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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK SCALF and JOSEPH J. BERRY

Appeal 2017-000920
Application 12/406,595
Technology Center 3600

Before MAHSHID D. SAADAT, JOHN A. JEFFERY, and JASON M. REPKO, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 4, 6, 25, and 26.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellants, the real party in interest is Ford Global Technologies, LLC. App. Br. 2.

² Claims 2, 3, 5, 7–19, 22–24, and 28 have been cancelled and claims 20 and 21 have been withdrawn from consideration.

STATEMENT OF THE CASE

Appellants' invention relates to a system that uses traffic information from an existing traffic database in order to determine an optimal route of travel. Spec. 3:26–29. Exemplary claim 1 under appeal reads as follows:

1. A system comprising:
 - a processor programmed to:
 - receive user selection of a displayed selectable option to find an alternative route to a traffic-heavy route-portion;
 - examine a current route in a direction from a vehicle to a destination, to find a first road-portion where the traffic is above a threshold level;
 - examine the current route in a direction from the destination to the vehicle, to find a second road-portion where the traffic is above the threshold level; and
 - determine an alternative route, avoiding travel on the current route between the first road-portion and the second road-portion.

Claims 1, 4, 6, 25, and 26 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. *See* Ans. 2–3.

Claims 1, 4, 6, 25, and 26 stand rejected under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. *See* Ans. 3–5.

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments in the Briefs. For the reasons discussed below, we are not persuaded by Appellants' arguments that the Examiner erred in rejecting claims 1, 4, 6, 25, and 26 under 35 U.S.C. § 101. We adopt as our own, the findings and reasons set forth by the Examiner in the Office Action from

which this appeal is taken (Final Act. 2–3) and in the Examiner’s Answer in response to Appellants’ Appeal Brief (Ans. 6–10). However, we reach the opposite conclusion with respect to the rejection of claims 1, 4, 6, 25, and 26 under 35 U.S.C. § 112 (pre-AIA), first paragraph. For emphasis, we consider and highlight specific arguments as presented in the Briefs.

Section 101 Rejection

The Examiner rejects the claims under 35 U.S.C. § 101 because they are directed to patent-ineligible subject matter. *See* Final Act. 3–4; Ans. 2–3. In particular, the Examiner finds the claims are directed to the abstract idea of avoiding traffic congestion. *See* Final Act. 3; Ans. 3. The Examiner further finds the claims describe a mental process of comparing new and stored information. *See* Final Act. 4; Ans. 3. The Examiner also finds the additional features related to a processor, speaker, or display do not amount to significantly more than the abstract idea. *See id.*

Appellants argue the Examiner erred. *See* App. Br. 6–8; Reply Br. 2. Appellants specifically argue the claims require more than a generic computer to avoid traffic congestion and specifically, “a specific methodology of determining where the congestion lies.” App. Br. 7.

According to Appellants,

[t]he claims recite a very formulaic methodology of defining where congestion lies that could not be achieved through use of ‘listening to the radio.’ No radio broadcast examines a route forwards from a current vehicle location to find a first point of congestion, and backwards from a destination to find a last point of congestion, all the radio will do is alert the user as to where congestion generally lies.

Id.

The Supreme Court in *Alice Corp. v. CLS Bank International* reiterated the framework set out in *Mayo Collaborative Services v. Prometheus Laboratories Inc.*, 132 S. Ct. 1289 (2012) for “distinguishing patents that claim . . . abstract ideas from those that claim patent-eligible applications of those concepts.” 134 S. Ct. 2347, 2355 (2014). The first step in the analysis is to determine if the claim is directed toward a patent-ineligible concept and, if so, the second step is to determine whether there are additional elements that transform the nature of the claim into a patent eligible application. *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 132 S. Ct. at 1297–98). The second step searches for an inventive concept that is sufficient to ensure that the patent amounts to significantly more than a patent on the patent-ineligible concept. *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 132 S. Ct. at 1294).

We are not persuaded by Appellants’ argument and agree, instead, with the Examiner that the claims “merely recite ‘examining’ a current route in a direction from a vehicle to a destination and a destination to the vehicle, to find an area (two portions) of the road with traffic above a threshold level - in other words, perform a bidirectional search of the current route to find an area to be avoided.” Ans. 7. We also agree the recited method “is nothing more than a simplistic, verbal expression of the manner in which well-known mathematical expressions (bidirectional route searching algorithms) operate.” Ans. 8. Moreover, we agree the claim can be performed in the human mind, or by a human

by viewing a map that includes the route and other roadways and listening to the traffic information from the radio broadcast to find congested areas of the roadway on the map. Radio reports of traffic jams often include, for example, the highway

exits or cross streets nearest to the traffic jam, which the driver or passenger can then identify on the map, and then use the map to find an alternate route.

Ans. 8–9. *See Cyberfone Systems, LLC v. CNN Interactive Group, Inc.* 558 Fed. Appx. 988 (Fed. Cir. 2014) (non-precedential); *SmartGene, Inc. v. Advanced Biological Laboratories*, 555 Fed. Appx. 950 (Fed. Cir. 2014) (non-precedential).

We also agree with the Examiner’s conclusion that, consistent with the Specification (*see* Spec. ¶¶ 72, 81), the radio broadcast provides traffic information such that the user may determine if an alternate route is available. Ans. 9. *See also Alice*, 134 S. Ct. at 2356; *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716–17 (Fed. Cir. 2014).

Applying the first step, we agree with the Examiner that the claim is directed to the identified abstract ideas. Accordingly, we find that the claim is directed to a patent-ineligible concept.

Having determined that the claim is directed to a patent-ineligible concept, step two of the analysis considers whether the claim contains an inventive concept such as limitations that add significantly more to the claim so that it does not fully cover the abstract idea itself. *See Alice*, 134 S. Ct. at 2357. Here, we agree with the Examiner that no inventive concept is present. Moreover, the recited processor is the type of generic element that has been determined to be insufficient by the Supreme Court to transform a patent-ineligible claim into one that is patent-eligible. *See id.* at 2358. The claim includes no limitations that prevent it from covering the abstract idea itself. Therefore, we are unpersuaded by Appellants’ argument that the

claims constitute an inventive concept that is significantly more than a patent on the patent-ineligible concept.

Appellants' argument that "there is no one single abstract idea embodied in the claims that it tied up such that others cannot practice it" is also not persuasive. App. Br. 6. "While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility. . . . Where 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 Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP Technologies, Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015).

Thus, for the reasons discussed above, we sustain the Examiner's rejection of independent claim 1, as well as claims 4, 6, 25, and 26 not separately argued, under 35 U.S.C. § 101.

Section 112 Rejection

The Examiner finds the term "avoiding travel on the current route between the first road-portion and the second road-portion" has no support in the Specification. Final Act. 4. The Examiner specifically asserts the Specification does not provide any specific or quantitative measure and relies on an arbitrarily selected threshold. Final Act. 4–5. We disagree.

"[T]he description requirement does not demand any particular form of disclosure, or that the specification recite the claimed invention *in haec verba.*" *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (*en banc*) (citation omitted). Rather, "the test for sufficiency is

whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad*, 598 F.3d at 1351.

Here, as explained by Appellants, the disclosure on page 19 of the Specification describes “‘routing around’ areas of congestion on a preferred road in a number of places,” which supports the claimed limitation. App. Br. 8. Furthermore, Appellants point to page 16 of their Specification for a description of how an area of congestion is established and a route to avoid the congestion is determined. Reply Br. 3. We also agree with Appellants that these descriptions would reasonably convey to a person of ordinary skill in the art that “looking forward towards a destination to find an onset point, and then backwards from a destination to find an end point,” among other things, specify “avoiding travel on the current route between the first road-portion and the second-road-portion.” *See* Reply Br. 3 (emphasis omitted).

Thus, we are persuaded by Appellants’ argument that the Specification provides written description support for the limitation “avoiding travel on the current route between the first road-portion and the second road-portion” and that the Examiner erred by rejecting the pending claims under § 112, first paragraph.

DECISION

We affirm the Examiner’s decision to reject claims 1, 4, 6, 25, and 26 under 35 U.S.C. § 101, but reverse the Examiner’s decision to reject claims 1, 4, 6, 25, and 26 under 35 U.S.C. § 112. Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner’s decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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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