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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AMIP J. SHAH, CHANDRAKANT PATEL, and
CULLEN E. BASH

Appeal 2013-008584
Application 12/237,695¹
Technology Center 3600

Before HUBERT C. LORIN, CYNTHIA L. MURPHY, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Amip J. Shah et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–15. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and enter a NEW GROUND OF REJECTION.

¹ The Appellants identify Hewlett-Packard Development Company, LP as the real party in interest. App. Br. 3.

THE INVENTION

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

1. A method of managing a structure to perform a service, said method comprising:

determining, by a processor, a net power value for implementing the structure;

calculating, by the processor, a structure available energy value from the net power value;

calculating, by the processor, a fuel available energy value from the structure available energy value, wherein the fuel available energy value is a function of the structure available energy value and an environmental sustainability of the structure; and

managing, by the processor, implementation of the structure based upon the calculated fuel available energy value.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Kramer	US 6,757,591 B2	June 29, 2004
Itoh	US 2005/0278040 A1	Dec. 15, 2005
Nojima	US 2007/0038388 A1	Feb. 15, 2007

The following rejections are before us for review:

1. Claims 1–15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention.
2. Claims 1–15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ito, Kramer, and Nojima.

ISSUES

Did the Examiner err in rejecting claims 1–15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention?

Did the Examiner err in rejecting claims 1–15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ito, Kramer, and Nojima?

ANALYSIS

The rejection of claims 1–15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention.

The Examiner states:

Claims 1–5 and 9–15 recite limitation of managing “implementation of the structure” and “implementing the structure”.

Since these claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. The structure or method steps which go to make up the device or method must be clearly and positively specified.

Final Act. 2.

The Examiner’s statements give no indication that the claims have been read in light of the Specification. Nor has a claim construction analysis been conducted in an attempt to ascertain the meaning of the claim terms “implementation” or “implementing.” Rather than clearly explaining why “implementation of the structure” and “implementing the structure” renders

the claims imprecise, the Examiner is demanding more; that is, additional steps be included in the claims before they can be found definite. “If the claims, read in the light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.” *Georgia-Pacific Corp. v. U.S. Plywood Corp.*, 258 F.2d 124, 136 (2d Cir. 1958). Given the lack of explanation, the demand that additional steps be included in the claims reflects a concern over the breadth of the claims. But “[b]readth is not indefiniteness.” *In re Gardner*, 427 F.2d 786, 788 (CCPA 1970).

The rejection of claims 1–15 under 35 U.S.C. §103(a) as being unpatentable over Ito, Kramer, and Nojima.

The Examiner’s position is that Itoh discloses all that is claimed in independent claims 1, 11, and 15

but does not explicitly disclose an invention of calculating a fuel available energy value from the structure available energy value, wherein fuel available energy value is also a function of environmental sustainability of the structure, and managing the structure based upon the calculated fuel available energy value.

Final Act. 4. Kramer is relied upon as disclosing “managing structure to calculate a fuel available energy value from the structure available energy value, and managing the structure based upon the calculated fuel available energy value (Claim 1).” *Id.* Nojima is relied upon for disclosing “fuel available energy value is also a function of environmental sustainability of the structure (figures 10–12 and paragraphs [0072]–[0073]).” *Id.* The Examiner finds that

it would have been obvious for one of ordinary skill in the art of structure management to have modified the invention of Itoh to calculate a fuel available energy value from the structure available energy value, and to manage the structure based upon the calculated fuel available energy value as taught by Kramer and wherein fuel available energy value is also a function of environmental sustainability of the structure as taught by Nojima, in order to manage an environmental friendly structure.

Id.

The Appellants disagree, in part, with the finding that Nojima discloses “fuel available energy value is a function of ... an environmental sustainability of the structure” (claims 1, 11 and 15). App. Br. 14 (emphasis omitted). We agree.

As the Appellants point out, para. 73 of Nojima discloses that

[t]he fuel purchase system of above item (7), adapted to assist the fuel supplier in fuel purchase by providing to the supplier a database inclusive of environmental tax data and global warming coefficient data and setting up a certain object function to minimize costs as well as to minimize environmental pollution.

This passage describes how the fuel purchase system assists a fuel supplier in purchasing fuel using environmental and global warming data. The data – such as “environmentally influential substance emissions (Nojima ¶ 72)”, “costs of . . . fuels manufactured” (*id.*), and global warming coefficient data (*id.* ¶ 73) – helps fuel suppliers make fuel purchases to minimize costs and minimize environmental pollution. We see no disclosure in the cited figures and passages to calculating a fuel available energy value based on the environmental sustainability of the structure as claimed.

Accordingly, because a preponderance of the evidence does not support finding Nojima discloses the claim limitation “fuel available energy

value is a function of . . . an environmental sustainability of the structure” (claims 1, 11 and 15), and there being no other evidence in support thereof, a prima facie case of obviousness has not been made out in the first instance and the rejection cannot be sustained.

NEW GROUND OF REJECTION

Claims 1–15 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

We take the independent claims as representative of the claims on appeal. The three independent claims are nominally directed to a process, an apparatus, and article of manufacture (claims 1, 11, and 15, respectively). However, they are directed to the same mathematical operations; that is, (a) determining A; (b) calculating B from A; (c) calculating C from B where C is a function of B and D; and, (d) managing implementation of a structure based on C; where,

A = a net power value;

B = a structure available energy value;

C = a fuel available energy value; and,

D = an environmental sustainability of the structure.

Equations corresponding to these vaguely claimed mathematical operations are described in the Specification (pages 11–12). As reasonably broadly construed in light of the Specification, the claimed series of operations amount to a mathematical formula. *Cf. In re Maucorps*, 609 F.2d 481 (CCPA 1979). A mathematical formula is an abstract idea. *See Parker v. Flook*, 437 US 584 (1978). Because the claims are directed to a

mathematical formula, an abstract idea, the claims at issue are directed to a patent-ineligible concept.

Turning now to the elements of the claims to determine whether they contain an inventive concept sufficient to transform the claimed mathematical formula into a patent-eligible application, we find none. The steps of “determining” and “managing” fail to transform the formula to an inventive concept as these steps do no more than gather data and present a post-solution activity, respectively. *Cf. id.* at 594 (“Respondent’s process is unpatentable under § 101, not because it contains a mathematical algorithm as one component, but because once that algorithm is assumed to be within the prior art, the application, considered as a whole, contains no patentable invention. Even though a phenomenon of nature or mathematical formula may be well known, an inventive application of the principle may be patented. Conversely, the discovery of such a phenomenon cannot support a patent unless there is some other inventive concept in its application.”)

The repeated use of the term “processor” in claim 1 and “module” in claim 11 and the phrase “one or more computer programs comprising a set of instructions” in claim 15 do not add anything of inventive significance because they cover employing a general purpose computer. “[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2358 (2014). We see nothing in the Specification that would suggest otherwise. The discussion therein describes employing known electronic devices. *See, e.g.*, Spec., para. 17.

Therefore, we enter a new ground of rejection of claims 1–15 under 35 U.S.C. § 101.

For the foregoing reasons, the rejections are reversed but the claims are newly rejected under § 101.

CONCLUSIONS

The rejection of claims 1–15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention is reversed.

The rejection of claims 1–15 under 35 U.S.C. § 103(a) as being unpatentable over Ito, Kramer, and Nojima is reversed.

Claims 1–15 are newly rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

DECISION

The decision of the Examiner to reject claims 1–15 is reversed.

Claims 1–15 are newly rejected.

NEW GROUND

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(s), 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

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

REVERSED; 37 C.F.R. § 41.50(b)