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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHEW DeROLLER

Appeal 2018-008042
Application 13/706,544
Technology Center 3600

Before BIBHU R. MOHANTY, MICHAEL C. ASTORINO, and
BRUCE T. WIEDER, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Xerox Corporation. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The Appellant's claimed invention relates to a document workflow management system that may generate an alert for a possible delay (Spec. ¶¶ 4, 5). Claim 1, reproduced below with the italics added, is representative of the subject matter on appeal.

1. A method of coordinating and monitoring progress of an electronic document workflow across a plurality of workflow action personnel electronic devices, the method comprising:

by one or more processors of a hub electronic device, accessing a document workflow file, the document workflow file representing a document management workflow for an electronic document, the document workflow file comprising information identifying a plurality of workflow action personnel, an action that is to be taken by each of the workflow action personnel, and a time period for each action, wherein each of the workflow action personnel is associated with an electronic device;

by the one or more processors of the hub electronic device, monitoring progress of the document management workflow by:

identifying at least a portion of the workflow action personnel to whom the electronic document will be transmitted for action based on a network address or an identification code of the electronic device associated with each of the workflow action personnel,

aggregating, from a plurality of sources associated with a plurality of workflow action personnel electronic devices that are in electronic communication with the hub electronic device via a network, user status information for the identified portion of the workflow action personnel, wherein at least one of the sources for each of the identified workflow action personnel comprises an application that the identified workflow action personnel accesses via an electronic device,

before the document management workflow is complete, determining that the document management workflow is subject to a delay based on the user status information for at least one of the workflow action personnel,

identifying a person whose status is a cause of the delay and a first action that the person is to perform in the document management workflow, and

analyzing the user status information for the identified person to identify a reason for the delay;

by the one or more processors of the hub electronic device, generating an alert comprising an identification of the electronic document, the identified person, and the reason; and

by the one or more processors of the hub electronic device, causing the alert to be transmitted to at least one of the workflow action personnel to whom an action has been assigned.

THE REJECTIONS

The following rejections are before us for review:

1. Claim 7, 11, and 18 are rejected on the grounds of nonstatutory double patenting over claim 4 of US Patent 9,027,537.
2. Claims 1–20² are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.³

² The Answer at page 3 states in heading “2” that claims 1–20 are rejected, but in contrast heading “3” states that the rejection of claims 12–20 is withdrawn. The Answer at pages 3 and 10 states that claims 12–20 are under this grounds of rejection. Thus, the Answer in two locations says claims 12–20 are under this rejection and we consider the withdrawal at heading “3” to be a typographical error. We also note the Appellant states in the Reply Brief at page 2 that all claims 1–20 are rejected.

³ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

ANALYSIS

Rejection under Nonstatutory Double Patenting

The Appellant has not provided any arguments in regards to this rejection and the rejection is therefore summarily affirmed.

Rejection under 35 U.S.C. § 101

The Appellant argues that the rejection of claim 1 is improper because the claim is not directed to an abstract idea (Appeal Br. 9–18). The Appellant argues further that the claim is “significantly more” than the alleged abstract idea (Appeal Br. 18–21; Reply Br. 2–9).

In contrast, the Examiner has determined that the rejection of record is proper (Final Action 6–12; Ans. 4–10).

We agree with the Examiner. 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, and thus patent ineligible, 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)); “tanning, dyeing, making waterproof 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 187; *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.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (internal citation omitted) (citing *Benson* and *Flook*); *see, 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.”).

The PTO recently published revised guidance on the application of § 101. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”). Under the Guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application, i.e., evaluate whether the claim “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* Guidance, 84 Fed. Reg. at 54; *see also* MPEP § 2106.05(a)–(c), (e)–(h)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

- (3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or
- (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See Guidance.

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 (citation 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.* (alterations in original) (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 Specification, at paragraphs 4 and 5, states that the invention generally relates to a document workflow management system that may generate an alert for a possible delay. Here, the Examiner has determined that claim 1 sets forth a method for “collecting information, analyzing it, and displaying certain results of the collection and analysis” and is directed to an abstract concept (Ans. 4). We substantially agree with the Examiner. We determine that the claim sets forth the subject matter in italics above which describes the concept of monitoring document workflow and generating a delay alert which is a certain method of organizing human activity, i.e. a judicial exception. *See Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016) where collecting information, analyzing it, and displaying certain results of the collection and analysis was held to be an abstract idea. In *Two-Way Media LTD v. Comcast Cable Communications*, 874 F.3d 1329, 1377 (Fed. Cir 2017), it was held that claims directed to the concept of (1) sending information, (2) directing the sent information, (3) monitoring the receipt of the sent information, and (4) accumulating records about receipt of the sent information were directed to an abstract idea. In *Fairwarning IP, LLC v. Iatric Systems, Inc.*, 839 F.3d 1089, 1094, (Fed. Cir. 2016), it was held that claims directed to collecting and analyzing information to detect misuse and notifying a user when misuse is detected

was directed to an abstract idea. Thus, we consider the claim to set forth a judicial exception as identified above.

We next determine whether the claim recites additional elements to integrate the judicial exception into a practical application. *See* Guidance, 84 Fed. Reg. at 54–55. The Revised Guidance references the MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) §§ 2106.05(a)–(c) and (e)–(h).

Here, the claim does not improve computer functionality, improve another field of technology, utilize a particular machine, or effect a particular physical transformation. Rather, we determine that nothing in the claim imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort to monopolize the judicial exception.

For example, in claim 1 the steps of [1] “by one or more processors of a hub electronic device, accessing a document workflow file”, [2] “by the one or more processors of the hub electronic device, monitoring progress of the document management workflow by: identifying at least a portion of the workflow action personnel to whom the electronic document will be transmitted”, [3] “aggregating . . . user status information for the identified portion of the workflow action personnel”, [4] “before the document management workflow is complete, determining that the document management workflow is subject to a delay based on the user status information for at least one of the workflow action personnel”, [5] “identifying a person whose status is a cause of the delay and a first action that the person is to perform in the document management workflow”, [6] “analyzing the user status information for the identified person to identify a reason for the delay”, [7] “generating an alert comprising an identification of the electronic document” and [8] “by the one or more processors of the hub

electronic device, causing the alert to be transmitted to at least one of the workflow action personnel” are merely steps performed by a generic computer that do not improve computer functionality. That is, these recited steps [1]–[8] “do not purport to improve the functioning of the computer itself” but are merely generic functions performed by a conventional processor. Likewise, these same steps [1]–[8] listed above do not improve the technology of the technical field and merely use generic computer components and functions to perform the steps. Also, the recited method steps [1]–[8] above do not require a “particular machine” and can be utilized with a general purpose computer, and the steps performed are purely conventional. In this case the general purpose computer is merely an object on which the method operates in a conventional manner. Further, the claim as a whole fails to effect any particular transformation of an article to a different state. The recited steps [1]–[8] fail to provide meaningful limitations to limit the judicial exception and rather are mere instructions to apply the method to a generic computer.

Considering the elements of the claim both individually and as “an ordered combination” the functions performed by the computer system at each step of the process are purely conventional. Each step of the claimed method does no more than require a generic computer to perform a generic computer function. Thus, the claimed elements have not been shown to integrate the judicial exception into a practical application as set forth in the Revised Guidance which references the MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) §§ 2106.05(a)–(c) and (e)–(h).

Turning to the second step of the *Alice* and *Mayo* framework, we determine that the claim does not contain an inventive concept sufficient to “transform” the abstract nature of the claim into a patent-eligible application. The claim fails to add a specific limitation beyond the judicial exception that is not well-understood, routine, and conventional in the field. Rather the claim uses well-understood, routine, and conventional activities previously known in the art and they are recited at a high level of generality. The Specification at paragraphs 20 and 36–41, for example, describes using conventional computer components such as network server, central processing unit, and computer memory in a conventional manner. The claim specifically includes recitations for computers to implement the method but these computer components are all used in a manner that is well-understood, routine, and conventional in the field. Here, the claim has not been shown to be “significantly more” than the abstract idea.

The Appellant at page 4 of the Reply Brief has also cited to *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016) to show that the claim is not abstract, but the claims in that case were not similar in scope to those here and were in contrast directed to a self-referential data table.

The Appellant cites to *DDR Holdings, LLC v. Hotels, L.P.*, 773 F. 3d 1245 (Fed. Cir. 2014) and argues that the claim is “rooted in computer technology” (Reply. Br. 4–7). We disagree as the Appellant has not shown how the claimed subject matter is rooted in technology given that the Specification describes only the use of generic computer equipment used in routine, conventional, and generic manner.

For these above reasons the rejection of claim 1 is sustained. The Appellant has provided the same arguments for the remaining claims which

are drawn to similar subject matter and the rejection of these claims is sustained for the same reasons given above.

CONCLUSIONS OF LAW

We conclude that Appellant has not shown that the Examiner erred in rejecting the claims as listed in the Rejections section above.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
7, 11, 18		Non Statutory Double Patenting	7, 11, 18	
1-20	101	Eligibility	1-20	
Overall Outcome			1-20	

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).

AFFIRMED