UNITED STATES PATENT AND TRADEMARK OFFICE

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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 THOMAS R. GRUBER, ALESSANDRO F. SABATELLI, and
DONALD W. PITSCHEL

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Appeal 2017-001924
Application 13/251,088
Technology Center 3600

_____

Before MURRIEL E. CRAWFORD, NINA L. MEDLOCK, and
PHILIP J. HOFFMANN, *Administrative Patent Judges.*

CRAWFORD, *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 decision rejecting claims 1–31. We have jurisdiction over the appeal
under 35 U.S.C. § 6(b). Appellants appeared for hearing on January 30,
2018.

We REVERSE.

Claim 1 is illustrative:

1. A method comprising:
    at an electronic device comprising one or more
processors and memory storing one or more programs for
execution by the one or more processors, the method
comprising:
    receiving, from a user, input that expressly specifies one
or more first attributes of a task;
    based on the input, generating a task item for the task;
    automatically without user intervention, retrieving
context data that is separate from the input;
    deriving from the context data one or more second
attributes of the task; and
    causing a plurality of attributes to be stored in association
with the task item, wherein the plurality of attributes includes
the one or more first attributes and the one or more second
attributes, and wherein the task item is stored in a list of task
items to be displayed to and performed by the user.

App. Br. 61 (Claims Appendix).

Appellants appeal the following rejections:

1. Claims 1–31 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

2. Claim 1–31 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Upton (US 7,541,940 B2, iss. June 2, 2009) in view of Cleary et al. (US 2008/0294418 Al, pub. Nov. 27, 2008).

PRINCIPLES OF LAW

An invention is patent-eligible if it claims a "new and useful process, machine, manufacture, or composition of matter." 35 U.S.C. § 101. The

Supreme Court, however, has long interpreted § 101 to include implicit exceptions: "[l]aws of nature, natural phenomena, and abstract ideas" are not patentable." *E.g.*, *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014).

In determining whether a claim falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court's two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is "directed to" a patent-ineligible abstract idea. *See Alice*, 134 S. Ct. at 2356 ("On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk."); *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) ("Claims . . . in petitioners' application explain the basic concept of hedging, or protecting against risk."); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) ("Analyzing respondents' claims according to the above statements from our cases, we think that a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter."); *Parker v. Flook*, 437 U.S. 584, 594–595 (1978) ("Respondent's application simply provides a new and presumably better method for calculating alarm limit values."); *Gottschalk v. Benson*, 409 U.S. 63, 64 (1972) ("They claimed a method for converting binary-coded decimal (BCD) numerals into pure binary numerals.").

The patent-ineligible end of the spectrum includes fundamental economic practices, *Alice*, 134 S. Ct. at 2357; *Bilski*, 561 U.S. at 611; mathematical formulas, *Parker*, 437 U.S. at 594–95; and basic tools of

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scientific and technological work, *Gottschalk*, 409 U.S. at 69. On the patent-eligible side of the spectrum are physical and chemical processes, such as curing rubber, *Diamond*, 450 U.S. at 184 n.7, "tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores," and a process for manufacturing flour, *Gottschalk*, 409 U.S. at 69.

If the claim is "directed to" a patent-ineligible abstract idea, we then consider the elements of the claim—both individually and as an ordered combination—to assess whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2355. This is a search for an "inventive concept"—an element or combination of elements sufficient to ensure that the claim amounts to "significantly more" than the abstract idea itself. *Id.*

ANALYSIS

Rejection under 35 U.S.C. §101

The Examiner held that the claims are directed to the abstract idea of gathering user information related to tasks that are based on user input and contextual data to display and assign tasks to a user, which is viewed as the comparing of new and stored information, and using rules to identify options, which are the mental steps, although done on a computer. Fin. Act. 10–11. The Examiner found that the claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because receiving, retrieving, deriving, storing, and displaying are viewed as using a computer program that is merely a set of instructions to determine the mathematical relationship/formula to govern the organizing of human activities, on a generic computer. The Examiner found that it is not

clear that there is any meaningful improvement to the technology or to the technological environment. Ans. 11. The Examiner did not address the specific recitations of claim 1 or the recitations of any of the other claims subject to this rejection.

Appellants argue that the claimed invention recites the intelligent use of context data, which improves the accuracy, relevance, and usefulness of tasks generated for electronic lists. Among the improvements to the digital assistant field the Appellants list are fewer interactions between digital assistant and the user, which enhances the computing efficiency and battery life of electronic devices, and improves the user experience. App. Br. 55. These improvements flow from the fact that context data are retrieved, and second attributes derived therefrom, without user intervention. This feature of the claim relieves the user of making further input of context data after the first attribute of the task is received.

We will not sustain this rejection because the Examiner has not established or explained why the derivation of context data without user intervention is not a technical improvement to the process of gathering user information. In this regard, the Examiner has not addressed why the improvements that flow from retrieving context data and deriving second attributes therefrom without user intervention does not amount to significantly more than the abstract idea. In fact, the Examiner does not specifically address this feature of the claim.

In view of the foregoing, we will not sustain the rejection as it is directed to claim 1 and the claims dependent therefrom. We will also not sustain the rejection of independent claims 12 and 14 and their dependent claims for the same reason.

Rejection under 35 U.S.C. §103(a)

The Appellants argue that the Examiner's rationale to combine Upton and Cleary is without merit. App. Br. 27. We agree.

We find that Upton discloses a system and method to provide proximity-based task alerts in a mobile computing device (col. 1, ll. 54–56). This allows a user to receive a reminder to perform a task associated with a particular location when the user is within the proximity or vicinity of that location (col. 6, ll. 57–60). The Examiner recognizes that Upton does not disclose deriving from the context data a second attribute of the task. The Examiner relies on paragraphs 60 and 65 of Cleary for teaching this subject matter.

We find that Cleary discloses a method for network management comprising a configuration of control protocols between network elements in a network represented through a current, static, network element managed object model comprising a number of managed objects (Cleary ¶ 1). Paragraphs 60 and 65 of Cleary relate to tasks to be done in a network configuration. The Examiner has not established that a person of ordinary skill in the art at the time of the invention would have had a reason to combine the teachings of Upton which is directed to proximity-based task alerts in a mobile computing device with network configuration tasks as taught by Cleary. In this regard, although Upton and Cleary disclose old elements, it is not apparent how the result of the combination would have been predictable. In fact, as Upton and Cleary relate to such disparate tasks, it is not clear how one would combine these teachings.

In view of the foregoing, we will not sustain this rejection.

DECISION

We reverse the Examiner's decision.

ORDER

<u>REVERSED</u>