

# EXHIBIT F



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28875	7590	09/09/2008	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			HOLMES, MICHAEL B	
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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.





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## Examiner's Detailed Office Action

1. This Office Action is responsive to communication, filed 06/26/2007.

### Information Disclosure Statement

2. Applicant is respectfully remind of the Duty to disclose 37 C.F.R. 1.56 all pertinent information and material pertaining to the patentability of applicant's claimed invention, by continuing to submitting in a timely manner PTO-1449, Information Disclosure Statement (IDS) with the filing of applicant's of application or thereafter.

### Drawings

3. The formal drawings submitted have been reviewed by the Office of Initial Patent Examination (OIPE) and/or the USPTO Office of Draftperson's Patent Drawings Review.

### Specification

4. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Appropriate correction is required.

## Claim Rejections - 35 USC § 101

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

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

6. The invention as disclosed in claims 1-15 are rejected under 35 U.S.C. § 101 as being non-statutory subject matter. *see In re Comiskey*, Case No. 2006-1286, at 8, 16-21, (Fed. Cir., September 20, 2007). “Only if the requirements of § 101 are satisfied is the inventor allowed to pass through to the other requirements for patentability, such as novelty under § 102 and, non-obviousness under § 103.” “Moreover, ... when an abstract concept has no claimed practical application, it is not patentable.”

7. *No preemption is permitted* i.e., when a claim is so broad that it reads on both statutory and nonstatutory subject matter, *it must be amended*. A claim that recites a computer that solely calculates a mathematical formula is not statutory. In other words, one may not patent a process that comprises every “substantial practical application” of an abstract idea, because such a patent in “practical effect would be a patent on the [abstract idea] itself.” Regarding claims 1-15 i.e., “a method capable of performing decision logic” would in fact cover virtually all decision logic. Nothing is specified in the claims to limit the invention to a particular application e.g., an Accounting systems; Alliance management systems; Asset management systems; Brand management systems; Budgeting/financial planning systems; Business intelligence systems; Call management systems; Cash management systems; Channel management systems; Commodity risk management systems; Content management systems; Contract management systems; Credit-risk management system Customer relationship management systems; Data integration

Art Unit: 2129

systems; Demand chain systems; Decision support systems; Document management systems; Email management systems; Employee relationship management systems; Energy risk management systems; Executive dashboard systems; Expense report processing systems; Fleet management systems; Fraud management systems; Freight management systems; Human capital management systems; Human resource management systems; Incentive management systems; Innovation management systems; Insurance management systems; Intellectual property management systems; Intelligent storage systems Interest rate risk management systems; Investor relationship management systems; Knowledge management systems; Learning management systems; Location management systems; Maintenance management systems; Material requirement planning systems; Metrics creation system; Online analytical processing systems; Ontology management systems; Partner relationship management systems; Payroll systems; Performance management systems; Price optimization systems; Process management systems; Product life-cycle management systems; Project management systems; Project portfolio management systems; Revenue management systems; Risk management information system Risk simulation systems; Sales force automation systems; Scorecard systems; Sensor grid systems; Service management systems; Six-sigma quality management systems; Strategic planning systems; Supply chain systems; Supplier relationship management systems; Support chain systems; Taxonomy development systems; Technology chain systems; Unstructured data management systems; Visitor (web site) relationship management systems; Weather risk management systems; Workforce management systems; or Yield management systems. Without clearly stating in the claim a particular application, it *preempts* all decision logic. Where as, the courts have also held that a claim may not preempt ideas, laws of nature or natural phenomena.

Art Unit: 2129

The concern over preemption was expressed as early as 1852. See Le Roy v. Tatham, 55 U.S. (14 How.) 156, 175 (1852) (“A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.”); See Funk Bros. Seed Co. v. Kalo Inoculant Co., 333 U.S.127, 132, 76 USPQ 280, 282 (1948).

8. The claims fail to provide a “useful, concrete or tangible result.” Moreover, there must be a practical application, by either (1) transforming (physical thing) or (2) by having the **FINAL RESULT** (not the steps) achieve or produce a “useful” (specific, substantial, AND credible), “concrete” (substantially repeatable/non-unpredictable), AND “tangible” (real world/non-abstract) result. Moreover, the claims are directed to an abstract idea rather than a practical application of an abstract idea which would produce a “useful, concrete or tangible results.” Accordingly, the claims fail to provide a practical application and is insufficient to establish a real world “tangible” result, *see In re Warmerdam*, 31 USPQ2d, 1354.

9. Devoid of such, applicant’s claimed invention is an abstract idea e.g., a computational model or a mathematical manipulation of a function or equation. A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might inherently have some usefulness. *see In re Sarkar*, 588 F.2d at 1335, 200 USPQ at 139, wherein the court explained why this approach must be followed:

No mathematical equation can be used, as a practical matter, without establishing and substituting values for the variables expressed therein. Substitution of values dictated by the formula has thus been viewed as a form of mathematical step. If the steps of gathering and substituting values were alone sufficient, every mathematical equation, formula, or algorithm having any practical use would be per se subject to patenting as a “process” under 101. Consideration of whether the substitution of specific values is enough to convert the disembodied ideas present in the formula into an embodiment of those ideas, or into an application of the formula, is foreclosed by the current state of the law.

Art Unit: 2129

10. A claim is limited to a practical application when the invention as claimed, produces a concrete, tangible and useful result; i.e., the invention recites a steps or a process or act of producing something that is concrete, tangible and useful. *See AT & T*, 172 F.3d at 1358, 50 USPQ2d at 1452. *See* MPEP § 2106(IV) The claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. Remember, the claims define the property rights provided by a patent, and thus require careful scrutiny. Therefore, it is not enough to set forth invention in the specification. The claims must also reflect the scope and breath of applicant’s invention. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551(CCPA 1969). The situation in this application appears to be more difficult since it does not appear that the practical application is contained within the specification.

### Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by *McAndrew et al.* (USPN 5,517,405).

Art Unit: 2129

Regarding claim 1.

*McAndrew et al.* describes a method, comprising: (a) executing an application capable of performing decision logic; (b) retrieving information from a database in accordance with the decision logic; (c) receiving information from a user in accordance with the decision logic utilizing a user interface; and (d) processing the information utilizing the decision logic; (e) (b)-(d) are carried out using universal modules capable of interfacing with different applications adapted for applying the universal modules to different business sectors.

[see Abstract; FIG. 1 & FIG. 2; C 5, L 50 to C 6, L 29]

Regarding claim 14.

*McAndrew et al.* describes a computer program product embodied on a computer readable medium, comprising: computer code for executing an application capable of performing decision logic; computer code retrieving information from a database in accordance with the decision logic; computer code for receiving information from a user in accordance with the decision logic; utilizing a user interface; computer code for processing the information utilizing the decision logic; and wherein collaborative decision making is carried out between the receiving business and the supplying business in real-time. [see Abstract; FIG. 1 & FIG. 2; C 5, L 50 to C 6, L 29]

Regarding claim 15.

*McAndrew et al.* describes a system, comprising: logic for executing an application capable of performing decision logic; logic for retrieving information from a database in accordance with the decision logic; logic for receiving information from a user in accordance with the decision logic utilizing a user interface; logic for processing the information utilizing the decision logic;

Art Unit: 2129

and wherein collaborative decision making is carried out between the receiving business and the supplying business in real-time. [see Abstract; FIG. 1 & FIG. 2; C 5, L 50 to C 6, L 29]

Regarding claims 2-13.

of which, are rejected under the same rationale as their respective base claim. [see Abstract; FIG. 1 & FIG. 2; C 5, L 50 to C 6, L 29]

## Double Patenting

13. Claims 1-15 of application 11/768,836 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,876,991. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or

Art Unit: 2129

claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

## Claim Interpretation

14. The claims and only the claims form the metes and bounds of the invention. “Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Moreover, limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541,550-551 (CCPA 1969)” (MPEP p 2100-8, c 2,145-48; p 2100-9, c 1,1 1-4).

15. The Examiner has full latitude to interpret each claim in the broadest reasonable sense. The Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

16. Examiner’s Notes are/if provided with the cited references to prior art to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the citations are self-explanatory to one skilled in the art and do not need any further explanation. Moreover, the Examiner’s Notes are not prior art but a link to prior art that one of ordinary skill in the art would find inherently or obviously appropriate.

Art Unit: 2129

17. Unless otherwise annotated, as aforementioned, Examiner's statements are to be interpreted in reference to that of one of ordinary skill in the art. Statements made in reference to the condition of the disclosure constitute, on the face of it, the basis and such would be obvious to one of ordinary skill in the art, establishing thereby an inherent or obviousness prima facie case or statement(s).

### Correspondence Information

18. Any inquires concerning this communication or earlier communications from the examiner should be directed to Michael B. Holmes, who may be reached Monday through Friday, between 8:00 a.m. and 5:00 p.m. EST. or via telephone at (571) 272-3686 or facsimile transmission (571) 273-3686 or email [michael.holmesb@uspto.gov](mailto:michael.holmesb@uspto.gov).

If you need to send an Official facsimile transmission, please send it to (571) 273-8300.

If attempts to reach the examiner are unsuccessful the Examiner's Supervisor, David Vincent, may be reached at (571) 272-3080.

Hand-delivered responses should be delivered to the Receptionist @ (Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located on the first floor of the south side of the Randolph Building.

Finally, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Moreover, 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

Art Unit: 2129

information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) toll-free @ 1-866-217-9197.

***Michael B. Holmes***

Primary Examiner

Artificial Intelligence

Art Unit 2129

United States Department of Commerce

Patent & Trademark Office

*Wednesday, September 03, 2008*

*MBH*

*/Michael B. Holmes/*

*Primary Examiner, Art Unit 2129*