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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* PETER AR-FU LAM

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Appeal 2017-000385  
Application 09/930,422  
Technology Center 3600

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Before KENNETH G. SCHOPFER, TARA L. HUTCHINGS, and  
AMEE A. SHAH, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

The Appellant<sup>2</sup> appeal under 35 U.S.C. § 134(a) from the Examiner’s final decision rejecting claims 6, 7, 9–18, 40, 49, 56–59, and 61.<sup>3</sup> We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

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<sup>1</sup> Throughout this Decision, we refer to the Appellant’s Appeal Brief (“Appeal Br.,” filed Oct. 29, 2015), Reply Brief (“Reply Br.,” filed Oct. 4, 2016), and Specification (“Spec.,” filed Aug. 15, 2001), and to the Examiner’s Answer (“Ans.,” mailed Aug. 8, 2016) and Final Office Action (“Final Act.,” mailed Apr. 1, 2015).

<sup>2</sup> The real party in interest is the inventor, Peter A. Lam. Appeal Br. 3. The Appellant has filed this appeal *pro se*. *Id.* at 1, 36.

<sup>3</sup> Claims 1–5, 19–21, 24–34, 37, 38, 47, 48, 50, 51, 53–55, and 60 are withdrawn, and claims 22, 23, 35, 36, 39, 42–46, and 52 are cancelled. Claims App. Claim 8 has been indicated as allowable. Final Act. 8.

STATEMENT OF THE CASE

The Appellant’s “invention relates generally to methods and apparatus for use by retailers for facilitating a customer’s selection of coordinated and properly sized articles of wearing apparel.” Spec. 1, ll. 10–11. In particular, the “present invention is directed to an enhanced system for facilitating traditional and/or internet retail sales of garments, i.e., wearing apparel.” *Id.* at 3, ll. 2–3.

Claims 40 and 59 are the independent claims. Claim 40 (Appeal Br. 41–42 (Claims. App.) is exemplary of the subject matter on appeal and is reproduced below:

40. A method of processing a body profile (BP) code describing the physical dimensions of a human body to facilitate garment shopping, said method comprising the steps of:

(1) specifying the positions of the human body to be measured for defining m different parametric terms describing the size and/or shape of said human body;

(2) providing a value for each of said m defined parametric terms;

(3) developing a desire to apply a BP Code for supporting garment shopping;

(4) providing a step to evaluate the characteristics and/or relationship of said parametric terms for defining the criteria to compose a BP Code software program;

(5) composing said BP Code software program according to the criteria of step (4); and

(6) providing a data converting system configured to work with said BP Code software program for processing the m values to [sic] of step (2) to produce a multiple digits compressed BP code for representing said m values; wherein each BP code can be decompressed to provide a specific value for each of m different parametric terms of step (a)<sup>4</sup>; and said method further comprises at least one of the characteristics (a) to (d) as follow:

(a) providing a step to display said BP code on a display terminal for supporting a garment shopping process;

(b) providing printed media for recording representation of said BP code for supporting a garment shopping process;

(c) wherein said BP Code software program is represented by data encoded or stored in a digital data storage or recording device or computer readable medium; and/or

(d) transmitting said BP Code through a data transmission channel for supporting a garment shopping process.

#### THE REJECTIONS<sup>5</sup>

Claims 6, 7, 9–18, 40, 49, 56–59, and 61 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Final Act. 3.

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<sup>4</sup> We consider this to be a typographical error that should read “step (1).”

<sup>5</sup> The rejection of claims 40 and 59 under 35 U.S.C. § 112 has been withdrawn. Adv. Act. (mailed Nov. 10, 2015).

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Claims 6, 7, 9–18, 40, 49, 56–58, and 61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spackova et al. (US 4,539,585, iss. Sept. 3, 1985) (hereafter “Spackova”) and Behram et al. (US 5,499,293, iss. Mar. 12, 1996) (hereafter “Behram”). *Id.* at 3.

Claims 57–59 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spackova, Behram, and Aisaka et al. (US 4,417,401, iss. Nov. 29, 1983) (hereafter “Aisaka”). *Id.* at 7.

#### ANALYSIS<sup>6</sup>

##### *35 U.S.C. § 101 — Patent Eligible Subject Matter*

The Appellant argues claims 6, 7, 9–18, 40, 49, 56–59, and 61 as a group. *See* Appeal Br. 32. We consider claim 40 representative of the group with claims 6, 7, 9–18, 49, 56–59, and 61 standing or falling therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “. . . long held that this 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.*, 569 U.S. 576, 589 (2013)).

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<sup>6</sup> The rejections are considered in the order presented by the Examiner in the Final Action.

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, 75–77 (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*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are *directed to* one of those patent-ineligible concepts.” *Id.* (emphasis added) (citing *Mayo*, 566 U.S. at 76–79). 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 79, 78).

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. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015). 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 Examiner determines that claim 40 is directed to “the abstract idea of processing a body profile code to facilitate garment shopping.” Final Act. 3; *see also* Ans. 3.

The Title of the Specification provides for a “BODY PROFILE CODING METHOD AND APPARATUS USEFUL FOR ASSISTING USERS TO SELECT WEARING APPAREL.” The Background section of the Specification discusses that a “[p]ersonalized animated fashion show . . . gives customers greater confidence before they placed [sic] mail orders and avoids returns.” Spec. 2, ll. 25–29. The Summary of the Invention section provides that the “invention is directed to an enhanced system for facilitating traditional and/or internet retail sales of garments, i.e., wearing apparel.” *Id.* at 3, ll. 2–4. Claim 40 provides for “[a] method of processing a body profile (BP) code describing the physical dimensions of a human body to facilitate garment shopping, said method comprising the steps of: (1) specifying the positions of the human body to be measured,” “(2) providing a value” for each of the defined terms describing the size or shape of the body, “(3) developing a desire to apply a BP code,” “(4) providing a step to evaluate the characteristics,” “(5) composing said BP Code software program according to the criteria” defined in step (4), “(6) providing a data converting system configured to work with” the BP program for processing the values of step 2 “to produce a multiple digits compressed BP code” that can be decompressed, and “at least one of[:]” “(a) providing a step to display said BP code on a display terminal” “(b) providing printed media,” “(c) wherein said BP Code software program is represented by data encoded or stored,” “and/or (d) transmitting said BP code.” Appeal Br. 41–42 (Claims App.). On its face, the claim does not call for any form of computer

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implementation and recites steps that could be performed manually. Put differently, the limitations above all involve acts that could be performed by a human, i.e., either mentally, or manually using pen and paper, without the use of a computer or any other machine, i.e., specifying, providing, developing, and composing data. At best, the claim provides for a direction to create a program that implements the method. *See* Appeal Br. 34 (arguing that the claim requires generating “BP Code”). Although the “BP Code generation process is claimed in the independent claim 1 of the parent U.S. Patent 7,194,327” (Appeal Br. 5), the method does not actually claim that process. *Cf. Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1149 (Fed. Cir. 2016) (“The § 101 inquiry must focus on the language of the Asserted Claims themselves.”); *see also Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1345 (Fed. Cir. 2013) (“[T]he important inquiry for a § 101 analysis is to look to the claim.”); *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714 (Fed. Cir. 2014) (“We must first examine the claims because claims are the definition of what a patent is intended to cover.”); *Alice*, 134 S. Ct. at 2355 (“We must first determine whether the *claims at issue* are directed to a patent-ineligible concept.”) (emphasis added).

In that context, claim 40 is directed to composing a body profile code based on specified, provided, and developed data regarding dimensions of a body to facilitate garment shopping, a concept that is analogous to, and is claimed as, human mental work. The claim here is similar to ones our

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reviewing court has deemed abstract in *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1326 (Fed. Cir. 2017), *cert. denied*, 138 S. Ct. 672, (2018) (“encoding and decoding image data”), *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1350 (Fed. Cir. 2014) (“organizing information through mathematical correlations and is not tied to a specific structure or machine”), and *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1150 (Fed. Cir. 2016), *cert. denied*, 138 S. Ct. 71 (2017) (“translating a functional description of a logic circuit into a hardware component description of the logic circuit” through a mental process). Moreover, the law is clear that “[a] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.” *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011); *see also Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (“[p]henomena of nature . . . , mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.”). Mental processes remain unpatentable even when automated to reduce the burden on the user of what once could have been done with pen and paper. *CyberSource*, 654 F.3d 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*.”).

We find unavailing the Appellant’s arguments that the claim overcomes the 35 U.S.C. § 101 rejection because the claim “as a whole heavily rel[ies] on a real world physical body . . . [and an] [a]bstract idea

objected by 35 U.S.C. 101 can never involve a physical human body in the real world” (Appeal Br. 33), and because the claim “as a whole requires a real world action of conducting physical human body measurements . . . [and an] [a]bstract idea objected by 35 U.S.C. 101 cannot involve ‘an action’ to be conducted in the real world living” (*id.* at 34). The Appellant provides no support for these statements. An abstract idea can involve and rely on a physical object and an action conducted in the real world. For example, in *In re Brown*, 645 F. App’x 1014, 1016–17 (Fed. Cir. 2016), the court determined that the method of assigning hair design comprising steps of cutting hair defining a head shape, designating zones, and assigning patterns to cones was an abstract idea even though the method relied on a head, i.e., a real world physical body.

Turning to the second step of the *Alice/Mayo* framework, because we determine that claim 40 is directed to an abstract idea, the claim must include an “inventive concept” in order to be patent-eligible. 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.’” *Alice*, 134 S. Ct. at 2355 (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

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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).

Here, we agree with the Examiner’s determination that the elements of the claim, individually or as an ordered combination, do not amount to significantly more than that abstract idea. *See* Final Act. 3; Ans. 3–4. We are not persuaded of error by the Appellant’s arguments that assert the opposite. *See* Appeal Br. 34.

As discussed above, claim 40 does not specify any technology for performing to steps of specifying, providing developing, and composing. As such, nothing in the claim purports to improve computer functioning or “effect an improvement in any other technology or technical field.” *Alice*, 134 S. Ct. at 2359. The Specification provides that the claimed invention purports to “facilitat[e] a customer’s selection of coordinated and properly sized articles of wearing apparel” (Spec. 1, l. 11) and to provide a personalized animated fashion show to “give[] customers greater confidence before they placed mail orders and avoids returns” (*id.* at 2, ll. 25–27). The Appellant asserts that “[t]he benefits offered by the BP Code system enable consumers to order fitting garment remotely with peace of mind . . . [and] resolves a real world problem.” Appeal Br. 34. Thus, the claim does not solve a problem unique to the Internet. *See DDR Holdings LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014); *see also Alice*, 134

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S. Ct. at 2352, 2356 (claims relating to a computerizing scheme for mitigating settlement risk mirroring real-world accounts were not patent-eligible under § 101).

We find unpersuasive the Appellant’s arguments that the claim is patent-eligible under §101 because it “identifie[s] real world hardware system[s] for working with the invented system” and because it can be “[i]mplement[ed] . . . through the demo systems of IGRS and BPCode.com as illustrated in Attachments G-3 to G-10. A working system that everyone can try is never an abstract idea.” Appeal Br. 34. The Appellant’s arguments are not commensurate with the scope of the claim in that claim 40 does not recite the system or code, but rather steps that compose a code and that provide a system configured to work with the code and process values. Moreover, the Specification discusses various systems, e.g. a “computer supported garment coordination system” (Spec. 3, ll. 26–27), a “BP coding system” (*id.* at 4, l. 1), a “visual measurement system” (*id.* at 4, l. 23), an “imaging system” (*id.* at 4, l. 28), a “servicing system” (*id.* at 5, l. 17), and a “computer system” (*id.* at 5, l. 21), any of which can comprise a general purpose computer. *See id.* at 25, ll. 19, 26, at 26, ll. 8–18, Fig. 8. The recitation of a system/computer here is a mere instruction to implement the abstract idea on a general purpose computer operating in its normal, conventional manner. *See Alice*, 134 S. Ct. at 2358–59; *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016) (claims

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could be performed on a conventional computer); *CyberSource*, 654 F.3d at 1375–76 (claims that were a software implementation of a mental process).<sup>7</sup>

Thus, we are not persuaded the Examiner erred, and we sustain the Examiner’s rejection under 35 U.S.C. § 101 of claim 40 and of claims 6, 7, 9–18, 49, 56–59, and 61, which fall with claim 40.

*35 U.S.C. § 103 — Obviousness*

The Appellant contends that the Examiner’s rejection is in error because, in relevant part, Spackova, upon which the Examiner relies, does not teach specifying the positions of the human body to be measured for defining terms describing the size and/or shape of the body that are then given values, as recited in limitations (1) and (2) of independent claim 40 and similarly recited in independent claim 59. *See* Appeal Br. 10. We agree.

The Examiner cites to Spackova’s Figure 3 and column 4 for teaching this limitation. Final Act. 4. Specifically, the Examiner finds that Spackova’s indicia 74 specify the position and indicia segments 72 and coded indicia 74 define m different parametric terms. *Id.* However, the Examiner has not adequately explained how Spackova teaches specifying the positions of the body to be measured to define terms describing the body.

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<sup>7</sup> In response to the Appellant’s request for the Board to “provide guidance” (Appeal Br. 34), we refer the Appellant to the guidelines provides by the Office, which can be found at <https://www.uspto.gov/patent/laws-and-regulations/examination-policy/subject-matter-eligibility>.

Spackova discloses “a previewer wherein articles may be dynamically viewed in relation to the context of their use.” Spackova col. 1, ll. 7–9. A binary digit frame identifier in a video camera provides “binary digital frame members in the form of a row of dots for recording on each frame, with those lit dots being a specific frame identification number in binary form as is displayed at **19** on monitor **17**.” *Id.* at col. 2, ll. 58–63. A computer graphics video image generator provides graphics images of an article that are displayed in the monitor. *Id.* at col. 2, l. 67–col. 3, l. 4, col. 4, ll. 10–15. A computer and digital image processor process orientation information to re-image the article to conform to the position of the subject on a specific frame. *Id.* at col. 3, ll. 12–15. The re-imaged article is displayed with the specific frame pose to form a composite picture of the subject wearing the article. *Id.* at col. 3, ll. 16–21. Using a keyboard and joystick, the user can select the article for wearing and a specific frame (i.e., subject pose), modify the article configuration, orient the article image, and move a part, e.g., the head, to a desired orientation or pose. *Id.* at col. 3, ll. 23–38. “The user selected orientation position is then matched with the pre-recorded orientation position” and that posed position is displayed on a monitor with the re-imaged article, to form a new composition image incorporating the new orientation position. *Id.* at col. 3, ll. 39–44. For apparel, the computer retrieves graphic specifications “with coded indicia segments [72 that contain coded indicia 74] with binary digit reference information corresponding to the body location on which that item of apparel should

appear in relation to the corresponding segment on garment **71** (i.e. in the position as it should be worn by the subject),” and retrieves matching graphic descriptions for the selected article corresponding to the specifications. *Id.* at col. 4, ll. 15–24. The figure of the user is transmitted from the video recorder to the processor to form and display on the monitor a composite image with “the subject human figure information as pre-recorded or recorded in real-time and the selected articles of apparel **85'** and **86'** as re-oriented or re-imaged **85"** and **86"** in accordance with the orientation of indicia segments **72** for each video frame.” *Id.* at col. 4, ll. 35–41.

As the Appellant states “[t]he indicia (74) and indicia segments (72) of Spackova are provided to generate body image reference points that will be applied to direct the image reference points of a garment for a garment preview process.” Appeal Br. 10. In other words, Spackova’s coded indicia 72 and 74 that correspond to body locations on which the item should appear (Spackova, col. 4, ll. 15–24) teach specifying the positions of the human body on which or where the garment would be placed. However, the Examiner does not explain, and one of ordinary skill in the art would not understand, how the indicia teach where the human body is to be measured to define terms of the body that are then given values.

Thus, we do not sustain the Examiner’s rejection under 35 U.S.C. § 103 of independent claims 40 and 59. We also do not sustain the

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rejections under 35 U.S.C. § 103 of dependent claims 6, 7, 9–18, 49, 56–58, and 61, which rely on the same inadequately supported finding.

#### DECISION

The Examiner's rejection of claims 6, 7, 9–18, 40, 49, 56–59, and 61 under 35 U.S.C. § 101 is AFFIRMED.

The Examiner's rejections of claims 6, 7, 9–18, 40, 49, 56–59, and 61 under 35 U.S.C. § 103(a) are 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