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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS F. DOYLE

Appeal 2016-007479
Application 11/346,012
Technology Center 3600

Before JAMES R. HUGHES, ERIC S. FRAHM, and CATHERINE SHIANG, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–6, 8–14, and 27–33, which are all the claims pending and rejected in the application. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Introduction

According to the Specification, the present invention relates to asset usage, such as a rental asset usage. *See generally* Spec. 1. Claim 1 is exemplary:

> 1. A method of providing a rental status signal relating to a rental asset, comprising:

receiving a rental asset completion signal by a processor associated with the rental asset,

wherein the rental asset completion signal is initiated by an operator of the rental asset to indicate that the rental of the rental asset is complete;

upon receiving the rental asset completion signal, triggering a determination by the processor of at least one rental asset operating characteristic of the rental asset in order to determine whether an operation of the rental asset is complete;

determining that the rental asset is not in use only upon receipt of both

the rental asset completion signal, and

an independent indication, from a sensor coupled to the processor, ~~via~~ that the at least one determined rental asset operating characteristic indicates that operation of the rental asset is complete, wherein the sensor monitors the operating characteristic of the rental asset;

generating the rental status signal based on the determining that the rental asset is not in use;

transmitting, via a network, the rental status signal to indicate to a remote rental agency that the rental asset is not in use to stop billing of the rental asset at the remote rental agency;

continuing to monitor the sensor output to determine whether the rental asset remains not in use based on the at least one rental asset operating characteristic and independent of the rental status completion signal; and

when it is determined that the rental asset use has resumed after billing at the remote rental agency has already stopped, displaying on a display device a request for an authorization code or billing information and transmitting a new rental status signal indicating that the rental asset use has resumed, and

receiving a status indicator alerting the operator of the rental asset that billing has resumed.

Rejection

Claims 1–6, 8–14, and 27–33 stand rejected under 35 U.S.C. § 101 because they are directed to patent-ineligible subject matter.

ANALYSIS

We disagree with Appellant's arguments, and agree with and adopt the Examiner's findings and conclusions in (i) the action from which this appeal is taken and (ii) the Answer to the extent they are consistent with our analysis below.[1]

On this record, the Examiner did not err in rejecting claim 1.

The Examiner rejects the claims under 35 U.S.C. § 101 because they are directed to patent-ineligible subject matter. *See* Final Act. 2–4; Ans. 2–4. In particular, the Examiner finds the claims are direct to the abstract idea of determining information associated with a rental asset. *See* 2–4; Ans. 2–4. The Examiner further finds the claims use generic computer components to perform generic computer functions. *See* Ans. 2–4; Ans. 2–4. Appellant argues the Examiner erred. *See* App. Br. 6–10; Reply Br. 3–7.

Appellant has not persuaded us of error. Section 101 of the Patent Act provides "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions

[1] To the extent Appellant advances new arguments in the Reply Brief without showing good cause, Appellant has waived such arguments. *See* 37 C.F.R. § 41.41(b)(2).

and requirements of this title." 35 U.S.C. § 101. That provision "'contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.'" *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). According to the Supreme Court:

> [W]e 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. First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. If so, we then ask, "[w]hat else is there in the claims before us?" To answer that question, we 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. We have described step two of this 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."

Alice Corp., 134 S. Ct. at 2355 (citations omitted).

The Federal Circuit has described the *Alice* step-one inquiry as looking at the "focus" of the claims, their "character as a whole," and the *Alice* step-two inquiry as looking more precisely at what the claim elements add—whether they identify an "inventive concept" in the application of the ineligible matter to which the claim is directed. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

Regarding *Alice* step one, the Federal Circuit has "treated *collecting information*, including when limited to particular content (which does not

change its character as information), as within the realm of abstract ideas." *Elec. Power*, 830 F.3d at 1353 (emphasis added); *see also Internet Patents*, 790 F.3d at 1348–49; *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015); *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014). "In a similar vein, we have treated *analyzing information* [including manipulating information] by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category." *Elec. Power*, 830 F.3d at 1354 (emphasis added); *see also In re TLI Commc'ns. LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016). "And we have recognized that *merely presenting the results of abstract processes of collecting and analyzing information, without more* (such as identifying a particular tool for presentation), is abstract as an ancillary part of such collection and analysis." *Elec. Power*, 830 F.3d at 1354 (emphasis added); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714–15 (Fed. Cir. 2014).

The rejected claims "fall into a familiar class of claims 'directed to' a patent-ineligible concept." *Elec. Power*, 830 F.3d at 1353. Contrary to Appellant's arguments (App. Br. 6–9; Reply Br. 3–6), the claims are similar to the claims of *Electric Power*, and are focused on the combination of abstract-idea processes or functions. *See Elec. Power*, 830 F.3d at 1354. For example, claim 1 is directed to receiving or collecting information ("receiving a rental asset completion signal," "an independent indication, from a sensor coupled to the processor," "transmitting . . . ," "receiving a status indicator alerting"), analyzing information ("determining that the rental asset is not in use," "triggering a determination by the processor,"

"generating the rental status signal," "monitor the sensor output to determine . . ."), and presenting information ("displaying on a display device a request"). *See Elec. Power*, 830 F.3d at 1353.

The dependent claims are directed to similar functions or processes, and Appellant has not shown such claims are directed to other non-abstract functions or processes. *See* claims 2–6, 8–14, and 27–33. In particular, with respect to dependent claim 13, Appellant asserts "the rental agency may even remotely disable the rental asset if the operator of the rental asset is unable to provide requested authorization code." *See* App. Br. 8; *see also* Reply Br. 6. That argument is not commensurate with the scope of the claim, as claim 13 merely recites "disabling the rental asset until the requested authorization is received." In any event, Appellant has not shown the claim is directed to non-abstract functions or processes.

Regarding *Alice* step two, contrary to Appellant's assertion (App. Br. 10; Reply Br. 6–7), Appellant has not shown the claims in this case require an arguably inventive set of components or methods, or invoke any assertedly inventive programming. *See Elec. Power*, 830 F.3d at 1355. In particular, the claims merely utilize computer capabilities—not "improve[ing] computer capabilities," as Appellant asserts (Reply Br 6). Further, Appellant's assertion that the claims implement "a tangible improvement in the realm of wireless communications" (Reply Br. 6) is unpersuasive, because Appellant does not even show the claims require wireless communications.

Further, contrary to Appellant's arguments (App. Br. 10; Reply Br. 6–7), the claims are similar to the claims of *Electric Power*, because they do not require any nonconventional computer, network, or display components,

or even a "non-conventional and non-generic arrangement of known, conventional pieces," but merely call for performance of the claimed information collection, analysis, and display functions on generic computer components and display devices. *See Elec. Power*, 830 F.3d at 1355; *see also* Claim 1 (reciting "a processor," "a sensor," "a network," and "a display device"). The dependent claims call for similar generic components and devices, and Appellant has not shown such claims require any non-conventional components or devices. *See* claims 2–6, 8–14, and 27–33.

In addition, Appellant's argument that the claims are drawn to a "new and useful end" by the deficiency of prior art (App. Br. 9) is unpersuasive, because the requirements under 35 U.S.C. §§ 102–103 are separate from the requirement under 35 U.S.C. § 101. Likewise, Appellant's assertion—without persuasive analysis and support—that the claims achieve a "new and useful end" (App. Br. 10; Reply Br. 6–7) is unpersuasive.

In short, Appellant has not shown the claims, read in light of the Specification, require anything other than conventional computer, network, and display technology for collecting, analyzing, and presenting the desired information. *See Elec. Power*, 830 F.3d at 1354. Such invocations of computers and networks are "insufficient to pass the test of an inventive concept in the application" of an abstract idea. *See Elec. Power*, 830 F.3d at 1355.

Because Appellant has not persuaded us the Examiner erred, we sustain the Examiner's rejection of claims 1–6, 8–14, and 27–33 under 35 U.S.C. § 101.

DECISION

We affirm the Examiner's decision rejecting claims 1–6, 8–14, and 27–33.

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