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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES PATTERSON and NATHAN MOODY

Appeal 2016-004160
Application 13/216,773
Technology Center 3600

Before MURRIEL E. CRAWFORD, CYNTHIA L. MURPHY, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's final decision rejecting claims 1–4, 6, 11–13, 20–22, 24, and 29–31. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

BACKGROUND

Appellants' invention is directed to the field of electronic books and more particularly to systems and methods for accessing additional materials referenced within an electronic text via electronic devices. Spec. ¶ 2.

Claim 1 is illustrative:

1. An electronic book reader comprising:
a hardware processor; and
a reader module configured to display a portion of text from an electronic book, the portion of text including a bibliographic reference to an external work, the electronic book not natively providing a link to the external work, the reader module comprising:
a recognition subsystem, configured to identify, using the hardware processor, the bibliographic reference in the portion of text based on a pattern of characters within the portion of text indicative of the bibliographic reference being present in the portion of text; and
an ordering subsystem, configured to select a source of the external work and obtain a digital copy of the external work from the source responsive to selection of the bibliographic reference in the portion of text by a user.

REJECTIONS

Claims 1–4, 6, 11–13, 15, 20–22, 24, and 29–31 are rejected under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more..

Claims 1–4, 6, 11–13, 15, 20–22, 24, and 29–31 are rejected under 35 U.S.C. § 103(a) as unpatentable over Siegel et al. (US 2008/0168073 A1, published July 10, 2008, in view of Hayes et al. (US 2005/0210047 A1, published Sept. 22, 2005).

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.*, 566 U.S. 66, 75–78 (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, *Flook*, 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.*

In addition, the Federal Circuit has held that if a method can be performed by human thought alone, or by a human using pen and paper, it is merely an abstract idea and is not patent-eligible under § 101. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) (“[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.”). Accordingly, the mental processes recited in independent claim 1, e.g., assimilating information, creating a hypothetical resource, mapping hypothetical and actual resources, determining a minimum parameter increase and reconciling a parameter increase with a scheduling policy, remain unpatentable, even when automated to reduce the burden on the user of what once could have been

done with pen and paper. *Id.* at 1375 (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*, [409 U.S. 63 (1972)].”).

ANALYSIS

Rejection under 35 U.S.C. §101

The Appellants argue that the Examiner does not provide an explanation nor cite any references to support the conclusion that the claims are not directed to significantly more than an abstract idea. We do not agree.

The Examiner holds and explains that the claims are directed to an electronic book reader and that that is an abstract idea. Final Act. 3; Ans. 2. We note that this holding regarding the claims is in agreement with Appellants’ own characterization of the claims found on page one of Appellants’ Specification. And the Specification describes the recited elements of the electronic book reader as consisting of, and/or implemented on, conventional (e.g., commercially available) computer components. (*See* Spec. ¶¶ 28–36.)

It is true that the Examiner did not cite any evidence in the form of references to support the rejection. However, consideration of evidence in making a determination under the first step of the *Alice* framework has merit. *See Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229 (Fed. Cir. 2016). But there is no requirement that examiners must provide evidentiary support in every case before a conclusion can be made that a claim is directed to an abstract idea. 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 often do

not rely on evidence that a claimed concept is a judicial exception, and in many cases resolve the ultimate legal conclusion on eligibility without making any factual findings. Evidence may be helpful in certain situations where, for instance, facts are in dispute. But, here, it is not necessary as there is no cogent dispute that the claims are directed to an electronic book reader and that this an abstract idea.

We do not agree with the Appellants that the Examiner is relying on allegations of lack of novelty to conclude that the claims are directed to an abstract idea. Rather, the Examiner simply analyzes the claims in accordance with the second part of the *Alice* analysis and finds the other elements of the claims in addition to the abstract idea do not recite significantly more than the abstract idea itself.

Appellants also argue that novelty is at the heart of the statutory subject matter analysis. This is not true. To the extent Appellants maintain that the limitations of claim 1 necessarily amount to “significantly more” than an abstract idea because the claimed apparatus is allegedly patentable over the prior art, Appellants misapprehend the controlling precedent. Although the second step in the *Alice/Mayo* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for ““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.”” *Alice*, 134 S. Ct. at 2355. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 89–91.

We are not persuaded of error on the part of the Examiner by Appellants’ argument that the claims do not preempt all applications of the

alleged abstract idea. “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015), cert. denied, 136 S. Ct. 701, 193 (2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”). And, “[w]here a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa*, 788 F.3d at 1379.

In view of the foregoing, we will sustain this rejection as it is directed to claim 1. We will also sustain the rejection as it is directed to the remaining claims because the Appellants have not argued the separate patent eligibility of these claims.

Rejection under 35 U.S.C. §103

We will not sustain this rejection because we agree with the Appellants that Siegel does not disclose an ordering subsystem that is configured to *select a source* of the external work.

Appellants’ Specification discloses that the source of the external work is selected by the ordering subsystem. [¶ 50]. Independent claims 1, 11 and 20 positively recite that a selection of a source of the external work is done.

The Examiner relies on the teaching in Siegel of annotations to digital works as the external work, and on paragraphs 90 to 92, for teaching an

ordering subsystem configured to select a source of the external work and obtain a digital copy. Ans. 7.

We find that Siegel teaches that a user is presented with a list of annotations when reading an electronic book and can select an annotation to obtain from the Siegel system. However, the *source* of the annotations is the Siegel server system itself. [¶ 60]. The Examiner considers the author of the annotation to be the source of the annotations. However, even if this were true, the Examiner has not established that the Siegel system selects an author of the annotation *responsive to selection of the bibliographic reference* by the user. Rather, it appears that in Siegel, the author of the annotation is fixed and the annotation is stored in an annotation database and the annotation is presented to the user upon request. [¶ 58].

In view of the foregoing, we will not sustain this rejection.

DECISION

We affirm the Examiner's 35 U.S.C. § 101 rejection of claims 1–4, 6, 11–13, 15, 20–22, 24, and 29–31 .

We reverse the Examiner's 35 U.S.C. § 103 rejection of claims 1–4, 6, 11–13, 15, 20–22, 24, and 29–31.

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