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EXAMINER

GRANT, MICHAEL CHRISTOPHER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DOUG DOHRING, DAVID HENDRY,
STEPHANIE YOST, and JERRY CHIAWEI CHEN

Appeal 2017-003236
Application 14/704,877
Technology Center 3700

Before CHARLES N. GREENHUT, THOMAS F. SMEGAL, and
LISA M. GUIJT, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims
1–19. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

CLAIMED SUBJECT MATTER

The claims are directed to a language phoneme practice engine. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A computer-based language phoneme practice system comprising:
 - (a) a digital processing device comprising at least one processor, a memory, and an operating system configured to perform executable instructions; and
 - (b) a computer program, provided to said digital processing device, including executable instructions that create a language phoneme practice engine, wherein said engine comprises:
 - i. a taxonomy of phonemes of a target language;
 - ii. a software module for providing a first interface for practicing each said phoneme in said taxonomy, wherein said interface allows a learner to optionally access a visual representation and an auditory representation of each said phoneme in said taxonomy;
 - iii. a software module for providing a second interface for practicing each said phoneme in the context of the beginning, middle, and end of words of said target language, the interface providing one or more words beginning with the selected phoneme, one or more words with the selected phoneme in their middle, and one or more words ending with the selected phoneme, wherein the interface allows the learner to access a visual and auditory representation of each word, wherein each word is depicted as a composition of phonemes, wherein each phoneme in each word is interactive and allows the learner to access a visual and an auditory representation of each phoneme in each word; and
 - iv. a navigation element, wherein the navigation element allows the learner to navigate between the first interface and the second interface.

REJECTIONS

Claims 1–19 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to an abstract idea without significantly more.

Claims 1–19 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims of U.S. Patent No. 9,058,751. This rejection is not contested and, according to Appellants, rendered moot by the filing of the terminal disclaimer with the Reply Brief of Dec. 22, 2016. We leave final determination of the acceptability of the terminal disclaimer to the Examiner and summarily sustain this rejection without reaching the merits thereof. *See e.g. In re Berger*, 279 F.3d 975 (Fed. Cir. 2002) (in which the Board affirmed an uncontested rejection of claims under 35 U.S.C. § 112, second paragraph, and on appeal the Federal Circuit affirmed the Board’s decision and found that the appellant had waived his right to contest the indefiniteness rejection by not presenting arguments as to error in the rejection on appeal to the Board). *See also, Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir. 2008) (“the applicant can waive appeal of a ground of rejection”).

OPINION

Principles of Law

A patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101. The Supreme Court has consistently held that this provision contains an important implicit exception: laws of nature, natural phenomena, and abstract ideas are not patentable. *See Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014); *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (“Phenomena of nature, though just discovered, mental

processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.”). Notwithstanding that a law of nature or an abstract idea, by itself, is not patentable, an application of these concepts may be deserving of patent protection. *See Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293–94 (2012). In *Mayo*, the Court stated that “to transform an unpatentable law of nature into a patent-eligible *application* of such a law, one must do more than simply state the law of nature while adding the words ‘apply it.’” *Mayo*, 132 S. Ct. at 1294 (citation omitted).

In *Alice*, the Court reaffirmed the framework set forth previously in *Mayo* “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 the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are directed to a patent-ineligible concept, then the second step in the analysis 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*, 132 S. Ct. at 1298, 1297).

In *Gottschalk*, the Court, citing *O’Reilly v. Morse* (56 U.S. 62 (1853)), cautioned that a claim “so abstract and sweeping as to cover both known and unknown uses” is not directed to patent-eligible subject matter under 35 U.S.C. § 101. *Gottschalk v. Benson*, 409 US at 68. In *Alice* the Supreme Court reaffirmed this principle:

We have long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and

abstract ideas are not patentable. We have interpreted § 101 and its predecessors in light of this exception for more than 150 years. We have described the concern that drives this exclusionary principle as one of pre-emption. Laws of nature, natural phenomena, and abstract ideas are ‘the basic tools of scientific and technological work. [M]onopolization of those tools through the grant of a patent might tend to impede innovation more than it would tend to promote it, thereby thwarting the primary object of the patent laws. We have repeatedly emphasized this concern . . . that patent law not inhibit further discovery by improperly tying up the future use of these building blocks of human ingenuity.

Alice Corp. Pty. Ltd. v. CLS Bank Intern., 134 S. Ct. at 2354 (quotations and citations omitted).

Analysis

With representative claim 1 (*see* App. Br. 10–21; 37 C.F.R. § 41.50(c)(1)(iv)), Appellants seek to reserve exclusive rights to, in effect, any computer-based system for learning phonemes in isolation (module ii) or context (module iii). Final Act. 2. It cannot reasonably be argued that this is not, first, an attempt to reserve exclusive rights to an abstract idea, and second, an attempt to reserve exclusive rights to essentially any computer-based implementation of a notoriously old and fundamental tool or teaching method used by human beings for language learning.¹ Appellants take issue with the Examiner “strip[ing] away” other aspects of the claim. App. Br. 12;

¹ At the outset, we reject Appellants’ contention that the absence of a rejection under §§ 102 or 103(a) provides evidence that the claimed subject matter is neither generic nor conventional. App. Br. 19. The avoidance of piecemeal examination is merely a preferential examination practice. *See* MPEP § 707.07(g). How Examiners choose to allocate their time and resources is ultimately a procedural matter within the Examiner’s discretion. The absence of a prior-art rejection does not create any binding legal effect for purposes of an analysis under § 101.

Reply. Br. 13; Ans. 8. However, a careful examination of the remaining language in the claim reveals nothing more than generic and conventional steps and structures necessary for computerized implementation. Clearly the preamble and elements (a) and (b) contain no more than this. Examples are “computer-based,” “digital processing device,” “processor,” “memory,” “operating system,” and “executable instructions.” Limitation i amounts to a database, and limitation iv amounts to a mechanism to switch between different parts of the interface. It cannot reasonably be argued that the latter, essentially the only limitation integrating elements i–iii, makes the “ordered combination” something more than the sum of its parts. App. Br. 15–17. Element iv simply allows choosing between the particular mechanism to teach the phoneme. It cannot reasonably be argued that language tutors have not employed both isolated and contextual phoneme teaching methods but typically would not use both systems at the same time.

Limitation ii has a visual and auditory representation of the phoneme. It cannot reasonably be argued that this aspect, essentially a pronunciation key coupled with auditory assistance,² is not a notoriously old, generic, and fundamental tool used for language learning with or without a computer. The same is true of limitation iii which demonstrates these phonemes in context.³ The use of abstractions to claim broad generic objectives does not *improve* a technical field (App. Br. 17–18); it preempts improvements in it.

² For example, /a/ or /ay/ are used to visually represent or demonstrate the sound of the letter a (Spec. 11; Fig. 1) in the manner symbols such as a, ã and ei, ā are traditionally used.

³ For example a visual representation of map as /m/a/p/ and coupling it with a picture (Spec. 12–15; Fig. 2) is similar to how it might be described in a pronunciation key as mǎp or taught by sight or association to a child, respectively.

Appeal 2017-003236
Application 14/704,877

Claim 1 lacks any limitations directed to specific structures, techniques, or algorithms for providing the generic modules which cover fundamental human language learning tools. In other words, the claim lacks “significantly more.” *See Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S. Ct. at 2353.

Although we make the aforementioned points for emphasis, we agree that the Examiner has provided a thorough and comprehensive analysis of the issues raised by Appellants, and we therefore adopt the Examiner’s analysis in that regard (Ans. 3–17) as our own. *See, e.g., In re Paulsen*, 30 F. 3d 1475, 1478 n. 6 (Fed. Cir. 1994) *accord In re Cree*, No. 2015-1365 n. 2 (Fed. Cir. Mar. 21, 2016).

DECISION

The Examiner’s rejections are sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED