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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ADAM KENNEY, PHILLIP HENDERSON,
and JEFFERY A. THOMPSON

Appeal 2018-003145
Application 12/380,578
Technology Center 3600

Before NINA L. MEDLOCK, BART A. GERSTENBLITH, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–50 and 62–65. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Our decision references Appellant's Appeal Brief (“Appeal Br.,” filed July 10, 2017) and the Examiner's Answer (“Ans.,” mailed October 30, 2017) and Final Office Action (“Final Act.,” mailed February 7, 2017). Appellant identifies the real party in interest as Camelot UK Bidco Limited. Appeal Br. 1.

CLAIMED INVENTION

Appellant's claimed invention "relates to computer-implemented business processes" and "provides a workflow management system that enables users to create and execute tasks and to collaborate with others in performing business functions, including the management of Intellectual Property ('IP')" (Spec. ¶ 1).

Claims 1, 25, 45, and 65 are the independent claims on appeal. Claim 1, reproduced below with bracketed notations added, is illustrative of the claimed subject matter:

1. A system for performing Intellectual Property (IP) management workflow processes, comprising:

a central server comprising a processor for executing code, including a workflow program comprised of IP workflow routines executed by the central server and adapted to present via a graphical user interface workflow screens adapted to facilitate the exchange of data and instructions in executing IP workflow routines, the workflow program comprising:

[(a)] an administration module adapted to create authorized user accounts and to assign roles and privileges associated with the created authorized user accounts involved in execution of IP workflow routines;

[(b)] a workflow creation module adapted to generate a user interface to facilitate creation of a user-defined IP workflow routine comprising first and second user-defined workflow tasks, each of the first and second user-defined workflow tasks comprising elements for selecting two or more of workflow task type, workflow task resource, variable link, and task modifier, the workflow creation module further adapted to:

[(b1)] present via the user interface a set of user-selectable workflow task types;

[(b2)] receive a signal representing a first user-selected workflow task type;

[(b3)] present via the user interface a set of user-selectable workflow task resources and, upon receiving an input representing a selected first workflow task resource, a set of user-configurable elements associated with the first workflow task resource, the first workflow task resource being associated with the first user-selected workflow task type;

[(b4)] receive a signal representing a first set of user-configured elements associated with the first workflow task resource;

[(b5)] the first user-defined workflow task adapted to process an IP related data set received via a user interface workflow screen, the first user-defined workflow task being defined by the first user-selected workflow task type and the first set of user-configured elements;

[(b6)] the second user-defined workflow task adapted to process a second data set representing a response to a review associated with the IP related data set, the second user-defined workflow task being defined by a second user-selected workflow task type and a second set of user-configured elements associated with the second user-selected workflow task type; and

[(c)] a database adapted to store IP related data, including the IP related data set, the database being in communication with and adapted to exchange data with the central server.

REJECTIONS

Claims 1–50 and 62–65 are rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.

Claims 1, 2, 4–12, 15–22, 25–33, 36–42, 44–50, and 62–65 are rejected under 35 U.S.C. § 103(a) as unpatentable over Grainger (US 2002/0111824 A1, published Aug. 15, 2002) and Ouchi (US 2003/0023675 A1, published Jan. 30, 2003).

Claim 3 is rejected under 35 U.S.C. § 103(a) as unpatentable over Grainger, Ouchi, and Charisius (US 2002/0075293 A1, published June 20, 2002).

Claims 13, 14, 34, and 35 are rejected under 35 U.S.C. § 103(a) as unpatentable over Grainger, Ouchi, and Garrett (US 2008/0077466 A1, published Mar. 27, 2008).

Claims 23 and 43 are rejected under 35 U.S.C. § 103(a) as unpatentable over Grainger, Ouchi, and Geary (US 2001/0007977 A1, published July 12, 2001).

Claim 24 is rejected under 35 U.S.C. § 103(a) as unpatentable over Grainger, Ouchi, and Chone (US 7,133,833 B1, issued Nov. 7, 2006).

ANALYSIS

Patent-Ineligible Subject Matter

Appellant argues the pending claims as a group (Appeal Br. 10–22). We select independent claim 1 as representative. The remaining claims stand or fall with claim 1. *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). This 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.’” *Id.* at 217–18 (alteration in original).

In rejecting the pending claims under 35 U.S.C. § 101, the Examiner determined that claim 1 (which the Examiner treated as representative of the independent claims) is directed to “a workflow process applied in the context or field of use of intellectual property management” and “describes . . . facilitating data exchange between users in a user-defined workflow routine, where a first and second user with roles and privileges are assigned tasks to process data according to the workflow task type and user-defined elements” — a concept that the Examiner concluded is similar to other concepts that the courts have held abstract (Final Act. 5–8). The Examiner also determined that claim 1 does not include additional elements or a combination of elements, other than the abstract idea, sufficient to amount to significantly more than the abstract idea itself (*id.* at 8–11) and that none of the dependent claims includes additional features sufficient to

transform the recited abstract idea into a patent-eligible invention (*id.* at 11–25).

After Appellant’s Appeal Brief was filed, and the Examiner’s Answer mailed, the U.S. Patent and Trademark Office (the “USPTO”) published revised guidance for use by USPTO personnel in evaluating subject matter eligibility under 35 U.S.C. § 101. 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50, 57 (Jan. 7, 2019) (the “2019 Revised Guidance”). That guidance revised the USPTO’s examination procedure with respect to the first step of the *Mayo/Alice* framework by (1) “[p]roviding groupings of subject matter that [are] considered an abstract idea”; and (2) clarifying that a claim is not “directed to” a judicial exception if the judicial exception is integrated into a practical application of that exception. *Id.* at 50. The 2019 Revised Guidance, by its terms, applies to all applications, and to all patents resulting from applications, filed before, on, or after January 7, 2019. *Id.*²

Step One of the Mayo/Alice Framework (2019 Revised Guidance, Step 2A)

The first step in the *Mayo/Alice* framework, as mentioned above, is to determine whether the claims at issue are “directed to” a patent-ineligible concept, e.g., an abstract idea. *Alice Corp.*, 573 U.S. at 217. This first step,

² The 2019 Revised Guidance supersedes MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) § 2106.04(II) and also supersedes all versions of the USPTO’s “Eligibility Quick Reference Sheet Identifying Abstract Ideas.” See 2019 Revised Guidance, 84 Fed. Reg. at 51 (“Eligibility-related guidance issued prior to the Ninth Edition, R-08.2017, of the MPEP (published Jan. 2018) should not be relied upon.”). Accordingly, Appellant’s arguments challenging the sufficiency of the Examiner’s rejection will not be addressed to the extent those arguments are based on currently superseded USPTO guidance.

as set forth in the 2019 Revised Guidance (i.e., Step 2A), is a two-prong test; in Step 2A, Prong One, we look to whether the claim recites a judicial exception, e.g., one of the following three groupings of abstract ideas: (1) mathematical concepts; (2) certain methods of organizing human activity, e.g., fundamental economic principles or practices, commercial or legal interactions; and (3) mental processes. 2019 Revised Guidance, 84 Fed. Reg. at 54. If so, we next consider whether the claim includes additional elements, beyond the judicial exception, that “integrate the [judicial] exception into a practical application,” i.e., that apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception (“Step 2A, Prong Two”). *Id.* at 54–55. Only if the claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application do we conclude that the claim is “directed to” the judicial exception, e.g., an abstract idea. *Id.*

We are not persuaded, as an initial matter, that the Examiner overgeneralized the claims as directed to “a workflow process applied in the context or field of use of intellectual property management” or that the Examiner otherwise failed to consider the claims as a whole (Appeal Br. 12–13). Instead, the Examiner’s characterization of claim 1 is, in our view, fully consistent with the Specification, as described below, including the claim language. *Cf. Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016) (“An abstract idea can generally be described at different levels of abstraction. As the Board has done, the claimed abstract idea could be described as generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location. It could

be described in other ways, including, as indicated in the specification, taking orders from restaurant customers on a computer.”).

We also do not agree with Appellant that the Examiner erred in determining that claim 1 is directed to an abstract idea (Appeal Br. 13–19). The Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the specification, 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. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). 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. Here, it is clear from the Specification, including the claim language, that the claims focus on an abstract idea, and not on any improvement to technology and/or a technical field.

The Specification is entitled “METHOD AND SYSTEM FOR WORKFLOW INTEGRATION,” and describes, in the Background section, that as companies continue to strive for efficiency, consistency, and flexibility, computers and software executed on computers are increasingly being relied on to automate, semi-automate, enhance, and quicken business processes, and to make these processes reliable and uniform (Spec. ¶ 2). The Specification discloses that one exemplary business process is product life cycle, and that “[i]ncluded in the product life cycle is ideation of features or whole products, and collecting and processing decisions respecting the identification, disclosure, and securing of IP rights, including patent, trademark[,] and copyright rights” (*id.*). The Specification describes that

organizations often involve many employees and outside concerns in handling businesses processes (*id.* ¶ 3), and that the management of IP rights across large concerns or across a multiplicity of concerns is made cumbersome by the localized nature of functions associated with the process (*id.* ¶ 4). Therefore, according to the Specification, what is needed is “a secure, integrated approach to handling the business process . . . that promotes and facilitates informed decision making” and “a flexible user intuitive workflow module capable of permitting users to create and modify workflow tasks and routines . . . to address particular business needs” (*id.*).

The claimed invention is ostensibly intended to satisfy this need by providing an IP Workflow manager that effects collaboration, among users across a business organization, in performing business functions, including functions regarding IP management (*id.* ¶ 5). Claim 1, thus, recites a system for performing IP management workflow processes comprising a central server having a processor for executing a workflow program comprising modules for: (1) creating authorized user accounts and assigning roles and privileges to the user accounts, i.e., “an administration module adapted to create authorized user accounts and to assign roles and privileges associated with the created authorized user accounts involved in execution of IP workflow routines” (limitation (a)); (2) generating a user interface for use in creating a user-defined IP workflow, including first and second user-defined workflow tasks, i.e.,

a workflow creation module adapted to generate a user interface to facilitate creation of a user-defined IP workflow routine comprising first and second user-defined workflow tasks, each of the first and second user-defined workflow tasks comprising elements for selecting two or more of workflow task type, workflow task resource, variable link, and task modifier

(limitation (b)); (3) presenting, via the user interface, a set of user-selectable workflow task types, and receiving a first user's selected workflow task type, i.e., "present[ing] via the user interface a set of user-selectable workflow task types" and "receiv[ing] a signal representing a first user-selected workflow task type" (limitations (b1) and (b2)); and (4) presenting, via the user interface, a set of user-selectable task resources; receiving a first user-selected task resource; presenting, via, the user interface, a set of user-configurable elements associated with the selected task resource; and receiving a first set of user-configured elements, i.e.,

present[ing] via the user interface a set of user-selectable workflow task resources and, upon receiving an input representing a selected first workflow task resource, a set of user-configurable elements associated with the first workflow task resource, the first workflow task resource being associated with the first user-selected workflow task type; [and]

receiv[ing] a signal representing a first set of user-configured elements associated with the first workflow task resource

(limitations (b3) and (b4)). Claim 1 further recites that the first user-defined workflow task is adapted to process an IP related data set, i.e.,

the first user-defined workflow task adapted to process an IP related data set received via a user interface workflow screen, the first user-defined workflow task being defined by the first user-selected workflow task type and the first set of user-configured elements

(limitation (b5)); that the second user-defined workflow task, defined by a second user-selected workflow task type and a second set of user-configured elements, is adapted to process a second data set representing a response to a review associated with the IP related data set, i.e.,

the second user-defined workflow task adapted to process a second data set representing a response to a review associated

with the IP related data set, the second user-defined workflow task being defined by a second user-selected workflow task type and a second set of user-configured elements associated with the second user-selected workflow task type (limitation (b6)); and that the system includes a database that stores the IP related data set, i.e., “a database adapted to store IP related data, including the IP related data set, the database being in communication with and adapted to exchange data with the central server” (limitation (c)).

These limitations, when given their broadest reasonable interpretation, recite (1) storing IP related data, including an IP related dataset; (2) assigning roles and privileges to a first user and a second user; and (3) defining, via a graphical user interface, a first user-defined task for processing the IP related dataset and a second user-defined task for processing a second dataset representing a response to a review associated with the IP related dataset. In other words, claim 1 recites managing human behavior or interactions between people, which is a method of organizing human activity and, therefore, an abstract idea. *See* 2019 Revised Guidance, 84 Fed. Reg. at 52.

It also is significant here that although claim 1 recites a processor executing code, i.e., a workflow program, for performing the recited functions, we agree with the Examiner that the underlying processes recited in the claim are all acts that could be performed by a human, e.g., mentally or manually, using pen and paper, without the use of a computer or any other machine (*see* Final Act. 7–8). For example, an administrator could assign particular roles and privileges to individual employees, orally or in writing. Workflow tasks also could be defined, mentally or with the use of pen and paper; and information regarding the workflow tasks, including data

associated with the execution of a particular task, could be communicated, orally or via written communication. The IP related data also could be stored in written form. Simply put, in addition to reciting a method of organizing human activity, claim 1 recites a mental process, i.e., a concept performed in the human mind or manually, using pen and paper, and therefore, an abstract idea. *See* 2019 Revised Guidance, 84 Fed. Reg. at 52. *See also CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) (holding that method steps that can be performed in the human mind, or by a human using a pen and paper, are unpatentable mental processes); *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“Adding one abstract idea . . . to another abstract idea . . . does not render the claim non-abstract.”).

Having concluded that claim 1 recites a judicial exception, i.e., an abstract idea (Step 2A, Prong One), we next consider whether the claim recites additional elements that integrate the judicial exception into a practical application (Step 2A, Prong Two).

The only additional elements recited in claim 1, beyond the abstract idea, are the “central server comprising a processor”; “user interface”; and “database” — elements that, as the Examiner observes (Final Act. 9), are recited at a high level of generality, i.e., as generic computer components (*see also, e.g.*, Spec. ¶¶ 59–61). We find no indication in the Specification, nor does Appellant direct us to any indication, that the operations recited in claim 1 require any specialized computer hardware or other inventive computer components, i.e., a particular machine, invoke any assertedly inventive programming, or that the claimed invention is implemented using other than generic computer components to perform generic computer

functions. *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 also find no indication in the Specification that the claimed invention effects a transformation or reduction of a particular article to a different state or thing. Nor do we find anything of record that attributes an improvement in technology and/or a technical field 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 2019 Revised Guidance.³

Appellant argues that that the claimed system is “far removed from the concepts of risk hedging and intermediated settlement[] [held abstract in *Bilski v. Kappos*, 561 U.S. 593 (2010) and *Alice*]” and “solves a problem unique to managing and displaying electronic data and for facilitating the interaction and manipulation of that data through unique user interface elements presented in a specific graphical user interface, one that did not exist prior to the advent of computers” (Appeal Br. 14). Appellant maintains that the claimed invention, as such, is “related to solving a problem that is specific to a computer and necessary for the information age relating to the

³ The 2019 Revised Guidance references MPEP § 2106.05(a)–(c) and (e) in describing the considerations that are indicative that an additional element or combination of elements integrates the judicial exception, e.g., the abstract idea, into a practical application. 2019 Revised Guidance, 84 Fed. Reg. at 55. If the recited judicial exception is integrated into a practical application, as determined under one or more of these MPEP sections, the claim is not “directed to” the judicial exception.

Internet” (*id.* at 15). But, Appellant does not identify the problem “unique to managing and displaying electronic data” and “specific to a computer and necessary for the information age relating to the Internet” that the claimed system allegedly solves. Nor does Appellant explain how the claimed system addresses this problem.

Appellant further argues that claim 1 is similar to the claims held patent eligible in *Enfish, BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), *McRO, Inc. v. Bandai Namco Games America, Inc.*, 837 F.3d 1299 (Fed. Cir. 2016), and *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016) (*id.*). But, we find no parallel between claim 1 and the claims at issue in any of *Enfish*, *BASCOM*, *McRO*, and *Amdocs*.

Appellant asserts that “[I]ike the system for synchronizing computer animation with an audio recording in *McRO*, the claimed invention enables a computer to do something that goes beyond human capabilities from a computational standpoint,” i.e., “process a workflow routine comprising workflow tasks having workflow task resources and user-configurable elements via a graphical user interface and user interface elements and use the workflow takes [sic] to process an IP related data set received via the graphical user interface” (*id.* at 16). But, Appellant offers no persuasive argument or technical reasoning to explain why the claimed functions, as recited in claim 1, could not be performed by a human mentally or with pen and paper, as the Examiner proposes (*see* Final Act. 7–8).

Moreover, even if, as Appellant contends (Appeal Br. 20–21), the subject matter of claim 1 cannot be performed entirely in the human mind or by a human using pen and paper, the claim is not automatically rendered

patent eligible. Although “a method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101,” *CyberSource*, 654 F.3d at 1373, it does not automatically follow that methods that arguably cannot be performed entirely in the human mind are, therefore, patent eligible. The claims in *Alice* also required the use of a computer: “As stipulated, the claimed method requires the use of a computer to create electronic records, track multiple transactions, and issue simultaneous instructions; in other words, ‘[t]he computer is itself the intermediary.’” *Alice Corp.*, 573 U.S. at 224. Yet, those claims were nonetheless held patent ineligible. *See id.* at 223 (“the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention”).

The law also is clear that “relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.” *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015); *see also Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (“[T]he fact that the required calculations could be performed more efficiently via a computer does not materially alter the patent eligibility of the claimed subject matter.”). And, unlike the situation in *McRO*, where the Federal Circuit found that the computer was used to perform a process distinct from the process previously performed by animators, *see McRO*, 837 F.3d at 1314, there is no evidence here that the claimed invention does more than merely automate an otherwise manual process, i.e., the creation, management, and display of workflow tasks.

We also are not persuaded by Appellant's argument that the claimed invention, like the claims at issue in *Enfish*, improves the functioning of a computer (Appeal Br. 16). Appellant argues that the claimed invention improves the functioning of a computer because

the information processed and managed by the computer is not only significantly more than what could be achieved by any manual methods, but it also enables the computer to generate and manage the workflow routines, workflow tasks, workflow task resources, and user-configurable elements, and present said information as user interface elements in a graphical user interface in a manner that is not possible by human implemented methods due to the numer[os]ity of factor considerations

(*id.*). But, even accepting Appellant's argument, there is a fundamental difference between computer functionality improvements, on the one hand, and uses of existing computers as tools to perform a particular task, on the other. Indeed, the Federal Circuit applied this distinction in *Enfish* in rejecting a § 101 challenge at the step one stage in the *Mayo/Alice* analysis because the claims at issue focused on a specific type of data structure, i.e., a self-referential table for a computer database, designed to improve the way a computer carries out its basic functions of storing and retrieving data, and not on asserted advances in the uses to which existing computer capabilities could be put. *Enfish*, 822 F.3d at 1335–36.

We find no parallel here between claim 1 and the claims in *Enfish* nor any comparable aspect in claim 1 that represents an improvement to computer functionality. The alleged advantages that Appellant touts do not concern an improvement to computer capabilities but instead relate to an alleged improvement in creating, managing, and displaying workflow tasks — a process in which a computer is used as a tool in its ordinary capacity.

For much the same reasons, we are not persuaded that there is any parallel between claim 1 and the claim at issue in *Amdocs*. In *Amdocs*, the Federal Circuit held the claim was patent eligible because the claim entails an unconventional technological solution (enhancing data in a distributed fashion) to a technological problem (massive record flows which previously required massive databases). Although the solution requires generic components, the court determined that “the claim’s enhancing limitation necessarily requires that these generic components operate in an unconventional manner to achieve an improvement in computer functionality” and that the “enhancing limitation depends not only upon the invention’s distributed architecture, but also depends upon the network devices and gatherers—even though these may be generic—working together in a distributed manner.” *Amdocs*, 841 F.3d at 1300–01.

Appellant maintains here that the claim limitations “improve a specific technological environment by providing for the managing, processing, configuring, and executing of workflow tasks and the display of the data as user interface elements in a user interface” (Appeal Br. 17). But, Appellant does not identify any “distributed architecture” comparable to that in *Amdocs* or otherwise establish that the generic components recited in the claim operate in an unconventional manner.

Appellant also misapprehends the controlling precedent to the extent Appellant maintains that claim 1 is patent eligible because the claim poses no risk of preemption (*id.*). Although the Supreme Court has described “the concern that drives [the exclusion of abstract ideas from patent-eligible subject matter] as one of pre-emption,” *Alice Corp.*, 573 U.S. at 216, 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 Corp.*, 573 U.S. at 216). “[P]reemption may signal patent ineligible subject matter, [but] the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

Appellant’s further argument that claim 1 is analogous to the claims held patent eligible in *Trading Technologies International v. CQG Inc.*, 675 F. App’x 1001 (Fed. Cir. 2017), is likewise unpersuasive of Examiner error (Appeal Br. 17–18). In *Trading Technologies*, the Federal Circuit affirmed the district court’s holding that the patented claims (which recited a method and system for displaying market information on a graphical user interface) were not directed to an abstract idea because the district court found, and the Federal Circuit agreed, that the challenged claims did not simply recite displaying information on a graphical user interface; instead, the claims required “a specific, structured graphical user interface paired with a prescribed functionality directly related to the graphical user interface’s structure that is addressed to and resolves a specifically identified problem in the prior state of the art.” *Id.* at 1004.⁴ The Federal Circuit, thus,

⁴ Specifically, the district court found that with prior art graphical user interfaces (“GUIs”), the best bid and best ask prices changed based on updates received from the market; therefore, there was a risk with these GUIs that a trader would miss her intended price as a result of prices changing from under her pointer at the time she clicked on the price cell on the GUI. The patents-in-suit provided a system and method whereby traders

found that the district court’s ruling was in accord with precedent that has recognized that “specific technologic modifications to solve a problem or improve the functioning of a known system generally produce patent-eligible subject matter.” *Id.* at 1004–05.

Appellant argues here that, “[l]ike the user interface of *Trading Tech*,” the claimed invention “provides a graphical user interface that provides a technological improvement on the prior art and presents user interface elements including a set of user-selectable workflow task types and user-configurable elements” (Appeal Br. 17). But, unlike the situation in *Trading Technologies*, Appellant does not identify any problem with prior user interfaces that the present interface was specifically designed to resolve.

Claim 1, in our view, is like the claims that the courts in *Trading Technologies* distinguished as patent ineligible. Rather than solving a technological problem, claim 1 simply calls for displaying certain information in a user interface. *See Trading Techs.*, 2015 WL 774655, at *4 (“If the claims simply provided for ‘setting, displaying, and selecting’ data information, CQG would be correct in its assessment that the claims are directed to an abstract idea”); *Trading Techs.*, 675 F. App’x at 1005 (“ineligible claims generally lack steps or limitations specific to a solution of a problem, or improvement in the functioning of technology”).

could place orders at a particular, identified price level, not necessarily the highest bid or the lowest ask price by keeping the prices static in position, and allowing the quantities at each price to change. *Trading Techs. Int’l, Inc. v. CQG, Inc.*, No. 05-cv-4811, 2015 WL 774655, at *4 (N.D. Ill. Feb. 24, 2015).

We also do not agree with Appellant that claim 1, like the claims in *DDR Holdings*, solves a problem specific to computers and computer networks (Appeal Br. 19). Appellant argues that,

[l]ike the subject matter of the claims in *DDR Holdings*, which were directed towards a method for generating a target website with the same look and feel as an originating web site, the subject matter of claim 1 solves a problem unique to electronic management of business tax structure across multiple jurisdictions

(*id.*). But, that argument is not persuasive at least because it is not commensurate with the scope of claim 1. As the Examiner observes, managing business tax structure across multiple jurisdictions is not recited in the claim and, moreover, is itself an abstract idea (Ans. 18).

We conclude, for the reasons set forth above, that claim 1 recites an abstract idea, and that additional elements recited in the claim are no more than generic computer components used as tools to perform the recited abstract idea. As such, they do not integrate the recited abstract idea into a practical application. *See Alice Corp.*, 573 U.S. at 223–24 (“[W]holly generic computer implementation is not generally the sort of ‘additional featur[e]’ that provides any ‘practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.’”) (quoting *Mayo*, 566 U.S. at 77)). Accordingly, we agree with the Examiner that claim 1 is directed to an abstract idea.

Step Two of the Mayo/Alice Framework (2019 Revised Guidance, Step 2B)

Having determined under step one of the *Mayo/Alice* framework that claim 1 is directed to an abstract idea, we next consider under Step 2B of the 2019 Revised Guidance, the second step of the *Mayo/Alice* framework, whether claim 1 includes additional elements or a combination of elements

that provides an “inventive concept,” i.e., whether the additional elements amount to “significantly more” than the judicial exception itself.

2019 Revised Guidance, 84 Fed. Reg. at 56.

We note at the outset that Appellant misapprehends the controlling precedent to the extent Appellant argues that the claims are patent eligible, e.g., that claim 1 amounts to “significantly more” than an abstract idea, because the claim is allegedly novel and/or non-obvious in view of the prior art (Appeal Br. 20). 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.*, 573 U.S. at 217–18 (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.”).

Appellant asserts that the claims recite a specific system comprising at least

IP workflow routines, a graphical user interface, workflow screens, authorized user accounts, an administration module, a workflow creation module, user interface elements, workflow tasks, workflow task elements, workflow task resources, processing of IP related data sets, and a database and how these claim elements are interrelated within the system of claim 1 (Appeal Br. 21). And Appellant argues that this “more than satisfies the requirement of ‘add[ing] a specific limitation other than what is well-understood, routine, conventional activity in the field or unconventional steps that confine the claim to a particular useful application’” (*id.*). But, as described above, we find no indication in the Specification that the operations recited in claim 1 require any specialized computer hardware or other inventive computer components, i.e., a particular machine, invoke any assertedly inventive programming, or that the claimed invention is implemented using other than generic computer components. Appellant also offers no evidence or technical reasoning to demonstrate that the functions recited in claim 1 require more than the performance of well-understood, routine, and conventional computer activities, i.e., generic computer functions. *Cf. In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1316 (Fed. Cir. 2011) (“Katz has not claimed a specific function performed by a special purpose computer, but has simply recited the claimed functions of ‘processing,’ ‘receiving,’ and ‘storing.’ Absent a possible narrower construction of the terms ‘processing,’ ‘receiving,’ and ‘storing,’ discussed below, those functions can be achieved by any general purpose computer without special programming.”). Simply programming a general-purpose computer to perform an abstract idea does not provide an “inventive concept” such that the claim amounts to significantly more than that abstract idea. *See Alice Corp.*, 573 U.S. at 221–27 (applying an abstract idea, such

as an algorithm, on a general purpose computer is not enough to transform a patent-ineligible abstract idea into a patent-eligible invention.); *EON Corp. IP Holdings LLC v. AT&T Mobility LLC*, 785 F.3d 616, 623 (Fed. Cir. 2015) (“A general purpose computer is flexible—it can do anything it is programmed to do.”).

We are not persuaded, on the present record, that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection of claim 1, and claims 2–50 and 62–65, which fall with claim 1.

Obviousness

Independent Claims 1, 25, 45, and 65 and Dependent Claims 2, 4–12, 15–22, 26–33, 36–42, 44, 46–50, and 62–64

We are persuaded by Appellant’s argument that the Examiner erred in rejecting independent claims 1, 25, 45, and 65 under 35 U.S.C. § 103(a) at least because Ouchi, on which the Examiner relies (Final Act. 31–34 (citing Ouchi ¶¶ 110, 111, 114, 138, 139, 150, and 160)), fails to disclose or suggest “a user interface as claimed and . . . presenting a set of user-selectable workflow task resources and user-configurable elements as claimed,” i.e., limitations (b), and (b1)–(b4), as recited in claim 1, and similarly recited in claims 25, 45, and 65 (Appeal Br. 23–28).

Ouchi is directed to workflow systems and methods, and describes that, in one embodiment, the invention provides an email-based workflow system for processing a document; the system is connected to a computer network and an email system, and comprises a form route manager connected to the network system, capable of receiving and sending emails and defining a route, i.e., a step-by-step sequence of email addresses in the

network (Ouchi ¶¶ 10–13). Thus, as shown in Figure 6, for example, a workflow document, e.g., a performance review, is processed in accordance with a route 610 defined by the form route manager; a sequence of emails (containing the review document) is, thus, sent between email addresses A, B, C and the form route manager to effect the workflow of route 610 (*see id.* ¶¶ 72–78). At each stage in the email chain, the user processes the workflow document in the email and returns the email, including the modified document, to the form manager for forwarding to the next email address in the route until the workflow route is completed (*see id.*; *see also id.* ¶¶ 64–65, Fig. 5).

Although the sequence of email messages in Ouchi can be used to define a workflow, we agree with Appellant that the workflow documents that are routed as emails are not workflow tasks defined by user-selectable elements, as called for in the independent claims (Appeal Br. 24). In Ouchi, a user may select or route an email; but, we find nothing in the cited portions of Ouchi that discloses or suggests that the email is user configurable and nothing that discloses or suggests that a user is presented “a set of user-selectable workflow task types,” or “a set of user-selectable workflow task resources and, upon receiving an input representing a selected first workflow task resource, a set of user-configurable elements associated with the first workflow task resource,” as claimed.

In view of the foregoing, we do not sustain the Examiner’s rejection of independent claims 1, 25, 45, and 65 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the rejection of dependent claims 2, 4–12, 15–22, 26–33, 36–42, 44, 46–50, and 62–64. *Cf. In re Fritch*, 972 F.2d

1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

Dependent Claims 3, 13, 14, 23, 24, 34, 35, and 43

The rejections of dependent claims 3, 13, 14, 23, 24, 34, 35, and 43 do not cure the deficiencies in the rejection of independent claims 1, 25, 45, and 65. Therefore, we do not sustain the rejections of dependent claims 3, 13, 14, 23, 24, 34, 35, and 43 under 35 U.S.C. § 103(a) for the same reasons set forth above with respect to the independent claims.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–50, 62–65	101	Eligibility	1–50, 62–65	
1, 2, 4–12, 15–22, 25–33, 36–42, 44–50, 62–65	103(a)	Grainger, Ouchi		1, 2, 4–12, 15–22, 25–33, 36–42, 44–50, 62–65
3	103(a)	Grainger, Ouchi, Charisius		3
13, 14, 34, 35	103(a)	Grainger, Ouchi, Garrett		13, 14, 34, 35
23, 43	103(a)	Grainger, Ouchi, Geary		23, 43
24	103(a)	Grainger, Ouchi, Chone		24
Overall Outcome			1–50, 62–65	

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED