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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YASUTAKA NISHIMURA, AKIRA OHKADO, and
TADASHI TSUMURA

Appeal 2018-001730¹
Application 13/564,858²
Technology Center 3600

Before HUBERT C. LORIN, BRADLEY B. BAYAT, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

HUTCHINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1, 3, 4, and 6–17. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellants’ Appeal Brief (“App. Br.,” filed June 23, 2017) and Reply Brief (“Reply Br.,” filed Dec. 7, 2017), and the Examiner’s Answer (“Ans.,” mailed Nov. 3, 2017) and Final Office Action (“Final Act.,” mailed Apr. 21, 2017).

² Appellants identify International Business Machines Corporation as the real party in interest. App. Br. 2.

CLAIMED INVENTION

Appellants' claimed invention "relates to a method of managing an access right, and to a system and a computer program for the same." Spec.

¶ 2.

Claims 1, 6, and 9 are the independent claims. Claim 9, reproduced below, is illustrative of the claimed subject matter:

9. A method to manage an access right associated with a work order in a digital format, or to an access control device associated with an access path to the asset associated with the work order, the method comprising steps executed by a computer of:

at a scheduled start time for a work order to be executed, or in response to reception of a report indicating a start of work for the work order or a report indicating a completion of work for a preceding work order to the work order, the computer loading the work order into a memory of the computer, and authorizing a worker entity, designated in the loaded work order, to have the access right to the asset or the access control device; and

revoking a granted access right at a scheduled completion time for a work order already started, or in response to reception of a report indicating the completion of work for the work order already started or a report indicating the start of a succeeding work order to the work order already started, wherein the access right to the asset or the access control device is managed online by the computer, the method further comprising a step executed by the computer of:

transmitting a message to the asset or the asset control device indicating the granting of the access right of the worker entity to the asset or the access control unit to which the message indicating the granting is transmitted.

REJECTION

Claims 1, 3, 4, and 6–17 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

ANALYSIS

Independent Claims 1, 6, and 9, and Dependent Claims 2, 5, 7, 8, 10, and 11

Appellants argue claims 1, 2, and 5–11 as a group. App. Br. 10. We select independent claim 9 as representative. The remaining claims stand or fall with claim 9. *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 § 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*, 573 U.S. 208, 216 (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.*, 573 U.S. at 217. 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

Appeal 2018-001730
Application 13/564,858

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)).

We are not persuaded, as an initial matter, by Appellants’ arguments the Examiner erred in determining that claim 9 is directed to an abstract idea. App. Br. 10–14. The Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the [S]pecification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp.*, 790 F.3d at 1346). It asks whether the focus of the claims is on a specific improvement in relevant technology or on a process that itself qualifies as an “abstract idea” for which computers are invoked merely as a tool. *See id.* at 1335–36.

The Background section of the Specification discloses that assets, such as a computer, a lighting device, an air conditioner, and a power generator, are managed and maintained based on a work process. Spec. ¶ 3. A work order issues based on the work process. *Id.* The work order allows assets to be managed and maintained on a desired schedules, such as a monthly or bi-monthly basis, or after every 300 operation hours. *Id.* Once approved, the work becomes an executable work that is assigned to a worker. The assignment of the worker considers several factors, such as the date on which the work is to be executed; the needed skills and qualifications of the worker; and a current amount of work assigned to the worker. *Id.* The work order is approved through a process, and becomes an

executable work. *Id.* The worker registers the start and completion of work after assignment in an asset management application or reports the information to an asset manager. *Id.* It is known for the access control to manage an asset management target based on physical access control, such as allowing a particular user access to an asset, and also role-based access control, such as allowing a particular role access to a particular asset. *Id.* at ¶¶ 8–9. The Background describes a problem, however, with “none of the [] access controls [being] associated with a work process.” *Id.* at ¶ 10. “An object of the [claimed] invention is to give a worker associated with a work order an access right to an asset while the worker is performing management and maintenance work in accordance with the work order.” *Id.*

Claim 9 recites a method to manage an access right to an asset associated with a work order. The method includes the following steps: loading a worker order; authorizing a worker entity, designated in the loaded work order, to have the access right to the asset or the access control device; revoking a granted access right; and transmitting a message to the asset or the asset control device indicating the granting of the access right of the worker entity. The access right is tailored based on information in the work order. Understood in light of the Specification, claim 9 is directed to managing an access right to an asset/access control device associated with a work order, which is a commercial interaction, i.e., a method of organizing human activities and, therefore, an abstract idea. Therefore, we are not persuaded that the Examiner erred in determining that the claims are directed to concepts that are similar to other concepts the courts have held to be abstract ideas. *See* Ans. 2–4; *see also* Final Act. 3.

We disagree with Appellants that the abstract idea to which the claims are directed is not similar to any abstract idea identified by the courts in the

Appeal 2018-001730
Application 13/564,858

body of precedential case law. *See* App. Br. 11–14; *see also* Reply Br. 2–5. Here, we do not find the claims meaningfully different than the ideas found to be abstract in other cases involving methods of organizing human activity. In *Prism Technologies, LLC v. T-Mobile USA, Inc.*, 696 Fed. Appx. 1014, 1017 (Fed. Cir. 2017), for example, the asserted claims recited a method for restricting access to resources that involved: (1) receiving identify data from a devices with a request for access to resources; (2) confirming the authenticity of the identify data associated with that device; (3) determining whether the device identified is authorized to access the resources requested; and (4) if authorized, permitting access to the requested resources. *Id.* (citation omitted). There, the Federal Circuit held that the concept of “providing restricted access to resources” is an abstract idea analogous to other patent ineligible methods of organizing human activities. *Id.* (citing *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016) (finding the claims analogous to “inventions pertaining to methods of organizing human activity”); *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1367 (Fed. Cir. 2015) (finding the claim at issue “not meaningfully different from ideas found to be abstract in other cases . . . involving methods of organizing human activity”). Much like the claims at issue in *Prism Technologies*, Appellants’ representative claim 9 recites a method for managing a resource that involves receiving data (loading a work order), processing the data to authorize and then revoke access to the resource, and communicating the result of that processing to the resource. In this way, claim 9 also is similar to other claims found to be abstract involving collecting and analyzing data, and reporting the results of the collection and analysis. *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (claims directed to collecting, analyzing,

Appeal 2018-001730
Application 13/564,858

and displaying are directed to abstract ideas); *see also FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093 (Fed. Cir. 2016) (collecting information, analyzing the information according to rules to determine if the activity indicates improper access, and providing notification if improper access has occurred is an abstract idea).

Appellants argue that the claims are distinguishable from those in *FairWarning* because the claims in *FairWarning* related to the concept of analyzing records of human activity to detect suspicious behavior, and a human activity record analysis is not the same as a technique provided to manage an access right to an asset/access control device. Reply Br. 3. But the limitations recited in the claims need not be identical to those previously held to be directed to abstract ideas. Nonetheless, examining earlier cases can be helpful in deciding whether a claim is directed to an abstract idea. *See Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (courts examine earlier cases in which a similar or parallel descriptive nature can be seen to determine whether a claim is directed to an abstract idea).

We also are not persuaded by Appellants' argument that the claims are not directed to an abstract idea because the "actions [are] associated with both a computer memory and a security device." App. Br. 13 ("Claim 1 *does reference material objects (security device) performing non-routine, non-generic steps/actions (a 'work order' driven asset access control process), and is therefore not directed to an abstract idea itself*"); *see also* Reply Br. 5. As described above, we determine that the claim is directed to a method of organizing human activities, and not a mental process or an idea itself. Appellants do not identify, and we do not find, any indication that the claims are tied to any particular novel machine or apparatus or are

Appeal 2018-001730
Application 13/564,858

implemented other than using generic computer components. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”).

We are not persuaded by Appellants’ argument regarding preemption. *See* App. Br. 13–14. Although the Supreme Court has described “the concern that drives [the exclusion of abstract ideas from patent eligible subject matter] as one of preemption” (*Alice*, 134 S. Ct. at 2354), characterizing preemption as a driving concern for patent eligibility is not the same as characterizing preemption as the sole test for patent eligibility. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice*, 134 S. Ct. at 2354). “[P]reemption may signal patent ineligible subject matter, [but] the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

Appellants argue that the claimed invention improves “the technical field of asset management by using a ‘work order’ that controls the particular timeframe for which access rights are granted and revoked for accessing an asset, thereby improving overall security by limiting asset access by a worker entity to particular time-based windows associated with a particular work process.” App. Br. 14; *see also id.* (the claimed invention uses characteristics of the work order to “minimize the amount of time that access to an access/access control device is granted to a worker). Yet, the improvement that Appellants identify is an improvement to a process for

Appeal 2018-001730
Application 13/564,858

managing an access right to an asset associated with a work order — the abstract idea. And an improved abstract idea is still an abstract idea.

Contrary to Appellants' suggestion, we find no parallel between claim 1 and the claims at issue in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014). In *DDR Holdings*, the claims were directed to retaining website visitors, and in particular to a system that modified the conventional web browsing experience by directing a user of a host website who clicks an advertisement to a “store within a store” on the host website, rather directing the user to the advertiser’s third-party website. *DDR Holdings*, 773 F.3d at 1257–1258. The court determined “the claims address a business challenge (retaining website visitors) [that] is a challenge particular to the Internet.” *Id.* at 1257. The court also determined that the invention was “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks,” and that the claimed invention did not simply use computers to serve a conventional business purpose. *Id.* Rather, there was a change to the routine, conventional functioning of Internet hyperlink protocol. *Id.* Here, we do not find, and Appellants do not identify, any analogous modification to the routine and conventional functioning of computer network technology. At best, the claimed invention appears to use generic computer components (e.g., work order in digital format, access control device, computer, memory) to perform an abstract idea.

Appellants do not identify, and we do not find, anything in the Specification that attributes a technological improvement to the claimed invention or that otherwise indicates that the claimed invention integrates the abstract idea into a “practical application,” as that phrase is used in the

Appeal 2018-001730

Application 13/564,858

USPTO’s “2019 Revised Patent Subject Matter Eligibility Guidance,” 84 Fed. Reg. 50, 55 (January 7, 2019).³

Turning to step two of the *Mayo/Alice* framework, Appellants argue that even if the claims are directed to an abstract idea, the claims are nonetheless patent-eligible because the claims amount to significantly more than the alleged abstract idea. App. Br. 14–15. Specifically, Appellants maintain that this is so at least because the claimed invention “recites additional inventive concepts of using properties/characteristics of a work order as the invocation/triggering mechanism for when access is both granted and revoked in order to minimize the amount of time that access to an asset/access control device is granted to a worker entity.” *Id.* at 14. The difficulty with Appellants’ argument, however, is that these limitations are part of the abstract idea itself (i.e., managing an access right to an asset/access control device associated with a work order). As such, these limitations are not additional elements to be considered when determining whether the claims include additional elements or a combination elements that is sufficient to amount to significantly more than the abstract idea.

³ In accordance with the USPTO’s revised guidance, a claim will be considered “directed to” an abstract idea if (1) the claim recites subject matter falling within one of the following groupings of abstract ideas: (a) mathematical concepts; (b) certain methods of organizing human interactions, e.g., fundamental economic principles or practices, commercial or legal interactions; and (c) mental processes, and (2) the claim does not integrate the abstract idea into a practical application. *See Revised Guidance*, 84 Fed. Reg. at 54–55. “A claim that integrates a judicial exception into a practical application will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limitation on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *Id.* at 54.

The Examiner determined here (Final Act. 4), and we agree, that the only claim elements beyond the abstract idea are generic computer components recited as performing generic computer functions. *See, e.g.*, Spec. ¶¶ 25–27, 29–31, 33, 35, 38, 39. Appellants cannot reasonably contend, nor do they, that there is a genuine issue of material fact regarding whether operation of the claimed components are well-understood, routine, or conventional, where, as here, there is nothing in the Specification to indicate that the operations recited in the claims require any specialized hardware or inventive computer components or that the claimed invention is implemented using other than generic computer components to perform generic computer functions.

We are not persuaded, on the present record, that the Examiner erred in rejecting claim 9 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection of claim 9 under 35 U.S.C. § 101, as well as claims 1, 2, and 5–11, which fall with claim 9.

Claim 4

Claim 4 recites that the start or completion of work for the work order is reported by using the security device carried by the worker entity. Appellants argue that this feature recites an inventive concept because the “‘security device’ has *dual*-functionality of (1) facilitating access authentication for the asset or access control device; and (2) reporting work/state completion status for a particular work order.” App. Br. 16. Yet Appellants’ Specification provides that a “security device” includes a cell phone and a personal digital assistant (“PDA”) (Spec. ¶ 39), and using a cell

phone or PDA to report information is not arguably inventive. Therefore, we sustain the Examiner's rejection of claim 4 under 35 U.S. C. 101.

Claim 6⁴

Independent claim 6 recites, in part, receiving a message inquiring about whether the worker is authorized to access the asset or the access control device; and, when authorized, transmitting a message indicating the granting of the access right of the worker entity to the asset or asset control device that transmitted the inquiry message. Appellants additionally contend with respect to independent claim 6 that these limitations “facilitate a direct association between the security device and the asset or control device,” thereby “further improving system interoperability using these expanded communication capabilities that offers [sic] greater flexibility in supporting the particular types of assets being managed using these inventive concepts.” App. Br. 16. Yet these limitations merely further narrow the abstract idea with additional steps that themselves are abstract (receiving and transmitting information). Therefore, Appellants additional arguments do not apprise us of error in the Examiner's rejection of claim 6 under 35 U.S.C. § 101. Therefore, we sustain the Examiner's rejection of claim 6.

Claim 17

Claim 17 depends from claim 1 and additionally recites that the computer includes a configuration management system and a configuration management database, the asset being a configuration item and the work

⁴ We treat the Appellants' identification of claims 7–11 in Group III as inadvertent. *See* Reply Br. 6 (identifying only claim 6 in Group III); *see also* App. Br. 16 (discussing only claim 6 in the Group III section of the Appeal Brief).

Appeal 2018-001730
Application 13/564,858

order being issued by a change management process or release management process. Appellants argue that “the use of a change/release management process in combination with a configuration management system and configuration management provides an inventive concept not previously known in the art.” App. Br. 16–17. Yet Appellants do not explain, and it is not readily apparent, how using a configuration management system with a configuration management database involves more than the use of generic computers in their ordinary capacity.

We are not persuaded that the Examiner erred in rejecting claim 17 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection of claim 17.

DECISION

The Examiner’s rejection of claims 1, 3, 4, and 6–17 under 35 U.S.C. § 101 is 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