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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/330,182	12/08/2008	Wolfgang Mayle	DE920080056US1	1315
77212	7590	05/24/2019	EXAMINER	
Cantor Colburn LLP - IBM Endicott 20 Church Street 22nd Floor Hartford, CT 06103			SCHEUNEMANN, RICHARD N	
			ART UNIT	PAPER NUMBER
			3624	
			NOTIFICATION DATE	DELIVERY MODE
			05/24/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WOLFGANG MAYLE and SEBASTIAN ROTHBUCHER

Appeal 2018-003820
Application 12/330,182¹
Technology Center 3600

Before HUBERT C. LORIN, BRUCE T. WIEDER,
and SHEILA F. McSHANE, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner’s final decision to reject claims 1, 2, and 5–18. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to Appellants, the real party in interest is International Business Machines Corporation. Appeal Brief filed October 13, 2017, hereafter “App. Br.,” 2.

BACKGROUND

The invention relates to the formation of an information technology (IT) plan for an enterprise utilizing an automated enterprise architecture (EA) system. Specification, hereafter “Spec.,” ¶ 4. The invention is directed to creation of a project document, which describes a particular portion of operations of the enterprise; ranking the criticality of the project as to other projects; linking products; receiving organization technology adoption preferences; and creating a list of products to be upgraded. *Id.* ¶ 5.

Representative claim 1 is reproduced from page 8 of the Appeal Brief in the Claims Appendix (Claims App’x) as follows:

1. A method of forming an IT plan for an enterprise utilizing an automated enterprise architecture (EA) system, the method comprising:

creating a project document, the project document describing a particular process performed during operation of the enterprise;

ranking the criticality of the process as compared to other processes of the enterprise;

linking products, including product versions, that are related to the processes of the project document in the EA system, wherein the link is a two-way link;

receiving organization software version adoption preferences at a computing device; [and]

creating, with the computing device, a list of products to be upgraded based on the technology adoption preferences and the ranking of the process.

In a Final Rejection, the Examiner rejects claims 1, 2, and 5–18 under 35 U.S.C. § 101 as directed to a judicial exception without significantly more. Final Action, hereafter “Final Act.,” 2–5, mailed May 12, 2017.

DISCUSSION

An invention is patent eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981) (“*Diehr*”)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1853))); and

manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))). In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 176; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”), *see also e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (quotation marks omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The USPTO recently published revised guidance on the application of § 101, in accordance with judicial precedent. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50, 52 (Jan. 7, 2019) (“2019 Guidance”). Under the 2019 Guidance, a claim is “directed to” an abstract idea if the claim recites any of (1) mathematical concepts, (2) certain methods of organizing human activity, and (3) mental processes—without

integrating such abstract idea into a “practical application,” i.e., without “apply[ing], rely[ing] on, or us[ing] 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.” *Id.* at 52–55. A claim so “directed to” an abstract idea constitutes ineligible subject matter, unless it recites an additional element (or combination of elements) amounting to significantly more than the abstract idea. *Id.* at 56.

With this context in mind, we evaluate the Examiner’s rejection of representative claim 1.

The Examiner finds that claim 1 is directed to a judicial exception because it is directed to forming an IT (information technology) plan for an enterprise. Final Act. 4. The Examiner finds that this is a method of organizing human activity, which is an ineligible abstract idea. *Id.* The Examiner further finds that the claim 1 limitations including “creating a project document,” “ranking the criticality of the process,” “linking products,” “receiving organization software version adoption preferences,” and “creating . . . a list of products” are steps for data manipulation related to the abstract idea of forming an IT plan. *Id.*

Appellants argue that the formation of an IT plan is not abstract. App. Br. 4. More particularly, Appellants assert that the specific steps of claim 1 that are implemented are not themselves abstract. Appellants argue that the steps of creating a project document and ranking the criticality of the processes are particular processes. *Id.* Appellants further contend that the steps of linking products, receiving organizational software adoption preferences, and creating a list of products for upgrade are not abstract but are real world processes. *Id.* at 4–5.

We agree with the Examiner’s findings that claim 1 recites the steps of “creating a project document,” “ranking,” “linking products,” “receiving,” and “creating,” and that these steps are used for “forming an IT plan for an enterprise” of the claim preamble, which is a method of organizing human activity, that is, managing activities and following rules and instructions. *See Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (determining “system claims . . . [that] only contain 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” to be patent-ineligible); *Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266, 1270, 1278, 1280 (Fed. Cir. 2012) (method and system claims for managing a stable value protected life insurance policy by performing calculations and manipulating the results held patent-ineligible); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1354 (Fed. Cir. 2014) (creating a contractual relationship). Further, our reviewing courts have determined certain claims drawn to manipulating information, a task humans have always performed, are ineligible. *See Content Extraction and Transmission LLC v. Wells Fargo Bank, National Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (“collecting data, . . . recognizing certain data within the collected data set, and . . . storing that recognized data in a memory”). The Examiner’s findings also align with the intrinsic record. The specification states that its embodiments are directed to a product for producing an IT plan for an enterprise. *See Spec.* ¶¶ 4–5. Thus, we find that representative claim 1 recites the abstract idea of organizing human activity.

We next consider the issue of whether representative claim 1

integrates the judicial exception into a practical application, that is, whether it “appl[ies], rel[ies] on, or use[s] 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.” *See* 2019 Guidance, 54–55. Here, the Examiner finds that the claims require no more than a generic computer to perform generic computer functions.

Final Act. 5. We agree that the method of representative claim 1 is implemented by a computing system, which may by “any suitable computer or computing platform,” and with no specialized computer or computer interfaces identified in the specification. Spec. ¶ 29, *see also id.* ¶¶ 26–28, 30–32, Fig. 1. Under *Alice*, instructing one to “apply” an abstract idea and reciting no more than generic computer elements performing generic computer tasks does not make an abstract idea patent eligible. *See Alice*, 573 U.S. at 217–218.

Appellants argue that the processes in the claim are linked to allow the computing device to operate in an improved manner, which is similar to the improved computer function in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016) (“*Enfish*”). Reply Brief, hereafter “Reply Br.,” 2, mailed February 22, 2018. Appellants further argue that the bi-directional linking-of-products step allows for better processing. *Id.* at 2–3. We are not persuaded by Appellants’ arguments. In *Enfish* the claims were directed to improvements in the way computers and networks carry out their basic functions, that is, an improvement in technology. *See Enfish*, 822 F.3d at 1335–36 (“[T]he first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’

for which computers are invoked merely as a tool.”). Here, we discern no improvements to technology by the steps of claim 1, and instead the steps use computers as a tool for implementation. As to the bi-directional linking of products step, that step may allow improved efficiency in furtherance of forming an IT plan, an abstract idea, however, there is no identification of a technology improvement. *See* Reply Br. 2–3. Moreover, the linking step is recited at a high level of generality and is performed by generic computer functions. Thus, we find no reversible error with the Examiner’s determination that representative claim 1 recites an abstract idea.

With regard to the second step of the *Alice* framework, the Federal Circuit has held that, after determining that the claim is directed to an ineligible concept, we assess whether the claim limitations, other than the invention’s use of the ineligible concept to which to was directed, were well-understood, routine, and conventional. *BSG Tech. LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018). Here, the Examiner found that representative claim 1 limitations of “creating,” “ranking,” “linking products,” “receiving organization software version,” and “creating” are steps for data manipulation related to the abstract idea of forming an IT plan. Final Act. 4. Appellants do not assert that there is any unconventional use of a computer, and merely list all the steps of the claims, but fail to explain or provide support that the claims entail anything more than the use of a generic computer to implement the abstract idea of the claims. App. Br. 5–6. The use of a generic computer performing generic computer functions to implement an abstract idea has repeatedly been found to not make an abstract idea patent eligible. *See Alice*, 573 U.S. at 223–24 (Instructing one to “apply” an abstract idea and reciting no more than generic computer

elements performing generic computer tasks does not make an abstract idea patent eligible.); *BSG Tech. LLC*, 899 F.3d at 1290–91; *SAP America, Inc. v. InvestPic, LLC*, 890 F.3d 1016, 1023 (Fed. Cir. 2018) (“In accordance with the Supreme Court’s conclusion in *Alice*, . . . this court has ruled many times that ‘such invocations of computers and networks that are not even arguably inventive are insufficient to pass the test of an inventive concept in the application of an abstract idea.’”) (citing *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055–56 (Fed. Cir. 2017)). Thus, we find no error with the Examiner’s determination that the claims implement an abstract idea through generic computer systems performing generic computer functions.

Appellants additionally argue that the claims do not preempt the general field of generating an IT plan. App. Br. 6. However, while preemption may signal patent ineligible subject matter, “the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–1363 (Fed. Cir. 2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”). And, “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa*, 788 F.3d at 1379.

Accordingly, we are not persuaded of error in the Examiner’s conclusion that representative claim 1 is directed to patent-ineligible subject

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matter. Claims 2 and 5–18 are not separately argued and fall with claim 1.
See 37 C.F.R. § 41.37(c)(1)(iv).

SUMMARY

The rejection of claims 1, 2, and 5–18 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