



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
**United States Patent and Trademark Office**  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/576,369	10/09/2009	Sabrina Sellers	DC-15117	1979
160816	7590	10/13/2020	EXAMINER	
Terrile, Cannatti & Chambers, LLP - Dell			BOYCE, ANDRE D	
P.O. Box 203518			ART UNIT	PAPER NUMBER
Austin, TX 78720			3623	
			NOTIFICATION DATE	DELIVERY MODE
			10/13/2020	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@dockettrak.com  
tmunoz@tcciplaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* SABRINA SELLERS and TRISHA COLLIER

---

Appeal 2019-005835  
Application 12/576,369<sup>1</sup>  
Technology Center 3600

---

Before PHILIP J. HOFFMANN, KENNETH G. SCHOPFER, and  
SHEILA F. McSHANE, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant appeal from the Examiner's decision to reject claims 1, 3–7, 9–13, and 15–18. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

---

<sup>1</sup> 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 Dell Products L.P. Appeal Br. 1.

## BACKGROUND

The invention relates to information handling systems and, more specifically, to a usage based process for selecting hardware and software in a build-to-order environment. Specification, hereafter “Spec.,” Abstract,

¶ 1. The usage based process presents a survey to a customer and uses information derived from the survey, including preferred configuration, to automatically populate an information handling system configuration. *Id.*

¶ 4.

Representative method claim 1 is reproduced from page 5 of the Appeal Brief (Claims App.) as follows:

1. A system for enabling configuration of an information handling system comprising:

a configurator, the configurator configuring a system with options selected according to user input;

a survey module, the survey module enabling obtaining information from a user and identifying a preferred configuration based upon the information from the user;

an automatic population module, the automatic population module automatically populating an information handling system configuration based upon the preferred configuration;

a database, the database receiving information from and supplying information to the configurator, the survey module and the automatic population module;

an installation system, the installation system fabricating an information handling system corresponding to the information handling system configuration, the information handling system comprising a plurality of hardware components; and wherein

the automatically populating the information handling system configuration further comprises performing a configuration accuracy analysis on the information handling

system configuration to assure that the information handling system configuration provides a completed and accurately configured information handling system;

the information from the user comprises information regarding potential usage of system, types of applications to be used or documents that will be manipulated by the system, an ecosystem in which the system will reside and whether the system will be coupled to a network and if so the type of network; and

the information regarding the ecosystem in which the system will reside further includes information relating to technology ownership, electronic devices to which the system will be coupled and whether the system will be part of a home network.

The Examiner rejects claims 1, 3–5, 7, 9–11, 13, and 15–17 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Final Action, hereafter “Final Act.,” 2–7, mailed September 28, 2018; Answer, hereafter “Ans.,” 3, mailed May 30, 2019.

#### DISCUSSION

##### *35 U.S.C. § 101*

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: “[I]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 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) (“*Diehr*”)); “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 (1854))); 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 176; *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.”), *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 and quotation marks 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 USPTO has guidance on the application of 35 U.S.C. § 101, in accordance with judicial precedent. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50, 57 (Jan. 7, 2019) (“2019 Guidance”). Under 2019 Guidance, a claim is “directed to” an abstract idea if the claim recites any of (1) mathematical concepts, (2) certain methods of organizing human activity, and (3) mental processes—without integrating such abstract idea into a “practical application,” i.e., without “apply[ing], rely[ing] on, or us[ing] 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.” *Id.* at 52–55. A claim so “directed to” an abstract idea constitutes ineligible subject matter, unless it recites an additional element (or combination of elements) amounting to significantly more than the abstract idea. *Id.* at 56.

With this context in mind, we evaluate the Examiner’s rejection of representative claim 1. The Examiner finds that claim 1 is “directed to the abstract idea of enabling configuration of an information handling system,”

that includes “configuration of an information handling system, including configuring, obtaining, populating, receiving, fabricating and performing steps.” Final Act. 3; Ans. 3–4. The Examiner finds the claim is similar to those where the Federal Circuit found the claim was directed to an abstract idea, such as concepts involving organizing activity. Final Act. 4 (citing *Digitech Image Techs., LLC v. Elecs. For Imaging, Inc.*, 758 F.3d 1344 (Fed. Cir. 2014); *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014)). The Examiner also finds that the claim “limitations of configuring, obtaining, populating, receiving, fabricating and performing, are a process that . . . covers performance of the limitations in the mind, but for the recitation of generic computer components.” Ans. 4. The Examiner finds that “other than reciting a computer system and a plurality of modules, of modules, nothing in the claim elements preclude the steps from practically being performed in the mind.” *Id.* at 5.

As first raised in the Reply Brief, Appellant contends that the claimed element of “fabricating an information handling system corresponding to the information handling system configuration” could not be performed merely by a mental process because the fabrication of the information handling system, which comprises hardware components, “is a physical process that could not be performed merely by a mental process.” Reply Brief, hereafter “Reply Br.,” 2–3, mailed July 29, 2019. Appellant refers to a Merriam-Webster dictionary<sup>2</sup>, and asserts that it defines “fabricate” as to “construct from diverse and usually standardized parts” and as to “make by combining

---

<sup>2</sup> Appellant does not identify the edition of the Merriam-Webster dictionary that is referenced. *See* Reply Br. 2–3.

or arranging parts,” which could not be accomplished by a mental process.  
*Id.* at 3.

The Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). The analysis asks whether the focus of the claim is either on a specific improvement in relevant technology or on a process that itself qualifies as an “abstract idea” for which computers are invoked merely as a tool. *See id.* at 1335–36.

We do not find Appellant’s argument persuasive. First, the Examiner points to a portion of the Specification, which states:

The software modules discussed herein may include script, batch, or other executable files. The software modules may be stored on a machine-readable or computer-readable storage medium such as a disk drive. Storage devices used for storing software modules in accordance with an embodiment of the invention may be magnetic floppy disks, hard disks, or optical discs such as CD-ROMs or CD-Rs, for example. A storage device used for storing firmware or hardware modules in accordance with an embodiment of the invention may also include a semiconductor-based memory, which may be permanently, removably or remotely coupled to a microprocessor/memory system. Thus, the modules may be stored within a computer system memory to configure the computer system to perform the functions of the module.

Ans. 6–7 (quoting Spec. ¶ 32) (emphasis added). The Specification states that hardware modules may be stored, with the hardware module configuring the computer system to perform the functions of the hardware module.

Thus, the Specification discloses that hardware modules of the information handling system are stored in the system, which would reasonably be considered “fabrication” under an interpretation that the term means “constructing” or “making by combining.” Consistent with the Examiner’s findings, the Specification does not indicate or suggest that the storage of hardware modules is anything other than the conventional installation of generic computer components. Thus, we determine that the Examiner’s findings that the elements of the claims perform steps capable of being performed in the mind, except for generic computer-implemented steps, is supported by the record.

Second, even if we were to interpret that the “installation system” element, which fabricates an information handling system with hardware components, to include physical processes, whether something claimed is physical is not the test for determining whether claimed subject matter is judicially-accepted from patent-eligibility. Were that the case, claims to computers necessarily would be patent eligible. *See Alice*, 573 U.S. at 224 (explaining that a computer’s existence in the physical rather than conceptual realm is not relevant to the analysis); *Solutran, Inc. v. Elavon, Inc.*, 931 F.3d 1161, 1168 (Fed. Cir. 2019). Here, Appellant does not argue that any physical fabrication of hardware components represents an advance or anything other than a conventionally-known act. Without more, the mere potential physical nature of some claim elements is not enough to save the claims from a finding of abstractness. *See In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157, 1161 (Fed. Cir. 2018) (“the abstract idea exception does not turn solely on whether the claimed invention comprises physical versus mental steps”).

Finally, we find no error with the Examiner’s findings in a Non-Final Rejection that the inventive concept and abstract idea of the claim is directed to the configuration of the information handling system, and the fabrication is merely a post-solution activity. Non-Final Act. 10, mailed March 21, 2018. As the Examiner finds, and we concur, “the actual assembly of components of the information handling system is not Applicant’s invention, nor is it described in the specification with any specificity (i.e. how the fabrication is specifically done).” *Id.*

Appellant also asserts that the claims do not fall within one of the groups of abstract ideas identified in the 2019 Guidance. Appeal Br. 3–4; “Reply Br.,” 1–2. Appellant argues that “it is respectfully submitted that the claims do not *per se* (i.e., by themselves) claim any of the groupings of abstract ideas enumerated in Section I of the revised guidelines,” and then lists the claimed steps. Reply Br. 2.

We consider the Examiner’s finding that the elements performing the steps of the claims may be performed by mental processes, except for generic computer-implemented steps. *See 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.”). The Specification describes the invention as:

. . . a usage based process for selecting hardware and software in a build to order environment is set forth. More specifically, during the configuration of an information handling system, the usage based process presents a survey to a customer and uses information derived from the survey to automatically populate an information handling system configuration. In certain

embodiments, the process of auto-populating the information handling system configuration includes a configuration accuracy analysis to assure that the various components identified for the auto-population provide a completed and accurately configured information handling system.

Spec. ¶ 4. In accordance with the description, the claim limitations include a survey module for obtaining information from a user and identifying a preferred configuration based upon that information, a configurator for configuring a system according to options selected by user input, populating the information handling system based on the preferred configuration, and performing a configuration accuracy analysis to assure that the configuration provides a completed and accurately configured information handling system. We find no error with the Examiner's finding that these steps could reasonably be performed by a human as mental processes. *See* Ans. 4–5. As discussed above, the installation system element performing fabrication is a post-solution activity and is extraneous to the abstract idea of enabling the configuration of an information handling system. Further, the additional elements of the claim, that is, a database that receives and supplies information to the configurator, the survey module, and the automatic population module, as well as an installation system, discussed above, which fabricates an information handling system comprising a plurality of hardware components, are recitals of the generic computer components of a computer system and a plurality of modules, which are consistent with the Examiner's findings that the other claim recitals recite only a generic computer system components and their use. *See id.* at 5.

The next issue under the second prong of step 2A is whether additional elements in representative claim 1 integrate the judicial exception

into a practical application, such as elements reflecting an improvement in the functioning of a computer or an improvement to other technology or technical field.<sup>3</sup>

Appellant contends that the claims are directed to a practical application which is enabling configuration of an information handling system. Appeal Br. 4. We are not persuaded of error by the Examiner on the issue of whether the additional elements in representative claim 1 integrate the judicial exception into a practical application. The Examiner finds, and we agree, that when considered either individually or as an ordered combination, the steps of representative claim 1 do not include improvements to a technology or technical field. Final Act. 4; Ans. 5–7. We agree with the Examiner that the use of the computer system and modules (and the enablement of their configuration) in the steps of the claim are recited at a high level of generality, absent the imposition of any meaningful limits on the practice of the abstract idea. *See* Ans. 5.

As a result, we conclude that representative claim 1 does not recite additional elements that integrate the judicial exception into a practical application, and we find no reversible error with the Examiner’s findings that representative claim 1 recites an abstract idea.

Turning to the second step of the *Alice* inquiry, we now look to whether representative claim 1 contains any inventive concept or adds anything significantly more to transform the abstract concept into a patent-eligible application. *Alice*, 573 U.S. at 216.

---

<sup>3</sup> *See, e.g., Alice*, 573 U.S. at 223, discussing *Diamond v. Diehr*, 450 U.S. 175 (1981).

The Federal Circuit has held that, after determining that the claim is directed to an ineligible concept, we assess “whether the claim limitations, *other than the invention’s use of the ineligible concept to which it was directed*, were well-understood, routine, and conventional.” *BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018) (emphasis added). We find no error with the Examiner’s finding that the claim does not recite more than the implementation of the abstract idea by generic computer components and functions. Final Act. 5. Appellant does not assert that there is any unconventional use of a computer, and the use of generic computer components to perform generic steps to implement an abstract idea has repeatedly been found to not make an abstract idea patent eligible. *See Alice*, 573 U.S. at 217–218 (Instructing one to “apply” an abstract idea and reciting no more than generic computer elements performing generic computer tasks does not make an abstract idea patent eligible.).

Accordingly, we are not persuaded of error in the Examiner’s conclusion that representative claim 1 is directed to patent-ineligible subject matter.

### CONCLUSION

For the above reasons, the Examiner’s 35 U.S.C § 101 rejection of claims 1, 3–7, 9–13, and 15–18 is affirmed.

### DECISION SUMMARY

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 3–7, 9–13, 15–18	101	1, 3–7, 9–13, 15–18	

Appeal 2019-005835  
Application 12/576,369

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