



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.
11/470,377	09/06/2006	Harold Moss	RSW920060111US1	7965
61136	7590	02/27/2013	EXAMINER	
HAMILTON & TERRILE, I.P.			PHILLIPS, III, ALBERT M	
IBM RSW			ART UNIT	PAPER NUMBER
P.O. BOX 203518			2155	
AUSTIN, TX 78720			NOTIFICATION DATE	DELIVERY MODE
			02/27/2013	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):

tmunoz@hamiltontertile.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* HAROLD MOSS

---

Appeal 2010-006775  
Application 11/470,377  
Technology Center 2100

---

Before JOHN A. JEFFERY, DENISE M. POTHIER, and  
BARBARA A. BENOIT, *Administrative Patent Judges*.

POTHIER, *Administrative Patent Judge*.

DECISION ON APPEAL  
STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-20.<sup>1</sup> We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

---

<sup>1</sup> Throughout this opinion, we refer to the Appeal Brief (App. Br.) filed September 1, 2009 and supplemented October 28, 2009 and the Examiner's Answer (Ans.) mailed January 15, 2010.

*Invention*

Appellant's invention relates to a policy validator that automates validating existing or proposed policies. *See* Abstract. Claim 1 is reproduced below with the key disputed limitations emphasized:

1. A computer-implementable method comprising:  
creating a questionnaire relating to a policy;  
electronically distributing the questionnaire to a plurality of reviewers, receiving responses from the plurality of reviewers to the questionnaire; and  
*using a policy validator to score the responses to the questionnaire to determine the validity of the policy.*

The Examiner relies on the following as evidence of unpatentability:

Yanase	US 7,054,876 B2	May 30, 2006
Castelli	US 2007/0202483 A1	Aug. 30, 2007 (filed Feb. 28, 2006)

Curt Finch, *On Demand 1-3<sup>2</sup>* (2006), available at <http://www.projectsatwork.com/articles/articlesPrint.cfm?ID=229286> ("Finch").

*The Rejections*

Claims 13-20 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Ans 3-4.

Claims 1, 2, 6-8, 12-14, and 19 are rejected under 35 U.S.C. § 102(e) as anticipated by Castelli. Ans. 5-10.

Claims 3, 9, and 15 are rejected under 35 U.S.C. § 103(a) as unpatentable over Castelli. Ans. 10-13.

Claims 4, 5, 10, 11, and 16-18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Castelli and Yanase. Ans. 13-21.

---

<sup>2</sup> Three printed pages of this reference were provided, and these page numbers correspond sequentially to the pages provided.

Claim 20 is rejected under 35 U.S.C. § 103(a) as unpatentable over Castelli and Finch. Ans. 21-22.<sup>3</sup>

#### THE NON-STATUTORY SUBJECT MATTER REJECTION

Regarding representative claim 13, Appellant argues the amendment to Paragraph 0015 of the disclosure removes this rejection. *See* Supp. App. Br. 1. The Examiner maintains that Paragraph 0015 as written still includes a propagation medium for a computer usable medium that is directed to non-statutory subject matter. Ans. 3-4.

#### ISSUE

Under § 101, has the Examiner erred in rejecting claim 13 by finding that the recited “computer-usable medium” is directed to non-statutory subject matter?

#### ANALYSIS

Based on the record before us, we find no error in the Examiner’s rejection of claim 13. We agree with the Examiner that the amended disclosure includes a computer usable medium as both a propagation medium and paper. Spec. ¶ 0015. These media are directed to non-statutory subject matter. For example, a propagation medium encompasses a signal that performs the recited operations. Such signals are not patentable subject matter under § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). Also, paper containing logic or a program is printed matter and is considered non-statutory under § 101. *See In re Miller*, 418 F.2d 1392, 1396 (CCPA

---

<sup>3</sup> The Examiner has withdrawn the § 101 rejection of claims 7-12. Ans. 2.

1969); *see also Ex parte Shealy*, 2007 WL 5211669, No. 2006-1601, at \*21-22 (BPAI Apr. 23, 2007) (informative) and Manual of Patent Examining Procedure (MPEP) § 2106 (I), 8th ed., Rev. 9, Aug. 2012.

When read in light of the Specification, independent claim 13 includes both statutory subject matter (instructions stored on a tangible medium) and non-statutory subject matter (instructions conveyed by a signal or paper). According to USPTO guidelines, however, such claims must be amended to recite solely statutory subject matter. *See Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

For the foregoing reasons, Appellant has not persuaded us of error in the rejection of independent claim 13 and claims 14-20 not separately argued with particularity.

#### THE ANTICIPATION REJECTION OVER CASTELLI

Regarding representative claim 1, the Examiner finds that Castelli discloses a policy validator determining the policy's validity by assessing how well a safety program is performed and analyzing the results. Ans. 5, 24, 26.

Appellant argues that Castelli fails to disclose a policy validator that determines "the validity of the policy." Supp. App. Br. 1-4. In particular, Appellant asserts that Castelli determines how well a user has performed in implementing a safety program and also quantitatively assesses compliance with a safety program, but does not validate a policy or verify the validity of a policy, such as "establishing the soundness of" a policy. Supp. App. Br. 2-3.

## ISSUE

Under § 102, has the Examiner erred in rejecting claim 1 by finding that Castelli discloses using a policy validator to score the responses to the questionnaire to determine the validity of the policy?

## ANALYSIS

We begin by construing the key disputed limitation of claim 1 which recites “using a policy validator . . . to determine the validity of the policy.” We agree with the Examiner (Ans. 24) that Appellant has narrowly construed this phrase. Claims are given their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

When construing claim 1 broadly, but reasonably, the disputed recitation related “to determine the validity of the policy” is an intended use limitation, requiring only that the policy validator is capable of being used to determine the validity of a policy. That being said, Appellant has not defined what “validity of the policy” means (*see generally* Specification), but does discuss a policy can be approved if the validation score is within an acceptable range. Spec. ¶¶ 007, 032, 034; Fig. 4. This, however, is just an example of how to determine the validity of a policy (*see* ¶ 007), and the breadth of claim 1 includes other techniques.

Appellant also uses a definition of the term, “validate,” as “to establish the soundness of; corroborate” (*see* Supp. App. Br. 2) in arguing that a skilled artisan would not consider Castelli’s assessment of how well a client has implemented a program as equivalent to establishing the

soundness of the safety program (e.g., determining the validity of a policy). *See* Supp. App. Br. 2-3. Notably, claim 1 does not recite “validate,” but rather uses a more expansive phrase, “to determine the validity.” Thus, the definition of “validate,” does not necessarily illustrate what the term, “validity” means. Nonetheless, we adopt the Examiner’s unrebutted position that soundness can be equated to effectiveness (*see* Ans. 24) as well as free from defects (*see* Ans. 25).<sup>4</sup> As such, we find that the phrase, “to determine the validity of the policy” includes to establish the effectiveness of a policy as well as to determine whether a policy has defects (*see* Ans. 25).

Thus, even using the proposed definition, we agree with and adopt the Examiner’s position (*see* Ans. 24, 26) that Castelli discloses using a validator to determine the effectiveness of a policy. To elaborate, Castelli discusses analyzing a best practice safety assessment using a questionnaire to score questions and to provide an assessment of the performance of a safety program (e.g., a policy). *See* Ans. 5 (citing Abstract, ¶ 0002); *see also* ¶ 0004. Castelli further states that the best practices assessment is used to determine whether a business has taken proper measures to comply with general principles and guidelines related to a safety program. *See* ¶ 0004. Moreover, Castelli discloses scoring clients and plotting the scores against an industry average to identify strengths and weaknesses of the safety policy in different areas. Ans. 24, 26 (citing ¶¶ 0108-09); *see also* Fig. 5. Thus, by using the questionnaire in Castelli to assess performance in different safety areas against an industry standard, Castelli shows using a validator to

---

<sup>4</sup> Notably, the underlying reference (<http://dictionary.reference.com>), which we do not rely upon and forms no part of this opinion, has a publication date after the effective filing date of Appellant’s application.

establish the effectiveness of its safety policy (e.g., those areas being implemented properly and those areas needing improvement) and to determine whether a policy has defects (e.g., areas needing improvement).

Lastly, we agree with the Examiner (Ans. 25) that the words, such as “verify,” “revalidated,” “re-approved,” and “wizard” (Supp. App. Br. 2) or the phrase, “policy . . . [being] invalid due to its being in conflict with the existing policy” (Supp. App. Br. 4), do not appear in claim 1. Any arguments that Castelli fails to disclose such limitations are therefore not commensurate in scope with the claim.

For the foregoing reasons, Appellant has not persuaded us of error in the rejection of independent claim 1 and claims 2, 6-8, 12-14, and 19 not separately argued with particularity.

#### THE REMAINING REJECTIONS

The Examiner finds that claims 3-5, 9-11, 15-18, and 20 are obvious over Castelli alone or in combination with other references. *See* Ans. 10-22. Appellant does not separately argue these rejections. *See* App. Br. 3-6; Supp. App. Br. 1-4. We therefore summarily sustain the rejections of claims 3-5, 9-11, 15-18, and 20. *See, e.g.*, MPEP § 1205.02, 8th ed., Rev. 9, Aug. 2012 (“If a ground of rejection stated by the examiner is not addressed in the appellant's brief, that ground of rejection will be summarily sustained by the Board.”).

#### CONCLUSION

The Examiner did not err in rejecting claims 13-20 under § 101 and claims 1-20 under §§ 102 or 103.

Appeal 2010-006775  
Application 11/470,377

DECISION

The Examiner's decision rejecting claims 1-20 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)(1)(iv).

AFFIRMED

rwk