UNITED STATES PATENT AND TRADEMARK OFFICE

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12/178,896	07/24/2008	Kulvir S. Bhogal	END920070264US1	7178

46583 7590 03/19/2018		EXAMINER
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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 KULVIR S. BHOGAL, RICK A. HAMILTON II,
BRIAN M. O'CONNELL, and CLIFFORD A. PICKOVER

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Appeal 2016-008742
Application 12/178,896[1]
Technology Center 3600

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Before DEBRA K. STEPHENS, DANIEL J. GALLIGAN, and
DAVID J. CUTITTA II, *Administrative Patent Judges.*

CUTITTA II, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of

claims 1–4, 8–10, 12–18, 23, 24, and 27, which are all of the claims pending

in the application.[2] We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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[1] Appellants identify International Business Machines Corporation as the
real party in interest. *See* App. Br. 2.
[2] Claims 5–7, 11, 19–22, 25, and 26 are cancelled.

STATEMENT OF THE CASE

According to Appellants, the claims are directed to ensuring the rendering order of rendered objects which are prioritized based on bids (Spec. ¶¶ 63–64, Abstract).[3] Claim 1, reproduced below, is representative of the claimed subject matter:

> 1.   A method implemented in a computer infrastructure having computer executable code, comprising:
>
> receiving two or more bids for an enhanced rendering order of two or more objects in a same region or scene of a virtual universe (VU);
>
> performing a bid resolution for the received two or more bids for the enhanced rendering order, the bid resolution comprising:
>
> determining a bid value for each of the two or more bids; and
>
> sorting the two or more bids based on the bid value for each of the two or more bids;
>
> receiving two or more bids for an enhanced rendering quality of two or more objects in the same region or scene of the VU;
>
> performing a bid resolution for the received two or more bids for the enhanced rendering quality, the bid resolution comprising:
>
> determining a bid value for each of the two or more bids;
>
> determining a highest bid value of the bid values for the two or more bids;

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[3] This Decision refers to: (1) Appellants' Specification filed July 24, 2008 (Spec.); (2) the Final Office Action (Final Act.) mailed March 5, 2015; (3) the Appeal Brief (App. Br.) filed July 2, 2015; (4) the Examiner's Answer (Ans.) mailed July 27, 2016; and (5) the Reply Brief (Reply Br.) filed September 21, 2016.

assigning the highest bid value a complete rendering attribute that corresponds to a maximum rendering quality;

assigning all bid values for the two or more bids that are less than the highest bid value and greater than zero with a percentage rendering attribute based on a percentage of the highest bide value that correspond to a rendering quality equal to a percentage of the maximum rendering quality; and

assigning all bid values for the two or more bids that are zero with a default rendering attribute that corresponds to a default rendering quality for the VU;

rendering the two or more objects in the VU with the enhanced rendering order based on the bid resolution for the enhanced rendering order such that a rendering start time of a first object of the two or more objects with a higher bid value occurs prior to a rendering start time of a second object of the two or more objects with a lower bid value; and

providing the enhanced rendering quality to the first object and the second object based on the bid resolution for the enhanced rendering quality such that the first object and second object are rendered with a maximum rendering quality, a percentage of the maximum rendering quality, or a default rendering quality,

wherein the rendering start time for the first object with the higher bid value for the enhanced rendering order and the rendering start time for the second object with the lower bid value for the enhanced rendering order are adjusted to account for a delay in rendering caused by the maximum rendering quality, the percentage of the maximum rendering quality, or the default rendering quality provided to each of the first object and the second object such that the first object of the two or more objects with the higher bid value for the enhanced rendering order is completely rendered before the second object of the two or more objects with a lower bid value for the enhanced rendering order is completely rendered.

REJECTION

Claims 1–4, 8–10, 12–18, 23, 24, and 27 stand rejected under 35

U.S.C. § 101 as being directed to non-statutory subject matter. Final Act. 2–

4.

ANALYSIS

The Examiner rejects claims 1–4, 8–10, 12–18, 23, 24, and 27 under

35 U.S.C. § 101 as being directed to non-statutory subject matter that does

not amount to significantly more than an abstract idea itself because the

abstract idea is "performed by software on a generic computer on the

internet, performing generic computer functions that are well-understood,

routine activities previously known to the industry." Ans. 2; *see id.* at 5; *see*

also Final Act. 3–4.

Appellants argue claim 1 is patent-eligible because the claim "recites

significantly more than the abstract idea itself" by "adding a specific

limitation other than what is well-understood, routine and conventional in

the field." App. Br. 19.

We are persuaded by Appellants' argument. The Supreme Court has

set forth "a framework for distinguishing patents that claim laws of nature,

natural phenomena, and abstract ideas from those that claim patent-eligible

applications of those concepts." *Alice Corp. Pty. Ltd. v. CLS Bank Int'l,* 134

S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus*

Labs, Inc., 132 S. Ct. 1289, 1296–97 (2012)). According to the Supreme

Court's framework, we first determine whether the claims at issue are

directed to one of those concepts (i.e., laws of nature, natural phenomena,

and abstract ideas). *Id.* If so, we secondly "consider the elements of each

claim both individually and 'as an ordered combination' to determine

whether the additional elements 'transform the nature of the claim' into a patent-eligible application." *Id.* (internal citation omitted). The Supreme Court characterizes the second step of the analysis as "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.'" *Id.* (internal citation omitted).

Deferring our step one analysis and turning to the second step of the Supreme Court's framework, we examine whether the Examiner has proffered sufficient evidence and argument persuading us that claim 1 merely recites conventional computer functions. *See Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC,* 827 F.3d 1341, 1349 (Fed. Cir. 2016) ("We therefore defer our consideration of the specific claim limitations[] . . . for step two"); *see also Amdocs (Israel) Ltd. v. Openet Telecom, Inc.,* 841 F.3d 1288, 1300 (Fed. Cir. 2016), cert. denied, 138 S. Ct. 469 (2017) ("even if we were to agree that claim 1 is directed to an ineligible abstract idea under step one, the claim is eligible under step two"). We determine the Examiner has not.

Here, claim 1 includes limitations that ensure a first object is rendered before a second object is rendered by accounting for the rendering time of the first object and accordingly adjusting when rendering of the second object will begin. Specifically, claim 1 recites:

> wherein *the rendering start time for the first object* with the higher bid value for the enhanced rendering order *and the rendering start time for the second object* with the lower bid value for the enhanced rendering order *are adjusted to account for a delay in rendering caused* by the maximum rendering quality, the percentage of the maximum rendering quality, or the

> default rendering quality provided to each of the first object and
> the second object *such that the first object of the two or more*
> *objects with the higher bid value for the enhanced rendering*
> *order is completely rendered before the second object* of the two
> or more objects with a lower bid value for the enhanced
> rendering order is completely rendered

(emphases added). Although we understand the claimed invention uses "generic computer, network and Internet components, none of which is inventive by itself," the "inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces." *Bascom*, 827 F.3d 1350. According to Appellants, the claimed rendering order prioritization technique is not well-understood, routine, or conventional. App. Br. 19. The Examiner has not set forth with sufficient specificity or provided any finding (*see* Ans. 2, 5; *see also* Final Act. 3–4) that the specifically claimed manner of rendering order prioritization technique is well-understood, routine, or conventional. *Berkheimer v. HP Inc.,* No. 2017-1437, slip op. at 14 (Fed. Cir. Feb. 8, 2018) ("Whether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination."). As such, on the record before us, we cannot find that ensuring rendering priority by adjusting rendering start time to account for rendering delay is well-understood or routine.

Because we are persuaded by at least one of the arguments advanced by Appellants, we need not reach the merits of Appellants' other arguments (*see* App. Br. 9–18, 21–67). We, therefore, do not sustain the Examiner's rejection of claim 1 as being directed to patent ineligible subject matter. Independent claims 18, 23, 24, and 27 all similarly recite the ensured rendering priority limitations of claim 1. Accordingly, for the same reasons,

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we also do not sustain the rejections of independent claims 18, 23, 24, and 27, and dependent claims 2–4, 8–10, and 12–17 under 35 U.S.C. § 101.

DECISION

For the reasons above, we reverse the Examiner's decision rejecting claims 1–4, 8–10, 12–18, 23, 24, and 27.

REVERSED