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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* CHARLES AUSTIN CROPPER

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Appeal 2014-001403  
Application 12/844,917<sup>1</sup>  
Technology Center 3600

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Before: BIBHU R. MOHANTY, BRUCE T. WIEDER, and  
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–21. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> According to the Appellant, the real party in interest is Dr. Charles Austin Cooper. Appeal Br. 1.

### ILLUSTRATIVE CLAIM

1. A method performed by a special purpose processing system for providing access to an individual's stored personal records, the method comprising:

causing presenting of a plurality of questions to the individual through a terminal, wherein the plurality of questions relate to the individual's personal history contained in the individual's stored personal records;

receiving personal history information related to specific episodes for the individual responsive to the plurality of questions from the individual through the terminal;

comparing the received personal history information to a plurality of personal records stored in at least one database and associated with a plurality of individuals to determine a first set of records;

causing presenting through the terminal further questions to the individual to determine a record subset of the first set of records, wherein the record subset contains records associated with a portion of the plurality of individuals;

receiving further personal history information for the individual through the terminal;

further comparing the further personal history information to the record subset;

identifying, based at least in part on the further comparing, target personal records related to the individual to at least a threshold degree of certainty; and

providing data for the target personal records to the terminal.

## REJECTIONS<sup>2</sup>

I. Claims 1–7 are rejected under 35 U.S.C. § 101 as unpatentable subject matter.

II. Claims 1–7 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

III. Claims 1–21 are rejected under 35 U.S.C. § 103(a) as unpatentable over Marshall (US 2008/0133273 A1, published June 5, 2008) and Jakobsson (US 2011/0314559 A1, published Dec. 22, 2011).<sup>3</sup>

IV. Claims 1–21 are rejected under 35 U.S.C. § 103(a) as unpatentable over Marshall and Calver (US 2001/0032092 A1, published Oct. 18, 2001).

## FINDINGS OF FACT

The findings of fact relied upon, which are supported by a preponderance of the evidence, appear in the following Analysis.

## ANALYSIS

### *Rejection I*

With regard to the rejection of claims 1–7 under 35 U.S.C. § 101, the Final Rejection (October 19, 2012) applied essentially only the machine-or-transformation test for assessing whether the subject matter of these claims

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<sup>2</sup> The Final Action also states that claims 1–21 are unpatentable over Marshall and Yanagihara (US 2011/0191838 A1, published Aug. 4, 2011). Final Action 13–16. This rejection is withdrawn. Answer 2.

<sup>3</sup> The Final Action characterizes a rejection under 35 U.S.C. § 103(a) as based upon Marshall in view of Jakobsson or Calver. Final Action 9. This rejection is set forth herein as two rejections: Rejection III (based on Marshall and Jakobsson); and Rejection IV (based on Marshall and Calver).

would be eligible for patenting. Final Action 5–7. However, more than two years earlier, the Supreme Court’s decision in *Bilski v. Kappos*, 561 U.S. 593 (2010) had already modified the analysis of non-statutory subject matter, by holding that a patent claim’s failure to satisfy the machine-or transformation test is not dispositive of the inquiry. Further, USPTO guidance memoranda regarding the Supreme Court’s *Bilski* decision were provided to the Patent Examining Corps on June 28, 2010 (the day the opinion was published) and on July 27, 2010 – both more than two years prior to the Final Action.

Also predating the Final Action is the Supreme Court’s decision in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 10 (2012) (dated March 20, 2012), which further articulated the analysis of patent-eligible subject matter under 35 U.S.C. § 101.

Accordingly, there has been insufficient analysis of the claim language of claims 1–7 to establish a prima facie case of patent-ineligible subject matter under 35 U.S.C. § 101, such that the rejection of these claims is not sustained.

### ***Rejection II***

The Final Action identifies two grounds of indefiniteness as to claim 1 (and thus as to claims 2–7, depending therefrom), which are discussed in turn below. Final Action 7.<sup>4</sup> Because the Appellant’s arguments are persuasive, the rejection of claims 1–7 under 35 U.S.C. § 112, second paragraph, is not sustained.

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<sup>4</sup> The Examiner’s Answer appears to identify further grounds of indefiniteness that were not set forth in the Final Action. *See* Answer 4–5 (items numbered 1–3). Such further grounds are not designated as new grounds of rejection pursuant to 37 C.F.R. § 41.39(a)(2) and thus are not addressed herein.

**1. “*identifying . . . to at least a threshold degree of certainty*”**

In the claimed “*identifying . . . target personal records related to the individual to at least a threshold degree of certainty*” (Appeal Br. 26, Claims App. (emphasis added)), the Examiner states that “the phrase ‘to at least a threshold degree of certainty’ appears to be related to the ‘matching’ feature and not ‘identifying’” (Final Action 7).

The Appellant argues that the Examiner is referring to a previous version of the claim limitation (employing the now-deleted word “matching”) and that the claimed limitation, in its present form, is not indefinite and the notion of “identify[ing]” something to a “threshold degree of certainty” is “a basic concept” that would be understandable to a person of ordinary skill. Appeal Br. 7–8.

The Examiner’s Answer states that the phrase “at least a threshold degree of certainty” is “normally used in a ‘comparison’ or ‘matching’ of two more [sic] items” (and is used as such in the Specification), whereas once something “is identified, it’s being identified completely,” such that the claim “does not make sense.” Answer 5–6 (citing Spec. ¶ 51).

The Appellant’s argument is persuasive because an item may be identified to a specified degree of certainty. The use of the word “identifying” (as opposed to “matching” or “comparing”) does not render the claim limitation indefinite.

**2. “*providing data for the target personal records to the terminal*”**

In regard to the claimed “providing data for the target personal records to the terminal” (Appeal Br. 26, Claims App.), the Examiner asks: “[W]hy ‘providing data’ for the ‘target personal records’ and . . . why [‘]to

the terminal’?” (Final Action 7). The Final Action further states that the phrasing “should be ‘providing the records *to the individual*’ as shown in other independent claims.” *Id.* (emphasis added); *see also* Answer 6–7.

The Appellant contends that the independent claims need not employ identical terms and that the choice of drafting claim 1 such that “data” is provided to the “terminal” does not give rise to indefiniteness. Appeal Br. 9.

The Appellant’s argument is persuasive because claim 1 is drawn in terms of various interactions involving the “terminal.” Accordingly, the claimed feature of “providing data . . . to the terminal” is consistent with other language in the claim and does not render the claim indefinite.

### ***Rejection III***

Claims 1–21 are rejected under 35 U.S.C. § 103(a) as unpatentable over Marshall and Jakobsson.

The Appellant argues that Jakobsson is not prior art. As explained below, this argument is not persuasive.

The Appellant also argues that the claims are not obvious over Marshall and Jakobsson. As explained below, this argument is persuasive, such that the rejection of claims 1–21 is not sustained.

#### **1. Prior Art Status of Jakobsson**

The application that is the subject of this Appeal has an effective filing date of July 28, 2010. Appeal Br. 10. Jakobsson is a published non-provisional patent application that was filed on June 15, 2011, but which claims priority to a provisional application filed on June 16, 2010. *Id.* Thus, if Jakobsson is afforded the filing date of its related provisional application,

then it would constitute prior art, under 35 U.S.C. § 102(e)(1) (Pre-AIA),<sup>5</sup> in regard to the subject application of this Appeal.

The Appellant argues that Jakobsson is not prior art because the Examiner has not demonstrated that the Jakobsson provisional application supports the subject matter relied upon for the obviousness rejection.

Appeal Br. 10.

In order for the filing date of a provisional application to apply to a published patent document, for prior art purposes, the relevant disclosure of the published patent document must be “carried forward” from the provisional application. *See In re Giacomini*, 612 F.3d 1380, 1383 (Fed. Cir. 2010). In addition, “[a]n important limitation is that the provisional application must provide written description support for the claimed invention.” *Id.*; *see also Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1381–82 (Fed. Cir. 2015). Although *Giacomini* and *Dynamic Drinkware* involved the prior art status of issued patents, per 35 U.S.C. § 102(e)(2) (Pre-AIA) — as opposed to a published application, like Jakobsson, which is treated under § 102(e)(1) (Pre-AIA) — the requirements set forth in *Giacomini* apply here, nevertheless. *See Ariosa Diagnostics, Inc. v. Illumina, Inc.*, 2016 WL 354412 at \*11 (PTAB 2016).

As to the first requirement — i.e., whether the relevant disclosure of Jakobsson has been carried forward from its provisional application — the Appellant states that “obvious differences” exist between the two applications, that the provisional application “appears much shorter,” and

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<sup>5</sup> Because the subject application of this Appeal has an effective filing date earlier than March 16, 2013, the pre-AIA version of the statute is applied herein.

that the provisional application has fewer figures that also differ in some respect from those of the published application. Appeal Br. 11. Yet, as the Examiner states, the Appellant does not contend (and therefore does not show) that the provisional application lacks the relevant disclosure of the published Jakobsson application. Answer 7. Therefore, the Appellant's argument on this ground is unpersuasive.

The Appellant does not address the second requirement — i.e., whether the Jakobsson provisional application provides written description support for the claimed subject matter of the published Jakobsson application. Therefore, any allegation of error on this ground is waived. *See Hyatt v. Dudas*, 551, F.3d 1307, 1313–14 (Fed. Cir. 2008); *see also Giacomini*, 612 F.3d at 1383–84.

Accordingly, the Appellant's argument that Jakobsson does not constitute prior art is not persuasive.

## **2. Whether the Prior Art of Record Teaches the Claimed Subject Matter**

The Appellant contends that no combination of Marshall and Jakobsson teaches the presentation of authentication questions that, per claim 1, “**relate to the individual's personal history** contained in the individual's stored personal records” to which access is sought. Appeal Br. 14.

According to the Final Action, Marshall discloses this feature. Final Action 9 (citing Marshall Figs. 1, 2, 3A, 4, 5, 7, and ¶ 31). Yet, as the Appellant shows, none of the cited portions of Marshall teaches authorization questions based upon the stored records to which access is sought. *See* Appeal Br. 14–15. The Answer does not address this issue.

Therefore, the Appellant's argument that the Examiner erred in rejecting claim 1 (and claims 2–7, which are dependent thereon) is persuasive.

Like independent claim 1, each of the other two independent claims (claims 8 and 15) requires authentication questions based upon information contained in the records to which access is sought. *See* Appeal Br. 28, 40 (Claims App.); *see also* Final Action 9. Accordingly, the Appellant's argument that the Examiner erred in rejecting claims 8 and 15, as well as the claims dependent thereon (claims 9–14 and 16–21), is persuasive.

#### ***Rejection IV***

As the Appellant contends (Appeal Br. 10), aside from stating that the claims are obvious over Marshall and Calver (Final Action 9), the Final Action does not otherwise address or explain this proposed alternative ground of rejection. Nor does any such explanation appear in the Answer. Accordingly, such alternative ground of rejection is not sustained.

#### **DECISION**

We reverse the Examiner's decision rejecting claims 1–21.

#### **REVERSED**