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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YUMIKO CHRISTINE YOKOI, NANCY V. LANG,
JUSTIN CRAIG FIELD, ANDREW PHILIP GILLIBRAND,
HITESHBHAI D. SHAH, and STEVEN K. CHU

Appeal 2017-010839
Application 13/407,342¹
Technology Center 2100

Before ROBERT E. NAPPI, CATHERINE SHIANG, and STEVEN M.
AMUNDSON, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1, 3, 4, 7–11, and 14–17, which are all the claims pending and rejected in the application.² We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ Appellants identify Oracle International Corporation as the real party in interest (Appeal Br. 1).

² The Examiner objects to claim 1 (Final Act. 5), and such objection is not before us.

STATEMENT OF THE CASE

Introduction

According to the Specification, the present invention relates to communications applications that facilitate diverting, tagging, or otherwise associating messages for predetermined purposes. *See generally* Spec. 1.

Claim 1 is exemplary:

1. A method, performed by one or more processors, of managing performance feedback of a group of persons associated with an enterprise, the method comprising:
 - designating, by the one or more processors and in response to input signals selecting a portion of electronic message content displayed in an electronic message presentation interface, only a selected portion of an electronic message as a designated unsolicited feedback information portion, with the designated unsolicited feedback information portion of the electronic message pertaining to performance evaluation of a particular person in the group of persons and with the electronic message including a portion other than the designated unsolicited feedback portion;
 - directing, by the one or more processors, only the designated unsolicited feedback information portion of the electronic message to populate in feedback pool, with the feedback pool being a repository of feedback information and with the feedback pool populated with feedback information including feedback information for each person in the group of persons associated with the enterprise;
 - searching, by the one or more processors and in response to input signals received from a search user interface, for feedback information, stored in the feedback pool, relating to the particular person in the group of persons; and
 - displaying, by the one or more processors, feedback search results, retrieved from the feedback pool, for the particular person in the group of persons on a display user interface, with the display user interface including a plurality of controls to facilitate organizing information in the feedback pool and a plurality of feedback sections, with each feedback

section displaying feedback information, including the designated unsolicited feedback information portion, returned from the feedback pool relating to the particular person and displaying identity information for each participating feedback person who provided displayed feedback information and with the controls including one or more of: a tag feedback control, responsive to input signals, facilitating tagging of displayed feedback information; a link feedback control, responsive to input signals, facilitating linking displayed feedback information to one or more specified computing objects, including goals, projects or participants; and a goal creation control, responsive to input signals, for creating a goal and associating displayed feedback information with the goal.

References and Rejections

Claims 1, 3, 4, 7–11, and 14–17 are rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

Claims 1, 3, 4, 7–11, and 14–17 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Cochran (US 2004/0030697 A1; Feb. 12, 2004), Bensky (US 2006/0173824 A1; Aug. 3, 2006), and Lindia (US 2002/0184085 A1; Dec. 5, 2002).

ANALYSIS

We disagree with Appellants' arguments, and agree with and adopt the Examiner's findings and conclusions in (i) the action from which this appeal is taken (Final Act. 7–23) and (ii) the Answer (Ans. 2–17) to the extent they are consistent with our analysis below.³

³ To the extent Appellants advance new arguments in the Reply Brief without showing good cause, Appellants have waived such arguments. *See* 37 C.F.R. § 41.41(b)(2).

35 U.S.C. § 101

The Examiner rejects the claims under 35 U.S.C. § 101 because they are directed to patent-ineligible subject matter. *See* Ans. 2–5. In particular, the Examiner concludes the claims are directed to the abstract idea of selecting, storing, searching, and displaying information. *See* Ans. 3–4. The Examiner determines the claims are similar to the claims of *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). *See* Ans. 3. The Examiner determines the claims use generic computer components to perform generic computer functions. *See* Ans. 3–4. Appellants argue the Examiner erred under *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016). *See* Reply Br. 1.

Appellants have not persuaded us of error. Section 101 of the Patent Act provides “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. That provision “contains an important implicit exception: Laws 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 *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). According to the Supreme Court:

[W]e set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . If so, we then ask, “[w]hat else is there in the claims before us?” . . . To answer that question, we consider the elements of each claim both

individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. . . . We have described step two of this analysis as a 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.”

Alice Corp., 134 S. Ct. at 2355.

The Federal Circuit has described the *Alice* step-one inquiry as looking at the “focus” of the claims, their “character as a whole,” and the *Alice* step-two inquiry as looking more precisely at what the claim elements add—whether they identify an “inventive concept” in the application of the ineligible matter to which the claim is directed. *See Elec. Power*, 830 F.3d at 1353; *Enfish*, 822 F.3d at 1335–36; *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

Regarding *Alice* step one, the Federal Circuit has “treated *collecting information*, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.” *Elec. Power*, 830 F.3d at 1353 (emphasis added); *see also Internet Patents*, 790 F.3d at 1348–49; *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015); *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014). “In a similar vein, we have treated *analyzing information* [including manipulating 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*, 830 F.3d at 1354 (emphasis added); *see also In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016). “And we have recognized that *merely presenting the results of*

abstract processes of collecting and analyzing information, without more (such as identifying a particular tool for presentation), is abstract as an ancillary part of such collection and analysis.” *Elec. Power*, 830 F.3d at 1354 (emphasis added); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714–15 (Fed. Cir. 2014).

The rejected claims “fall into a familiar class of claims ‘directed to’ a patent-ineligible concept.” *Elec. Power*, 830 F.3d at 1353; *see also* Ans. 3. Contrary to Appellants’ arguments (Reply Br. 1), the claims are similar to the claims of *Electric Power*, and are focused on the combination of abstract-idea processes or functions. *See Elec. Power*, 830 F.3d at 1354. For example, claim 1 is directed to analyzing (including selecting and searching) information (“designating . . .”; “searching . . .”), collecting information (“directing . . . to populate . . .”), and displaying information (“displaying . . .”). Independent claims 16 and 17 are directed to performing similar functions of analyzing, collecting, and displaying information. *See* claims 16–17; *Elec. Power*, 830 F.3d at 1353. The dependent claims are directed to similar functions or processes, and Appellants have not shown such claims are directed to other non-abstract functions or processes. *See* claims 3, 4, 7–11, 14, and 15.

In response to the Examiner’s rejection, Appellants merely cite excerpts from *Enfish* and assert:

In *Enfish, LLC v. Microsoft Corp*, the claims recited specific data tables and the manner in which the tables relate to each other and are processed. Claim 1 recites data structures and the manner that those data structures relate to each other and are processed. For example, Claim 1 recites

In a similar manner, the other independent Claims 14, 15,⁴ 16, and 17 recite data structures and the manner that those data structures relate to each other and are processed.

Reply Br. 1.

We disagree. In *Enfish*, the court determines:

The . . . patents are directed to an innovative logical model for a computer database. . . . A logical model generally results in the creation of particular tables of data, but it does not describe how the bits and bytes of those tables are arranged in physical memory devices. Contrary to conventional logical models, the patented logical model includes all data entities in a single table, with column definitions provided by rows in that same table. The patents describe this as the “self-referential” property of the database.

Enfish, 822 F.3d at 1330.

[T]he plain focus of the claims is on an improvement to computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity.

. . . [T]he claims . . . are directed to a specific improvement to the way computers operate, embodied in the self-referential table.

Accordingly, we find that the claims at issue in this appeal are not directed to an abstract idea within the meaning of Alice. Rather, they are directed to a specific improvement to the way computers operate, embodied in the self-referential table.

Enfish, 822 F.3d at 1336.

[T]he claims are directed to a specific implementation of a solution to a problem in the software arts. Accordingly, we find the claims at issue are not directed to an abstract idea.

Enfish, 822 F.3d at 1339.

⁴ Claims 14 and 15 depend on claim 1. *See* claims 14–15. Appellants incorrectly state claims 14 and 15 are independent claims.

Appellants have not shown the rejected claims are like the claims of *Enfish*, because they have not shown the rejected claims are directed to “a specific improvement to the way computers operate, embodied in the self-referential table.” *Enfish*, 822 F.3d at 1336. Nor have Appellants shown the rejected claims are directed to “an improvement to computer functionality itself.” *Enfish*, 822 F.3d at 1336. In particular, Appellants’ assertion that the claims are directed to “data structures and the manner that those data structures relate to each other and are processed” (Reply Br. 1) does not explain why and how such claims are patent eligible under *Enfish*.

Regarding *Alice* step two, Appellants do not assert the Examiner’s determination is incorrect. As discussed above, Appellants only advance arguments under *Enfish*, which is decided under *Alice* step one. *See Enfish*, 822 F.3d at 1339 (“Because the claims are not directed to an abstract idea under step one of the *Alice* analysis, we do not need to proceed to step two of that analysis.”).

In reaching the decision, we have considered only the arguments Appellants actually raised. Arguments that Appellants could have made but chose not to make are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Because Appellants have not persuaded us the Examiner erred, we sustain the Examiner’s rejection of claims 1, 3, 4, 7–11, and 14–17 under 35 U.S.C. § 101.

35 U.S.C. § 103

On this record, the Examiner did not err in rejecting claim 1.

I

Appellants contend:

Claim 1 recites . . . “the designated unsolicited feedback information portion of the electronic message pertaining to performance evaluation of a particular person.” In contrast, Cochran teaches that a user requests display of a document using a browser, selects a portion of the displayed document, provides feedback about the selected portion of the document using . . . a form (see Cochran 0058-0059). Therefore, Cochran’s selected portion of Cochran’s document is the subject of Cochran’s feedback instead of the feedback information itself.

. . . Accordingly, the electronic message includes the feedback information prior to being designated and that feedback information that is in the electronic message is stored in a feedback pool.

In contrast, Cochran’s electronic message does not include feedback at all but is instead the subject of the feedback. For example, Cochran teaches selecting a portion of the document and using a form to provide feedback on the selected portion (see Cochran 0058-0059).

Appeal Br. 9–10; *see also* Reply Br. 2–5.

Appellants have not persuaded us of error. In particular, Appellants’ arguments are unpersuasive because they are not directed to the Examiner’s specific findings. The Examiner maps the claimed electronic message to Cochran’s document 12. *See* Final Act. 8; Ans. 8; Cochran Fig. 19. The Examiner correctly maps the claimed “only a selected portion of an electronic message as a designated unsolicited feedback information portion” to Cochran’s “a portion of the document 14 that has been highlighted by the user.” Cochran ¶ 101, Fig. 19; *see also* Final Act. 8;

Ans. 8. As shown in Cochran's Figure 19 and contrary to Appellants' above arguments, the document 12 includes "a portion of the document 14."

II

Appellants argue:

Cochran teaches away from . . . "designating, by the one or more processors and in response to input signals selecting a portion of electronic message content displayed in an electronic message presentation interface, only a selected portion of an electronic message as a designated unsolicited feedback information portion, with the designated unsolicited feedback information portion of the electronic message; directing, by the one or more processors, only the designated unsolicited feedback information portion of the electronic message to populate in feedback pool, with the feedback pool being a repository of feedback information and with the feedback pool populated with feedback information including feedback information for each person in the group of persons associated with the enterprise," as recited by independent Claim 1. . . . Cochran teaches receiving a document, selecting portions of the document, providing feedback about the selected portion in a location that is outside of the document that includes the selected portion (see Cochran 0058, 0059). Cochran requires providing the feedback about the selected portion that is outside of the document because Cochran requires reviewing and approving the feedback before changing the document that the feedback pertains to (see Cochran 0065 lines 8-13, 0084). Therefore, Cochran teaches away from Cochran's feedback being a part of Cochran's document at the time that Cochran selects the portion of Cochran's document that the feedback will pertain to

. . . Cochran's subject of feedback is Cochran's document. A document can be displayed. However, Claim 1 recites "the designated unsolicited feedback information portion of the electronic message pertaining to performance evaluation

of a particular person.” A person cannot be displayed. Further, portions of a person cannot be selected. Therefore, Cochran teaches away from “only a selected portion of an electronic message as a designated unsolicited feedback information portion, with the designated unsolicited feedback information portion of the electronic message pertaining to performance evaluation of a particular person,” as recited by independent Claim 1.

Appeal Br. 10–11 (emphases omitted); *see also* Reply Br. 2–3.

As discussed above, Appellants’ arguments are unpersuasive because they are not directed to the Examiner’s specific findings. In particular, the Examiner correctly maps “only a selected portion of an electronic message as a designated unsolicited feedback information portion” to Cochran’s “a portion of the document 14 that has been highlighted by the user”—not some outside feedback that is outside the document 14, as Appellants assert (Appeal Br. 10).

In any event, Appellants’ teaching away argument is unpersuasive. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (citation omitted). “The prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed in the . . . application.” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Here, Appellants have not provided adequate analysis under the case law, and have not demonstrated Cochran’s teachings “criticize, discredit, or otherwise discourage” the claimed invention. *Fulton*, 391 F.3d at 1201.

III

Appellants assert:

Bensky does not teach or suggest at least “tagging of displayed feedback information . . . linking displayed feedback information to one or more specified computing objects, including goals, projects or participants; and a goal creation control . . . for creating a goal and associating displayed feedback information with the goal.”

Appeal Br. 12.

Appellants’ general assertion is unpersuasive of error. *See* 37 C.F.R. § 41.37(c)(1)(iv) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”); *see also In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (holding that “the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art”).

IV

In the Reply Brief and for the first time, Appellants belatedly argue there is no motivation to modify Cochran’s teachings to move the feedback information inside the document. *See* Reply Br. 5. Appellants have waived such arguments because they are untimely, and Appellants have not demonstrated any “good cause” for the belated presentation. *See* 37 C.F.R. § 41.41(b)(2). We also note Appellants’ belated arguments are unpersuasive: Appellants’ arguments are not directed to the Examiner’s specific findings, because the Examiner does not move Cochran’s feedback information, as Appellants assert (Reply Br. 5).

Because Appellants have not persuaded us the Examiner erred, we sustain the Examiner's rejection of independent claim 1, and independent claims 16 and 17 for similar reasons.

We also sustain the Examiner's rejection of corresponding dependent claims 3, 4, and 7–11, as Appellants do not advance separate substantive arguments regarding those claims.

Separately Argued Dependent Claims

Regarding dependent claims 14 and 15, Appellants assert Cochran teaches away from “further including providing a user interface control that is adapted to enable a recipient of an electronic message to designate the electronic message or a portion thereof as feedback information,” as recited in claim 14. *See* Appeal Br. 13–14. Appellants also assert Cochran teaches away from “further including providing a user interface control for displaying content of a performance review document and providing a user option to search for designated contents of one or more particular electronic messages that have been designated as feedback information,” as recited in claim 15. *See* Appeal Br. 15–16. In particular, Appellants advance teaching-away arguments discussed above with respect to claim 1.

As discussed above, Appellants' teaching-away arguments are unpersuasive because they are not directed to the Examiner's specific findings, and Appellants fail to provide adequate analysis under the case law. Therefore, for similar reasons discussed above with respect to claim 1, we affirm the Examiner's rejection of dependent claims 14 and 15.

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Application 13/407,342

DECISION

We affirm the Examiner's decision rejecting claims 1, 3, 4, 7–11, and 14–17.

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