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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN C. SCHIMPF, EDITH H. STERN,
ROBERT C. WEIR, and BARRY E. WILLNER¹

Appeal 2011-005139
Application 11/431,380
Technology Center 3600

Before, ANTON W. FETTING, BIBHU R. MOHANTY, and
KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE²

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1-6, 8-19, 21-32, and 34-39. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

THE INVENTION

¹ IBM Corporation is the real party in interest.

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed August 10, 2010) and Reply Brief ("Reply Br.," filed January 7, 2011), and the Examiner's Answer ("Ans.," mailed November 8, 2010).

Appellants' disclosure relates to a method and system for inspecting indicators of events that are derived from event messages that are generated by transaction entities. (Spec. ¶ [0001].)

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method for inspecting at least one indicator of an event, comprising:

enabling a token to be received by a transaction entity, said token corresponding to an account of a user of an aggregating entity, wherein said token is configured such that said aggregating entity can utilize said token to uniquely identify said account;

communicating to said transaction entity, at least one type of event of interest, wherein occurrences of events of interest detected by said transaction entity are reported by said transaction entity to said aggregating entity;

obtaining at least one indicator from said account of said aggregating entity, said at least one indicator adapted to be created by said aggregating entity based upon at least one event message received from said transaction entity, wherein each indicator contains sufficient information to allow said user to at least identify that a corresponding event of interest has occurred and each indicator only includes text that does not violate a predetermined security and does not disclose the identity of either said user or said transaction entity that communicated the event message; and

inspecting said at least one indicator;

wherein:

said event message comprises said token, which is adapted to be used by said aggregating entity to identify said account; and

said event message corresponds to an occurrence of an event of at least one type of event of interest to be reported by said transaction entity to said aggregating entity.

(App. Br., Claims Appendix 20.)

REJECTIONS

The prior art references relied upon by the Examiner in rejecting the claims are:

Ballinger	2006/0015932 A1	Jan. 19, 2006
Taylor	2007/0135099 A1	Jun. 14, 2007

Appellants respond to the following rejections:

Claims 1-6, 8-19, and 21-26 rejected under 35 U.S.C. § 101 because the claimed subject matter is directed to non-statutory subject matter.³

Claims 1-6, 8-19, 21-32, and 34-39 rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.⁴

Claims 1-6, 8-19, 21-32, and 34-39 rejected under 35 U.S.C. § 103(a) as unpatentable over Taylor and Ballinger.

ISSUES

Did the Examiner err in rejecting claims 1-6, 8-19, and 21-26 as directed to non-statutory subject matter under 35 U.S.C. § 101?

Did the Examiner err in interpreting the “indicator” of independent claims 1, 14, and 27 to be non-functional descriptive material, and as such err in rejecting claims 1-6, 8-19, 21-32, and 34-39 under 35 U.S.C. § 103(a) as unpatentable over Taylor and Ballinger based on this interpretation?

³ Initially, the Examiner rejected claims 27-32 and 34-39 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, however, the rejection of these additional claims was withdrawn by the Examiner in the Examiner’s Answer. (*See* Ans. 5.)

⁴ We note that the final rejection did not identify any specific rejections of the claims under 35 U.S.C. § 112.

FINDING OF FACT

Taylor is directed to a technique for instant message history display which includes combining message histories for multiple different messaging services. (¶ [0006].)

ANALYSIS

Claims 1-6, 8-19, and 21-26 stand rejected under 35 U.S.C. § 101 as having subject matter directed to non-statutory subject matter.

Claims 1-6 and 8-13

The Examiner asserts claims 1-6 and 8-13 are directed to non-statutory subject matter. (Ans. 8.) Specifically, the Examiner finds independent method claim 1 fails to recite at least one significant step performed by, or tied to a particular machine and additionally fails to transform the underlying subject matter to a different state or thing. (Ans. 8-9.)

In response, Appellants do not argue that claim 1 is tied to a particular machine, but instead assert that claim 1 transforms a particular article into a different state or thing. (App. Br. 13; Reply Br. 5.) In particular, Appellants contend in the claim that “physical tangible events are transformed into event messages that did not exist prior to the event occurring and this message is then transmitted,” satisfies the second prong of the machine-or-transformation test. We cannot agree with Appellants.

The Supreme Court clarified in *Bilski* that while the machine-or-transformation test “is not the sole test for deciding whether an invention is a patent-eligible ‘process’ under § 101,” it remains a “useful and important

clue or investigative tool.” *Bilski v. Kappos*, 130 S. Ct. 3218, 3221 (2010). However, the only factors presently being considered in front of us are the two machine-or-transformation factors, in which we find both weigh against the patent eligibility of independent claim 1.

Accordingly, we are not persuaded by Appellants’ argument that claim 1 transforms a physical object or thing. While we agree with Appellants that claim 1 may “transform” events into event messages that did not exist prior to the event occurring, we cannot agree with Appellants that “events,” as presently claimed, are “articles” that represent a physical object or substance. Instead, we find that the steps of independent claim 1 do little more than change one type of information into another type of information. Mere “manipulation of basic mathematical constructs [i.e.,] the paradigmatic 'abstract idea',” has not been deemed a transformation. *Cybersource v. Retail Decisions*, 654 F.3d 1366, 1372 n.2, (Fed. Cir. 2011)(quoting *In re Warmerdam*, 33 F.3d 1354, 1355, 1360 (Fed. Cir. 1994).

Therefore, we sustain the Examiner’s rejection of claims 1-6 and 8-13 under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 14-19 and 21-26

The Examiner also rejected independent claim 14, and its dependent claims, under 35 U.S.C. § 101 as encompassing software per se. (Ans. 10.) In response, Appellants assert that claim 14 pertains to a physical system or apparatus not drawn merely to software embodiments. (App. Br. 13-14; Reply Br. 5-6.)

We are not persuaded by Appellants' argument and agree with the Examiner that the "module to enable," "module to communicate," "module to obtain," and "module to inspect," recited by system claim 14, are not structure or hardware necessary to the performance of their respective functions, but rather software components, under the broadest reasonable interpretation commensurate with the Specification. (*See Spec.* at ¶ [0006].) While these "modules" may be implemented on computer hardware, Appellants' Specification describes that the "modules" may take the form of software, and there is no other recitation provided by the claim which would instantiate any of the instructions contained within these "modules." (*Id.*) "Abstract software code is an idea without physical embodiment." *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 449 (2007).

Accordingly, Appellants have failed to persuade us that independent claim 14, and its dependent claims 15-19 and 21-26, are not merely software per se, under the broadest reasonable interpretation in light of the Specification. As such, we sustain the Examiner's rejection of claims 14-19, and 21-26 under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claims 1-6, 8-19, 21-32, and 34-39 rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

As an initial matter, we do not find the Examiner's Answer to contain any grounds of rejection directed to the second paragraph of 35 U.S.C. § 112. While the Examiner implies that the term "sufficient," is a relative term which renders independent claims 1, 14, and 27 indefinite (Ans. 20-21),

the Examiner fails to make a proper rejection to that effect. In fact, the only discussion of indefiniteness is found in the Response to Arguments section of the Examiner's Answer. (*See* Ans. 17-21.) Therefore, in the absence of such a formal rejection, we make no decision with respect to the Examiner's discussion of indefiniteness.

However, to the extent the Examiner has raised this issue, we do not agree with the Examiner that the term "sufficient" is a relative term, such that it renders independent claims 1, 14, and 27 indefinite. To the contrary, we find that the use of "sufficient" reasonably apprises one of ordinary skill in the art of its scope based on the language of the independent claims. To that effect, we find Examiner's questions go to the scope of the claims, rather than to the definiteness of their claim scope. Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689 (CCPA 1971); *See also Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, (Fed. Cir. 2004) (internal citations omitted) ("[t]he requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles. Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite").

Claims 1-6, 8-19, 21-32, and 34-39 rejected under 35 U.S.C. § 103(a) as unpatentable over Taylor and Ballinger.

Independent claims 1, 14, and 27

Appellants argue *inter alia* that the combination of Taylor and Ballinger fails to teach or suggest:

obtaining at least one indicator from said account of said aggregating entity, said at least one indicator adapted to be created by said aggregating entity based upon at least one event message received from said transaction entity, wherein each indicator contains sufficient information to allow said user to at least identify that a corresponding event of interest has occurred and each indicator only includes text that does not violate a predetermined security and does not disclose the identity of either said user or said transaction entity that communicated the event message

(App. Br. 15; Reply Br. 10.)

To address this limitation, the Examiner relies on the instant messaging service taught by Taylor. (Ans. 23-24; *See also* FF.) In doing so, the Examiner interprets the “indicator” of claims 1, 14, and 27 to be non-functional descriptive material, and as such, gives no weight to the additional recitation of claims 1, 14, and 27 which recite “wherein each indicator contains sufficient information to allow said user to at least identify that a corresponding event of interest has occurred and each indicator only includes text that does not violate a predetermined security and does not disclose the identity of either said user or said transaction entity that communicated the event message.” (Ans. 23.)

In response, Appellants contend that the Examiner erred in asserting that the “indicator” recited by independent claims 1, 14, and 27 is directed to

non-functional descriptive material. (App. Br. 15-16.) Specifically, Appellants argue that “the indicator obtained from the aggregating entity must be structured such that information within the indicator clearly informs a user about the event’s occurrence but does not reveal the identity of the transaction entity or the identity of the user nor does it violate a predetermined security,” and thus, is directed to functional language which must be given patentable weight. (Reply Br. 8-11.)

We are persuaded by Appellants’ argument and agree with Appellants that the “indicator,” as recited by independent claims 1, 14, and 27, is structured such that the indicator contains “sufficient information” to “at least identify that a corresponding event of interest has occurred,” “only includes text that does not violate a predetermined security,” and “not disclose the identity of either said user or said transaction entity that communicated the event message.” (See App. Br. 16; Reply Br. 11.) In making this determination, we find that the independent claims require an “indicator [to] contain[] sufficient information,” and this “sufficient information” *is functionally interrelated to the structure of the indicator*, to an extent that the structure of the indicator depends on the limitations “at least identify[ing] that a corresponding event of interest has occurred,” “only includ[ing] text that does not violate a predetermined security,” and “not disclos[ing] the identity of either said user or said transaction entity that communicated the event message.” Thus, we find a structural and functional relationship exists between how the “indicator” of claims 1, 14, and 27 is created by the aggregating entity, to the extent that the indicator is structured

to include “sufficient information” altered by these additional limitations in order to achieve the utility of the invention.

Accordingly, we find the Examiner erred in failing to give patentable weight to the “indicator” of independent claims 1, 14, and 27, to the extent discussed above, and as such, and as the Examiner failed to show how all of the elements of those claims were taught or suggested by the cited art, we cannot sustain the Examiner’s rejection of claims 1-6, 8-19, 21-32, and 34-39 rejected under 35 U.S.C. § 103(a) as unpatentable over Taylor and Ballinger.

CONCLUSIONS

We conclude that the Examiner did not err in rejecting claims 1-6, 8-19, and 21-26 as directed to non-statutory subject matter under 35 U.S.C. § 101.

We conclude that the Examiner erred in interpreting the “indicator” of independent claims 1, 14, and 27 to be non-functional descriptive material, and as such, erred in rejecting claims 1-6, 8-19, 21-32, and 34-39 under 35 U.S.C. § 103(a) as unpatentable over Taylor and Ballinger.

DECISION

We affirm the Examiner’s rejection of claims 1-6, 8-19, and 21-26.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1).

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Application 11/431,380

AFFIRMED-IN-PART

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