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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte OMAYMA EL-SAYED MOHARRAM

Appeal 2017-010364¹
Application 10/668,133²
Technology Center 3600

Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and
NINA L. MEDLOCK, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–8, 10–19, 21–26, 40–45, and 47–51. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellant’s Appeal Brief (“App. Br.,” filed April 17, 2017) and Reply Brief (“Reply Br.,” filed July 31, 2017), and the Examiner’s Answer (“Ans.,” mailed June 5, 2017) and Final Office Action (“Final Act.,” mailed November 23, 2016).

² Appellant identifies the inventor, Omayma E. Moharram, as the real party in interest. App. Br. 3.

CLAIMED INVENTION

Appellant's claimed invention "relates generally to business tools and, in particular, to [a] tool and method for [determining an] operations, management, capacity, and services (OMCS) business solution for a telecommunications network" (Spec. ¶ 1).

Claims 1 and 40 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A computer program product comprising a non-transitory computer-readable medium having stored thereon instructions for causing a computer to perform a process for determining alternative management processes for managing selected network architectures for a telecommunications network, the computer program product comprising instructions for:

(a) receiving data and options for various management processes, which comprise network management processes and service and customer management processes, for managing said network architectures;

(d) selecting the network management processes and the service and customer management processes for manual and mechanized operations mode for managing said network architectures,

wherein the network management processes comprise processes having costs for the manual and mechanized operations mode for each network element of said network architectures, and

wherein the service and customer management processes comprise processes having costs for the manual and mechanized operations mode for each link of said network architectures;

(e) determining management processes costs, which comprise a network management processes cost and a service and customer management processes cost for the manual and mechanized operations mode for each network element and link of said network architectures; and

computing the network management processes cost, which comprises totaling the network elements for each of said network architectures and the costs for the manual and mechanized operations mode for each network element of said network architectures; and the service and customer management processes cost, which comprises totaling the links for each of said network architectures and the costs for the manual and mechanized operations mode for each link of said network architectures;

(g) determining business parameters for the telecommunications network based on the costs of the network architectures, the network management processes cost, and the service and customer management processes cost; and comparing the business parameters for said network architectures for determining the management processes costs for reducing total expenditure; and

(h) storing and displaying the network management processes and the service and customer management processes for managing said network architectures, the costs for the network architectures, the management processes costs, which comprise the network management processes cost, and the service and customer management processes cost, and the business parameters for the telecommunications network.

REJECTIONS

Claims 1–8, 10–19, 21–26, 40–45, and 47–51 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–8, 10–19, 21–26, 40–45, and 47–51 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1–8, 10–19, 21–26, 40–45, and 47–51 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly

point out and distinctly claim the subject matter that Appellant regards as the invention.

Claims 1–8, 10, 15–19, 21–26, 40–45, and 47–51 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ngi et al. (US 2003/0158765 A1, pub. Aug. 21, 2003) (“Ngi”), Bowman-Amuah (US 6,611,867 B1, iss. Aug. 26, 2003), and EURESCOM Project P901-PF “Extended investment analysis of telecommunication operator strategies” (“EURESCOM”): Deliverable 1: “Investment analysis framework definition and requirements specification” (“D1”); Deliverable 2: “Investment Analysis Modeling” (“D2”).

Claims 11–14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ngi, Bowman-Amuah, EURESCOM, and Arbel et al. (US 2004/0008673 A1, pub. Jan. 15, 2004) (“Arbel”).

ANALYSIS

Patent-Ineligible Subject Matter

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

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 (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 Corp.*, 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.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, 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 there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78).

The Court acknowledged in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. Therefore, the Federal Circuit has instructed that claims are to be considered in their entirety to determine “whether their character as a whole is directed to excluded subject matter.” *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

In rejecting the pending claims under 35 U.S.C. § 101, the Examiner determined that the claims are directed to “determining business solutions,” which the Examiner concluded is a fundamental economic practice, an idea of itself, and also a method of organizing human activities and, therefore, an abstract idea (Final Act. 4–8). The Examiner also determined that the claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the claims recite “generic computer elements (e.g., *a computer readable medium*) which do not add a meaningful limitation to the abstract idea because they would be routine in any computer implementation” (*id.* at 11–12).

Appellant first charges that the Examiner erred in rejecting independent claims 1 and 40 under § 101 because “the claimed invention effect[s] an improvement in the **technology and technical field** of operations and management processes of telecommunication networks” (App. Br. 6). Appellant asserts that the claimed invention is “directed towards determining operations and management processes, (or management networks), for managing specific network architecture and technology[,] and [quantifying the] *pertinent costs* of the operations and management processes for managing the specific network architecture and technology” (*id.* at 7). And Appellant argues that the claimed invention effects a technological improvement “for the reasons that prior art references are *only* directed to planning network architectures and technologies” whereas the claimed invention is “directed to determining alternative management processes, (or management networks), for completely managing the network architectures and technologies for the telecommunications network” (*id.* at 8).

Appellant appears to be arguing that the claims are patent-eligible because the claimed invention is distinguishable from the prior art. Yet, neither a finding of novelty nor a non-obviousness determination automatically leads to the conclusion that the claimed subject matter is patent-eligible. Although the second step in the *Mayo/Alice* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for “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.’” *Alice Corp.*, 134 S. Ct. at 2355 (citation omitted).

“Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90; *see also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (“The ‘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.”).

Focusing specifically on independent claim 1, Appellant asserts that claim 1 is directed to a process for determining alternative management processes for managing selected network architectures for a telecommunications network (App. Br. 9), and that the claim includes additional elements, i.e., steps (d), (e), and (g), which “add **significantly more** to prior references, which are directed *only* to planning network architectures and technologies” (*id.* at 10). But again, Appellant appears to be arguing that the claim is patent-eligible because it is patentable over the prior art, which, as described above, is not persuasive of Examiner error.

Appellant further asserts that the technical improvement of the claimed invention is “directed towards: (1) determining alternative management processes for managing selected network architectures and technologies; and (2) reducing costs for the alternative management processes for managing the selected network architectures and technologies” (*id.* at 10–11). But, we fail to see how or why, and Appellant does not explain how or why, this constitutes a technological improvement as opposed to an improvement in a business practice.

Appellant offers substantially similar arguments with respect to independent claim 40 (*id.* at 11–12). But, as with claim 1, Appellant does not explain how or why “determining alternative management processes, (or the management networks), for completing managing various network architectures and technologies for a telecommunications network” and reducing costs for the alternative management processes, (or management networks), for managing various network architectures and technologies for the telecommunications network” constitutes a technical improvement. Instead, Appellant merely asserts, “the claimed invention discloses a computer program product and a method, which are both *novel and inventive*” (*id.* at 12), which is not persuasive of Examiner error.

We are not persuaded, on the present record, that the Examiner erred in rejecting independent claims 1 and 40 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection. We also sustain the Examiner’s rejection under § 101 of dependent claims 2–8, 10–19, 21–26, 41–45, and 47–51, which are not argued separately except based on their dependence from independent claims 1 and 40 (*id.* at 13).

Written Description

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact and is assessed on a case-by-case basis. *See, e.g., Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991)). The disclosure, as originally filed, need not literally describe the claimed subject matter (i.e., using the same terms or *in haec verba*) in order to satisfy the written description requirement. But the Specification must convey with reasonable

clarity to those skilled in the art that, as of the filing date, Appellant was in possession of the claimed invention. *See id.*

In rejecting independent claims 1 and 40 under § 112, first paragraph, the Examiner takes the position that the Specification lacks sufficient written description support for limitations (d) and (e), as recited in independent claim 1, and similarly recited in independent claim 40 (Final Act. 24–25). The remaining claims are rejected based on their dependence from claims 1 and 40 (*id.* at 26).

We agree with Appellant that the original Specification includes the requisite written description support at least in paragraphs 136–138 and Table 1430 of Figure 14 (App. Br. 15–22) (identifying the portions of the Specification and drawings where the requisite written description is found). Therefore, we do not sustain the Examiner’s rejection of independent claims 1 and 40 under 35 U.S.C. § 112, first paragraph. For the same reasons, we also do not sustain the Examiner’s rejection of dependent claims 2–8, 10–19, 21–26, 41–45, and 47–51.

Indefiniteness

Appellant does not provide any response to the Examiner’s rejection of claims 1–8, 10–19, 21–26, 40–45, and 47–51 under 35 U.S.C. § 112, second paragraph. Therefore, the Examiner’s rejection is summarily sustained.

Obviousness

Independent Claims 1 and 40 and Dependent Claims 2–8, 10, 15–19, 21–26, 41–45, and 47–51

Appellant maintains that none of the cited references, individually or in combination, discloses or suggests limitations (d) and (e), as recited in

independent claim 1, and similarly recited in independent claim 40 (App. Br. 23–33). Yet, Appellant’s arguments amount to no more than a recitation of the claim language, summaries of the cited references, and general allegations of patentability (*id.* at 25–32), from which Appellant summarily concludes, “*a person of ordinary skill in the art* would not find reason (or motive) to modify the prior art references for claims **elements (d) and (e)** of the claimed invention. Hence, the claimed invention of the present application **cannot be obvious**” (*id.* at 33).

Appellant may well disagree with how the Examiner interpreted and applied the references, but Appellant offers no substantive arguments to rebut the specific underlying factual findings made by the Examiner in support of the ultimate legal conclusion of obviousness. And we decline to examine the claims *sua sponte*, looking for distinctions over the prior art. *Cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art.”).

In the absence of a more detailed explanation, we are not persuaded of error on the part of the Examiner. *See In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections.” (citing *Ex Parte Frye*, 94 USPQ2d 1072 (BPAI 2010) (precedential) (“The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon.”))). Therefore, we sustain the Examiner’s rejection of independent claims 1 and 40 under 35 U.S.C. § 103(a). For the same reasons, we also

sustain the Examiner's rejection of dependent claims 2–8, 10, 15–19, 21–26, 41–45, and 47–51, which were not argued separately except based on their dependence from claims 1 and 40 (App. Br. 36–37).³

Dependent Claims 11–14

Claims 11–14 depend, directly or indirectly, from independent claim 1. Appellant does not present any substantive arguments in support of the patentability of claims 11–14 except to assert that Arbel does not cure the deficiencies of Ngi, Bowman-Amuah, and EURESCOM, and that claims 11–14 are non-obvious for the same reasons that independent claim 1 is non-obvious (App. Br. 37–38).

We are not persuaded, for the reasons set forth above, that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a). Therefore, we sustain the Examiner's rejection of claims 11–14 for the same reasons.

DECISION

The Examiner's rejection of claims 1–8, 10–19, 21–26, 40–45, and 47–51 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejection of claims 1–8, 10–19, 21–26, 40–45, and 47–51 under 35 U.S.C. § 112, first paragraph, is reversed.

The Examiner's rejection of claims 1–8, 10–19, 21–26, 40–45, and 47–51 under 35 U.S.C. § 112, second paragraph, is affirmed.

³ The Appeal Brief includes a section entitled “Objective evidence present in the application indicating nonobviousness” in which Appellant variously describes the claimed invention, including “the key objective” of the claimed invention, the motivation of the invention, and its “focal point.” But, as the Examiner also observes (Ans. 19–20), there is nothing in that section that provides objective evidence of non-obviousness, e.g., unexpected results, commercial success, long-felt but unsolved needs, failure of others.

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The Examiner's rejections of claims 1–8, 10–19, 21–26, 40–45, and 47–51 under 35 U.S.C. § 103(a) are 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)(1)(iv).

AFFIRMED