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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT C. FULLINGTON and THOMAS M. TRIPP

Appeal 2014-009105
Application 13/335,861¹
Technology Center 3600

Before HUBERT C. LORIN, JAMES A. WORTH, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Robert C. Fullington et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–15 and 17–21. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and enter a NEW GROUND OF REJECTION.

¹ The Appellants identify Hewlett-Packard Development Company, LP as the real party in interest. App. Br. 1.

THE INVENTION

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

1. A computer-implemented method comprising:

receiving a service destination with a processor;

filtering, with a processor, a population of service providers to identify candidate service providers, the filtering being based upon whether each server provider has a starting location within a geographic zone containing the service destination;

comparing, with the processor, travel times to the destination for the candidate service providers;

selecting, with the processor, a service provider from the candidate service providers based on the comparison; and

dispatching the selected service provider to the destination.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Shaffer	US 5,907,608	May 25, 1999
Lesaint	US 6,578,005 B1	June 10, 2003
Cossins	US 7,469,247 B2	Dec. 23, 2008
McGee	US 2011/0047230 A1	Feb. 24, 2011

The following rejections are before us for review:

1. Claims 1, 6, 8, 10, 11, 15, and 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lesaint.²
2. Claims 2, 13, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lesaint and Shaffer.
3. Claims 3–5 and 19–21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lesaint, Shaffer, and McGee.
4. Claims 7, 12, and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lesaint and McGee.
5. Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Lesaint and Cossins.

ISSUE

Did the Examiner err in rejecting claims 1, 6, 8, 10, 11, 15, and 17 under 35 U.S.C. § 102(b) as being anticipated by Lesaint?

Did the Examiner err in rejecting claims 2, 13, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Lesaint and Shaffer?

Did the Examiner err in rejecting claims 3–5 and 19–21 under 35 U.S.C. § 103(a) as being unpatentable over Lesaint, Shaffer, and McGee?

² The statement of the rejection indicates that claim 16 is also rejected. *See* Final Act. (mailed Nov. 7, 2013) 11; Ans. 4. However, claim 16 was cancelled by Amendment, filed Aug. 27, 2013. It appears to have been entered. This is the Appellants' understanding as well. *See* App. Br. 2. Accordingly, the indication that claim 16 is rejected is taken as an inadvertent mistake.

Did the Examiner err in rejecting claims 7, 12, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Lesaint and McGee?

Did the Examiner err in rejecting claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Lesaint and Cossins?

ANALYSIS

The rejection of claims 1, 6, 8, 10, 11, 15, and 17 under 35 U.S.C. § 102(b) as being anticipated by Lesaint.

The Examiner indicates that “col. 5, lines (25-51), col. 13, lines (38-43) and col. 27, lines (43-45)” of Lesaint describes the claim limitation “filtering, with a processor, a population of service providers to identify candidate service providers, the filtering being based upon whether each server provider has a starting location within a geographic zone containing the service destination” (independent claim 1). Final Act. 11.

We have reviewed the cited passages but can find no express description of the filtering as claimed. In fact, the term “filtering” is not mentioned.

The cited passages also do not inherently describe the filtering as claimed. Said passages describe allocating a plurality of tasks to a plurality of resources; taking into account certain factors for putting a list in priority order; and, determining certain factors when considering making an allocation, respectively. While it is possible that “filtering” could be employed to accomplish any of these operations, “[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

Hansgird v. Kemmer, 102 F.2d 212, 214 (CCPA 1939), *quoted in Cont'l Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

A prima facie case of anticipation for the subject matter of claim 1 has not been made out in the first instance by a preponderance of the evidence. We reach the same conclusion as to the other independent claim, claim 10, which includes, similar to claim 1, a “filtering module” and to which the Examiner has taken the same position. *See* Final Act. 13. The rejection of claims 6, 8, 11, and 17, which depend from claims 1 and 10, respectively, is not sustained for the same reasons.

The Examiner indicates that “col. 5, lines (25-51)” of Lesaint describes the claim limitation “incrementally increasing the radius of the geographic zone until the number of candidate service providers within the geographic zone satisfies a predetermined threshold” (independent claim 15). *Ans.* 8; *see also* Final Act. 13–14 (rejecting claim 15 for the same reasons set forth in the rejection of claim 1). However, we agree with the Appellants that Lesaint does not describe, expressly or inherently, the claim 15 limitation “incrementally increasing the radius of the geographic zone until the number of candidate service providers within the geographic zone satisfies a predetermined threshold.” *App. Br.* 11; *see also* *Reply Br.* 4–8. We also agree with Appellants that the Examiner’s position with respect to claim 15 is undermined by the rejection of claim 3 not under § 102 but under § 103, given that claim 3 is directed to an even broader concept: “adjusting the radius of the area of the geographic zone if a number of the candidate service providers does not satisfy a predetermined threshold.” *See App. Br.* 11–12. Accordingly, the rejection of claim 15 is not sustained.

The rejection of claims 2, 13, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Lesaint and Shaffer.

The rejection of claims 3–5 and 19–21 under 35 U.S.C. § 103(a) as being unpatentable over Lesaint, Shaffer, and McGee.

The rejection of claims 7, 12, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Lesaint and McGee.

The rejection of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Lesaint and Cossins.

These rejections of the dependent claims are not sustained for the reasons discussed above with respect to the independent claims. In particular, we find that the independent claims include limitations not described in Lesaint. Since no other position with regard to said claim limitations has been taken, the rejections are not sustained because a prima facie case of obviousness has not been made out in the first instance by a preponderance of the evidence.

NEW GROUND OF REJECTION

Claims 1–15 and 17–21 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Alice Corp. Pty. Ltd. v. CLS Bank International, 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 claim 1 as representative of the claims on appeal, the claimed subject matter is directed to information gathering. Information gathering is a fundamental building block of human ingenuity. As such it is 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.* (alteration in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012)).

We see nothing in the subject matter claimed that transforms the abstract idea of information gathering into an inventive concept.

The method of claim 1 sets out three steps for gathering a particular information; that is, identifying a first information (“candidate service providers . . . [in] a starting location within a geographic zone containing [a] service destination”), comparing the first information to second information (“travel times”), and selecting a third information (“a service provider”) from the first information based on the comparison. The particular third information that is selected is used to perform a certain post-solution activity; that is, “dispatching the selected service provider to the destination” (claim 1).

The identifying, comparing, and selecting steps are known operations for obtaining a desired information and thus add little to patentably transform the information gathering abstract idea.

Furthermore, each of the identifying, comparing, and selecting steps are themselves abstract ideas. For example, “comparing one thing to

another” is an abstract idea. *See Blue Spike, LLC v. Google Inc.*, No. 14-CV-01650-YGR, 2015 WL 5260506 (N.D. Cal. Sept. 8, 2015), *aff'd*, No. 2016-1054, 2016 WL 5956746 (mem) (Fed. Cir. Oct. 14, 2016). Merely combining three abstract ideas does not render the combination any less abstract. *Cf. Shortridge v. Found. Constr. Payroll Serv., LLC*, No. 14-CV-04850-JCS, 2015 WL 1739256 (N.D. Cal. Apr. 14, 2015), *aff'd*, No. 2015-1898, 2016 WL 3742816 (Fed. Cir. July 13, 2016).

We note that the identifying step specifically calls for “filtering”; that is, “filtering, with a processor, a population of service providers to identify candidate service providers, the filtering being based upon whether each server provider has a starting location within a geographic zone containing the service destination” (claim 1). However, “filtering” per se in an effort to identify a certain desired information is well known and thus adds little to patentably transform either the identifying or the overall information gathering abstract ideas. *Cf. LendingTree, LLC v. Zillow, Inc.*, No. 2014-1435, 2016 WL 3974203 (Fed. Cir. July 25, 2016).

As for the fourth step, “dispatching the selected service provider to the destination” (claim 1), it simply expresses a mere post-solution activity. Once the information (i.e., “a service provider”) is obtained, said service provider is dispatched to a destination. *Cf. CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1371 (Fed. Cir. 2011) (“The Court [*Parker v. Flook*, 437 U.S. 584 (1978)] rejected the notion that the recitation of a practical application for the calculation could alone make the invention patentable.”). Moreover, the step is not linked to any device and thus could be practiced mentally. Adding a mental step cannot patentably transform an

otherwise abstract idea into an inventive concept. *In re Comiskey*, 554 F.3d 967, 979 (Fed. Cir. 2009) (“mental processes—or processes of human thinking—standing alone are not patentable even if they have practical application”).

Finally, we note that claim 1 calls for the recited method to be “computer-implemented” and that three of the four recited steps involve a “processor.” But any general-purpose computer available at the time the application was filed would have satisfied these limitations. The Specification supports that view. *See* Spec., para. 12. “[T]he 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.” *Alice*, 134 S. Ct. at 2358.

For the foregoing reasons, we find that claim 1 covers claimed subject matter that is judicially-excepted from patent eligibility under § 101. The other independent claims — apparatus claims 10 and 15, which substantially parallel claim 1 — similarly cover claimed subject matter that is judicially-excepted from patent eligibility under § 101. The dependent claims describe various information gathering schemes which do little to patentably transform the abstract idea.

Therefore, we enter a new ground of rejection of claims 1–15 and 17–21 under 35 U.S.C. § 101.

For the foregoing reasons, the rejections are reversed but the claims are newly rejected under § 101.

CONCLUSIONS

The rejection of claims 1, 6, 8, 10, 11, 15, and 17 under 35 U.S.C. § 102(b) as being anticipated by Lesaint is reversed.

The rejection of claims 2, 13, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Lesaint and Shaffer is reversed.

The rejection of claims 3–5 and 19–21 under 35 U.S.C. § 103(a) as being unpatentable over Lesaint, Shaffer, and McGee is reversed.

The rejection of claims 7, 12, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Lesaint and McGee is reversed.

The rejection of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Lesaint and Cossins is reversed.

Claims 1–15 and 17–21 are newly rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

DECISION

The decision of the Examiner to reject claims 1–15 and 17–21 is reversed.

Claims 1–15 and 17–21 are newly rejected.

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. . . .

REVERSED; 37 C.F.R. § 41.50(b)