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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT E. DOWNING

Appeal 2017-010103¹
Application 12/454,528
Technology Center 3600

Before MICHAEL C. ASTORINO, BRADLEY B. BAYAT, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

FINAMORE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant appeals from the Examiner's decision to reject of claims 1, 2, 7, and 8. We have jurisdiction under § 6(b).

We AFFIRM.

¹ Our Decision references Appellant's Specification ("Spec.," filed May 19, 2009) and Appeal Brief ("Br.," filed Apr. 26, 2017), as well as the Examiner's Final Office Action ("Final Act.," mailed Feb. 27, 2017) and Answer ("Ans.," mailed May 24, 2017).

SUBJECT MATTER ON APPEAL

The invention is directed to “[a] method and electronic integrated model generically facilitating efficiency with diffusion-based prognostics of operations, short-long term planning, risks, and impacts.” Spec., Title. Claim 1, reproduced below, is the sole independent claim on appeal and is representative of the claimed subject matter:

1. A resource planning forecast product operable in a computer and recorded on a non-transitory computer-readable medium for retrieval interlinking non-business or business information relevant to the end user without mandatory reliance on a network or another computer file or Internet access to operate wherein the product is produced by processes of:

(a) designing a diffusion-based proprietary forecasting technique on an Excel computer platform for operation within a resource planning framework to: (1) simplify forecasting initialization with defaults option and exclusion of advanced statistical requirements in forecasting, (2) consider social and technological change, (3) make forecasts of operations and development and strategic plans of 1-5-15 years simultaneously, and (4) provide automatic updates reducing manual operations and storage requirements such that this process taken in combination improves the end user’s ease of operation and assessments;

(b) structuring presentations on the same computer platform by linking display of the forecasted data with features of: (1) additional resource planning applications beyond the typical such as an information resource utility and intangibles, (2) adjacent display of the operations and development and strategic plans’ 1-5-15 year forecasts, and (3) comprehensive print views available simultaneously of forecasted activity reports, resource plans, and yearly performance next 15 years such that this process taken in combination expands the utility of resource planning in the field of forecasting; and

(c) constructing one-time settings for the structure, on the same computer platform, for the capability of accommodating the full extent of resource planning cited and more efficient operation by: (1) fixed display of self-explanatory instructions and definitions, (2) only 4 required settings of initializing diffusion indices, starting calendar date, non-financial or financial mode, and the names for activity reports, resource plans, and optional information reports, and (3) optional settings related to goals-objective-missions, allocations, and risk-impact data such that this process taken in combination improves the end users' ease of use and availability of forecasted resource planning applications;

such that this product's capabilities and features accommodate the full extent of resource types and resource planning (encompassing the five categories of planning noted) for operation by non-technical or technical users in one unbundled computer file through end user interaction with displays.

Br., Claims App.²

² The claims in the Claims Appendix of the Appeal Brief are different from the claims pending prior to this appeal, namely the claims filed on January 17, 2017. The prior claims included typographical errors, and the Examiner objected to the claims for including these errors. Final Act. 2. In addition to other changes, Appellant corrected the typographical errors in the claims in the Claims Appendix, and the Examiner withdrew the claim objections. Ans. 2. As such, we understand that the Examiner has entered the claims set forth in the Claims Appendix, and we consider the claims in the Claims Appendix to be the claims on appeal, which is consistent with Appellant's understanding of the claims on appeal (Br. 4).

REJECTIONS³

The Examiner rejects the claims on appeal as follows:

claims 1, 2, 7, and 8 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement;

claims 1, 2, 7, and 8 under 35 U.S.C. § 112, second paragraph, as indefinite; and

claims 1, 2, 7, and 8 under 35 U.S.C. § 101 as non-statutory subject matter.

³ In addition to rejecting the claims, the Examiner objects to the Specification under 37 C.F.R. § 1.71 as being incomprehensible. Final Act. 3. Compliance with § 1.71 is a matter reviewable by petition to the Director under 37 C.F.R. § 1.181, not an appealable matter, and therefore not before us on appeal. *See, e.g., In re Hengehold*, 440 F.2d 1395, 1403 (CCPA 1971) (“There are a host of various kinds of decisions an examiner makes in the examination proceeding—mostly matters of a discretionary, procedural or nonsubstantive nature—which have not been and are not now appealable to the board.”). The Examiner also objects to the Specification for introducing new matter into the disclosure. Final Act. 3. Although the requirement to cancel new matter from the Specification is a petitionable matter (MPEP § 1002.02(c)(3)(b) (9th ed. Rev. 08.2017, Jan. 2018)), the Board may review adverse decisions of examiners which “relate, at least indirectly, to matters involving the rejection of claims.” *In re Hengehold*, 440 F.2d at 1404; MPEP § 2163.06(II) (“If both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition.”). Here, the new matter in the Specification also is recited in the claims and relates to the rejection of the claims under 35 U.S.C. § 112, first paragraph. Therefore, we consider the Examiner’s objection to the Specification for including new matter concurrently with this rejection on appeal.

ANALYSIS

Written Description

As noted previously, the Examiner finds that both the claims and the Specification include new matter. More specifically, the Examiner finds the claims contain subject matter that is not sufficiently described in the original disclosure and rejects the claims under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Final Act. 4. The Examiner similarly finds the present Specification⁴ includes new matter that is not supported by the original disclosure and objects to the Specification accordingly. *Id.* at 3–4. Although the Examiner refers to certain subject matter in the Specification as new matter, this subject matter is related to the claimed subject matter. We consider this subject matter as claimed subject matter, and determine whether the original disclosure provides written description support for the claimed subject matter. Therefore, our determination with respect to the Examiner’s rejection of the claims under 35 U.S.C. § 112, first paragraph, is dispositive as to the corresponding objection to the Specification.

According to our reviewing court:

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

⁴ The present Specification is the Specification as amended on January 17, 2017. Although the Examiner has objected to the amended Specification, the amendments are entered.

In re Kaslow, 707 F.2d 1366, 1375 (Fed. Cir. 1983) (citations omitted). The court also has explained that “[t]he content of the drawings may also be considered in determining compliance with the written description requirement.” *Id.*

Here, the Examiner finds paragraphs 16–19 of the present Specification are new matter. Final Act. 4. In contrast, Appellant argues that the amendments to the disclosure clarify the invention and do not introduce new subject matter. Br. 15–16.

At the outset, we note the subject matter of paragraphs 16–19 is likewise set forth in steps (a)–(c) of independent claim 1, so we consider whether the original disclosure⁵ reasonably conveys to an artisan that the inventor had possession of the subject matter of steps (a)–(c). Step (a) of independent claim 1 describes “designing a diffusion-based proprietary forecasting technique on an Excel computer platform for operation with a resource planning framework” to accomplish certain objectives. Paragraph 13 of the original Specification describes a diffusion-based projection process. Paragraph 13 also describes the computer program as a spreadsheet workbook coded on eight sheets, and original paragraph 11 describes the drawings as electronic spreadsheets.

Step (b) describes “structuring presentations on the same computer platform by linking display of the forecasted data” with certain features. Original claim 1, for example, recites a “single-source (Workbook) integrated generic planning model as a unit,” and original claim 3,

⁵ The original disclosure is the Specification, including the claims, abstract, and drawings, and the computer program listing filed on May 19, 2009.

depending therefrom, recites “preset generic structure for up to 32 simultaneous activities, plans, projects, or programs.” Spec. 5.

Step (c) describes settings. Figure 5 of the original drawings depicts step 3Ca called “Settings,” and Figure 5 shows various substeps further describing step 3Ca.

As such, the original disclosure reasonably conveys to an artisan that Appellant had possession of at least some of the subject matter of steps (a)–(c). Therefore, the Examiner has not sufficiently shown that steps (a)–(c) in their entirety lack written description support.

The Examiner also finds the limitation of independent claim 1 reciting “constructing one-time settings for the model’s structure . . . by using only 4 required settings” lacks support in the original disclosure. Final Act. 4. Appellant argues that steps 3Ca(1)–(4) in Figure 13 of the amended drawings filed January 17, 2017, provide written description support for this limitation. Br. 17–18. Appellant’s argument is persuasive.

Figure 13 of the amended drawings corresponds to Figure 5 of the original drawings. Indeed, steps 3Ca(1)–(4) of Figure 5 show four types of settings, but the Examiner does not provide reasoning why a person skilled in the art would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of these steps of Figure 5. As such, the Examiner has not shown sufficiently that the claim limitation “constructing one-time settings for the model’s structure . . . by using only 4 required settings” lacks support.

The Examiner further finds that the limitation “make forecasts of operations and development and strategic plans of 1-5-15 years simultaneously,” as recited in independent claim 1, is new matter.

Final Act. 3. Appellant argues that paragraph 13 of the original Specification and steps 2Ce–h, 3Dd–g, and 3Dm(1)(A)(i)–(2)(B)(v) of the drawings provide support for this limitation. Br. 13. Appellant also relies on the computer program listing appendix numbers 8–9, as well as page 66 of the amended drawings filed on September 14, 2009, which, according to Appellant, corresponds to computer program listing appendix number 9. *Id.* Appellant’s argument is convincing.

As Appellant points out, paragraph 13 of the original Specification discloses “planning periods of 1-5-15 years.” Furthermore, steps 2Ce–h of Figure 2 of the original drawings show estimations for 1-5-15 year periods, and steps 3Dd–g and 3Dm(1)(A)(i)–(2)(B)(v) of original Figure 7 also show estimations for 1-5-15 year periods. The Examiner does not address paragraph 13 of the original disclosure, nor the steps shown in Figures 2 and 7 of the original drawings. Accordingly, the Examiner has not sufficiently shown that the limitation “make forecasts of operations and development and strategic plans of 1-5-15 years simultaneously” lacks support.

The Examiner additionally finds that “intangibles (goodwill, barter, intellectual property)” constitutes new matter. Final Act. 3. We note independent claim 1 similarly recites “intangibles.”

Appellant contends there is support for “intangibles” in the original disclosure because “intangibles” is an accurate description of a line item in the “predefined master budget” described in the original Specification. Br. 13. Appellant also asserts that “intangibles” is a common category recognized in tax information for the “Gifts and Property” line item of the

“Master Personal Budget” shown on page 71 of the amended drawings.⁶ *Id.* at 13–14. Appellant’s arguments do not apprise us of Examiner error.

Although we agree with Appellant that the original disclosure recites a “predefined master budget,” the original disclosure does not describe “intangibles” as part of the “predefined master budget.” Furthermore, even if we agree with Appellant that gifts and property fall within the category of “intangibles,” this category also includes other types of assets. A person of ordinary skill in the art would not have understood Appellant’s disclosure of gifts and property as a disclosure of the entire category of “intangibles.” Consequently, there is insufficient support for “intangibles” in the original disclosure.

In view of the foregoing, the Examiner has not sufficiently shown that the following subject matter of independent claim 1 lacks written description: steps (a)–(c), i.e., paragraphs 16–19 of the present Specification; “constructing one-time settings for the model’s structure . . . by using only 4 required settings;” and “make forecasts of operations and development and strategic plans of 1-5-15 years simultaneously.” On the other hand, Appellant does not apprise us of error in the Examiner’s finding that the limitation of independent claim 1 reciting “intangibles,” i.e., “intangibles (goodwill, barter, intellectual property)” in the Specification, lacks written description. We therefore sustain the Examiner’s rejection of independent

⁶ Appellant refers to the amended drawings on September 7, 2011, but these drawings include only 68 pages. Page 71 of the amended drawings filed on September 14, 2009, depicts a “Master Personal Budget” including a line item entitled “Gifts and Property Acquired.” As such, we understand Appellant is referring to the amended drawings filed on September 14, 2009.

claim 1 and dependent claims 2, 7, and 8 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

Indefiniteness

The Examiner determines that several limitations render the claims indefinite. Final Act. 4–5. During prosecution, “[a] claim is indefinite when it contains words or phrases whose meaning is unclear.” *Ex parte McAward*, No. 2015-006416, 2017 WL 3669566, at *5 (PTAB Aug. 25, 2017) (alteration in original) (citing *In re Packard*, 751 F.3d 1307, 1310, 1314 (Fed. Cir. 2014)). With this standard in mind, we consider the disputed limitations.

The Examiner determines that the claims are indefinite because they contain long recitations. Final Act. 5 (citing MPEP § 2173.05(m)). Long recitations, however, are not necessarily unclear, and the Examiner does not explain how these long recitations in the claims are unclear. Absent such explanation, the Examiner has not shown that long recitations render the claims indefinite.

The Examiner also determines that it is unclear whether Appellant is claiming a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof. Final Act. 5. In contrast, Appellant argues it is clear that the claims are product-by-process claims. Br. 19–20. Appellant’s argument does not apprise us of Examiner error.

A product-by-process claim defines a product in terms of the process by which the product is made. *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985). Here, the claimed steps do not define how the product is made, but rather describe the functions performed by the product. For

example, the preamble of independent claim 1 recites a “resource planning forecast product operable in a computer and recorded on a non-transitory computer-readable medium,” and the body of the claims recites the steps of “designing a diffusion-based proprietary forecasting technique,” “structuring presentations,” and “constructing one-time settings.” The resource planning forecast product is not made by designing a diffusion-based proprietary forecasting technique, structuring presentations, and constructing one-time settings. Rather, the resource planning forecast product designs a diffusion-based proprietary forecasting technique, structures presentations, and constructs one-time settings. As such, independent claim 1 is not a product-by-process claim, and consequently, the limitation of independent claim 1 reciting “wherein the product is produced by processes of” is unclear.⁷

The Examiner further determines that the limitation reciting “operation within the resource planning framework” renders independent claim 1 unclear because there is insufficient antecedent basis for the resource planning framework. Final Act. 5. Independent claim 1 in the Claims Appendix of the Appeal Brief, which, as noted above, represents the claims

⁷ As an example, omitting this limitation from independent claim 1 and amending the preamble to recite that when executed by a computer, the resource planning forecast product causes the computer to perform the recited steps would make clear that the claimed subject matter is a product. *See In re McAward*, 2017 WL 3669566 at *4 (“[T]he patent drafter is in the best position to resolve . . . ambiguity in the patent claims, and it is highly desirable that patent examiners demand that applicants do so in appropriate circumstances so that the patent can be amended during prosecution rather than attempting to resolve the ambiguity in litigation.” (quoting *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008))).

on appeal, recites “operation within a resource planning framework” and therefore provides an antecedent basis for the resource planning framework.

The Examiner similarly determines that the limitation reciting “business information relevant to the end user” lacks sufficient antecedent basis for the end user and renders independent claim 1 indefinite.

Final Act. 5. On the other hand, Appellant points out that independent claim 1 actually recites “interlinking non-business or business information relevant to the [end] user,” and asserts that paragraph 15 of the present Specification describes types of users of non-financial applications. Br. 20. Appellant’s argument does not apprise us of Examiner error.

The Specification’s description of users of non-financial applications does not provide clarity for the term “the end user.” In accordance with the Specification and Appellant’s argument, the claimed invention can have different types of users, and it is unclear which user or which type of user is “the end user.”⁸

The Examiner further determines that the limitation of claim 2 reciting “establishing a resource planning framework through worksheet named by purpose on a computer” is unclear. Final Act. 5. Appellant points out that claim 2 actually recites “establishing a resource planning framework through the platform’s worksheets named by purpose” and argues that in view of paragraph 14 of the present Specification and the drawings, it is clear that the limitation means that the worksheets are named according to the purpose of each worksheet. Br. 20. We agree with Appellant.

⁸ Amending this limitation of independent claim 1 to recite “business information relevant to an end user” would provide an antecedent basis and resolve any certainty as to which entity is “the end user.”

In view of the foregoing, the Examiner has not shown that the long recitations of the claims are unclear. The Examiner also has not shown that the limitation of independent claim 1 reciting “operation within a resource planning framework” and the limitation of claim 2 reciting “establishing a resource planning framework through the platform’s worksheets named by purpose” are unclear. On the other hand, it is unclear what type of subject matter Appellant is claiming. More specifically, the limitation of independent claim 1 reciting “wherein the product is produced by processes of” is unclear. The limitation of independent claim 1 reciting “business information relevant to the end user” is also unclear. We therefore sustain the Examiner’s rejection of independent claim 1 and dependent claims 2, 7, and 8 under 35 U.S.C. § 112, second paragraph, as indefinite.

Non-Statutory Subject Matter

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). To “distinguish[] patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts,” the Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), which, in the first step, considers whether a claim is directed to a

patent-ineligible concept, e.g., an abstract idea, and, if so, considers, in the second step, whether the elements the claim, individually and as an ordered combination, recite an inventive concept—an element or combination of elements sufficient to ensure the claim amounts to significantly more than the abstract idea and transform the nature of the claim into a patent-eligible concept. *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 132 S. Ct. at 1294, 1296–98).

Here, in rejecting the claims under 35 U.S.C. § 101 as non-statutory subject matter, i.e., subject matter judicially-excepted from statutory subject matter, the Examiner analyzes the claims using this two-step analysis for determining patent-eligibility. Final Act. 5–7. More specifically, pursuant to the first step, the Examiner determines the claims are directed to the abstract idea of “creating an electronic spreadsheet for personal management.” *Id.* at 5. Under the second step, the Examiner determines that the claims do not recite elements amounting to significantly more than the abstract idea because the generically-recited computer elements perform functions that are routine, conventional, and well-understood to one of ordinary skill in the computer art. *Id.* at 6–7.

Appellant argues that the claims are directed to a product, and that “manufacture” is a patent-eligible statutory subject matter category under 35 U.S.C. § 101. Br. 20. Appellant’s argument does not apprise us of error. As set forth above, there are judicial exceptions to the statutory classes of patent-eligible subject matter recited in § 101. In other words, claimed subject matter may fall within one of the statutory classes set forth in § 101 and still be patent-ineligible as judicially-excepted subject matter. Even if we agree with Appellant that the claims are directed to a product, which falls

under the statutory class of “manufacture,” the Examiner is rejecting the claims as subject matter judicially-excepted from the statutory classes, namely an abstract idea.

Appellant further argues that, contrary to the Examiner’s characterization of the claims according to the first step of the patent-eligibility analysis, the claimed invention is not limited to personal management. Br. 21. According to Appellant, the claimed invention provides resource planning for a variety of users and uses. *Id.* at 21–22. Appellant’s argument is not persuasive of error.

In determining what the claims are directed to pursuant to the first step of the patent-eligibility analysis, our reviewing court has instructed that “the claims are considered in their entirety to ascertain 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) (emphasis added). Here, independent claim 1, for example, recites a resource planning forecast product and the steps of: (a) designing a diffusion-based proprietary forecasting technique; (b) structuring presentations by linking display of the forecasted data with certain features; and (c) constructing one-time settings for the capability of accommodating the full extent of resource planning. Whether the claim is characterized as personal management or, more broadly, resource planning, these characterizations describe the character of the claim as a whole. As such, Appellant’s argument does not apprise us of Examiner error, but simply suggests that the Examiner’s characterization of the claims is at a lower level of abstraction, i.e., a particular application of resource planning. *See Apple*,

Inc. v. Ameranth, Inc., 842 F.3d 1229, 1240 (Fed. Cir. 2016) (“An abstract idea can generally be described at different levels of abstraction.”).

Appellant also argues that the claims are not directed to an abstract idea because they are not directed to a mental process, fundamental economic practice, method of organizing human activity, mathematical algorithm, or an abstract idea of itself. Br. 27–28. We disagree.

The Federal Circuit has explained that when determining whether a claim is directed to an abstract idea, “the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.” *Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016). Personal management, and, more broadly, resource planning, are similar to concepts the courts have held to be abstract ideas, such as mitigating settlement risk in *Alice* and hedging in *Bilski v. Kappos*, 130 S. Ct. 3218 (2010). Like mitigating settlement risk and hedging, the concept of resource planning abates risk and is a fundamental economic practice long prevalent in our system of commerce. As such, Appellant’s argument does not apprise us of error in the Examiner’s determination that the claims are directed to an abstract idea.

Appellant further argues the claims are not directed to an abstract idea because the claimed product is new. Br. 21. Appellant’s argument is unconvincing because patentability over the prior art in accordance with 35 U.S.C. §§ 102 or 103 is not the test for patent-eligibility under § 101. *See, e.g., Diamond v. Diehr*, 101 S. Ct. 1048, 1058 (1981) (“The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within

the § 101 categories of possibly patentable subject matter.”); *see also* *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (“[A] claim for a *new* abstract idea is still an abstract idea.”).

Appellant additionally asserts that the claimed invention is not directed to an abstract idea, but rather to a new computer application software product. Br. 21–25. According to Appellant, as an application software product, the claimed functions embody a practical approach to unconventional resource planning and are more than the generic functions of control and operation of computer hardware. *Id.* at 25–27. Appellant’s argument is not persuasive of Examiner error.

Simply reciting a software application does not place a claim outside the realm of abstract ideas. That said, a claim directed to a computer application software product may be eligible under one or both of the steps of the patent-eligibility analysis. In regard to the first step, our reviewing court has held that claims directed to software that improves computer-related technology are not directed to an abstract idea. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). The present claims, however, are not directed to software that improves computer-related technology. As Appellant points out, the claimed invention is software for resource planning. Br. 25–26. Resource planning is not a computer function, and there is no indication in the record that resource planning software improves computer-related technology. As such, the claimed invention being resource planning software does not apprise us of error in the Examiner’s determination that the claims are directed to an abstract idea.

Apart from the first step, claims reciting software may be patent-eligible under the second step of the analysis. In particular, we consider whether the claimed invention requires something other than the generic computer implementation of the abstract idea under the second step of the analysis. *See, e.g., Alice*, 134 S. Ct. at 2358 (explaining that under the second step of the analysis, the generic computer implementation of an abstract idea is insufficient to transform a patent-ineligible abstract idea into a patent-eligible invention). Similarly, although novelty is not the test of patent-eligibility, novelty in the implementation of an abstract idea can affect patent-eligibility under the second step. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (“[N]ovelty in implementation of the idea is a factor to be considered only in the second step of the *Alice* analysis.”). Accordingly, we address Appellant’s arguments regarding to the computer implementation of the abstract idea and any novelty associated therewith under the second step of patent-eligibility analysis.

Turning to the second step of the analysis, Appellant argues that “[c]ompared to what is known and routine, conventional, and well-understood in the ordinary art, the [c]laims support a new product in resource planning. Br. 30. In doing so, Appellant points to several claimed features that are allegedly unconventional. *Id.* at 30–31. As set forth above, however, the question in the second step of the patent-eligibility analysis is not whether a claimed element is novel or non-obvious, but rather whether the implementation of the abstract idea involves “more than performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction & Transmission LLC v. Wells Fargo*

Bank, N.A., 776 F.3d 1343, 1347–48 (Fed. Cir. 2014) (alteration in original) (quoting *Alice*, 134 S. Ct. at 2359).

Here, there is no indication that the implementation of the claimed steps requires something apart from generic computing components performing routine and conventional computer functions, such as retrieving, processing, and displaying data. Rather, according to paragraph 21 of the present Specification, the claimed invention is implemented on an Excel 2003 platform, which is a known computer platform. As such, even if the claims recite a novel method for resource planning, we fail to see how the claimed invention is something other than a method for resource planning that is implemented on a generic computer using the conventional computer functions associated with Excel.

Furthermore, we appreciate that some of the claim limitations Appellant asserts are unconventional may represent a different computer implementation than prior resource planning products. For example, the claims recite one unbundled computer file for an Excel platform that does not require reliance on a network or another computer file or Internet access to operate. The claims also recite a defaults option and exclusion of advanced statistical requirements, as well as automatic updates reducing manual operations and storage requirements. The claims further recite linking the display of the forecasted data with certain features and constructing one-time settings for more efficient operation. Although using Excel may be a unique way to implement resource planning compared to the computer implementation of prior resource planning products, Excel is nonetheless a known and conventional computer platform. As such, we fail to see how the claimed invention is something other than the generic

computer implementation of the abstract idea via computer functions that are well-understood, routine, and conventional. Such a generic computer implementation is insufficient for patent-eligibility.

Appellant also argues that the claims recite an inventive concept. Br. 36–38. According to Appellant, “a tool providing the best use of resources over time is an inventive concept,” and “[i]mproving functionality in the field or improving [the] use of resources more efficiently across this field beyond the capabilities of existing tools and models clarifies the innovation.” *Id.* at 37. Appellant’s argument is not convincing.

Even if we agree with Appellant that the claimed invention is an improvement to resource planning, an improvement to resource planning, an abstract idea, is not an inventive concept. The Supreme Court has described an “inventive concept” as an element or combination of elements sufficient to transform the nature of the claim into a patent-eligible concept. *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 132 S. Ct. at 1294, 1297–98). An improvement to an abstract idea does not transform the nature of a claim into a patent-eligible concept. Limitations reciting such an improvement are not an inventive concept, but rather further describe the abstract idea.

Appellant further argues that claims recite practical solutions to the shortcomings of prior forecasting products. Br. 31–32. As set forth above, an improvement to the abstract idea of resource planning is not an inventive concept that transforms the nature of a claim into a patent-eligible concept. That said, the Supreme Court has explained that an improvement to the functioning of the computer itself is an inventive concept. *Alice*, 134 S. Ct. 2359. The Court has also explained that an inventive concept may lie with an improvement to another technology or technical field. *Id.*

Accordingly, we have considered whether the claimed invention improves the functioning of the computer itself or is an improvement to another technology or technical field, and we determine that it does not.

We are similarly unpersuaded of error by Appellant's identification of several additional claim limitations that could be considered significantly more than the abstract idea. Br. 32–36. We fail to see how these limitations result in the claimed invention being something other than the computer implementation of a resource planning method on a conventional Excel platform, which is insufficient to confer patent-eligibility.

In view of the foregoing, Appellant does not apprise us of error in the Examiner's determination that the claims are patent-ineligible as judicially-accepted from statutory subject matter. We therefore sustain the Examiner's rejection of claims 1, 2, 7, and 8 under 35 U.S.C. § 101.

DECISION

The Examiner's decision to reject claims 1, 2, 7, and 8 under 35 U.S.C. § 112, first paragraph, is affirmed.

The Examiner's decision to reject claims 1, 2, 7, and 8 under 35 U.S.C. § 112, second paragraph, is affirmed.

The Examiner's decision to reject claims 1, 2, 7, and 8 under 35 U.S.C. § 101, 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). 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED