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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 MAJEED M. ARNI, PETER A. COLDICOTT,
EDUARDO T. KAHAN, and MEI Y. SELVAGE

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Appeal 2017-008357
Application 12/502,010
Technology Center 3600

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Before JOHN A. JEFFERY, DENISE M. POTHIER, and
JUSTIN BUSCH, *Administrative Patent Judges.*

POTHIER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants[1,2] appeal under 35 U.S.C. § 134(a) from the Examiner's

decision to reject claims 1, 3, 5, 11, 13, 16, 23, 24, and 26–34. App. Br.

9–17. Claims 2, 4, 6–10, 12, 14, 15, 17–22, and 25 have been canceled as

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[1] Throughout this opinion, we refer to (1) the Final Office Action (Final
Act.) mailed September 16, 2016, (2) the Appeal Brief (App. Br.) filed
December 9, 2016, (3) the Examiner's Answer (Ans.) mailed April 7, 2017,
and (4) the Reply Brief (Reply Br.) filed May 18, 2017.
[2] The real party in interest is listed as International Business Machines
Corporation. App. Br. 2.

indicated in the Final Action. Final Act. 2. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Invention

Appellants' invention "relates . . . to a method associated with the governance or governance flow for a service oriented architecture (SOA)." Spec. ¶ 2; *see also id.*, Abstract.

Illustrative claim 1 is reproduced below:

1.   A method for establishing a governance procedure configured for providing governing services of a service oriented architecture (SOA) and deploying a first archive file configured to provide multiple different SOA governance flows, the method comprising the steps of:

a computer providing, for use by a user, a template in a virtual machine, wherein the template comprises first and second software components, wherein the first software component represents a first plurality of tasks, and wherein the second software component represents a second plurality of tasks, and further wherein the first and second plurality of tasks govern the services of the SOA by defining an SOA governance flow, and still further wherein the first plurality of tasks are optional and selectable by the user, and wherein the second plurality of tasks are not modifiable by the user and define mandatory SOA governance processes;

the computer producing a first implementation of the SOA governance flow responsive to the computer receiving a user selection of a first one of the first plurality of tasks, wherein the first implementation includes the second plurality of tasks and the first one of the first plurality of tasks;

the computer producing a second implementation of the SOA governance flow responsive to the computer receiving a user selection of a second one of the first plurality of tasks, wherein the second implementation includes the second

plurality of tasks and the second one of the first plurality of tasks;

the computer providing the first implementation of the SOA governance flow and the second implementation of the SOA governance flow in the first archive file;

the computer constructing a second archive file that includes a custom implementation of a customized task of the SOA governance flow, wherein the customized task is different from the first plurality of tasks, and wherein the first archive file is configured to call a process of the custom implementation through the second archive file; and

the computer deploying the first archive file to provide a customized service for the user using the SOA.

The Rejection

Claims 1, 3, 5, 11, 13, 16, 23, 24, and 26–34 are rejected under 35 U.S.C. § 101. Final Act. 3–9.[3]

CONTENTIONS

The Examiner finds the claims are "directed towards establishing a governance procedure, which is consider an idea 'of itself' and thus an abstract idea." Final Act. 6. The Examiner further states the claims do not include additional elements that amount to significantly more than the abstract idea. *Id.* The Examiner determines the claims do not (1) improve another technology or technical field, or the functioning of a computer itself

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[3] Notably, the Examiner rejects all pending claims under 35 U.S.C. § 101 as being directed to judicially excepted, patent-ineligible subject matter and separately rejects claims 11, 13, 27, and 30 under § 101 as being directed to non-statutory subject matter. Also, the rejection of claims 1, 3, 5, 11, 13, 16, 23, 24, and 26–34 under 35 U.S.C. § 112, first paragraph (Final Act. 10–12) has been withdrawn. Ans. 2.

or (2) move beyond generally linking the abstract idea to a particular technologic environment. Rather, the Examiner determines the claims recite no more than instructions to apply the abstract idea on a computer and a generic computer to perform generic computer functions that are well-understood, routine, and conventional activities previously known in the industry. *Id.*

Separately, the Examiner finds independent claim 11 "[amounts] to mere data structures as [it does] not positively recite any structural components of the system in the body of the claim, and therefore could merely comprise the program code or modules for performing the steps of the invention." *Id.* at 3. According to the Examiner, "the program instructions [in claim 11] are code which could be a signal per se since the preamble says comprising and is merely a program listing that is just stored and not executed." Ans. 3.

Appellants first argue "claim 11 already recites 'non-transitory' . . . and . . . the claim does not cover 'forms of non-transitory tangible media *and transitory propagating signals*.'" App. Br. 10. Appellants next argue that the claimed invention is not directed to an abstract idea. App. Br. 11–15. Appellants further assert the elements of Appellants' claims amount to significantly more than an abstract idea. App. Br. 15–16; Reply Br. 2–3. According to Appellants, the Examiner has oversimplified the claimed invention and has failed to consider the specific limitations in the claims' bodies as a whole. App. Br. 13–15; Reply Br. 2–3.

ISSUE

Under § 101, has the Examiner erred in rejecting claims 1, 3, 5, 11, 13, 16, 23, 24, and 26–34 under 35 U.S.C. § 101? This issue turns on whether

(I) the recited "computer program product comprising: one or more non-transitory computer-readable tangible storage devices" in claims 11, 13, 27, and 30[4] encompasses non-statutory, transitory media; and

(II) claims 1, 3, 5, 11, 13, 16, 23, 24, and 26–34 are directed to judicially excepted, patent-ineligible subject matter under the analysis set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012) and *Alice Corp. Proprietary Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014)?

ANALYSIS

I. TRANSITORY MEDIA

We do not sustain the Examiner's 35 U.S.C. § 101 rejection of independent claim 11 reciting, in pertinent part, a "computer program product comprising: one or more non-transitory computer-readable tangible storage devices." App. Br. 21 (Claims App'x).

The Examiner acknowledges claim 11 recites a computer program product comprising one or more non-transitory computer-readable tangible storages devices to perform steps but finds the claim merely comprises stored program code for performing the steps. Final Act. 3–4. Even so, the Examiner indicates that adding the limitation "non-transitory" to the claim

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[4] Although indirectly dependent on claim 11, claim 33 was not included in this rejection. Final Act. 3–5.

would overcome this rejection under § 101. Final Act. 4; Ans. 3. Thus, the Examiner's rejection is premised on a purported absence of the term "non-transitory" from claim 11.

Appellants identify that claim 11 includes the term "non-transitory," arguing the claimed "one or more non-transitory computer-readable tangible storage devices" do not cover forms of transitory signals. App. Br. 10; Reply Br. 2. We agree. Claim 11 recites "[a] computer program product . . . comprising: one or more non-transitory computer-readable tangible storage devices" and "program instructions, stored on at least one of the one or more storage devices, to" perform various functions. App. Br. 21–22 (Claims App'x). Limitations that include the instructions stored on one or more *non-transitory*, computer-readable storage devices exclude embodiments with transitory signals like those discussed in *In re Nuijten*, 500 F.3d 1346, 1355–57 (Fed. Cir. 2007). *See Ex parte Mewherter*, 107 USPQ2d 1857, 1860 n.5, 1862 (PTAB May 8, 2013) (precedential).

Therefore, we are persuaded that the Examiner erred in rejecting independent claim 11, and dependent claims 13, 27, and 31 as encompassing transitory media.

II. ABSTRACT IDEA

Appellants argue claims 1, 3, 5, 23, 24, and 26 as a group. App. Br. 10–17. Appellants refer to the arguments raised for claim 1 when addressing claims 11, 13, 16, and 27–31. App. Br. 17–18. Dependent claims 32–34 are not separately argued. *See* App. Br. 10–18. We select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv). Based on the record before us, we find no error in the Examiner's rejection of representative claim 1.

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*, 134 S. Ct. at 2354 (2014) (quoting *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). As noted by Appellants (App. Br. 6), the Supreme Court in *Alice* reiterated the two-step framework previously set forth in *Mayo*, "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. First, "determine whether the claims at issue are directed to a patent-ineligible concept," such as an abstract idea. *Id.*[5] If so, "consider the elements of each claim both individually and 'as an ordered combination' to determine whether the additional elements" add enough to transform the "nature of the claim" into "significantly more" than a patent-ineligible concept. *Id.* at 2355, 2357 (quoting *Mayo*, 566 U.S. at 79); *see Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

Mayo/Alice Step 1

Step one in the *Mayo/Alice* framework involves looking at the "focus" of the claims at issue and their "character as a whole." *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *Enfish, LLC v.*

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[5] Contrary to Appellants' assertion (*see* App. Br. 12), abstract ideas *may* include, *but are not limited to*, fundamental economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Alice*, 134 S. Ct. at 2355–57.

Microsoft Corp., 822 F.3d 1327, 1335 (Fed. Cir. 2016). There is no definitive rule in determining what constitutes an "abstract idea." *Enfish*, 822 F.3d at 1334 (citing *Alice*, 134 S.Ct at 2357). Also, "[a]n abstract idea can generally be described at different levels of abstraction." *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240–41 (Fed. Cir. 2016) (finding an "abstract idea could be described as generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location. It could be described in other ways, including, as indicated in the specification, taking orders from restaurant customers on a computer.").

We agree with *both* the Examiner and Appellants that claim 1 is directed to establishing a governance procedure. *See* Final Act. 6; App. Br. 12 (asserting "when analyzing the claim as a whole, a method is provided for establishing a governance procedure for governing services."). Claim 1 (preamble) recites "[a] method for establishing a governance procedure configured for providing governing services of a service oriented architecture (SOA) and deploying a first archive file configured to provide multiple different SOA governance flows." App. Br. 20 (Claims App'x). The Specification also supports this understanding. *See* Spec. ¶ 8 (stating "[e]mbodiments of the invention are directed to establishing a governance procedure for a selected service oriented architecture.").

Additionally, the body of claim 1 includes more detailed limitations for implementing or establishing the noted governance procedure. App. Br. 20–21 (Claims App'x). For example, claim 1 recites several steps, including (1) providing a template representing first tasks and second tasks that govern an SOA's services by defining an SOA governance flow, (2) producing a

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first implementation of the SOA governance flow responding to receiving a user selection of a first one of the first tasks, (3) producing a second implementation of the SOA governance flow responding to receiving a user selection of a second one of the first tasks, and (4) providing the first and second implementations in a first archive file. App. Br. 20 (Claims App'x).

We need only look to other decisions where similar concepts were previously found abstract by the courts. *See Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) ("Instead of a definition [for what an 'abstract idea' encompasses], then, the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided") (citing *Elec. Power Grp.*, 830 F.3d at 1353–54); *see also Enfish*, 822 F.3d at 1334–35. In that regard, the Examiner notes the above steps are similar or analogous to the claims at issue in *Electric Power Group*. Ans. 4.

In *Electric Power Group*, the Federal Circuit concluded claims that essentially recite "collecting information, analyzing it, and displaying certain results of the collection and analysis" were directed to an abstract idea. *Elec. Power Grp.*, 830 F.3d at 1353–54. Similarly, the above-identified steps in claim 1 are directed to gathering information (e.g., "providing . . . [a] template compris[ing] first and second software components, . . . represent[ing] a first . . . [and] second plurality of tasks" and "receiving a user selection of a first one . . . [and] a second one of the first plurality of tasks"), and organizing, analyzing, or comparing information (e.g., "producing a first . . . [and] a second implementation of the SOA governance flow" and "providing the first . . . [and] second implementation of the SOA

governance flow in the first archive file"). We therefore find unavailing Appellants' contention that the claims in *Electric Power Group* involving "collect[ing]/analyz[ing] data, or display results" are not analogous to the limitations in claim 1. Reply Br. 3.

Claim 1 additionally includes the recitation "constructing a second archive file that includes a custom implementation of a customized task of the SOA governance flow, . . . wherein the first archive file is configured to call a process of the custom implementation through the second archive file" and "deploying the first archive file to provide a customized service for the user using the SOA." App. Br. 21 (Claims App'x). To the extent these steps are not part of the Examiner's identified abstract idea, they are also drawn to an abstract idea of customizing information. *See Intellectual Ventures I LLC v. Capital One Bank*, 792 F.3d 1363, 1369–70 (Fed. Cir. 2015).

In *Capital One Bank*, the patent claims concerned a method of customizing web page content as a function of user-specific information and the user's navigation history. *Id.* at 1369. The court found these method steps of customizing web page content as a function of a user's personal characteristics analogous to tailoring information (e.g., newspaper inserts) based on a user's characteristics and concluded such a method is directed to an abstract idea. *Id.* at 1369. Similarly, claim 1 tracks or monitors user's selections of a first plurality of tasks and provides a customized service for the user by constructing a custom implementation of a customized task of a SOA governance flow and "deploying the first archive file to provide a customized service for the user using the SOA." App. Br. 21 (Claims App'x); *see also* Spec. ¶ 38, Fig. 3 (step 306).

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Lastly, we find unavailing Appellants' argument that "[a]n abstract idea is one that has no reference to material objects or specific examples— i.e., it is not concrete . . . ." App. Br. 12 (bolding omitted) (quoting *Ultramercial Inc. v. Hulu LLC*, 722 F.3d 1335, 1346 (Fed. Cir. 2013) (citations omitted), *vacated and remanded, WildTangent, Inc. v. Ultramercial LLC*, 134 S. Ct. 2870 (2014) (remanding for consideration in light of *Alice*, 134 S. Ct. 2347)).[6] Whether or not something as claimed is "concrete" and "physical" is not the current test for determining whether the claimed subject matter is judicially-excepted from patent-eligibility. "The fact that a computer 'necessarily exist[s] in the physical, rather than purely conceptual, realm,' . . . is beside the point." *Alice*, 134 S. Ct. at 2358–59.

For the foregoing reasons, we determine claim 1, when viewed as a whole, is directed to one or more abstract ideas.[7]

Mayo/Alice Step 2

In step two, we consider the elements of claim 1 both individually and as an ordered combination to determine whether the additional elements add enough to transform the claim into significantly more than a patent-ineligible concept. Step two in the *Mayo/Alice* framework involves the search for an "inventive concept." *Alice*, 134 S. Ct. at 2355; *Elec. Power Grp.*, 830 F.3d at 1353. An "inventive concept" requires more than "well-understood, routine, conventional activity already engaged in" by the

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[6] Notably, on remand, the Federal Circuit determined the claims were patent ineligible. *Ultramercial Inc. v. Hulu LLC*, 772 F.3d 709, 717 (Fed. Cir. 2014).

[7] *See RecogniCorp, LLC v. Nintendo Co., Ltd*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (stating "Adding one abstract idea (math) to another abstract idea (encoding and decoding) does not render the claim non-abstract.")

relevant community. *Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1047 (Fed. Cir. 2016) (quoting *Mayo*, 566 U.S. at 79–80).

To recap, we determine above that the steps of "providing a template, producing an implementation, providing a first implementation, constructing a second archive file, [and] deploying the first archive file" concern the above-identified abstract idea of establishing a governance procedure and are not additional elements to the abstract ideas. As previously discussed, these functions, performed by or involving a computer, software components, and virtual machine, are drawn to abstract ideas of collecting, organizing, analyzing, or comparing information. *See Elec. Power Grp.*, 830 F.3d at 1353–54. Additionally, as discussed above, constructing a second archive file and deploying the first archive file are directed to an abstract idea of customizing information. *See Capital One Bank*, 792 F.3d at 1369–70.

Thus, Appellants' contentions that the above limitations express "meaningful limitations" that transform claim 1 into a patent eligible subject matter is not persuasive. *See* App. Br. 15–16. Specifically, the Court in *Alice* "only assessed whether the claim limitations *other than the invention's use of the ineligible concept* to which it was directed were well-understood, routine and conventional." *See BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018) (emphasis added).

The Examiner further concludes under step two in the *Mayo/Alice* framework that claim 1 uses a "virtual machine" and "software component" to perform computer functions, but that these uses do not qualify as significantly more than the abstract idea. Final Act. 8–9. Appellants do not sufficiently challenge that the virtual machine and software components

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operate in their conventional manner. The disclosure also describes the virtual machine's and the software components' operation in generalities. Spec. ¶¶ 21–23, Figs. 4–5.

Appellants direct attention to the "computer" performing the steps of claim 1 to thereby tie the method to a machine "in light of the machine/transformation test." App. Br. 16. Under the "machine-or-transformation" test, a claimed process may be patent eligible under § 101 if it: (1) is tied to a particular machine or apparatus, or (2) transforms a particular article into a different state or thing. *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008), *aff'd sub nom. Bilski v. Kappos*, 561 U.S. 593 (2010). *See also Ultramercial*, 772 F.3d at 716 (acknowledging the "machine-or-transformation" test, although not the only test, can, nevertheless, provide a "'useful clue' in the second step of the *Alice* framework."). But Appellants' focus on the "machine-or-transformation" test does not consider that "after *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible. . . . The bare fact that a computer exists in the physical rather than purely conceptual realm is beside the point." *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (internal citations and quotation marks omitted). That is the case here.

Additionally, merely reciting a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2358. To the extent argued (*see* App. Br. 15–16), we disagree claim 1 recites the "computer" operating in a manner that is not generic or routine. The disclosure further supports the notion the recited "computer" functions in its routine manner, including collecting and processing information,

because the Specification describes a computer only in generalities. Spec. ¶¶ 21–23, Figs. 4–5.

Thus, like the Examiner (Final Act. 8–9), we conclude the additional elements in claim 1 are no more than generic computer elements that do not transform the above-discussed abstract idea into a patent-eligible invention. *See Alice*, 135 S. Ct. at 2358 (holding "the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention"); *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1341 (Fed. Cir. 2017) ("[T]he claims recite both a generic computer element—a processor—and a series of generic computer 'components' that merely restate their individual functions . . . . That is to say, they merely describe the functions of the abstract idea itself, without particularity. This is simply not enough under step two.").

Appellants further argue that claim 1 provides "an improvement in the technical field of a service oriented architecture (SOA) that is used to provide customized services to users." Reply Br. 5. We disagree. In particular, Appellants' alleged improvement in technology to customize SOA services involves a user's input. *See* App. Br. 20 (Claims App'x) (reciting "receiving a user selection of a first one of the first plurality of tasks" and "a user selection of a second one of the first plurality of tasks"); *see also* Spec. ¶¶ 20–21, 28, 30 (discussing the user is involved in customizing). Thus, the limitations of claim 1 considered individually and as an ordered combination do not recite an inventive concept involving a *technical* improvement.

Nor do we find availing Appellants' argument that the claims recite significantly more than a patent-ineligible concept because there is no prior

art cited to reject claim 1. App. Br. 17. "[P]atent-eligibility does not turn on ease of execution or obviousness of application. Those are questions that are examined under separate provisions of the Patent Act." *Rapid Litig. Mgmt.*, 827 F.3d at 1052 (citing *Mayo*, 566 U.S. at 89–90); *see also Myriad*, 569 U.S. at 590–91. Thus, the mere absence of prior art in rejecting claim 1 under 35 U.S.C. §§ 102 or 103 does not alter our § 101 analysis. Nor does Appellants' preemption argument alter our analysis. App. Br. 16; Reply Br. 3–5. *See Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). ("While preemption may signal patent ineligible matter, the absence of complete preemption does not demonstrate patent eligibility.") *Id.*

For the above reasons, claim 1's limitations, viewed "both individually and as an ordered combination," do not amount to significantly more than the judicial exception and do not sufficiently transform the nature of the claims into patent-eligible subject matter. *See Alice*, 134 S. Ct. at 2355.

Claim 11 recites a "computer program product" having instructions to implement a method similar to claim 1. App. Br. 21–22 (Claims App'x). Independent claim 16 recites a "computer system" having one or more processors, one or more memories, and one or more storage devices to implement a method similar to claim 1. *Id.* at 23–24 (Claims App'x). These claims recite processors, memories, and storage devices operating in a conventional manner (*see* Spec. ¶¶ 15, 18, 44, 57) and do not transform the claims into patent-eligible subject matter. We refer to the above analysis for more details.

For the foregoing reasons, Appellants have not persuaded us of error in the rejection of independent claims 1, 11, and 16 and dependent claims 3, 5, 13, 23, 24, and 26–34.

DECISION

We reverse the Examiner's rejection of claims 11, 13, 27, and 30 under 35 U.S.C. § 101 as encompassing transitory signals and, therefore, being directed to non-statutory subject matter (TRANSISTORY MEDIA).

We affirm the Examiner's rejection of claims 1, 3, 5, 11, 13, 16, 23, 24, and 26–34 under 35 U.S.C. § 101 (ABSTRACT IDEA).

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED