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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KWAI H. MAN and WAI K. SO¹

Appeal 2018-004006
Application 13/553,199
Technology Center 2400

Before JOSEPH L. DIXON, MICHAEL J. STRAUSS, and
JOHN R. KENNY, *Administrative Patent Judges*.

STRAUSS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ According to Appellants, the real party in interest is International Business Machines Corporation. *See* App. Br. 3.

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 1, 2, 5–10, 12–14, and 17–25. Claims 3, 4, 11, 15, and 16 are canceled. Final Act. 2. This appeal is related to Application Serial No. 13/046,417 (Appeal No. 2018-004033) a decision in which is being issued contemporaneously with the instant decision. Br. 4. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.²

THE INVENTION

The claims are directed to auto-updating documents within content management systems. Spec., Title, Abstract. Claim 17, reproduced below, is illustrative of the claimed subject matter:

17. A computer-implemented method for document updates in a content management system to trigger document updates to other documents determined as related, the computer-implemented method comprising:

analyzing, by the content management system, each of a plurality of documents in order to determine one or more characteristics of the respective document, wherein the plurality of documents is stored electronically in the content management system;

generating, by the content management system, a respective similarity value for each of a plurality of combinations of documents selected from the plurality of documents, wherein the respective similarity value is generated based on the determined one or more characteristics of the respective combination of documents, wherein a respective auto-update relationship is established between source and target documents of the respective combination of documents based on the

² We refer to the Specification, filed July 19, 2012 (“Spec.”); the Final Office Action, mailed May 31, 2017 (“Final Act.”); Appeal Brief, filed Nov. 8, 2017 (“Br.”); and the Examiner’s Answer, mailed Dec. 28, 2017 (“Ans.”).

respective similarity value and based further on a predefined similarity threshold;

enforcing, by the content management system when executed by one or more computer processors, each auto-update relationship by monitoring changes to the respective source document and automatically updating the respective target document based on the monitored changes; and

outputting each automatically updated target document.

REFERENCES

The following prior art is relied upon by the Examiner in rejecting the claims on appeal:

Bates et. al.	US 6,088,707	July 11, 2000
McChrystal	US 2005/0198565 A1	Sept. 8, 2005
Cragun et al.	US 2009/0083247 A1	Mar. 26, 2009
Tanaka	US 2011/0239102 A1	Sept. 29, 2011
Parikh	US 2013/0024185 A1	Jan. 24, 2013

REJECTIONS

The Examiner made the following rejections³:

Claims 1, 2, 5–10, 12–14, and 17–25 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Final Act. 5–9

Claims 1, 2, 5–10, 13, 14, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cragun, McChrystal, and Parikh. Final Act. 10–20.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cragun, McChrystal, Parikh, and Tanaka. Final Act. 20–21.

³ The rejection of claims 20–24 under 35 U.S.C. § 112, first paragraph, has been withdrawn. Ans. 22.

Claims 19–21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cragun, McChrystal, Parikh, and Bates. Final Act. 21–23.

Claims 22 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cragun, McChrystal, Parikh, Bates, and Tanaka. Final Act. 23–26.

ANALYSIS

35 U.S.C. § 101

In *Alice Corp. Pty. Ltd. v. CLS Bank International*, 573 U.S. 208 (2014), the Supreme Court reiterated an analytical two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 79 (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*, 573 U.S. at 217. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* If the claims are directed to eligible subject matter, the inquiry ends. *Thales Visionix Inc. v. U.S.*, 850 F.3d 1343, 1346 (Fed. Cir. 2017); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016).

If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “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*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 79, 78). In other words, the second step is to “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) (quoting *Mayo*, 566 U.S. at 72–73).

In rejecting the claims under 35 U.S.C. § 101, the Examiner determines these claims are directed to “analyzing documents to determine if they are similar, which amounts to a basic manipulation of existing information, such as visually comparing two documents to detect same or similar words/phrases/images/etc., which is an abstract idea.” Final Act. 7; Ans. 4. The Examiner analogizes the pending claims to those addressed in *Electric Power Grp, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016) and *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344 (Fed. Cir. 2014). Ans. 27. Further, the Examiner determines that the additional requirement the steps be performed by a content management system is insufficient to transform the abstract idea into a patent-eligible invention. Final Act. 5–6.

Alice Step One

Appellants contend claim 17 is not directed to an abstract idea, analogizing the claim to those found to be patent eligible in *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016). Appellants argue claim 17 permits alternative approaches for achieving the desired results, i.e., “recites a novel process and limits itself to specific features in a way that does not preempt other approaches of achieving desired results [and, therefore], the instant claim is not abstract.” Br. 23. The Examiner replies, finding automatic updating of documents is “well-known from pre-computer era and is not rooted in computer technology.”

Ans. 28. The Examiner distinguishes Appellants' claims over the claims in *McRO*, which were directed to a different way of accomplishing lip syncing. *Id.* In contrast, according the Examiner, Appellants' claimed auto-update relationships "implement an old practice of linking similar documents such that one document is updated the related document is updated in the same way." *Id.* Appellants do not reply.

We are not persuaded by Appellants' arguments. We agree with the Examiner that claim 17 is not analogous to those in *McRO*. In contrast to *McRO*, we are unpersuaded the rejected claims produce an improvement in computer-related technology. The claims in *McRO* recited a "specific . . . improvement in computer animation" using "unconventional rules that relate[d] sub-sequences of phonemes, timings, and morph weight sets." *McRO*, 837 F.3d at 1302–03, 1307–08, 1314–15. Moreover, it was not the mere presence of unconventional rules in *McRO* that led to patent eligibility; rather, it was that the rules were used "in a process specifically designed to achieve an improved technological result." *Id.* at 1316. Here, Appellants have not shown how the claimed document analysis and updating are used in a process to achieve improved technological results.

We are also unpersuaded the claims would not be abstract based on any novel aspects argued by Appellants. Br. 23. Whether the subject matter of claim 17 is novel is irrelevant for the patent eligibility inquiry. *Mayo*, 566 U.S. at 78, 88 (even a truly groundbreaking abstract idea, like Einstein's theory of relativity, cannot make a claim patent-eligible); *Affinity Labs of Texas, LLC v. DirecTV, LLC*, 838 F.3d 1253, 1263 (Fed. Cir. 2016) (novelty "does not avoid the problem of abstractness"); *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016) ("a claim directed to a newly

discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the novelty of that discovery for the inventive concept necessary for patent eligibility”); *buySAFE*, 765 F.3d at 1352 (abstract ideas are unpatentable “no matter how ‘[g]roundbreaking, innovative, or even brilliant’” they may be); *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014) (the fact that a method was “not previously employed in this art is not enough—standing alone—to confer patent eligibility upon the claims”).

Appellants’ argument regarding preemption is also misplaced. Br. 23. Although “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). “Where a patent’s claims are deemed only to disclose patent ineligible subject matter” under the *Alice/Mayo* framework, “preemption concerns are fully addressed and made moot.” *Id.*

Accordingly, we agree with the Examiner that the pending claims are directed to an abstract idea of comparing new and stored information and using rules to identify options.

Alice Step Two

Appellants contend the claimed combination of components amounts to significantly more than an abstract idea. Br. 23. Appellants argue “the recited process solves the technological problem of establishing automatic updates for documents automatically determined to be related to one another in a content management system.” *Id.* The Examiner responds, finding the “[r]ecited ‘content management system’ is a program executed by a generic processor and stored in a generic memory that merely ‘automates’ a manual

activity.” Ans. 29. According to the Examiner, updating similar documents is not a technical solution to a problem and, therefore, unlike the claims in *Enfish*, cited by Appellants. *Id.*

We are not persuaded by Appellants’ argument. Appellants fail to identify any technological improvement addressed by the claims. Prior cases have made clear that mere automation of manual processes using generic computers does not constitute a patentable improvement in computer technology. In those cases, “the focus of the claims is not on such an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools.” *Credit Acceptance Corp. v. Westlake Svcs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017) (quoting *Elec. Power Grp.*, 830 F.3d at 1354).

Accordingly, we sustain the rejection of claim 17 under 35 U.S.C. § 101 and, for the same reasons, the rejection of independent claims 1 and 9 which are argued on the basis of claim 17 together the rejection of dependent claims 2, 5–8, 10, 12–14, and 18–25 which are not argued separately. *See* Br. 24.

35 U.S.C. § 103(a)

The Examiner finds Cragun’s Content Management System (CMS) teaches establishing an auto-update relationship based on rules between portions of documents. Final Act. 11. The Examiner applies McChrystal for teaching comparing changes between separate source and target documents rather than changes within a single document as disclosed by Cragun. *Id.* at 11–12. Except for establishment of the auto-update relationship taught by Cragun and document-to-document comparison taught by McChrystal, the Examiner finds the remainder of the generating step is taught by Parikh’s

text input prediction and completion system which bases predictions on extracting words from a plurality of unstructured documents and identifying similar documents based on vectors representing the extracted words. Final Act. 19. *See also* Parikh, Abstract. Thus, the Examiner relies on the combination of Cragun, McChrystal, and Parikh for teaching or suggesting the generating step of claim 17.

Appellants contend the rejection is improper because Parikh is deficient. Br. 11. According to Appellants:

Parikh simply does not contemplate the notion of any auto-update relationship being established between source and target documents - let alone any such auto-update relationship being enforced by the content management system by monitoring changes to the source document and automatically updating the target document based on the monitored changes. Further, *Cragun* and *McChrystal* do not cure these deficiencies of *Parikh*. Because *Cragun*, even in view of *McChrystal* and *Parikh*, does not teach or suggest at least the underlined limitations above, Applicants respectfully request withdrawal of the rejection of independent claim 17.

Br. 12.

The Examiner responds, explaining that aspects of the limitation argued to be missing from *Parikh* are instead taught by *Cragun* and *McChrystal*. Ans. 23. In particular, the Examiner identifies the auto-updating and content management system features of the claims, rather than being taught by *Parikh*, are taught by *Cragun* and *McChrystal*. *Id.* at 23–24. Thus, the Examiner urges Appellants' argument is an improper attack on the references individually when the rejection is based on combinations of references. *Id.* at 23 citing *In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In*

re Merck & Co., Inc., 800 F.2d 1091, 1097 (Fed. Cir. 1986). Appellants do not reply.

We agree with the Examiner. The features argued by Appellants to be missing from Parikh are found in Cragun and McChrystal, notwithstanding Appellants' generalized allegation to the contrary. *See* Br. 12 (“*Cragun* and *McChrystal* do not cure these deficiencies of *Parikh*.”). Thus, other than the naked contention the Cragun and McChrystal references fail to teach aspects of the disputed limitation, Appellants fail to address the Examiner's findings applying those references in combination with Parikh. Merely reciting a claim limitation and asserting it is not present falls short of identifying an error in the Examiner's rejection as required on appeal. Arguments must address the Examiner's action. 37 C.F.R. § 41.37(c)(1)(iv) (“The arguments shall explain why the examiner erred as to each ground of rejection contested by appellant.”); *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[T]he Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art”). Accordingly, we sustain the rejection of independent claim 17 and, for the same reasons, the rejection of independent claims 1 and 9 under 35 U.S.C. § 103(a) together with the rejections of dependent claims 2, 5–8, 10–14, and 18–22⁴ which are not argued separately with particularity.

Appellants also contend error in the rejection of dependent claim 23, arguing the references fail to teach or suggest all four auto-update actions of (i) modifying content without annotating, (ii) augmenting content without

⁴ Claims 24 and 25, which depend from claim 23 (addressed below), are not rejected under 35 U.S.C. § 103(a). Final Act. 26.

annotating, (iii) annotating without updating or augmenting, and (iv) deleting content. Br. 19. Appellants further argue the Examiner’s rationale for combining the teachings of the references is inadequate as merely conclusory. *Id.* The Examiner responds, explaining why each of the actions is taught or suggested by the applied references. Ans. 25. According to the Examiner “the recited four actions are not distinct because ‘augmenting’, ‘annotating’, and ‘deleting’ are specific types of a generic ‘modifying’.” *Id.* at 26. Finding each of the actions to be taught or suggested by the references, the Examiner explains

[O]ne of ordinary skill in the art would be motivated to monitor for changes and perform each of these four actions when changes are determined in order to ensure that both documents contain same information by virtue of additions, deletions, augmentations, and annotations, where annotations can include summary of what has been added, deleted, or otherwise modified in the other related document.

Id.

Appellants’ contentions are unpersuasive of Examiner error. Appellants fail to persuade us the references are deficient in teaching each of the recited actions. In connection with the combination, the Federal Circuit has “[held] that while an analysis of obviousness always depends on evidence that supports the required *Graham* factual findings, it also may include recourse to logic, judgment, and common sense available to the person of ordinary skill that do not necessarily require explication in any reference or expert opinion.” *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009); *see also Nat’l Steel Car, Ltd. v. Canadian Pacific Ry., Ltd.*, 357 F.3d 1319, 1337 (Fed. Cir. 2004) (“It has long been the law that the motivation to combine need not be found in prior art references,

but equally can be found ‘in the knowledge generally available to one of ordinary skill in the art.’” (Quoting *In re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992))). The Court further instructs that

[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 421 (2007).

The Examiner finds the reason for combining the teachings of Cragun, McChrystal, Parikh, Bates, and Tanaka is to ensure that documents contain the same information by virtue of additions, deletions, augmentations, and annotations. Ans. 26. In the absence of sufficient evidence or argument to the contrary, we find the Examiner has articulated reasoning with rational underpinnings sufficient to justify the legal conclusion of obviousness and are unpersuaded by Appellants’ contention that the Examiner’s combination of references is inadequate or improper. Accordingly, we sustain the rejection of claim 23 under 35 U.S.C. § 103(a).

DECISION

We affirm the rejection of claims 1, 2, 5–10, 12–14, and 17–25 under 35 U.S.C. § 101.

We affirm the rejection of claims 1, 2, 5–10, 12–14, and 17–23 under 35 U.S.C. § 103(a).

Appeal 2018-004006
Application 13/553,199

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