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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NATHAN VICTOR BAK, ELIZABETH BARUKA SILBERG,
YELENA BAYEVA, SUKADEV BHATTIPROLU, and
ALEXIS HOPE BRUEMMER

Appeal 2013-009289^{1,2}
Application 12/822,772
Technology Center 3600

Before JOSEPH A. FISCHETTI, PHILIP J. HOFFMANN, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

HOFFMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

¹ Our decision references Appellants’ Specification (“Spec.,” July 29, 2010), Appeal Brief (“Appeal Br.,” filed Apr. 4, 2013), and Reply Brief (“Reply Br.,” filed July 16, 2013), as well as the Final Office Action (“Final Action,” mailed Oct. 3, 2012) and the Examiner’s Answer (“Answer,” mailed June 13, 2013).

² Appellants identify the real party in interest as “International Business Machines Corporation.” Appeal Br. 2.

We AFFIRM-IN-PART, and to the extent that our rationale differs from that of the Examiner, we designate a rejection as a NEW GROUND OF REJECTION PURSUANT TO 37 C.F.R. § 41.50(b).

According to Appellants, “the invention relates to the automated scheduling of meetings on calendars and the organization of such calendars of invitees based upon the importance of a set of predetermined attributes of such meetings.” Spec. 1. We reproduce below independent claim 1, as representative of the appealed claims.

1. In a network of computer controlled user interactive display stations, a method for the scheduling of meetings on the calendars of invitee users comprising:

prompting an inviter, at a sending display station, to enter into an invitation a predetermined set of general attributes for the scheduled meeting;

enabling each invitee to predetermine a set of invitee-specific attributes applicable to each invitation; and

enabling each invitee to prioritize each predetermined general attribute and each invitee-specific attribute to a numerical priority level to determine the priority of said meeting on the invitee’s calendar.

Appeal Br., Claims App.

REJECTIONS AND PRIOR ART

The Examiner rejects the claims as follows:

claims 1–8 under 35 U.S.C. § 101 as directed to non-statutory subject matter;

claims 1, 9, and 13 under 35 U.S.C. § 103(a) as unpatentable over Olliphant (US 2010/0293029 A1, pub. Nov. 18, 2010) and O’Sullivan (US 2006/0271419 A1, pub. Nov. 30, 2006); and

claims 2–8, 10–12, and 14–20 under 35 U.S.C. § 103(a) as unpatentable over Olliphant, O’Sullivan, and Doss (US 2004/0093290 A1, pub. May 13, 2004).

See Final Action 5–35; *see also* Answer 3.

ANALYSIS

Section 101 rejection

The Examiner rejects independent claim 1, as well as claims 2–8 depending therefrom, under 35 U.S.C. § 101(a) as directed to non-statutory subject matter. Final Action 5. The Examiner first determines that “none of the recited steps in claim 1 are explicitly or inherently performed using a particular machine; thus, no particular machine imposes a meaningful limit on the scope of the claims.” *Id.* at 8. The Examiner also determines that in claim 1 “no subject matter transforms into a different state or thing.” *Id.* With reference to the memoranda “Guidance for Examining Process Claims in view of *In re Bilski*” (signed 7 January 2009) and “Interim Examination Instructions For Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101” (signed 24 August 2009),³ the Examiner determines that Appellants’ method of scheduling meetings on calendars of invitee users is an abstract idea that is not eligible for patenting. *See id.* at 8–9.

Conversely, Appellants argue the claims are patent eligible in accordance with the requirements of *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008). Specifically, Appellants argue that “the method instructions carried out are tied to a machine, a user interactive computer controlled display

³ Both memoranda are available at <http://www.uspto.gov/web/patents/memoranda.htm>.

station in a network of such display stations.” Appeal Br. 8. Appellants further argue that “the method steps do make a tangible transformation[,] i.e. the two prioritized sets of attributes are correlated into a meeting schedule for an invitee in a general meeting between invitees. This is a transformation of the two attribute sets into a meeting scheduled between network display stations.” *Id.*

After the mailing of the Examiner’s Answer, the Supreme Court issued its decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347 (2014), which explains the law as it relates to patent-eligible subject matter. The claims in *Alice* were directed to a “method of exchanging obligations as between parties.” *Alice*, 134 S.Ct. at 2352 n.2. In *Alice*, the Supreme Court discussed its prior decision in *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 132 S.Ct. 1289 (2012) and explained:

In *Mayo* . . . we 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. First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . If so, we then ask, “[w]hat else is there in the claims before us?” To answer that question, we 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. We have described step two of this 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.”

Alice, 134 S.Ct. at 2355 (citations omitted). Thus, to determine whether a claim is eligible for patenting, we first must determine whether the claim is directed to a patent-ineligible concept (such as an abstract idea) and, if so,

we must determine whether there is something else in the claim which ensures that the claim is directed to “significantly more” than a patent-ineligible concept.

Are the claims at issue directed to a patent-ineligible concept?

In this case, claim 1 recites a method of scheduling meetings on calendars of invitee users includes prompting an inviter (at a sending display station) to enter into an invitation a predetermined set of general attributes for the scheduled meeting, enabling each invitee to predetermine a set of invitee-specific attributes applicable to each invitation, and enabling each invitee to prioritize each predetermined general attribute and each invitee-specific attribute to a numerical priority level to determine the priority of the meeting on the invitee’s calendar. We determine that, when read as a whole, independent claim 1 constitutes a patent-ineligible abstract idea—i.e., the claim is directed to the abstract idea of scheduling a meeting.

Is there something else in the claim which ensures that the claim is directed to “significantly more” than a patent-ineligible concept?

Inasmuch as we determine claim 1 is directed to an abstract idea, according to *Alice*, the question to be settled next is whether claim 1 recites an element or combination of elements that ensure that the claim is directed to “significantly more” than the abstract idea. *See Alice*, 134 S. Ct. at 2357 (“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. 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].’”) (citation omitted). In this case, to the extent that claim 1 requires a network of computer controlled user interactive display stations and a sending display

station, we determine that the recitation of such generic component is insufficient to transform the nature of the claim into a patent-eligible application.

Taking the elements of claim 1 separately, for example, the function performed by the computer display at the claimed step of the process is purely conventional. We are unpersuaded that using a sending display station to prompt an inviter to enter, into an invitation, a predetermined set of general attributes for the scheduled meeting is anything other than one of the basic functions of a computer. Thus, we are unpersuaded that this computer function is anything other than well-understood, routine, conventional activity previously known to the industry. In short, the step does no more than require a generic computer to perform generic computer functions, such as communicating with other devices.

Based on the foregoing, we agree with the Examiner that independent claim 1, and claims 2–8 depending on claim 1 which Appellants do not argue separately, are directed to non-statutory subject matter. To the extent that our rationale differs from that of the Examiner, we designate the rejection of claims 1–8 under 35 U.S.C. § 101(a) a NEW GROUND OF REJECTION PURSUANT TO 37 C.F.R. § 41.50(b).

Section 103 rejections

Independent claim 1, from which claims 2-8 depend, requires the following limitations:

prompting an *inviter*, at a sending display station, *to enter* into an invitation *a predetermined set of general attributes* for the scheduled meeting;

enabling each *invitee to predetermine a set of invitee-specific attributes* applicable to each invitation; and

enabling each *invitee to prioritize each predetermined general attribute and each invitee-specific attribute to a numerical priority level to determine the priority of said meeting* on the invitee's calendar.

Appeal Br., Claims App. (emphases added). Independent claims 9 and 13, from which claims 10–12 and 14–20 respectively depend, require similar limitations. *See id.* Thus, each of the claims requires that *an invitee prioritize* its own attributes as well as attributes entered by the inviter, and that this information is used to determine a priority of the meeting. Appellants argue that neither reference discloses or suggests the claimed *prioritization by the invitee*, and that such prioritization determines the priority of the meeting. *See* Appeal Br. 9–11; *see also* Reply Br. 1–2. We agree with Appellants. Although the Examiner relies on paragraphs 3, 56, 62, and 63 in Olliphant, none of these paragraphs cited by the Examiner discloses that an appointment is scheduled based on any prioritization of the invitee's attributes by the invitee, and that a priority of the scheduled meeting is based on such prioritization. *See* Final Action 11–12; *see also* Answer 6–7. In fact, even the example cited by the Examiner from paragraph 65 of Olliphant does not disclose any prioritization of attributes by an invitee or that a meeting is of any particular priority—instead the example proposes that a meeting is scheduled when users' preference information matches. *See* Answer 7 (“[I]f the first user likes restaurant[s] A and . . . B and . . . not . . . C, while the second user likes restaurant[s] D and . . . B, but . . . not . . . A, then a proposed appointment (e.g., a lunch) including both . . . user[s] will be scheduled at restaurant B, rather than restaurant A or . . . D.”).

Based on the foregoing, we do not sustain the obviousness rejections of claims 1–20.

DECISION

We REVERSE the Examiner’s rejections of claims 1–20 under 35 U.S.C. § 103.

We AFFIRM the Examiner’s rejection of claims 1–8 under 35 U.S.C. § 101 as directed to non-statutory subject matter. To the extent our rationale differs from that set forth by the Examiner, we designate this rejection as a NEW GROUND OF REJECTION.

Section 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Thus, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, Appellants 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; or
- (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record.

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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-IN-PART, 37 C.F.R. § 41.50(b)

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