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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAY SHIRO TASHIRO and DARREN R. CHOATE

Appeal 2016-001314
Application 11/097,523
Technology Center 3700

Before STEFAN STAICOVICI, MICHELLE R. OSINSKI, and
WILLIAM A. CAPP, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134(a) of the non-final rejection of claims 10, 14, 16, and 20 under 35 U.S.C. § 101 as not directed to patent eligible subject matter. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE INVENTION

Appellants' invention uses a computer to administer and score an academic test given to a student. Spec. 2, 6. Claim 10, reproduced below with certain language at the end of the claim highlighted in italics, is illustrative of the subject matter on appeal.

10. An article of manufacture comprising a information storage medium selected from a magnetic information storage medium, an optical information storage medium, and an electronic information storage medium, a plurality of test questions written to said information storage medium, said test questions relating to a subject area, and a computer useable medium having computer readable program code disposed therein to assess a person's knowledge of said subject area, wherein said article of manufacture is interconnected to an information display device and a data input device, the computer readable program code comprising a series of computer readable program steps to effect:

retrieving a plurality of test questions comprising (N) questions in each of (M) categories relating to said subject area, wherein (N) and (M) are each greater than 2;

selecting a plurality of first test questions for each of said (M) categories;

displaying each of said first test questions on said information display device;

receiving via said data input device zero or more answers to said first test questions;

determining for each of said displayed first test questions if that first test question was correctly answered;

calculating a first score comprising a percentage of first questions correctly answered;

retrieving a pre-determined Excellent Threshold and a pre-determined Excellent Points Assignment;

determining if said first score is greater than or equal to said Excellent Threshold;

operative if said first score is greater than or equal to said Excellent Threshold:

allocating said Excellent Points Assignment;

assigning an End Of Pathway designation of Excellent;
and

ending;

operative if said first score is not greater than or equal to said Excellent Threshold:

selecting second test questions for each of said (M) categories, wherein, for each value of (j), a number of second test questions for an (j)th category is based upon the number of incorrectly answered first questions for said (j)th category, wherein (j) is greater than or equal to 1 and less than or equal to (M);

displaying each of said second test questions on said information display device;

receiving via said data input device zero or more answers to said second test questions;

determining for each of said displayed second test questions if that second test question was correctly answered;

calculating a second score comprising a percentage of second questions correctly answered;

retrieving predetermined values for a Good Threshold, a Good-Pass Threshold, a Poor-Pass Threshold, a Good-Pass Points Assignment, a Good-Fail Points Assignment, a Poor-Pass Points Assignment, and a Poor-Fail Points Assignment;

operative if said first score is less than said Excellent Threshold but greater than said Good Threshold, and if said second score is greater than or equal to said Good-Pass Threshold:

allocating said Good-Pass Points Assignment to said person;

assigning an End Of Pathway designation of Good-Pass to said person; and

ending;

operative if said first score is less than said Excellent Threshold but greater than said Good Threshold, and if said second score is not greater than or equal to said Good-Pass Threshold:

allocating said Good-Fail Points Assignment to said person;
assigning an End Of Pathway designation of Good-Fail to said person; and
ending;

operative if said first score is less than said Good Threshold, and if said second score is greater than or equal to Poor-Pass Threshold:

allocating said Poor-Pass Points Assignment to said person;
assigning an End Of Pathway designation of Poor-Pass to said person; and
ending;

operative if said first score is less than said Good Threshold, and if said second score is not greater than or equal to said Poor-Pass Threshold:

allocating said Poor-Fail Points Assignment to said person;
assigning an End Of Pathway designation of Poor-Fail to said person; and
ending;

wherein said plurality of questions comprise one or more questions relating to a first category of knowledge relating to said subject area, and one or more questions relating to a second category of knowledge relating to said subject area;

wherein said computer readable program code to select a plurality of first test questions from said predetermined plurality of test questions further comprises a series of computer readable program steps to effect selecting from said plurality of questions (n1) first test questions relating to said first category and (n2) first test questions relating to said second category;

calculating a first category score C1 for said first category by dividing the number of correctly answered first test questions relating to said first category by (n1);

calculating a first category score C2 for said second category by dividing the number of correctly answered first test questions relating to said second category by (n2).

OPINION

Current Posture of the Application on Appeal

The instant application made a previous appearance before the Board that was decided on October 31, 2013 (the “Prior Decision”). In the Prior Decision, the Board Affirmed the Examiner’s rejection of then pending claims 10, 12–14, 16, 18–20, and 22–27 under 35 U.S.C. § 101 as directed to non-patentable subject matter. Prior Decision 15. The Board also disposed of various prior art rejections under 35 U.S.C. § 103(a). *Id.*

After entry of the Prior Decision, Appellants filed a Request for Continued Examination on December 30, 2013 and, contemporaneously therewith, filed an amendment cancelling all but claims 10, 14, 16, and 20. *See* Preliminary Amendment dated December 30, 2013. Among other things, Appellants added language to claim 10 that is italicized in the above recitation of the claim. *Id.* On June 19, 2014, the Supreme Court entered its decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014). Shortly thereafter, on August 8, 2014, the Examiner entered a non-final rejection rejecting all pending claims under 35 U.S.C. § 101 as directed to patent ineligible subject matter, after which the instant appeal was taken.

35 U.S.C. § 101 - Patent Ineligible Subject Matter

In *Alice*, the Supreme Court set forth “a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 566 U.S. 66, 72–73 (2012)). According to the Supreme Court’s framework, we

must first determine whether the claims at issue are directed to one of those concepts. *Id.* If so, we must secondly “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.* The Supreme Court characterizes the second step of the analysis as “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.* (brackets in original) (quoting *Mayo*, 566 U.S. at 72).

Regarding the rejection of independent claim 10 with respect to the first step, the Examiner determines that the claim is directed to the “abstract idea of a method of organizing human activities.” Non-Final Action 2. With respect to the second step of the *Alice/Mayo* analysis, the Examiner finds:

The additional elements or combination of elements in the claims other than the abstract idea per se amounts to no more than: mere instructions to implement the idea on a computer. Viewed as a whole, these additional claim elements do not provide meaningful limitation(s) to transform the abstract idea into a patent eligible application of the abstract idea such that the claim(s) amounts to significantly more than the abstract idea itself.

Id.

Claim 10

Appellants argue that claim 10 is not directed to an abstract idea or a method of organizing human activity. Br. 15–17. According to Appellants, “the Examiner’s unsupported thesis that Appellant’s claims relate to ‘a method of organizing human activities’ lacks any merit whatsoever.” *Id.* at 16. Appellants take the position that “assess[ing] a person’s knowledge of

a subject area” is something other than an abstract idea related to organizing human activities. *Id.* at 17.

In response, the Examiner directs our attention to the case of *Planet Bingo, LLC v. VKGS LLC*, 576 F. App’x 1005 (Fed. Cir. 2014) as an example of an abstract idea in the form of a method of organizing human activity. Ans. 5.

Although the claims are not drawn to the same subject matter, the abstract idea of managing a game of bingo is similar to the abstract ideas of managing risk (hedging) during consumer transactions (*Bilski*) and mitigating settlement risk in financial transactions (*Alice Corp.*) In the present case, an abstract idea of assessing a person’s knowledge of a subject area can be performed mentally or in a computer and is similar to the kind of “organizing human activity” that was at issue in *Planet Bingo* and *Alice Corp.* The claims provide a series of mental steps that can be performed by a human either in the human mind or on paper which can be included in the non-limiting examples of methods of organizing human activities.

Id. at 5–6; Ans. 8.

With respect to step 1 of the *Alice/Mayo* analysis, we agree with the Examiner’s position that the invention is directed to a method of organizing human activity. Assessing a person’s knowledge of a subject area by administering and scoring/grading a test is similar to other abstract ideas that have been found to relate to organizing human activities. *See, e.g., Multimedia Plus, Inc. v. PlayerLync LLC*, 695 F. App’x 577 (Fed. Cir. 2017) (claim dealt with training program); *See also Smart Systems Innovations, LLC v. Chicago Transit Authority*, 873 F.3d 1364, 1372 (Fed. Cir. 2017) (“collection, storage, and recognition of data”); *Netflix, Inc. v. Rovi Corporation*, 114 F. Supp.3d 927, 944 (N.D. Cal. 2015) (claims directed to

“using a user’s viewing history to visually distinguish watched programs from unwatched programs and to make recommendations”).

With respect to step 2 of the *Alice/Mayo* analysis, Appellants argue that the Examiner ignores “additional elements” that the Board had previously found patentable in the Prior Decision. Br. 18. Appellants argue that these additional elements cover more than three (3) complete pages of type-written text. *Id.* at 21.

In response, the Examiner points out that Appellants’ arguments about subject matter that was “previously found patentable” related to prior art rejections under 35 U.S.C. § 103(a) and that Appellants’ arguments are not relevant for purposes of a Section 101 patentable subject matter analysis. Ans. 12. We agree with the Examiner on this point.

With respect to Appellants’ “additional elements” arguments, the Examiner takes the position that the three complete pages of “additional elements” merely relate to the steps of administering and scoring a test and, as such, merely evidence the fact that the claim is directed to an abstract idea. Ans. 12–13; *see also* Claims App. claim 10 steps immediately following: “*the computer readable program code comprising a series of computer readable program steps to effect:*” The Examiner points out, correctly, that the elements in the claim that go to the issue of whether the claimed subject matter is something more than a claim on the abstract idea itself, are the elements directed to computerized administration of the test. Ans. 13. The Examiner identifies these elements as an information storage medium, a computer useable medium with program code, an information display device, and a data device. *Id.* The Examiner considers these elements as “commonly known hardware with basic input and output, and

the claimed functionality does not produce any improvement in the functioning of the computers themselves.” *Id.* The Examiner concludes, therefore, that there is nothing “significantly more” in claim 10. *Id.*

We agree with the Examiner that the computerization elements in claim 10 do not amount to something “significantly more” under step 2 of the *Alice/Mayo* analysis. Appellants provide neither evidence nor persuasive argument to contravene this point. It is well settled that merely relying on the data storage and processing capabilities of a computer is insufficient to overcome a rejection under Section 101. As our reviewing court has explained, “the fact that the required calculations could be performed more efficiently via a computer does not materially alter the patent eligibility of the claimed subject matter.” *Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Can. (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012). Similarly, the fact that administration and scoring of an academic test could be performed more quickly or efficiently via a computer does not materially alter the patent eligibility of Appellants’ claims. It is now well settled that mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2358. Thus, merely stating an abstract idea while adding the words “apply it” is not enough to confer patent eligibility. *Id.*

[I]f that were the end of the § 101 inquiry, an applicant could claim any principle of the physical or social sciences by reciting a computer system configured to implement the relevant concept.

Id. at 2359.

Under the second prong of the *Alice/Mayo* test, we have considered whether the claim elements, both individually and “as an ordered

combination,” “transform the nature of the claim’ into a patent-eligible application.” *See Alice*, 134 S. Ct. at 2355. We are not persuaded that using a computer to administer and score an academic subject matter test to students satisfies the “significantly more” criteria under the second prong of *Alice/Mayo*. *Id.* at 2359. Essentially, all Appellants have done here is use generic computer data gathering, processing, and display technology to administer and score/grade an academic test to a student. As in *Alice*, “each step does no more than require a generic computer to perform generic computer functions.” *Id.*

We have considered Appellants’ remaining arguments, and find them to be without merit. Accordingly, we sustain the Examiner’s Section 101 rejection of claim 10.

Claim 16

Claim 16 is an independent claim. Claims App. Claim 16 is directed to a computer program product and recites a plurality of limitations directed to computer readable program code that causes certain specified outcomes or results related to the administration and scoring/grading of an academic test. *Id.*

As with claim 10, Appellants argue that claim 16 is not directed to an abstract idea of organizing human activity. Br. 21. Given the similarity in subject matter between claims 10 and 16, we find this argument unpersuasive for the same reasons discussed above with respect to the rejection of claim 10.

With respect to step 2 of *Alice/Mayo* analysis, Appellants direct our attention to the plethora of “computer readable program code” limitations recited in claim 16. *Id.* at 21–26. Appellants, once again, request that we

take into account that the recital of such limitations covers more than three pages of type written text. *Id.* at 26. Appellants argue that claim 16 recites a “specific way to automate assessment of a person’s knowledge of a subject area.” *Id.*

In response, the Examiner states, correctly, that claim 16 provides nothing significantly more than generic computer hardware. Ans. 11. “The limitations merely provide commonly known hardware with basic input and output, and the claimed functionality does not produce any improvement in the functioning of the computers themselves. As such, there is nothing ‘significantly more’ in claim 16.” *Id.* at 15.

Appellants’ “additional elements” argument is not persuasive. Claim 16 presents an abstract idea of administering and scoring/grading an academic test to a student. The fact that Appellants use more than three page of typewritten text to describe a method of organizing human activity does not make the idea any less abstract. The computer hardware and code limitations merely implement the abstract idea. As previously discussed, merely stating an abstract idea while adding the words “apply it” in connection with generic computer technology is not enough to confer patent eligibility. *See Alice*, 134 S. Ct. at 2358.

We have considered Appellants other arguments, including the non-preemption arguments (*see* Br. 26–27), and do not find them persuasive. *See Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, preemption concerns are fully addressed and rendered moot). We sustain the Examiner’s Section 101 rejection of claim 16.

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Claims 14 and 20

Claims 14 and 20 are not separately argued by Appellants and are deemed to fall with claims 10 and 16. *See* 37 C.F.R. § 41.37(c)(iv) (failure to separately argue claims).

DECISION

The decision of the Examiner to reject claims 10, 14, 16, and 20 is 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)(1)(iv).

AFFIRMED