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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN C. SCHIMPF, EDITH H. STERN,
ROBERT C. WEIR,
and
BARRY E. WILLNER

Appeal 2017-002718
Application 11/534,681¹
Technology Center 3600

Before CARLA M. KRIVAK, HUNG H. BUI, and JON M. JURGOVAN,
Administrative Patent Judges.

JURGOVAN, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants seek review under 35 U.S.C. § 134(a) from a Final Rejection of claims 49–61, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.²

¹ Appellants identify International Business Machines Corporation, as the real party in interest. (App. Br. 4.)

² Our Decision refers to the Specification (“Spec.”) filed September 25, 2006, the Final Office Action (“Final Act.”) mailed January 13, 2016, the Appeal Brief (“App. Br.”) filed June 13, 2016, the Examiner’s Answer (“Ans.”) mailed October 21, 2016, and the Reply Brief (“Reply Br.”) filed December 21, 2016.

CLAIMED INVENTION

The claims are directed to methods and systems for “accessing workflows through the use of radio frequency identification (RFID) technology” that includes an “RFID tag . . . attached to, or associated with, a physical asset,” the physical asset being “logically associated with [an] electronic document[.]” (Spec. ¶¶ 3, 4, 19.) In one aspect of Appellants’ invention, “a workflow . . . automatically establish[es] a communication session,” such as an instant messaging session, between participants specified in metadata read from the RFID tag. (Spec. ¶¶ 40, 44–45.) In another aspect of Appellants’ invention, a workflow “include[s] a security feature that discontinues operation or processing of the electronic document” by a user that is not listed in the RFID tag’s metadata. (Spec. ¶¶ 44, 48.)

Claims 49, 52, 54, 57, and 59 are independent. Claims 49 and 52, reproduced below, are illustrative of the claimed subject matter:

49. A method comprising:

receiving, by an information processing system comprising a hardware processor, from a radio-frequency identification (RFID) reader, information stored in at least one RFID tag and read from the at least one RFID tag by the RFID reader, the information comprising at least one attribute associated with an electronic document and metadata, the metadata comprising a plurality of instant messaging addresses;

processing, by the information processing system, the at least one attribute associated with the electronic document and, responsive to processing the at least one attribute associated with the electronic document, selecting, by the information processing system, at least one workflow according to the attribute, wherein the workflow is predefined and documented;

identifying, by the information processing system, the plurality of instant messaging addresses and, responsive to identifying the plurality of instant messaging addresses,

initiating, by the information processing system, the workflow, initiating the workflow comprising the information processing system initiating a multi-person chat session among the plurality of instant messaging addresses by interfacing with at least one instant messaging system using data synchronization and instructing the at least one instant messaging system to establish the multi-person chat session among the plurality of instant messaging addresses.

52. A method comprising:

receiving, by an information processing system comprising a hardware processor, from a radio-frequency identification (RFID) reader, information stored in at least one RFID tag and read from the at least one RFID tag by the RFID reader, the information comprising at least one attribute associated with an electronic document and metadata, the metadata listing at least one user;

processing, by the information processing system, the at least one attribute associated with the electronic document and, responsive to processing the at least one attribute associated with the electronic document, selecting, by the information processing system, at least one workflow according to the attribute, wherein the workflow is predefined and documented; and

processing, by the information processing system, the metadata read from the at least one RFID tag and, responsive to the information processing system processing the metadata, initiating, by the information processing system, the workflow, initiating the workflow comprising the information processing system discontinuing operation or processing of the electronic document when a user is logged into the information processing system, via which the electronic document is being accessed, and the user is not listed in the metadata read from the RFID tag.

(App. Br. 45–51 (Claims App.).)

REJECTIONS & REFERENCES

(1) Claims 52, 53, 57, and 58 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. (Final Act. 4–5.) However, this

rejection was withdrawn in the Examiner's Answer, and is thus, not before us. (Ans. 18.)

(2) Claims 52, 53, 57, and 58 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. (Final Act. 3–4.)

(3) Claims 49–51, 54–56, and 59–61 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.³ (Ans. 16–18.)

(4) Claims 49, 51, 54, 56, 59, and 61 stand rejected under 35 U.S.C. § 103(a) based on Shaffer et al. (US 2006/0208889 A1, published Sept. 21, 2006) (“Shaffer”), Hull et al. (US 2004/0074961 A1, published Apr. 22, 2004) (“Hull”), and Barac et al. (US 2006/0074933 A1, published Apr. 6, 2006) (“Barac”). (Final Act. 6–10.)

(5) Claims 50, 55, and 60 stand rejected under 35 U.S.C. § 103(a) based on Shaffer, Hull, Barac, and Vuattoux et al. (US 2005/0246341 A1, published Nov. 3, 2005) (“Vuattoux”). (Final Act. 11–12.)

(6) Claims 52, 53, 57, and 58 stand rejected under 35 U.S.C. § 103(a) based on Hull, Barac, and Allard et al. (US 2005/0182661 A1, published Aug. 18, 2005) (“Allard”). (Final Act. 12–16.)

³ This rejection is presented for the first time in the Examiner's Answer.

ANALYSIS

*Rejections of Claims 49–61 under 35 U.S.C. § 101
as being directed to non-statutory subject matter*

The Examiner finds claims 49 and 52 are “directed to the abstract idea of initiating workflows associated with electronic documents,” which is a “data gathering activity” similar to “collecting and comparing known information of *Classen* and comparing new and stored information to a rule to determine options as in *SmartGene*.” (Ans. 16, 18–19 (citing *SmartGene, Inc. v. Advanced Bio. Labs., SA*, 852 F.Supp.2d 42 (D.D.C. 2012), *aff’d* 555 Fed.Appx. 950 (Fed. Cir. 2014); *Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057 (Fed. Cir. 2011)).) The Examiner also finds the claims’ “workflow automation and using RFID technology are routine and conventional activities” that “merely automat[e] business steps to achieve something which could be performed without automation.” (Ans. 19.) For these reasons, the Examiner concludes the claims are directed to unpatentable subject matter under § 101. (Ans. 16, 18–19.)

Appellants argue independent claim 49 (and similarly worded independent claims 54 and 59) and independent claim 52 (and similarly worded independent claim 57) are not directed to the generic abstract ideas asserted by the Examiner, but rather to novel and nonobvious “technological improvement[s] over existing workflow processing techniques.” (Reply Br. 4–5, 16.) Appellants argue claim 49 is directed to a new and useful technique enabling an “instant messaging system to establish [a] multi-person chat session among [a] plurality of instant messaging addresses” that are “stored in at least one RFID tag and [are] read from the at least one RFID tag.” (Reply Br. 8, 10–11.) Appellants also argue claim 52 is directed to a new and useful technique enabling an information processing system to

“discontinu[e] operation or processing of . . . [an] electronic document when a user is logged into the information processing system, via which the electronic document is being accessed, and the user is not listed in the metadata read from [an] RFID tag” that lists another user. (App. Br. 21; *see also* Reply Br. 16.)

To determine whether subject matter is patentable under § 101, the Supreme Court has set forth a two part test “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014).

The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* (citation omitted). For computer-related technologies, “the first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the *specific asserted improvement* in computer capabilities” (which would be eligible subject matter) or instead “on a process that qualifies as an ‘abstract idea’ for which *computers are invoked merely as a tool*” (which would be ineligible subject matter). *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36, 1338 (Fed. Cir. 2016) (emphasis added). “If the claims are not directed to an abstract idea [or other patent-ineligible concept], the inquiry ends. If the claims are ‘directed to’ an abstract idea, then the inquiry proceeds to the second step of the *Alice* framework.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016). The second step in the *Alice* framework is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a

patent-eligible application.” *Id.* (quoting *Mayo Collaborative Serv. v. Prometheus Labs., Inc.*, 566 U.S. 66, 79, 78 (2012)). 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.’” *Id.* (citing *Mayo*, 566 U.S. at 72–73).

When considering whether the claims are directed to a patent ineligible concept, such as an abstract idea, “[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.” *See Enfish*, 822 F.3d at 1335–36 (citing *Mayo*, 566 U.S. at 70–71). Rather, “the ‘directed to’ inquiry applies a stage-one filter to claims” considered in their entirety, in light of the Specification, to ascertain whether the claims’ character as a whole is directed to excluded subject matter. (*Id.* (citing *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).)

Having reviewed the evidence, we disagree with the Examiner’s conclusion that the claims are directed to abstract ideas of gathering and comparing data for initiating workflows associated with electronic documents. (Ans. 16, 18–19.) Rather, we conclude the character of the claims as a whole is directed to improved information processing systems and methods for electronically accessing and interacting with physical (*i.e.*, non-digital) assets, such as paper documents and other physical objects. (*See Spec.* ¶¶ 2, 22, 26, 29, 37, 40, 46–18.) Particularly, independent claims 49, 54, and 59 are directed to information processing systems and methods

that allow and improve *the combined performance of an RFID tag*—programmed or imprinted with instant messaging (IM) addresses of team members responsible for a physical asset bearing the RFID tag—*with an instant messaging system* controlled to establish a multi-person chat session between the RFID tag’s IM addresses. (See Spec. ¶¶ 5, 26, 34, 40, 45, 56; Reply Br. 4–5, 8–9.) The other independent claims (52 and 57) are directed to information processing systems and methods executing a security policy for an electronic document and its corresponding RFID-tagged physical asset, by *automatically discontinuing* the electronic document’s processing *by a user that is not listed on the asset’s RFID tag*. (See Spec. ¶¶ 4, 46–48; Reply Br. 16, 18.) See *Enfish*, 822 F.3d at 1335–36; *McRO*, 837 F.3d at 1314 (patent eligible method claims directed to an improvement in computer animation, not an abstract idea that merely invokes generic processes and machinery).

Our conclusion is supported by the Specification’s description of Appellants’ invention as directed to “rapid access to data oriented workflows” “through the use of radio frequency identification (RFID) technology” such as RFID tags establishing “a logical association . . . between . . . [an] electronic document . . . and the RFID tag” of a physical asset. (See Spec. ¶¶ 3, 43, Title (capitalization altered).) Appellants’ information processing system (as in claims 49, 54, and 59) interfaces the RFID tag with an instant messaging system for “automatically establishing a communication session with one or more participants as specified by the metadata . . . associated with the detected RFID tag.” (See Spec. ¶¶ 35, 45.) Another information processing system (as in claims 52 and 57) “implement[s] a security policy relating to the physical asset [and] the

electronic document” by “discontinu[ing] operation or processing of the electronic document” by an unauthorized “user . . . not listed in the metadata . . . associated with the electronic document . . . associated with the RFID tag.” (See Spec. ¶¶ 4, 48.) In Appellants’ invention:

multiple RFID tags and electronic documents are read and identified, [and] a workflow can be automatically executed that determines one or more of the electronic documents to be processed. Such a workflow, for example, can make the determination by evaluating the priority of an electronic document relative to other electronic documents, disqualifying electronic documents from consideration if a security attribute of an electronic document exceeds the security level of a user associated with the computer that detected the RFID tag, or the like. Still, the workflow can implement or initiate other actions such as implementing a proximity-based security policy, [or] establishing a communication session between participants specified by the metadata using a communication technology or communication session type (i.e., teleconference, instant message, etc.) specified by the metadata.

(Spec. ¶ 57.)

Additionally, we note the Examiner’s characterization of the directed-to concept of Appellants’ claims fails to account for the concrete technological improvements recited in these claims, i.e., (i) “instructing the at least one instant messaging system to establish the multi-person chat session among the plurality of instant messaging addresses” stored in the RFID tag, as recited in claim 49 (and, similarly, in claims 54 and 59), and (ii) controlling the information processing system to “discontinu[e] operation or processing of the electronic document when a user is logged into the information processing system, via which the electronic document is being accessed, and the user is not listed in the metadata read from the RFID tag,” as recited in claim 52 (and, similarly, in claim 57). (Reply Br. 4, 11,

15–16.) Additionally, the Examiner’s finding similarity of Appellants’ claims to those in the *SmartGene* and *Classen* cases is incongruous, as the *SmartGene* and *Classen* claims did not involve interfacing RFID tags with messaging systems or proximity-based security systems. (Reply Br. 4–6.)

Because claims 49, 52, 54, 57, and 59 are directed to specific technological improvements for electronic interaction with physical assets, we find claims 49, 52, 54, 57, and 59, and their dependent claims 50, 51, 53, 55, 56, 58, 60, and 61 are not directed to an abstract idea. As the claims are not directed to an abstract idea under the first step of the *Alice* analysis, we need not proceed to step two of the analysis. *See Enfish*, at 1336, 1339.

For these reasons, we do not sustain the Examiner’s rejection of claims 49–61 as directed to non-statutory subject matter under 35 U.S.C. § 101.

*Rejection of Claims 49–51, 54–56, and 59–61
under 35 U.S.C. § 103(a)*

The Examiner finds the combination of Shaffer, Hull, and Barac teaches initiating a workflow by “initiating a multi-person chat session among the plurality of instant messaging addresses by interfacing with at least one instant messaging system using data synchronization and instructing the at least one instant messaging system to establish the multi-person chat session among the plurality of instant messaging addresses” stored in an RFID tag’s metadata as claimed in independent claim 49, and similarly recited in independent claims 54 and 59. (Final Act. 6–8; Ans. 21–22.) Particularly, the Examiner finds Shaffer teaches an “RFID tag . . . associated with an instant messaging address as well as having the contact center instant messaging address, thus demonstrating multiple instant

messaging addresses” are stored by an RFID tag, as required by claim 49. (Ans. 21 (citing Shaffer ¶¶ 34, 39, Fig. 4); *see also* Final Act. 6.) The Examiner also finds Hull “discloses various information stored on an RFID tag including address information and routing information for recipients of . . . [an] electronic document, thus implying multiple addresses stored on an RFID device.” (Ans. 21–22 (citing Hull ¶¶ 32, 47, 57–59).) With respect to the claimed instant messaging system establishing a multi-person chat session among RFID tag’s IM addresses, the Examiner finds Shaffer discloses an IM session “automatically connecting a user [to a service center] based on the contact information within the RFID tag.” (Ans. 21–22 (citing Shaffer ¶¶ 27–29, 31–34); *see also* Final Act. 7–8.) We do not agree.

We agree with Appellants that Shaffer and Hull, alone or in combination, fail to teach or suggest instructing an instant messaging system to establish an “‘instant messaging session’ . . . setup ‘among the plurality of instant messaging addresses’ included in ‘metadata’ of the ‘RFID tag,’” as required by claim 49. (App. Br. 33; Reply Br. 20.) Rather, “Shaffer only discloses a single ‘instant message address’ contained in the ‘contact field’” of a user’s RFID tag, the “instant message address” being “contact information for a service center.” (Shaffer ¶ 39; Reply Br. 19.) Shaffer discloses, “[a]n instant messaging session may . . . be set up between the computer of the user and the service center” (*see* Shaffer ¶ 48), however, Shaffer does not store “the originating instant message address [of the user’s computer]” on the RFID tag. (App. Br. 34.) That is, although Shaffer initiates an IM session between user and service center, Shaffer does not teach that *plural IM addresses* involved in the IM session *are stored on the RFID tag*; only the service center’s IM address is stored on the RFID tag.

(*See* Shaffer ¶ 39.) Thus, Shaffer does not establish a multi-person chat session among a plurality of IM addresses stored in an RFID tag, as claimed.

The Examiner responds “if the functionality of storing one instant messaging address is present then it is reasonable that more than one address may be stored” in an RFID tag, such as Shaffer’s. (Ans. 21–22.) Even accepting *arguendo* the Examiner’s implicit finding that it would be within the ability of the skilled artisan to store multiple IM addresses in an RFID tag, we agree with Appellants that the Examiner has failed to identify any teaching or suggestion for *instructing an IM system to “establish [a] multi-person chat session among the [RFID tag’s] plurality of instant messaging addresses.”* (Reply Br. 19–20 (emphasis added).) *See In re Chaganti*, 554 Fed.Appx. 917, 922 (Fed. Cir. 2014) (“It is not enough to say that . . . to do so would ‘have been obvious to one of ordinary skill.’ . . . Such circular reasoning is not sufficient—more is needed to sustain an obviousness rejection.”)

Hull does not make up for the above-noted deficiencies of Shaffer. Hull merely routes a “paper form after it has been filled out” to one or more “postal address[es]” stored in an RFID tag. (Reply Br. 20 (citing Hull ¶¶ 57–59, Fig. 8).) Since a “‘postal address’ is not an ‘instant messaging address’” and “[p]aper cannot be communicated in an ‘instant messaging session,’” Hull does not teach or suggest instructing an IM system to establish a multi-person chat session among multiple IM addresses stored in an RFID tag, as claimed. (Reply Br. 20.)

The Examiner also has not shown that the additional teachings of Barac and Vuattoux make up for the above-noted deficiencies of Shaffer and Hull. Thus, for the reasons set forth above, we do not sustain the

Examiner's rejections of independent claims 49, 54, and 59 and claims 50, 51, 55, 56, 60, and 61 dependent therefrom. Because the above-discussed issue is dispositive as to the obviousness rejections of claims 49–51, 54–56, and 59–61, we do not reach additional issues raised by Appellants' arguments as to the rejections of claims 50, 55, 60 and 61.

*Rejection of Claims 52, 53, 57, and 58
under 35 U.S.C. § 103(a)*

The Examiner finds the combination of Hull, Barac, and Allard teaches an “information processing system discontinuing operation or processing of the electronic document when a user is logged into the information processing system, via which the electronic document is being accessed, and the user is not listed in the metadata [listing another user] read from the RFID tag,” as claimed in independent claim 52, and similarly recited in independent claim 57. (Final Act. 13–15.) Particularly, the Examiner finds Hull teaches an RFID tag listing at least one user. (Ans. 24 (citing Hull ¶ 38).) The Examiner also finds Allard teaches the claimed “discontinuing operation or processing of the electronic document” because Allard discloses “a smart card with an RFID tag used to access patient records,” such that “[w]hen . . . [a] physician scans the smart card to access [a patient's] medical information,” the physician “would have no access [to the patient's information] if the patient has not provisioned the physician” with access. (Ans. 24 (citing Allard ¶¶ 19–26).) We do not agree.

We agree with Appellants that Hull and Allard, alone or in combination, fail to teach or suggest “discontinuing operation or processing of the electronic document when a user is logged into the information processing system, via which the electronic document is being accessed, and

the user is not listed in the metadata read from the RFID tag.” (Reply Br. 23–24.) Rather, Allard controls access to electronic documents (e.g., patient records) by a PIN provided to a repository Web site of patient records. (App. Br. 42 (citing Allard ¶¶ 25–26).) The PIN controls access to the patient’s records by requiring a user (e.g., a physician) to provide the PIN (and scan a smartcard) to the repository, in order to “be granted access to the medical information of each patient that granted the physician access.” (See Allard ¶¶ 26–27; Reply Br. 24.) Allard provides no disclosure regarding an unauthorized user (such as a user not listed in an RFID tag’s metadata) being *already logged in* the patient’s repository *and accessing patient records*. (Reply Br. 24; App. Br. 42.) Rather, Allard blocks unauthorized users from logging in in the first place. (See Allard ¶¶ 18, 20.)

Thus, Allard does not teach or suggest discontinuing operation or processing of an electronic document when a user is logged into the system via which the electronic document is being accessed, and the user is not listed in a previously read RFID tag, as claimed. (App. Br. 41–42.) The Examiner also has not shown that Hull’s “ownership information” is an RFID tag’s metadata prompting to discontinue operation or processing of an electronic document, as claimed. (Ans. 24.) Additionally, the Examiner has not shown that the additional teachings of Barac make up for the above-noted deficiencies of Hull and Allard.

Thus, for the reasons set forth above, we do not sustain the Examiner’s rejection of independent claims 52 and 57 and claims 53 and 58 dependent therefrom.

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DECISION

The Examiner's rejections of claims 49–61 under 35 U.S.C. § 101 are reversed.

The Examiner's rejections of claims 49–61 under 35 U.S.C. § 103(a) are reversed.

REVERSED