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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DANIEL J. BUDNIK and SHIH-LIEN LEON CHU

Appeal 2014-005879
Application 11/809,660
Technology Center 3600

Before HUBERT C. LORIN, BIBHU R. MOHANTY, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

BAYAT, *Administrative Patent Judge*.

DECISION ON APPEAL¹

STATEMENT OF CASE

Appellants² appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–11 and 13–20. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE DECISION

We REVERSE and enter a NEW GROUND OF REJECTION.

¹ Our decision references Appellants' Appeal Brief ("Br.," filed Jan. 27, 2014), the Examiner's Answer ("Ans.," mailed Mar. 11, 2014), and the Final Office Action ("Final Act.," mailed July 29, 2013).

² Appellants identify the real party in interest as "United Technologies Corporation" (Br. 1).

CLAIMED INVENTION

The claimed invention relates to “configuration valid bills of material planning and auditing” (Spec. ¶ 1). Claims 1 and 9 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the subject matter on appeal (Br. 15, Claims App.).

1. A computer-implemented process for planning a configuration valid bill of materials for a product, comprising:

inputting at least one MOD from a MOD list into a planning module in a computer to generate a part genealogy of a product;

using said computer to identify a senior MOD of said MOD list based upon a progression level value and a ranking value for at least one location identifier;

determining a shortest path in said part genealogy from at least one base-part of said product to said senior MOD for said at least one location identifier using said computer;

identifying a complete progression from each of said at least one base parts to each corresponding said at least one senior MODs for each of said at least one location identifiers using said computer;

generating a configuration valid bill of materials for said product using said computer; and

conveying said configuration valid bill of materials.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Hawman	US 2003/0040826 A1	Feb. 27, 2003
Knight	US 2009/0070296 A1	Mar. 12, 2009

Claims 1–11 and 13–20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Knight and Hawman.³

ANALYSIS

Independent claim 1 requires, *inter alia*, “using said computer to identify a senior MOD of said MOD list based upon a progression level value and a ranking value for at least one location identifier” (Br. 15, Claims App.).

The Examiner finds the claimed “progression level” in the hierarchical arrangement of elements of a product disclosed in, *inter alia*, paragraphs 64, 66, 100, 101, and 105 of Knight (Final Act. 2–8). According to the Examiner, “Appellant's published Specification in paragraphs [0048 and 0052] defines ‘progression level’ as the level of indenture for each part number and service bulletin combination with the location identifier (LD) genealogy tree.” (Ans. 5).

Appellants dispute this finding (Br. 6–10). We are persuaded by Appellants’ arguments.

With respect to the “progression level” of claim 1, we agree with the Examiner’s interpretation in light of paragraph 52 of the Specification. What is missing from the rejection is any explanation for how the limitation, as construed by the Examiner, is found in Knight. Specifically, the Examiner has not made any finding for a “level of indenture,” nor has the

³ Although the Examiner ostensibly relies on Hawman in the heading of the rejection, the Examiner only actually makes findings in Hawman with respect to claims 8, 10, 11, 13, and 16–20 (*see* Final Act.).

Examiner made any finding for “part number and service bulletin combination with the location identifier (LID).”

A rejection based on § 103 clearly must rest on a factual basis. The Examiner has the initial duty of supplying the factual basis for the rejection and may not resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in its factual basis. We have reviewed the cited portions of Knight, and we see no disclosure of “level of indenture,” or “part number and service bulletin combination with the location identifier (LID).” Thus, we fail to see and the Examiner does not adequately explain how Knight discloses a “progression level” as required by claim 1.

Accordingly, we do not sustain the rejection of independent claim 1 as obvious over Knight and Hawman. Independent claim 9 similarly requires “a progression level” and the Examiner’s findings regarding this limitation are also deficient as in claim 1. For the same reasons, we do not sustain the rejection of dependent claims 2–8, 10, 11, and 13–20. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

NEW GROUND OF REJECTION

Claims 1–11 and 13–20 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Alice Corp. Pty. Ltd. v. CLS Bank Intern., 134 S. Ct. 2347 (2014), 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 independent claims 1 and 9 as representative of the claims on appeal, the claimed subject matter is directed to configuration planning and configuration auditing.

Appellants’ Specification indicates that configuration planning (claim 1) and configuration auditing (claim 9) are conventionally done manually but consume a significant amount of time and require multiple audits to ensure accuracy (*see* Spec. ¶¶ 4–8). Therefore, the claims are directed to a computer-implemented process for automating a task that was conventionally performed manually. As such, the claims are directed to an abstract idea. Specifically, claim 1 is directed to the abstract idea of configuration planning, and claim 9 is directed to the abstract idea of configuration auditing.

Step two of the *Alice* framework 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.’” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289).

In that regard, we see nothing in the subject matter claimed that transforms the abstract idea of configuration planning or configuration auditing into an inventive concept.

Claim 1 describes a “computer-implemented process” for planning a configuration. The configuration planning of claim 1 inputs conventional MOD data into “a planning module,” identifies a senior MOD, determines a

shortest path to the senior MOD, identifies a complete progression for each location identifier, generates a configuration, and conveys the configuration.

Claim 9 describes a “computer-implemented process” for auditing a bill of material. The auditing process of claim 9 includes dispositioning a part, inputting a configuration into “an auditing module,” determining a status of each part, inputting a scheduled modification, generating variables, and conveying an audited MOD list.

Each of these steps characterize known variables in manually planning and auditing a configuration tied to a generic “computer.” The abstract idea of configuration planning or auditing is not meaningfully transformed by automating it using a computer and taking into account known variables using generic computer components. Accordingly, the recited claim limitations, both individually and as an ordered combination, fail to transform the nature of the claims into a patent-eligible application.

DECISION

The Examiner’s rejection under 35 U.S.C. § 103(a) is reversed.

Claims 1–11 and 13–20 are newly rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

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 Appellants, 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

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

REVERSED; 37 C.F.R. § 41.50(b)