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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/590,467	08/21/2012	Mark C. Davis	RPS920120013USNP(710.198)	6881

58127 7590 11/28/2016
FERENCE & ASSOCIATES LLC
409 BROAD STREET
PITTSBURGH, PA 15143

EXAMINER

WU, QING YUAN

ART UNIT	PAPER NUMBER
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2199

MAIL DATE	DELIVERY MODE
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11/28/2016

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK. C. DAVIS, DARYL C. CROMER,
HOWARD J. LOCKER, SCOTT E. KELSO

Appeal 2015-006679
Application 13/590,467
Technology Center 2100

Before BRUCE R. WINSOR, SHARON FENICK, and
DAVID J. CUTITTA II, *Administrative Patent Judges*.

WINSOR, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from the final rejection of claim 21. We have jurisdiction under 35 U.S.C. § 6(b). Claims 1–9 and 11–19 are allowed. Final Act. 2. Claims 10 and 20 are cancelled. App. Br. (Claims App’x) 13, 15.

We reverse.

¹ The real party in interest identified by Appellants is Lenovo (Singapore) PTE. LTD. App. Br. 3.

STATEMENT OF THE CASE

Appellants' disclosed invention relates to "scheduling [tasks] for execution on an information handling device having two or more cores of different size." Spec. Abstract. Claim 21 reads as follows:

21. A program product, comprising:

a storage device having program code embodied therewith, the program code comprising:

program code configured to identify a task to be scheduled for execution on an

information handling device having two or more cores of different size;

program code configured to determine an appropriate scheduling of the task for execution on the two or more of cores of different size, wherein the appropriate scheduling of the task is determined via a core signature for the task, wherein the core signature is determined via a procedure comprising: determining if the task fits on a little core; determining if the task is high priority; and determining if the task is executable on the little core within a threshold tolerance with respect to little core utilization;

program code configured to direct the task to an appropriate core for execution based on the appropriate scheduling determined; and

program code configured to execute the task on the appropriate core.

Claim 21 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Rather than repeat the arguments here, we refer to the Briefs ("App. Br." filed Feb. 23, 2015; "Reply Br." filed July 7, 2015) and the Specification ("Spec." filed Aug. 21, 2012, amended Aug. 28, 2014 and Dec. 2, 2014) for the positions of Appellants and the Final Office Action

(“Final Act.” mailed Sept. 5, 2014) and Examiner’s Answer (“Ans.” mailed May 7, 2015) for the reasoning, findings, and conclusions of the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2014).

ISSUE

The issue presented by Appellants’ arguments is whether the Examiner errs in finding “[a] program product, comprising: a storage device having program code embodied therewith” (herein the “storage device limitation”), as recited in claim 21, encompasses non-statutory subject matter under 35 U.S.C. § 101.

PRINCIPLES OF LAW

Claim construction is an issue of law that we review *de novo*. *Cordis Corp. v. Boston Scientific Corp.*, 561 F.3d 1319, 1331 (Fed. Cir. 2009).

When construing claims during prosecution,

[the USPTO] applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.

In re Morris, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *see also In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). Although claims are interpreted in light of the specification, “limitations are not to be read

into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Our reviewing court has found that transitory, propagating signals are not within any of the four statutory categories (process, machine, manufacture, or composition of matter). Therefore, a claim directed to computer instructions embodied in a signal is not statutory under 35 U.S.C. § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). “A transitory, propagating signal . . . is not a ‘process, machine, manufacture, or composition of matter.’ [These] four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter.” *Id.* Moreover, claims that are so broad that they read on non-statutory as well as statutory subject matter are unpatentable. *Cf. In re Lintner*, 458 F.2d 1013, 1015 (CCPA 1972) (citation omitted) (“Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter.”) “[A] machine is a ‘concrete thing, consisting of parts, or of certain devices and combination of devices.’ This ‘includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result.’” *In re Ferguson*, 558 F.3d 1359, 1364 (Fed. Cir. 2009) (quoting *Nuijten*, 500 F.3d at 1355)).

The Supreme Court has defined “manufacture” (in its verb form) as “the production of *articles* for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery.” The term is used in the statute in its noun form, and therefore refers to “articles” resulting from the process of manufacture. The same dictionary the Supreme Court relied on for its definition of “manufacture” in turn defines “article” as “a

particular substance or commodity: as, an *article* of merchandise; an *article* of clothing; salt is a necessary *article*.”

These definitions address “articles” of “manufacture” as being tangible articles or commodities.

Nuijten, 500 F.3d at 1356 (internal citations omitted).

ANALYSIS

The Examiner finds claim 21 encompasses a non-statutory signal because “unless a specific definition of storage device is provided, it is simply a variation of storage medium and as such may be interpreted to cover both statutory and non-statutory forms of the media.” Ans. 3. Appellants’ contend “the device is a storage device, i.e., hardware that stores instructions” (Reply Br. 10) and, therefore, does not encompass a transitory signal. We agree with Appellants.

We agree with the Examiner’s implicit thesis that a “storage device” necessarily includes a storage medium (*see* Ans. 3) but we do not agree that such a device is simply a variation of a medium (*see id.*). We first look to the ordinary meaning of the term “device” as used by those of ordinary skill in the computer arts. *See Morris*, 127 F.3d at 1054. The following is a pertinent definition from a technical dictionary: “**device** Any *hardware* component or peripheral, such as a printer, modem, monitor, or mouse, that can receive and/or send data.” WEBSTER’S NEW WORLD COMPUTER DICTIONARY 107 (10th ed. 2003) (emphasis added). We also note that in distinguishing a “machine,” as that term is used in 35 U.S.C. § 101, from a signal, our reviewing court uses “device” to define “machine.” *See Ferguson*, 558 F.3d at 1364; *Nuijten*, 500 F.3d at 1355. We conclude the ordinary meaning in the art of “device” encompasses a hardware computer

component, i.e., a “concrete thing,” *id.*, or a “tangible article[],” *id.* at 1355. In other words, the ordinary meaning of the term device encompasses a “machine” or “manufacture.” It does not, however, encompass a “[a] transitory, propagating signal,” *Nuijten*, 500 F.3d at 1357.

We now look to the Specification to ascertain if Appellants have defined or used the term “device” in a manner that expands its meaning to encompass a transitory propagating signal, *per se*. See *Morris*, 127 F.3d at 1054. In particular we look to the following paragraph relied upon by both the Examiner (Ans. 4–5) and Appellants (App. Br. 9):

Any combination of one or more *non-signal* device readable medium(s) may be utilized. The *non-signal* medium may be a storage medium. A storage medium may be, for example, an electronic, magnetic, electromagnetic, or semiconductor system, apparatus, or device, or any suitable combination of the foregoing. More specific examples of a storage medium would include the following: a portable computer diskette, a hard disk, a random access memory (RAM), a read-only memory (ROM), an erasable programmable read-only memory (EPROM or Flash memory), a portable compact disc read-only memory (CD-ROM), a magnetic storage device, or any suitable combination of the foregoing.

Spec. ¶ 51 (amended) (emphases added). We find nothing in this paragraph, or elsewhere in Appellants’ Specification, that evidences an intent to define or use the term “device” in anything other than its ordinary meaning in the art, i.e. one that encompasses a machine or manufacture but not a transitory signal. Indeed, the paragraph specifically qualifies the examples with the term “non-signal.” To be sure, paragraph 51 was amended during prosecution to eliminate certain examples (*see* Amendment after Final 7 (Dec. 2, 2014)) that the Examiner reasoned to read on transitory signal media (*see* Final Act. 2). We note that this is not a case where the

Specification has been amended to eliminate examples in order to *restrict* the scope of a term to less than its ordinary meaning — rather the Specification has been amended to eliminate examples in order to avoid *expanding* the scope of “device” *beyond its ordinary meaning*. Contrary to the Examiner’s conclusion (*see* Ans. 3–4), we conclude this amendment to paragraph 51, eliminating examples that may have been interpreted to expand the meaning of “device” beyond its ordinary meaning to include transitory signal media, was effective to negate any such expansion of the scope of the term “device” beyond its ordinary meaning.

For the foregoing reasons, we conclude claim 21 encompasses a machine or manufacture, but does not encompass a transitory signal *per se*. Accordingly, we do not sustain the rejection of claim 21.

DECISION

The decision of the Examiner to reject claim 21 is reversed.

REVERSED