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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TIMO KRATZER, HERBERT KRUG,
JESUS-MIGUEL CABEZA-GUILLEN, and HARAIID RUENZ

Appeal 2017-002376
Application 13/685,324
Technology Center 3600

Before BRUCE T. WIEDER, AMEE A. SHAH, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL¹

The Appellants² appeal under 35 U.S.C. § 134(a) from the Examiner’s final decision rejecting claims 2–30. The Appellants’ representative appeared for oral argument on December 6, 2018. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Throughout this decision, we refer to the Appellants’ Appeal Brief (“Appeal Br.,” filed Mar. 15, 2016), Reply Brief (“Reply Br.,” filed Nov. 28, 2016), and Specification (“Spec.,” filed Nov. 26, 2012), and to the Examiner’s Answer (“Ans.,” mailed Oct. 3, 2016), and Final Office Action (“Final Act.,” mailed Oct. 22, 2015).

² According to the Appellants, the real party in interest is Carl Zeiss Vision GmbH. Appeal Br. 1.

STATEMENT OF THE CASE

The Appellants' invention relates generally to "dispensing eyeglasses" (Spec. ¶ 2) and more particularly to "obtaining an eyeglass prescription and ordering eyeglass lenses for a person" (*id.* ¶ 26).

Claims 2, 7, 13, 14, 19, 24, 25, and 30 are the independent claims on appeal. Claim 25 (Appeal Br. 24 (Claims App.)) is illustrative of the subject matter on appeal and is reproduced below.

25. A system, comprising:

a first computer, a second computer, and a third computer, wherein the third computer is associated with a lens manufacturing site, the third computer being in a location different from the first computer and the second computer, and

(a) the first computer is programmed to:

receive information about a person's vision based on one or more refractions of the person's eye and to send the information about the person's vision over a network to the second computer; and

receive prescription information from the second computer and to send an order for a lens based on the prescription information to the third computer;

(b) the second computer is programmed to:

receive the information about the person's vision;

calculate prescription information based on the information about the person's vision, the prescription information comprising at least one parameter selected from the group consisting of sphere, cylinder, cylinder axis, prism, and base; and

send the prescription information to the first computer;

(c) the third computer is programmed to:

receive the order for the lens based on the prescription information.

REJECTIONS

Claims 2–30 stand rejected under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more.

Claims 2–30 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Cabeza et al. (US 8,079,707 B2, iss. Dec. 20, 2011) (“Cabeza”) and Cox et al. (US 6,499,843 B1, iss. Dec, 31, 2002) (“Cox”).

ANALYSIS

35 U.S.C. § 101

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, 89 (2013)). 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, 78–79 (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 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 78–79).

The Appellants argue claims 2–30 as a group and make similar arguments for each of the independent claims. *See* Appeal Br. 5, 8, 9. We select claim 25 from the group, with claims 2–24 and 26–30 standing or falling therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Under the first step of the *Alice* framework, the Examiner determines that claim 25 is directed to “comparing new and stored information and using rules to identify options.” Final Act. 2. The Appellants do not ostensibly disagree with the Examiner’s characterization of the claim. *See* Appeal Br. 5. Rather, the Appellants contend that the Examiner’s determination under the second step of the *Alice* framework is in error because “[t]he claims include additional elements that amount to significantly more than the abstract idea alleged by the Examiner.” *Id.* We are not persuaded of Examiner error.

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).

We find unpersuasive the Appellants’ argument that the claimed computers are not generic computers performing routine functions because they communicate with each other from separate locations. *See* Appeal

Br. 5–7. The Specification provides for an ordering computer, a calculation computer, and a manufacturing computer. Spec. ¶¶ 27, 30, Figs. 2, 3. These computers “can be implemented in digital electronic circuitry, or in computer hardware, firmware, software, web-enabled applications, or in combinations thereof,” with a system that includes “at least one programmable processor coupled to receive data and instructions from, and to transmit data and instructions to, a data storage system, at least one input device, and at least one output device.” *Id.* ¶ 55. “Suitable processors include, by way of example, both general and special purpose microprocessors.” *Id.* “Generally, a computer will include one or more mass storage devices for storing data files, such devices include magnetic disks, such as internal hard disks and removable disks magneto-optical disks and optical disks.” *Id.* As such, the Specification provides for a system comprising general purpose computers operating in their conventional capacities to send, receive, and calculate data. And, a generic computer or a special purpose processor specially programmed to perform the conventional functions of receiving, sending, and calculating data does not amount to an inventive concept such that the claim is significantly more than the abstract idea. *See Alice*, 134 S. Ct. at 2357–60 (applying an abstract idea, such as an algorithm, on a general purpose computer is not enough to transform a patent-ineligible abstract idea into a patent-eligible invention.); *EON Corp. IP Holdings LLC v. AT & T Mobility LLC*, 785 F.3d 616, 623 (Fed. Cir. 2015) (“A general purpose computer is flexible—it can do anything it is programmed to do.”).

Further, the benefits the Appellants describe from the arrangement of the computers being in different locations (*see* Appeal Br. 6–7) do not

comprise a technical improvement over prior art ways of dispensing eyeglasses (*see BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016)). The Specification describes advantages to having separate first, second, and third computers of “reducing the amount of data transferred” (Appeal Br. 6, citing Spec. ¶ 29), “allow[ing] a prescription to be ordered using existing ordering systems that do not include fields for providing wavefront data” (*id.*), “generat[ing] lenses having prescriptions based on wavefront data without having to upgrade the manufacturing locations to perform such calculations” (*id.*), “allow[ing] an eye care professional to review and adjust the prescription prior to placing the order” (*id.* at 6–7), reducing “the amount of software and data needed by” each computer (*id.* at 7, citing Spec. ¶ 50), and requiring updates “only to the second computer rather than each of the first computers” (*id.*, citing Spec. ¶ 30). However, even assuming *arguendo* that these alleged advantages, referenced in the Specification, constitute a technical or technological improvement in dispensing eyeglasses or in “comparing new and stored information and using rules to identify options,” no such features are recited in the claims on Appeal. Other than having multiple generic computers, the claim does not recite any elements that reflects how these advantages are technologically or technically achieved. Therefore, these purported advantages cannot signify any claim element(s) amounting to significantly more than the abstract idea.

We also find unpersuasive the Appellants’ argument that the claim is significantly more than the abstract idea because it “addresses the data-centric challenge of providing the best prescription based on input from a wavefront sensor and manufacturing a lens based on that prescription” and,

when considering the limitations as an ordered combination, there is a “technologically rooted solution to a data-centric problem.” Appeal Br. 7. Claim 25 does not claim a solution “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 125757 (Fed. Cir. 2015). The problems of “providing the best prescription based on input” and “manufacturing a lens based on that prescription” (Appeal Br. 7) is a business problem that existed prior to the Internet. And, the purported solution comprises the use of computers operating in their normal and ordinary capacities. *See Spec.* ¶ 55.

We further disagree with the Appellants that the Examiner overlooks the recitations of the locations of the first and second computers, as claimed in claims 14, 19, and 24, and “other tangible elements” of claims 4, 16, and 27. *See Appeal Br. 8; Reply Br. 3.* The Examiner considers the limitations and determines they are not significantly more than the abstract idea. *See Ans. 4–5.* We note that the Appellants merely recite the limitations of the other claims and assert for some that the limitation is “a meaningful [one] beyond generally linking the use of an abstract idea to a particular technological environment,” without any further argument or explanation. *See Appeal Br. 8; Reply Br. 3.*

Thus, we are not persuaded the Examiner erred in the rejection of independent claim 25 under 35 U.S.C. § 101, and we sustain the rejection of claim 25 and of claims 1–24 and 26–30, which fall with claim 25.

35 U.S.C. § 103(a)

We agree with the Appellants that the Examiner does not adequately show how the combination of the prior art teaches “[a] first computer[]

programmed to [] send[] information about [a] person’s vision to [a] second computer and receive a calculated lens prescription from the second computer,” as recited in claim 1, with similar subject matter recited in independent claims 7, 13, 14, 19, 24, 25, and 30. Appeal Br. 9 (alterations in original); *see also* Reply Br. 3.

The Examiner finds that Cabeza teaches receiving a calculated lens prescription comprising at least the parameter of cylinder. *See* Final Act. 3. The Examiner further finds that Cabeza does not explicitly “the distributed network” (Ans. 6) of a first computer sending information to a second computer and receiving calculated data from the second computer (*see* Final Act. 3–4). The Examiner relies on Cox at column 6, lines 5–60 for curing this deficiency (*id.* at 4) by providing “remote facilities . . . to reduce cost required to perform functions in low volume local locations” (*id.*). Specifically, the Examiner finds that Cox’s “practitioners’ platform **140** is analogous to the first computer, the service platform **300** is analogous to the second computer, and the order/billing platform **18** is analogous to the third computer.” Ans. 5. Thus, the Examiner relies on the combination of Cabeza and Cox to teach this limitation. *See id.*

Cabeza discloses a calculating device configured to calculate a prescription, including determining a prescription value for cylinder. Cabeza, col. 3, ll. 24–25, col. 4, ll. 7–11. Cox discloses practitioner’s platform 140, located at the practitioner’s facility, that generates vision diagnostic information, practitioner information, and other information. *See* Cox, col. 6, ll. 7–13. The information is sent to service platform 300 that generates billing information, sends that information to order/billing platform 18, and generates lens design and manufacturing information that is

sent to custom lens platform 20. *Id.*, col. 6, ll. 13–22. The custom lens information is received and used by custom lens platform 20 to produce custom lens products that can be shipped to the practitioner or patient. *Id.*, col. 6, ll. 24–28. Based on information, such as wavefront, vision, and/or demographic data, service platform 300, lens platform 20, and/or billing platform 18 can generate feedback to practitioner. *Id.*, col. 6, ll. 32–41.

Even assuming *arguendo* that Cox's second computer, service platform 300, as modified by Cabeza's device that calculates a prescription, teaches the second computer sending the calculated prescription information, the Examiner has not shown how Cox's system teaches that the calculated information is sent by second computer 300 to the first computer, practitioner platform 140, that then sends it to the third computer, either order/billing platform 18 (as relied on by the Examiner) or custom lens platform 20 (as disclosed by Cox as receiving prescription lens information). Rather, the portions of Cox cited by the Examiner teach that the second computer (service platform 300) receives information from the first computer (practitioner platform 140), generates/calculates custom/prescription information, and sends that information to a third computer (billing platform 18 or lens platform 20), not back to first computer 140. Although Cox teaches that second computer, service platform 300, can generate feedback to the practitioner, the Examiner has not explained, and we do not see, how that teaches, suggests, or combines with Cabeza to teach sending the calculated prescription back to the first computer, practitioner platform 140.

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Thus, we are persuaded the Examiner erred in the rejection of the independent claims 1, 7, 13, 14, 19, 24, 25, and 30 under 35 U.S.C. § 103(a), and we do not sustain the rejection of claims 2–30.

DECISION

The Examiner's rejection of claims 1–30 under 35 U.S.C. § 101 is AFFIRMED.

The Examiner's rejection of claims 1–30 under 35 U.S.C. § 103(a) is 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