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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GREG OLSEN, GANESH BELL, RICARDO CRAFT,
CHELLAH THIRUNAVUKKARASU, LENIN SUBRAMANIAN,
MANOHAR RAGHUNATH, and ZHENG CHEN

Appeal 2017-008993
Application 13/842,035¹
Technology Center 3600

Before LARRY J. HUME, JASON J. CHUNG, and
BETH Z. SHAW, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 1–18 and 20.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellants, ServiceSource International, Inc. is the real party in interest. App. Br. 2.

² Claim 19 is canceled. App. Br. 35.

INVENTION

The invention is directed to processing and managing recurring revenue asset information. Spec. ¶ 1. Claim 1 is illustrative of the invention and is reproduced below:

1. A computer program product comprising a non-transitory machine-readable medium storing instructions that, when executed by at least one programmable processor, cause the at least one programmable processor to perform operations comprising:

receiving a first unit of data at a recurring revenue management system;

receiving a second unit of data at the recurring revenue management system;

extracting content from the first unit of data and the second unit of data based on one or more parameters of a predefined data object that is part of an asset data model defined in the recurring revenue management system;

adding the extracted content to an instance of the predefined data object and associating reference tags with the content extracted from each of the first unit of data and the second unit of data, each reference tag comprising identification information for its associated content, wherein the identification information of each reference tag comprises an indication of a source from which the associated extracted content was received, the identification information further comprising a tag history including a history of previous reference tags that have been associated with the extracted content with which the reference tag is associated, the tag history configured to provide the history and source of origin of all changes to the associated extracted content;

detecting a duplicate data condition in which the content extracted from the first unit of data and the content extracted from the second unit of data provide redundant, conflicting values for a same field within the instance of the data object; and

resolving the duplicate data condition by applying a predefined approach to conflict resolution that is based on the

identification information in the reference tags of the content of the first unit of data and the second unit of data.

REJECTIONS AT ISSUE^{3,4}

Claims 1–18 and 20 stand rejected under 35 U.S.C. § 101 as being directed to a patent-ineligible subject matter. Ans. 2–5.

Claims 1–18 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Gotz (US 2004/0034699 A1; published Feb. 19, 2004) and Caballero (US 2008/0270256 A1; published Oct. 30, 2008). Ans. 5–9.

We have only considered those arguments that Appellants actually raised in the Briefs. Arguments Appellants could have made, but chose not to make, in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

³ The Examiner rejects claims 1–20 under 35 U.S.C. § 101 in the Final Rejection, but rejects claims 1–18 and 20 under 35 U.S.C. § 101 in the Answer. *Compare* Final Act. 3 *with* Ans. 2. Claim 19 has been canceled. App. Br. 35. We, therefore, interpret the Final Rejection pertaining to the rejection of claims 1–20 under 35 U.S.C. § 101 as a typographical error and, instead, interpret the 35 U.S.C. § 101 rejection as stated in the Answer.

⁴ The Examiner rejects claims 1–18 under 35 U.S.C. § 103 in the heading of the rejection in the Final Rejection, but includes an analysis for claims 1–20 in the body of the rejection. *Compare* Final Act. 6 *with id.* at 7–10. Moreover, the Examiner rejects claims 1–18 and 20 under 35 U.S.C. § 103 in the heading of the Answer, but includes an analysis for claims 1–20 in the body of the rejection. *Compare* Ans. *with id.* at 6–9. However, claim 19 has been canceled. App. Br. 35. We, therefore, interpret the Examiner’s rejection under 35 U.S.C. § 103 as a typographical error and, instead, interpret the 35 U.S.C. § 103 rejection as rejecting claims 1–18 and 20.

ANALYSIS

35 U.S.C. § 101

The Examiner concludes the present claims are directed to an abstract idea similar to the abstract idea in *Electric Power Grp, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir, 2016). Ans. 11. Furthermore, the Examiner concludes the additional elements do not amount to significantly more than the abstract idea because they recite generic components that perform generic functions that are well understood, routine, and conventional. *Id.* at 4.

Appellants argue the Examiner fails to present a *prima facie* case of patent ineligibility by impermissibly relying on conclusory statements that the present claims are abstract and therefore did not meet the Examiner's burden. App. Br. 13–16. Appellants argue the present claims are not abstract because, like *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), there are improvements to the function of computers such as detecting and resolving duplicate data and allowing for the tracking and capturing of data provenance. App. Br. 16–18.

Appellants argue that, similar to *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014) and *BASCOM Global Internet Serv., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), the present claims amount to significantly more than any abstract idea because they recite a non-conventional, non-generic, and specifically ordered arrangement of elements. App. Br. 19–22. Appellants argue the present claims are patent eligible because they do not preempt any abstract idea. App. Br. 23–26. Appellants argue the propriety of the Examiner's new findings and

conclusions pertaining to *Electric Power* and argue that they do not have an opportunity to respond. Reply Br. 5–6. We disagree with Appellants.

Legal Standards

Regarding Appellants’ argument that the Examiner did not present a *prima facie* case of patent ineligibility (App. Br. 13–16), patent eligibility under 35 U.S.C. § 101 is a question of law that is reviewable *de novo*. See *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012). We are aware of no controlling authority that requires the Examiner to provide factual evidence under step one of the *Alice* framework to support a determination that a claim is directed to an abstract idea. The Federal Circuit has repeatedly noted that “the *prima facie* case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). The Examiner satisfies the burden of establishing a *prima facie* case under 35 U.S.C. § 132 by setting forth a rejection in a sufficiently articulate and informative manner. *In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011). If the Examiner “adequately explain[s] the shortcomings . . . the burden shifts to the applicant to rebut the *prima facie* case with evidence and/or argument.” *Hyatt*, 492 F.3d at 1370. The Final Office Action adequately explains the § 101 rejection. See Final Act. 7–8. The Examiner’s statements satisfy § 132(a) because they apply the *Alice* analytical framework and apprise Appellants of the reasons for the § 101 rejection under that framework. Appellants have not responded by alleging a failure to understand the rejection. To the contrary, Appellants clearly identify the abstract idea. See, e.g., App. Br. 15–19.

Following the decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014), (citing *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 82–84 (2012)), we analyze claims where the abstract idea judicial exception to the categories of statutory subject matter is at issue using the following two-part analysis set forth in *Mayo*:

1) determine whether the claim is directed to an abstract idea; and 2) if an abstract idea is present in the claim, determine whether any element, or combination of elements, in the claim is sufficient to ensure that the claim amounts to significantly more than the abstract idea itself. *See Alice*, 134 S. Ct. at 2350.

As to the first part of the analysis, examples of abstract ideas referenced in *Alice* include: fundamental economic practices⁵; certain methods of organizing human activities⁶; “[a]n idea of itself”⁷; and, mathematical relationships or formulas.⁸ Claims that include abstract ideas like these are examined under the second part of the analysis to determine whether the abstract idea has been applied in an eligible manner.

⁵ *Alice Corp.*, 134 S. Ct. at 2350: e.g., intermediated settlement, i.e., the use of a third party intermediary to mitigate settlement risk.

⁶ *Id.* at 2356: e.g., a series of steps instructing how to hedge risk (citing *Bilski v. Kappos*, 561 U.S. 593, 599 (2010)).

⁷ *Id.* at 2355: e.g., a principle, an original cause, a motive (citing *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) and *Le Roy v. Tatham*, 14 How. 156, 175 (1852)).

⁸ *Id.* at 2350: e.g., a mathematical formula for computing alarm limits in a catalytic conversion process (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)), or a formula for converting binary-coded decimal numerals into pure binary form (*Benson*, 409 U.S. at 71–72).

As to the second part of the analysis, we consider the claim as a whole by considering all claim elements, both individually and in combination. *Id.* at 2355. Limitations referenced in *Alice* that may be enough to qualify as “significantly more” when recited in a claim with an abstract idea include, as non-limiting or non-exclusive examples: Improvements to another technology or technical field⁹; improvements to the functioning of the computer itself¹⁰; and meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment.¹¹ Limitations referenced in *Alice* that are not enough to qualify as “significantly more” when recited in a claim with an abstract idea include, as non-limiting or non-exclusive examples: adding the words “apply it” (or an equivalent) to an abstract idea¹²; mere instructions to implement an abstract idea on a computer¹³; or requiring no more than a generic computer to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the industry.¹⁴

⁹ *Id.* at 2358: e.g., a mathematical formula applied in a specific rubber molding process (citing *Diamond v. Diehr*, 450 U.S. 175, 177–78 (1981)).

¹⁰ *Id.* at 2359.

¹¹ *Id.* at 2360: noting that none of the hardware recited “offers a meaningful limitation beyond generally linking ‘the use of the [method] to a particular technological environment,’ that is, implementation via computers” (citing *Bilski*, 561 U.S. at 610–11).

¹² *Id.* at 2357–58.

¹³ *Id.*: e.g., simply implementing a mathematical principle on a physical machine, namely a computer (citing *Mayo*, 566 U.S. at 84–85).

¹⁴ *Id.* at 2359: e.g., using a computer to obtain data, adjust account balances, and issue automated instructions.

If there are no meaningful limitations in the claim that transform the abstract idea into a patent eligible application such that the claim amounts to significantly more than the abstract idea itself, the claim is directed to non-statutory subject matter under 35 U.S.C. § 101.

Alice Step 1

On this record, we see no error in the Examiner’s analysis and conclusion that the present claims are directed to an abstract idea similar to the abstract idea in *Electric Power*. Ans. 11. That is, we conclude the present claims are directed to the abstract idea of collecting information and analyzing it, which is similar to *Electric Power*. Moreover, we conclude the present claims are directed to the abstract idea of obtaining and comparing data, similar to that in *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366 (Fed. Cir. 2011). And we conclude the present claims are directed to the abstract idea of parsing and comparing data, similar to the abstract idea in *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018).

In addition, we disagree with Appellants’ argument that the present claims are directed to an improvement in technology (App. Br. 16–18) because the present claims are directed to an improved abstraction that automate provisioning, which happen to use computer tools in a nominal manner.¹⁵ Accelerating a mental process with a processor does not make claims patent eligible. *Bancorp Servs., LLC v. Sun Life Assurance Co.*, 687 F.3d 1266, 1279 (Fed. Cir. 2012) (“Using a computer to accelerate an ineligible mental process does not make that process patent-eligible.”).

¹⁵ *Infra* n.14.

Because the present claims are directed to an abstract idea, we proceed to step (2) of the *Alice*, two-part test.

Alice Step 2

On this record, we see no error in the Examiner’s analysis and conclusion that the present claims are not directed to significantly more than the abstract idea because they recite generic components that perform generic functions that are well understood, routine, and conventional. Ans. 4.

The Specification states, “**Generic techniques** and mechanisms for managing data quality and provenance can be included in a recurring revenue management approach” (emphasis added). Spec. ¶ 57. And the Specification states “[t]hese various aspects or features can include implementation in one or more computer programs that are executable and/or interpretable on a programmable system including at least one programmable processor, which can be special or **general purpose**, coupled to receive data and instructions from, and to transmit data and instructions to, a storage system, at least one input device, and at least one output device” (emphasis added). Id. ¶ 79. We therefore conclude the Specification recites generic elements that are well-understood, routine, and conventional.

We also disagree with Appellants’ argument that *Enfish* states that patentable algorithms can execute on generic computing hardware, which means the present claims amount to significantly more than any abstract idea (Reply Br. 2–3) because Appellants’ reliance on *Enfish* is misplaced; that is, *Enfish* pertains to *Alice* step 1 (i.e., abstract idea) rather than *Alice* step 2 (i.e., significantly more). Nonetheless, the present claims are directed to an abstract idea without significantly more for the reasons stated *supra* and *infra*.

Additionally, we disagree with Appellants' argument that, under both *DDR* and *BASCOM*, the present claims are patent eligible because they recite a non-conventional, non-generic, and specifically ordered arrangement of elements (App. Br. 19–22); we disagree because accelerating a mental process similar to that in *Electric Power*, *Berkheimer*, and *CyberSource* does not make claims patent eligible. *Bancorp*, 687 F.3d at 1279.

Furthermore, we disagree with Appellants' argument that the present claims are patent eligible because they do not preempt any abstract idea (App. Br. 23–26); while preemption may denote patent ineligibility, its absence does not demonstrate patent eligibility. *See FairWarning, IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016). For claims covering a patent-ineligible concept, preemption concerns “are fully addressed and made moot” by an analysis under the *Mayo/Alice* framework. *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015).

Also, we disagree with Appellants' argument that the Examiner introduced new arguments by citing to *Electric Power* and they do not have an opportunity to respond (Reply Br. 5–6) for the following reasons. First, the Examiner does not make arguments. Rather, the Examiner makes findings and conclusions. In this case, because the Examiner is addressing an issue under 35 U.S.C. § 101, the Examiner is making a conclusion. Second, as stated *supra*, subject matter eligibility under 35 U.S.C. § 101 is a question of law that is reviewable *de novo*. Third, Appellants had an adequate opportunity to respond in their Reply Brief, and they did respond (*see e.g.*, Reply Br. 5 (“Applicants point out that the claims in *Electric Power Group* were found ineligible for describing little more than an

intended result.”)). Fourth, we note the issue of whether an Examiner raises a new theory for the first time in an Answer is a petitionable matter and not an appealable matter. *See* 37 C.F.R. § 41.40(a). Appellants failed to timely file such a petition and, therefore, waived the argument that the rejection must be designated as a new ground of rejection. *See* 37 C.F.R. § 41.40(a).

Appellants do not argue separately dependent claims 2–6, 8–12, 14–18, and 20 with particularity, but assert the rejections of those claims should be withdrawn for at least the same reasons as argued in independent claims 1, 7, and 13. App. Br. 26. Accordingly, we sustain the Examiner’s rejection of: (1) independent claims 1, 7, and 13; and (2) dependent claims 2–6, 8–12, 14–18, and 20 under 35 U.S.C. § 101.

35 U.S.C. § 103

The Examiner concludes the limitation:

wherein the identification information of each reference tag comprises an indication of a source from which the associated extracted content was received, the identification information further comprising a tag history including a history of previous reference tags that have been associated with the extracted content with which the reference tag is associated, the tag history configured to provide the history and source of origin of all changes to the associated extracted content

(hereinafter “the disputed limitation”) recited in claims 1, 7, and 13 amounts to non-functional descriptive material. Final Act. 9–10; Ans. 8, 13–14. Additionally, the Examiner finds Gotz and Caballero do not teach “the disputed limitation,” but the present claims remain unpatentable because “the disputed limitation” amounts to non-functional descriptive material. Final Act. 7–9; Ans. 6–8.

Appellants argue “the disputed limitation” does not amount to non-functional descriptive material because the final part of claim 1 recites “resolving the duplicate data condition by applying a predefined approach to conflict resolution that is based on **the identification information in the reference tags** of the content of the first unit of data and the second unit of data” and the Examiner cannot ignore limitations from the entirety of the claim. App. Br. 27–28. Appellants also argue paragraph 62 of the Specification describes an example of how a reference tag can be used. Reply Br. 8 (citing Spec. ¶ 62). We agree with Appellants that the disputed limitation does not amount to non-functional descriptive material.

The informational content of non-functional descriptive material is not entitled to weight in the patentability analysis. *See Ex parte Nehls*, 88 USPQ2d 1883, 1887–90 (BPAI 2008) (precedential); *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (informative) (Federal Circuit Appeal No. 2006-1003), *aff’d*, Rule 36 (June 12, 2006)); *Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (informative), *aff’d*, 191 F. App’x 959 (Fed. Cir. 2006). However, in *In re Distefano*, 808 F.3d 845, 851 (Fed. Cir. 2015), the Federal Circuit reasoned although selected web assets can and likely do communicate some information, the content of the information is not claimed. In *Distefano*, the Federal Circuit held the Board erred in finding that the origin of assets was subject to no patentable weight under the printed matter doctrine. *Id.*

Similarly, the present claims recite a “source from which the associated extracted content was received” (i.e., the origin) and a “source of origin of all changes to the associated extracted content” (i.e., the origin). Therefore, pursuant to *Distefano*, the limitations “source from which the

associated extracted content was received” and a “source of origin of all changes to the associated extracted content” recited in present claims 1, 7, and 13 should be given patentable weight. However, as stated *supra*, the Examiner finds Gotz and Caballero do not teach “the disputed limitation.” Therefore, on this record, the Examiner has not shown sufficiently or explained how the cited references teach the disputed limitation.

Accordingly, we do not sustain the Examiner’s rejection of: (1) independent claims 1, 7, and 13; and (2) dependent claims 2–6, 8–12, 14–18, and 20 under 35 U.S.C. § 103.

DECISION

We affirm the Examiner’s decision rejecting claims 1–18 and 20 under 35 U.S.C. § 101.

We reverse the Examiner’s decision rejecting claims 1–18 and 20 under 35 U.S.C. § 103(a).

Because we affirm on at least one ground of rejection with respect to each claim on appeal, we affirm the Examiner’s decision to reject claims 1–18 and 20. *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