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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte ANURADHA NARASIMHASWAMY MELKOTE, DAMIAN PORCARI, and KELLY ANNE SLANK

_____

Appeal 2018-008843
Application 13/679,419
Technology Center 2400

_____

Before JEAN R. HOMERE, MARC S. HOFF, and ERIC B. CHEN, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the Examiner's decision to reject claims 1–5, 8–11, and 16–23. Claims 6, 7, and 12–15 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Appellant's invention relates to an on-line invention disclosure system. (Abstract.)

Claim 1, reproduced below, is illustrative of the claimed subject matter, with bracketed reference numbers added and disputed limitations in italics:

> 1. A method of forming an online invention disclosure comprising:
>
> by at least one processor,
>
> [i] forming an invention disclosure online by receiving a plurality of selected information that includes identification information for a plurality of inventors and a predefined classification code indicative of a type of technical subject matter described by the disclosure;
>
> [ii] storing the information in a central storage location,
>
> [iii] prompting approval of the disclosure,
>
> [iv] in response to the approval, locking the disclosure to create a locked disclosure to prevent further editing of the disclosure, and
>
> [v] *in response to the locking, obtaining a docket number for the disclosure from a docket system*, and

[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 Anaqua, Inc. (Appeal Br. 2.)

> generating a notification for an invention ranking committee selected according to the predefined classification code to prompt the committee to rank the disclosure.

REFERENCES

Name	Reference	Date
Hager et al.	US 5,247,661	Sept. 21, 1993
Lemble	US 5,315,504	May 24, 1994

REJECTIONS

Claims 1–5, 8–11, and 16–23 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.

Claims 1–5, 8–11, and 16–23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lemble and Hager.

OPINION

§ 101 Rejection

We are unpersuaded by Appellant's arguments (Appeal Br. 3–4; *see also* Reply Br. 2) that independent claims 1, 16, and 20 are directed to patent-eligible subject matter under 35 U.S.C. § 101.

The Examiner determined that claims 1, 16, and 20 are "directed to an abstract idea of drafting [an] 'invention disclosure'" (Final Act. 2) and "the claimed limitations . . . could simply be a human performing a role of a 'processor' performing the claims limitations" (Ans. 4). Moreover, the Examiner determined that

> Claim 1 includes additional elements of "at least processor", Claim 16 includes additional elements of "user computer", "server" and database", and Claim 20 includes additional element of "at least one processor", which are components of a

> generic network computer or is a generic network computer itself.

(Final Act. 3.) We agree with the Examiner's determinations and ultimate conclusion that the claims are directed to patent-ineligible subject matter.

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*. *Alice*, 573 U.S. 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, 67 (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 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 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.* (citing *Benson* and *Flook*); *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 (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.* (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 PTO recently published revised guidance on the application of § 101. USPTO's *2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE*, 84 Fed. Reg. 50 (Jan. 7, 2019); *see also* USPTO, *October 2019 Update: Subject Matter Eligibility*, 84 Fed. Reg. 55942 (Oct. 17, 2019). Under that 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 (*see* MPEP § 2106.05(a)–(c), (e)–(h) (9th ed. 2019)).

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 are 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 84 Fed. Reg. 56.

Are the claims at issue directed to a patent-ineligible concept?

Step One

Claims 1 and 20 are method claims, which fall within the "process" category of 35 U.S.C. § 101. Likewise, claim 16 is a system claim, which

falls within the "manufacture" category of 35 U.S.C. § 101. Therefore, claims 1, 16, and 20 fall within one of the four statutory categories of patentable subject matter identified by 35 U.S.C. § 101.

Although claims 1, 16, and 20 fall within the statutory categories, we must still determine whether the claims are directed to a judicial exception, namely an abstract idea. *See Alice*, 573 U.S. at 216. Thus, we must determine whether the claims recite a judicial exception and whether the exception is integrated into a practical application. *See* 84 Fed. Reg. at 52–55. If a claim recites a judicial exception without integrating the judicial exception into a practical application, the claim is directed to a judicial exception under the first step of the *Alice/Mayo* test. *See id.*

Step 2A, Prong One

Independent claim 1 is a method claim, and recites the following limitations: "[i] forming an invention disclosure . . . by receiving a plurality of selected information that includes identification information for a plurality of inventors and a predefined classification code indicative of a type of technical subject matter described by the disclosure" and "[ii] storing the information in a central storage location."

Thus, the method steps of claim 1 encompass mental processes. In particular, the method limitations of claim 1 can be performed either by human thought alone, by a human using pen and paper, or by humans without a computer. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) ("[U]npatentable mental processes" include "steps [that] can be performed in the human mind, or by a human using a pen and paper."); *see also Mortg. Grader, Inc. v. First Choice Loan*

Servs. Inc., 811 F.3d 1314, 1324 (Fed. Cir. 2016) ("The series of steps covered by the asserted claims . . . could all be performed by humans without a computer."). For example, a legal professional could receive an invention disclosure, which includes information about the inventors and the technical subject matter. Upon receipt, the invention disclosure could be stored in a filing system.

Independent claim 1 further recites the following limitations: "[iv] in response to the approval, locking the disclosure to create a locked disclosure to prevent further editing of the disclosure," "[v] in response to the locking, obtaining a docket number for the disclosure from a docket system," and "[vi] generating a notification for an invention ranking committee selected according to the predefined classification code to prompt the committee to rank the disclosure." Likewise, the method steps of claim 1 can be performed either by human thought alone, by a human using pen and paper, or by humans without a computer. *See CyberSource Corp.*, 654 F.3d at 1372–73; *see also Mortg. Grader, Inc.*, 811 F.3d at 1324. For example, the legal professional can request that the inventors submit updates to the invention disclosure before a deadline. Once the deadline has passed, the legal professional assigns the invention disclosure a docketing number and forwards such invention disclosure for management approval, such that management prioritizes the invention disclosure based upon technical subject matter.

Accordingly, claim 1 recites a judicial exception. Claims 16 and 20 recite limitations similar to those discussed with respect to claim 1. Thus, claims 16 and 20 also recite a judicial exception.

Step 2A, Prong Two

Because claims 1, 16, and 20 recite a judicial exception, we next determine if the claims recite additional elements that integrate the judicial exception into a practical application.

Method claim 1 includes the following limitations: "by at least one *processor*, [i] forming an invention disclosure *online* . . . [ii] storing the information . . . [iii] prompting approval of the disclosure . . . [iv] in response to the approval, locking the disclosure . . . [v] in response to the locking, obtaining a docket number . . . and generating a notification" (emphases added).

The recited computer hardware, including a "processor" and computer for "online" access are merely tools for performing the abstract idea. *See Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1262 (Fed. Cir. 2016) ("[T]he claims are directed not to an improvement in cellular telephones but simply to the use of cellular telephones as tools in the aid of a process focused on an abstract idea.").

Accordingly, claim 1 does not recite additional elements that integrate the judicial exception into a practical application. Claims 9 and 17 recite similar additional limitations.

Is there something else in the claims
that ensures that they are directed to significantly
more than a patent ineligible concept?

Step 2B

Because claims 1, 9, and 17 are directed to a judicial exception, we next determine, according to *Alice*, whether these claims recite an element,

or combination of elements, which is enough to ensure that the claim is directed to significantly more than a judicial exception.

Claims 1 and 20 are method claims, which recite a "processor" and a computer for accessing an "online" invention disclosure. Similarly, claim 16 recites a "user computer," a "server," a "database," and "user screens."

With respect to the claimed hardware components, Appellant's Specification discloses the following:

> Referring now to Figure 1, an on-line invention disclosure system 10 is illustrated. On-line disclosure system 10 is web based system having a *web server 12* that is coupled to a plurality of users, one of which is shown as *user computer 14*. The web server 12 as will be further described below may be coupled to a directory server 16 containing user information and to a *database system 18*. Database 18 may contain both docketing information and disclosure information.

(Spec. 6:19–28 (emphasis added).)

> In one aspect of the invention an on-line invention disclosure system [10] includes a user computer [14] and a web server [12] having an identification subsystem. A database [18] is coupled to the server [12]. *The server provides user screens* to the user to prompt users to provide user information to the server.

(Spec. 4:7–12 (emphasis added).)

The generalized functional terms by which the computer components are described reasonably indicates that Appellant's Specification discloses: (i) conventional user computer 14; (ii) conventional web server 12 with user screens; and (iii) conventional database system 18. Although Appellant's Specification is silent with respect to the claimed "processor," such

processor is also a conventional computer component.[2] In addition, Appellant's Figure 1 illustrates on-line invention disclosure system 10, which includes user computer 14, web server 12, and database system 18 functioning cooperatively as an ordered combination.

In view of Appellant's Specification, the claimed hardware components, including a "processor," a "user computer," a "server," a "database," and "user screens," reasonably may be determined to be generic, purely conventional computer elements, as an ordered combination.

Thus, claims 1, 16, and 20 do no more than require generic, purely conventional computer elements, as an ordered combination, performing generic computer functions, rather than improve computer capabilities.

Appellant argues the following:

> The claims are directed to improvements in the technological infrastructure used for creating and processing invention disclosures. Such improvements are evidenced by the fact that, responsive to approval of a disclosure, the disclosure is locked, and responsive to the disclosure being locked, a docket number is obtained, a notification for a ranking committee is generated, etc.—none of which are abstract ideas.

(Appeal Br. 3; *see also* Reply Br. 2.) However, Appellant has not adequately explained why the claim "purport[s] to improve the functioning of the computer itself" or "any other technology or technical field." *Alice*, 573 U.S. at 225. In particular, Appellant has not explained how "creating and processing invention disclosures" improves the function of a computer or other technology. Moreover, the Examiner has identified the appropriate

[2] A "CPU" (or "processor") is defined as "[t]he computational and control unit of a computer" and "is the device that interprets and executes instructions." MICROSOFT® COMPUTER DICTIONARY 132 (5th ed. 2002).

judicial exception as "mental processes" and the Examiner has compared the claimed concepts of independent claim 1 to the appropriate Federal Circuit decision (i.e., language from *CyberSource*).

Appellant further argues the following:

> Claim 1, for example, requires that the docket number be obtained for the disclosure from a docket system, and that a notification for an invention ranking committee selected according to the predefined classification code be generated to prompt the committee to rank the disclosure. These operations are not mere generic activity, but specifically tailored (or specialized) to the world of invention disclosures. A generic computer, for example, is not able to obtain data from a docket system.

(Appeal Br. 3–4.) However, other than conclusory statements that the claims recite "something more" because "[a] generic computer . . . is not able to obtain data from a docket system," Appellant has not provided any further arguments or evidence to support this position.

Thus, we agree with the Examiner that claims 1, 16, and 20 are directed towards patent-ineligible subject matter.

Accordingly, we sustain the rejection of independent claims 1, 16, and 20 under 35 U.S.C. § 101. Claims 2–5, 8–11, 17–19, and 21–23 depend from independent claims 1, 16, and 20, and Appellant has not presented any additional substantive arguments with respect to these claims. We sustain the rejection of claims 2–5, 8–11, 17–19, and 21–23 under 35 U.S.C. § 101 for the same reasons discussed with respect to independent claims 1, 16, and 20.

§ 103 Rejection

We are unpersuaded by Appellant's arguments (Appeal Br. 4–5; *see also* Reply Br. 2) that the combination of Lemble and Hager would not have rendered obvious independent claim 1, which includes the limitation "in response to the locking, obtaining a docket number for the disclosure from a docket system."

The Examiner found that the automatic distribution system of Hager for electronic invention disclosure documents, including determining if the invention disclosure document is in final form and assigning a unique disclosure number, collectively correspond to the limitation "in response to the locking, obtaining a docket number for the disclosure from a docket system." (Ans. 4–5; *see also* Final Act. 5.) We agree with the Examiner's findings.

Hager relates to "the automated distribution of an electronic document to a preselected list of recipients." (Abstract.) Figures 2 and 3 of Hager illustrate "creation of an electronic invention disclosure document which may be automatically distributed." (Col. 2, ll. 51–58.) In reference to Figure 2, Hager explains the following:

> block 64 depicts the determination of whether or not the invention disclosure document is now in final form and ready to be submitted to an evaluation facility by the performance of an automated error check to determine if all required data for a complete invention disclosure document has been entered. . . . Thereafter, block 66 illustrates the transmission of the invention disclosure document to an evaluation facility and the process terminates, as depicted in block 68.

(Col. 4, l. 68 to col. 5, l. 12.) Moreover, in reference to Figure 5, Hager explains that "block 78 depicts the automatic assigning of a unique identifier, such as a disclosure number, to be associated thereafter with the

invention disclosure document." (Col. 5, ll. 57–60.) Because Hager explains that in block 64, the invention disclosure document is only placed in "final form" after completion of an error check before proceeding to block 78, Hager teaches the limitation "in response to the locking, obtaining a docket number for the disclosure from a docket system."

Appellant argues the following:

> there is a check to determine whether the invention disclosure is in final form before transmitting it to an evaluation facility (Figure 2), and there is a check to determine whether a received invention disclosure is organized in the desired format and includes all required information before assigning a disclosure number (Figure 3). . . . But just because operation A occurs before operation D does not mean that operation D is performed in response to operation A. Put a different way, assigning a disclosure number is not in response to finalizing.

(Appeal Br. 5; *see also* Reply Br. 2.) Contrary to Appellant's arguments, Hager explains that placing the invention disclosure document in "final form" (i.e., block 64) is required before proceeding to the step of assigning a disclosure number (i.e., block 78).

Thus, we agree with the Examiner that the combination of Lemble and Hager would have rendered obvious independent claim 1, which includes the limitation "in response to the locking, obtaining a docket number for the disclosure from a docket system."

Accordingly, we sustain the rejection of independent claim 1 under 35 U.S.C. § 103. Claims 2–5 and 8–11 depend from claim 1, and Appellant has not presented any additional substantive arguments with respect to these claims. Therefore, we sustain the rejection of claims 2–5 and 8–11 under 35 U.S.C. § 103, for the same reasons discussed with respect to independent claim 1.

Independent claims 16 and 20 recite limitations similar to those discussed with respect to independent claim 1, and Appellant has not presented any additional substantive arguments with respect to these claims. We sustain the rejection of claims 16 and 20, as well as dependent claims 17–19 and 21–23, for the same reasons discussed with respect to claim 1.

CONCLUSION

The Examiner's decision rejecting claims 1–5, 8–11, and 16–23 under 35 U.S.C. § 101 is affirmed.

The Examiner's decision rejecting claims 1–5, 8–11, and 16–23 under 35 U.S.C. § 103 is affirmed.

DECISION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–5, 8–11, 16–23	101	Eligibility	1–5, 8–11, 16–23	
1–5, 8–11, 16–23	103	Lemble, Hager	1–5, 8–11, 16–23	
Overall Outcome			1–5, 8–11, 16–23	

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)(1)(iv).

AFFIRMED