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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK CHARLES SPITTLE, SIMON SKELTON, and
BARRY YEARSLEY

Appeal 2017-001438
Application 11/996,192
Technology Center 3700

Before PHILIP J. HOFFMANN, BRUCE T. WIEDER, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

HOFFMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellants¹ appeal from the Examiner's rejection of claims 78–92. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

According to Appellants, their “invention relates to an electronic entertainment device.” Spec. 1, l. 1. Claim 78 is the only independent claim

¹ According to Appellants, the real party in interest is Big Ideas Product Development Limited. Appeal Br. 1.

on appeal. Below, we reproduce claim 78 as illustrative of the appealed claims.

78. A cellular phone comprising: a display screen, an audio speaker, a memory having access to a plurality of stored items of data, and a processor programmed to analyze a telephone number or name, isolate respective subsets of component digits of the telephone number or respective subsets of the component characters of the name and associate said stored items of data with a telephone number or a name according to values of respective subsets of component digits of the telephone number or to values of respective subsets of component characters of the name, whereby said associated items of data are played or displayed on one or more of said display screen and audio speaker.

REJECTION²

The Examiner rejects claims 78–92 under 35 U.S.C. § 101 as patent-ineligible subject matter.

ANALYSIS

With respect to the § 101 rejection, Appellants argue claims 78–92 as a group. *See* Appeal Br. 5–6. We base our analysis on independent claim 78, and its dependent claims 79–92 stand or fall with claim 78. *See* 37 C.F.R. § 41.37(c)(1)(iv).

We determine whether a claim recites ineligible subject matter based on the Supreme Court’s framework, as articulated in *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014), which follows the two-part test set forth in *Mayo Collaborative Services v. Prometheus Laboratories*,

² The Examiner withdraws the rejections under 35 U.S.C. §§ 112 and 103(a). *See* Answer 3.

Inc., 566 U.S. 66 (2012). That is, a claim recites ineligible subject matter if, in accordance with the first part of the *Alice* test, the claim is *directed to* ineligible subject matter, e.g., an abstract idea, and if, in accordance with the second part of the test, the claim lacks any further claim limitations that, when “consider[ed] . . . both individually and ‘as an ordered combination’ . . . ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78, 79).

More specifically, with respect to the first part of the *Alice* test, [t]he “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, 2016 WL 1393573, at *5 (Fed. Cir. 2016) (inquiring into “the focus of the claimed advance over the prior art”).

Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1335 (Fed. Cir. 2016). The court put the question as being “whether the focus of the claims is on [a] specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Id.* at 1335–36 (citation omitted). In this case, according to Appellants,

similar to the claims at issue in *Enfish* . . . , [c]laim 78 is focused [on] a novel invention for improving cellular phone functionality. In other words, upon analysis of the claim

limitations as an ordered combination, claim 78 as a whole amounts to significantly more than simply organizing human activity or manipulating data using a generic computer system. With regard to the sole independent claim, the recited invention addresses the technology-centric issue of providing an improved cellular phone device, i.e., a phone with special programming for the automated personalization/identification of an incoming call (or message alert). In other words, when viewed as a whole, the claim 78 is directed to a cellular phone possessing a wholly technological improvement in automated identification/personalization.

Appeal Br. 5; *see also id.* at 5–6.

We note, however, that claim 78 is not limited to identification of incoming calls or messages. Instead, the claim recites “a processor programmed to analyze a telephone number or name,” to “associate . . . stored items of data with a telephone number or a name,” and to “play[] or display[] on one or more of [a] display screen and [an] audio speaker” the “associated items of data,” without limitation to a received call. As written, claim 78 does not require anything other than a generic processor performing routine operations, such as analyzing, associating, and outputting different types of data, and, therefore, the claim is directed to ineligible subject matter, in accordance with the first part of the *Alice* test. *See, e.g., DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (citing *Alice*, 134 S. Ct. at 2358) (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”).

With respect to the second part of the *Alice* test, Appellants argue that the claims are “directed to a cellular phone possessing a wholly technological improvement in automated identification/personalization.”

Appeal Br. 5; *see also id.* at 6 (The claims recite “a cellular phone with a specifically[-]defined improvement to technological functionality.”). We are not persuaded by Appellants’ argument, however. Because the claims recite a cellular phone having a processor that is programmed to gather, analyze, and display data, does not, in and of itself, mean the claims represent an improvement to cellular phone functionality. To the contrary, the recited cellular phone simply limits the claims to a particular technological environment, which is insufficient for patent eligibility. *See Alice*, 134 S. Ct. at 2358 (quoting *Bilski v. Kappos*, 130 S. Ct. 3218, 3230 (2010)). Thus, Appellants do not persuade us that the claims recite limitations that transform the claim into a patent-eligible application.

Therefore, based on the foregoing, we are not persuaded of Examiner error. Thus, we sustain the Examiner’s §101 rejection of claims 78–92.

DECISION

We AFFIRM the Examiner’s rejection of claims 78–92.

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