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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALEXANDER A. DUBITSKY, AMAR KUCHINAD, REBECCA FEIN, SAMUEL RAMOS, SCOTT SILVERMAN, JOHN FOWLER, and JONATHAN HECHT

Appeal 2015-003872[1]
Application 12/098,082[2]
Technology Center 3600

Before BRADLEY B. BAYAT, TARA L. HUTCHINGS, and MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 2–4, 21, 26, and 30–42. We have jurisdiction under 35 U.S.C. § 6(b).

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[1] Our decision references Appellants' Appeal Brief ("Appeal Br.," filed October 17, 2014), Reply Brief ("Reply Br.," filed February 4, 2015), the Examiner's Answer ("Ans.," mailed December 4, 2014), and Final Office Action ("Final Act.," mailed April 16, 2014).
[2] Appellants identify Goldman, Sachs, Co. as the real party in interest (Appeal Br. 3).

We AFFIRM.

CLAIMED INVENTION

Appellants' claimed invention relates generally to a "deferred premium annuity [that] allows a purchaser (e.g., an individual) to pledge assets rather than pay cash upfront to purchase an annuity" (Spec. ¶ 3).

Claims 21, 26, and 30 are the independent claims on appeal. Claim 21, reproduced below with added bracketed notations, is illustrative of the subject matter on appeal:

> 21. A computer processor implemented method comprising:
>
> [a] offering, by a computer processor, an annuity to a purchaser, wherein the annuity has a price;
>
> [b] issuing, by the computer processor, the annuity to the purchaser in exchange for, at least, assignment of a future interest in an asset to a provider of the annuity, wherein the future interest comprises an ownership right associated with the asset that matures at death of the purchaser;
>
> [c] distributing, by the computer processor, periodic benefits associated with the annuity, wherein distributing comprises at least one of: paying the periodic benefits to the purchaser and accruing the periodic benefits into the annuity;
>
> [d] relinquishing the future interest if a payment that satisfies the price is received before the death of the purchaser, wherein the distributing the periodic benefits continues after the future interest is relinquished; and
>
> [e] receiving a current interest in the asset, based upon maturation of future interest, if the payment is not received before the death of the purchaser.

REJECTIONS

Claims 2–4, 21, 26, and 30–42 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.[3]

Claims 2–4, 21, 26, and 30–42 are rejected under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement.

Claims 2–4, 21, 26, and 30–42 are rejected under 35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), second paragraph, as being indefinite.

Claims 2–4, 21, and 30–42 are rejected under 35 U.S.C. § 103(a) as unpatentable over Gross (US 5,083,270, iss. Jan. 21, 1992), Jannah (US 2002/0055905 A1, pub. May 9, 2002), and Carden (US 2007/0130035 A1, pub. June 7, 2007).[4]

Claim 26 is rejected under 35 U.S.C. § 103(a) as unpatentable over Gross, Jannah, Carden, and Mordecai (US 2008/0215480 A1, pub. Sept. 4, 2008).

Claim 26 is rejected under 35 U.S.C. § 103(a) as unpatentable over Gross, Jannah, Carden, and Intrator (US 2007/0179882 A1, pub. Aug. 2, 2007).

[3] The Examiner entered this rejection as a new ground (*see* Ans. 4–5).
[4] In the Answer, the Examiner withdrew the rejection of independent claim 26 under this bases (*see* Ans. 4). The Examiner did not, however, modify the rejections of independent claim 26 to also include claims 36–40 which depend therefrom. We take this error to be harmless error which does not alter the disposition of the present appeal.

ANALYSIS

Non-statutory subject matter

Independent claims 21, 26, and 30, and dependent claims 2–4, and 31–42

In rejecting independent claims 2–4, 21, 26, and 30–42 under 35 U.S.C. § 101, the Examiner determined that the claims, considered as a whole, are directed to a fundamental economic practice, and as such directed to an abstract idea of "issuing [an] annuity, distributing period benefits, relinquishing and receiving interest" (Ans. 4) without additional elements that transform it into a patent-eligible application of that idea (*see id.* at 4–5).

Appellants argue that the Examiner errs in rejecting the claims because "[a]t best, the Examiner recites generic paragraphs with minimal amendments to make a variety of conclusory statements" (Ans. 2 (emphasis omitted), and as such, "[t]here is no analysis or rationale provided to support these and the other assertions made by the Examiner" (*id.* at 3). More particularly, Appellants argue that there is no support in the Examiner's Answer to establish that the claims are directed to a fundamental economic practice (*id.*), and as such, "the claims are not directed to a patent ineligible concept" (*id.* at 4). Appellants' arguments are not persuasive.

According to the Specification, the present invention is directed to "deferred premium annuities and accompanying methods" (Spec. ¶ 3). The Specification observes "[u]nfortunately, typical annuity contracts require the individual to provide a lump sum amount of money to the life insurance company at the time of purchasing the annuity contract" (*id.* ¶ 2). To address this limitation, the Specification discloses a "deferred premium annuity [that] allows a purchaser (e.g., an individual) to pledge assets rather than pay cash upfront to purchase an annuity" (*id.* at ¶ 3). The Specification also discloses various payment options that a purchaser may elect to exercise after the annuity has been issued, i.e., during the "distribut[ion]" step (*see, e.g.*, *id.* ¶¶ 4–5). And, independent claim 21 is directed to a computer implemented method for offering an annuity, issuing the annuity in exchange for a future interest, distributing periodic benefits of the annuity, relinquishing the future interest, but continuing to distribute periodic payments, if a payment satisfies the price of the future interest, and receiving a current interest in the now matured future asset unless the future interest was previously satisfied.

Under step one of the framework set forth in *Alice*, we agree with the Examiner that the invention is broadly directed to the concept of "issuing [an] annuity, distributing period benefits, relinquishing and receiving interest" (Ans. 4), and similar to certain fundamental economic and conventional business practices that our reviewing courts have found patent ineligible, such as the concept of intermediated settlement in *Alice*, and the concept of risk hedging in *Bilski v. Kappos*, 561 U.S. 593 (2010), and, thus, is an abstract idea beyond the scope of § 101. *See Alice Corp.*, 134 S. Ct. at 2356; *Bilski*, 561 U.S. at 611.

And, to the extent Appellants argue that the Examiner erred in adequately supporting this determination by providing analysis or rationale (*see* Reply Br. 2–6), Appellants' argument is unpersuasive.

There is no requirement that the Examiners must provide evidentiary support in every case before a conclusion can be made that a claim is directed to an abstract idea. *See, e.g.*, para. IV "July 2015 Update: Subject Matter Eligibility" to 2014 Interim Guidance on Subject Matter Eligibility (2014 IEG), 79 Fed. Reg. 74618 (Dec. 16, 2014) ("The courts consider the determination of whether a claim is eligible (which involves identifying whether an exception such as an abstract idea is being claimed) to be *a question of law*. Accordingly, courts do not rely on evidence that a claimed concept is a judicial exception, and in most cases resolve the ultimate legal conclusion on eligibility without making any factual findings.") (Emphasis added). We agree that evidence may be helpful in certain situations where, for instance, facts are in dispute. But it is not always necessary. Based on the above analysis in light of the claims themselves, we are unpersuaded it is necessary in this case. *See Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) ("Instead of a definition [for what an 'abstract idea' encompasses], then, the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.")

We next consider whether additional elements transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the abstract idea on generic computer components. We conclude that it does not.

Independent claim 21 is directed to "[a] computer processor implemented method" including steps for "offering . . . an annuity to a purchaser" "issuing . . . the annuity to the purchaser in exchange for, at least, assignment of a future interest in an asset," "distributing . . . periodic benefits . . . [by] paying the periodic benefits to the purchaser [or] accruing the periodic benefits into the annuity," "relinquishing the future interest[, but continuing to distribute periodic payments,] if a payment that satisfies the price is received before" the future interest matures, and "receiving a current interest in the [matured future] asset . . . if the payment is not received before" maturation. Here, considering each of the claim elements in turn, we find them all to be directed to well-understood, routine, conventional activities previously known to the industry. And, when viewed as a whole, the computer components (e.g., "computer processor") of Appellants' method add nothing that is not already present when the steps are considered separately.

We also note that Appellants' claims do not purport to improve the functioning of the system itself. Nor do they effect an improvement in any other technology or technical field. Instead, claims 2–4, 21, 26, and 30–42 amount to nothing significantly more than an instruction to implement the abstract idea of "issuing [an] annuity, distributing period benefits, relinquishing and receiving interest" (Ans. 4) using generic computer components (*see, e.g.*, Spec. ¶ 14). This is insufficient to transform an abstract idea into a patent-eligible invention. "[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.

Appellants argue even if the claims are directed toward an abstract idea, there is no concern of preemption because "the claims present functional and palpable applications in the field of deferred premium annuities, but the claims also recite specific ways for issuing and managing the annuities using a specific set of elements recited by the claims" (Reply Br. 4–6). However,

> [t]he Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability. *Alice*, 134 S. Ct. at 2354 ("We have described the concern that drives this exclusionary principle as one of pre-emption[.]"). For this reason, questions on preemption are inherent in and resolved by the § 101 analysis.

Ariosa Diagnostics, Inc. v. Sequenom, Inc., 788 F.3d 1371, 1379 (Fed. Cir. 2015). Preemption concerns are, thus, fully addressed and rendered moot where a claim is determined to disclose patent ineligible subject matter under the two-part framework described in *Mayo* and *Alice*. Although "preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility" (*id.*).

We find no meaningful distinction between independent method claim 21, and either medium claim 26, or independent system claim 30; the claims all are directed to the same underlying invention. We acknowledge Appellants' argument regarding the means-plus-function limitations of independent system claim 30 (*see* Reply Br. 6), however, the portions of the Specification Appellants identify as providing the requisite corresponding structure (*see* Appeal Br. 3–4, 5 (citing Spec. ¶¶ 3–5, 10, 14, 16–24)) fail to persuade us that the system utilizes anything more than a generic computer, and as the Federal Circuit has made clear "the basic character of a process claim drawn to an abstract idea is not changed by claiming only its performance by computers, or by claiming the process embodied in program instructions on a computer readable medium." *See CyberSource*, 654 F.3d at 1375–76 (*citing In re Abele*, 684 F.2d 902 (CCPA 1982)).

In view of the foregoing, we sustain the Examiner's rejection of claims 2–4, 21, 26, and 30–42 under 35 U.S.C. § 101.

Written Description

In rejecting claims 2–4, 21, 26, and 30–42 under 35 U.S.C. § 112, first paragraph, the Examiner finds that there is no written description support in the Specification for "relinquishing the future interest if a payment that satisfies the price is received before the death of the [purchaser,] wherein the distributing the periodic benefits continues after the future interest is relinquished," as recited by limitation [c] of independent claim 21, and similarly recited by independent claims 26 and 30 (*see* Final Act. 2). More particularly, the Examiner finds "neither [] the word 'relinquishing' nor its equivalent was described anywhere in the Specification" (Ans. 5).

Whether a Specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact and is assessed on a case-by-case basis. *See, e.g.*, *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991)). The disclosure, as originally filed, need not literally describe the claimed subject matter (i.e., using the same terms or *in haec verba*) in order to satisfy the written description requirement. But the Specification must convey with reasonable clarity to those skilled in the art that, as of the filing date, Appellant was in possession of the claimed invention. *See id.*

Appellants maintain that the rejection is improper because the term "relinquishing" appears in original claim 1 and identify paragraphs 3–5 and 10 of the Specification, as well as Figure 1, as providing support (*see* Appeal Br. 4–5; *see also* Reply Br. 7–8). We agree with Appellants that a person of ordinary skill in the art would reasonably understand from the Specification (including claims), as originally filed, that the Specification provides written description support for the claim limitation "relinquishing the future interest if a payment that satisfies the price is received before the death of the [purchaser,] wherein the distributing the periodic benefits continues after the future interest is relinquished," as recited by limitation [c] of independent claim 21, and similarly recited by independent claims 26 and 30, at the time the application was filed. Here, we note that originally filed independent claim recites "if the purchaser or another entity provides full payment for the annuity before or at the death of the purchaser, then relinquishing the future interest in the asset."

Therefore, we do not sustain the Examiner's rejection of claims 2–4, 21, 26, and 30–42, under 35 U.S.C. § 112, as lacking written description.

Indefiniteness

In rejecting claims 2–4, 21, 26, and 30–42 under 35 U.S.C. § 112, second paragraph, the Examiner finds

> [t]he terms 'current' and 'future' in claims 21, 26 and 30 are a relative term[] which renders the claim indefinite. The terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

(Final Act. 3; *see also* Ans. 6).

However, we agree with Appellants that "a current interest or a future interest is simply a current ownership interest or a future ownership interest" (Appeal Br. 6 (citing Spec. ¶¶3, 17) (emphasis omitted); *see also* Reply Br. 8–9). We also agree with Appellants that "claim 21 implicitly defines the terms by reciting 'receiving a current interest in the asset, based upon maturation of future interest, if the payment is not received before the death of the purchaser'" (Appeal Br. 6–7 (emphasis omitted)).

In view of the foregoing, we do not sustain the Examiner's rejection under 35 U.S.C. § 112, second paragraph, of claims 2–4, 21, 26, and 30–42. *See Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification.").

In rejecting claims 34, 39, and 41 under 35 U.S.C. § 112, second paragraph, the Examiner finds

> [t]he 'similar' in claims 34, 39 and 41 are a relative term[] which renders the claim indefinite. The terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

(Final Act. 3; *see also* Ans. 6–7). However, we agree with Appellants that an "ordinary person would understand the scope of the phrase 'similar annuity paid with cash'" (Appeal Br. 7).

In view of the foregoing, we do not sustain the Examiner's rejection under 35 U.S.C. § 112, second paragraph, of dependent claims 34, 39, and 41. *See Orthokinetics,* 806 F.2d at 1576.

In rejecting claims 34, 39, and 41 under 35 U.S.C. § 112, second paragraph, the Examiner finds "[c]laims 34, 39 and 41 recite the limitation '<u>the</u> price charged for the annuity.' There is insufficient antecedent basis for this limitation in the claim" (Final Act. 3). However, in our view, a person of ordinary skill in the art would understand what is claimed when the claim is read in light of the claims and Specification. More particularly, we agree with Appellants that one of ordinary skill would understand "the independent claims from which they depend all recite 'the annuity has a price'" (Appeal Br. 7).

In view of the foregoing, we do not sustain the Examiner's rejection under 35 U.S.C. § 112, second paragraph, of dependent claims 34, 39, and 41.

In rejecting claims 30–35 under 35 U.S.C. § 112, second paragraph, the Examiner finds the "claim element 'means for' is a limitation that invokes 35 U.S.C. [§] 112(f) or 35 U.S.C. [§] 112 (pre-AIA), sixth paragraph" (Final Act. 3–4). The Examiner also finds "the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function" (*id.*).

In response, Appellants argue "that the specification sets forth an adequate disclosure showing what is meant by that language of the claim" (Appeal Br. 8; *see also* Reply Br. 10). We are not persuaded by Appellants' argument.

For computer-implemented means-plus-function claims where the disclosed structure is a computer programmed to implement an algorithm, "the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm." (*WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999)). Thus, the Appellants must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm to provide the necessary structure under § 112, ¶ 6.

In support of independent claim 30, for the limitation "means for offering an annuity to a purchaser, wherein the annuity has a price," Appellants direct us to their Figures 2 and 3 and paragraphs 14, 16, and 24 of the Specification (*see* Appeal Br. 8). Figure 2 shows "an exemplary flow diagram for purchasing an exemplary deferred premium annuity" (Spec. ¶ 8) which the Specification discloses "represent[s] a sequence of operations that can be implemented in hardware, software, or a combination thereof" (*id.* ¶ 14) and paragraph 16 merely discloses that a provider may offer a traditional annuity or a deferred annuity. Figure 3 shows "exemplary elements of a deferred premium annuity" (*id.* ¶ 9) and the Specification discloses that "[i]n some instances, information depicted within annuity 104 may be implemented as a data structure encoded on one or more computer-readable media" (*id.* ¶ 24).

After reviewing the identified portions, we find the Specification provides no description of how "offering an annuity to a purchaser" is to be performed by the system. Even if the described function could be programmed to be performed on a computer by the ordinary artisan, the fact that the ordinary artisan *could* program a computer to perform the recited functions does not create structure where none otherwise is disclosed. *See Function Media, L.L.C. v. Google, Inc.*, 708 F.3d 1310, 1319 (Fed. Cir. 2013). There must be at least one structure actually disclosed, not merely implied as being obvious to one of ordinary skill. Simply pointing to parts of a generic computer such as the memory that holds the algorithm is insufficient. *WMS Gaming,* 184 F.3d at 1349. We cannot look beyond the portions of the Specification pointed to by the Appellants for such supporting structure. *In re Aoyama,* 656 F.3d 1293, 1298 (Fed Cir. 2011).

Appellants have, thus, not disclosed adequate structure in support of the functions claimed under 35 U.S.C. § 112, sixth paragraph, rendering independent claim 30 and dependent claims 31–35 indefinite.

Obviousness

Independent claim 21 and dependent claims 2–4, 41, and 42,

We are persuaded by Appellants' argument that the Examiner erred in rejecting independent claim 21 under 35 U.S.C. § 103(a) because the combination of Gross, Jannah, and Carden fails to disclose or suggest "relinquishing the future interest if a payment that satisfies the price is received before the death of the purchaser, wherein the distributing the periodic benefits continues after the future interest is relinquished," as recited by limitation [d] of independent claim 21 (*see* Appeal Br. 9–11; *see also* Reply Br. 10–14).

In the Final Office Action, the Examiner acknowledges that Gross fails to disclose the argued limitation (Final Act. 5), but finds that Jannah discloses "relinquishing the future interest if a payment that satisfies the price is received before the death of the person" (*id.* at. 5–6 (citing Jannah ¶¶ 33–34); *see also* Ans. 8 (citing Jannah, Abs.) and Carden discloses "providing a guarantee that periodic payments will be made to consumers until death" (Final Act. 6 (citing Carden ¶ 28)).

Gross is directed to a system wherein "the owner of an asset may gain access to the value of the asset without relinquishing ownership or control of the asset during his lifetime" (Gross, col. 1, ll. 49–51).

Jannah is directed to a system for implementing "a reverse mortgage loan in exchange for pledging an asset, such as a home, as collateral"

(Jannah ¶ 33). Jannah discloses that "borrower **15** is not required to repay the reverse mortgage loan until the loan becomes due, such as when the asset is sold, or is otherwise triggered" (*id.*). Jannah discloses, however, "[t]he borrower **15** may repay the reverse mortgage loan from the proceeds of the sale of the home" (*id.*). More particularly, Jannah discloses that "[r]epayment of the reverse mortgage loan may be made either directly by the borrower **15** (e.g., by a cash repayment), or if the borrower **15** dies, out of the proceeds of the sale of the real property" (*id.* ¶ 34). .

Carden is directed to "a method for enabling a plurality of consumers to receive a term of life periodic payment from a financial product provide" (Carden ¶ 11). Carden discloses

> calculating [a] series of periodic payments by determining a future value of the asset utilizing an estimated value of the asset and a predetermined loan to value ratio, utilizing the future value to calculate a present value, and utilizing the present value and the expected life expectancy of the consumer to calculate the value of each one of the series of periodic payments.

(*Id.* ¶ 12). Carden discloses that "on the death of a consumer in the plurality of consumers, calculating the final payment payable to the financial product provider" (*id.* ¶ 13). Carden also discloses an embodiment which

> would allow for a Life Insurance Company to use its balance sheet in place of the SPV, thereby funding the consumer cash flows by providing life insurance policies to a pool of consumers, in return for a periodic payment, the periodic payment being utilized to fund the term of life annuity payments.

(*Id.* ¶ 20; *see also id.* ¶ 28).

We have reviewed the cited portions of Gross, in view of Jannah and Carden, and agree with Appellants that the combination of Gross, Jannah, and Carden fails to disclose or suggest the argued limitation (*see* Appeal Br.

9–11; *see also* Reply Br. 10–14). Although we agree with the Examiner that the combination of Gross and Jannah discloses "relinquishing the future interest if a payment that satisfies the price is received before the death of the purchaser," as recited by limitation [d] of independent claim 21 (*see* Final Act. 5–6 (citing Jannah ¶¶ 33–34); *see also* Ans. 8 (citing Jannah, Abs.), we cannot agree with the Examiner that the asserted combination discloses or suggests "wherein the distributing the periodic benefits continues after the future interest is relinquished," as further recited. That is, none of the cited references disclose or suggest that "distributing the periodic benefits continues after the future interest is relinquished," as independent claim 21 requires.

In response to Appellants' arguments, the Examiner takes the position that "the specific length of distributing (whether it continues after death or not) does not affect the manipulative steps recited in the claims" as such, "is considered to be an intended result" (Ans. 9). The Examiner also takes the position that because

> the independent claims comprises two "if statements" that are opposite scenarios and "relinquishing the future interest if a payment that satisfies the price is received before the death of the purchaser; wherein the distributing the periodic benefit continues after the future interest is relinquished" is just one of the two, the claims would still be unpatentable even if this wherein clause is not simply an intended result.

(*Id.*). However, we agree with Appellants that "[w]hile one may only be satisfied at a time, the Examiner is not at liberty to ignore expressly recited claim elements" (Reply Br. 13) and the limitation is not merely an intended result which can simply be ignored (*see id.* 13–14; *see also* Appeal Br. 11). In this regard, Carden, upon which the Examiner relies, must at least disclose the capability of "distributing the periodic benefits continues after the future interest is relinquished," as independent claim 21 requires, when "a payment that satisfies the price is received before the death of the person" to support the finding that Carden in combination with Gross and Jannah discloses the claimed subject matter as a whole.

In view of the foregoing, we do not sustain the Examiner's rejection of independent claim 21 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the Examiner's rejections of claims 2–4, 41, and 42, which depend therefrom.

Independent claim 26 and dependent claims 36–40

Independent claim 26 includes a limitation substantially similar to limitation [d] of independent claim 21, as discussed above. The Examiner's rejections of claim 26 under 35 U.S.C. § 103(a) based on Mordecai, in combination with Gross, Jannah (*see* Final Act. 14), and Carden and Intrator, in view of Gross, Jannah, and Carden (*see* Final Act. 11), do not cure the deficiency, identified by Appellants, in the Examiner's rejection of independent claim 21. Therefore, we do not sustain the Examiner's rejections of independent claim 26 under 35 U.S.C. § 103(a) for the same reasons set forth above with respect to independent claim 21. For the same reasons, we also do not sustain the Examiner's rejections of claims 36–40, which depend therefrom.

Independent claim 30 and dependent claims 31–35

The rejections of claims 30–35 are reversed pro forma. As discussed above, we find claims 30–35 indefinite under 35 U.S.C. § 112, second paragraph. The rejections of claims 30–35 under 35 U.S.C. § 103(a) over the prior art must fall, pro forma, as being necessarily based on speculative assumptions as to the scope of these claims. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). Our decision in this regard is based solely on the indefiniteness of the subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

DECISION

The Examiner's rejection of claims 2–4, 21, 26, and 30–42 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejection of claims 2–4, 21, 26, and 30–42 under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, is reversed.

The Examiner's rejection of claims 2–4, 21, 26, and 36–42 under 35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), second paragraph, is reversed.

The Examiner's rejection of claims 30–35 under 35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), second paragraph, is affirmed.

The Examiner's rejections of claims 2–4, 21, 26, and 30–42 under 35 U.S.C. § 103(a) are reversed.

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

AFFIRMED