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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DARSHAN KUMAR, AMBILI SUDHI, GOVINDRAJA ACHAR,
PANKESH JHAVERI, HARISH KUMAR, and WALTER BACK

Appeal 2017-008735
Application 12/362,409¹
Technology Center 3600

Before, ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's non-final rejection of claims 1, 4-8, 10, 12 and 14-21. We have jurisdiction under 35 U.S.C. § 6(b).

¹ Appellants identify Oracle International Corporation as the real party in interest. Br. 2.

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants state “[o]ne embodiment is directed to customer relationship management, and more particularly directed to sample management during a sales call.” Spec. ¶ 1.

Claim 1 reproduced below, is representative of the subject matter on appeal.

1. A method for validating pharmaceutical sales call data, comprising:

receiving, by a processor operatively coupled to a display, a request to validate the sales call data regarding pharmaceutical samples, the sales call data comprising a product name, a lot number and a quantity, as well as physician data;

retrieving a rules list comprising a plurality of rules for validating the sales call data and rule criteria, wherein each rule comprises a string indicating a name for the rule, a method name of a function that applies a validation of the rule, a status message indicating a result of the rule, a call type indicating a type of sales call for which the rule is applicable, and an indication as to when the rule should be processed depending on a signatory requirement of the sales call;

wherein the rules list is customizable by changing, for at least one rule, at least one of the method name of the function that applies the validation of the rule, the status message indicating the result of the rule, the call type indicating the type of sales call for which the rule is applicable, or the indication as to when the rule should be processed depending on a signatory requirement of the sales call;

selecting a subset of customizable rules to apply to the sales call data from the plurality of rules based on the rule criteria;

validating, by the processor, the sales call data in accordance with the subset of customizable rules, wherein all rules in the subset of rules are

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applied in one iteration to validate the sales call data before displaying to a user the subset of rules that failed;
and

displaying to the user a user list comprising, for each rule in the subset of rules that failed, the name for the rule and a message corresponding to the status message that comprises a validation error that requires corrective action.

Claims Appendix 11–12.

THE REJECTION

The following rejection is before us for review.

Claims 1, 4–8, 10, 12 and 14–21 are rejected under 35 U.S.C. § 101.

FINDINGS OF FACT

1. We adopt the Examiner’s findings as set forth on pages 2–11 of the Non–Final Action and 3–16 of the Answer.

ANALYSIS

35 U.S.C. § 101 REJECTION

We will affirm the rejection of claims 1, 4–8, 10, 12 and 14–21 under 35 U.S.C. § 101. Appellants argued claims 1, 4–8, 10, 12 and 14–21 as a group. We select claim 1 as the representative claim for this group, and the remaining independent claims standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2015).

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101.

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However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See id.* at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 192 (1981)); “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores” (*id.* at 184 n.7 (quoting *Corning v. Burden*, 56 U.S.

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252, 267–68 (1853)); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 176; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (quotation marks omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to

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monopolize the [abstract idea].” *Id.* (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance* (“2019 Memorandum”). Under that guidance, we first look to whether the claim recites:

(1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human interactions such as a fundamental economic practice, or mental processes); and

(2) additional elements that integrate the judicial exception into a practical application, i.e., that “apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *2019 Memorandum* at 18; *see also* MPEP § 2106.05(a)–(c), (e)–(h).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

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(3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or

(4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See 2019 Memorandum.

The Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the [S]pecification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). It asks whether the focus of the claims is on a specific improvement in relevant technology or on a process that itself qualifies as an “abstract idea” for which computers are invoked merely as a tool. *See id.* at 1335–36.

In so doing, as indicated above, we apply a “directed to” two prong test: 1) evaluate whether the claim recites a judicial exception, and 2) if the claim recites a judicial exception, evaluate whether the claim “appl[ies], rel[ies] on, or use[s] the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *See 2019 Memorandum.*

The Examiner found that the claims are directed to four abstractions¹, namely:

1. **An idea of itself**, since the aforementioned limitations fall well-within the broadly defined uninstantiated concept, plan or scheme, as well as a mental process (i.e. claimed here with respect to rule validat[ing]), that can be performed in the human mind, or by a human using a pen and paper.”
2. **A method of organizing human activities**, since the aforementioned limitations also fall well-within concepts relating to interpersonal and intrapersonal activities. (see "*July 2015 Update: Subject Matter Eligibility*" page 4 Section B), such as: managing relationships or transactions between people, social activities, and human behavior; satisfying or avoiding a legal obligation; sales activities or behaviors, claimed here as a rule validation with respect to "*receiving*", "*retrieving*", "*selecting*" and "*displaying*" limitations on "*sales call data*" with further considerations for its "*applicability*", "*signature*" requirements, parties involved (i.e. "*user*", "*doctor*", "*doctors*", "*organization*") etc.,
3. **A fundamental economic practice**, since the aforementioned limitations fall well-within the broadly concepts relating to the economy and commerce ("*July 2015 Update: Subject Matter Eligibility*" page 4 Section A), such as: agreements between people in the form of contracts, legal obligations, and business relations, claimed here by the aforementioned limitations with respect to the "*pharmaceutical sales call*" and

its corresponding "rule" "validation".

4. **Mathematical** relationships since rule-based validation falls well within the broadly defined mathematical algorithms of the "July 2015 Update: Subject Matter Eligibility" page 5 Section D. (Non-Final Act. 5–7).

We agree with the Examiner that the claims are directed to a mathematical relationship and an idea itself, because the claim is directed to applying rules in sales calls “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016).

We also agree with the Examiner that the claims are directed to a method of organizing human activities as the claim is directed to applying rules in sales calls which is supported by the claim recitation of, “the call type indicating the type of sales call for which the rule is applicable” which is way of directing a sales call in a given way. We also agree that the claims are directed to a fundamental economic because the claims focuses on product sales which is a fundament economic practice by virtue of the transaction. Sales transactions are the engine of an economic practice and the Examiner correctly reasons this in his findings. The patent-ineligible end of the spectrum includes methods of organizing human activity and fundamental economic practice. See *Alice*, 134 S.Ct. at 2355–57.

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Turning to the second prong of the “directed to” test, claim 1 only generically requires “a processor”. We fail to see how the generic recitation of a computer component so integrates the judicial exception as to “impose a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *2019 Memorandum* at 18.

Thus, we find that the claims recite the judicial exceptions of a mental process and a legal interaction.

That the claims do not preempt all forms of the abstraction or may be limited to pharmaceutical sales calls, does not make them any less abstract. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362 (Fed. Cir. 2015) (“And that 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.”).

Turning to the second step of the *Alice* analysis, because we find that the claims are directed to abstract ideas/judicial exceptions, the claims must include an “inventive concept” in order to be patent-eligible, i.e., there must be an element or combination of elements sufficient to ensure that the claim in practice amounts to significantly more than the abstract idea itself. *See Alice*, 134 S.Ct. at 2355 (quoting *Mayo Collaborative Servs.*, 566 U.S. at 72–73).

Concerning this step, the Examiner found the
recitation of generic, ubiquitous computer structure

such as: "*processor*", "*memory*", "*non-transitory computer-readable medium*" recited at a high level of generality (see for example Original Specification ¶ [0018] - ¶ [0022]) [] serves to perform the generic computer instructions or functions that, as identified above, are already directed to abstract idea(s), and also apparently directed to well-understood, routine, and conventional activities previously known to the pertinent industry and given at least the considerations of "*July 2015 Update: Subject Matter Eligibility*" at page 7 ¶2 last sentence & bullet points #1 to #6.

(Non-Final Act. 7).

We agree with the Examiner. “[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice*, 134 S.Ct. at 2359. They do not.

Considered as an ordered combination, the computer components of Appellants’ claims add nothing that is not already present when the steps are considered separately. The sequence of data reception-analysis (retrieving, selecting, validating and displaying) is equally generic and conventional or otherwise held to be abstract. See *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (sequence of receiving, selecting, offering for exchange, display, allowing access, and receiving payment recited an abstraction), *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (holding that sequence of data retrieval,

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analysis, modification, generation, display, and transmission was abstract), *Two-Way Media Ltd. v. Comcast Cable Commc 'ns, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (holding sequence of processing, routing, controlling, and monitoring was abstract). The ordering of the steps is, therefore, ordinary and conventional.

Thus, the claims at issue amount to nothing significantly more than instructions to apply the claimed abstract ideas using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 134 S.Ct. at 2360.

We have reviewed all the arguments (Br. 4–10) Appellants have submitted concerning the patent eligibility of the claims before us that stand rejected under 35 U.S.C. § 101. We find that our analysis above substantially covers the substance of all the arguments, which have been made. But, for purposes of completeness, we will address various arguments in order to make individual rebuttals of same.

Appellants argue,

the Examiner has failed to meet the requirements of these patent office issued guidelines. For the present case, the Examiner has alleged that the abstract idea for each of the independent claims is nearly the ENTIRETY of the claims. See 7/27/16 Office Action, pp. 4–5. A comparison of this alleged abstract idea to the abstract ideas identified by the courts shows that there are no similarities.

(Appeal Br. 5).

We disagree with Appellants. We find that Examiner’s findings and analysis, which included citations to applicable case law (see Non–Final Act. 3–11), are sufficient to present a *prima facie* case as to step one of *Mayo*. See, e.g., *Amdocs (Israel), Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (explaining that there is not a single test for what an abstract idea encompasses and courts instead “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”); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016) (“both [the Federal Circuit] and the Supreme Court have found it sufficient to compare claims at issue to those claims already found to be directed to an abstract idea in previous cases” to determine what constitutes an abstract idea sufficient to satisfy step one of the *Mayo* inquiry); see also *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1366–67 (Fed. Cir. 2018) (comparing the claims at issue to claims held directed to an abstract idea in prior cases for step one of *Mayo*). The Examiner’s analysis was sufficient to put Appellants on notice of the basis for the ground of rejection and to allow Appellants to recognize and seek to counter the grounds of rejection. See *In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011).

Appellants further argue, “the present claims are allowable over the prior art, so there is no evidence that the claimed process was previously used either manually, or using a computer. And, just as in *McRO*, the

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present claims includes computer software based rules used to validate sales call data.” (Appeal Br. 7).

We disagree with Appellants. We are not persuaded by Appellants’ argument because the standard for patentability under 35 U.S.C. § 103(a) is obviousness, the standard for patentability under 35 U.S.C. § 102 is novelty, and the standard for patent eligibility under 35 U.S.C. § 101 is abstract idea. Each of these standards is separately required to be met before patentability can be conferred on invention, which is not the case here based on the latter standard. The question in step two of the Alice framework is not whether an additional feature is novel but whether the implementation of the abstract idea involves “more than the performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1347–48 (quoting Alice, 134 S. Ct. at 2359).

Moreover, the question is whether the claims as a whole “focus on a specific means or method that improves the relevant technology” or are “directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016). In this case, claim 1 as a whole attempts to satisfy certain contingencies for validating a call type indicating the type of sales call for which the rule is applicable, and not focused on an technology improvement.

Appellants further argue,

If a proper analysis was undertaken for the §101 rejections, the Examiner would have found that the pending claims recite a ‘non-conventional and non-generic arrangement of known, conventional pieces’ because they are allowable over the prior art, meaning all of the pending claims recite an inventive concept per *Bascom*².

(Appeal Br. 8).

We disagree with Appellants. In *Bascom*, the claims described an inventive concept in the non-conventional and non-generic arrangement of known, conventional pieces. *Bascom*, 827 F.3d at 1350. Specifically, the Federal Circuit determined that the claimed installation of a filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each end user, provided an inventive concept in that it gave the filtering tool both the benefits of a filter on a local computer and the benefits of a filter on the ISP server. *Id.* Appellants do not identify any comparable non-conventional, non-generic arrangement of elements that is recited in the present claims other than re-reciting limitations in the context as they appear in the claims.

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 1, 4–8, 10, 12 and 14–21 under 35 U.S.C. § 101.

² *Bascom Global Internet v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016).

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DECISION

The decision of the Examiner to reject claims 1, 4–8, 10, 12 and 14–21 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

¹ We find no error in the Examiner’s finding that the claims are directed to four abstractions. *See Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016) (“An abstract idea can generally be described at different levels of abstraction.”)