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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JUERGEN FRITSCH, DETLEF KOLL,
KJELL SCHUBERT, CHRISTOPHER M. CURRIVAN

Appeal 2016-001721
Application 13/196,276
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant(s) seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1–6. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

BACKGROUND

Appellants' invention is directed to a method for monitoring user interaction with a document editing system. Spec. 2¹.

Claim 1 is illustrative:

1. (previously presented) A method performed by at least one computer processor executing computer program instructions stored on at least one non-transitory computer-readable medium, wherein the computer program instructions are executable by the at least one computer processor to perform a method for use with a document editing system and a plurality of documents, the method comprising:

(A) identifying, during editing of the plurality of documents, actual editing behavior applied by a user to the document editing system to edit the plurality of documents; and

(B) identifying a modification to the document editing system based on the actual editing behavior, comprising:

(B) (1) deriving a statistic from the actual editing behavior;

(B) (2) determining whether a value of the statistic is below a minimum value;

(B) (3) if the value of the statistic is determined to be below the minimum value, then identifying the modification as a modification that increases the value of the statistic; and

¹ We refer to the Specification filed Aug. 2, 2011 ("Spec."); [the Second] Non-Final Office Action mailed Nov. 28, 2014 ("Non-Fin. Act."); Appeal Brief filed Apr. 27, 2015 ("App. Br."); and the Examiner's Answer mailed Sept. 21, 2015 ("Ans."). (It is noted that a Reply Brief was filed on Nov. 23, 2015.)

(B) (4) if the value of the statistic is determined to be higher than the minimum value, then identifying the modification as a modification that decreases the value of the statistic.

(App. Br., Claims App'x, 25–26.)

The Examiner relies on the following prior art reference as evidence of unpatentability:

Halverston, C., et al., *The Beauty of Errors: Patterns of error connection in desktop speech systems [PDF]*, umich.edu; *Proceedings of INTERACT...1999* books.google.com

Vemuri, S., et al., *Improving Speech Playback Using Time-Compression and Speech Recognition, [PDF]*, uiowa.edu...*Proceedings of the 2004 – di.acm.org*

Appellant(s) appeal the following rejection(s):

Claims 1–6 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory ideas.

Claims 1–6 under 35 U.S.C. § 103(a) as unpatentable over Halverston, C., et al., *The Beauty of Errors: Patterns of error connection in desktop speech systems [PDF]*, umich.edu; *Proceedings of INTERACT...1999* books.google.com; in view of Vemuri, S., et al., *Improving Speech Playback Using Time-Compression and Speech Recognition, [PDF]*, uiowa.edu...*Proceedings of the 2004 – di.acm.org*

PRINCIPLES OF LAW

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347, 2354 (2014).

In determining whether a claim falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. *See Alice*, 134 S. Ct. at 2356 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (“Analyzing respondents’ claims according to the above statements from our cases, we think that a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter.”); *Parker v. Flook*, 437 U.S. 584, 594–595 (1978) (“Respondent’s application simply provides a new and presumably better method for calculating alarm limit values.”); *Gottschalk v. Benson*, 409 U.S. 63, 64 (1972) (“They claimed a method for converting binary-coded decimal (BCD) numerals into pure binary numerals.”).

The patent-ineligible end of the spectrum includes fundamental economic practices, *Alice*, 134 S. Ct. at 2357; *Bilski*, 561 U.S. at 611; mathematical formulas, *Parker*, 437 U.S. at 594–95; and basic tools of scientific and technological work, *Gottschalk*, 409 U.S. at 69. On the patent-eligible side of the spectrum are physical and chemical processes, such as curing rubber, *Diamond*, 450 U.S. at 184 n.7, “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores,” and a process for manufacturing flour, *Gottschalk*, 409 U.S. at 69.

If the claim is “directed to” a patent-ineligible abstract idea, we then consider the elements of the claim—both individually and as an ordered combination—to assess whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2355. This is a search for an “inventive concept”—an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.*

ANALYSIS

Rejection under 35 U.S.C. § 101

The Examiner held that the claims are directed to managing editing behavior of a user which is a way of organizing human activities. (Non-Fin. Act. 3.) The Examiner further explains that the abstract idea is calculating a statistic of a user’s job performance and then comparing that to a threshold as to whether the job performance can be improved and this is a way of organizing human activity (i.e. if the person’s job performance with respect to a particular aspect is below par, then identifying how they can improve it.)

The Examiner finally held that the abstract idea is merely comparing the amount or type of work that a user is doing with what they could be doing. Ans. 5.

We are not persuaded of error on the part of the Examiner by Appellants' argument that the method is performed by a computer and not a human and thus is not directed to an abstract idea of organizing human activities. We agree with the Examiner that the claims are directed to comparing the amount or type of work that a user is doing with what they could be doing. In this regard, claim 1 is directed to the abstract idea of identifying actual editing behavior of a user and deriving a statistic therefrom and comparing the statistic regarding the actual editing behavior of a user to a value and identifying modifications to the system that will increase the statistic. The fact that the various steps are performed by a computer does not change the basic character of a method of claim 1. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011) (*citing In re Abele*, 684 F.2d 902 (CCPA 1982)).

We are not persuaded of error on the part of the Examiner by Appellants' argument that the Examiner's rejection is conclusory and has not addressed each element of claim 1. We conclude that the Examiner's statement is sufficient to place Appellants on notice as to step 1 of *Alice* as required under 35 U.S.C. § 132. Further, Appellants' understanding of the Examiner's rejection on this point was manifested by their response to the Office Action. Appellants did not respond by asserting that they did not understand the Examiner's rejection. Instead, Appellants presented arguments in response to the rejection. *See In re Jung*, 637 F.3d 1356 (Fed.

Cir. 2011). On the issue of prima facie notice, particularly to anticipation but also generally, our reviewing court was clear in *Jung* that:

There has never been a requirement for an examiner to make an on-the-record claim construction of every term in every rejected claim and to explain every possible difference between the prior art and the claimed invention in order to make out a prima facie rejection.

637 F.3d at 1363.

The Federal Circuit further stated:

Section 132] does not mandate that in order to establish prima facie anticipation, the PTO must explicitly preempt every possible response to a section 102 rejection. Section 132 merely ensures that an applicant at least be informed of the broad statutory basis for the rejection of his claims, so that he may determine what the issues are on which he can or should produce evidence.” *Chester*, 906 F.2d at 1578 (internal citation omitted). As discussed above, all that is required of the office to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. As the statute itself instructs, the examiner must “notify the applicant,” “stating the reasons for such rejection,” “together with such information and references as may be useful in judging the propriety of continuing prosecution of his application.

Jung, 637 F.3d at 1363.

The Examiner's discussion was more than sufficient to meet this burden as to *Alice* step 1.

Appellants' argument that the Examiner erred in rejecting claim 1 as being directed to patent ineligible subject matter because claim 1 expressly recites a modification to the document editing system itself not changing the behavior of the user, is likewise unpersuasive. As stated above, in our view, claim 1 is directed to comparing the amount or type of work that a user is doing with what they could be doing i.e. identifying an actual editing behavior of a user and deriving a statistic therefrom and comparing the statistic regarding the actual editing behavior of a user to a value. The recitation of identifying a modification to the document editing system is part of the abstract idea itself.

In view of the foregoing, we will sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 101. We will also sustain the rejection as it is directed to claims 2–6 because the Appellants have not argued the separate patent eligibility of these claims.

Rejection under 35 U.S.C. § 103

We are not persuaded of error on the part of the Examiner by Appellants' argument that Halverston does not disclose identifying *during editing* of the plurality of documents actual editing behavior applied by the user to the document editing system to edit the documents (App. Br. 20–21). Appellants argue that Halverston does not identify editing behavior until after the subjects have completed dictating. App. Br. 21.

We agree with the Examiner that Halverson teaches that the step of identifying behaviors is done by videotaping the editors actually editing a document (3.3-3.4). As such, Halverson does disclose identifying editing behaviors during editing as recited in claim 1.

In view of the foregoing, we will sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a). We will also sustain the rejection as it is directed to claims 2–6 because the claims do not argue the separate patentability of these claims.

DECISION

We affirm the Examiner's § 101 rejection,
We affirm the Examiner's § 103(a) rejection.

TIME PERIOD

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) (2009).

ORDER

AFFIRMED