

Office Action Summary	Application No. 11/045,543	Applicant(s) OWEN ET AL.	
	Examiner Michael B. Holmes	Art Unit 2121	

-- 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) MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, 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 10 September 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) 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

- 4) Claim(s) 1-88 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-88 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

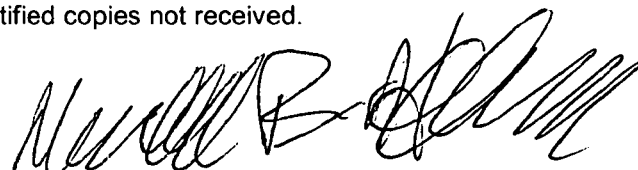
Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

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

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


Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>09/12/07&09/19/07&09/20/07e 09/27/07.</u> | 6) <input type="checkbox"/> Other: _____ |



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P.O. Box 1450, Alexandria, Virginia 22313-1450 – www.USPTO.GOV

Examiner's Detailed Office Action

1. This Office Action is responsive to communication received on 09/10/2007.
2. Amendment under 37 CFR § 1.111 reconsideration and allowance of application is respectfully requested by applicant.
3. Applicant's arguments have been fully considered, however, they are not persuasive.
4. Their rejection under 35 U.S.C. 101 stands.

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 1-88 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."

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 1-88 i.e., “a method which supports a decision making process,” would in fact cover virtually any and all forms of decision making process. Moreover, nothing is specified in the claims to limit the invention to a particular application e.g., a telecommunications system, a medical system, a supply chain system, etc.. Without clearly stating in the claim a particular application, it *preempts* all forms of clinical trials. Where as, the courts have also held that a claim may not preempt ideas, laws of nature or natural phenomena. 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).

Response to Argument(s)

8. As mentioned above, *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*. While applicant’s claimed invention may have a practical application directed to an industrial process e.g., a telecommunications system, a medical system, supply chain system, a business intelligence system, a call management system, a cash management systems, a contract management systems, a

credit-risk management system, etc.. Nothing is specified in the claims to limit the invention to a particular application capable of performing **decision logic**. Thus, it preempts all decision making processes.

Examiners Summary

9. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Correspondence Information

11. 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.

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

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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 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

Patent Examiner

Artificial Intelligence

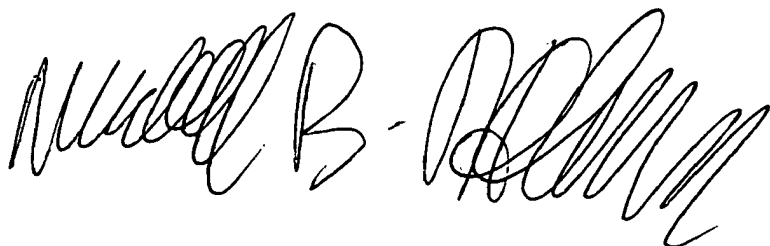
Art Unit 2121

United States Department of Commerce

Patent & Trademark Office

Tuesday, November 20, 2007

MBH

A handwritten signature in black ink, appearing to read "Michael B. Holmes", written in a cursive style.

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Office Action Summary	Application No. 11/045,543	Applicant(s) OWEN ET AL.	
	Examiner Michael B. Holmes	Art Unit 2121	

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Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE (3) MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, 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 01 June 2007.
- 2a) This action is FINAL.
- 2b) This action is non-final.
- 3) 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

- 4) Claim(s) 1-88 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-88 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

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).
 - a) All b) Some * c) None of:
 - 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) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 06/04/2007.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.



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Examiner's Detailed Office Action

1. This Office Action is responsive to communication 06/01/2007.
2. Claims 1-88 have been examined.

Claim Rejections - 35 USC § 101

3. 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.

4. The invention as disclosed in claims 1-88 are rejected under 35 U.S.C. 101 as being non-statutory subject matter.

5. *No preemption is permitted* i.e., 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. In other words claims 1-88 i.e., “a method, system and computer program product for performing a collaborative decision platform” would in fact cover virtually any and all forms of applications performing **decision logic**. In other words, nothing is specified in the claims to limit the invention to a particular application. Thus, it *preempts* all forms of applications performing **decision logic**.

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6. Regarding claim 58 software modules devoid of any apparent hardware, and therefore are computer programs e.g., functional descriptive material. Moreover, since the computer programs are not embodied on an appropriate computer-readable storage medium. They are not patent eligible subject matter in accordance with *In re Warmerdam*, 31 USPQ2d, 1354. Furthermore, as mentioned above, the software modules as claimed does not produce any tangible result that has a practical application i.e., merely manipulating data not tied to the real-world is not patent eligible subject matter, *see In re Warmerdam*, 31 USPQ2d, 1354.

Correspondence Information

7. 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.

If you need to send an Official facsimile transmission, please send it to (703) 746-7239.

If attempts to reach the examiner are unsuccessful the Examiner's Supervisor, Anthony Knight, may be reached at (571) 272-3687.

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

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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 any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) toll-free @ 1-866-217-9197.

Michael B. Holmes

Patent Examiner

Artificial Intelligence

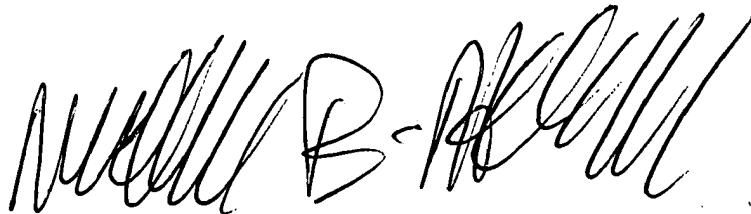
Art Unit 2121

United States Department of Commerce

Patent & Trademark Office

Tuesday, August 7, 2007

MBH

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Office Action Summary

Application No. 11/045,543	Applicant(s) OWEN ET AL.	
Examiner Michael B. Holmes	Art Unit 2121	

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Period for Reply

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Status

- 1) Responsive to communication(s) filed on 28 January 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) 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

- 4) Claim(s) 1-27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5, 14-18 and 27 is/are rejected.
- 7) Claim(s) 6-13 and 19-26 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 January 2005 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).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

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).
a) All b) Some * c) None of:
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)

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Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |



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Examiner's Detailed Office Action

Claim Rejections - 35 USC § 102

1. 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.

2. Claims 1-5, 14-18 & 27 are rejected under 35 U.S.C. 102(b) as being anticipated by *McAndrew et al.* (USPN 5,517,405).

Regarding claim 1. *McAndrew et al.* discloses a method for providing a collaborative decision platform adapted to run on a computer, comprising the steps of:

(a) executing an application capable of performing **decision logic**; [see Abstract, C 5, L 08-38 & C 5, L 50 to C 6, L 39 & FIG. 1 & FIG. 2]

(b) retrieving information from a database in accordance with the **decision logic**; [see Abstract, C 5, L 08-38 & C 5, L 50 to C 6, L 39 & FIG. 1 & FIG. 2]

(c) receiving information from a user in accordance with the **decision logic** utilizing a user interface; (d) processing the information utilizing the **decision logic**; [see Abstract, C 5, L 08-38 &

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C 5, L 50 to C 6, L 39 & FIG. 1 & FIG. 2] and

(e) wherein steps (a)-(d) are carried out by a collaborative decision platform capable of accomplishing steps (b)-(d) for different purposes by executing different applications each capable of performing different **decision logic**. [see Abstract, C 5, L 08-38 & C 5, L 50 to C 6, L 39 & FIG. 1 & FIG. 2]

Regarding claim 14. *McAndrew et al.* discloses, a computer program product for providing a collaborative decision platform adapted to run on a computer, comprising:

(a) computer code for executing an application capable of performing **decision logic**; [see Abstract, C 3, L 18-36 & C 5, L 08-38 & C 5, L 50 to C 6, L 39 & FIG. 1 & FIG. 2]

(b) computer code for retrieving information from a database in accordance with the **decision logic**; [see Abstract, C 3, L 18-36 & C 5, L 08-38 & C 5, L 50 to C 6, L 39 & FIG. 1 & FIG. 2]

(c) computer code for receiving information from a user in accordance with the **decision logic** utilizing a user interface; [see Abstract, C 3, L 18-36 & C 5, L 08-38 & C 5, L 50 to C 6, L 39 & FIG. 1 & FIG. 2]

(d) **computer code for processing** the information utilizing the **decision logic**; [see Abstract, C 3, L 18-36 & C 5, L 08-38 & C 5, L 50 to C 6, L 39 & FIG. 1 & FIG. 2] and

(e) wherein computer code segments (a)-(d) are carried out by a collaborative decision platform capable of executing computer code segments (b)-(d) for different purposes by executing different applications each capable of performing different **decision logic**. [see Abstract, C 3, L 18-36 & C 5, L 08-38 & C 5, L 50 to C 6, L 39 & FIG. 1 & FIG. 2]

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Regarding claim 27. *McAndrew et al.* discloses, a system for providing a collaborative decision platform adapted to run on a computer, comprising:

(a) logic for executing an application capable of performing **decision logic**; [see Abstract, C 3, L 18-36 & C 5, L 08-38 & C 5, L 50 to C 6, L 39 & FIG. 1 & FIG. 2]

(b) logic for retrieving information from a database in accordance with the **decision logic**; [see Abstract, C 3, L 18-36 & C 5, L 08-38 & C 5, L 50 to C 6, L 39 & FIG. 1 & FIG. 2]

(c) logic for receiving information from a user in accordance with the **decision logic** utilizing a user interface; [see Abstract, C 3, L 18-36 & C 5, L 08-38 & C 5, L 50 to C 6, L 39 & FIG. 1 & FIG. 2]

(d) logic for processing the information utilizing the **decision logic**; [see Abstract, C 3, L 18-36 & C 5, L 08-38 & C 5, L 50 to C 6, L 39 & FIG. 1 & FIG. 2] and

(e) wherein logic elements (a)-(d) are carried out by a collaborative decision platform capable of performing logic elements (b)-(d) for different purposes by executing different applications each capable of performing different **decision logic**. [see Abstract, C 3, L 18-36 & C 5, L 08-38 & C 5, L 50 to C 6, L 39 & FIG. 1 & FIG. 2]

Regarding claims 2 & 15. *McAndrew et al.* discloses, the method as recited in claim 1, wherein the collaborative decision platform communicates with the application through a standard interface protocol. [see FIG. 1, C 6, L 29-45]

Regarding claims 3 & 16. *McAndrew et al.* discloses, the method as recited in claim 1, wherein the information is retrieved and received via a network. [see FIG. 1, C 6, L 29-45]

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Regarding claims 4 & 17. *McAndrew et al.* discloses, the method as recited in claim 3, wherein the network is the Internet. [see FIG. 1, C 6, L 29-45]

Regarding claims 5 & 18. *McAndrew et al.* discloses, the method as recited in claim 1, wherein the purpose is selected from the group consisting of real estate-related, medical-related, corporate-related, and financial-related. [see Abstract & C 5, L 50-59]

Claim Objection(s)

3. Claims 6-13 & 19-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Correspondence Information

4. 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.

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Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located on the first floor of the south side of the Randolph Building.

Michael B. Holmes

Patent Examiner

Artificial Intelligence

Art Unit 2121

United States Department of Commerce

Patent & Trademark Office

Friday, November 10, 2006

MBH

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