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HAMMER & ASSOCIATES, P.C. 3125 SPRINGBANK LANE SUITE G CHARLOTTE, NC 28226			LINDSEY III, JOHNATHAN J	
			ART UNIT	PAPER NUMBER
			3629	
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**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.

<b>Office Action Summary</b>	<b>Application No.</b> 13/668,989	<b>Applicant(s)</b> AGNEW ET AL.	
	<b>Examiner</b> JOHNATHAN LINDSEY III	<b>Art Unit</b> 3629	<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 June 22, 2015.  
 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) 1-17 and 19 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5a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.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) 1-17 and 19 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 November 5, 2012 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)  Notice of References Cited (PTO-892)
- 2)  Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)  
Paper No(s)/Mail Date \_\_\_\_\_
- 3)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 4)  Other: \_\_\_\_\_

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

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

**DETAILED ACTION**

2. In view of the appeal brief filed on June 22, 2015, PROSECUTION IS HEREBY REOPENED.

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 Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

3. Claims 1-17 and 19 are currently pending and have been examined below.

***Claim Rejections - 35 USC § 101***

4. 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.

5. Claims 1-17 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

6. With respect to independent claims 1 and 10: In the instant invention, the claims are directed towards the concept of registering ownership data for oil and gas mineral interest and storing such data in a record with an assigned standard number.

Registering ownership information in a data record is a fundamental practice in real estate (*See, e.g.*, MLS or property tax databases). Thus, the examiner concludes that the claims are drawn to an abstract idea. Furthermore, the claims do not recite limitations that are “significantly more” than the abstract idea because the claims do not recite an improvement to another technology or technical field, an improvement to the functioning of the computer itself, or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment. In fact, the limitations of the current claims are performed by a generic processor. The limitations are merely instructions to implement the abstract idea on a computer and require no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry. Therefore, independent claims 1 and 10 are directed to non-statutory subject matter.

Furthermore, all dependent claims, when analyzed as a whole, are also held to be patent ineligible under 35 U.S.C. 101 because the additional recited limitations fail to

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establish that the independent claims are not directed toward non-statutory subject matter.

***Claim Rejections - 35 USC § 112, First Paragraph***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112(a):

(a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

The following is a quotation of the first paragraph of pre-AIA 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1 and 19 are rejected under 35 U.S.C. 112(a) or 35 U.S.C. 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for pre-AIA the inventor(s), at the time the application was filed, had possession of the claimed invention. In order for computer-implemented functional claims to meet the written description requirement, the specification must disclose “the computer and algorithm (*e.g.*, the necessary steps and/or flowcharts) that perform the claimed function in sufficient detail such that one of ordinary skill in the art . . . would know how to program the disclosed computer to perform the necessary steps described in the specification to achieve the claimed function.” See MPEP § 2161.01; *In re Hayes*

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*Microcomputer Prods., Inc. Patent Litigation*, 982 F.2d 1527, 1533-34 (Fed. Cir. 1992).

In the instant case, the applicant's specification does not teach, explain or suggest how the disclosed system would distinguish between each of the three disclosed embodiments of the Quick Serial Identifier for Producing Properties (QSIPP) identifiers (See Figure 4 and Paragraph 0026) or how the system would use the three embodiments at the same time as recited in the claims.

### ***Claim Rejections - 35 USC § 112, Second Paragraph***

9. The following is a quotation of 35 U.S.C. 112(b):  
(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1 and 19 are rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention.

11. With respect to claim 1: Claim 1 recites ***wherein the original depositor code, the serial number code and the check digit are used to identify an original oil and gas mineral interest ... wherein the original depositor code, the serial number code, the check digit, the split number and the item number are used to identify an individual piece of data of an original oil and gas mineral interest.*** The examiner asserts the limitations recite using all three code combinations at the same

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time under the broadest reasonable interpretation of the claim. However, the specification suggests that the different code combinations are alternative embodiments (See Figure 4; Paragraph 0026: "As disclosed in Fig. 6 [sic], three embodiments may identify..."). Thus, the claim is rendered indefinite. For the purposes of compact prosecution, the examiner will continue to interpret the claim as reciting the use of all three code combinations.

12. With respect to claim 19: Claim 19 recites ***using the combination of (a), (b), and (c) to identify an original oil and gas mineral interest ... using the combination of (a), (b), (c), (d) and (e) to identify an individual piece of data of an original oil and gas mineral interest.*** The examiner asserts the limitations recite using all three code combinations at the same time under the broadest reasonable interpretation of the claim. However, the specification suggests that the different code combinations are alternative embodiments (See Figure 4; Paragraph 0026: "As disclosed in Fig. 6 [sic], three embodiments may identify..."). Thus, the claim is rendered indefinite. For the purposes of compact prosecution, the examiner will continue to interpret the claim as reciting the use of all three code combinations.

The examiner also argues the "use" limitations constitute an attempt to claim a process without actually setting forth any steps involved in the process. Claims that merely recite a use without any active, positive steps delimiting how the use is actually practiced have previously been held to be indefinite. See MPEP § 2173.05(q) (citing *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. 1986)).

**Claim Rejections - 35 USC § 103**

13. The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if 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. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-17 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Sinclair (Pub. No. 2008/0249790) in view of Cagan (Pub. No. 2010/0325067).

15. With respect to claim 1: Sinclair discloses a system for tracking and managing oil and gas mineral interest comprising:

(a) **a server; one or more databases operatively associated with said server for storing oil and gas mineral interest data; one or more computer terminals operatively associated with said server and said database** (See at least Figures 1-4A; Paragraphs 0004 and 0036; Sinclair discloses a system for managing mineral interests, comprising at least one database for storing data records relating to oil / gas mineral interest and a server that enables generation of a graphical user interface in each browser at a plurality of locations over an open network);

(b) **an owner registration module operatively associated with said server and said database which is used to register the owner and provide the owner access to the system; a beneficiary registration module operatively associated with said server and said database which is used to register the beneficiary and provide the beneficiary access to the system** (See at least Figure 4A; Paragraphs 0042 and 0053; Sinclair discloses a registration step/page, wherein new users are



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required to enter certain information to establish the identity of the user and to establish a password of the user. Sinclair further discloses that the user is enabled to access various system functionalities as permitted by their security level and group membership once the user has been established as a verifiable user of the system. Examiner further asserts that an owner and beneficiary is the same person under the broadest reasonable interpretation of the claim);

**(c) an access control module operatively associated with said server and said database which is used to grant one or more levels of access to owners and/or beneficiaries to the system** (See at least Paragraphs 0039, 0049-50; System management functionalities enable the operator of the oil and gas mineral interest management system to control the level of access of various users and/or customers);

**(d) an oil and gas mineral interest data registration module operatively associated with said server and said database** (See at least Figures 7-13, 19-20, and 27; Paragraphs 0044, 0045, and 0082; Sinclair discloses an interface that allows users to enter various oil and gas interest data, wherein the data is transmitted via the internet and stored within the centralized database);

**(e) a data standardization module operatively associated with said server and said database which generates and grants a standard number and standard organizational theme to a copy of each entry of oil and gas mineral interest data entered into the system wherein said data standardization module generates numbers which uniquely identifies the oil and gas mineral interest data associated with each entry** (See at least Figures 7 (elements 706 and 708) and 14;

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Paragraphs 0054-56; Sinclair discloses a graphical user interface that displays a deed indicator disclosing deed reference number. Sinclair also teaches the graphical user interface displays a deed identifier, which is auto-generated. Under the broadest reasonable interpretation of the claim, examiner asserts that deed reference number and/or deed ID encompass a standard number and organizational theme. This interpretation is consistent with Applicant's specification (*See at least* Paragraphs 0022-23));

(f) ***an update module operatively associated with said server and said database which allows for the updating of oil and gas mineral interest data*** (*See at least* Figure 4B; Paragraph 0045; Sinclair discloses an "add deed" page that provides data fields for entering all of the respective information in each of the deed, including overview, conveyances, grantors, grantees, leases, wells and attachment sections. Sinclair further discloses that the data fields within the pages of the deed browsers are also editable by the user so that any information may be updated as necessary).

Sinclair does not explicitly disclose the remaining limitation. However, Cagan discloses ***a surveillance process module operatively associated with said server and said database which allows for the monitoring of owner and/or beneficiary oil and gas mineral interest data*** (*See at least* Paragraph 0013; Cagan discloses a computer-based method of updating a loan portfolio with information on secondary liens relating to a property of interest by monitoring a secondary lien database). Sinclair may be modified to include a mechanism to monitor mineral interest ownership data stored in a database as disclosed by Cagan. It would have been obvious to one of

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ordinary skill in the art at the time of the invention to include a mechanism to monitor mineral interest ownership data stored in a database as taught by Cagan in the system disclosed by Sinclair. As demonstrated by Cagan, it is within the capabilities of one of ordinary skill in the art to add a mechanism monitor mineral interest ownership data stored in a database to the system disclosed by Sinclair with the predictable result of tracking changes in the mineral interest ownership as needed in the Sinclair reference. See KSR, 127 S. Ct. 1727, 1739 (2007).

Neither the Sinclair reference nor the Cagan reference explicitly teaches ***wherein said standard number and standard organizational theme includes a plurality of code identifiers which include: (a) an original depositor code; (b) a serial number code; (c) a check digit; (d) a split number; and (e) an item number.*** However, examiner asserts that the limitation is merely a description of the standard number and organizational theme. It has been held that USPTO personnel need not give patentable weight to an additional instructional limitation absent a new and unobvious functional relationship between the limitation and the claimed method. See *MPEP* § 2111.05. As currently drafted, the description of the standard number and organizational theme (in this case, the content or digits comprising the standard number) does not functionally alter or explicitly impact the claimed method steps in a manner that distinguishes the claimed invention from the prior art in terms of patentability. The element is not positively recited as being used in any further steps, and therefore is simply descriptive of what is being provided. Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to further specify the content comprising

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the standard number and standard organizational theme because the described characteristic is not functionally related to the claimed method steps.

Although Sinclair discloses using reference numbers for land tracts and related documents (*See at least* Figure 7 (elements 706 and 708); Paragraph 0055; Sinclair discloses a graphical user interface that displays a deed indicator disclosing deed reference number), the references do not explicitly teach ***wherein the original depositor code, the serial number code and the check digit are used to identify an oil interest; wherein the original depositor code, the serial number code, the check digit identify and split number are used to identify divisions and splits an original oil and gas mineral interest; wherein the original depositor code, the serial number code, the check digit identify, the split number and the item number are used to identify an individual piece of data of an original oil and gas mineral interest.*** The examiner asserts that the limitations recite an intended use. In this case, the limitations recite using various combinations of the codes to identify an original oil and gas mineral interest. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ F.2d 1647 (1987).

16. With respect to claim 2: Although the proposed combination of Sinclair and Cagan references discloses the system of claim 1 wherein the system includes a server, neither reference expressly discloses ***wherein said server being a server selected from the group including an application server, a database server, a file***

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**server, a proxy server, a remote access server or a standalone server.** However, examiner asserts that the limitation is merely a description of the server provided. As currently drafted, the additional characteristic of the different types of servers that can be used is not positively recited as being used in any further operative steps of the system, and therefore is simply a description of what is being provided. Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include limitations regarding the different types of servers that can be used because the described characteristics are not functionally related to the claimed system's operation.

17. With respect to claim 3: Although the proposed combination of Sinclair and Cagan references discloses the system of claim 1 which includes a server that **permits a user to access the server and/or the one or more databases operatively associated with the server for storing oil and gas mineral interest data from a remote location over an open or closed computer network or the internet** (See at least Figures 1-4A; Paragraphs 0004 and 0036; Sinclair discloses a system for managing mineral interests, comprising at least one database for storing data records relating to oil / gas mineral interest and a server that enables generation of a graphical user interface in each browser at a plurality of locations over an open network), neither reference explicitly discloses that **the server is a remote access server.** However, examiner asserts that the limitation is merely a description of the server provided. As currently drafted, the additional characteristic of the type of servers that can be used is not positively recited as being used in any further operative steps of the system, and

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therefore is simply a description of what is being provided. Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include limitations regarding the type of servers that can be used because the described characteristics are not functionally related to the claimed system's operation.

18. With respect to claim 4: The proposed combination of Sinclair and Cagan references discloses the system of claim 1 ***wherein the oil and gas mineral data includes data selected from the group comprising: real property deeds (Le., general warranty deed, special warranty deed, quitclaim deed and the like), mineral interest related deeds, leases, contracts, operating agreements, pooling/unit agreements, government orders, conveyances, transfers, well records, and the like*** (See at least Paragraphs 0034 and 0038; Sinclair discloses that the oil and gas mineral interest management system acts as a central repository for managing information related to oil and gas mineral interests in a centralized fashion that enables users to obtain all types of information about various deeds, leases and wells from the centralized database repository).

19. With respect to claim 5: Although the proposed combination of Sinclair and Cagan references disclose the system of claim 1, neither reference expressly discloses ***wherein beneficiaries include any and all individuals or entities which have any legal interest in an oil and gas mineral interest***. However, examiner asserts that the limitation is merely a description of the server provided. As currently drafted, the additional characteristic of a beneficiary is not positively recited as being used in any further operative steps of the system, and therefore is simply a description of what is

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being provided. Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include limitations regarding the additional characteristic of a beneficiary because the described characteristics are not functionally related to the claimed system's operation.

20. With respect to claim 6: The proposed combination of Sinclair and Cagan references discloses the system of claim 1 ***wherein owners are granted access to all data related to their own oil and gas mineral interest and to all data related to the beneficiaries of the owner's oil and gas mineral interest through the access control module*** (See at least Paragraphs 0039, 0049-50; System management functionalities enable the operator of the oil and gas mineral interest management system to control the level of access of various users and/or customers).

21. With respect to claim 7: The proposed combination of Sinclair and Cagan references discloses the system of claim 1 ***wherein beneficiaries are granted access to only the data related to their own oil and gas mineral interest through the access control module*** (See at least Paragraphs 0039, 0049-50; System management functionalities enable the operator of the oil and gas mineral interest management system to control the level of access of various users and/or customers. Examiner further asserts that an owner and beneficiary is the same person under the broadest reasonable interpretation of the claim).

22. With respect to claim 8: The proposed combination of Sinclair and Cagan references discloses the system of claim 1 ***wherein the oil and gas mineral interest data of an owner and/or the oil and gas mineral data of a beneficiary may be***

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***entered into said system through the use of the oil and gas mineral interest data registration module*** (See at least Figures 7-13, 19-20, and 27; Paragraphs 0044, 0045, and 0082; Sinclair discloses an interface that allows users to enter various oil and gas interest data, wherein the data is transmitted via the internet and stored within the centralized database).

23. With respect to claim 9: The proposed combination of Sinclair and Cagan references discloses the system of claim 1 ***wherein said data standardization module may assign codes for data such as the original beneficiary, the agreement type, the year the agreement was executed, a system generated serial number, a check digit, a split number, or a combination thereof*** (See at least Figure 7 (elements 706 and 708); Paragraph 0055; Sinclair discloses a graphical user interface that displays a deed indicator disclosing deed reference number).

24. With respect to claim 10: Claim 10 recites the same limitations as claim 1. Thus, the arguments applied to claim 1 also apply to claim 10.

25. With respect to claim 11: Claim 11 recites the same limitations as claim 2. Thus, the arguments applied to claim 2 also apply to claim 11.

26. With respect to claim 12: Claim 12 recites the same limitations as claim 3. Thus, the arguments applied to claim 3 also apply to claim 12.

27. With respect to claim 13: Claim 13 recites the same limitations as claim 4. Thus, the arguments applied to claim 4 also apply to claim 13.

28. With respect to claim 14: Claim 14 recites the same limitations as claim 5. Thus, the arguments applied to claim 5 also apply to claim 14.



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29. With respect to claim 15: Claim 15 recites the same limitations as claim 6. Thus, the arguments applied to claim 6 also apply to claim 15.

30. With respect to claim 16: Claim 16 recites the same limitations as claim 7. Thus, the arguments applied to claim 7 also apply to claim 16.

31. With respect to claim 17: Claim 17 recites the same limitations as claim 8. Thus, the arguments applied to claim 8 also apply to claim 17.

### ***Response to Arguments***

32. Applicant's arguments filed June 22, 2015, have been fully considered but they are not persuasive.

33. **With respect to the 101 Rejection:** The applicant challenges the 101 rejections of claims 1-17 and 19. Specifically, the applicant argues the examiner's observation that "the implementing steps are carried out on nothing more than a generic computer" are at odds with MPEP § 2106(II)(B)(1)(a) and should be disregarded. The applicant also contends the claims include elements that amount to something significantly more because they are directed to a particular practical application of an abstract idea. The examiner disagrees.

A proper rejection under 35 U.S.C. §101 requires a two-part analysis: (1) A determination whether the claim is directed to a judicial exception (i.e., a law of nature, a natural phenomenon or an abstract idea), and (2) A determination of whether any element, or combination of elements, in the claim amounts to significantly more than the abstract idea itself. Interim Guidance on Patent Subject Matter Eligibility, 79 Fed. Reg.

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74619, 74622-74624 (Dec. 16, 2014) (to be codified at 37 C.F.R. pt. 1) [hereinafter Interim Guidance]. In this case, the claims are not patent eligible because they are directed to an abstract idea without significantly more.

**(A) Are the claims directed to an abstract idea?**

The independent claims 1 and 10 are directed to an abstract idea. The “registering an owner of an oil and gas mineral interest...,” “registering one or more beneficiaries...,” “granting one or more levels of access to owners and/or beneficiaries...,” “registering oil and gas mineral interest data...,” “generating and granting a stand number...,” “updating the oil and gas mineral interest data...,” and “monitoring the owner and/or beneficiary oil and gas mineral interest data using a surveillance process module...” broadly describe a method for registering ownership information in a data record for storage in a database. Registering ownership information in a database is processing information through a clearinghouse, which the Federal Circuit has previously characterized as an abstract idea. *See id. at 74622* (citing *Dealertrack, Inc. v. Huber*, 674 F.3d 1315 (Fed. Cir. 2012)).

**(B) Do the claims recite features that amount to something significantly more than the abstract idea?**

Claims directed to an abstract may still be patent eligible if they include limitations that qualify as something more than the abstract such as improvements to another technology or technical field, the addition of unconventional steps confining the claim to a particular useful application, or other meaningful limitations beyond generally

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linking the use of the judicial exception to a particular technological environment. *Id.* at 74624.

The claims at issue do not include limitations that qualify as something significantly more. Instead, they simply recite a method for registering information (ownership, beneficiary, and interest) in a database, wherein the method steps are performed by a generic computer previously known to the industry. For example, claim 1 recites "a server, one or more databases operatively associated with said server for storing oil and gas mineral interest data, [and] one or more computer terminals operatively associated with said server and said database." The applicant's specification explicitly teaches the server, database and computer terminal components are already well-known by those having ordinary skill in the art:

Servers, as used herein, describes a computer or a series of computers.... Servers within this system function as understood by those having skill in the art. A server may be a computer dedicated to run one or more services, to serve the needs of various users of other computers on the network.... Database, as described herein, refers to an organized collection of data which stored within or on some form of computer readable storage medium (i.e., a hard drive, flash drive, magnetic storage medium, optical disk etc.).... Computer terminal, as described herein, refers to a device which is well known in the art. A computer terminal may include a personal computer, a general purpose computer, a workstation, a smart phone, a tablet, or a combination thereof. Paragraphs 0014-16.

Merely executing a software program or function using a generic computer is not enough to qualify the applicant's invention as patent eligible subject matter. The computer implementation must supply the necessary inventive concept. *See Alice Corporation Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347, 2357-58 (2014) (citing, in part, *Gottschalk v. Benson*, 409 U.S. 63, 64-67 (1972)). In this case, neither the

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claims nor the specification teaches the generic computer provides an inventive concept or limits the recited method steps to be performed by specific hardware. Citing MPEP § 2106(II)(B)(1)(a), the applicant argues the use or programming of generic computers is irrelevant to subject matter eligibility analysis. However, the analytical framework established by the *Alice* decision supersedes MPEP 2106(II)(A) and 2106(II)(B). See USPTO Preliminary Examination Instructions in view of the Supreme Court Decision in *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*

Furthermore, the examiner disagrees with applicant's contention that a particular application of a judicial exception constitutes patent eligible subject matter. The Federal Circuit rejected a similar argument in *Dealertrack*. Like the applicant here, Dealertrack asserted its claim was "patent eligible because it covered the use of a clearinghouse only in the car loan application process, and not all uses thereof." 674 F.3d 1315, 1334 (Fed. Cir. 2012). The Federal Circuit noted that such distinctions, without something more, were not consequential in subject matter eligibility analysis. *See id.* (citing footnote 14 in *Diamond v. Diehr, 450 U.S. 175, 192 n. 14* (1981): "A mathematical formula does not suddenly become patentable subject matter simply by having the applicant acquiesce to limiting the reach of the patent for the formula to a particular technological use.").

34. **With respect to the §103 rejections of claims 1-17:** The applicant argues the claimed invention is patentable because the cited prior art does not explicitly disclose a standard number and standard organizational theme that includes a plurality of code identifiers which include:

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(a) an original depositor code; (b) a serial number code; (c) a check digit; (d) a split number; and (e) an item number; wherein the original depositor code, the serial number code and the check digit are used to identify an oil interest; wherein the original depositor code, the serial number code, the check digit identify and the split number are used to identify divisions and splits of an original oil and gas mineral interest; wherein the original depositor code, the serial number code, the check digit identify, the split number and the item number are used to identify an individual piece of data of an original oil and gas mineral interest

The examiner disagrees. The examiner defines a standard number and organizational theme, as recited in the claims, to include a number or code that uniquely identifies a data record in a database under the broadest reasonable interpretation of the claim.

This interpretation is consistent with the applicant's specification. The applicant's specification teaches the disclosed system utilizes a Quick Serial Identifier for Producing Properties (QSIPP), which "globally and uniquely identifies oil and gas assets and the data associated with each asset" (Figure 4 and Paragraphs 0022-23). Sinclair describes a system for managing mineral interests that includes a database for storing records and a graphical user interface that enables the creation and editing of data records relating to oil and gas mineral interests. Sinclair additionally teaches each data record may be uniquely identified by an auto-generated Deed Identifier and/or Deed Number (*See at least* Figures 7 (elements 706 and 708) and 14; Paragraphs 0054-56). The applicant's QSIPP and Sinclair's deed identifier both perform the same function of uniquely identifying a data record in a database.

Although the examiner concedes that the cited references do not explicitly teach the above limitations regarding the codes or the various combinations of codes, the examiner asserts these limitations do not patentably distinguish the claimed invention

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over the prior art because they merely recite additional descriptions of the standard number and organizational theme (Figure 4; Paragraphs 0023-26). It has been held that USPTO personnel need not give patentable weight to an additional instructional limitation absent a new and unobvious functional relationship between the limitation and the claimed method. See *MPEP* § 2111.05. As currently drafted, the description of the standard number and organizational theme (in this case, the content or digits comprising the standard number) does not functionally alter or explicitly impact the claimed method steps in a manner that distinguishes the claimed invention from the prior art in terms of patentability. The element is not positively recited as being used in any further steps, and therefore is simply descriptive of what is being provided. Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to further specify the content comprising the standard number and standard organizational theme because the described characteristic is not functionally related to the claimed method steps.

The examiner further argues the limitations, particularly those reciting the various combinations of the original depositor code, the serial number code, the check digit, split number and item number, could also be interpreted as reciting different labels for data. Though the labels may relate to the meaning and information conveyed through the labels (i.e., the specific type of information), they do not add anything to the method steps or system modules that would serve to distinguish the claimed invention over the prior art. In this case, the applicant's specification, claims and remarks fail to teach how the information identified by the various code combinations would change how the

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system would perform the basic function of using reference numbers to identify and locate a data record in a database any differently from what is currently taught in the prior art.

Finally, the examiner reiterates the claimed invention is not patentably distinct over the prior art because the limitations, "wherein the original depositor code, the serial number code and the check digit are used to identify an oil interest; wherein the original depositor code, the serial number code, the check digit identify and the split number are used to identify divisions and splits of an original oil and gas mineral interest; wherein the original depositor code, the serial number code, the check digit identify, the split number and the item number are used to identify an individual piece of data of an original oil and gas mineral interest," simply recite an intended use. In this case, the limitations recite using various combinations of the codes to identify an original oil and gas mineral interest. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ F.2d 1647 (1987).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHNATHAN LINDSEY III whose telephone number is (571)270-3986. The examiner can normally be reached on M-F 7:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on 571-272-6782. 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.

/J. L./  
Examiner, Art Unit 3629

/LYNDA JASMIN/  
Supervisory Patent Examiner, Art Unit 3629