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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM KRESS BODIN, BRYAN WILLIAM CLARK,
ALBERT CHUNG-CHEE KWOK, JOHN RICHARD DEL PIZZO JR.,
WOJCIECH T. STRYJEWSKI, DAVID PATRICK HUFF,
DERRAL CHARLES THORSON, and MICHAEL KARASICK

Appeal 2015-002372
Application 11/843,945¹
Technology Center 3600

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

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1 and 4–6. 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 International Business Machines Corporation as the real party in interest. App. Br. 1.

THE INVENTION

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

1. A system for arranging for a business transaction for an operator of an automobile which is in transit, the system comprising:

a web server having a processor communicably disposed between an automotive on-board diagnostic system and one or more automotive maintenance servers which:

responsive to receipt of service need message from the diagnostic system generates a bid request;

transmits the bid request to the automotive maintenance servers;

responsive to receipt of one or more electronic offers from the automotive maintenance servers, qualifies the electronic offers according to staff skills, parts availability, and estimated time of arrival;

coalesces the qualified offers by modifying and combining the qualified electronic offers to meet preferences of a user;

transmits the coalesced offers to the on-board automotive diagnostic system;

receives a user selection from the on-board automotive diagnostic system; and

confirms an order to one or more of the automotive maintenance servers according to the user selection;

wherein needs for service to an automobile are automatically brokered and scheduled for future performance according to user-selected offer.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Moulinet	US 2001/0032172 A1	Oct. 18, 2001
Ying	US 2002/0181405 A1	Dec. 5, 2002

The following rejections are before us for review:

1. Claim 1 stands 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 Appellants regard as the invention.
2. Claims 1 and 4–6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moulinet and Ying.

ISSUES

Did the Examiner err in rejecting claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention; and claims 1 and 4–6 under 35 U.S.C. § 103(a) as being unpatentable over Moulinet and Ying?

ANALYSIS

The rejection of claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention

According to the Examiner, the claim 1 limitation “estimated time of arrival” is indefinite because “[i]t is unclear from the claim language whether the time of arrival denotes the time of arrival of the vehicle at the

service location or the time of arrival of the parts required” (Final Act. 2) and has unclear antecedent basis (Ans. 3).

The Appellants contend that the meaning is clear in light of the Specification which “consistently refers to the time of arrival of the vehicle” (Appeal Br. 4) (citing paragraphs 28, 44, 45, 58, 61, and 62 of the Specification) and that there is no antecedent basis problem (Reply Br. 3).

We agree with the Appellants. The difficulty with the Examiner's rejection is that no consideration has been given to the construction to be given claim 1. General principles of claim construction apply when determining indefiniteness. *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1332–33 (Fed. Cir. 2010). Regarding the “estimated time of arrival,” the Specification consistently refers to the “estimated arrival of the mobile system” (Spec. para. 32. This meaning is also clear from Figure 1 which depicts anticipated time of arrival t_1 and expected time of arrival t_2 of mobile system 11. We also fail to see any antecedent basis problem. It is clear from the language of claim 1 that “parts availability” and “estimated time of arrival” are two distinct criteria in the list of criteria used to qualify electronic offers.

Accordingly, the rejection is not sustained.

The rejection of claims 1 and 4–6 under 35 U.S.C. § 103(a) as being unpatentable over Moulinet and Ying.

Independent claim 1 includes the limitation:

responsive to receipt of one or more electronic offers from the automotive maintenance servers, qualifies the electronic offers according to staff skills, parts availability, and estimated time of arrival;

(App. Br. 8, Claims Appendix).

The Examiner finds this limitation in Moulinet at paragraph 20 (Final Act. 4–5).

The Appellants contend that the cited portion of Moulinet does not disclose this limitation (App. Br. 6).

We agree with the Appellants that the cited passage of Moulinet does not disclose the above limitation. Paragraph 20 of Moulinet discloses that a user of a local computing system creates a “short list” of “one or more service providers” after an RFP has been submitted. We see no disclosure in Moulinet that the short list of service providers (or proposals received from the service providers as discussed in paragraph 21) is qualified or filtered based on any “estimated time of arrival” as required by the claim.

A *prima facie* case of obviousness has not been made out in the first instance by a preponderance of the evidence. Accordingly, the rejection is not sustained.

NEW GROUND OF REJECTION

Claims 1 and 4–6 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Alice Corp. Pty. Ltd. v. CLS Bank Int’l, 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. *Id.* at 2355.

Taking claim 1 as representative of the claims on appeal, the claimed subject matter is directed to a monitoring automotive systems and automatically brokering and scheduling and maintenance. Monitoring automotive systems and automatically brokering and scheduling and maintenance is a method of organizing human activity and/or fundamental economic practice. As such it is an abstract idea.

Step two of *Alice* 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.* at 2355 (citation omitted).

We see nothing in the subject matter claimed that transforms the abstract idea of monitoring automotive systems and automatically brokering and scheduling and maintenance into an inventive concept.

The system of claim 1 includes a web server that performs eight steps of generating first information (“generates a bid request”), transmitting the first information (“transmits the bid request”), filtering second information (“qualifies the electronic offers”), modifying the second information (“coalesces the qualified offers”), transmitting the second information (“transmits the coalesced offers”), gathering third information (“receives a user selection”), and placing an order for services (“confirms an order”). Claim 1 also requires that the automotive service is “automatically brokered and scheduled.”

All of the claim limitations are well-understood, routine, conventional activities previously known to the industry. The information generating, transmitting, filtering, and modifying steps are known information gathering

operations for distributing information in a conventional electronic network (e.g., internet) and thus add little to patentably transform the abstract idea of monitoring automotive systems. Receiving bids for automobile maintenance and scheduling maintenance is also a routine, conventional practice.

Furthermore, each of the information gathering, brokering, and maintenance scheduling steps are themselves abstract ideas. For example, using an intermediary to broker services by collecting offers from multiple service providers, filtering the offers according to selection criteria, and receiving user selection of an offer is an abstract idea. *See LendingTree, LLC v. Zillow, Inc.*, No. 2014-1435, 2016 WL 3974203 (Fed. Cir. July 25, 2016) (internet-based loan-application clearinghouse for receiving loan offers from a “plurality of lending institutions” using “a filter comprising [a] plurality of selection criteria” and receiving a decision from the user held to be an abstract idea). Tracking the location of a vehicle and intermediated booking of vehicle maintenance is also an abstract idea. *See GT Nexus, Inc. v. INTTRA, Inc.*, No. 2016-1267, 2016 WL 5899189 (Fed. Cir. Oct. 11, 2016) (“intermediated booking and tracing of shipping containers” held to be an abstract idea). Central monitoring of vehicle status and location is also an abstract idea. *See Wireless Media Innovations, LLC v. Maher Terminals, LLC*, 636 F. App’x 1014 (Fed. Cir. 2016) (“monitoring locations, movement, and load status of shipping containers within a container-receiving yard, and storing, reporting and communicating this information in various forms through generic computer functions” held to be an abstract idea). Merely combining several 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, *11 (N.D. Cal. Apr. 14, 2015), *aff'd*, No. 2015-1898, 2016 WL 3742816 (Fed. Cir. July 13, 2016).

Finally, we note that claim 1 calls for “a web server having a processor” and “one or more automotive maintenance servers.” Dependent claim 5 specifies that “the automotive maintenance servers comprise networked enterprise servers.” But any general-purpose computer available at the time the application was filed would have satisfied these limitations. The Specification supports that view. *See, e.g.*, paragraph 40 of the Specification (“any other suitable computer platform such as an IBM-compatible personal computer, Sun Microsystem’s server, or other capable computer”). Claim 1 also requires “an automotive on-board diagnostic system” and dependent claim 4 specifies that the “on-board automotive diagnostic system comprises a vehicle electronic control module.” These limitations also refer to generic/conventional systems. *See, e.g.*, paragraph 28 of the Specification (“any system used to diagnose a mobile system such as a vehicle or other system which can be transported”). “[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* at 2358.

For the foregoing reasons, we find that claims 1, 4, and 5 cover subject matter that is judicially-excepted from patent eligibility under § 101. Dependent claim 6 describes additional criteria for matching service providers to users which do little to patentably transform the abstract idea.

Therefore, we enter a new ground of rejection of claims 1 and 4–6 under 35 U.S.C. § 101.

CONCLUSIONS

The rejection of claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention is reversed.

The rejection of claims 1 and 4–6 under 35 U.S.C. § 103(a) as being unpatentable over Moulinet and Ying is reversed.

Claims 1 and 4–6 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 and 4–6 is reversed.

Claims 1 and 4–6 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 Appellant(s), 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)