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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* PATRICK J. ALLIN, CHARLES C. CHERRY, and  
WILLIAM H. EICHHORN

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Appeal 2017-007810  
Application 13/658,390  
Technology Center 3600

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Before CAROLYN D. THOMAS, JOSEPH P. LENTIVECH, and  
AARON W. MOORE, *Administrative Patent Judges*.

LENTIVECH, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellants<sup>1</sup> appeal from the Examiner's decision to reject claims 14–20. Claims 1–13 have been canceled. *See* App. Br. 17 (Claims App'x). We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm.

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

STATEMENT OF THE CASE

*Appellants' Invention*

Appellants' invention generally relates to “a computer-based method of managing documents.” Spec. ¶ 9. Claim 14, which is illustrative of the claimed invention, reads as follows:

14. A computer-based method of managing documents, the method comprising:

storing a list of a plurality of required documents in a project document requirement table of a database server, the list of required documents identifying a required document;

receiving the required document over a computer network from a first computer device and storing the required document in a memory of a construction payment management system;

causing, by the construction payment management system, a receive document notification to be displayed on a second computer device on the computer network, the receive document notification indicating the required document is available for download;

receiving, by the construction payment management system, an update to a status of the required document over the computer network from the second computer device;

withholding a payment associated with a payment request if the status of any of the required documents indicates any of the required documents is missing or expired; and

transmitting electronically, by the construction payment management system, payment instructions to a payment system if the statuses of the required documents indicate none of the required documents is missing or expired, wherein the payment instructions indicate the payment associated with the payment request is to be paid.

*Rejection*

Claims 14–20 stand rejected under 35 U.S.C. § 101 because the claimed subject matter is judicially-excepted from patent eligibility under § 101. Final Act. 2–5.

*Issue on Appeal*

Did the Examiner err in finding that claims 14–20 are directed to subject matter that is judicially-excepted from patent eligibility under § 101?

ANALYSIS

Appellants do not substantively argue claims 14–18 and 20 separately, but instead rely on the same arguments for these claims. In accordance with 37 C.F.R. § 41.37(c)(1)(iv), we select independent claim 14 as the representative claim. Remaining claims 15–18 and 20 stand or fall together with claim 14. Appellants present additional arguments for claim 19. App. Br. 11, 16. We address these arguments below under separate subheadings.

*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, 82–84 (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. *Id.* The inquiry often is whether the claims are directed to “a specific means or method” for improving technology or whether they are simply directed to an abstract end-result. *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016). If the claims are not directed to a patent-ineligible concept, 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). 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 invokes generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

#### CLAIM 14

##### Step 1

The Examiner finds claim 14 is directed to “managing documents” by “storing a list of documents; receiving [a] document, receiving [an] update, withholding a payment and transmitting payments.” Final Act. 3. The Examiner finds claim 14 is directed to an abstract idea because the recited

steps “can be performed manually or by a ‘processing system’ and is similar to the kind of ‘organizing human activity’ at issue in Alice Corp.” Final Act. 3. Additionally, the Examiner finds “[t]he claims are directed [to the] abstract idea of fundamental economic practice in *Alice*. The current claim is directed to [the] abstract idea of payment instructions indicat[ing] the payment associated with the payment request is to be paid, just like [the] abstract idea of mitigating settlement risk in *Alice*.” Ans. 2. The Examiner also finds:

In the current case, receiving document (i.e. collecting information), an update to a status of the required document (i.e. analyzing it) and transmitting payment instructions (i.e. displaying certain results of the collection and analysis), [is] just like collecting information, analyzing it, and displaying certain results of the collection and analysis in *Electric Power Group*. The claim [is] also directed to [the] abstract idea of certain methods of organizing human activity (*TLI Comms.*). The current claim is directed to [the] abstract idea of . . . identifying a required document (i.e. classifying digital images) and storing the required document in a memory of a construction payment management system (i.e. storing digital images in an organized manner).

Ans. 3 (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016); *In re TLI Communications LLC Patent Litigation*, 823 F.3d 1607 (Fed. Cir. 2016)).

Appellants contend claim 14 is not directed to an abstract idea. App. Br. 7–11; Reply Br. 2–5. Appellants argue the Examiner fails to consider the claim as a whole but, instead, only considers the preamble and the first few words of each of the recited limitations. App. Br. 8. Appellants argue “[w]hen considered as a whole with the other claim elements, claim 14 is

directed to a construction project management system that controls electronic instructions for payments.” App. Br. 8.

Claim 14 is directed to managing documents related to a construction process and controlling electronic instructions for payments based on managing the documents. The Specification describes the claimed method as a conventional business practice utilized by contractors and financial entities as part of residential and commercial construction projects. Spec. ¶¶ 2–8. As such, claim 14 is directed to a fundamental business practice and method of organizing human activity, long prevalent in our system of commerce. Like the risk hedging in *Bilski* (see *Bilski v. Kappos*, 561 U.S. 593 (2010)), the intermediated settlement in *Alice* (see *Alice*, 134 S. Ct. at 2356–57), verifying credit card transactions in *CyberSource* (see *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011)), collecting and analyzing information to detect and notify of misuses in *FairWarning* (see *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016)), and guaranteeing transactions (see *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1354 (Fed. Cir. 2014)), claim 14 is directed to an abstract idea.

Appellants’ argument that the claimed invention improves a technology or technical field arising in the realm of computer networks (App. Br. 8–10) is not persuasive because the mere application of an abstract idea on a computer system does not make a claimed invention patentable. See *Alice Corp.*, 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.”) (citations omitted). A claimed invention must embody a concrete solution to a

problem having “the specificity required to transform a claim from one claiming only a result to one claiming a way of achieving it.” *SAP Am., Inc. v. InvestPic, LLC*, 890 F.3d 1016, 1021–22 (Fed. Cir. 2018) (collecting cases).

Here, the recited limitations of: (1) “storing a list of a plurality of required documents”; (2) “receiving the required document”; (3) “causing . . . a receive document notification to be displayed”; (4) “receiving . . . an update to a status of the required document”; (5) “withholding a payment associated with a payment request if the status of any of the required documents indicates any of the required documents is missing or expired”; and (6) “transmitting . . . payment instructions to a payment system if the statuses of the required documents indicate none of the required documents is missing or expired” are the abstract concepts of collecting, storing, and analyzing information and transmitting a result of the collection and analysis. Information, as such, is intangible. *See Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 451 n.12 (2007). Information collection and analysis, including when limited to particular content, is within the realm of abstract ideas. *See, e.g., Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1349 (Fed. Cir. 2015); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011). Recitation, as in this case, of the collecting, storing, and analyzing information and transmitting a result of the collection and analysis is abstract absent a “specific improvement to the way computers [or other technologies] operate.” *Enfish*, 822 F.3d at 1336. It is clear, from the claim and the Specification, that the recited limitations require no improved computer

resources Appellants claim to have invented, just already available computers, with their already available basic functions, to use as tools in executing the claimed process.

Appellants contend claim 14 is akin to the claim at issue in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), in which claims addressing a business challenge (retaining website visitors) that is particular to the Internet were held patent-eligible. App. Br. 10–11. This argument is unpersuasive. Tracking and coordinating required documents on multiple computer devices and controlling transmission of electronic instructions for payments based on specific conditions are not business challenges particular to the Internet, or to any other technological area—the underlying ideas are for a business method that, as described in the Specification (¶¶ 2–8), may be performed by a human using pen and paper.

## Step 2

Turning to the second step of the analysis, the Examiner finds that the additional elements recited in the claims are not sufficient to amount to significantly more than the abstract idea. Final Act. 3–4. We find nothing in Appellants’ claims that adds anything “significantly more” to transform the abstract concepts of collecting, storing, and analyzing information and transmitting a result of the collection and analysis into a patent-eligible application. *Alice*, 134 S. Ct. at 2357. Limiting such an abstract concept to a general purpose computer having generic components does not make the abstract concept patent-eligible under 35 U.S.C. § 101. As recognized by the Supreme Court, “the mere recitation of a generic computer cannot transform a patent ineligible abstract idea into a patent-eligible invention.”

*See Alice*, 134 S. Ct. at 2358 (concluding claims “simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer” not patent eligible); *see also Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) (“[s]imply adding a ‘computer aided’ limitation to a claim covering an abstract concept, without more, is insufficient to render [a] claim patent eligible” (internal citation omitted)).

Appellants argue that “[c]laim 14 contains an ‘inventive concept’ in its ordered combination of limitations that are not found in the prior art” and “[t]hus claim 14 recites significantly more and is patent eligible under § 101.” App. Br. 12; *see also* App. Br. 13–14. Yet the Supreme Court has held that “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981). Thus, “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).

## CLAIM 19

### Step 1

Appellants argue:

Claim 19 further recites wherein the payment subject to hold notification comprises a link selectable to review the status of any of the required documents. Claim 19 further cites “a link” selected to review a status. This is [sic] adds to the solution of claim 14 similar to the patent eligible claim from DDR. DDR recites “a host web page having a link correlated with a

commerce object.” Thus claim 19 recites is patent eligible under § 101 for similar reasons as DDR.

App. Br. 11.

We disagree. Appellants’ argument overlooks that the argued “solution” must be a technical solution. Appellants’ argument does not explain how either the problem or solution are technical. Unlike the claims at issue in cases such as *DDR* (claims at issue are “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks” (*DDR*, 773 F.3d at 1257)) and *Enfish* (claims at issue are “directed to a specific implementation of a solution to a problem in the software arts” (*Enfish*, 822 F.3d at 1339)), Appellants’ claims merely address a business issue through the use of generic, computer-related recitations that do not add meaningful limitations to steps otherwise directed to an abstract idea.

## Step 2

Regarding the second step of the analysis, Appellants repeat the arguments provided with respect to the first step of the analysis. App. Br. 16. We find these arguments unpersuasive for the reasons discussed *supra*.

## CONCLUSION

Because Appellants’ claims 14–20 are directed to a patent-ineligible abstract concept, and do not recite something “significantly more” under the second prong of the *Alice* analysis, we sustain the Examiner’s rejection of these claims under 35 U.S.C. § 101.

Appeal 2017-007810  
Application 13/658,390

DECISION

We affirm the Examiner's rejection of claims 14–20 under 35 U.S.C. § 101.

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