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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOACHIM H. FRANK and JAMES E. RUMBAUGH

Appeal 2018-006763
Application 11/618,182
Technology Center 3600

Before ANTON W. FETTING, BIBHU R. MOHANTY,
MEREDITH C. PETRAVICK, *Administrative Patent Judges.*

PETRAVICK, *Administrative Patent Judge.*

DECISION ON REHEARING

STATEMENT OF THE CASE

Pursuant to 37 C.F.R. § 41.52(a), Appellant¹ filed a Request for Rehearing on November 25, 2019 (“Req. Reh’g”) seeking reconsideration of our Decision on Appeal mailed September 25, 2019 (“Dec.”). We have jurisdiction over the Request for Rehearing under 35 U.S.C. § 6(b).

For reasons explained below, Appellant’s Request for Rehearing is denied.

ANALYSIS

A request for rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a). Appellant first contends that, because the Board determined that the claimed method of handling interrupts in a business process is not an improvement to a technical field but to a business process, the Board overlooked “Appellants’ arguments that the process shown in Figure 3 of Appellants’ specification is not a process improving a ‘business process’ but a process improving the technical field of interrupt handling when applied to a business process.” Req. Reh’g 3 (citing Dec. 11). Appellant asserts that the Specification demonstrates that interrupt handling is a technical field. Req. Reh’g 4 (citing Spec. ¶¶ 8–9).

The Board did not overlook Appellant’s arguments. As explained in the Decision, the Board determined that claim 1’s “method of handling an interrupt in a business process” is not an improvement to a technical field but merely uses existing computers as a tool to perform a particular task—handling interrupts in a business process. Dec. 8–9, 11–12. Appellant

¹ “Appellant” refers to “applicant” as defined in 37 C.F.R. § 1.42.

merely disagrees with our determination. Mere disagreement with the Board's Decision is not a proper basis for rehearing.

Contrary to Appellant's assertion, Figure 3 and paragraphs 8 and 9 of the Specification do not describe improvements to a technical field but improvements to a method of handling interrupts of tasks in a business process. The Specification describes a known way of handling interrupts as "immediate and displacing" and describes three other possible ways of handling interrupts, "immediate and additive," "deferred and displacing," and "deferred and additive." Spec. ¶ 8. Likewise, Figure 3 depicts "a flow chart illustrating a logic flow for handling interrupts in a business process execution system." Spec. ¶ 15. The Specification does not describe and Figure 3 does not depict an improvement to a technical field but an improvement to the ways of handling interrupts in the business process. *See e.g.* Spec. ¶¶ 7-9. Further, other paragraphs of the Specification show that an improvement to interrupt handling in a business process is not an improvement to a technical field. As noted in the Decision, the Specification describes the invention as related to "managing interrupting events in a process flow for a business process" and describes known handling interrupts in "a real-world [business] process external to the computer model of a real-world business process." Dec. 2 (citing Spec. ¶¶ 1, 7).

Appellant next argues that because the Examiner allegedly admitted that the claims were novel and non-obvious, the claims are neither routine, conventional, nor well-understood and, therefore, patent eligible. Req. Reh'g 4-5.

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. v. CLS Bank Int’l*, 573 U.S. 208, 217–18 (2014) (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 Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 90 (2012); *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.”).

In the Decision, the Board found that the Specification sufficiently demonstrates that the additional claim elements simply append well-understood, routine, and conventional activities previously known to the industry, specified at a high level of generality, to the abstract idea. *See* Dec. 13–15 (citing Spec. ¶¶ 1–8, 28). In the Rehearing Request, Appellant does not address the Board’s findings with respect to the disclosure of the Specification. *See* Req. Reh’g 4–5. Appellant seems to merely disagree with the Board’s general determination that the additional claim elements,

individually and in combination, are well-understood, routine, and conventional. Mere disagreement with the Board's Decision is not a proper basis for rehearing.

Appellant's Request for Rehearing is denied.

CONCLUSION

Outcome of Decision on Rehearing:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Denied	Granted
1-9	101	patent ineligible subject matter	1-9	
Overall Outcome			1-9	

Final Outcome of Appeal after Rehearing:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-9	101	patent ineligible subject matter	1-9	
Overall Outcome			1-9	

TIME PERIOD FOR RESPONSE

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).

DENIED