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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER LEE ROVIK, CHARAN S. LOTA,
and DONALD ANTHONY RESTAURI III,

Appeal 2016-006567
Application 13/409,775
Technology Center 3600

Before BIBHU R. MOHANTY, TARA L. HUTCHINGS, and
AMEE A. SHAH, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL¹

The Appellants² appeal under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 1–20, which are all of the pending claims.

We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Throughout this decision, we refer to the Appellants' Appeal Brief ("Appeal Br.," filed Nov. 2, 2015), Reply Brief ("Reply Br.," filed June 17, 2016), and Specification ("Spec.," filed Mar. 1, 2012), and to the Examiner's Answer ("Ans.," mailed Apr. 22, 2016) and Final Office Action ("Final Act.," mailed May 8, 2015).

² According to the Appellants, the real party in interest is Toyota Motor Engineering & Manufacturing North America, Inc. Appeal Br. 3.

STATEMENT OF THE CASE

The Appellants' invention "generally relate[s] to a vehicle, and more specifically to a vehicle for communicating with a vendor interaction system." Spec. ¶ 1.

Claims 1, 17, and 20 are the independent claims on appeal. Claim 1 (Appeal Br. 30 (Claims App.)) is illustrative of the subject matter on appeal, and is reproduced below (bracketing added for reference):

1. A vehicle for communicating with a vendor interaction system of a vendor, the vehicle comprising (paragraphing added for clarity):

[(a)] network interface hardware;

[(b)] at least one processor communicatively coupled to the network interface hardware; and

[(c)] at least one display communicatively coupled to the at least one processor,

wherein the at least one processor executes logic to:

[(b1)] establish a communication link with the vendor interaction system;

[(b2)] receive, with the network interface hardware, a vendor data signal from the vendor interaction system, the vendor data signal indicative of vendor information;

[(b3)] receive, with the network interface hardware, a user preference data signal indicative of user order preferences for the vendor, wherein the user preference data signal contains at least one of prior orders placed with the vendor, information related to prior orders placed with the vendor, user favorite orders at the vendor, pending orders placed with the vendor, coupons of the vendor, discount information of the vendor, and a list of favorite food items commonly available from multiple vendors;

[(b4)] display at least one of the user order preferences and the vendor information on the at least one display; and

[(b5)] display an order prompt on the at least one display requesting a user to make an order selection from at least one of the vendor information or the user order preferences displayed on the at least one display.

REJECTIONS

Claims 1–20 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Final Act. 2.

Claims 1–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chutorash (US 2010/0280956 A1, pub. Nov. 4, 2010) and Pisz (US 2010/0156712 A1, pub. June 24, 2010. *Id.* at 3.

ANALYSIS

35 U.S.C. § 101 – Non-Statutory Subject Matter

The Supreme Court in *Alice* reiterated the two-step framework, set forth previously in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 78–79 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). The first step in that analysis is to “determine whether the claims at issue are *directed to* one of those patent-ineligible concepts.” *Id.* (citing *Mayo*, 566 U.S. at 79) (emphasis added). If so, the second step is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether the additional elements “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 78–79).

In other words, the second step is to “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.* (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73). The Court acknowledged in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea, and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

The Appellants first contend that the Examiner’s rejection is in error because the Examiner fails to follow the Office guidelines for setting forth a *prima facie* case of subject matter ineligibility. *See* Appeal Br. 11, 12, 14, 15, 19–23; Reply Br. 2–5. Specifically, the Appellants point to the 2014 Interim Guidance on Patent Subject Matter Eligibility, 79 Fed. Reg. 74618 (Dec. 16, 2014) (“Interim Guidance”), the July 2015 Update Appendix I (“Update”), issued after the mailing date of the Final Office Action, and the May 4, 2016 Memorandum entitled “Formulating a Subject Matter Eligibility Rejection and Evaluating the Applicant’s Response to a Subject Matter Eligibility Rejection” (“May 2106 Memo”), issued after the mailing date of the Answer. We disagree.

Here, in rejecting the pending claims under § 101, the Examiner analyzes the claims using the *Mayo/Alice* two-step framework. Specifically, the Examiner looks to the language of the claims and determines that the

claims are directed to “the abstract idea of communicating preferences to a vendor from a remote device.” Final Act. 2; *see also* Ans. 13. The Examiner cites judicial decisions and compares the idea to those found to be abstract in those decisions. Ans. 14; *cf.* Reply Br. 3 (“The Examiner has not pointed to any case law recognizing the concept of communicating preferences to a vendor from a remote device or similar concepts to be an abstract idea.”). The Examiner further determines that the additional elements of the claims, taken alone and as an ordered combination, do not ensure that the claims amount to significantly more than the abstract idea. *Id.* at 14–16; *see also* Final Act. 2–3. The Examiner, thus, has clearly followed the guidelines.³ And, the Examiner has clearly articulated the reasons for the rejection and has notified Appellants of the reasons for the rejection “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” 35 U.S.C. § 132. And we find that, in doing so, the Examiner set forth a *prima facie* case of unpatentability. *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011); *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (Section 132 “is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

We are also not persuaded of Examiner error by the Appellants’ argument that “a streamline eligibility analysis should have been applied, and [the independent claims], as well as claims dependent thereon, should

³ We further note that the MPEP and guidelines are not legal requirements. *Cf. In re Fisher*, 421 F.3d 1365, 1372 (Fed. Cir. 2005) (“The MPEP and Guidelines ‘are not binding on this court’”).

have been found subject matter eligible.” Appeal Br. 14; *see also id.* at 15–16, 21–23. As set forth in the Interim Guidance, the streamlined analysis is an optional tool for Examiners to use at the Examiner’s discretion. *See* Interim Guidance at 74625 (“[A] streamlined eligibility analysis can be used.”) “[I]f there is doubt as to whether the applicant is effectively seeking coverage for a judicial exception itself, *the full analysis should be conducted.*” *Id.* (emphasis added). Here, the Examiner’s decision to perform a full § 101 analysis is not an error.

Under the first step of the *Mayo/Alice* framework, the Examiner determines that claims 1–20 are directed to “the abstract idea of communicating preferences to a vendor from a remote device.” Final Act. 2. Conversely, the Appellants contend that independent apparatus claims 1 and 20 (and their dependent claims) are directed to “tangible objects: vehicles or passenger travel” (Appeal Br. 12) and independent method claim 17 (and its dependents) is directed to “solving a business challenge that is particular to ordering from a vendor while in a vehicle” (*id.* at 21).

Before determining whether the claims at issue are directed to an abstract idea, we must first determine what the claims are directed to.

The “directed to” inquiry . . . cannot simply ask whether the claims involve a patent-ineligible concept, because essentially every routinely patent-eligible claim involving physical products and actions *involves* a law of nature and/or natural phenomenon—after all, they take place in the physical world. *See Mayo*, 132 S. Ct. at 1293 (“For all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.”) Rather, the “directed to” inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether “their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir.

2015); *see Genetic Techs. Ltd. v. Merial L.L.C.*, [818 F.3d 1369, 1375] (Fed. Cir. 2016) (inquiring into “the focus of the claimed advance over the prior art”).

Enfish, 822 F.3d at 1335.

The step-one analysis requires us to consider the claims “in their entirety to ascertain whether their character as a whole is directed to excluded subject matter.” *Internet Patents Corp.*, 790 F.3d at 1346. The question is whether the claims as a whole “focus on a specific means or method that improves the relevant technology” or are “directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016).

Here, the preambles of claims 1 and 20 provide for “[a] vehicle for communicating with a vendor interaction system of a vendor.” Appeal Br. 30, 35 (Claims App.) The vehicle comprises interface hardware, a processor, and a display, i.e., a computer. The processor executes logic to establish a link, receive data and data signals, transmit data, and display data. *Id.* The preamble of claim 17 provides for “[a] method for a vehicle to communicate with a vendor interaction system.” *Id.* at 34. The method comprises the steps of establishing a link, receiving data signals, and displaying data. *Id.* Other than the computer elements, no other structure of the vehicle or interaction between the computer and other vehicle structure is claimed. The Specification provides for a vehicle, i.e., apparatus, and method “for communicating with a vendor interaction system.” Spec. ¶¶ 1, 4, 5. The vehicle is a generic vehicle, such as an automobile or “any passenger or non-passenger vehicle” (Spec. ¶ 12) comprising a generic communication path bus capable of exchanging data via signals (*id.*),

generic input/output hardware, i.e., “any device capable of transforming a data signal into a mechanical, optical, or electrical output (*id.* ¶ 13), a generic display, i.e., “any medium capable of transmitting an optical output” (*id.* ¶ 16), and a generic processor, i.e., “any device capable of executing machine readable instructions” (*id.* ¶ 18).

In that context, we agree with and find supported the Examiner’s determination that claims 1, 17, and 20 are directed to receiving data and displaying data based on the received data to communicate with a vendor system.⁴ This is similar to claims found to be abstract ideas by our reviewing court. For example, in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016), the court held that collecting information and “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, [are] essentially mental processes within the abstract-idea category.” And, in *Apple*, 842 F. 3d at 1240–41, the court held that generating menus on a computer and taking orders from customers on a computer are abstract ideas. Here, claims 1, 17, and 20 involve nothing more than receiving data and displaying data based on the received data without any implementation details or techniques, technical description, or particular inventive technology — an abstract idea. *See Elec. Power Grp.*, 830 F.3d at 1354. As such, we find unpersuasive the Appellants’ argument that the Examiner’s determination is in error. *See Reply Br.* 3–4.

⁴ We note that “[a]n abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). The Board’s “slight revision of its abstract idea analysis does not impact the patentability analysis.” *Id.* at 1241.

We also find unpersuasive the Appellants' arguments that claims 1 and 20 are not directed to an abstract idea because they are directed to a tangible object, i.e., a vehicle. *See* Appeal Br. 12. The claims do not recite any structural components of the vehicle but for the generic computer hardware to receive and display data. And, there are no limitations reciting any change or function to any vehicular component. Thus, the claims are directed to a computer within the vehicle to perform an abstract idea. In other words, the claims generally link the use of the method to the particular technological environment of a vehicle. *See Alice*, 132 S. Ct. at 2360.

We further find unpersuasive the Appellants' arguments that the claims are not abstract because they are analogous to those of *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), i.e., Example 2 of the Update, "because the claims are directed to solving a business challenge that is particular to ordering from a vendor while in a vehicle." Appeal Br. 13; *see also id.* at 20–21.

In *DDR Holdings*, the Federal Circuit determined that the claims addressed the problem of retaining website visitors who, if adhering to the routine, conventional functioning of Internet hyperlink protocol, would be transported instantly away from a host's website after clicking on an advertisement and activating a hyperlink. *DDR Holdings*, 773 F.3d at 1257. The Federal Circuit, thus, held that the claims were directed to statutory subject matter because they claim a solution "necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks." *Id.* The court cautioned that "not all claims purporting to address Internet-centric challenges are eligible for patent." *Id.* at 1258. And the court contrasted the claims to those at issue in

Ultramercial Inc. v. Hulu, LLC, 772 F.3d 709 (Fed. Cir. 2014) in that, in *DDR Holdings*, the computer network was not operating in its “normal expected manner” and the claims did not “recite an invention that is merely the routine or conventional use of the Internet.” *Id.* at 1258–59.

In contrast here, according to the Appellants, the claim addresses the “business challenge of how to provide a customer with user order preferences when they order from a vendor while in a vehicle.” Appeal Br. 13; *see also id.* at 14 (“address a business challenge[]”), 21 (“directed to solving a business challenge”). The Specification provides that previously, ordering from a vehicle was done via pick up windows and ordering interfaces, thereby “[e]xposing the customer in a vehicle to outside conditions, such as weather conditions, can be non ideal.” Spec. ¶ 2. And, “communication between a customer inside of their vehicle with a vendor ordering interface outside of the vehicle can be strained through outside background noise.” *Id.* Thus, the Specification provides that the invention addresses the “need . . . for a vehicle that can communicate with a vendor interaction system to send and/or receive information relevant to a customer order.” *Id.* ¶ 3. Although the communication is network-centric, providing information to a customer in a vehicle is not a problem rooted in technology arising out of computer networks, but rather, as the Appellants acknowledge, a business problem that existed prior to the Internet and computers.

Also, unlike *DDR Holdings*, here, the solution comprises components of the claimed network interface hardware, processor, and display operating in their normal capacities to establish a communication link, receive data signals, and display data based on the received data signals. As discussed above, the Specification provides that these components are generic (*see*

Spec. ¶¶ 12–18, Fig. 1), without any particular inventive technology, to implement the abstract idea. The Appellants do not direct attention to, and we do not see, where the Specification provides for an improvement in the technology or technical functioning of these components. The claims recite an invention that is merely the routine or conventional use of the Internet to perform an abstract business practice. *DDR Holdings*, 773 F.3d at 1258–59.

Under the second step of the *Alice* framework, we adopt and find supported the Examiner’s determination that the claim limitations, taken individually or as an ordered combination, do not recite an inventive concept. *See* Final Act. 2; Ans. 15–16. We are unpersuaded by the Appellants’ arguments that the claim limitations recite significantly more than the abstract idea. *See* Appeal Br. 16–17, 23–24.

We disagree that the claims “include improvements to another technology or technical field.” *Id.* at 17, 24. “Product ordering” (*id.*) is not a technical or technological field. As discussed above, claims 1 and 20 are not directed to improving the vehicle itself, but to address a business challenge using the computer inside of the vehicle. We agree with the Examiner’s finding that establishing a communication link, receiving data signals, and displaying data based on the received data are well-understood, routine, and conventional functions of a generic computer. *See* Final Act. 2–3; Ans. 15. The Specification supports this view in providing for a generic vehicle comprising generic network interface, processor, and display to perform the functions of the claims. *See* Spec. ¶¶ 12–18, Fig. 1. There is no further specification of particular technology for performing the steps. *See Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1263 (Fed. Cir. 2016); *see also Enfish*, 822 F.3d. at 1336 (focusing on whether the claim

is “an improvement to the computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity”). As such, we find unpersuasive the Appellants’ argument that the Examiner’s rejection is in error because the Examiner “misconstrued the claims as described in the specification.” Reply Br. 4. Rather, we conclude the Examiner properly construes the claims and that the Specification provides for generic components operating in their ordinary capacities.

Thus, we are not persuaded that the Examiner erred in rejecting claims 1–20 under 35 U.S.C. § 101, and we sustain the Examiner’s rejection.

35 U.S.C. § 103 – Obviousness

We agree with the Appellants’ contention that the Examiner does not adequately show that the prior art teaches limitation (b3) of claim 1, and similarly recited in claims 17 and 20, of receiving a user preference data signal that contains at least one of the claimed data. *See* Appeal Br. 26–29.

The Examiner finds, in relevant part, that Chutorash teaches receiving, with the network hardware, a user preference data signal indicative of user order preferences for the vendor, i.e., Chutorash’s payment preferences. Final Act. 4 (citing Chutorash ¶¶ 64, 66, 114). The Examiner relies on Pisz for teaching the user preference data signal containing at least user favorite orders. *See id.* (citing Pisz ¶ 32), Ans. 20 (citing Pisz ¶ 32). The Examiner determines that one of ordinary skill in the art would combine the art “with the motivation of conveniently placing orders without any action by the customer.” Final Act. 5 (citing Pisz ¶ 32).

Chutorash discloses a system and method for vehicles to wirelessly communicate and conduct transactions with merchants. Chutorash, Abstract. The cited portions of Chutorash disclose a system with a

connectivity module installed in a vehicle and configured to form wired and/or wireless connections to communicate with merchant systems, devices, remote systems, and payment mechanism readers. *Id.* ¶¶ 64, 66. For example, the module can wirelessly communicate with a user device to send and receive user information such as payment information. *Id.* ¶ 66. The system can also include a payment selection system configured to recall information, present options, allow users to make selections, and wirelessly provide or transfer the information to make a purchase. *Id.* ¶ 114.

Pisz discloses a GPS gate system that triggers transmission of a message. Pisz, Abstract. The cited portion of Pisz discloses that the GPS receiver can be placed at the entrance of a drive thru for a restaurant. Pisz ¶ 32. Once the gate has been crossed, the receiver can transmit a message to the restaurant, such as an order that the customer has placed through an interface. *Id.* “Alternatively, a customer’s favorite order may be stored at the restaurant, and when the customer’s GPS receiver crosses the GPS gate, the customer’s favorite order can automatically be placed.” *Id.*

As such, Chutorash teaches the interface hardware in the vehicle receiving, from the user device, a user preference signal, and Pisz teaches the vendor storing user favorite orders. But the Examiner has not adequately explained to one of ordinary skill in the art how Chutorash’s user preference signal from the user device would be modified to include Pisz’s order information stored with the vendor. Although payment information can indicate an order preference (Ans. 19), claims 1, 17, and 20 specifically define what type of order preference the signal must contain (*see* Appeal Br. 26; Reply Br. 6). The Examiner has not adequately shown how

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Chutorash's signal, alone or in combination with Pisz, meets the claimed limitation.

Based on the foregoing, we do not sustain the Examiner's rejection under 35 U.S.C. § 103 of independent claims 1, 17, and 20 and their dependent claims.

DECISION

The Examiner's rejection of claims 1–20 under 35 U.S.C. § 101 is AFFIRMED.

The Examiner's rejection of claims 1–20 under 35 U.S.C. § 103 is REVERSED.

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