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12/128,098	05/28/2008	Richard D. Dettinger	ROC920070004US1	9699

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Patterson & Sheridan, LLP  
24 Greenway Plaza, Suite 1600  
Houston, TX 77046

EXAMINER
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FISHER, PAUL R

ART UNIT	PAPER NUMBER
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3689

NOTIFICATION DATE	DELIVERY MODE
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05/19/2016

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):

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<b>Office Action Summary</b>	<b>Application No.</b> 12/128,098	<b>Applicant(s)</b> DETTINGER ET AL.	
	<b>Examiner</b> PAUL R. FISHER	<b>Art Unit</b> 3689	<b>AIA (First Inventor to File) Status</b> No

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2016 (PTAB Decision).  
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims\*

- 5) ☒ Claim(s) 1-24 is/are pending in the application.  
5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1-24 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

\* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see [http://www.uspto.gov/patents/init\\_events/pph/index.jsp](http://www.uspto.gov/patents/init_events/pph/index.jsp) or send an inquiry to [PPHfeedback@uspto.gov](mailto:PPHfeedback@uspto.gov).

### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

#### Certified copies:

- a) ☐ All    b) ☐ Some\*\*    c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 3) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)<br>Paper No(s)/Mail Date ____. | 4) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### RESPONSE TO PTAB DECISION

1. In the decision by the Board of Patent Appeals and Interferences mailed **February 11, 2016**, the rejections of **claims 1-24** were reversed. The reason for the reversal of **claims 1-24** were, in substance, that the Patent Trial and Appeal Board stated:

“We are persuaded by the Appellants' argument that in Yehia "publication rule" is stored in a database and applied to a whole document (document field 72), based on a category (category field 74) and specifying a time frame (start field 76 and end field 78). Donde demonstrates no knowledge of "parsing the unstructured document to identify a set of terms included in the publishing rule" and "annotating each term with metadata describing the term to create a structured pattern describing the publishing rule." The database structure taught by Donde does not teach, or even suggest, this field level of metadata under which claim 1 applies a publication rule...”

“Claim 1 recites "parsing the unstructured document to identify a set of terms included in the publishing rule" and "annotating each term with metadata describing the term to create a structured pattern describing the publishing rule." Clearly the publishing rules" discussed in Donde do not teach these limitations of claim 1.”

“App. Br. 15-16. The Examiner's finding that Donde describes publishing rules within a document is in error. The Examiner cites Donde 2:4-12. Final Act.

5. While one might get the impression of such a finding if this passage is read

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quickly, the passage actually states that it is Donde's document management system, not the document that contains the rules. Donde does not describe obtaining those rules from a document per se.”

“All three independent claims contain similar limitations.” (Appeal Br. 5.)

Upon review, **claims 1-24** are directed to non-statutory subject matter with respect to updated 101 eligibility guidance. Therefore, under 37 CFR 1.198, prosecution is hereby reopened (see MPEP 1214.04). The new grounds of rejection are detailed below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Technology Center Director has approved of reopening prosecution by signing below:

***Status of Claims***

2. **Claims 1 – 24** have been reversed by the Patent Trial and Appeal Board for the rejections under 35 USC 103(a).
3. **Claims 1-24** remain pending and a **new rejection** under 35 USC 101 has been **provided**.

***Notice of Pre-AIA or AIA Status***

4. The present application is being examined under the pre-AIA first to invent provisions.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 1-24** are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter.

When considering subject matter eligibility under 35 U.S.C. § 101, it must be determined whether the claim is directed to one of the four statutory categories of invention, i.e., process, machine, manufacture, or composition of matter. If the claim does fall within one of the statutory categories, it must then

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be determined whether the claim is directed to a judicial exception (i.e., law of nature, natural phenomenon, and abstract idea), and if so, it must additionally be determined whether the claim is a patent-eligible application of the exception. If an abstract idea is present in the claim, any element or combination of elements in the claim must be sufficient to ensure that the claim amounts to significantly more than the abstract idea itself. Examples of abstract ideas include fundamental economic practices, certain methods of organizing human activities, an idea itself, and mathematical relationships/formulas. *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*, 573 U.S. \_\_\_\_ (2014).

In the instant case, **claims 1-8** are directed to a method, **claims 9-16** are directed toward a medium and **claims 17-24** are directed toward a system. Thus, each of the claims falls within one of the four statutory categories. Nevertheless, the claims fall within the judicial exception of an abstract idea.

**Claims 1-24** are directed to an abstract idea of handling or processing documents based on rules, such as, receiving an unstructured document which includes a rule, parsing the document to identify a set of terms, annotating each term, comparing the structured pattern to a plurality of patterns to find the best-fit and generating a best-fit template based on the comparison. For instance, in *Alice Corp.* the Supreme Court found that “intermediated settlement” was a fundamental economic practice, which is an abstract idea. In this case, the claimed invention is directed to *a fundamental economic practice and an idea of itself* because the claimed invention is *directed towards concepts relating to the economy and commerce, such as processing documents, as well as, an idea*

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*standing alone such as an uninstantiated concept, plan, or scheme, as well as a mental process (thinking) that “can be performed in the human mind, or by a human using a pen and paper”, such as, collecting and comparing information (receiving and reviewing the documents in order to perform a particular workflow); comparing new and stored information and using rules to identify options (determining, for example, which pattern is the best-fit); and data recognition and storage (reviewing the documents by parsing for information and using the rules to determine the matches), which results in it being a fundamental economic practice and an idea of itself.*

Part I: Is the claim **directed** to a law of nature, a natural phenomenon, or an abstract idea? As was discussed above, the claimed invention is, indeed, directed to an abstract idea as it is directed towards the abstract idea of commerce, specifically, the handling of a documents based on rules. The claimed invention is directed towards performing the well-understood, routine, and conventional activities in the technical field of data management. Independent **claims 1, 9 and 17** are directed towards the well-understood, routine, and conventional activities of receiving and reviewing a document to determine which steps apply to the particular document.

Additionally, the Interim Eligibility Guidelines at 74625 state that “**if there is doubt as to whether the applicant is effectively seeking coverage for a judicial exception itself, the full analysis should be conducted to determine whether the claim recites significantly more than the judicial exception.**”

Further yet still, the July 2015 Guidelines are state:

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“In particular, the initial burden is on the examiner to explain why a claim or claims are unpatentable clearly and specifically, so that applicant has sufficient notice and is able to effectively respond. For subject matter eligibility, the examiner’s burden is met by clearly articulating the reason(s) why the claimed invention is not eligible, for example by providing a reasoned rationale that identifies the judicial exception recited in the claim and why it is considered an exception, and that identifies the additional elements in the claim (if any) and explains why they do not amount to significantly more than the exception. This rationale may rely, where appropriate, on the knowledge generally available to those in the art, on the case law precedent, on applicant’s own disclosure, or on evidence.

...

Accordingly, courts do not rely on evidence that a claimed concept is a judicial exception, and in most cases resolve the ultimate legal conclusion on eligibility without making any factual findings.

...

*Alice Corp.*, *Myriad*, *Mayo*, *Bilski*, *Diehr*, *Flook* and *Benson* relied solely on comparisons to concepts found to be exceptions in past decisions when identifying judicial exceptions.

...

*Alice Corp.*, *Bilski*, *Diehr*, *Flook* and *Benson* did not cite any evidence in support of the significantly more inquiry, even where additional elements were identified as well-understood, routine and conventional in the art. *Mayo* did not cite any evidence in support of identifying additional elements as mere field-of-use or data gathering steps, but did cite the patent’s specification when identifying other limitations as well-understood, routine and conventional.”

(Pages 6 - 7)

Therefore, the full analysis under *Alice* is still appropriate because applicant’s remarks have not eliminated all doubt that the invention is directed to a judicial exception.



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Although, one may argue that the claimed invention does not seek to “tie up” the exception because of the claimed invention’s narrow scope, the Examiner asserts that clever draftsmanship of further narrowing the abstract idea does not change the fact that the invention is still directed towards an abstract idea. Here, the claimed invention is directed towards a similar scenario because the claimed invention is taking the abstract idea of document management, specifically, performing a set of steps based on the content of the document, and merely implementing it in a particular environment, i.e. the claimed invention is merely implementing well-known business practices and implementing them in a computer environment that is comprised of generic computing devices to perform generic functions, or, more specifically, applies them in the aforementioned well-understood, routine, and conventional activities that are known in the technical field of document management.

Also, in *BuySafe, Inc. v. Google, Inc.* (Fed. Cir. 2014), the court stated that “*abstract ideas, no matter how groundbreaking, innovative, or even brilliant, are outside what the statute means by “new and useful process, machine, manufacture, or composition of matter”*”, and reference is made to *Mryiad* by the court for this position. Also stated in *BuySafe* is

“In defining the excluded categories, the Court has ruled that the exclusion applies if a claim involves a natural law or phenomenon or abstract idea, even if the particular natural law or phenomenon or abstract idea at issue is narrow. Mayo, 132 S. Ct. at 1303. The Court in Mayo rejected the contention that the very narrow scope of the natural law at issue was a reason to find patent eligibility, explaining the point with reference to both natural laws and one kind of abstract idea, namely, mathematical concepts.”

Again, the Examiner would like to reiterate that this is a rejection under 35 USC 101 and not a rejection under 35 USC 102/103.

Therefore, because independent **claims 1, 9 and 17** include an abstract idea, the claim must be reviewed under Part II of the Alice Corp. analysis to determine whether the abstract idea has been applied in an eligible manner.

Part II: The claim(s) does not include additional element that are sufficient to amount to significantly more than the judicial exception because the claim recited generically computer elements (e.g. a computing device) which do not add a meaningful limitation to the abstract idea because they would be routine in any computer implementation. An example of this is found in paragraphs [0020], [0022] and [0025], which shows using generic routine computing components and that the software is "not limited to any currently existing computing environment or programming language" indicating that that too can be any sort of generic computing instructions. As highlighted in paragraph [0025] the instructions for parsing and adding metadata about the the information using known architectures such as "UIMA". As such this is not found to be an improvement but rather the usage of known techniques which are considered to be a standard in the field.

The Examiner asserts that the claimed invention does not further or improve upon the technology or the technical field as merely having a general purpose device to perform the steps of the abstract idea is nothing more than having the general purpose device perform the well-understood, routine, and

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conventional activities already known in commerce, which results in the claimed invention not amounting to being significantly more than the judicial exception. The Examiner further notes that the decision of *DDR Holdings* does not apply as, unlike *DDR Holdings*, the claimed invention is not “deeply rooted in the technology” since: 1.) humans have, for some time, longed been known to perform the well-understood, routine, and conventional activities in the field of document management, e.g., gathering the necessary information pertaining to the document so as to determine what steps can be performed; and 2.) the well-understood, routine, and conventional activities of the abstract idea does not change, alter, or improve upon how the technology, i.e. the computing device, fundamentally functions. The invention further fails to improve upon the technical field (document management) because merely using the general purpose device to perform the well-understood, routine, and conventional activities of the document management and that such use of the technology has been held to not be an “inventive concept” as the general purpose device is being used for the very purpose that such device are known to be used for, e.g. more efficient, faster, and etc.

Additionally, the claimed invention is also directed towards the abstract idea of collecting data, recognizing data, and storing the recognized data in order to perform a particular transaction, in this case workflow for the document. The Examiner asserts that the concept of data collection, recognition, and storage is undisputedly well-known and, indeed, humans have always performed these functions. As was already discussed above, the claimed invention is merely

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utilizing general purpose devices (computing device) to perform the steps of data retrieval, i.e. receiving a document and parsing the document to determine which steps to apply. Although one may argue that the human mind is unable to process and recognize the electronic stream of data that is being received, transmitted, stored, and etc. by the computing device, the Examiner asserts that this is insufficient to overcoming the rejection under 35 USC 101 (see *Content Extraction and Transmission LLC v Wells Fargo Bank, National Association* and *Cyberfone* where the system uses categories to organize, store, and transmit information, which was considered by the courts to be an abstract idea). The claims in *Alice Corp v CLS Bank* also required a computer that processed streams of data, but nonetheless were found to be abstract. There is no “inventive concept” in the claimed invention's use of a general purpose computing device to perform well-understood, routine, and conventional activities commonly used in the technical field, in this case, commerce or, more specifically, performing the parsing of the document to determine which rules to apply and how the workflow should be performed. (*Content Extraction and Transmission LLC v Wells Fargo Bank, National Association*) At most, the claims attempt to limit the abstract idea of recognizing and storing information using the devices to a particular environment. Such a limitation has been held insufficient to save a claim in this context.

Further still, the steps of receiving and transmitting information between the computing device and the storage of the information are merely directed towards the concept of data gathering and transmitting are considered

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insignificant extra solution activities. Viewed as a whole, these additional claim elements do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself.

The claim(s) does/do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional elements or combination of elements in the claims other than the abstract idea per se amounts to no more than: (i) managing the follow of a document, and/or (ii) recitation of computer readable storage medium having instructions encoded to perform functions of providing a workflow for a document which can be performed using well understood, routine, and conventional activities previously known to the industry. Considering all claim elements both individually and in combination, do not amount to significantly more than an abstract idea.

In light of the detailed explanation and evidence provided above, the Examiner asserts that the claimed invention is directed towards the abstract idea of managing document workflow, which a fundamental economic practice and an idea of itself. As disclosed, the claimed invention is directed towards managing the workflow of a document based on parsing and recognizing the contents of that document. It is also directed towards being an idea of itself as the claimed invention is directed towards the collection and comparison of information and, based on a set of rules, determining what rules to apply to the document. Lacking significantly more for the remainder of the claim, the invention is nothing more than an abstract idea.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL R. FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [8am/4:30pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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