UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MERZAD HEMMAT

Appeal 2009-003911
Application 10/429,615
Technology Center 3600

Decided: October 13, 2009


HORNER, Administrative Patent Judge

DECISION ON APPEAL
STATEMENT OF THE CASE


SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellant’s claimed invention is a method for defining and selecting integrated potential software, hardware, and networking approaches for addressing a business need. Spec. 5, para. 0016. Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A process for defining and selecting integrated potential software, hardware, and networking approaches for addressing a business need comprising:
   
   providing an identification of a business need to at least one conceptual architect in a concept document, the concept document provided to the at least one conceptual architect including
   
   context information regarding where the business need fits into an enterprise and with related projects,
   target information regarding what the intended market uses and volumes are for the business need, and
   detailed information on capabilities and constraints that the business need is introducing;
the at least one conceptual architect identifying the potentially impacted business domains using the context information, target information, and the capabilities and constraints information provided in the concept document;

holding a meeting which includes a representative of IT, a representative of network, and a representative of operations from each potentially impacted business domain wherein the meeting results in additions to the concept document identifying at least one proposed approach, the additions to the concept document including

architectural approaches to each proposed approach encompassing network and information technology (IT) perspectives;

critical functional impacts of each proposed approach; and

required or desired testing for each proposed approach;

identifying impacted systems for each proposed approach by examining the additions to the concept document including the architectural approaches, the critical function impacts, and the testing for each proposed approach;

providing the entire concept document to representatives of each impacted system for feedback before final selection of a proposed approach or initiation of efforts to implement a proposed approach; and

selecting a final selection from the at least one proposed approach with a view of the long-range plans and overall direction of an enterprise rather than to a specific problem.
THE REJECTIONS

Appellant seeks review of the following rejections:

1. The Examiner’s rejection of claims 1-18\(^1\) under 35 U.S.C. § 101 as being directed to patent ineligible subject matter.
2. The Examiner’s rejection of claims 1-18 under 35 U.S.C. § 112, second paragraph, as being indefinite.

ISSUES

For each ground of rejection, Appellant argues all of the claims as a single group. We select claim 1 as representative, and claims 2-18 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

The Examiner found that the subject matter of claims 1-18 is not directed to patent eligible subject matter because the claimed method is not concrete or repeatable with a reasonable degree of repeatability. Ans. 3-4. Appellant contends the claimed method is patentable because it produces a result that is repeatable or predictable and is therefore concrete. App. Br. 19.

The Examiner found that claims 1-18 are indefinite because (1) it is not clear how many approaches are called for in the claims, and (2) the claim

\(^1\) The Examiner corrected a typographical error in the final office action, from which this appeal is taken, to clarify that the rejection of the claims under 35 U.S.C. § 101 includes a rejection of claim 18. Ans. 3.
requirement that the selection of an approach is to be made not with a view to a specific problem is inconsistent with rest of the claim that calls for the at least one proposed approach to be directed to addressing the specific business need identified in the concept document. Ans. 4-5. Appellant contends that (1) “it is clear that the phrase ‘each proposed approach’ individually refers to the one or more approaches covered by the phrase ‘at least one approach’” and (2) “there is not a contradiction in selecting a final approach which addresses a specific problem based on the long-range plans and overall direction of the enterprise rather than to a specific problem.” App. Br. 20-21.

The Examiner concluded that the claimed method would have been obvious in view of the teachings of Bowman-Amuah. Ans. 5-13. Appellant challenges the Examiner’s articulation of obviousness in view of Bowman-Amuah. App. Br. 25-35.

The issues presented by this appeal are:

Has Appellant shown the Examiner erred in concluding that claim 1 is directed to patent ineligible subject matter?

Has Appellant shown the Examiner erred in concluding that claim 1 is indefinite?

Has Appellant shown the Examiner erred in concluding that the subject matter of claim 1 would have been obvious in view of Bowman-Amuah?
FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Bowman-Amuah teaches:

   Data elements [used in software development] should usually be controlled by the Repository Management team, because they are the basic building blocks of the system and have broad reuse. Poorly defined data elements can cause inconsistency, redundancy, and generation errors. Data elements should therefore be located at least by the time construction starts, and possibly earlier, depending on the discipline of the team. Bowman-Amuah, col. 20, ll. 11-17.

2. Bowman-Amuah then discloses that “[w]henever a data element is changed, impact analysis must be performed to understand the side-effects. Where-used reports are useful to determine these side-effects.” Bowman-Amuah, col. 20, ll. 43-45.

PRINCIPLES OF LAW

The law in the area of patent-eligible subject matter for process claims has been clarified by the Federal Circuit in *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc), *cert. granted*, 129 S. Ct. 2735 (U.S. Jun. 1, 2009) (No. 08-964). The en banc court in *Bilski* held that “the machine-or-transformation test, properly applied, is the governing test for determining
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patent eligibility of a process under § 101.” Id. at 956. The court in Bilski further held that “the ‘useful, concrete and tangible result’ inquiry is inadequate [to determine whether a claim is patent-eligible under § 101.]” Id. at 959-60. The court explained the machine-or-transformation test as follows: “A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” Id. at 954 (citations omitted).

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

[W]e employ a lower threshold of ambiguity when reviewing a pending claim for indefiniteness than those used by post-issuance reviewing courts. In particular, rather than requiring that the claims are insolubly ambiguous, we hold that if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.

Ex parte Miyazaki, 89 USPQ2d 1207, 1211 (BPAI 2008).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406
The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”)

**ANALYSIS**

_Rejection of claims 1-18 under 35 U.S.C. § 101_

Claim 1 recites a method for organizing human activity to define and select integrated potential software, hardware, and networking approaches for addressing a business need. As in *Bilski*, the method steps are not tied to a particular machine and do not result in a transformation of an article to a different state or thing. Rather, the claim is directed to a method for selecting an approach to address a business need, in which the business need and other information is outlined in a concept document that is provided to various stakeholders, meetings are held to discuss proposed approaches, further information is added to the concept document, and then a final selection of an approach is made. The claim does not involve the use of any machine or apparatus. Further, the claim does not involve the transformation of any physical objects or substances. As the court in *Bilski* noted, “[p]urported transformations or manipulations simply of public or
private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances.” 545 F.3d at 963. Thus, the method of claim 1 fails the machine-or-transformation test and is not directed to patent-eligible subject matter under 35 U.S.C. § 101. Claims 2-18 fall with claim 1.

Rejection of claims 1-18 under 35 U.S.C. § 112, second paragraph

Claim 1 recites the step of holding a meeting to identify “at least one proposed approach” for addressing a business need. One having ordinary skill in the art would understand this claim recitation to mean that one or more proposed approaches will result from the meeting. The claim then refers to adding information to the concept document for “each proposed approach,” identifying impacted systems “for each proposed approach,” and selecting a final selection from “the at least one proposed approach.” To “select” ordinarily means “[t]o take as a choice from among several; pick out.” The American Heritage Dictionary of the English Language (4th ed. 2000). In the event that only one approach is proposed at the meeting, it is unclear how the step of selecting a final selection would be performed, because with only one proposed approach, it is not possible to select that proposed approach from among several (or at least two) possible approaches.

Even if one having ordinary skill in the art were to understand that the step of selecting a final selection from a single proposed approach involves
simply selecting that sole proposed approach as the final approach, the claim is still internally inconsistent because the one proposed approach is selected to address a specific business need, yet the last step of claim 1 further recites that the final selection is made “with a view of the long-range plans and overall direction of an enterprise rather than to a specific problem.” If the proposed approach was initially proposed to address a specific problem, and if it is the sole approach from which the final selection can be made, then this approach is necessarily selected with a view to the specific problem. As such, it is unclear how the claim can be met when only a single approach is proposed.

Appellant tries to explain this final step of the claim by way of example in the Reply Brief. Reply Br. 13-14. In particular, Appellant says that if the long range plans and overall direction of an enterprise are “to meet all legal mandates,” then the one approach may be the only approach for satisfying the business need while at the same time being the only approach that meets a legal mandate. This example is not in keeping with the claimed method because the example seems to imply that the persons proposing the one proposed approach already took into account the long range plans and overall direction of the enterprise in ruling out other possible approaches that met the identified business need but that did not “meet all legal mandates.” The claim, however, recites that the “at least one proposed approach” is identified at a meeting based on the concept document, which provides an identification of a specific business need. The claim does not refer to the
long range plans and overall direction of an enterprise until the last step of the method.

The other example provided by Appellant is one in which the long range plans and overall direction of an enterprise are to “upgrade legacy systems.” Reply Br. 14. Appellant contends that “[i]f the one approach is the only approach for satisfying a business need of upgrading a billing system, then the one approach is selected in order to conform to the long range plans and overall direction of the enterprise of upgrading legacy systems.” This example is also not in keeping with the claimed method because the example presumes that the business need and the long range plans and overall direction are the same, _viz_, to upgrade systems. The claim, however, requires that the step of selecting occurs “with a view of the long-range plans and overall direction of an enterprise rather than to a specific problem.” This claim recitation implies that the long range plans and overall direction are different from the specific problem (i.e., business need). We are not persuaded by Appellant’s examples that the Examiner erred in concluding that the claim is internally inconsistent such that one having ordinary skill in the art would not understand what is claimed when the claim is read in light of the Specification.

As such, we agree with the Examiner that claim 1 is indefinite for failing to particularly point out and distinctly claim the invention. Claims 2-18 fall with claim 1.
Independent claim 1 recites “identifying impacted systems for each proposed approach by examining the additions to the concept document including the architectural approaches, the critical function impacts, and the testing for each proposed approach.” Claims 11 and 18 similarly recite holding a meeting wherein a plan is created that establishes at least one potential approach to the concept and “the systems that are actually impacted.” In each claim, this information about the impacted systems is added to the concept document prior to making a final selection of an approach.

The Examiner pointed to the disclosure in column 20, lines 43-54 to support the finding that Bowman-Amuah discloses identifying impacted systems for each proposed approach. This portion of Bowman-Amuah does not disclose identification of impacted systems for a proposed approach for addressing a business need. Rather, the reference is disclosing that once a change has been made to a data element, the where-used report determines the impact of the change on all of the components affected by that changed (Facts 1, 2). We fail to see, absent hindsight, how this disclosure in the prior art would have led one having ordinary skill in the art to identify systems impacted by each proposed approach prior to making a final selection of an approach. As such, we will not sustain the rejection of claims 1-18 under 35 U.S.C. § 103.
CONCLUSIONS

Appellant has failed to show the Examiner erred in concluding that claim 1 is directed to patent ineligible subject matter.

Appellant has failed to show the Examiner erred in concluding that claim 1 is indefinite.

Appellant has shown the Examiner erred in concluding that the subject matter of claim 1 would have been obvious in view of Bowman-Amuah.

DECISION

The decision of the Examiner to reject claims 1-18 is affirmed.


AFFIRMED

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