



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
16/593,924	10/04/2019	Luisa Goytia	Procure 19-0901-NP	1560
130085	7590	03/01/2024	EXAMINER	
Lee Sullivan Shea & Smith LLP 656 W. Randolph St. Floor 5W Chicago, IL 60661			WALTON, CHESIREE A	
			ART UNIT	PAPER NUMBER
			3624	
			NOTIFICATION DATE	DELIVERY MODE
			03/01/2024	ELECTRONIC

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ls3_docketing@cardinal-ip.com
york@ls3ip.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LUISA GOYTIA, WOJCIECH PELIKS, and
JACOB JOSEPH SHEEHY

Appeal 2023-004166
Application 16,593,924¹
Technology Center 3600

Before, JOSEPH A. FISCHETTI, MICHAEL C. ASTORINO, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection² of claims 1–3, 8–10, 15–17, 21–28, 30, and 31. We have jurisdiction under 35 U.S.C. § 6(b). A hearing was held on January 30, 2024.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies Procore Technologies, Inc. as the real party in interest. Appeal Br. 1.

² Final Action dated June 16, 2024.

SUMMARY OF DECISION

We reverse and enter a new ground (37 C.F.R. § 41.50(b)).

THE INVENTION

Appellant states its disclosure relates to a plan “created during a planning phase of a construction project[,] an inspection and test plan (‘ITP’), which specifies the set of inspections and tests that must be completed on the construction project before it can be closed out.”

Spec. ¶ 2.

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

1. A computing system comprising:
 - at least one processor;
 - a non-transitory computer-readable medium; and
 - program instructions stored on the non-transitory computer-readable medium that are executable by the at least one processor such that the computing system is configured to:
 - receive definitions of a plurality of inspection and test activities that are to be included in an inspection and test plan (ITP) for a construction project, wherein the plurality of inspection and test activities comprises (i) a first inspection and test activity that includes a hold point condition with respect to a second inspection and test activity but not a third inspection and test activity, (ii) the second inspection and test activity that is sequenced after the first inspection and test activity in a first section of the ITP, and (iii) the third inspection and test activity in a second section of the ITP that is sequenced after the first inspection and test activity in the first section of the ITP;
 - publish the ITP by making the ITP available to at least (i) a first client station associated with a first user, wherein the first user is designated as an assignee of the first inspection and test activity, (ii) a second client station associated with a second user, wherein the second user is designated as an assignee of the

second inspection and test activity, and (iii) a third client station associated with a third user, wherein the third user is designated as an assignee of the third inspection and test activity;

based on the hold point condition, restrict the second client station associated with the second user from interacting with the second inspection and test activity;

receive, from the third client station, an indication that the third user has signed-off on the third inspection and test activity;

after receiving the indication that the third user has signed-off on the third inspection and test activity:

receive an indication of a record to link to the first inspection and test activity of the plurality; and

receive, from the first client station, an indication that the first user has signed-off on the first inspection and test activity; and

based on receiving the indication that the first user has signed-off on the first inspection and test activity, automatically enable the second client station associated with the second user to interact with the second inspection and test activity.

Appeal Br. 9–10 (Claims App.)

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Saylor	US 9,378,386 B1	June 28, 2016
Martinez	US 2014/0058963 A1	Feb. 27, 2014
Reed	US 2016/0267412 A1	Sept. 15, 2016

The following rejection is before us for review.

Claims 1–3, 8–10, 16, 17, 21–28, 30, and 31 are rejected under 35 U.S.C. § 103 as being unpatentable over Reed in view of Martinez, and in further view of Saylor.

ANALYSIS

35 U.S.C. § 103 REJECTION

Each of independent claims 1, 8, and 15 requires in one form or another,

wherein the plurality of inspection and test activities comprises (i) a first inspection and test activity that includes a hold point condition with respect to a second inspection and test activity but not a third inspection and test activity, (ii) the second inspection and test activity that is sequenced after the first inspection and test activity in a first section of the ITP, and (iii) the third inspection and test activity in a second section of the ITP that is sequenced after the first inspection and test activity in the first section of the ITP.

Appellant argues the following:

Applicant respectfully submits that there is nothing in Martinez that amounts to a hold point condition that allows for this type of sequencing. Rather, Martinez discusses a traveler form, where “[e]ach section of form consists of various checklists can be signed off with the condition of hold point, witness point, surveillance or review by several field personnel.” Martinez at [0018]. In this regard, Martinez is clear that a “checklist signed off with the hold point cannot proceed to the next checklist until the issue solved.” *Id.* at [0019]. For example, Example 3 in Martinez shows an example of a traveler form for a “paving job [that] can be separated into five (5) different sections (pre-paving, base preparation, paving operations, material testing and post paving) according to the sequence of the work.” *Id.* But there is no suggestion in Martinez of a first activity (e.g., pre-paving) that includes a hold point condition with respect to a second, later-sequenced activity (e.g., base preparation) but ***not*** a third, later-sequenced activity (e.g., paving operations).

(Response After Final Action, dated Sept. 27, 2022, p. 11).

The Examiner found, concerning these limitations that Martinez discloses them at Fig. 2; Fig. 3; ¶¶ 18–19. (Final Act. 8).

Martinez discloses at paragraph 18, “[e]ach section of form consists of various checklists can be signed off with the condition of hold point, witness point, surveillance or review by several field personnel. The entire construction of all items can be conformed to their phases of work with signoff to insure quality compliance.” While Martinez does disclose “checklists can be signed off with the condition of hold point,” (Martinez ¶ 18), nowhere in any of the references relied upon by the Examiner in the proposed combination is it disclosed or suggested for ordered inspections, “a hold point condition with respect to a second inspection and test activity but not a third inspection and test activity,” and, “the third inspection and test activity in a second section of the ITP that is sequenced after the first inspection and test activity in the first section of the ITP.” We hence agree with the Appellant that in Martinez “there is no suggestion of a first activity (e.g., pre-paving) that includes a hold point condition with respect to a second, later sequenced activity (e.g., base preparation) but not a third, later-sequenced activity (e.g., paving operations).” (Response After Final Action, dated Sept. 27, 2022, p. 11).

Thus, we reverse the rejection of claims 1, 8, and 15. We also reverse the rejection of dependent claims 2, 3, 9, 10, 16, 17, 21–28, 30, and 31.

35 U.S.C. § 101 REJECTION

Under our authority of 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claims 1–3, 8–10, 15–17, 21–28, 30, and 31 under 35 U.S.C. § 101 as being directed to an abstract idea without significantly more.³

We select claim 1 as the representative claim for the independent claims on appeal. Independent claims 8 and 15 have the same scope as claim 1.

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Alice*, 573 U.S. at 217–18 (citing *Mayo Collaborative Servs. v.*

³ We disagree with the Examiner’s assessment on pages 3–4 of the Final Action for “withdrawal of the rejection of claims 1-4, 8-11, 15-18, and 21-28 under 35 U.S.C. § 101.” The independent claims only generically recite “at least one processor,” and “non-transitory computer-readable medium,” “a first client station,” “a second client station” and “a third client station.” These are *per se* generic and conventional, and claim 1 recites no inventive programming. Thus, claim 1 recites general-purpose computer components without special programming. “[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 223 (2014). That different users are each assigned to one of the three client stations does not enhance generic and conventional nature of these devices, it only individually gives identity to them.

Prometheus Labs., Inc., 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See id.* at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1853))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “a claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 187; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection

of our patent laws, and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (quotation marks omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (alterations in original) (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

In January 2019, the U.S. Patent and Trademark Office (“USPTO”) published revised guidance on the application of § 101. 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”).⁴ “All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.” (*Id.* at 51; *see also* October 2019 Update at 1).⁵

⁴ In response to received public comments, the Office issued further guidance on October 17, 2019, clarifying the 2019 Revised Guidance. USPTO, *October 2019 Update: Subject Matter Eligibility* (the “October 2019 Update”) (available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf).

⁵ The Manual of Patent Examining Procedure incorporates the 2019

Under the 2019 Revised Guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes) (“Step 2A, Prong One”); and
 - (2) additional elements that integrate the judicial exception into a practical application (*see* Manual of Patent Examining Procedure (“MPEP”) § 2106.05(a)–(c), (e)–(h) (9th ed. Rev. 10.2019 (June 2020))) (“Step 2A, Prong Two”).⁶
- (Guidance, 84 Fed. Reg. at 52–55).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look, under Step 2B, to whether the claim:

- (3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or
 - (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.
- (Guidance, 84 Fed. Reg. at 52–56). The U.S. Court of Appeals for the Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the specification, based on

Guidance and subsequent updates in Section 2106 (9th ed. Rev. 07.2022, pub. February 2023).

⁶ This evaluation is performed by (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception, and (b) evaluating those additional elements individually and in combination to determine whether the claim as a whole integrates the exception into a practical application. *See* Guidance – Section III(A)(2), 84 Fed. Reg. at 54–55.

whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). It asks whether the focus of the claims is on a specific improvement in relevant technology or on a process that itself qualifies as an “abstract idea” for which computers are invoked merely as a tool. *See Enfish*, 822 F.3d at 1335–36.

In so doing, as indicated above, we apply a “directed to” two prong test: 1) evaluate whether the claim recites a judicial exception, and 2) if the claim recites a judicial exception, evaluate whether the claim “appl[ies], rel[ies] on, or use[s] the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” (Guidance, 84 Fed. Reg. at 53; *see also* MPEP §§ 2106.04–2106.05).

Accordingly, we find:

The Specification states:

Construction projects can be complex endeavors that involve collaboration between multiple different parties. For instance, an owner may be responsible for funding a construction project and collaborating with an architect on its design. The architect may then collaborate with a general contractor (“GC”) that has been tasked with managing the overall construction project. In turn, the GC may collaborate with various subcontractors that have been tasked with handling specific aspects of the construction project, such as concrete, carpentry, masonry, roofing, electrical, plumbing, HVAC, etc.

Further, construction projects typically involve various phases, one of which may be a planning phase that involves the creation of a set of plans that are to govern the subsequent phases of the construction project (e.g., the execution and/or closure phases). In this respect, one type of plan that may need to be

created during a planning phase of a construction project is an inspection and test plan (“ITP”), which specifies the set of inspections and tests that must be completed on the construction project before it can be closed out. In practice, this set of inspections and tests that must be completed on the construction project is typically dictated by certain specifications associated with the construction project, which may take the form of standardized specifications and/or project-specific specifications (e.g., project drawings). Further, in practice, the ITP may also include requirements as to the manner in which the inspections and tests must be completed on the construction project (where such requirements may also be dictated by the specifications), including but not limited to requirements as to when the inspections and tests must be completed and/or requirements as to the individual(s) responsible for completing the inspections and tests.

After an ITP for a construction project has been created during a planning phase of the construction project, the ITP may then be used to manage quality control on the construction project during execution and/or closure phases of the construction project. In practice, this task may involve consulting the ITP to identify the inspections and/or tests that need to be completed on the construction project, performing such inspections and/or tests in accordance the requirements set forth in the ITP, and then providing confirmation that such inspections and/or tests have been completed in accordance with the requirements set forth in the ITP.

Spec. ¶¶ 1–3.

Claim 1 recites in pertinent part,

receive definitions of a plurality of inspection and test activities that are to be included in an inspection and test plan (ITP) for a construction project, wherein the plurality of inspection and test activities comprises (i) a first inspection and test activity that includes a hold point condition with respect to a second inspection and test activity but not a third inspection and test activity, (ii) the second inspection and test activity that is sequenced after the first inspection and test activity in a first

section of the ITP, and (iii) the third inspection and test activity in a second section of the ITP that is sequenced after the first inspection and test activity in the first section of the ITP;

publish the ITP by making the ITP available to at least (i) a first client station associated with a first user, wherein the first user is *designate*[-]d as an assignee of the first inspection and test activity, (ii) a second client station associated with a second user, wherein the second user is *designate*[-]d as an assignee of the second inspection and test activity, and (iii) a third client station associated with a third user, wherein the third user is *designate*[-]d as an assignee of the third inspection and test activity;

based on the hold point condition, *restrict* the second client station associated with the second user from interacting with the second inspection and test activity;

receive, from the third client station, an indication that the third user has signed-off on the third inspection and test activity;

after receiving the indication that the third user has signed-off on the third inspection and test activity:

receive an indication of a record to link to the first inspection and test activity of the plurality; and

receive, from the first client station, an indication that the first user has signed-off on the first inspection and test activity; and

based on receiving the indication that the first user has signed-off on the first inspection and test activity, ... *enable* the second client station associated with the second user to interact with the second inspection and test activity.

Accordingly, all this intrinsic evidence shows that claim 1 is directed to a test plan for a construction project which specifies a set of inspections and tests that must be completed on the construction project before it can be closed out, which constitutes managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions), which is one of certain methods of

organizing human activity that are judicial exceptions. (Guidance, 84 Fed. Reg. at 52.)

In addition, the claimed steps highlighted above in italics mimic human thought processes of selecting certain information over others, i.e., evaluation, and creating perhaps with paper and pencil, graphic data interpretation perceptible only in the human mind. *See In re TLI Commc 'ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016). The Federal Circuit has held similar concepts to be abstract. Thus, for example, the Federal Circuit has held that abstract ideas include the concepts of collecting data, analyzing the data, and reporting the results of the collection and analysis, including when limited to particular content. *See, e.g., Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340–41 (Fed. Cir. 2017) (identifying the abstract idea of organizing, displaying, and manipulating data); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (characterizing collecting information, analyzing information by steps people go through in their minds, or by mathematical algorithms, and presenting the results of collecting and analyzing information, without more, as matters within the realm of abstract ideas). Thus, under the first prong, claim 1 also recites the patent ineligible judicial exception of a mental process.

Turning to the second prong of the “directed to” test, claim 1 only generically requires “at least one processor,” and “non-transitory computer-readable medium,” “a first client station,” “a second client station” and “a third client station.” These components are described in the Specification at a high level of generality. *See Spec.* ¶¶ 43–48, Fig. 1. We fail to see how

the generic recitations of these most basic computer components and/or of a system so integrates the judicial exception as to “impose[] a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” Guidance, 84 Fed. Reg. at 53.

Merely confining the abstract idea to a particular technological environment does not establish a practical application. *See id.* at 54. “A claim does not cease to be abstract for section 101 purposes simply because the claim confines the abstract idea to a particular technological environment in order to effectuate a real-world benefit.” *In re Mohapatra*, 842 F. App’x 635, 638 (Fed. Cir. 2021).

Thus, we find that the claims recite the judicial exceptions of a certain method of organizing human activity and a mental process that are not integrated into a practical application.

That the claims do not preempt all forms of the abstraction or may be limited to construction management, does not make them any less abstract. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“And that the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”).

Turning to the second step of the *Alice* analysis, because we find that the claims are directed to abstract ideas/judicial exceptions, the claims must include an “inventive concept” in order to be patent-eligible, i.e., there must be an element or combination of elements sufficient to ensure that the claim in practice amounts to significantly more than the abstract idea itself. *See Alice*, 573 U.S. at 217–18 (quoting *Mayo*, 566 U.S. at 72–73).

Concerning this step, we find the claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the computer as recited is a generic computer component that performs functions that are generic computer functions that are well-understood, routine, and conventional activities previously known to the industry. “[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice*, 573 U.S. at 225. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to retrieve, select, and apply decision criteria to data and modify the data as a result amounts to electronic data query and retrieval—one of the most basic functions of a computer. As to the data operated upon, “even if a process of collecting and analyzing information is ‘limited to particular content’ or a particular ‘source,’ that limitation does not make the collection and analysis other than abstract.” *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1168 (Fed. Cir. 2018) (internal citation omitted).

All of these computer functions are well-understood, routine, conventional activities previously known to the industry. *See Elec. Power*, 830 F.3d at 1354; *see also In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1316 (Fed. Cir. 2011) (“Absent a possible narrower construction of the terms ‘processing,’ ‘receiving,’ and ‘storing,’ . . . those functions can be achieved by any general purpose computer without special programming”). In short, each step does no more than require a generic computer to perform generic computer functions. The claims do not, for example, purport to improve the functioning of the computer itself. In

addition, the claims do not effect an improvement in any other technology or technical field. The Specification spells out different generic equipment and parameters that might be applied using this concept and the particular steps such conventional processing would entail based on the concept of information access under different scenarios (*see, e.g.*, Spec. ¶¶ 43–48, Fig. 1). Thus, the claims at issue amount to nothing significantly more than instructions to apply the abstract idea using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 573 U.S. at 225–26.

Considered as an ordered combination, the computer components of Appellant’s claims add nothing that is not already present when the steps are considered separately. The sequence of data reception-analysis (receive publish, designate, designate, designate, receive, restrict, receive, receive, enable) and storing is equally generic and conventional or otherwise held to be abstract. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (sequence of receiving, selecting, offering for exchange, display, allowing access, and receiving payment recited an abstraction), *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (holding that sequence of data retrieval, analysis, modification, generation, display, and transmission was abstract), *Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (holding sequence of processing, routing, controlling, and monitoring was abstract). The ordering of the steps is, therefore, ordinary and conventional.

The method claims merely describe process parameters. We conclude that the method claims at issue are directed to a patent-ineligible concept itself, and not to the practical application of that concept.

As to the dependent claims, there is nothing recited in these claims which would make the independent claims eligible.

For example, claim 2 recites in pertinent part, “a first interface through which the computing system receives the definitions of the plurality of inspection and test activities that are to be included in an ITP for the construction project.” It is well settled law that a generically recited user interface cannot confer patent eligibility when “the hardware needed was typical and that the programming steps were commonly known, ...with no disclosure of how this would be technologically implemented.” *See Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229 at 1244 (Fed. Cir. 2016). Claim 9 recites only data characterization: “definitions of the plurality of inspection and test activities that are to be included in an ITP for the construction project. Claims 3 and 10, recite only post solution activity: “evidenc[ing] completion of the first inspection and test activity.”

CONCLUSIONS OF LAW

We conclude the Examiner erred in rejecting claims 1–3, 8–10, 15–17, 21–28, 30, and 31 under 35 U.S.C. § 103.

We enter a new ground of rejection of claims 1–3, 8–10, 15–17, 21–28, 30, and 31 under 35 U.S.C. § 101.

DECISION

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed	New Grounds
1-3, 8- 10, 15- 17, 21- 28, 30, 31	103	Reed, Martinez, Saylor		1-3, 8- 10, 15- 17, 21- 28, 30, 31	
1-3, 8- 10, 15- 17, 21- 28, 30, 31	101	Eligibility			1-3, 8- 10, 15- 17, 21- 28, 30, 31
Overall Outcome				1-3, 8- 10, 15- 17, 21- 28, 30, 31	1-3, 8- 10, 15- 17, 21- 28, 30, 31

TIME PERIOD FOR RESPONSE

This Decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

Appeal 2023-004166
Application 16/593,924

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. . . .

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

REVERSED; 37 C.F.R. § 41.50(b)