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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BETH ANN WRIGHT

Appeal 2017-010986¹
Application 14/100,604²
Technology Center 3700

Before HUBERT C. LORIN, MEREDITH C. PETRAVICK, and
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

SCHOPFER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the Examiner’s Final rejection of claims 21, 23–27, 29–33, and 35–41. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references the Appeal Brief (“Appeal Br.,” filed Jan. 23, 2017), the Supplemental Appeal Brief (“Supp. Br.,” filed Mar. 7, 2017), the Reply Brief (“Reply Br.,” filed Aug. 23, 2017), the Examiner’s Answer (“Ans.,” mailed July 6, 2017), and the Final Office Action (“Final Act.,” mailed Aug. 25, 2016).

² Appellant does not provide a real party in interest. *See* Appeal Br. 1–26.

BACKGROUND

According to Appellant, “[t]he present invention generally relates to learning, and more particularly to learning of occupational performance for competency based education and work force performance.” Spec. ¶ 4.

CLAIMS

Claims 21, 27, and 33 are the independent claims on appeal. Claim 21 is illustrative of the appealed claims and recites:

21. A system for assisting selection of goal-based content relating to occupational performance, comprising:

one or more processors;

one or more memory devices operatively coupled to the one or more processors;

one or more input means operatively coupled to the one or more processors;

one or more display means operatively coupled to the one or more processors; and

software instructions stored on the one or more memory devices and executed by the one or more processors,

said instructions including a predetermined competency goal element list having a plurality of competency goals,

said instructions including a predetermined performance standard goal element list having subsets, each subset selectively associated with one of the competency goals of the predetermined competency goal element list,

said instructions including a predetermined component goal element list having subsets, each subset selectively associated with one of the competency goals of the predetermined competency goal element list, and

said instructions including a predetermined measurement goal element list having subsets, each subset

selectively associated with one of the competency goals of the predetermined competency goal element list, comprising:

instructions for generating a graphical user interface (GUI) on the display means including identification of a competency goal relating to an occupational performance of a user, including instructions enabling development of a competency goal program by collecting, via the GUI and the input means, a competency goal from the predetermined competency goal element list and automatically thereafter collecting, via the GUI and the input means, (1) a performance standard from the predetermined performance standard goal element list, (2) a component from the predetermined component goal element list, and (3) a measurement from the predetermined measurement goal element list,

wherein each of the predetermined performance standard goal element list, the predetermined component goal element list, and the predetermined measurement goal element list are based on the collected competency goal, and

instructions requiring sequential selection, via the GUI and the input means, of:

a competency goal from the predetermined competency goal element list identifying a skill or behavior from the plurality of competency goals presented in the predetermined competency goal element list of the GUI on the display means;

a performance standard from the subset of the predetermined performance standard goal element list associated with the selected competency goal automatically upon the selection of the selected competency goal, wherein the selected performance standard

comprises a process to assist the user in achieving the selected competency goal from a plurality of performance standards presented in the subset of the predetermined performance standard goal element list of the GUI on the display means;

a component goal from the subset of the predetermined component goal element list associated with the selected competency goal automatically upon the selection of the selected performance standard, wherein the selected component goal comprises at least one of tools, media, activities, and curriculum presented in the subset of the predetermined component goal element list of the GUI on the display means for use in implementing the selected performance standard for achieving the selected competency goal; and

a measurement goal from the subset of the predetermined measurement goal element list associated with the selected competency goal automatically upon the selection of the selected component goal, wherein the measurement goal comprises a criteria relevant to implementing the selected performance standard for achieving the selected competency goal using the selected component wherein the selected criteria is selected from a plurality of measurements presented in the subset of the predetermined measurement goal element list of the GUI on the display means.

Supp. Br. 1–3.

REJECTION

The Examiner rejects claims 21, 23–27, 29–33, and 35–41 under 35 U.S.C. § 101.

DISCUSSION

Appellant argues claims 21, 23–27, 29–33, and 35–41 as a group. *See* Appeal Br. 10–15. We select independent claim 21 as representative of this group, and the remaining claims stand or fall with independent claim 21. *See* 37 C.F.R. § 41.37(c)(1)(iv).

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 35 U.S.C. § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty Ltd. 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.*, 132 S. Ct. 1289, 1300 (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,” e.g., to an abstract idea. *Id.* If the claims are not directed to a patent-ineligible concept, 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.” *Alice Corp.*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1297).

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*, 132 S. Ct. at 1293. We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

Here, regarding *Alice* step one, the Examiner determined that the independent claims “are directed to an invention relating to the evaluation of a user’s occupational performance,” which “is similar to the other types of basic concepts that have been found by the courts to be abstract” including mathematical algorithms related to managing a game, a user interface for meal planning, and comparing information from a sample to a control. Final Act. 2. Moreover, the Examiner finds that the claimed “concept could be carried out by a human mind, a pen and paper or in a computer and is similar to the kind of ‘organizing human activity’ in *Alice*.” *Id.* at 3. In the Answer, the Examiner also finds that the claims relate to the “well established practice [of using] a computer to implement a multiple-choice question or a performance assessment checklist.” Ans. 4–5.

In response, Appellant argues that “the claims of the present application include elements ‘specifically designed to achieve an improved technical result,’ which the *McRO* court held is not an abstract idea.” Appeal Br. 11 (citing *McRO, Inc. v. Bandai Namco Games America Inc.*, 837, F.3d, 1299, 1316 (Fed. Cir. 2016)). In support, Appellant asserts that

the independent claims “address the problem of assisting selection of goal-based content relating to occupational performance” by providing “a closed-form approach that sequentially and automatically defines subsets of the predetermined goal element lists based on selected competency goals.” *Id.* at 10–11 (citing Spec. ¶¶ 92, 95, 168, 171). Appellant asserts that “the claimed approaches guard against user error by ensuring that users select at least one of each of the four recited goal elements” and “the computerized coupling [of the alpha-numeric binary data] guards against coding errors and preserves the integrity of data.” *Id.* at 11 (citing Spec. ¶¶ 86, 308). Finally, Appellant asserts:

[The] focus [of the claims] on providing a closed-form approach that sequentially and automatically defines subsets of the predetermined goal element lists based on a selected competency goal is in contrast to concepts identified as ineligible abstract ideas by the courts: merely collecting information, purely mental and/or mathematical steps of analyzing information, merely presenting the results of information collection and processing, or even combinations of these abstract concepts.

Id. (footnotes omitted). We are not persuaded by Appellant’s arguments.

Under step one of the framework set forth in *Alice*, we agree with the Examiner that the invention is broadly directed to “organizing human activity” (Final Act. 3), and more particularly, directed to “the evaluation of a user’s occupational performance.” *Id.* at 2. And based on our review of independent claim 21, we also agree with the Examiner that the claim involves only steps that may be carried out by the human mind or with pen and paper. *Id.* at 3. Further, we find that the claim involves nothing more than gathering, processing, and displaying data, without more, and is thus similar to the steps that the Federal Circuit determined were patent ineligible

in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016).

In *Electric Power*, the method claims at issue were directed to performing real-time performance monitoring of an electric power grid by collecting data from multiple data sources, analyzing the data, and displaying the results. *Electric Power*, 830 F.3d at 1351–52. The Federal Circuit held that the claims were directed to an abstract idea, explaining that “[t]he advance they purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions.” *Id.* at 1354. Here, we find independent claim 21 is directed to “[a] system for assisting selection of goal-based content relating to occupational performance” and includes software instructions that include data related to predetermined competency, performance, component, and measurement goal element lists and list subsets; displaying a means for allowing a user to sequentially select competency, performance, and component goals; and providing a measurement goal based on those selections. Thus, claim 21 is concerned with gathering data related to a user’s occupational goals and performance through a user interface, analyzing that data, and providing a measurement goal based on that analysis.

Accordingly, we find that independent claim 1 is directed to nothing more than collecting and analyzing data, receiving and storing data, and generating a measurement goal, without any particular inventive technology — activities squarely within the realm of abstract ideas. *See, e.g., Electric Power*, 830 F.3d at 1353–54 (When “[t]he focus of the asserted claims . . . is on collecting information, analyzing it, and displaying certain results of the

collection and analysis,” the claims are directed to an abstract idea.). *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.).

Further, we are not persuaded that the claims here are not directed to an abstract concept because they “include elements ‘specifically designed to achieve an improved technical result’” similar to the results addressed in *McRO*. Appeal Br. 11. In *McRO*, the claims “transformed a traditionally subjective process performed by human artists into a mathematically automated process executed on computers,” and did not simply use a computer to implement an abstract method. *Fair Warning IP, LLC v. Iatric Sys. Inc.*, 839 F.3d 1089, 1094 (Fed. Cir. 2016) (citing *McRO*, 837 F.3d at 1313–16). In contrast, claim 21 here simply automates the process of selecting goals, i.e., selecting a measurement goal from a list of goal elements based on a user’s selection of competency, performance, and component goals, which themselves were selected from lists of goal elements. Although the selection of goals is subjective to the particular user, the claims are not, in contrast to *McRO*, automating a user’s selections. Rather, the claim automatically generates goals based on a user’s selections. We also note that the claims do not address a problem unique to the Internet or computer networks. *Cf. Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1371 (Fed. Cir. 2015) (“[C]laims here do not address problems unique to the Internet, so *DDR* has no applicability.”). Rather, we agree with the Examiner that the claims relate only to a process of

determining a measurement goal based on selections that can be performed in the human mind or on paper. This determination is supported by the Specification, which identifies the objects of the invention only as providing a number of “learning models” related to various occupational and educational goals, without any specific technological requirements. *See* Spec. ¶¶ 14–28.

Turning to step two, the *Alice* step two inquiry is “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*, 134 S.Ct. at 2355 (citing *Mayo*, 132 S.Ct. at 1294).

Similar to the situation in *Electric Power*, we find nothing sufficient to remove the claims from the class of subject matter ineligible for patenting. As the court explained in *Electric Power*, “merely selecting information, by content or source, for collection, analysis, and display does nothing significant to differentiate a process from ordinary mental processes, whose implicit exclusion from [35 U.S.C.] § 101 undergirds the information-based category of abstract ideas.” *Electric Power*, 830 F.3d at 1355.

Here, we agree with the Examiner that the claims do nothing more than limit the performance of the abstract concept of determining a measurement goal to a general purpose computer. *See* Final Act. 3. Appellant argues that the claims recite “a specific closed-form approach that sequentially and automatically defines subsets of the predetermined goal element lists based on a selected competency goal, [and thus] the claims . . . represent a software-based invention that improves the performance of the computer system itself.” Appeal Br. 13. Appellant also indicates that the

claims add limitations other than those that are well-understood, routine, and conventional because the claims “contain a combination of elements that addresses the problem of assisting selection of goal-based content relating to occupational performance that, if using conventional open-form techniques, would be left without a framework of goal elements.” *Id.* But Appellant does not provide an explanation as to how the performance of the computer system is improved. Rather, the use of a “closed-form” approach as opposed to an “open-form” approach does not appear to be an issue related to how the computer operates and instead is related to how the information is presented to the user, i.e., the computer merely automates the process of presenting a user with a closed list of goal elements.

Appellant also argues that “[t]he novelty and non-obviousness of the claims of the present application over the prior art of record is further evidence that the claims are ‘significantly more’ than what is ‘well-understood, routine and conventional in the field.’” Appeal Br. 14. We disagree. The question in step two of the *Alice* framework is not whether an additional feature is novel or non-obvious, 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*, 116 F.3d 1343, 1347-1348 (quoting *Alice*, 134 S.Ct. at 2359).

Moreover, an abstract idea does not transform into an inventive concept just because the prior art does not disclose or suggest it. *See Mayo*, 566 U.S. at 91. “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the [35 U.S.C.]§ 101 inquiry.” *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U. S. 576, 591 (2013). Indeed,

“[t]he ‘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 [35 U.S.C.] § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188-89 (1981); *see also Mayo*, 566 U.S. at 91 (Rejecting “the Government’s invitation to substitute §§ 102, 103, and 112 inquiries for the better established inquiry under [35 U.S.C.] § 101.”).

Next, Appellant indicates that the claims recite “a massive, elegantly designed structured data set.” Appeal Br. 14. However, Appellant does not adequately explain how the claims recite such a dataset or how the use of such a dataset represents an inventive concept, such as an improvement over well-understood, routine, and conventional databases.

Finally, we note Appellant’s arguments regarding preemption. *See* Appeal Br. 12. Specifically, Appellant argues that the claimed “approach does not preempt the setting of goals, making of performance records, and organizing of communities in any of the multitude of other ways noted by the Office or found in the prior art of record” and the claims “recite particular solutions that do not preempt or monopolize any alleged abstract idea of the kind recognized by the case law.” *Id.* However, Appellant’s preemption argument does not alter our 35 U.S.C. § 101 analysis. Preemption concerns are fully addressed and made moot where a patent’s claims are deemed to disclose patent ineligible subject matter under the two-part framework described in *Mayo* and *Alice*. *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“While preemption may signal patent ineligible matter, the absence of complete preemption does not demonstrate patent eligibility.”).

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Based on the foregoing, we sustain the rejection of claims 21, 23–27, 29–33, and 35–41.

CONCLUSION

We AFFIRM the rejection of claims 21, 23–27, 29–33, and 35–41.

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