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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD J.W. MANSFIELD, NISSIM SHANI,
DANIEL SHANI, RONI SHANI, and MICHELE SHANI

Appeal 2014-008256
Application 13/489,210¹
Technology Center 3600

Before JOSEPH A. FISCHETTI, JAMES A. WORTH, and
AMEE A. SHAH, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1–8, 11, 14, 17–53, 57, and 72. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We Reverse and enter a new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

¹ Appellants identify Forget You Not, LLC as the real party in interest. (Appeal Br. 1).

THE INVENTION

Appellants claim a computer-implemented method for “transferring items from one party to another.” (Spec. para. 1, *generally Summary, and Description*).

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

1. A computer-implemented method comprising:

maintaining, by a computer, information provided by a donor that specifically identifies or is useful in inferring a transfer item to be transferred, that specifically identifies or is useful in inferring a recipient who is to receive the transfer item, and that specifically identifies or is useful in inferring a transfer time when the transfer item is to be transferred to the recipient, the information being maintained until the transfer time,

inferring one or more of the transfer item, the identity of the recipient, and the transfer time based on (i) information provided by the donor that does not specifically identify at least one of the transfer item, the identity of the recipient, and the transfer time, and (ii) historical data about the recipient, the inferring comprising:

(a) when the transfer item is not specifically identified by the information provided by the donor, using a predictive analytical engine to infer the transfer item based on the information useful in inferring the transfer item and the historical data about the recipient,

(b) when the identity of the recipient is not specifically identified by the information provided by the donor, using the predictive analytical engine to infer the identity of the recipient based on the information useful in inferring the recipient, and

(c) when the transfer time is not specifically identified by the information provided by the donor, using the predictive

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analytical engine to infer the transfer time based on the information useful in inferring the transfer time and the historical data about the recipient, and

managing, by a computer, a transfer of the transfer item to the recipient at the transfer time.

(Appeal Br. 34 (Claims App.)).

THE REJECTIONS AND THE EVIDENCE

The Examiner relies upon the following as evidence of unpatentability:

Krim	US 2002/0072925 A1	June 13, 2002
Yost	US 2009/0276284 A1	Nov. 5, 2009
Weiss	US 2011/0099048 A1	Apr. 28, 2011
Isaacson	US 2012/0150740 A1	June 14, 2012

The interests of the unborn child (Nasciturus), VDV/am/2006, 1–41 (2006) available at <http://wikistudent.ws/Unisa> (hereinafter “Wikistudent”).

The following rejections are before us for review.

Claims 1–8, 11, 14, 17–53, 57, and 72 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 applicant regards as the invention.

Claims 1–8, 11, 14, 17–24, 26–29, 31–43, and 72 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Krim in view of Wikistudent (page 10), Weiss, and further in view of Yost.²

Claims 25 and 44–53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Krim in view of Wikistudent, Weiss, Yost, and further in view official notice.

Claim 30 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Krim in view of Wikistudent, Weiss, Yost, and further in view of Issacson.

Claim 57 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Krim in view of Wikistudent (page 10) and Weiss.

FINDINGS OF FACT

1. Wikistudent discloses:

[a] Testator may even nominate an unborn or unconceived person in a Will to inherit even if they would only be born generations after his death.

e.g. T dies and bequeaths his farm to his son (S), subject to the proviso that upon S's death the farm is to devolve upon S's eldest son (GS). . . .

(Wikistudent, p.10).

² Although the Examiner included claim 25 in the heading for this rejection (Final Act. 3), the Examiner did not include it in the body of the rejection (*id.* at 11).

ANALYSIS

35 U.S.C. § 112 REJECTION

We will not sustain the rejection of claims 1–8, 11, 14, 17–53, 57, and 72 under 35 U.S.C. § 112 because the Examiner’s concerns go to claim breadth, and not indefiniteness. “Breadth is not indefiniteness.” *In re Gardner*, 427 F.2d 786, 788 (1970).

35 U.S.C. § 103 REJECTIONS

Each of independent claims 1, 45, 57, and 72, requires in one form or another:

inferring one or more of the transfer item, the identity of the recipient, and the transfer time based on (i) information provided by the donor that does not specifically identify at least one of the transfer item, the identity of the recipient, and the transfer time, and (ii) historical data about the recipient, the inferring comprising:

- (a)
- (b)
- (c)

(Appeal Br. 34 (Claims App.)).

The Examiner found that Krim discloses all the elements of the independent claims except for:

inferring one or more of the transfer item, the identity of the recipient, and the transfer time based on (i) information provided by the donor that does not specifically identify at least one of the transfer item, the identity of the recipient, and the transfer time, and (ii) historical data about the recipient, the inferring comprising:

- (a)

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(b). . . .

(c). . . .

(Appeal Br. 34 (Claims App.)). *See* (Final Act. 4–5).

The Examiner thus relies on Wikistudent to meet the claimed shortfall and found that “Wikistudent discloses inferring the transfer time and the recipient identity.” (Ans. 5).

Appellants argue:

The cited parts of Wikistudent described a Testator who “bequeaths his farm to his son (S), subject to the proviso that upon S’s death the farm is to devolve upon S’s eldest son” (p. 10). Even assuming the time after S’s death was the transfer time, as the examiner asserts (Action dated January 9, 2014, p. 7) (and which we do not necessarily concede), the cited parts of Wikistudent did not describe *inferring* the time after S’s death. Wikistudent did not describe any inference that was to be made regarding the transfer time. Rather, the cited parts of Wikistudent described that the death of S is stated as a proviso in the Testator’s will.

(Appeal Br. 10).

We agree with Appellants. We find that Wikistudent’s disclosure of bequeathing a farm to the testator’s son and thereafter to the son’s yet to be conceived child (FF. 1), while it does disclose identifying the transfer item, fails to meet the claim requirement of inferring the recipient and/or transfer time, because neither the time designation or the recipient identity is inferable because S’s son is yet to be conceived.

The Examiner also found, in the alternative, that elements (a), (b), and (c) of independent claim 1 are “considered as optional language because if

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the provided information by the donor that specifically identify the transfer item, the identity of the recipient, and the transfer time, then the ‘inferring’ step by a predictive analytical engine would not happen.” (Final Act. 5).

Appellants argue that:

claim 1 requires that one or more of the transfer item and the identity of the recipient be inferred. Although it may be optional whether any particular one of the pieces of information—the item or the identity—is one of the pieces of information being inferred, the act of inferring of one or more of the transfer item and the identity of the recipient is not optional. An act of inferring must occur.

(Appeal Br. 27).

We agree with Appellants that the act of inferring the one or more transfer item, the identity of the recipient, and the transfer time occurring before the claim items (a), (b), and (c) is independent of the claim items (a), (b), and (c), because the steps at items (a), (b), and (c) cover the one(s) of the transfer item, the identity of the recipient, and the transfer time that was/were *not* inferred above the (a), (b), and (c) items.

Accordingly, we do not sustain the rejection of the independent claims 1, 45, 57, and 72.

Since dependent claims 2–8, 11, 14, 17–44, and 46–53 depend from one of claims 1 and 45, and since we do not sustain the rejections of the independent claims 1 and 45, we do not therefore sustain the rejections of the dependent claims 2–8, 11, 14, 17–44, and 46–53.

NEW GROUND OF REJECTION

We enter a new ground of rejection for claims 1–8, 11, 14, 17–53, 57, and 71, 54, 55, 58–70, and 72 under 35 U.S.C. § 101 pursuant to 37 C.F.R. § 41.50(b).

The Supreme Court states:

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 Corp., Pty. Ltd. v. CLS Bank Int’l, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012)) (internal citations omitted).

To perform the Supreme Court’s test in *Alice*, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

While the Court in *Alice* made a direct finding as to what the claims were directed to, we find that this case’s claims themselves provide enough information to inform one as to what they are directed to.

Exemplary claim 1 recites, “inferring one or more of the transfer item, the identity of the recipient, and the transfer time based on (i) information provided by the donor that does not specifically identify at least one of the transfer item, the identity of the recipient, and the transfer time, and (ii) historical data about the recipient. . . .” Thus, claim 1 is directed to an inferring process and “inferring”, by definition, means “to involve a normal outcome of thought.”³

It follows from prior Supreme Court cases, and *Gottschalk v. Benson*, 409 U.S. 63 (1972), in particular, that the claims at issue here are directed to an abstract idea. Like the algorithm in *Gottschalk*, the claimed process of inferring one or more of the transfer item, the identity of the recipient, and the transfer time based is a mathematical algorithm that preempts all implementations and uses. Thus, inferring is an “abstract idea” beyond the scope of § 101. *See Alice*, 134 S. Ct. at 2356.

As in *Alice*, we need not labor to delimit the precise contours of the “abstract ideas” category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of performing a mathematical algorithm in *Gottschalk* and the concept of inferring information from other information. Both are squarely within the realm of “abstract ideas” as the Court has used that term. *See Alice*,

³ <https://www.merriam-webster.com/dictionary/infer> (last visited 12/20/2016).

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134 S. Ct. at 2357. *See also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1360–1361 (Fed. Cir. 2015).

The introduction of a computer into the claims does not alter the analysis at *Mayo* step two:

the 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. Nor is limiting the use of an abstract idea “to a particular technological environment.” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implement[t]” an abstract idea “on ... a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our § 101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional feature[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

Alice, 134 S. Ct. at 2358 (alterations in original) (citations omitted).

“[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice*, 134 S. Ct. at 2359. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to take in data and compute a result from a database amounts to

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electronic data query and retrieval—one of the most basic functions of a computer. All of these claimed computer functions are well-understood, routine, conventional activities previously known to the industry. In short, each step does no more than require a generic computer to perform generic computer functions.

Considered as an ordered combination, the computer components of Appellants' method add nothing that is not already present when the steps are considered separately. Viewed as a whole, Appellants' claims simply recite the concept of inferring information from other information performed by a generic computer. The method claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of inferring data from other data, in a generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2360.

Accordingly, we enter a new ground of rejection for claims 1–8, 11, 14, 17–53, 57, and 72 under 35 U.S.C. § 101 pursuant to 37 C.F.R. § 41.50(b).

CONCLUSIONS OF LAW

We conclude the Examiner did err in rejecting:

- (1) claims 1–8, 11, 14, 17–53, 57, and 72 under 35 U.S.C.

§ 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(2) claims 1–8, 11, 14, 17–24, 26–29, 31–43, and 72 under 35 U.S.C. § 103(a) as being unpatentable over Krim in view of Wikistudent (page 10), Weiss, and further in view of Yost.

(3) claims 25 and 44–53 under 35 U.S.C. § 103(a) as being unpatentable over Krim in view of Wikistudent, Weiss, Yost, and further in view official notice.

(4) claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Krim in view of Wikistudent, Weiss, Yost, and further in view of Issacson.

(5) claim 57 under 35 U.S.C. § 103(a) as being unpatentable over Krim in view of Wikistudent (page 10) and Weiss.

DECISION

The decision of the Examiner to reject claims 1–8, 11, 14, 17–53, 57, and 72 is reversed.

We enter a new ground of rejection for claims 1–8, 11, 14, 17–53, 57, and 72 under 35 U.S.C. § 101 pursuant to 37 C.F.R. § 41.50(b).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial

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review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, 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 prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED; 37 C.F.R. § 41.50(b)