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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MURRAY J. BEATON, CHRISTINA P. LAU,
and SCOTT P. PEDDLE

Appeal 2020-000882
Application 12/266,448
Technology Center 3600

Before MICHAEL W. KIM, NINA L. MEDLOCK, and
JAMES A. WORTH, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 14–25. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and designate our affirmance of the Examiner’s rejection of claims 14–17 under 35 U.S.C. § 101 as a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b). We also enter a NEW GROUND OF REJECTION of claims 18–25 under 35 U.S.C. § 101 pursuant to this same authority.

CLAIMED INVENTION

Appellant describes that “[t]he present invention relates to the field of modeling” and, more particularly, to “managing process model assets” (Spec. ¶ 1).

Claims 14, 18, and 22 are the independent claims on appeal. Claim 14, reproduced below with bracketed notations added, is illustrative of the claimed subject matter:

14. A method comprising:
 - [(a)] setting up a repository of reusable BPM assets, with each BPM asset including a grouping of tasks, a grouping of activities, a grouping of actors, a grouping of elements and relationships [of] the groupings;

¹ We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Our decision references Appellant’s Appeal Brief (“Appeal Br.,” filed June 10, 2019) and Reply Brief (“Reply Br.,” filed November 13, 2019), and the Examiner’s Answer (“Ans.,” mailed September 13, 2019) and Final Office Action (“Final Act.,” mailed December 17, 2018). Appellant identifies International Business Machines Corporation as the real party in interest (Appeal Br. 2).

[(b)] selecting a BPM asset;

[(c)] copying, from the repository and to a process modelling tool, the selected BPM asset;

[(d)] responsive to the copying, determining a plurality of interdependent BPM assets that are required when using the selected BPM asset;

[(e)] copying, from the repository and to the process modelling tool, the plurality of interdependent BPM assets, with the copying including:

[(e1)] detecting that a first interdependent BPM asset of the plurality of BPM assets is already present in the process modelling tool through a prompting of an end user according to a comparison of:

(i) a unique identifier for the first interdependent BPM asset in combination with a name of the first interdependent BPM asset, and

(ii) with a unique identifier for an existing asset in the process modelling tool combination with a name of the existing asset,

[(e2)] responsive to the detection that a first interdependent BPM asset of the plurality of BPM assets is already present in the process modelling tool, resolving a conflict, and resolving circular references amongst the interdependent BPM assets by:

(i) tracking a navigation of each interdependent BPM asset of the plurality of BPM assets, and

(ii) prohibiting re-importation of one, or more, interdependent BPM asset(s) already encountered during copying of the plurality of interdependent BPM assets; and

[(f)] modelling, by the process modeling tool, a business process using:

(i) the selected BPM asset, and

(ii) the set of interdependent BPM asset(s) that are required when using the selected BPM asset.

REJECTIONS

Claims 14–17 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

Claims 14–25 are rejected under 35 U.S.C. § 103(a) as unpatentable over Carlson et al. (US 2003/0046282 A1, published Mar. 6, 2003) (“Carlson”) and Linehan (US 2007/0288412 A1, published Dec. 13, 2007).

ANALYSIS

Patent-Ineligible Subject Matter

Appellant argues claims 14–17 as a group (Appeal Br. 7–11). We select independent claim 14 as representative. Claims 15–17 stand or fall with claim 14. *See* 37 C.F.R. §41.37(c)(1)(iv).

Under 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. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp.*, 573 U.S. at 217. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements

of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78). This is “a search for an ‘inventive concept’ — *i.e.*, 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.’” *Id.* at 217–18 (alteration in original).

Here, in rejecting claims 14–17 under § 101, the Examiner determined that independent claim 14 is directed to “setting up a repository of reusable BPM assets,” *i.e.*, to a method of organizing human activities, and, therefore, to an abstract idea similar to other concepts that the courts have held abstract, *e.g.*, “gathering information from different data sources (*i.e.*, ‘BPM assets’), analyzing said gathered data[,] and displaying certain information/results of the gathered and analyzed data (*Electric Power Group, LLC, v. Alstom[, S.A.*, 830 F.3d 1350, 1351, (Fed. Cir. 2016))[,] similar to the database management of a set of processes” (Final Act. 3). The Examiner also determined that claim 14 does not include additional elements sufficient to amount to significantly more than the abstract idea, and that dependent claims 15–17 are patent ineligible for substantially the same reasons (*id.*).

After the Final Office Action was mailed, but before Appellant’s Appeal Brief was filed, the U.S. Patent and Trademark Office (the “USPTO”) published revised guidance for use by USPTO personnel in evaluating subject matter eligibility under 35 U.S.C. § 101. 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50, 57 (Jan. 7, 2019) (the “2019 Revised Guidance”). That guidance revised the

USPTO’s examination procedure with respect to the first step of the *Mayo/Alice* framework by (1) “[p]roviding groupings of subject matter that [are] considered an abstract idea”; and (2) clarifying that a claim is not “directed to” a judicial exception if the judicial exception is integrated into a practical application of that exception. *Id.* at 50. The 2019 Revised Guidance, by its terms, applies to all applications, and to all patents resulting from applications, filed before, on, or after January 7, 2019. *Id.*²

Step One of the Mayo/Alice Framework (2019 Revised Guidance, Step 2A)

The first step in the *Mayo/Alice* framework, as mentioned above, is to determine whether the claims at issue are “directed to” a patent-ineligible concept, e.g., an abstract idea. *Alice Corp.*, 573 U.S. at 217. This first step, as set forth in the 2019 Revised Guidance (i.e., Step 2A), is a two-prong test; in Step 2A, Prong One, we look to whether the claim recites a judicial exception, e.g., one of the following three groupings of abstract ideas: (1) mathematical concepts; (2) certain methods of organizing human activity, e.g., fundamental economic principles or practices, commercial or legal interactions; and (3) mental processes. 2019 Revised Guidance, 84 Fed. Reg. at 54. If so, we next consider whether the claim includes additional elements, beyond the judicial exception, that “integrate the [judicial] exception into a practical application,” i.e., that apply, rely on, or use 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

² The USPTO issued an update on October 17, 2019 (the “October 2019 Update: Subject Matter Eligibility,” available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf) clarifying the 2019 Revised Guidance in response to comments received from the public.

to monopolize the judicial exception (“Step 2A, Prong Two”). *Id.* at 54–55. Only if the claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application do we conclude that the claim is “directed to” the judicial exception, e.g., an abstract idea. *Id.*

We are not persuaded here that the Examiner erred in determining that claim 14 is directed to an abstract idea (Appeal Br. 13–22). 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)). It asks whether the focus of the claims is 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. Here, it is clear from the Specification (including the claim language) that claim 14 focuses on an abstract idea, and not on any improvement to technology and/or a technical field.

The Specification is titled “MANAGING REUSABLE BUSINESS PROCESS MODELING (BPM) ASSETS,” and describes that process modeling and simulation relates to the modeling and simulation of dynamic or static systems, including business process systems, and that these systems can be modeled and simulated for a variety of purposes, including monitoring, analysis, control, design, simulation, and management (Spec. ¶ 2). Process models generally specify one or more tasks or activities of a process and the relationship between the different tasks or activities (*id.* ¶ 3). “In a business process model (BPM), the tasks, activities, actors, elements

and the relationship there between can be individually grouped as BPM assets,” and individual BPM assets can be reused in different combinations with other BPM assets as part of different BPM solutions (*id.* ¶ 4). The Specification cautions that “it can be critical,” in managing reusable BPM assets in a development tool, e.g., a BPM modeling and/or simulation tool, “to manage linkages between different reusable BPM assets as some BPM assets will be dependent upon other BPM assets, and changes in one BPM asset may impart changes in other linked BPM assets” (*id.* ¶ 5). And the Specification describes that although advanced modeling tools have been expressly created to govern and manage assets, and provide a facility to download, submit, review, rate, and discuss BPM assets in a collaborative environment, these advanced modeling tools do not recognize BPM assets and BPM assets relationships, and “lack the ability to recognize versions of processes and services, and the ability to search for processes, the linkage between development, test and production environment for a particular process or service” (*id.* ¶ 6).

The claimed invention is ostensibly intended to address this deficiency by providing “a novel and nonobvious method, system[,] and computer program product for managing reusable BPM assets” (Spec. ¶ 7). Claim 14, thus, recites a method comprising: (1) establishing a repository of reusable BPM assets, i.e., “setting up a repository of reusable BPM assets, with each BPM asset including a grouping of tasks, a grouping of activities, a grouping of actors, a grouping of elements and relationships the groupings” (step (a)); (2) selecting a BPM asset from the repository and copying the BPM asset to a process modeling tool, i.e., “selecting a BPM asset” and “copying, from the repository and to a process modelling tool, the

selected BPM asset” (steps (b) and (c)); (3) copying, from the repository and to the process modeling tool, a plurality of interdependent BPM assets that are required when using the selected BPM asset, i.e., “responsive to the copying, determining a plurality of interdependent BPM assets that are required when using the selected BPM asset” and “copying, from the repository and to the process modelling tool, the plurality of interdependent BPM assets” (steps (d) and (e)); and (4) modeling a business process using the selected BPM asset and the interdependent BPM assets, i.e., “modelling, by the process modeling tool, a business process using: (i) the selected BPM asset, and (ii) the set of interdependent BPM asset(s) that are required when using the selected BPM asset” (step (f)).

Claim 14 recites that copying the plurality of interdependent BPM assets to the process modeling tool includes detecting whether an interdependent BPM asset is already present in the process modeling tool and, if so, preventing the re-importation of the BPM asset into the modeling tool, i.e.,

detecting that a first interdependent BPM asset of the plurality of BPM assets is already present in the process modelling tool through a prompting of an end user according to a comparison of:

(i) a unique identifier for the first interdependent BPM asset in combination with a name of the first interdependent BPM asset, and

(ii) with a unique identifier for an existing asset in the process modelling tool combination with a name of the existing asset,

responsive to the detection that a first interdependent BPM asset of the plurality of BPM assets is already present in the process modelling tool, resolving a conflict, and resolving circular references amongst the interdependent BPM assets by:

(i) tracking a navigation of each interdependent BPM asset of the plurality of BPM assets, and
(ii) prohibiting re-importation of one, or more, interdependent BPM asset(s) already encountered during copying of the plurality of interdependent BPM assets (steps (e1) and (e2)). These limitations, when given their broadest reasonable interpretation, recite copying, i.e., retrieving, BPM assets (including a selected BPM asset and a plurality of interdependent BPM assets that are required when using the selected BPM asset) from a repository of reusable BPM assets into a process modeling tool.

Retrieving data reasonably can be characterized as an observation that can be performed by a human mentally or manually using a pen and paper. Identifying interdependent BPM assets also reasonably can be characterized as an evaluation, judgment, or opinion that can be performed in the human mind. Claim 14, thus, reasonably can be characterized as reciting mental processes and, therefore, an abstract idea. *See* 2019 Revised Guidance, 84 Fed. Reg. at 52. *See also Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017) (holding “the concept of . . . collecting data, . . . recognizing certain data within the collected data set, and . . . storing that recognized data in a memory” patent ineligible); *Elec. Power Grp.*, 830 F.3d at 1353 (merely selecting information, by content or source, for collection, analysis, and display does nothing significant to differentiate a process from ordinary mental processes).

Appellant ostensibly does not dispute that claim 14 recites an abstract idea; instead Appellant maintains that claim 14 is not “directed to” an abstract idea because the claim provides an improvement to the technical field of managing reusable BPM assets, i.e., that claim 14 integrates any

alleged abstract idea into a practical application (Appeal Br. 10–11).³ Referencing paragraph 28 of the Specification, Appellant characterizes the improvement as “the resolution of circular references amongst dependencies during BPM asset importation” (*id.* at 11). Yet, we are not persuaded that resolving circular references during BPM asset importation, i.e., detecting a conflict between a BPM asset selected for importation and an existing BPM asset in the process modeling tool and prohibiting re-importation of the BPM asset, amounts to a technical improvement as opposed to an improvement in the abstract idea of copying reusable BPM assets into a process modeling tool, which is not enough for patent eligibility. *See SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1170 (Fed. Cir. 2018) (“[P]atent law does not protect such claims [i.e., claims to an asserted advance in the realm of abstract ideas], without more, no matter how groundbreaking the advance.”). This is particularly so where, as here, we find no indication in the Specification, nor does Appellant direct to any indication, that the operations recited in claim 14 require any specialized computer hardware or other inventive computer components, invoke any allegedly inventive

³ The 2019 Revised Guidance references MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) § 2106.05(a)–(c) and (e) in non-exhaustively listing considerations indicative that an additional element or combination of elements may have integrated the recited judicial exception into a practical application. 2019 Revised Guidance, 84 Fed. Reg. at 55. Thus, for example, an additional element may have integrated the judicial exception into a practical application if the additional element (1) reflects an improvement in the functioning of a computer or an improvement to other technology or technical field; (2) implements the judicial exception with, or uses the judicial exception with, a particular machine or manufacture integral to the claim; or (3) effects a transformation or reduction of an article to a different state or thing. *Id.*

programming, or that the claimed invention is implemented using other than generic computer components as tools operating in their normal, routine, and ordinary capacity.

We conclude, for the reasons outlined above, that claim 14 recites a mental process, i.e., an abstract idea, and that the additional elements recited in the claim beyond the abstract idea, i.e., “a repository” and “a process modeling tool,” are no more than generic computer components used as tools to perform the recited abstract idea. As such, they do not integrate the abstract idea into a practical application. *See Alice Corp.*, 573 U.S. at 223–24 (“[W]holly generic computer implementation is not generally the sort of ‘additional featur[e]’ that provides any ‘practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.’” (quoting *Mayo*, 566 U.S. at 77)). Accordingly, we agree with the Examiner that claim 14 is directed to an abstract idea.

Step Two of the Mayo/Alice Framework (2019 Revised Guidance, Step 2B)

Having determined under step one of the *Mayo/Alice* framework that claim 14 is directed to an abstract idea, we next consider under Step 2B of the 2019 Revised Guidance, the second step of the *Mayo/Alice* framework, whether claim 14 includes additional elements or a combination of elements that provides an “inventive concept,” i.e., whether an additional element or combination of elements adds specific limitations beyond the judicial exception that are not “well-understood, routine, conventional activity” in the field (which is indicative that an inventive concept is present) or simply appends well-understood, routine, conventional activities previously known to the industry to the judicial exception. 2019 Revised Guidance, 84 Fed. Reg. at 56.

Appellant argues that the rejection of claim 14 cannot be sustained because the Examiner has not established that “the combination of steps claimed [is] un-conventional, non-routine and not well-known” (Appeal Br. 11). But, that argument is not persuasive at least because “the relevant inquiry is not whether the claimed invention as a whole is unconventional or non-routine.” *BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018). Instead, the question under step two of the *Mayo/Alice* framework (i.e., step 2B) is whether the claim includes additional elements, i.e., elements other than the abstract idea itself, that “‘transform the nature of the claim’ into a patent-eligible application.” *Alice Corp.*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 79, 78). *See also Mayo*, 566 U.S. at 72–73 (requiring that “a process that focuses upon the use of a natural law also contain *other* elements or a combination of elements, sometimes referred to as an ‘inventive concept,’ sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the natural law itself” (citation omitted) (emphasis added)).

Here, the only claim elements beyond the abstract idea are “a repository” and “a process modeling tool.” The repository is generally described in the Specification as a storage medium for receiving and storing reusable assets, i.e., a generic computer component (*see, e.g.*, Spec. ¶¶ 20, 21, 27, 30). And the process modeling tool is similarly described at a high level (*see, e.g.*, Spec. ¶¶ 19, 24), i.e., as a conventional modeling tool capable of modeling a business process.

Appellant cannot reasonably maintain, nor does Appellant, that there is insufficient factual support for the Examiner’s determination that the operation of these components is well-understood, routine, or conventional,

where, as here, there is nothing in the Specification to indicate that the operations recited in claim 14 require any specialized hardware or inventive computer components or that the claimed invention is implemented using other than generic off-shelf components operating in their normal, routine, and ordinary capacity. Indeed, the Federal Circuit, in accordance with *Alice*, has “repeatedly recognized the absence of a genuine dispute as to eligibility” where claims have been defended as involving an inventive concept based “merely on the idea of using existing computers or the Internet to carry out conventional processes, with no alteration of computer functionality.” *Berkheimer v. HP, Inc.*, 890 F.3d 1369, 1373 (Fed. Cir. 2018) (Moore, J., concurring) (citations omitted); *see also BSG Tech*, 899 F.3d at 1291 (“BSG Tech does not argue that other, non-abstract features of the claimed inventions, alone or in combination, are not well-understood, routine and conventional database structures and activities. Accordingly, the district court did not err in determining that the asserted claims lack an inventive concept.”).

We are not persuaded, on the present record, that the Examiner erred in rejecting independent claim 14 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection of claim 14, and claims 15–17, which fall with claim 14. Because our rationale differs from that set forth by the Examiner, we denominate our affirmance as a new ground of rejection.

We also enter the following new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

New Ground of Rejection

Independent claim 14, as described above, is directed to the abstract idea of copying reusable BPM assets from a repository of reusable BPM

assets to a conventional process modeling tool, and does not include additional elements sufficient to amount to significantly more than the recited abstract idea.

Independent claim 18 recites a computer program product comprising computer program instructions, which, when executed by a computer, cause the computer to perform the method recited in claim 14. And independent system claim 22 recites a collection of generic computer components configured to implement the same abstract idea recited in claim 14.

Claims 18 and 22 are not materially different in substance from claim 14, and are patent ineligible for the same reasons set forth above with respect to claim 14. *See Alice Corp.*, 573 U.S. at 226 (noting that the Court has warned against interpreting § 101 in ways that make patent eligibility depend simply on the draftsman’s art). Therefore, we enter a new rejection of independent claims 18 and 22, and claims 19–21 and 23–25, which depend therefrom, under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

Obviousness

We are persuaded by Appellant’s argument that the Examiner erred in rejecting independent claims 14, 18, and 22 under 35 U.S.C. § 103(a) at least because neither Carlson nor Linehan, individually or in combination discloses or suggests “resolving circular references amongst the interdependent BPM assets by: (i) tracking a navigation of each interdependent BPM asset of the plurality of BPM assets, and (ii) prohibiting re-importation of one, or more, interdependent BPM asset(s) already encountered during copying of the plurality of interdependent BPM assets,”

as recited in claim 14, and similarly recited in claims 18 and 22 (Appeal Br. 14–16).

The Examiner cites paragraphs 87, 88, and 99 of Carlson as tracking the navigation of each interdependent BPM assets of plurality of BPM assets (Final Act. 6). But, the Examiner acknowledges that Carlson does not expressly disclose “resolving circular references amongst the interdependent BPM assets by: . . .(ii) prohibiting re-importation of one, or more, interdependent BPM asset(s) already encountered during copying of the plurality of interdependent BPM assets” (*id.* at 7). The Examiner cites Linehan to cure the deficiency of Carlson (*id.* (citing Linehan ¶¶ 107–109, Table III, and ¶¶ 132–136)). And the Examiner concludes that

it would have been obvious to a person of ordinary skill in the art to use Linehan’s method of generating an implementation of a business rule in Carlson’s system to improve the system and method with reasonable expectation that this would result in a reusable software management system that is able to provide more improved tracking of assets

(*id.* at 7–8).

Carlson is directed to a system for managing software assets, and describes that a “software asset” refers to a set of one or more related artifacts that have been created or harvested for the purpose of applying that asset repeatedly in subsequent development environments (Carlson Abstract). Carlson describes that the system includes a repository to store artifacts, and an asset source to generate a software asset based on the artifacts; the system also includes an asset management system to receive the software asset from the asset source and store the software asset within an asset library (*id.*). Carlson discloses, in paragraphs 87, 88, and 99, on which the Examiner relies, that, in some fully automated environments, the asset

source validates the asset information using asset definition templates so that the asset is then ready for publication to the asset library.

Linehan is directed to a method and system for implementing business rules (Linehan Abstract), and discloses that the business rules can generally be classified as one of two types: alethic and deontic (*id.* ¶ 106). Deontic rules state what is obligatory or permitted or prohibited and may have enforcement levels (*id.* ¶¶ 107–109). Thus, for example, if the available enforcement levels are “pay a fine” or “go to jail,” the deontic rule “a person may not have more than one spouse at a time” may have an associated enforcement level of “go to jail” (*id.* ¶ 108).

Linehan discloses, in paragraphs 132–136, on which the Examiner also relies, an exemplary impossibility rule, i.e., “[a]n order never has more than one payment,” and exemplary obligation rule, i.e., “[a] customer must pay for each order that is completed,” and describes that creation of a new payment is refused if one already exists, and that the business modeling client prevents shipping of the order if payment has not been made.

The Examiner compares the claimed “prohibiting of re-importation of one, or more, interdependent BPM asset(s) already encountered during copying of the plurality of interdependent BPM assets” to the “deontic rules for prohibiting or preventing such as the impossibility obligation” (Final Act. 7). But, we fail to see how, and the Examiner does not adequately explain how, the cited portion of Carlson, which refers only to the validation of asset information by an asset source using a template, in combination with Linehan’s deontic rules, discloses or suggests resolving circular references amongst interdependent BPM assets by tracking the navigation of each asset

during importation and prohibiting the re-importation of an asset already encountered, as called for in the independent claims.

Therefore, we do not sustain the rejection of independent claims 14, 18, and 22 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the rejection of dependent claims 15–17, 19–21, and 23–25. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed	New Ground
14–17	101	Eligibility	14–17		14–17
14–25	103	Carlson, Linehan		14–25	
18–25	101	Eligibility			18–25
Overall Outcome			14–17	18–25	14–25

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides that

[w]hen the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the Examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in MPEP § 1214.01.

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)