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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* AMARENDRA SRIVASTAVA, SAURABH SAXENA, and  
MOHAN SUNKARA

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Appeal 2019-001514  
Application 14/814,652  
Technology Center 3600

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Before ERIC S. FRAHM, JOYCE CRAIG and MATTHEW J. McNEILL,  
*Administrative Patent Judges.*

CRAIG, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1–20. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Intuit, Inc. Appeal Br. 4.

### CLAIMED SUBJECT MATTER

The claims are directed to logging user activities in an activity feed of a financial management application so that an activity may be later selected by the user to be undone. Spec. ¶ 12. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method for managing a plurality of financial documents using a financial management application (FMA), comprising:

performing a plurality of activities of the FMA,

wherein the plurality of activities comprises one or more actions performed to complete a task of the FMA resulting in at least one document detailing financial data related to the operation of an entity;

recording, in an activity feed on a user interface, the plurality of activities and metadata describing characteristics of performing the plurality of activities;

selecting, in response to a user request to undo a first activity of the plurality of activities found on the user interface, the first activity from the activity feed;

selecting, from the activity feed and further in response to the user request to undo the first activity, a second activity of the plurality of activities, wherein the second activity is selected based on a parent-child relationship with the first activity as specified by the metadata;

selecting, based on the metadata and from the plurality of financial documents, a first financial document that was accessed by the FMA when performing the first activity;

identifying, based on the metadata, a first result of the first activity on the first financial document; and

modifying the first financial document to remove the first result of the first activity.

## REJECTIONS

Claims 1–20 stand rejected under 35 U.S.C. § 101 because the claims are directed to patent-ineligible subject matter. Final Act. 3–9.

Claims 1–20 stand rejected under 35 U.S.C. § 103 as unpatentable over the combination of McInerney et al. (US 2008/0307333 A1, published Dec. 11, 2008) (“McInerney”) and Massey et al. (US 2011/0113359 A1, published May 12, 2011) (“Massey”). Final Act. 9–15.

## ANALYSIS

### *Rejection of Claims 1–20 Under 35 U.S.C. § 101*

Appellant argues that the Examiner’s rejection of claim 1 under 35 U.S.C. § 101 as directed to patent-ineligible subject matter is in error. Appeal Br. 7–13. To the extent Appellant has not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. 37 C.F.R. § 41.37(c)(1)(iv). Appellant argues claims 1–20 as a group. *See* Appeal Br. 7. Given our discretion under 37 C.F.R. § 41.37(c)(1)(iv), we decide the § 101 rejection of claims 1–20 based on representative claim 1.

### Legal Standard

“Whether a claim is drawn to patent-eligible subject matter is an issue of law that we review de novo.” *SiRF Tech., Inc. v. Int’l Trade Comm’n*, 601 F.3d 1319, 1331 (Fed. Cir. 2010).

The Supreme Court’s two-step framework guides our analysis of patent eligibility under 35 U.S.C. § 101. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014). In addition, the Office recently published revised guidance for evaluating subject matter eligibility under 35 U.S.C. § 101, specifically with respect to applying the *Alice* framework. USPTO, 2019

Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“2019 Revised Guidance”). If a claim falls within one of the statutory categories of patent eligibility (i.e., a process, machine, manufacture, or composition of matter) then the first inquiry is whether the claim is directed to one of the judicially recognized exceptions (i.e., a law of nature, a natural phenomenon, or an abstract idea). *Alice*, 573 U.S. at 217. As part of this inquiry, we must “look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

Per the 2019 Revised Guidance, this first inquiry has two prongs of analysis (i) does the claim recite a judicial exception (e.g., an abstract idea), and (ii) if so, is the judicial exception integrated into a practical application. 84 Fed. Reg. at 54. Under the 2019 Revised Guidance, if the judicial exception is integrated into a practical application, *see infra*, the claim is patent eligible under § 101. 84 Fed. Reg. at 54–55. If the claim is directed to a judicial exception (i.e., recites a judicial exception and does not integrate the exception into a practical application), the next step is to determine whether any element, or combination of elements, amounts to significantly more than the judicial exception. *Alice*, 573 U.S. at 217; 84 Fed. Reg. at 56. 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).

To summarize, under the current 2019 Revised 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* Manual for Patent Examining Procedure (“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* 2019 Revised Guidance.

#### Step 1

Claim 1, a method claim, falls within the process category of § 101. *See* 2019 Revised Guidance, 84 Fed. Reg. at 53–54 (citing MPEP § 2106.03, 2106.06).

#### Step 2A(i): Does the Claim Recite a Judicial Exception?

The Examiner determined that claim 1 is directed to “managing a plurality of financial documents by modifying them to undo an activity performed with respect to the document,” which is similar to “collecting

information, analyzing it,”<sup>2</sup> and “displaying certain results of the collection and analysis.”<sup>3</sup> See Final Act. 6. See Appeal Br. 8–11 and Reply Br. 2–5.

We agree with the Examiner that claim 1 recites an abstract idea, specifically mental processes. The “performing,” “selecting,” “identifying,” and “modifying” steps, as recited in claim 1, are part of the recited abstract idea because such rule-based tasks can be performed by the human mind or with pen and paper. The 2019 Revised Guidance explains that “mental processes” include acts that people can perform in their minds or using pen and paper, even if the claim recites that a generic computer component performs the acts. See Guidance, 84 Fed. Reg. at 52 n.14 (“If a claim, under its broadest reasonable interpretation, covers performance in the mind but for the recitation of generic computer components, then it is still in the mental processes category unless the claim cannot practically be performed in the mind.”); see also *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1318 (Fed. Cir. 2016) (“[W]ith the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper”), quoted in 2019 Revised Guidance, 84 Fed. Reg. at 52 n.14.

Moreover, the 2019 Revised Guidance expressly recognizes mental processes, including observations, evaluations, judgments, and opinions that can be performed in the human mind, as patent-ineligible abstract ideas. Accordingly, because the steps of “performing a plurality of activities,” “selecting” activities and a document, “identifying” a result, and “modifying” a document involve observations, evaluations, judgments,

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<sup>2</sup> *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016).

<sup>3</sup> *Id.*

and/or opinions, claim 1 can be characterized as reciting a judicial exception to patent-eligible subject matter.

Because claim 1 recites an abstract idea, we proceed to Prong Two of Step 2A to determine if the idea is integrated into a practical application, in which case the claim as a whole would not be “directed to” merely an abstract idea.

Step 2A(ii): Judicial Exception Integrated into a Practical Application?

Because we determined that claim 1 recites a patent-ineligible concept, we next determine whether the recited judicial exception is integrated into a practical application of that exception by: (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application.

We use the term “additional elements” for claim features, limitations, or steps that the claim recites beyond the identified judicial exception. *See* Revised Guidance at 55 n.24. In claim 1, the additional elements include the limitation “recording, in an activity feed on a user interface, the plurality of activities and metadata describing characteristics of performing the plurality of activities.”

To integrate the exception into a practical application, additional claim elements must, for example, improve the functioning of a computer or any other technology or technical field (*see* MPEP § 2106.05(a)), apply the judicial exception with a particular machine (*see* MPEP § 2106.05(b)), affect a transformation or reduction of a particular article to a different state or thing (*see* MPEP § 2106.05(c)), or apply or use the judicial exception in

some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment (*see* MPEP § 2106.05(e)). *See* 2019 Revised Guidance.

Appellant argues that claim 1 provides additional elements that reflect an improvement in the functioning of a computer, or an improvement to other technology or technical field. *See* Appeal Br. 11–12; Reply Br. 5–7. In particular, Appellant argues that the claim limitations result in effectively “rolling back” the financial document to a preferred version that would be otherwise unrecoverable. *See* Appeal Br. 11–12. Thus, Appellant argues that claim 1 provides an improvement in the technical fields of document management and version control. *Id.*

Appellant’s arguments are not persuasive. Appellant has not persuaded us that recording, in an activity feed on a user interface, the plurality of activities and metadata describing characteristics of performing the plurality of activities, as in claim 1, “improve[s] the functioning of the computer, make[s] it operate more efficiently, or solve[s] any technological problem.” *Trading Techs. Int’l Inc. v. IBG LLC*, 921 F.3d 1378, 1384–85 (Fed. Cir. 2019). Rather, the claim simply “includes instructions to implement an abstract idea on a computer” and “does no more than generally link the use of a judicial exception to a particular technological environment or field of use.” 2019 Revised Guidance, 84 Fed. Reg. at 55. Indeed, Appellant acknowledges that the method recited in claim 1 can be performed on virtually any type of computing system. *See* Spec. ¶¶ 38–39.

Further, the mere displaying of a plurality of activities on a graphical user interface, as described by the additional elements noted above, is simply

an insignificant extra-solution activity added to the judicial exception. *See* 2019 Revised Guidance, 84 Fed. Reg. at 55.

Appellant also argues that claim 1 is patent-eligible because its practice does not preempt practice by others. Appeal Br. 15.

While preemption may signal patent ineligible subject matter, the absence of complete preemption “does not demonstrate patent eligibility, . . . [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 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, 1362–63 (Fed. Cir. 2015) (“that 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”).

Considering claim 1 as a whole, then, Appellant’s invention lacks a technical solution to a technical problem. Claim 1 as a whole merely uses instructions to implement the abstract idea on a computer or, alternatively, merely uses a computer as a tool to perform the abstract idea. Here, the additional limitation(s) do not integrate the judicial exception into a practical application. More particularly, the claims do not recite (i) an improvement to the functionality of a computer or other technology or technical field; (ii) a “particular machine” to apply or use the judicial exception; (iii) a particular transformation of an article to a different thing or state; or (iv) any other meaningful limitation. *See* 84 Fed. Reg. at 55. Rather, claim 1 recites an abstract idea as identified in Step 2A(i), *supra*, and none of the limitations integrates the judicial exception into a practical application.

Therefore, because the abstract idea is not integrated into a practical application, we conclude that the claim is directed to the judicial exception.

Step 2B — “Inventive Concept” or “Significantly More”

If the claims are directed to a patent-ineligible concept, as we conclude above, we proceed to the “inventive concept” step. For Step 2B we must “look with more specificity at what the claim elements add, in order to determine ‘whether they identify an “inventive concept” in the application of the ineligible subject matter’ to which the claim is directed.” *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1258 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)). We look to see whether there are any “additional features” in the claims that constitute an “inventive concept,” thereby rendering the claims eligible for patenting even if they are directed to an abstract idea. *Alice*, 573 U.S. at 221. Those “additional features” must be more than “well-understood, routine, conventional activity.” *Mayo*, 566 U.S. at 79.

The Examiner found, and we agree, that the additional elements in claim 1 amount to a well-understood, routine, conventional activity previously known to the industry. *See* Final Act. 7–8 and Ans. 5–7.

Appellant argues that claim 1 includes a “hierarchy of activities” in which rolled-back changes may be automatically propagated through the hierarchy to all the child activities. Appellant argues that this combination of claim elements is not well-understood, routine, and conventional activity in the industry. *See* Appeal Br. 13–14, Reply Br. 5–7. Additionally, Appellant argues that the claims recite an inventive concept, alleging that the additional elements identified above amount to “significantly more” than the judicial exception. *See* Reply Br. 7–8. Finally, Appellant argues that the

factual findings required by *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018) have not been satisfied. *See* Reply Br. 8–9.

We are not persuaded that the Examiner erred. Appellant fails to provide any evidence as to how the additional elements identified above are “significantly more” than the well-understood, routine, and conventional functions outlined by the courts. Rather, Appellant simply recites:

[I]ndependent claim 1 includes receiving a user request to undo a first activity performed on a financial document, identifying a result that occurred from performing the first activity on the financial document, and then modifying the financial document to remove the result. This effectively rolls back the financial document to an earlier version of itself, giving the user access to a preferred version of the financial document that would otherwise be unrecoverable.

*See* Reply Br. 9. Based on the above, Appellant asserts, without persuasive argument, that claim 1 uses different computer functions than the arranging, storing, retrieving, sorting, eliminating and determining information described by the courts in *Versata*.<sup>4</sup> Reply Br. 9.

Moreover, as noted in Step 2A(ii) above, the claim limitation that is an additional element beyond the judicial exception is “recording, in an activity feed on a user interface, the plurality of activities and metadata describing characteristics of performing the plurality of activities.” Simply displaying a list of the plurality of activities, along with the metadata describing characteristics of performing the respective activities, is a well-understood, routine and conventional function of a generic computer. *See*

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<sup>4</sup> *Versata Dev. Group, Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1331 (Fed. Cir. 2015).

*Alice*, 573 U.S. at 224–25; *Versata*, 793 F.3d at 1334; *see also TLI Commc ’ns LLC Patent Litig.*, 823 F.3d 607, 612–13 (Fed. Cir. 2016).

Additionally, because the Specification describes the additional elements in general terms, without describing the particulars, we conclude the claim limitations may be broad but reasonably construed as reciting conventional computer components and techniques, particularly in light of Appellant’s Specification, as cited above. *See Berkheimer Memo*<sup>5</sup> § III.A.1; Spec. ¶¶ 38–39. We conclude claim 1 does not have an inventive concept because the claim, in essence, merely recites various computer-based elements along with no more than mere instructions to implement the identified abstract idea using the computer-based elements.

Because the claims are directed to a judicial exception, without significantly more, we sustain the Examiner’s § 101 rejection of independent claim 1 and grouped claims 2–20, not argued separately with particularity.

*Rejection of Claims 1–20 Under 35 U.S.C. § 103(a)*

The USPTO “must examine the relevant data and articulate a satisfactory explanation for its action including a rational connection between the facts found and the choice made.” *Motor Vehicle Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43 (1983) (internal quotation

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<sup>5</sup> “Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*)” at 3 (Apr. 19, 2018) (explaining that a specification that describes additional elements “in a manner that indicates that the additional elements are sufficiently well-known that the specification does not need to describe the particulars of such additional elements to satisfy 35 U.S.C. § 112(a)” can show that the elements are well understood, routine, and conventional).

marks and citation omitted); *see Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d 1309, 1322 (Fed. Cir. 2016) (stating that, as an administrative agency, the PTAB “must articulate logical and rational reasons for [its] decisions” (internal quotation marks and citation omitted)). We will not resort to speculation or assumptions to cure the deficiencies in the Examiner’s fact finding. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). In this light, and in view of the Examiner’s findings of fact for the rejection of claim 1 (*see* Final Act. 9–15; Ans. 7–11), we are persuaded that the Examiner erred in rejecting claim 1 over the combination of McInerney and Massey.

In the Final Rejection, the Examiner concluded that the combination of McInerney and Massey renders claim 1 obvious (*see* Final Act. 9–15). More particularly, the Examiner found McInerney teaches a method for managing a plurality of documents using a management application, including recording, in an activity feed on a user interface, the plurality of activities and metadata describing characteristics of performing the plurality of activities (McInerney ¶¶ 42, 66 and 90), and selecting, from the activity feed and further in response to the user request to undo the first activity, a second activity of the plurality of activities (¶ 60). The Examiner also found the claims do not explicitly require the selection of second activity occur after both the first and second activity are performed (*see* Ans. 8).

Appellant argues, and we agree, that claim 1 requires (i) both a first activity and a second activity be selected in response to a user request to undo the first activity; (ii) the selection of the first activity and the selection of the second activity occur after both the first activity and the second activity are performed; and (iii) the first activity and the second activity are

selected from the same activity feed. *See* Appeal Br. 17–18. Further, Appellant argues that McInerney, and, by extension, the combination of McInerney and Massey, fails to teach or suggest the second activity being listed on the activity feed, and further, being selected in response to the user’s request to undo the first activity. *Id.* at 17.

As Appellant points out, McInerney teaches a file navigation interface for managing multiple documents, wherein document backups are periodically taken as snapshots, each backup showing the existing document at the time of the snapshot. *See* Appeal Br. 17, citing ¶¶ 52–53. The user can choose to access a particular version of a document by selecting a snapshot and having the corresponding version of the document shown in the snapshot being restored to the active user interface. *Id.*, citing ¶ 55. McInerney further teaches that a document may be deleted from all subsequent snapshots or from a single snapshot. *Id.*, citing ¶¶ 60–61. Based on the above teachings, Appellant argues, and we agree, that McInerney’s second activity is not selected in response to a user’s request to undo a first activity. *See* Appeal Br. 17–18. Rather, McInerney teaches activity selections are performed independently of one another.

Additionally, claim 1 requires that all activities be recorded into an activity feed, from which a user can choose to undo a first activity and select a second activity. Thus, the first and second activities must be performed and recorded on the activity feed. If, as alleged by the Examiner, a deletion operation is the second activity (*see* Final Act. 10), it would be illogical to choose to perform the deletion operation on an already deleted document, even if the deletion operation was recorded on an activity feed.

As a result, on the record before us, Appellant has shown the Examiner erred in rejecting independent claims 1, 8, and 15 and, thus, claims 2–7, 9–14, and 16–20 depending respectively therefrom, under 35 U.S.C. § 103(a). Accordingly, we reverse the Examiner’s obviousness rejection of claims 1–20 over the combination of McInerney and Massey.<sup>6</sup>

### DECISION

We affirm the Examiner’s decision rejecting claims 1–20 under 35 U.S.C. § 101. We reverse the Examiner’s decision rejecting claims 1–20 under 35 U.S.C. § 103.

Because we affirm at least one ground of rejection with respect to each claim on appeal, the Examiner’s decision rejecting claims 1–20 is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

### DECISION SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–20	101	Eligibility	1–20	
1–20	103	McInerney, Massey		1–20
<b>Overall Outcome:</b>			1–20	

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<sup>6</sup> Because we are persuaded of error with regard to the identified issue, which is dispositive of the § 103 rejection of claims 1–20 over McInerney and Massey, we do not reach the additional issues raised by Appellant’s arguments.

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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