



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/549,217	07/13/2012	Julian Lunev	GOLD11-00340	7994
132787	7590	07/27/2016	EXAMINER	
Docket Clerk-GOLD P.O. Drawer 800889 Dallas, TX 75380			LU, KUEN S	
			ART UNIT	PAPER NUMBER
			2156	
			NOTIFICATION DATE	DELIVERY MODE
			07/27/2016	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

john.maxin@gs.com  
patents@munckwilson.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* JULIAN LUNEV, DAVID ORELOWITZ, and  
ROBERT MENDELOW

---

Appeal 2015-002299  
Application 13/549,217  
Technology Center 2100

---

Before JAMES R. HUGHES, KAMRAN JIVANI, and  
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants<sup>1</sup> appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 12–20, which constitute all of the claims pending in this application. Claims 1–11 have been cancelled. Br. 17 (Claims App'x). We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

---

<sup>1</sup> Appellants identify Goldman, Sachs & Co. as the real party in interest. Br. 2.

### THE INVENTION

The claimed invention is directed to methods of operating a computer system with a data availability management software package. Abstract, Spec. 5:20–6:5.

Claim 12, reproduced below, is illustrative of the claimed subject matter:

12. A method of operating a computer system, the method comprising:
  - changing a status of a data item from unavailable to available;
  - in response to said change of status, generating a report that requires availability of said data item;
  - changing the status of said data item from available to unavailable;
  - again changing the status of said data item from unavailable to available; and
  - in response to said second change of status of said data item from unavailable to available, again generating said report.

### REFERENCE

The prior art relied upon by the Examiner as evidence in rejecting the claims on appeal is:

Bou-Ghannam                      US 2011/0093868 A1      Apr. 21, 2011

### REJECTION

Claims 12–20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Bou-Ghannam. Final Act. 4–8.

## ANALYSIS

We have reviewed the Examiner's rejection in light of Appellants' arguments that the Examiner erred. In reaching this decision, we consider all evidence presented and all arguments made by Appellants. We are persuaded by Appellants' arguments that the Examiner erred.

### *Claims 12–16*

Appellants argue Bou-Ghannam does not disclose any of the steps recited in claim 12. Br. 10–12. According to Appellants, Bou-Ghannam discloses changing the modality of how data is inputted; however, Bou-Ghannam does not disclose changing the status of an item of data from unavailable, to available, to unavailable and back to available as recited in claim 12. *Id.*

The Examiner finds Bou-Ghannam discloses all of the limitations of claim 12. Final Act. 4–5; Ans. 3–8. More specifically, the Examiner finds a toggle function from unavailable to available is well-known in the art. Ans. 4. The Examiner further finds “the activation of the speech modality is a change of status and the speech input is the available data item for the speech modality to complete tasks, the completion of speech modality tasks result in a new dialogue state which is conveyed to the modality component server.” Ans. 6.

We disagree with the Examiner as the Examiner has not identified sufficient evidence or provided sufficient explanation as to how Bou-Ghannam discloses multiple changes of status for a specific data item as recited in claim 12. Bou-Ghannam is directed to different modalities of entering data, such as using a graphical user interface or speech input. Bou-

Ghannam ¶¶ 21, 24, 33, 36. However, the cited sections of Bou-Ghannam are silent as to what happens to the data after being inputted. Although Bou-Ghannam discloses that various input modalities may be available or unavailable, the cited sections do not disclose a specific data item undergoing the multiple changes of availability recited in claim 12.

Accordingly, we are constrained on this record to reverse the Examiner's rejection of claim 12, along with the rejections of claims 13–16, which depend, directly or indirectly, from claim 12.

*Claims 17–19*

Similar to claim 12 above, Appellants argue the Examiner erred in finding Bou-Ghannam discloses the steps recited in claim 17, such as “determining a second data item that is dependent for processing upon availability of the first data item.” Br. 12–14. Specifically, Appellants argue the cited paragraph of Bou-Ghannam discloses changing the availability of the modality for inputting data. Br. 13. However, “[a]ctivating and deactivating a GUI and a speech modality component is not the same as determining a second data item that is dependent for processing upon availability of the first data item.” *Id.*

The Examiner finds Bou-Ghannam discloses “determining a second data item that is dependent for processing upon availability of the first data item.” Final Act. 7 (citing Bou-Ghannam ¶ 33). More specifically, the Examiner finds “the operation of modality component as depicted in Fig. 4, the speech modality component is operated independently as it is activated and deactivated.” Ans. 10.

We disagree with the Examiner as the Examiner has not identified sufficient evidence or provided sufficient explanation as to how Bou-Ghannam discloses the determining step recited in claim 17. Bou-Ghannam paragraph 33 discloses activating and deactivating various modalities. Bou-Ghannam ¶ 33. However, the cited section of Bou-Ghannam does not disclose “determining a second data item that is dependent for processing upon availability of the first data item,” as recited in claim 17. Instead, we agree with Appellants that there is a difference between a modality for inputting data and a data item.

Accordingly, we are constrained on this record to reverse the Examiner’s rejection of claim 17, along with the rejections of claims 18 and 19, which depend, directly or indirectly, from claim 17.

*Claim 20*

Appellants argue the Examiner erred in finding Bou-Ghannam paragraph 33 discloses changing the status of a data item for unavailable to ready for processing or the either of the two conditions to change the status of the data item. Br. 14–15. Instead, Appellants argue Bou-Ghannam only discloses activating or deactivating a modality. Br. 15.

The Examiner finds Bou-Ghannam teaches all of the limitations of claim 33. Final Act. 7–8. Specifically, the Examiner finds Bou-Ghannam discloses “one condition, the condition being the availability of data item, wherein the system can generate the application requiring the voice entry that depends on the availability of certain data.” *Id.* (emphasis omitted).

Appellants have persuaded us that Examiner erred. The cited paragraph of Bou-Ghannam discloses activating and deactivating various

modes for inputting data. Bou-Ghannam ¶ 33. However, the cited section is silent as to the status of the data items or the conditions for changing the availability of a data item from unavailable to ready for processing. *Id.*

Accordingly, we are constrained on this record to reverse the Examiner's rejection of claim 20.

### DECISION

For the above reasons, we reverse the Examiner's decision rejecting claims 12–20.<sup>2</sup>

### REVERSED

---

<sup>2</sup> In the event of further prosecution, including any review for allowance, we invite the Examiner's attention to the question of whether the claims are patent-eligible under 35 U.S.C. § 101. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355-56 (2014). Regarding at least method claims 12, 17, and 20, besides the recitation of a method for operating a computer system, a question arises as to whether a person would be capable of performing the contested steps or acts as mental steps, or with the aid of pen and paper. See *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011) (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*”). “[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.” *CyberSource*, 654 F.3d at 1373. We have decided the issues before us. We leave further consideration of this § 101 issue to the Examiner. ***Although the Board is authorized to enter a new ground of rejection to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so.*** See MPEP 1213.02.