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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JONATHAN R. SCHROEDER

Appeal 2013-010979
Application 12/846,538[1]
Technology Center 3600

Before HUBERT C. LORIN, NINA L. MEDLOCK, and KENNETH G. SCHOPFER, Administrative Patent Judges.

LORIN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Jonathan R. Schroeder (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's Final rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

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[1] The Appellant identifies Pacific Bearing Company as the real party in interest. App. Br. 2.

THE INVENTION

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

1. A method of configuring an actuation system comprising:

establishing a connection, via an electronic communication network, with a linear actuation system customer;

receiving data from the linear actuation system customer that includes customer requirements for a linear actuation system, the data transmitted over the electronic communication network;

presenting the customer with a series of options, based on the customer requirements, from which to select components for the linear actuation system;

configuring a linear actuation system having multiple component parts based on customer selections; and

displaying a scaled representation of the linear actuation system that includes the components selected by the customer.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Bjornson et al. ("Bjornson")	US 6,173,210 B1	Jan. 9, 2001
Koren	US 2007/0156540 A1	July 5, 2007

The following rejections are before us for review:

1. Claims 1–9 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.
2. Claims 1–16 and 18–20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bjornson.

3. Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over Bjornson and Koren.

ISSUES

Did the Examiner err in rejecting claims 1–9 under 35 U.S.C. §101 as being directed to non-statutory subject matter?

Did the Examiner err in rejecting claims 1–16 and 18–20 under 35 U.S.C. §103(a) as being unpatentable over Bjornson?

Did the Examiner err in rejecting claim 17 under 35 U.S.C. §103(a) as being unpatentable over Bjornson and Koren?

FINDINGS OF FACT

We rely on the Examiner's factual findings stated in the Answer. Additional findings of fact may appear in the Analysis below.

ANALYSIS

The rejection of claims 1–9 under 35 U.S.C. §101 as being directed to non-statutory subject matter.

The Appellant argued claims 1–9 as a group (App. Br. 5–6). We select claim 1 as the representative claim for this group, and the remaining claims 2–9 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Notwithstanding that the framework for determining patent-eligible subject matter that was applied in the Final Rejection (mailed Dec. 13, 2012) — i.e., the "machine-or-transformation" test — has since changed (see *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S. Ct. 2347 (2014)), we make these observations about the Appellant's response.

First, the Appellant argues that the claimed subject matter satisfies the "machine" prong of that former test because "the electronic communication network is central to every step in claim 1." App. Br. 5. That is not a persuasive argument.

The generic claim phrase "the electronic communication network" provides no meaningful limit on the scope of the method claimed. The generic claim phrase "the electronic communication network" covers the well-known "internet" (*see* Specification, para. 30). There is no evidence that when, for example, the "internet" is used to perform the process as claimed anything but its most basic functions are involved (i.e., "establishing a connection" and transmitting data (see first two steps in claim 1). *See Cf. Bancorp Servs., L.L.C., v. Sun Life Assurance Co. of Cananda*, 687 F.3d 1266 (Fed. Cir. 2012) ("The computer required by some of Bancorp's claims is employed only for its most basic function, the performance of repetitive calculations, and as such does not impose meaningful limits on the scope of those claims.")

The Appellant also argue that "the electronic communication network is *central* to every step in claim 1." App. Br. 5 (emphasis added). However, we do not see that the scope of the method claimed, which is not meaningfully limited by the inclusion of the generic claim phrase "the electronic communication network," is limited any more meaningfully by expressing, *per se*, that said "electronic communication network" is employed to practice *all* the steps as claimed. Be that as it may, claim 1 does not in fact say that "the electronic communication network" is employed to practice all the steps as claimed. *Id.* A plain reading of the

claim reveals that only the first two steps of the claim require using an "electronic communication network;" the last three steps do not – none of which requires using a device. On that point — that "the electronic communication network is *central* to every step in claim 1" (App. Br. 5, (emphasis added)) — the Appellant's argument is not commensurate in scope with what is claimed.

Second, the Appellant argues that the claimed subject matter satisfies the "transformation" prong of the "machine-or-transformation" test because it "call[s] for the transformation of data representing customer requirements into a physical representation of a linear actuator system, wherein the physical representation is transmitted over an electronic network to be displayed on a user's computer display." App. Br. 6. That is not a persuasive argument. It is not based on a reasonable construction of what is claimed. Claim 1 is far broader than argued. Claim 1 requires neither (a) "transformation of data representing customer requirements into a physical representation of a linear actuator system" nor (b) that "[a] physical representation is transmitted over an electronic network to be displayed on a user's computer display." Rather, the claim 1 process simply presents selectable options for a configuration, makes a configuration based on the options selected, and displays a scaled representation of said configuration. Nonetheless, even if the argument was undergirded by a reasonably broad construction of the claim, there is insufficient evidence on record to support Appellant's argument that the claim 1 method "transforms" data.

Accordingly, for the foregoing reasons, the Appellant's arguments challenging the rejection of claims 1–9 under 35 USC 101, under the framework articulated in the Final Rejection, are unpersuasive as to error.

The Examiner's finding that the subject matter of claims 1-9 is patent-ineligible is not affected by the current framework. *Alice* identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under §101. According to *Alice* step one, "[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept," such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

Taking claim 1 as representative of the claims on appeal, the claimed subject matter is directed to customer-driven product design. Customer-driven product design is a fundamental economic practice. As such, it is directed to an abstract idea.

Step two is "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.'" *Id.*

We see nothing in the subject matter claimed that transforms the abstract idea of customer-driven product design into an inventive concept. Claim 1 reasonably broadly covers the "internet" (*see* Specification para. 30) employed to perform its common functions of "establishing a connection" and transmitting data and then, without a device, performing such common activities as presenting a customer with selectable options, making a product configuration based on what is selected; and then displaying the result —

i.e., a scaled representation of said product configuration. The abstract idea of customer-driven product design is not meaningfully transformed by including the "internet" and then, without any device, presenting a customer with selectable options for a displayable product configuration.

Thus, the rejection of claims 1–10 under 35 U.S.C. § 101 is sustained.

The rejection of claims 1-–16 and 18-–20 under 35 U.S.C. §103(a) as being unpatentable over Bjornson.

The Appellant mentions certain phrases recited in claims 1 and 10 but otherwise argues these claims as a group. *See* App. Br. 8–10. We select claims 1 and 10 as the representative claims for this group, and the remaining claims 2–9, 11–16 and 18–20 stand or fall with claims 1 and 10. 37 C.F.R. § 41.37(c)(1)(iv).

The Appellant argues that "the [Bjornson] apparatus does not perform any system configuration, as required by claim 1" (App. Br. 8) and "the [Bjornson] apparatus does not perform any transformation of the data received from the customer, nor does it perform any system configuration, as required by claims 1 and 10." App. Br. 8. The arguments are unpersuasive as to error in the rejection.

We agree with the Examiner (*see* Final Act. 4) that Fig. 33 depicts a configuration. *See* Bjornson, col. 39, lines 11–12 ("A side view of the seal provides an actual representation of the seal construction."). Furthermore, the Appellant admits that, given Bjornson, "[t]he user can view the relevant pump and choose from a number of seals that can be used in that pump." App. Br. 8. That being the case, Bjornson necessarily presents a customer

with selectable options, transforming a product configuration based on what is selected; and then displaying the result (i.e., a pump with a chosen seal).

If there is a difference between Bjornson and what is claimed, it resides in the product being designed. To be more accurate, the difference lies in the content of the information to represent a particular product to be designed. That is to say, both Bjornson and the claimed processes use selectable options to design a displayable configuration. However, in the claimed method, the configuration describes a linear actuation system while in Bjornson a pump with a seal is described.

We agree with the Examiner that:

> [t]he steps of establishing a connection, receiving data, presenting options based on the data, configuring a system based on the selected options and displayed a representation of the product based on selected options would all be performed in the same manner regardless of whether the product was a component pump seal, a linear actuation system, a computer, a car or any product comprised of parts or components.

Ans. 7. There is insufficient evidence that using the "internet" to perform its common functions of "establishing a connection" and transmitting data and then, without a device, performing such common activities as presenting a customer with selectable options, making a product configuration based on what is selected; and then displaying the result — i.e., a scaled representation of said product configuration — is functionally affected by describing a "linear actuation system." It is reasonable to characterize the information related to a "linear actuation system" as printed matter. Given that printed matter is not given patentable weight, the "linear actuation system" claim limitations — as a distinction between the Appellant's method and that of Bjornson — are not patentably consequential. They

amount to nonfunctional descriptive material. "[N]on-functional descriptive material, being useful and intelligible only to the human mind, is given no patentable weight." *Ex parte Graf*, Appeal 2012-003941, 2013 WL 3873066, at *4 (PTAB July 23, 2013) (non-precedential), *aff'd*, *In re Graf*, 585 F. App'x. 1012 (Fed. Cir. 2014) (non-precedential); *cf. In re DiStefano*, No. 2015–1453 (Fed. Cir. 2015); *as explained in In re Xiao*, 462 F.App'x. 947, 950–52 (Fed. Cir. 2011) (non-precedential):

> [T]he Board did not create a new "mental distinctions" rule in denying patentable weight . . . . On the contrary, the Board simply expressed the above-described functional relationship standard in an alternative formulation—consistent with our precedents—when it concluded that any given position label's function . . . is a distinction "discernable only to the human mind." Board Decision at 6; *see In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (describing printed matter as "useful and intelligible only to the human mind") (quoting *In re Bernhart*, 417 F.2d 1395, 1399 (CCPA 1969)).

"The rationale behind this line of cases is preventing the indefinite patenting of known products by the simple inclusion of novel, yet functionally unrelated limitations." *King Pharms., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1279 (Fed. Cir. 2010).

We should also point out that the argued-over configuring step in claim 1 and the transforming step in claim 10 are not required to be performed via a device. As claimed, they add to the remaining claimed subject matter nothing more than steps which could be performed in the human mind. The distinction between these steps over the prior art, notwithstanding they relate to a "linear actuation system," is one that is "useful and intelligible only to the human mind." *Lowry*, 32 F.3d at 1583 (citing *In re Bernhart,* 417 F.2d 1395, 1399 (Fed. Cir. 1969)). Such a

distinction carries no patentable weight. As already noted, "[t]he rationale behind this line of cases is preventing the indefinite patenting of known products by the simple inclusion of novel, yet functionally unrelated limitations." *King Pharms., Inc.*, 616 F.3d at 1279.

For the foregoing reasons, the Appellant's arguments are unpersuasive as to error in the rejection. The rejection is sustained.

The rejection of claim 17 under 35 U.S.C. §103(a) as being unpatentable over Njornson and Koren.

Claim 17 further limits the method of claim 10 so that "the information received from the customer [is transformed] into 3D computer-aided-design models." The Examiner relied on Koren as evidence that said transformation was known. *See* Final Act. 8. This is not challenged. Rather the Appellant focuses on limitations carried over from claim 10 and repeats the arguments used to challenge the rejection of claims 1 and 10. App. Br. 9. Those arguments were found unpersuasive (see above) and remain unpersuasive albeit to challenge the rejection of dependent claim 17. The rejection of claim 17 is sustained.

CONCLUSIONS

The rejection of claims 1–9 under 35 U.S.C. §101 as being directed to non-statutory subject matter is sustained.

The rejection of claims 1–16 and 18–20 under 35 U.S.C. §103(a) as being unpatentable over Bjornson is sustained.

The rejection of claim 17 under 35 U.S.C. §103(a) as being unpatentable over Bjornson and Koren is sustained.

DECISION

The decision of the Examiner to reject 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