UNITED STATES PATENT AND TRADEMARK OFFICE

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Kunzler, PC.
50 W. Broadway
10th Floor
SALT LAKE CITY, UT 84111

EXAMINER
REFAI, RAMSEY

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte HELENA C. BURTON, BRIAN D. CLARK,
JUAN A. CORONADO, BETH A. PETERSON,
and RICHARD A. RIPBERGER

_____

Appeal 2017-007616
Application 12/834,692[1]
Technology Center 3600

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Before HUBERT C. LORIN, NINA L. MEDLOCK, and
BRADLEY B. BAYAT, *Administrative Patent Judges.*

LORIN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Helena C. Burton et al. ("Appellants") seek our review under

35 U.S.C. § 134(a) from the Final Rejection of claims 1–6, 8–11, and 14–20.

We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

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[1] The Appellants identify International Business Machines Corporation as
the real party in interest. App. Br. 2.

THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. An apparatus for generating an advanced function usage planning report, the apparatus comprising:

a storage controller managing data storage on one or more storage devices;

a detection module configured to detect use of an advanced function on the storage controller in response to the storage controller accessing a logical volume of a storage device assigned to the advanced function, the advanced function being one of a plurality of advanced functions available on the storage controller, the advanced function comprising an optional storage operation of the storage controller, the advanced function beyond a standard function set of the storage controller;

an initialization module configured to initialize a predefined monitoring routine separately for each advanced function of the plurality of advanced functions, a monitoring routine for a particular advanced function being defined by one or more monitoring parameters for the particular advanced function;

a monitoring module configured to monitor the use of the advanced function on the storage controller according to the predefined monitoring routine, the monitoring module configured to monitor characteristics particular to the advanced function, the characteristics comprising one or more of defined device pair characteristics, defined relationship characteristics, and Parallel Access Volumes ("PAV") base volume characteristics, the monitoring module

>>> monitoring actual storage used based on the
advanced function, the predefined
monitoring routine defining one or more
alert thresholds associated with the
advanced function;
>> an alert module configured to generate one or more
alerts based on one or more of the monitored
use and a user attempting to use an advanced
function, wherein the alert module generates
an alert in response to the storage controller
reaching an alert threshold for the advanced
function defined by the monitoring routine;
and
>> a planning report module configured to generate a
planning report based at least in part on the
actual storage used.

THE REJECTIONS

The following rejections are before us for review:

Claims 1–6, 8–11, and 14–20 are rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

Claims 1–6, 8–11, and 14–20 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

ISSUES

Did the Examiner err in rejecting claims 1–6, 8–11, and 14–20 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter; and did the Examiner err in rejecting claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement?

ANALYSIS

The rejection of claims 1–6, 8–11, and 14–20 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

Alice Corp. Pty. Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under §101.

According to *Alice* step one, "[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept," such as an abstract idea. *Id.* at 2355.

In that regard, the Examiner determined that "[t]he claims are directed to the concept of *generating usage planning report* which is a method of organizing human activities and an idea of itself." Final Act. 4.

The Appellants argue that "the claims at issue, viewed as an ordered combination, provide a specific improvement to existing computer storage technology that should not be dismissed at the high level of abstraction put forward by the Office Action." App. Br. 7 (citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016)).

The court in *Enfish* put the question as being "whether the focus of the claims is on [a] specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an 'abstract idea' for which computers are invoked merely as a tool." *Enfish*, 822 F.3d at 1335–1336. The court found that the "plain focus of the claims" was on "an improvement to computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity." *Id.* at 1336.

From a plain reading of claim 1, we see the abstract idea identified by the Examiner recited in the preamble ("generating an advanced function

usage planning report"). *See Two-Way Media Ltd. v. Comcast Cable Communications, LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017) ("First, we see no error here in the district court citing to the preamble in its review of whether the claims are directed to an abstract idea. *See, e.g., Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016) (citing preamble for distillation of abstract idea). The district court's inquiry centered on determining the 'focus' of the claims, and was thus in accord with our precedent. *E.g., Elec. Power Grp.* [*LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)].")

The "directed to" inquiry in the claims applies a stage-one filter to the claims, considered in light of the Specification, based on whether "their character as a whole is directed to excluded subject matter." *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015); *see also Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016); *Enfish*, 822 F.3d at 1335 (Inquiring into "the focus of the claimed advance over the prior art.").

Here, the Appellants' Specification[2] discloses that the invention "particularly relates to generating an advanced function usage planning report." Spec. ¶ 1. By way of background, the Specification explains that "storage controllers offer advanced functionality that allows a user to perform tasks beyond standard data storage" and "these advanced functions [are] often separately licensed to the user." Spec. ¶ 2. According to the Specification, the problem solved by the invention is as follows:

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[2] The Appellants' Specification is entitled "GENERATING AN ADVANCED FUNCTION USAGE PLANNING REPORT."

> Typically, advanced functions are licensed to the user based on
> the user's anticipated need. Thus, if a user over anticipates
> advanced function use, the user will waste money on unused
> advanced function capacity. If a user under-anticipates
> advanced function use, the user may lack the advanced function
> capacity for required tasks.

Id. See also, id. ¶ 70 ("If the user under-plans, the user will not have the

advanced function capacity to perform desired advance functions. If the

user over-plans, the user has paid for unused advanced function capacity.").

According to the Specification, the invention helps solve this problem by

generating an advanced function usage planning report. *Id.* ¶ 3. With the

advanced function usage planning report, "a user may see which advanced

functions are used, how much advanced function capacity each advanced

function uses, and the like to facilitate better planning and licensing of

advanced functions." *Id.* ¶ 73.

In this case, we find that claim 1, as a whole, is focused on generating

an advanced function usage planning report, i.e., a report that contains

information to facilitate better planning and licensing of advanced functions.

Generating an advanced function usage planning report to facilitate better

planning and licensing of advanced functions is an economic task similar to

abstract ideas identified by our reviewing court. "[W]e have recognized

that merely presenting the results of abstract processes of collecting and

analyzing information, without more (such as identifying a particular tool for

presentation), is abstract as an ancillary part of such collection and analysis."

Elec. Power Grp., LLC v. Alstom S.A., 830 F.3d 1350, 1354 (Fed. Cir. 2016)

(collecting cases). *See also, FairWarning IP, LLC v. Iatric Sys., Inc.*,

839 F.3d 1089, 1094 (Fed. Cir. 2016) ("the claims here are directed to

collecting and analyzing information to detect misuse and notifying a user
when misuse is detected.").

We have reviewed all the arguments as to the step one determination
but do not find them persuasive as to error in the determination that claim 1
is directed to an abstract idea.

Step two of the *Alice* framework is "a search for an 'inventive
concept'—*i.e.*, an element or combination of elements that is 'sufficient to
ensure that the patent in practice amounts to significantly more than a patent
upon the [ineligible concept] itself.'" *Alice*, 134 S. Ct. at 2355 (alteration in
original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*,
566 U.S. 66, 72–73 (2012)).

In that regard, the Examiner determined that the additional
"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." Final Act. 4.

The Appellants argue, *inter alia*, that "the claims at issue recite an
improvement to a technology or technical field – namely detecting and
monitoring use of advanced storage functions of a storage controller *on a
per advanced storage function basis*." App. Br. 8. In particular, the
Appellants contend that "the advanced functions are tied to a particular
storage device and can be detected by the detection module when the storage
controller accesses the logical volume assigned to the advanced function."
Id. According to the Appellants, "this provides an efficient way to detect
use of an advanced function (e.g., only when the portion of the logical
volume assigned to the advanced function is accessed) instead of requiring

continuous detected use of an advanced function, characteristics of the advanced function, or the like, which improves the manner in which use of the advanced function is detected." *Id.*

Responding to the Appellants' arguments in the Answer, the Examiner determines that "these 'additional limitations' perform basic computer functions of retrieving, storing, manipulating, and processing data, which are well-understood, routine and conventional." Ans. 3. According to the Examiner, the Specification does not disclose an improvement to computer technology, and "[a]t best, the improvement is related to the abstract idea of generating a usage planning report." *Id.* at 4. The Examiner does not substantively address the Appellants' argument that assigning logical volumes to advanced functions provides a more efficient way to detect use of an advanced function.

The evidence of record weighs more in favor of the Appellants' view that the claims include significantly more than the abstract idea of generating an advanced function usage planning report.

The Appellants' Specification describes assigning logical volumes to advanced functions as a feature that is separate and distinct from generating a planning report. *See* Spec. ¶ 65 ("A user may assign or associate a logical volume or portion of a logical volume (an extent) of a storage device with an advanced function."); ¶ 81 ("the detection module 420 detects use of a particular advanced function in response to the storage controller 230 accessing at least a portion of a logical volume (such as one or more extents) associated with and/or assigned to the particular advanced function."). Claim 1 contains limitations directed to the arguably inventive concept described in the Specification, namely "a detection module configured to

detect use of an advanced function on the storage controller in response to the storage controller accessing a logical volume of a storage device assigned to the advanced function." App. Br. 13 (Claims App.). Independent claims 8 and 16 contain similar limitations.

In this case, given the discussion in the Specification and that the Examiner has not put forward an opposing detailed reasoning or evidence (other than to say that the invention employs basic computer functions (Ans. 3)), we find the record weighs in favor of finding that "the claims recite an invention that is not merely the routine or conventional use of" computer technology. *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1259 (Fed. Cir. 2014).

For that reason, we find the additional elements in the claims transform the nature of the claim into a patent-eligible application.

Accordingly, the rejection is not sustained.

The rejection of claims 1–6, 8–11, and 14–20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The Examiner determined that "[n]ewly amended limitation '*an initialization module configured to initialize a predefined monitoring routine*' does not appear to be supported by the original disclosure." Final Act. 5.

The Appellants have not provided a substantive response to this rejection. *See* App. Br. 2–12; Reply Br. 2–6. Accordingly, the rejection is summarily affirmed. *See* 37 C.F.R. § 41.37(c)(1)(iv).

CONCLUSIONS

The rejection of claims 1–6, 8–11, and 14–20 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter is reversed.

The rejection of claims 1–6, 8–11, and 14–20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is affirmed.

DECISION

The decision of the Examiner to reject claims 1–6, 8–11, and 14–20 is affirmed.

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