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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* SYUNSUKE GOKYU, TAKASHI TOMOMOTO,  
and KENJIRO YANAI

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Appeal 2016-007563  
Application 14/018,049<sup>1</sup>  
Technology Center 3600

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Before, JOSEPH A. FISCHETTI, BRUCE T. WIEDER, and  
BRADLEY B. BAYAT, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1–9. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

Claim 1 reproduced below, is representative of the subject matter on appeal.

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<sup>1</sup> Appellants identify Bridgestone Corporation as the real party in interest.  
Br. 2.

1. A method for tread selection to select a tread to attach to a tread side of a tire casing in a tire, comprising:

a) measuring at least one characteristic value indicating at least a tire pressure with a tire condition measurement unit, the tire condition measurement unit having at least a TPMS for measuring the tire pressure, and transmitting the at least one characteristic value to a casing life prediction unit via radio wave;

b) receiving the at least one characteristic value, estimating internal pressure application time equivalent to the amount of time internal pressure is applied based on the at least one characteristic value measured in step a); and predicting a remaining life of the tire casing based on the internal pressure application time using the casing life prediction;

c) selecting, by a tread selection unit, at least one recommended tread in accordance with the remaining life of the tire casing predicted in step b) from among a plurality of treads attachable to the tire casing, using wear life information calculated in advance for each of the treads and stored in database; and

d) transforming a display screen of a terminal to display the at least one recommended tread selected in step c).

## THE REJECTION

The following rejection is before us for review.

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

## ANALYSIS

### 35 U.S.C. § 101 REJECTION

The Examiner rejected claims 1–9 as patent ineligible under § 101 as directed to non-statutory subject matter.

In so doing, the Examiner found that:

It is unclear what the specific structure is to which applicants refer. The claim recites, "the tire condition measurement unit having at least a TPMS for measuring the tire pressure, and transmitting the at least one characteristic value to a casing life prediction unit via radio wave." This is not a recitation of structure, but is merely a recitation of the intended use of the TPMS.

(Final 2).

We disagree with the Examiner and find instead that the claims specify a process which is specifically designed to achieve an improved technological result in conventional industry practice. *See Alice Corp., Pty. Ltd. v CLS Bank Intl*, 134 S.Ct. 2347, 2358 (2014) (*citing Diehr*, 450 U.S. 175, 177).

The Supreme Court

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, [] 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, [] 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. [The Court] 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*, 134 S.Ct. at 2355 (citing *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S.Ct. 1289 (2012)).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept. We therefore look to whether the claims before us 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 Federal Circuit has further instructed that claims are to be considered in their entirety to determine “whether their character as a whole is directed to excluded subject matter.” *McRO, Inc. v. Bandai Namco Games America, Inc.*, 2016 WL 4896481, \*6 (Fed. Cir. September 13, 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

Here, the claimed invention relates to “a method for tread selection to select a tread to attach to a tread side of a tire casing... [by at least] measuring at least one characteristic value indicating at least a tire pressure with a tire condition measurement unit....” We find that claim 1 limits the scope of the claims to the use of specific devices, namely, a TPMS, radio wave transmission, a casing life prediction unit, a tread selection unit, and a display screen. As such, we find that claim 1 prevents preemption of all relationships between tire pressure and retread selection because the claims are narrowly tailored to require, i.e., the use of a TPMS and a tire condition measuring unit and the sending of the TPMS data to a tire condition

measuring unit using radio wave transmission.<sup>2</sup> We find that the specific components required by the claimed process and the claimed specified manner in which the data is required to be transmitted would prevent preemption of all relationships between a recommended tread and ascertaining remaining life of a tire.

The Federal Circuit noted in *McRO* that the abstract idea exception has been applied to prevent patenting of claims that abstractly cover results where “it matters not by what process or machinery the result is accomplished” (*McRO*, 2016 WL 4896481 at \*8 (quoting *O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 113 (1854))). In the case before us, it is clear that the claims require a specific claimed means that improves “the relevant technology” of tire tread selection. *Id.*

For the same reasons given above for claim 1, we will not sustain the rejection of independent claim 9 under 35 U.S.C. § 101 because this claim is correspondingly similarly directed to a tread selection system with the same components and associated functions as recited in claim 1.

We therefore find that the claims are not directed to an abstract idea.

#### CONCLUSIONS OF LAW

We conclude the Examiner did err in rejecting claims 1–9 under 35 U.S.C. § 101.

#### DECISION

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<sup>2</sup> Claim 1 recites in pertinent part, “measuring at least one characteristic value indicating at least a tire pressure with a tire condition measurement unit, *the tire condition measurement unit having at least a TPMS for measuring the tire pressure*, and transmitting the at least one characteristic value to a casing life prediction unit *via radio wave... .*”

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Application 14/018,049

The decision of the Examiner to reject claims 1–9 is reversed.

REVERSED.