’s comparison of project type to project type teaches or suggests determination “based on a correspondence between the set of high level parameters and details of the subset of the historic projects.” In particular, if the project type is the “set of high level parameters,” as the Examiner seems to find, the Examiner has not identified any “details of the subset of the historic projects” as recited in claim 9.

Accordingly, even if the Examiner’s definition of “statistically defined similarities” is correct, the Examiner has failed to establish that Gordon teaches the disputed limitations. We, therefore, do not sustain the obviousness rejection of claim 9. We also do not sustain the obviousness rejections of claims 10–12 and 14–19, which depend directly or indirectly from claim 9.

Nonstatutory Double Patenting

Appellants have provided no argument regarding the Examiner's nonstatutory double patenting rejection. We, therefore, summarily sustain the nonstatutory double patenting rejection of claims 1–12 and 14–21.

DECISION

Because we have sustained at least one ground of rejection with respect to each claim on appeal, we affirm the decision of the Examiner rejecting claims 1–12 and 14–21. *See* 37 C.F.R. § 41.50(a)(1).

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED