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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CARL ALEXANDER WOOLDRIDGE,
BRIAN TOWNSEND JOHNSON,
FRANCIS M. ANTON JR.,
and JEFFREY HUNTER PITTMAN

Appeal 2016–001501
Application 14/157,462
Technology Center 3600

Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and
BRUCE T. WIEDER, *Administrative Patent Judges*.
FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE¹

Carl Alexander Wooldridge, Brian Townsend Johnson, Francis M. Anton Jr., and Jeffrey Hunter Pittman (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1–9, the only claims pending in

¹ Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed May 22, 2015) and Reply Brief (“Reply Br.,” filed November 16, 2015), and the Examiner’s Answer (“Ans.,” mailed October 16, 2015), and Final Action (“Final Act.,” mailed January 6, 2015).

the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

The Appellants invented a way of offering an insurance policy for a mobile device. Specification para. 2.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below (bracketed matter and some paragraphing added).

1. A method for verifying an operational status of an [sic, a] mobile device that is requesting a protection policy, the method comprising the steps of:

[1] providing an application configured

to operate on the mobile device

and

to test at least one function of the mobile device;

[2] receiving a request to apply for the protection policy for the mobile device,

the request

received after the mobile device has been purchased and deployed to a user

and

not associated with a seller or manufacturer of the mobile device;

- [3] conducting a test of at least one function of the mobile device through the application including
 - identifying at least one component of the mobile device to test,
 - initiating a test of the one component including activating the one component either by
 - prompting the user to initiate an action that will use the one component
 - or
 - initiating an action in a background without user input that will use the one component;
- [4] determining results of the test including
 - determining an operational capability of the one component;
- [5] evaluating information in the request and at least one result of the test including
 - evaluating the determined results to determine whether the operational capability of the one component exceeds a predetermined threshold;
- [6] accepting the request based on the evaluating and at least one result of the test;
- and
- [7] denying the request based on the comparing and failure of the one component based on the evaluating.

Claims 1–9 stand rejected under 35 U.S.C. § 101 as directed to non–statutory subject matter.

ANALYSIS

Independent claim 1 recites it is a “method for verifying an operational status of an [sic] mobile device that is requesting a protection policy.” (Claims App.) It does so by taking advantage of the technological capacity of such a device to electronically make its internal structure and coding accessible to remote inspection, providing a mechanism for bypassing conventional manual inspection procedures. According to the Appellants, the claimed embodiment “eliminates inconvenience and disruption to the user of a mobile device who wishes to verify a warranty or insurance policy on the mobile device who would otherwise, for example, need take the device to a customer service center.” (Appeal Br. 8.)

In re Alice Corp. v. CLS Bank Int’l, 134 S. Ct. 2347 (2014), the Supreme Court provided a two-step test to evaluate whether a claim is eligible under § 101.² For the purposes of this appeal, we focus on the second step of the *Alice* test which requires the consideration of “the elements of each claim both individually and ‘as an ordered combination’ to determine whether the

² As for the first step of the *Alice* test, suffice it to say that we agree with the sentiment of both the Examiner and the Appellants, that the claims on appeal are directed to a concept that involves verifying an operational status of a mobile device that is requesting a protection policy. (See Answer 4; Appeal Br. 6.) The Appellants do not persuasively challenge, and we do not necessarily disagree with, the Examiner’s determination that verifying an operational status of a mobile device that is requesting a protection policy is an abstract idea. As for the specific limitations that the Appellants assert amplify the claims beyond an abstract idea (see Appeal Br. 6–9) we defer our consideration of their narrowing effect for step two of the *Alice* analysis.

additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355.

The Examiner establishes that the recited elements, “individually,” fail to “‘transform the nature of the claim’ into a patent-eligible application.” (*See id.*; *see also* Non-Final Action 4.) We agree with the Examiner that the claims appear to recite elements that “when taken alone, each execute in a manner routinely and conventionally expected of these elements.” (Non-Final Action 4–5.)

However, the Examiner does not sufficiently establish that the “ordered combination” of the recited elements also fails to “‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355. “An inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces,” even if these pieces constitute generic computer, network, and internet components. *Bascom Global Internet v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016). As discussed above, the Appellants explain that the claimed architecture (i.e., the ordered combination and arrangement of the recited elements) provides a particular technical advantage. And, as also discussed above, the Examiner does not persuasively challenge the Appellants’ position on this matter.

Accordingly, the Examiner has not sufficiently established, on the record before us, that claims 1–9 do not pass muster under step two of the *Alice* test. Thus, we do not sustain the Examiner’s rejection of claims 1–9 under 35 U.S.C. § 101.

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CONCLUSIONS OF LAW

The rejection of claims 1–9 under 35 U.S.C. § 101 as directed to non–
statutory subject matter is improper.

DECISION

The rejection of claims 1–9 is reversed.

REVERSED