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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL A. MARTH and KEN BEATON

Appeal 2019-001783
Application 14/630,442
Technology Center 3600

Before JOHNNY A. KUMAR, JENNIFER S. BISK, and JOYCE CRAIG,
Administrative Patent Judges.

BISK, *Administrative Patent Judge.*

DECISION ON APPEAL¹

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant² appeals from the Examiner’s decision to reject claims 1–16 and 21–24. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Throughout this Decision we have considered the Specification filed February 24, 2015 (“Spec.”), the Final Rejection mailed June 14, 2018 (“Final Act.”), the Appeal Brief filed October 18, 2018 (“Appeal Br.”), the Examiner’s Answer mailed November 30, 2018 (“Ans.”), and the Reply Brief filed December 26, 2018 (“Reply Br.”).

² We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Adobe Systems, Inc. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The claims are directed to managing content for marketing, including content creation, deployment collaboration, activity stream, and task management. Spec. ¶ 4. Claims 1, 13, and 21 are independent. Claim 1, reproduced below, is illustrative of the claimed subject matter (bracketed numbers added):

1. In a digital medium environment involving content creation, a system to create the content comprising one or more modules implemented at least partially in hardware, the one or more modules configured to perform operations comprising:

[1] monitoring interaction of one or more users with content available via a shared network resource, the interaction including execution of an image editing operation to modify the content as part of the shared network resource;

[2] collecting comments and markups made in association with the content as part of the monitored interaction, the markups identifying portions within the content that correspond with respective comments;

[3] exposing a user interface for display that includes:

[a] the content and the markups in which at least one of the markups is disposed over a display of the content; and

[b] an activity stream that includes the collected comments and an indication of the execution of the image editing operation to modify the content; and

[4] responsive to the comments and the markups being made by a first contributor type, presenting the content and the markups for review without requiring approval by a managing user of the shared network resource; and

[5] responsive to the comments and the markups being made by a second contributor type, presenting the content and the markups for review and requiring approval by the managing user of the shared network resource.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
O'Donnell	U.S. 9,396,279 B1	July 19, 2016
Vagell	U.S. 9,529,785 B2	Dec. 27, 2016
Roman	U.S. 2013/0332512 A1	Dec. 12, 2013

REJECTIONS

Claims 1–16 and 21–24 are rejected under 35 U.S.C. § 101 because the claimed invention is not directed to patent eligible subject matter. Final Act. 4–8.

Claims 1–8, 13–16, and 21–24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Donnell and Vagell. Final Act. 8–14.

Claims 9–12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Donnell, Vagell, and Roman. Final Act. 14–17.

OPINION

We review the appealed rejections for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). 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).

We have considered all of Appellant's arguments and any evidence presented. We highlight and address specific findings and arguments for emphasis in our analysis below.

Rejection of Claims 1–16 and 21–24 under 35 U.S.C. § 101

Section 101 of the Patent Act provides that “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” is patent eligible. 35 U.S.C. § 101. But the Supreme Court has long recognized an implicit exception to this section: “Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). To determine whether a claim falls within one of these excluded categories, the Court has set out a two-part framework. The framework requires us first to consider whether the claim is “directed to one of those patent-ineligible concepts.” *Alice*, 573 U.S. at 217. If so, we then examine “the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 573 U.S. at 217 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78, 79 (2012)). That is, we examine the claims for an “inventive concept,” “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*, 573 U.S. at 217–18 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

The Patent Office recently issued guidance regarding this framework. See USPTO, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Revised Guidance”). Under the Revised Guidance, to decide whether a claim is “directed to” an abstract idea, we evaluate whether the claim (1) recites subject matter falling within an abstract idea grouping listed in the Revised Guidance and (2) fails to

integrate the recited abstract idea into a practical application. *See* Revised Guidance, 84 Fed. Reg. at 51. If the claim is “directed to” an abstract idea, as noted above, we then determine whether the claim recites an inventive concept. The Revised Guidance explains that when making this determination, we should consider whether the additional claim elements add “a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field” or “simply append[] well-understood, routine, conventional activities previously known to the industry.” Revised Guidance, 84 Fed. Reg. at 56.

For the § 101 rejections, Appellant argues claims 1–16 and 21–24 together. *See* Appeal Br. 8–14. As permitted by 37 C.F.R. § 41.37, we decide the appeal for this rejection based on claim 1. *See* 37 C.F.R. §41.37(c)(1)(iv). Noting claims 1 and 21 recite systems and claim 13 recites a method and, therefore, falls within the process category of § 101, we turn to the Examiner’s § 101 rejection.

The Judicial Exception—Abstract Idea

The Examiner determined that claims 1 and 21 recite subject matter “monitoring user interactions, collecting comments and markups, and displaying content comments and markups,” which “are conceptually similar” to those actions found to be an abstract idea in *Electric Power Group*. Final Act. 4 (citing *Elec. Power Grp., LLC v. Alstom, S.A.*, 830 F.3d 1350 (Fed. Cir. 2016)). Similarly, the Examiner determines that claim 13 is directed to “updating the activity stream, the content and modifications to the content, as well as displaying the content and modifications to the content,” also similar to the claims at issue in *Electric Power Group*. *Id.* at 4–5.

The Examiner also states that “each of the foregoing activities” of claims 1, 13, and 21 can “be performed by a human being, or by a ‘human analog’ mentally or manually, i.e. with pen and paper.” *Id.* at 5.

For the reasons explained below, we agree that the claims recite an abstract idea.

According to the Specification, the invention overcomes problems related to having to select content for inclusion in marketing activities “from scratch.” Spec. ¶ 3. This often requires marketing professionals to create new marketing material by guessing why other marketing activities have been successful, “which could be complicated, time consuming, and may not be accurate.” *Id.* The Specification describes “[c]ontent and deployment collaboration techniques,” which use a “content creation service” and a “content deployment service,” so that deployment data may be tracked and reused in future marketing activities. *Id.* ¶ 5. Providing data to be used in creating marketing material falls within “advertising, marketing, or sales activities.” Revised Guidance, 84 Fed. Reg. at 52.

As quoted and enumerated above, claim 1 includes five main limitations. These limitations recite, in part, the following steps: *monitoring* user interaction, including image editing, of content (limitation [1]), *collecting* comments and markups associated with portions of the content (limitation [2]), and *displaying* the content with markups and corresponding comments by first (without manager approval required) and second contributor type (with manager approval required) (limitations [3], [4], and [5]). Appeal Br. 20 (Claims App.). Under their broadest reasonable interpretation, all these limitations ([1]–[5]) contribute to a method of creating and displaying marketing content, which is advertising, marketing or sales activity. Such activity has been found to be an abstract idea. *See,*

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e.g., See, e.g., Ultramercial, Inc. v. Hulu, LLC, 772 F.3d 709, 715 (Fed Cir. 2014) (holding that claim “describ[ing] only the abstract idea of showing an advertisement before delivering free content” is patent ineligible); *In re Ferguson*, 558 F.3d 1359, 1364 (Fed Cir. 2009) (holding methods “directed to organizing business or legal relationships in the structuring of a sales force (or marketing company)” to be ineligible).

In addition, we agree with the Examiner that at least limitations [1]–[5], except for the recitation of “shared network resource” and “user interface,” could be performed in the mind or with pencil and paper. That is, nothing recited in the claim prevents each of the steps from practically being performed in the mind. For example, but for the “shared network resource” and “user interface,” the claim encompasses a process that could occur in a person’s mind—watching users modifying content using image editing, writing on paper the comments and markups made during that process and linking those comments and markups with the content at issue, and then presenting those notes. Similar claims have been found ineligible by the Federal Circuit. For example, the Federal Circuit continues to “‘treat[] analyzing information by steps people go through in their minds, . . . without more, as essentially mental processes within the abstract-idea category.’” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146–47 (Fed. Cir. 2016) (quoting *Electric Power Group*, 830 F.3d at 1354).

When claimed in a manner similar to the claims here, gathering and analyzing information using conventional techniques has been determined to be an abstract idea. *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 612–13 (Fed. Cir. 2016). Also, more recently, our reviewing court has also concluded that some acts of collecting, analyzing, manipulating, and displaying data are patent ineligible. *Univ. of Fl. Research Found., Inc. v.*

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General Electric Co., 916 F.3d 1363, 1367 (Fed. Cir. 2019) (citing *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017); *Electric Power Group*, 830 F.3d at 1353–54).

Accordingly, we conclude claim 1 recites a certain method of organizing human activity identified in the Revised Guidance (i.e., a commercial interaction), and thus, an abstract idea.³ Revised Guidance, 84 Fed. Reg. at 52, 53 (listing “[c]ertain methods of organizing human activity . . . commercial or legal interactions” as one of the “enumerated groupings of abstract ideas”).

Integration of the Judicial Exception into a Practical Application

If a claim recites a judicial exception, we 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. If the

³ Our reviewing court recognizes that “[a]n abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). That need not and, in this case does not, “impact the patentability analysis.” *Id.* at 1241. Further, “[a]n abstract idea can generally be described at different levels of abstraction. . . . The Board’s slight revision of its abstract idea analysis does not impact the patentability analysis.” *Id.* Moreover, merely combining several abstract ideas does not render the combination any less abstract. *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“Adding one abstract idea (math) to another abstract idea . . . does not render the claim non-abstract.”); *see also FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (determining the pending claims were directed to a combination of abstract ideas).

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recited judicial exception is integrated into a practical application, the claim is not directed to the judicial exception.

Here, claim 1 recites the additional elements of “one or more modules implemented at least partially in hardware,” “shared network resource,” and “a user interface for display.” Appeal Br. 20 (Claims App.). Considering claim 1 as a whole, the additional elements do not apply or use the abstract idea in a meaningful way such that the claim as a whole is more than a drafting effort designed to monopolize the exception. The Supreme Court guides that the “prohibition against patenting abstract ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or [by] adding ‘insignificant postsolution activity.’” *Bilski*, 561 U.S. at 610–11 (quoting *Diamond v. Diehr*, 450 U.S. 175, 191–92 (1981)).

The Specification describes each of these additional elements as generic components. For example, the Specification states that “[c]omputing devices that are used to implement the content creation service 102, content deployment service 104, and the client device 106 are configurable in a variety of ways,” ranging from “full resource devices with substantial memory and processor resources (e.g., personal computers, game consoles) to a low-resource device with limited memory and/or processing resources (e.g., mobile devices).” Spec. ¶ 48; *see also* ¶¶ 153–166 (describing the system in terms of conventional computer hardware and software). The recited “shared network resource” is described in the Specification as including “a folder that may be made accessible to other users” that may be “maintained by a third-party sharing service, such as Google[®] Drive, Dropbox[®], OneDrive[®], and so forth.” *Id.* ¶¶ 92, 111. The Specification also describes “a display device (e.g., a monitor or projector).”

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Id. ¶ 157; *see also* ¶ 154 (“The example computing device 3502 as illustrated includes . . . one or more I/O interface 3508 that are communicatively coupled, one to another.”).

Appellant’s arguments have not persuaded us claim 1 is “directed to” a patent-eligible concept. Appellant argues that the claims are directed to a user interface that “improves the efficiency of content creation and deployment,” and, therefore, are not directed to an abstract idea. Appeal Br. 10–11 (citing *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, 880 F.3d 1356, 1362 (Fed. Cir. 2018); *Data Engine Techs. LLC v. Google LLC*, 906 F.3d 999 (Fed. Cir. 2018)). To support this argument Appellant cites to claim language requiring “a user interface for display that includes” “the content and the markups in which at least one of the markups is disposed over a display of the content” and “an activity stream that includes the collected comments and an indication of the execution of the image editing operation to modify the content” along with paragraphs 72–74 of the Specification. *Id.* at 11. In addition, Appellant contends that the Specification explains that the availability of deployment data is useful information to content creators and maybe manufacturers of devices and, therefore, “the specification identifies an improvement to a user interface.” Reply Br. 7 (citing Spec. ¶ 44).

We disagree that determining the availability of data to users describes an improvement to a user interface for displaying that data. The fact that users may find data displayed on a user interface to be useful has no bearing on whether there has been a technological improvement to technology of the user interface itself. Appellant does not point to, and we do not see, any disclosure in the Specification that describes improving the user interface itself, but instead describes determining what data should be

displayed by a conventional user interface. *See* Spec. ¶ 44 (“Content creators, in one such instance, receive this data to determine which of their content has been successfully employed as part of marketing activities and use this information in the creation of future content.”).

Appellant also argues that the claims “limit the technical means for presenting content and markups for review,” “identify several particular tools for presentation,” and “require performance of the claimed functions of presenting content and markups,” and, thus, are not similar to the claims found ineligible in *Electric Power Group*. Appeal Br. 10 (citing *Electric Power Group*, 830 F.3d at 1351).

We disagree with Appellant’s attempted differentiation of the claims of *Electric Power Group* from the claims in this case. In *Electric Power Group*, the court held ineligible a recited method of detecting events on an interconnected power grid from plural data streams in real time and analyzing those events, where the method included, among other things, displaying event analysis results and diagnoses, metrics, and concurrent visualization of measurements from the data streams, and deriving a composite reliability indicator. *Electric Power Group*, 830 F.3d at 1351–56. Notably, in *Electric Power Group*, the claimed invention was ineligible because it merely gathered and analyzed information, and then displayed results—an abstract idea that is strikingly similar to the one at issue here. Merely displaying the results of such abstract ideas does not integrate them into a practical application as illustrated in *Electric Power Group*. In addition to receiving and analyzing data using mathematical calculations, claim 12 in *Electric Power Group* also displayed the results of that analysis “in visuals, tables, charts, or combinations thereof, the data comprising at least one of monitoring data, tracking data, historical data, prediction data,

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and summary data.” *Electric Power Group*, 830 F.3d at 1352. It also displayed “concurrent visualization of measurements from the data streams and the dynamic stability metrics.” *Id.* The court held that displaying information that results from collection and organizing is “abstract as an ancillary part of such collection and analysis.” *Id.* at 1354.

We do not agree with Appellant’s argument that the claims here “limit the technical means for presenting content and markups for review” or “identify several particular tools for presentation” such that they are distinguishable from the claims at issue in *Electric Power Group*. Specifically, we do not agree that requiring presented content to be responsive to comments is a limitation on the “technical means for presenting content and markups from review,” but instead presents data in an analogous manner that was recited in the claims at issue in *Electric Power Group* (reciting displaying data after analysis). *See* Appeal Br. 10; *Electric Power Group*, 830 F.3d 1352. Similarly, we do not agree with Appellant’s argument that “presenting content and markups, presenting markups relative to content, and presenting content and markups with and without requiring approval” qualify as “particular tools for presentation.” *See* Appeal Br. 10. These limitations simply determine what data will be presented by generic display devices using commonly available tools. Finally, we do not agree that “requir[ing] performance of the claimed functions of presenting content and markups” in any way distinguishes the claims at issue with those in *Electric Power Group*. *See* Appeal Br. 10.

Here, claim 1 recites collecting comments and markups and displaying that data together with the relevant content based on contributor type and depending on whether a supervisor need approve the display. In other words, the display functions generically; it displays data. What data is

displayed and how it is arranged is described by the claims at issue, but not the mechanism of how that data is displayed.

Finally, Appellant argues that the claims recite significantly more than an abstract idea because they “recite how interactions are manipulated to achieve a desirable result.” Appeal Br. 14 (citing *DDR Holdings, LLC v. Hotels.com*, 773 F.3d 1245, 1258 (Fed. Cir. 2014)). We do not agree with Appellant’s reading of *DDR Holdings* as holding that “[c]laims that recite how interactions are manipulated to achieve a desirable result recite significantly more than an abstract idea.” *Id.* at 13.

In *DDR Holdings*, the Court evaluated the eligibility of claims “address[ing] the problem of retaining website visitors that, if adhering to the routine, conventional functioning of Internet hyperlink protocol, would be instantly transported away from a host’s website after ‘clicking’ on an advertisement and activating a hyperlink.” *Id.* at 1257. The Court found that the claims at issue in *DDR Holdings* were patent eligible because they transformed the manner in which a hyperlink typically functions to resolve a problem that had no “pre-Internet analog.” *Id.* at 1258. The Court cautioned, however, “that not all claims purporting to address Internet-centric challenges are eligible for patent.” *Id.* For example, the Court distinguished the patent-eligible claims at issue from claims found patent-ineligible in *Ultramercial*. *See id.* at 1258–59 (citing *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715-16 (Fed. Cir. 2014)). As the Court explained, the *Ultramercial* claims were “directed to a specific method of advertising and content distribution that was previously unknown and never employed on the Internet before.” *Id.* at 1258 (quoting *Ultramercial*, 772 F.3d at 715–16). Nevertheless, those claims were patent ineligible because they “merely recite[d] the abstract idea of ‘offering media content in exchange for viewing

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an advertisement,’ along with ‘routine additional steps such as updating an activity log, requiring a request from the consumer to view the ad, restrictions on public access, and use of the Internet.’” *Id.*

Appellant’s asserted claims are more similar to the claims found ineligible in *Ultramercial* than the claims found eligible in *DDR Holdings*. The ineligible claims in *Ultramercial* recited “providing [a] media product for sale at an Internet website;” “restricting general public access to said media product;” “receiving from the consumer a request to view [a] sponsor message;” and “if the sponsor message is an interactive message, presenting at least one query to the consumer and allowing said consumer access to said media product after receiving a response to said at least one query.” 772 F.3d at 712. Similarly, Appellant’s asserted claims recite collecting data and outputting certain of that data depending on content and potentially based on managerial approval. This is the type of activity found ineligible in *Ultramercial*.

Moreover, we agree with the Examiner that the invention as a whole does not solve problems specifically arising in some aspect of computer technology, nor is it solving an Internet centric problem, but rather the computer in the instant claims is used as a mechanism to improve efficiency. Ans. 4; *see also* Appeal Br. 11 (stating that the claims “improve[] the efficiency of content creation and deployment.”); *see FairWarning*, 839 F.3d at 1095 (citing *Bancorp Services, LLC v. Sun Life Assurance Co.*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (“[T]he fact that the required calculations could be performed more efficiently via a computer does not materially alter the patent eligibility of the claimed subject matter.”)); *see also Intellectual Ventures I LLC v. Erie Indemnity Co.*, 711 F. App’x 1012, 1017 (Fed. Cir. 2017) (unpublished) (“Though the claims purport to accelerate the process

of finding errant files and to reduce error, we have held that speed and accuracy increases stemming from the ordinary capabilities of a general-purpose computer ‘do[] not materially alter the patent eligibility of the claimed subject matter.’” (alteration in original) (citation omitted)).

Accordingly, even in combination with all the other recited elements, the addition of “one or more modules implemented at least partially in hardware,” “shared network resource,” and “a user interface for display” does not integrate the abstract idea into a practical application because it does not impose any meaningful limits on practicing the abstract idea. For these reasons, we determine that claim 1 does not integrate the recited abstract idea into a practical application.

Inventive Concept

Because we agree with the Examiner that claim 1 is “directed to” an abstract idea, we consider whether an additional element (or combination of elements) adds a limitation that is not well-understood, routine, conventional (“WURC”) activity in the field or whether the additional elements simply append WURC activities previously known to the industry, specified at a high level of generality, to the judicial exception. Revised Guidance, 84 Fed. Reg. at 23. The Examiner’s finding that an additional element (or combination of elements) is WURC activity must be supported with a factual determination. *Id.* (citing MPEP § 2106.05(d), as modified by the *Berkheimer* Memorandum⁴).

⁴ Robert W. Bahr, *Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision* (Berkheimer v. HP, Inc.) (2018) (hereinafter “*Berkheimer* Memorandum”).

Whether the additional elements (“one or more modules implemented at least partially in hardware,” “shared network resource,” and “a user interface for display”) are WURC activity is a question of fact. *See Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018) (“Whether something is well-understood, routine, and conventional to a skilled artisan . . . is a factual determination.”).

On the record before us, Appellant has not shown that the claims on appeal add a specific limitation beyond the judicial exception that is not “well-understood, routine, and conventional” in the field, whether the limitations are considered individually or as an ordered combination (*see* MPEP § 2106.05(d)). Appellant does not point to any particular claimed element, or combination of elements, that does not qualify as WURC. *See* Appeal Br. 8–14.

In fact, as explained by the Examiner (Final Act. 7) Appellant’s Specification demonstrates the WURC nature “one or more modules implemented at least partially in hardware,” “shared network resource,” and “a user interface for display” because it indicates they may be implemented with generic devices. Spec. ¶¶ 153–166.

For these reasons, we conclude that claim 1, considered as a whole, does not include an inventive concept.

Therefore, we sustain the Examiner’s § 101 rejection of independent claim 1. For the reasons discussed above, we also sustain the Examiner’s § 101 rejection of dependent claims 2–12. We also sustain the Examiner’s § 101 rejection of independent claims 13 and 21 and dependent claims 14–16 and 22–24, for which Appellant relies on the same arguments made with respect to claim 1. Appeal Br. 8–14; Reply Br. 2–8.

Rejection of Claims 1–16 and 21–24 under 35 U.S.C. § 103

The Examiner rejects independent claims 1, 13, and 21 as obvious over the combination of O’Donnell and Vagell. Final Act. 8–10. Specifically, the Examiner cites to O’Donnell as teaching the majority of limitations of the claims, but relies on Vagell “to illustrate the functionality of reviewers with and without approval authority in the same or similar context.” Final Act. 10 (claims 1 and 21), 13–14 (claim 13). In addition, the Examiner explains that a person of ordinary skill in the art “would have been motivated” to modify O’Donnell to include the elements of Vagell “in order to make sure that edits/modifications are approved by the designated authority” using “well-known computer technologies in the same or similar context.” Final Act. 10 (claims 1 and 21), 14 (claim 13). The Examiner adds that “the content, as disclosed by O’Donnell, needs to be presented, as disclosed by Vagell, in order for the steps disclosed by the application to be performed in a meaningful way.” Ans. 7 (claims 1 and 21), 8 (claim 13).

Appellant argues that the Examiner has not sufficiently shown that the combination of O’Donnell and Vagell render the claims obvious because the Examiner does not adequately provide the requisite rational underpinning to support the legal conclusion of obviousness (Appeal Br. 22–23 (claim 1), 25 (claim 13), 26–27 (claim 21); Reply Br. 13).

We agree with Appellant that the Examiner’s proffered rationale for combining O’Donnell and Vagell falls victim to hindsight bias. Care must be taken to avoid hindsight reconstruction by using ‘the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.’” *Grain Processing Corp. v. American-Maize Prods. Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988) (quoting *Orthopedic Equip Co. v. United States*, 702 F.2d

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1005, 1012 (Fed. Cir. 1983)). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” MPEP § 2143.01 (III) (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007)). The use of the present application as a “road map” for selecting and combining prior art disclosures is wholly improper. *See Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985) (stating that “[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time”); see also *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); MPEP § 2141.01(111); MPEP § 2142. Here, the Examiner appears to use Appellant’s application as a road map to show that the prior art references teach the claimed invention—the essence of hindsight. *See* Ans. 7 (“In this case, it becomes apparent that the content, as disclosed by O’Donnell, needs to be presented, as disclosed by Vagell, in order for the steps *disclosed by the application* to be performed in a meaningful way.”) (emphasis added)). Other than to reproduce the claims at issue, the Examiner does not explain why a person of ordinary skill in the art would have been motivated to modify O’Donnell to incorporate approval by a designated authority. Accordingly, we do not sustain the rejection of claims 1, 13, and 21 as obvious over the combination of O’Donnell and Vagell.

Because this determination resolves the § 103 rejection for all pending claims, we need not address Appellant’s other arguments regarding Examiner error. *See, e.g., Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984) (explaining that an administrative agency may render a decision based on “a single dispositive issue”).

CONCLUSION

We sustain the rejection of claims 1–16 and 21–24 under 35 U.S.C. § 101.

We reverse the rejection of claims 1–16 and 21–24 under 35 U.S.C. § 103.

Because we affirm at least one ground of rejection with respect to each claim on appeal, we affirm the Examiner’s rejection of claims 1–16 and 21–24.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Basis/ Reference(s)	Affirmed	Reversed
1–16, 21–24	101	Eligibility	1–16, 21–24	
1–8, 13–16, 21–24	103	O’Donnell, Vagell		1–8, 13–16, 21–24
9–12	103	O’Donnell, Vagell, Roman		9–12
Overall Outcome			1–16, 21–24	

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