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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VINICIO BOMBACINO, CLAUDIO FALCONE,
LEONARDO LANNI, and ANDREA TORTOSA

Appeal 2017-010335
Application 13/172,176
Technology Center 2400

Before BETH Z. SHAW, DANIEL J. GALLIGAN, and
JOSEPH P. LENTIVECH, *Administrative Patent Judges*.

SHAW, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of claims 25–45, which represent all the pending claims in this application. We have jurisdiction under 35 U.S.C. § 6(b).²

We affirm.

¹ According to Appellants, the real party in interest is IBM Corporation. (Br. 1.)

² The Board decided previous Appeal 2014-001953 in this application on March 18, 2016.

INVENTION

The invention is for “logical thread management through email infrastructure.” Spec. ¶ 3.

Claim 25 is illustrative and is reproduced below:

25. A computer-implemented method using an email client executing on a computer, comprising:

receiving, within a view associated with a first email and presented by the email client, a user input designating a logical thread to be associated with the first email;

sending, to a recipient, the first email accompanied by a logical thread identifier associated with the logical thread;

modifying, based upon the first email, a logical thread list associated with the logical thread;

receiving, from the recipient, a task response; and

updating, using the email client and based upon the task response, the logical thread list, wherein

the first email specifies a task to the recipient of the first email, and

the logical thread is a data structure associating each of a plurality of assigned task instances to an assigned recipient and a task status.

REJECTIONS

The Examiner rejected claims 25–45 under 35 U.S.C. § 101 as directed to patent-ineligible subject matter. Final Act. 2–3.

The Examiner rejected claims 25–27, 30–34, 37–41, 44, and 45 under 35 U.S.C. § 103(a) as unpatentable over Pradhan (US 2009/0204465 A1; published Aug. 13, 2009) in view of Herrero (US 2002/0078007 A1; published June 20, 2002). Final Act. 4–7.

The Examiner rejected claims 28, 29, 35, 36, 42, and 43 under 35 U.S.C. § 103(a) as unpatentable over Pradhan, Herrero, and Hammer (US 2010/0017194 A1; published Jan. 21, 2010). Final Act. 7–9.³

CONTENTIONS AND ANALYSIS

We have reviewed Appellants’ arguments in the Brief, the Examiner’s rejections, and the Examiner’s response to Appellants’ arguments. For at least the reasons discussed below, we agree with and adopt the Examiner’s findings and conclusions in the Final Action and Answer. *See* Ans. 3–28.

Section 101 Rejection

With respect to claims 25–45, the Examiner finds these claims are directed to an abstract idea of comparing new and stored information and using rules to identify options. Ans. 5. The Examiner also finds additional elements recited in these claims do not amount to significantly more than the abstract idea itself. *Id.* at 7–13. According to the Examiner, the claims require no more than using computers to send and receive information. *Id.*

Appellants present several arguments against the 35 U.S.C. § 101 rejection. Br. 9–21. Appellants contend the claims are not directed to an abstract idea and that the claims amount to significantly more than an abstract idea. *Id.*

We do not find Appellants’ arguments persuasive. Instead, we find the Examiner has provided a comprehensive response to Appellants’

³ In the final rejection, the Examiner rejected claims 25–45 under 35 U.S.C. 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. Final Act. 3. The Examiner withdraws this rejection in the Answer. Ans. 2.

arguments supported by a preponderance of evidence. Ans. 5–14; *see also* Final Act. 2–3. As such, we agree with and adopt the Examiner’s findings and explanations provided therein. *Id.* The Supreme Court has long held that “[l]aws 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 *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). The “‘abstract ideas’ category embodies ‘the longstanding rule that ‘[a]n idea of itself, is not patentable.’” *Alice*, 134 S. Ct. at 2355 (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)).

In *Alice*, the Supreme Court sets forth an analytical “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.*

If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1297–1298). In other words, the second step is to “search for an ‘inventive concept’—*i.e.*, 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.’” *Id.* (alteration in original) (quoting *Mayo*, 132 S. Ct. at 1294). The prohibition against patenting an abstract idea “cannot be

circumvented by attempting to limit the use of the formula to a particular technological environment’ or adding ‘insignificant postsolution activity.’” *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (citation omitted).

In the first step of the *Alice* inquiry, we agree that Appellants’ claims are directed to an abstract idea, as explained by the Examiner. Ans. 5; Final Act. 2–3. All the steps recited in Appellant’s claims are abstract processes of receiving, modifying, updating, and sending data. *Cf. Elec. Power Grp. LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (“collecting information, analyzing it, and displaying certain results of the collection and analysis” is abstract); *In re Salwan*, Appeal No. 2016-2079, 2017 WL 957239 at *3 (Fed. Cir. Mar. 13, 2017) (affirming the rejection under § 101 of claims directed to “storing, communicating, transferring, and reporting patient health information,” noting that “while these concepts may be directed to practical concepts, they are fundamental economic and conventional business practices”); *Cyberfone Systems, LLC v. CNN Interactive Grp, Inc.*, 558 F. App’x 988, 992 (Fed. Cir. 2014) (nonprecedential) (“using categories to organize, store, and transmit information is well-established”).

In the second step of the *Alice* inquiry, the limitations in Appellants’ claims do not add anything “significantly more” to transform into a patent-eligible application the abstract concept of receiving, modifying, updating, and sending data. Ans. 7–14; *see also Alice*, 134 S. Ct. at 2357. We agree with the Examiner that the specific details of the type of information being stored and received are further details of the abstract idea and are not “significantly more” than the abstract idea. Ans. 8. These are ordinary steps in data analysis and are recited in an ordinary order. Limiting an abstract

concept of sending, receiving, and updating data to a general purpose computer having generic components, such as the “computer” recited in Appellants’ claims, 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.” *Alice*, 134 S. Ct. at 2358; *see id.* at 2359 (concluding claims “simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer” are not patent eligible).

As our reviewing court has held, “the use of the Internet is not sufficient to save otherwise abstract claims from ineligibility under § 101.” *Ultramerical, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (claims merely reciting abstract idea of using advertising as currency as applied to particular technological environment of the Internet are not patent eligible; “use of the Internet does not transform an otherwise abstract idea into patent-eligible subject matter”); *see also Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (claims reciting “generalized software components arranged to implement an abstract concept [of generating insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer” are not patent eligible); *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)). Moreover, Appellants’ claims are not rooted in computer technology as outlined in *DDR Holdings*. *DDR Holdings, LLC v. Hotels.com, L.P.*, 773

F.3d 1245, 1258 (2014).

Because Appellants' claims 25–45 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 as being directed to patent-ineligible subject matter in light of *Alice* and its progeny.

Section 103 Rejections

Independent Claim 25

Appellants argue Pradhan fails to teach “receiving, within a view associated with a first email and presented by the email client, a user input designating a logical thread to be associated with the first email,” as recited in claim 25. Br. 29–30. The Examiner finds, however, that this limitation is taught by Pradhan's “Add Project” interface(s), which defines the claimed “logical threads.” Ans. 16 (citing Pradhan, Figs. 2, 8A, 8B, ¶¶ 7, 79, 87). We agree because Pradhan's Figure 8A depicts receiving an input in the “interface for composing an email communication,” which teaches the view associated with a first email and presented by the email client. Pradhan Fig. 8A; ¶ 87. The input 1020 for a project abbreviation project “SAMPL” indicates that the email communication relates to the “SAMPL” project, which teaches the user input designating a logical thread to be associated with the first email. *Id.* We disagree with Appellants' argument that Pradhan's user input is necessarily automatically inserted and therefore is not designated user input (Br. 30), because as the Examiner explains, Pradhan teaches an “Add Project” screen in the project portal that has an entry field for the project title and an entry field for an abbreviation of the project. Ans. 16 (citing Pradhan, Fig. 2.). As the Examiner further explains,

Pradhan’s Add Project screen is “associated with the email” because it is part of the same software and because the email calls upon information entered from the Add Project screen. Ans. 18.

Appellants also argue that Pradhan does not teach “sending, to a recipient, the first email accompanied by a logical thread identifier associated with the logical thread.” Br. 34. Yet, Pradhan Figures 2 and 8A teach the logical thread identifier (SAMPL) that is part of an email communication, and the email is sent to recipients. Pradhan ¶ 87; Ans. 20–21. Thus, we are not persuaded by Appellants’ argument.

Appellants additionally argue that “modifying, based upon the first email, a logical thread list associated with a logical thread” is not taught because Herrero modifies tasks based on an interface, not an email. Br. 35. Yet, as the Examiner correctly finds, Herrero teaches that its system sends email notification of a task and modifying a logical thread list. *See* Ans. 21–22 (citing Herrero Fig. 9, ¶¶ 51, 55, 68). Moreover, the Examiner explains that it is the combination of Pradhan and Herrero that teaches the claimed limitation. Ans. 22–23.

Appellants additionally argue Herrero fails to teach “receiving, from the recipient, a task response.” Br. 37–38. Yet, as the Examiner correctly finds, Herrero teaches an edit task button that allows a user to modify the complete percentage for a task (e.g., 100% complete), which teaches a task response. Ans. 24 (citing Herrero ¶ 58, Fig. 9, 928).

Appellants also argue Herrero and Pradhan fail to teach “updating, using the email client and based upon the task response, the logical thread list.” Br. 39–40. Pradhan’s paragraph 85 and Figure 7, however, describe a “State Change History” that is a list of actions taken with respect to a

project, which teaches updating the logical thread list. *See* Ans. 25.

Appellants argue the combination of Herrero and Pradhan is not based on a rational underpinning. Br. 37. Upon reviewing the record before us, we find that the Examiner’s rationale for the proposed modification in the prior art suffices as an articulated reason with some rational underpinning to establish a prima facie case of obviousness. *See* Ans. 22–23; *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). In summary, we find that an ordinarily skilled artisan at the time of the claimed invention would have combined Pradhan’s teaching of emails and a logical thread (*see* Pradhan ¶¶ 79, 87, Figs. 2, 8A, 8B), with Herrero’s teaching of modifying a logical thread list (*see* Herrero Fig. 9, ¶¶ 51, 55, 68) to nominate a particular person for an action. Final Act. 6; Ans. 22–23. In the absence of sufficient evidence or line of technical reasoning to the contrary, the Examiner’s findings are reasonable and we find no reversible error.

Accordingly, for these reasons and for the additional reasons stated in the Final Rejection and Answer, we sustain the rejection of claim 25. Appellants state that “claims 26-27, 30-34, 37-41, and 44-45 stand or fall together with independent claim 25.” Br. 28. Because we sustain the rejection of claim 25, we likewise sustain the rejection of these claims under 35 U.S.C. § 103(a) over the combination of Herrero and Pradhan.

Dependent Claim 28

The Examiner finds that the combination of Herrero, Pradhan, and Hammer teach “the task response is included within a second email from the recipient,” as recited in dependent claim 28. Ans. 25–27. Appellants argue that the Examiner erred by relying on a “making integral” rationale and that Pradhan does not teach in paragraph 86 that it is beneficial to link

communications with task changes. Br. 42.

We are unpersuaded by Appellants' arguments because, as explained by the Examiner, Herrero assigns a task to a user and allows for that user to mark the task as complete, and Pradhan teaches communication via email. Ans. 25–26. Contrary to Appellants' argument, we find Pradhan teaches emails are sent back and forth between project people to facilitate communication. Pradhan, in paragraph 86, explains that “[t]he originating document may appear like the interface shown in FIG. 6 with annotations provided *on the communication* indicating which portion or portions of the document reference the work item” (emphasis added). Thus, we agree with the Examiner's finding that Pradhan teaches it is beneficial to link communications with task changes.

Upon reviewing the record before us, we find that the Examiner's rationale for the proposed modification in the prior art suffices as an articulated reason with some rational underpinning to establish a prima facie case of obviousness for claim 28. *See* Ans. 25–27; Final Act. 7–8. The Examiner's proposed combination of the cited teachings of Herrero, Pradhan, and Hammer is no more than a simple arrangement of old elements with each performing the same function it had been known to perform, yielding no more than one would expect from such an arrangement. *KSR*, 550 U.S. at 416. The ordinarily skilled artisan, being “a person of ordinary creativity, not an automaton,” would be able to fit the teachings of the cited references together like pieces of a puzzle to predictably result in a task response being included within a second email from the recipient. *Id.* at 420–21. Because Appellants have not demonstrated that the Examiner's proffered combination would have been “uniquely challenging or difficult

for one of ordinary skill in the art,” we agree with the Examiner that the proposed modification would have been within the purview of the ordinarily skilled artisan. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418). Accordingly, absent persuasive rebuttal evidence or technical reasoning to the contrary, we are not persuaded that the Examiner erred in finding the combination of Herrero, Pradhan, and Hammer teaches or suggests “the task response is included within a second email from the recipient,” as recited in dependent claim 28. Therefore, we sustain the rejection of dependent claim 28.

Appellants state that “claims 29, 35-36, and 42-43 stand or fall together with dependent claim 28.” Br. 41. Because we sustain the rejection of claim 28, we likewise sustain the rejection of these claims under 35 U.S.C. § 103(a) over the combination of Herrero, Pradhan, and Hammer.

DECISION

We affirm the rejection of claims 25–45.

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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED