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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JASON I. SPERSKE and TIMOTHY J. BELLIG

Appeal 2015-003059
Application 12/207,275
Technology Center 2800

Before KAREN M. HASTINGS, N. WHITNEY WILSON, and
LILAN REN, *Administrative Patent Judges*.

REN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ timely appeal under 35 U.S.C. § 134(a) from the
Rejection² of claims 21–40. (App. Br. 6.) We have jurisdiction.
35 U.S.C. § 6(b). We affirm.

¹ The real party in interest is identified as Internet Pipeline, Inc. of Exton,
Pennsylvania (Appeal Brief, filed August 26, 2014 (“App. Br.”), 3.)

² Final Office Action mailed February 27, 2014 (“Final Rejection”; cited as
“FR.”).

OPINION

A. Introduction³

The subject matter on appeal seeks to remedy certain “deficiencies in existing quotation approaches by providing for the dynamic generation of quotations using rules and information from multiple sources.” (Spec. ¶ 28.) The ’275 Specification describes, for example, that a quote for a life insurance policy may be generated by a computer equipped with a software using input data including questions answered by the life insurance seeker, rules for underwriting the life insurance policy, terms/types of life insurance, and others. (*Id.* ¶¶ 33, 40.)

Representative claim 21 recites:

21. A method of dynamically generating quote information using one or more sets of rules and information from multiple sources, the method comprising:
generating a decision tree by:
obtaining, from at least a first source, the one or more sets of rules and associated questions using non-compiled text;
using a computer to automatically generate the decision tree from the noncompiled text, based on at least one set of rules, the decision tree including:
questions,
nodes, and
branches;
navigating the decision tree by receiving, from a second source, an input for each of a subset of the questions of the decision tree, and, for each input:
modifying the input based on an associated question type; and

³ Application 12/207,275, *Systems and Methods for Dynamic Quote Generation*, filed September 09, 2008. We refer to the “’275 Specification,” which we cite as “Spec.”

analyzing the modified input based on an associated rule type to determine a result; and automatically generating the quote information by the computer based, at least in part, on the result.

(Claims Appendix, App. Br. 13.)⁴

The Examiner maintains the following grounds of rejection⁵:

A: Claims 21, 28, and 35 stand rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement.

B: Claims 21–26, 28–33, and 35–39 stand rejected under 35 U.S.C. § 103(a) based on based on Hele.⁶

B1: Claims 27, 34, and 40 stand rejected under 35 U.S.C. § 103(a) based on based on Hele and Rosauer.⁷

⁴ Should there be further prosecution of this application (including any review for allowance), the Examiner may wish to review the claims for compliance under 35 U.S.C. § 101 in light of the preliminary examination instructions on patent eligible subject matter. See “Preliminary Examination Instructions in view of the Supreme Court Decision in *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*,” Memorandum to the Examining Corps, June 25, 2014 as well as the USPTO’s “July 2015 Update: Subject Matter Eligibility” and “May 2016 Subject Matter Eligibility Update (May 2016).”

⁵ Examiner’s Answer mailed November 21, 2014 (“Ans.”).

⁶ John C.R. Hele & Christopher Serflek, *Underwriting Insurance*, U.S. Patent Application Publication No. 2002/0111835 A1, published August 15, 2002 (“Hele”).

⁷ Matt Rosauer & Richard Vlasimsky, *Risk Modeling System*, U.S. Patent Application Publication No. 2007/0016542 A1, published January 18, 2007 (“Rosauer”).

B. Discussion

Findings of fact throughout this Opinion are supported by a preponderance of the evidence of record.

*Rejection A: Claim 21*⁸

The Examiner finds that the limitation “generate [a] decision tree from [] non-compiled text” recited in claim 21 lacks written description support. Appellants acknowledge that the ’275 Specification does not include the term “non-compiled text.” (App. Br. 7.) Appellants, however, argue that because the ’275 Specification contains “no description” whether the text at issue “is or could be compiled,” such silence affirmatively shows that the text is non-compiled. (*Id.*)

The nonexistence of the phrase “non-compiled text” in the ’275 Specification is not persuasive that the Specification conveys to those skilled in the art that the inventor had possession of the claimed subject matter – “non-compiled text” as of the filing date. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (citation omitted).

Nowhere in the ’275 Specification does it disclose that the texts are non-compiled. The ’275 Specification uses the word “compiled” only once: “after a questionnaire is completed and submitted, each of the facts can be compiled” (Spec. ¶ 38.) None of the claims as originally filed recite “non-compiled text.” (Spec. original claims 1–20.) Appellants in fact acknowledge that the ’275 Specification discloses that “[a] development language is provided that allows people to express arbitrary questions” and that “[t]he logic in the system then can determine which question to provide next based on the answers[.]” (*See* App. Br. 7 (citing Spec. ¶ 34, Tables 1–

⁸ Claims 28 and 35 stand or fall with claim 21 with respect to the written description rejection. (App. Br. 6.)

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8, and other portions to show that “a development language” is “used to create a decision tree”).)

Appellants’ argument regarding the non-existence of “non-compiled text” does not point to reversible error in the Examiner’s finding that a skilled artisan would not have recognized, based the disclosure of using “a development language,” that non-compiled text is used to generate the decision tree. (*See* Reply Br.⁹ 3; *see also* App. Br. 7; Ans. 7.) We accordingly affirm the written description rejection of claim 21.

*Rejection B: Claim 21*¹⁰

The prior art reference Hele is directed to “a method, software and system for underwriting life insurance” based on “user profile and the underwriting rules of the carriers.” (Hele ¶ 5.) It is undisputed that Hele discloses “an automated underwriting system that interacts with a declarative rules processor that encapsulates hierarchical underwriting rule sets for multiple insurance carriers.” (*Id.* ¶ 80 (cited in FR. at 5); *see also* App. Br. 8.) It is also undisputed that Hele discloses that the underwriting rules “are structured in a hierarchal manner to include basic underwriting rules 190 (e.g., applicable for all carriers and products), rules specific to individual carriers 192, and rules specific to individual products of each carrier 194” illustrated in Figures 7A and 7B produced below. (Hele ¶ 82.)

⁹ Reply Brief filed January 21, 2015 (“Reply Br.”).

¹⁰ Claims 28 and 35 stand or fall with claim 21 with respect to the written description rejection. (App. Br. 6.)

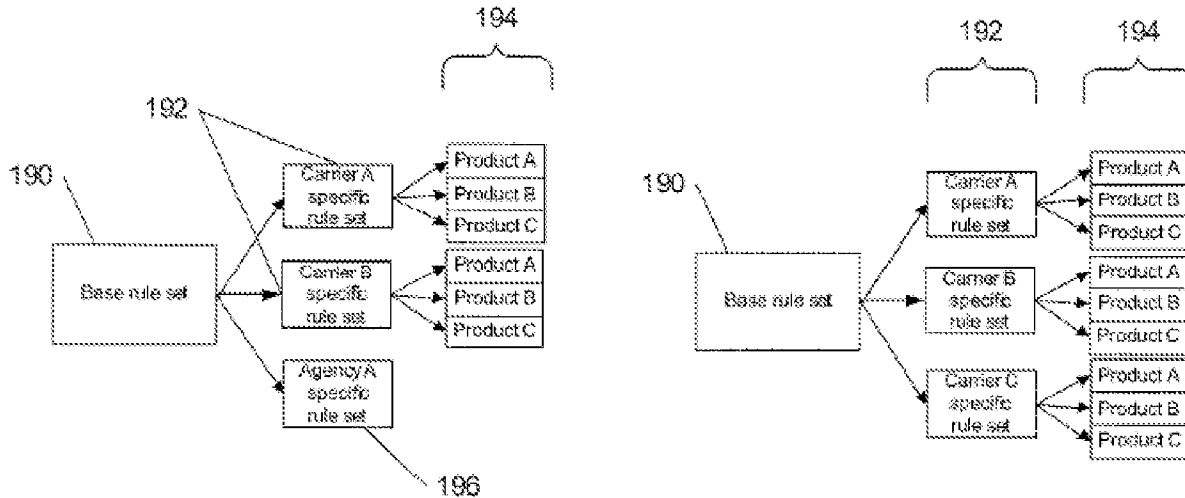


FIG. 7A of Hele illustrating a “structured rule set[.]” (Hele ¶ 34.)

FIG. 7B of Hele illustrating a “structured rule set[.]” (Hele ¶ 34.)

Appellants argue, however, that Hele does not teach or suggest a method to “generate [a] decision tree . . . based on at least one set of rules” as recited in claim 21 because “the rule set [in Hele] *is* the decision tree.” (App. Br. 9) (emphasis in original.) Appellants, however, do not provide a definition of the limitation “decision tree” and do not explain why a skilled artisan would have found the difference, if any, between the prior art and recited decision trees unobvious.

The '275 Specification provides “decision tree 200” illustrated in Figure 2 reproduced below:

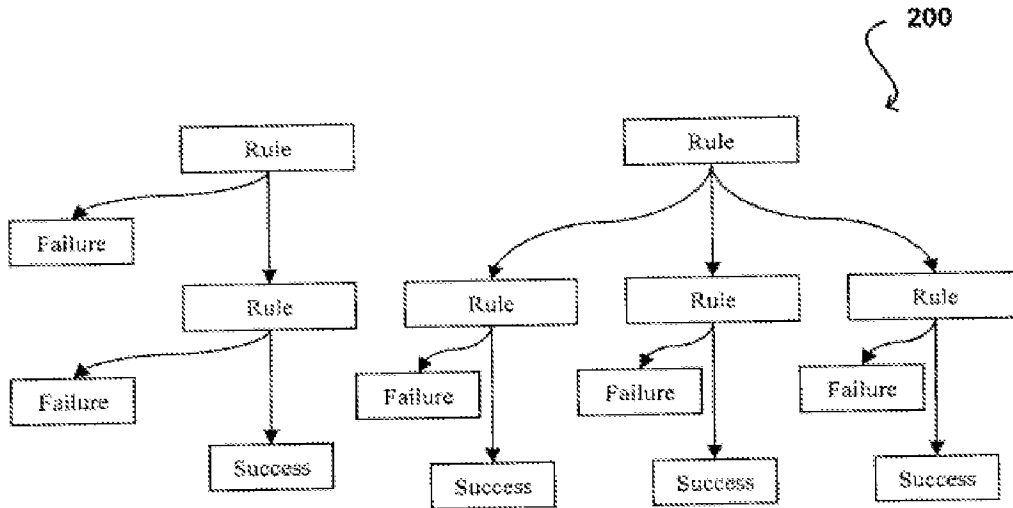


FIG. 2

FIG. 2 of the '275 Specification

The '275 Specification provides that “decision tree 200” may be created as “a logical representation of the underwriting process[.]” (Spec. ¶ 45.) The '275 Specification does not exclude a decision tree from being based solely on a rule set. Appellants have not shown reversible error in the finding that a skilled artisan would have had the skill to predictably “generate [a] decision tree . . . based on at least one set of rules” in view of Hele which teaches that a rule set may be used to create a “structured rule set[.]” “in a hierarchal manner” (Hele ¶¶ 34, 82). *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (“If a person of ordinary skill can implement a predictable variation [of a known work], § 103 likely bars its patentability.”).

Appellants also argue that a skilled artisan would not have found claim 21 obvious because Hele’s “structured rule set” does not include “questions” as recited in claim 21. (App. Br. 9.) While acknowledging that Hele discloses that a “tree architecture allows the system to customize the

questioning process for each user,” (*id.* (citing Hele ¶ 107)), Appellants argue that the “tree architecture” is not the “structured rule set” illustrated in Figures 7A and 7B. (App. Br. 9.)

The test for obviousness, however, is what the combined teachings of the references as a whole would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Absent evidence showing that Hele excludes the “tree architecture” from being applied to the “structured rule set,” we are not persuaded that the Examiner committed reversible error in evaluating the prior art as a whole. *See KSR*, 550 U.S. at 417.

Appellants next argue that Hele does not teach or suggest “modifying the input based on an associated question type” as recited in claim 21. Although Appellants acknowledge that Hele allows “modifying answers to previous questions” and categorizes questions presented to the user into various levels (e.g., “top-level” or “secondary-level” queries), Appellants argue that there is no correlation between the modification and the levels of questions. (App. Br. 10 (citing Hele ¶¶ 78, 107).)

As we stated *supra*, when analyzing obviousness, “the prior art as a whole must be considered. “The teachings are to be viewed as they would have been viewed by one of ordinary skill.” *In re Hedges*, 783 F.2d 1038, 1041 (Fed. Cir. 1986). In this case, the Examiner finds that Hele teaches using “multiple level query panels” “to pose [] questions to the user.” (Ans. 12 (citing Hele ¶ 105).) Based on the teaching that the process that uses the “multiple levels of query panels” may be customized (Hele ¶¶ 105, 107) and the teaching that customization may be implemented based on “modifying answers to previous questions,” (*id.* ¶ 78), the Examiner finds that the recited limitation of “modifying the input based on an associated question

type” is no more than a predictable result of the prior art. (Ans. 12; *see also KSR*, 550 U.S. at 416 (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).) Because Appellants argue each paragraph of Hele in isolation rather than evaluating the reference as a whole, no reversible error has been shown in the Examiner’s prima facie case of obviousness.

We are also not persuaded by Appellants’ unelaborated statement that the Examiner erred by “incorrectly limit[ing] the language ‘modifying the input based on an associated question type.’” (App. Br. 11.) Appellants do not explain how the Examiner has “limit[ed]” this claim term. Appellants do not provide their own claim construction of the term and do not point to the ’275 Specification to show why the Examiner erred in analyzing this claim limitation. *See In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983) (citation omitted) (“It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.”). The record before us shows that the rejection is based on the plain language of this limitation (*see* Ans. 11–12). Appellants’ conclusory assertion has not shown reversible error in the Examiner’s prima facie case of obviousness.

Rejection B1: Remaining Claims

Appellants argue that the rejections of claims 27, 34, and 40 are in error based on their respective dependency from claim 21 and claims that stand or fall with claim 21. (App. Br. 11–12.) Appellants have not provided arguments separate from those for claim 21, and we are not persuaded for the reasons discussed with respect to claim 21 from which the remaining

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claims depend. *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”).

C. Order

It is ORDERED that the rejections of claims 21–40 are affirmed.

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).

AFFIRMED