UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALEXANDRU SAVESCU, SAMUEL CHUNG,
PRADEEP GANAPATHYRAJ, BIATRICE AMBROSA,
COLLIN TIBBETTS, LEE JOHN THONI, and LUKE HUMPHREY

Appeal 2018-003174
Application 12/468,616
Technology Center 3600

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants[1] appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–14 and 20–25. App. Br. 26.[2] Claims 15–19 were canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

THE INVENTION

Appellants' invention creates a life-cycle workflow for a project. Spec. ¶ 3. Projects, proposals, and business cases may go through a governance process. *Id.* ¶ 1. A governance process is a multi-stage decision making process. *Id.* During the governance process, various checks are made at each stage—e.g., a project must be approved before designed. *Id.* According to the Specification, projects, proposals, and business cases are often complex. *Id.* ¶ 2. So it can be difficult to distinguish between project stages or to determine which decisions to make in those stages. *Id.* Also, reporting and modelling governance processes can be difficult. *Id.* To address these issues and others, Appellants' method creates a project workflow on a server and provides a web page with project details. *Id.* ¶ 3.

Claims 1, 20, and 21 are independent. Claim 1 is reproduced below:

1. A method for creating a life cycle workflow for a project comprising:

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creating one or more identifiable workflow stages for the project on a server computer, each of the one or more workflow stages corresponding to a specific sequence of workflow activities, wherein the creating further comprises using a workflow stage identifier as a property of the specific sequence of workflow activities for each of the one or more workflow stages;

creating one or more identifiable workflow phases for the project on the server computer, each workflow phase includes one or more corresponding workflow stages;

creating one or more project detail pages on the server computer, each project detail page being a web page that is made visible during a corresponding workflow stage;

when a workflow stage is created, associating a workflow phase with the workflow stage, the workflow phase being selected from the one or more workflow phases on the server computer; and

when the workflow stage is created, associating one or more project detail pages for the workflow stage.

App. Br. 27, Claims Appendix.

THE REJECTION

Claims 1–14 and 20–25 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter. Final Act. 3–8.

PRINCIPLES OF LAW

An invention is patent-eligible if it claims a "new and useful process, machine, manufacture, or composition of matter." 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: "[l]aws of nature, natural phenomena, and abstract

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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, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 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)); "tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores" (*id.* at 183 n.7 (quoting *Corning v. Burden*, 56 U.S. (15 How.) 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."). Having said that, the Supreme Court also indicated that a claim "seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment." *Id.* (citing *Benson* and *Flook*); *see, 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. "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.* (alterations in original) (quoting *Mayo*, 566 U.S. at 77). "[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention." *Id.*

The PTO recently published revised guidance on the application of § 101. *See* 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (USPTO Jan. 7, 2019) ("Guidance"). Under that guidance, we first look to whether the claim recites:

(1) any judicial exceptions, including certain groupings of abstract

ideas (i.e., mathematical concepts, certain methods of organizing

human activities such as a fundamental economic practice, or mental

processes); and

(2) additional elements that integrate the judicial exception into a

practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h) (9th ed.

Rev. 08.2017, Jan. 2018)).

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 Guidance, 84 Fed. Reg. at 56.

CLAIMS 1–14 and 21–25

The Examiner's Rejection

The Examiner rejects representative[3] claim 1 under 35 U.S.C. § 101

because the claim is directed to an abstract idea and does not recite

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[3] Appellants argue claims 1–14 and 21–25 as a group. *See* App. Br. 25
(arguing that claim 21 recites patent-eligible subject matter for the same
reasons as claim 1 and claims 2–14 and 22–25 recite patent-eligible subject
matter for the same reasons as the corresponding independent claims). So
we select independent claim 1 as representative of claims 1–14 and 21–25.
See 37 C.F.R. § 41.37(c)(1)(iv).

additional elements that amount to significantly more than the judicial exception itself. Final Act. 3–7. For the reasons discussed below, we are not persuaded that the Examiner erred.

The Judicial Exception

Viewing the Examiner's rejection through the lens of the Office's recent guidance, we first determine whether the claim *recites* a judicial exception and then determine whether the claim—considered as a whole—is *directed to* that exception.

Claim 1 recites a method of creating a life-cycle workflow for a project. *See* Spec. ¶¶ 1–2, 12. Specifically, claim 1 recites steps involving workflow stages: (1.a.) "creating one or more identifiable workflow stages for the project," and (1.b.) "each of the one or more workflow stages corresponding to a specific sequence of workflow activities, wherein the creating further comprises using a workflow stage identifier as a property of the specific sequence of workflow activities for each of the one or more workflow stages." App. Br. 27. Also, claim 1 recites steps involving workflow phases: (2.a.) "creating one or more identifiable workflow phases," (2.b.) "each workflow phase includes one or more corresponding workflow stages," (3) "associating a workflow phase with the workflow stage, the workflow phase being selected from the one or more workflow phases." *Id.*

As for the recited "workflow stages," limitations (1.a.) and (1.b.) group business activities into stages with names. For instance, "[a] workflow is a pattern of activities that accomplishes a specific purpose." Spec. ¶ 17. Activities include determining a project name, describing the project's purpose, defining a project's scope, among other things. *Id.* These

workflows include multiple stages. *Id.* And the stages are given names. *Id.*
In summary, the steps in limitations (1.a.) and (1.b.) recite activities that a
person would perform when starting a project.

In limitations (2.a.), (2.b.), and (3), examples of the created
"workflow phases" include "create, select, plan and manage." *Id.* ¶ 28. In
an example create phase, a project idea and its initial details are proposed.
Id. "In an example selection stage, the project is selected, reviewed and
approved." *Id.* Example plan and manage phases include identifying project
resources and monitoring the project, respectively. *Id.* In summary, the
steps recited in limitations (2.a.), (2.b.), and (3) include steps that a person
would perform when managing and planning a project.

Overall, limitations (1.a.) through (3) encompass steps for creating a
workflow that organizes how people perform project tasks. These
limitations recite steps that a person would perform when working on a
project. In this way, claim 1 recites a concept related to managing
relationships or transactions between people. *Accord id.* ¶¶ 1–2, 12
(describing governance processes). We also note that the concept here is
similar to the concepts of generating tasks for processing insurance claims in
Accenture Global Services v. Guidewire Software, Inc., 728 F.3d 1336,
1338–39 (Fed. Cir. 2013) (Ans. 5) and loan processing in *Credit Acceptance
Corp. v. Westlake Services*, 859 F.3d 1044, 1054 (Fed. Cir. 2017), which
were deemed abstract ideas. For all these reasons, the recited subject matter
belongs to the group of certain methods of organizing human activity.
Guidance, 84 Fed. Reg. at 52, n.13 (citing *Credit Acceptance*, 859 F.3d at
1054); MPEP § 2106.04(a)(2)(II)("CERTAIN METHODS OF

ORGANIZING HUMAN ACTIVITY") (citing *Accenture*, 728 F.3d at 1338–39).

Appellants argue that the Examiner has ignored the recited workflow-stage identifier. App. Br. 13; Reply Br. 2–4. Yet this identifier does not make claim 1 any less abstract. Instead, as broadly recited, the identifier essentially labels the workflow stage. For example, "[e]ach workflow stage is given a name and a description that lets the user understand the purpose of the workflow stage." Spec. ¶ 30. The "workflow stage identifier" correlates the stage with specific activities. *Id.* ¶ 31. Workflow activities are reused and applied to multiple workflow stages through association with the stage's identifier. *Id.* ¶ 33. In this way, the workflow stage identifier is analogous to the nontechnical human activity of labeling or cross-referencing.

Thus, claim 1 recites an abstract idea falling within the Guidance's subject-matter grouping of certain methods of organizing human activity— i.e., managing personal behavior or relationships or interactions between people.

Integration into a Practical Application

For the reasons discussed below, we conclude that claim 1, considered as a whole, does not integrate the judicial exception into a practical application

Here, we use the term "additional elements" to refer to features, limitations, or steps that the claim recites beyond the abstract idea itself. Guidance, 84 Fed. Reg. at 55 n.24. In claim 1, the additional limitations are a "server" and the step of "creating one or more project detail pages on the server computer, each project detail page being a web page that is made visible during a corresponding workflow stage." App. Br. 27. These

additional elements—considered in the context of claim 1 as a whole—do not integrate the abstract idea into a practical application. *See* Guidance, 84 Fed. Reg. at 55 nn.25 & 27–32 (citing MPEP §§ 2106.05(a)–(c), (e)–(h)).

Considering the claim as a whole, these additional limitations merely add generic computer activity to deliver web pages and store data, which is insufficient to integrate the judicial exception into a practical application. *See* MPEP § 2106.05(a). For instance, the server creates the project-detail pages. But the claim does not recite a technical improvement to how the project-detail pages are created. Instead, the project-detail pages are merely web pages that are viewed during a corresponding workflow stage.

Appellants argue claim 1 is "directed to a workflow architecture that is firmly rooted in the computer arts." App. Br. 13. In Appellants' view, "[t]he ordered combination of steps of Claim 1 provides an efficient method for generating electronic workflows in a computing environment." Reply Br. 4. Appellants argue that the claimed invention "improves the performance of the recited computing system by allowing for efficient creation of an electronic, server-hosted workflow." *Id.* at 6. According to Appellants, the specific improvement is "providing a life cycle workflow." *Id.* at 5.

A person, though, can create a project plan and description without a server. *See, e.g.,* Spec. ¶¶ 1–2. By creating the workflows on a server and adding project details to web pages, the recited server merely links the abstract idea to a computer environment. In this way, the server's involvement is merely a field of use, which does not integrate the abstract idea into a practical application. Guidance, 84 Fed. Reg. at 55; *see also* MPEP § 2106.05(h).

In fact, beyond storing the data and creating the web pages, the recited server contributes only nominally and insignificantly to the recited method, which indicates an absence of integration here. *See In re TLI Comms. LLC Patent Litig.*, 823 F.3d 607, 612–13 (Fed. Cir. 2016) (explaining that using a server in its ordinary capacity to store images may not be sufficient to render the claims patent eligible), *cited in* MPEP § 2106.05(f); *see also buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (explaining that sending and receiving information over a network without further specification may not be sufficient to render the claims patent eligible). Nor is claim 1's server a "particular machine" as described in *Bilski* for these reasons. *See* MPEP § 2106.05(b) ("Particular Machine") (citing *Bilski*, 561 U.S. at 604).

Appellants argue "the claims similarly provide a set of rules with specific characteristics realized through executed logic that allows for the improvements realized by the invention." Reply Br. 6. Appellants compare the claim to those in *Amdocs (Israel), Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016). *See* App. Br. 19–21; Reply Br. 6–7.

The claim in *Amdocs* provided a technological solution to a technological problem—i.e., a distributed architecture that allowed the system to "efficiently and accurately collect network usage information in a manner designed for efficiency to minimize impact on network and system resources." *Amdocs*, 841 F.3d at 1303. Claim 1, though, does not recite a technological improvement to how the recited project-detail pages are created. Rather, claim 1 uses the computer as a tool, in its ordinary capacity, to carry out the abstract idea. In this way, claim 1 is unlike the claim in *Amdocs*. *Accord* Ans. 10 (discussing *Amdocs*).

At most, the computer automates the manual process of creating workflow stages and phases. As to this level of computer involvement, mere automation of manual processes using generic computers does not necessarily indicate a patent-eligible improvement in computer technology. *Credit Acceptance*, 859 F.3d at 1055. Here, creating workflows a virtual environment does not improve operating efficiency or reduce storage costs. Rather, claim 1 uses a computer as a tool to automate a part of workflow creation. Considered as a whole, the claimed method does not improve the functioning of the computer itself or any other technology or technical field. *See Alice*, 573 U.S. at 210, *cited in* MPEP § 2106.05(a).

The Guidance also discusses other ways that the additional elements may integrate the judicial exception into a practical application—e.g., a particular transformation, a particular treatment of a disease, among other things. Guidance, 84 Fed. Reg. at 55. Claim 1, though, lacks such claimed features.

For all these reasons, claim 1 does not integrate the judicial exception into a practical application. *See id.* at 54–55. Thus, claim 1 is directed to the recited abstract idea.

The Inventive Concept

For the reasons discussed in this section, claim 1 also lacks an inventive concept.

Appellants argue that the claims are "so unique that the Office has now admitted the claims are otherwise allowable over the prior art." App. Br. 14; *see also* Reply Br. 4–5. But it is not "enough for subject-matter eligibility that claimed techniques be novel and nonobvious in light of prior art, passing muster under 35 U.S.C. §§ 102 and 103." *SAP Am., Inc. v.*

InvestPic, LLC, 898 F.3d 1161, 1163 (Fed. Cir. 2018); *see also Affinity Labs of Tex., LLC v. DirecTV, LLC*, 838 F.3d 1253, 1263 (Fed. Cir. 2016) (explaining that "[e]ven assuming" that a particular claimed feature was novel, the problem of abstractness was not avoided). Rather, to determine whether claim 1 provides an inventive concept, we consider the additional elements, individually and in combination, to determine whether they (1) add a specific limitation beyond the judicial exception that is not "well-understood, routine, conventional" activity in the field or (2) simply append well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. Guidance, 84 Fed. Reg. at 56.

In claim 1, the additional elements include a "server" and "creating one or more project detail pages on the server computer, each project detail page being a web page that is made visible during a corresponding workflow stage." App. Br. 27. As to these limitations, the Examiner finds that claim 1 recites well-understood, routine, and conventional features. Final Act. 6 (citing Spec. ¶¶ 63–64). We agree.

Like the claims in *Interval Licensing, LLC v. AOL, Inc.*, claim 1 "merely [recites] routine and conventional steps in carrying out the well-established practice of accessing data from an external source and displaying that data on a user's device." 896 F.3d. 1335, 1345 (Fed. Cir. 2018). In particular, we agree with the Examiner that the Specification describes the claimed server generically. Final Act. 6 (citing Spec. ¶¶ 63–64). Referring to the computer executing the method, the Specification states that the "devices are *well known in the art* and need not be discussed at length here." Spec. ¶ 65 (emphasis added). Indeed, the Specification merely states that

"the server 108 is a computing device, such as a server computer." *Id.* ¶ 63.
This device "can include input/output devices, a central processing unit
('CPU'), a data storage device, and a network device." *Id.* By identifying
these paragraphs, the Examiner has adequately supported the finding that the
recited server is well-understood, routine, and conventional (Final Act. 6),
contrary to Appellants' arguments (Reply Br. 5).

As a whole, claim 1 is directed to an abstract idea on a server used in
its ordinary capacity performing well-understood, routine, and conventional
activities. For all these reasons, claim 1's limitations, considered
individually and in combination, do not provide an inventive concept. *See*
Guidance, 84 Fed. Reg. at 56.

Other Arguments

Appellants argue that claim 1 cannot "prevent or preempt all uses"
because it is narrowly tailored in scope to electronic-workflow technology.
App. Br. 14; *see also* Reply Br. 6 ("The specific details of such rules avoid
any impermissible preemption."). Although the extent of preemption is a
consideration in our analysis, the absence of complete preemption is not
dispositive. *See, e.g., Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d
1371, 1379 (Fed. Cir. 2015) ("While preemption may signal patent ineligible
subject matter, the absence of complete preemption does not demonstrate
patent eligibility."). "[Q]uestions on preemption are inherent in and
resolved by the § 101 analysis," which the Examiner has applied. *Id.*

Conclusion

On this record, Appellants have not persuaded us of error in the
rejection of representative claim 1 under 35 U.S.C. § 101. Thus, we sustain

the Examiner's rejection of claims 1–14 and 21–25, which are argued as a group. *See supra* n.3.

CLAIM 20

For reasons similar to those discussed above, we are also unpersuaded that the Examiner erred in rejecting claim 20. Specifically, claim 20 recites at least the limitations of claim 1 as part of a computer-readable data storage device.

Specifically, claim 20 further recites various selections related to the project pages, fields, and workflow stages:

> when one or more project detail pages are selected, select an ordering for the one or more project detail pages;
> select one or more required custom fields from a plurality of workflow controlled custom fields made available on the server computer;
> select one or more read only custom fields from a plurality of workflow controlled custom fields made available on the server computer, at least one read only custom field corresponding to a custom field on a project detail page, the read only behavior of at least one read only custom field being controlled by workflow activity for a workflow stage;
> select a strategic impact behavior for a workflow stage, the strategic impact behavior designating a business impact for a business driver associated with the workflow stage, the business impact being either a low impact, a moderate impact or a high impact, the strategic impact behavior being designated as read only or required;
> . . .
> create an enterprise project type for the project on the server computer, the enterprise project type being associated with workflow for the project.

App. Br. 29, Claims Appendix.

Although claim 20 is narrower than claim 1, "[a] narrow claim directed to an abstract idea, however, is not necessarily patent-eligible."

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Intellectual Ventures I LLC v. Symantec Corp., 838 F.3d 1307, 1321 (Fed. Cir. 2016). "[A] claim for a *new* abstract idea is still an abstract idea." *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016). Claim 20 merely adds limitations that further narrow the abstract idea in claim 1 without adding features that integrate the abstract idea into a practical application or supply an inventive concept.

Claim 20 further recites a feature to "designate whether the project needs to be checked in for the workflow stage." App. Br. 29. For example, only one user can check out a project at a time. Spec. ¶ 40. If a workflow stage is not designated as requiring check in, the system blocks any workflow activities that require modifying the workflow stage until the project is checked in. *Id.* In this way, the step provides a version-control system that manages how people interact with the project, which is yet another further limitation on how human activities are managed—an abstract idea. In sum, claim 20's features are not directed to a specific improvement to the way computers operate.

Similarly, the computer's operation is not improved by selecting a strategic impact behavior and setting a "business impact" to low, medium, or high. Instead, these limitations focus on further customizations, labels, and a particular aspect of the workflow stage (i.e., designating a business impact for an associated business driver). These are features of the abstract idea that we described in detail in the analysis of claim 1.

Appellants argue that representative claim 20 recites features "firmly rooted in improving the efficiency and performance of an electronic workflow system operating in a server-hosted environment." App. Br. 22; *see also* Reply Br. 7–8 (discussing the server's role in the context of claim

20). Appellants compare the claim to those in *Amdocs (Israel), Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016). App. Br. 22–24. But the server has the same role in claim 20 as it does in claim 1. So the server, as recited in the above-quoted limitations, does not integrate the abstract idea into a practical application or supply an inventive concept for the same reasons as those discussed in connection with claim 1.

Thus, Appellants have not persuaded us of error in the rejection of claim 20 under 35 U.S.C. § 101.

DECISION

We affirm the Examiner's decision to reject claims 1–14 and 20–25.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED