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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEVEN PAUL RUSSELL, GUY R. VANBUSKIRK,
and ANDREW W. KITTLER

Appeal 2017-003569
Application 13/739,504
Technology Center 3700

Before STEFAN STAICOVICI, WILLIAM A. CAPP, and
ANTHONY KNIGHT, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134(a) of the final rejection of claims 1–15 as directed to patent ineligible subject matter under 35 U.S.C. § 101.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ A prior art ground of rejection under 35 U.S.C. § 103(a) has been withdrawn by the Examiner. Ans. 5.

THE INVENTION

Appellants' invention relates to training, monitoring and mining communications in an observation platform. Spec. ¶ 27. Claim 1, reproduced below with paragraph indentation added, is illustrative of the subject matter on appeal.

1. A method for instruction and training in an observation platform, comprising:

receiving a signal from a first communication device at a second communication device associated with a computer system,

wherein a first characteristic of said signal corresponds to supplemental information useful for said instruction and said training,

wherein a second characteristic of said signal corresponds to information indicative of a geographic position of said first communication device,

wherein said supplemental information comprises user habits of a user associated with said first communication device

wherein said user habits comprise button presses and user activity associated with said first communication device,

wherein said first communication device is a mobile device;

determining a status of said user is available based on an analysis of said user habits and context information derived from a communication history of said user, at said computer system, based on said supplemental information and information sent from said first communication device to said second communication device; and

sending instructional information to said first communication device in response to a determination that said status of said user is available to receive said instructional information, wherein said instructional information is for use by said user in conjunction with said first communication device.

OPINION

Appellants argue claims 1–15 as a group. Appeal Br. 7–14. We select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Supreme Court has set forth “a framework 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) (citing *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 566 U.S. 66, 72–73 (2012)). According to the Supreme Court’s framework, we must first determine whether the claims at issue are directed to one of those concepts. *Id.* If so, we must secondly “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.* The Supreme Court characterizes the second step of the analysis as “a 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.* (brackets in original) (quoting *Mayo*, 566 U.S. at 72).

With respect to the first step, the Examiner determines that the claims are directed to an abstract idea.

The claims recite the steps directed to an instruction and training based on availability of trainee . . . the recited steps are similar to the judicial exception of “Comparing new and stored information and using rules to identify options” as the new supplemental information is analyzed with the context information and communication information and uses certain rules to identify options such as sending instructional information.

Final Action 2–3.

With respect to the second step of the *Alice/Mayo* analysis, the Examiner finds that the recitation of computer limitations amounts to mere instructions to implement the abstract idea on a computer. *Id.* at 3–4. The Examiner further finds that the computer components merely perform “generic computer functions.” *Id.* at 4. The Examiner concludes that “there is no inventive concept sufficient to transform the claimed subject matter into a patent-eligible application.” *Id.*

Appellants argue that claim 1 is not directed to an abstract idea. Appeal Br. 8. Appellants characterize the Examiner’s analysis as “conclusory” and fault the Examiner for citing a Federal Circuit case that is “non-precedential.” *Id.* at 8–9 (referring to *SmartGene, Inc. v Advanced Biological Labs.*, 555 Fed. Appx. 950 (Fed. Cir. 2014)).

In response, the Examiner points out that the *SmartGene* is merely one example of an abstract idea taken from the PTO’s July 2015 Interim Guidance on Subject Matter Eligibility. Ans. 10. The Examiner cites *Alice* as precedential legal authority to support the rejection. *Id.*

We agree with the Examiner’s position that the invention is directed to an abstract idea. The recited steps of receiving a signal, determining user status, and sending information to a user communication device is merely a method of organizing human activity. *See Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1313 (Fed. Cir. 2016) (the category of abstract ideas includes methods of organizing human activity); *see also Smart Systems Innovations, LLC v. Chicago Transit Authority*, 873 F.3d 1364, 1372 (Fed. Cir. 2017) (“claims directed to the collection, storage, and recognition of data are directed to an abstract idea”); *see also Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (claims for

collecting information, analyzing it, and displaying results thereof focus on an abstract idea).

With respect to step 2 of the *Mayo/Alice* analysis, Appellants argue that the claimed embodiments “do far more than merely implement an abstract idea on a computer.” Appeal Br. 12. Appellants argue that the claimed embodiments improve the relevant technical field. *Id.* According to Appellants, this is accomplished by “determining a status” of a user and “sending instructional information.” *Id.*

Appellants submit that the pertinent technology is an observation platform that encompasses computer systems, radio technology, and mobile device, that are employed for audible communication and training purposes. In other words, the present technology does not make improvements to a single generic computer system, but rather demonstrates a significant improvement to a variety of technological devices employed from communication and training.

Id. at 13–14.

In response, the Examiner points out that Appellants confuse step 1 with step 2 of the *Mayo/Alice* analysis framework. Ans. 13. The Examiner explains that Appellants’ claim limitations directed to “determining a status” and “sending information” are part of Appellants’ abstract idea under step 1 of the analysis. *Id.* The Examiner further explains that Appellants’ implementation of the abstract idea does not amount to “something more” under step 2 of the analysis as it merely relies on generic computer and telecommunications equipment performing generic computer and telecommunication functions. *Id.*

It is now well settled that mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.

See Alice, 134 S.Ct. at 2358. Thus, merely stating an abstract idea while adding the words “apply it” is not enough to confer patent eligibility. *Id.*

[I]f that were the end of the § 101 inquiry, an applicant could claim any principle of the physical or social sciences by reciting a computer system configured to implement the relevant concept.

Id. at 2359.

Under the second prong of the *Alice/Mayo* test, we have considered whether the claim elements, both individually and “as an ordered combination,” “transform the nature of the claim’ into a patent-eligible application.” *See Alice*, 134 S.Ct. at 2355. We are not persuaded that using a computer to determine user status and send instructional information satisfies the “significantly more” criteria under the second prong of *Alice/Mayo*. *Id.* at 2359. Essentially, all Appellants have done here is use generic computer data gathering, processing, and display technology to send instructional information to a user based on a determination of the user’s availability to receive it.² As in *Alice*, “each step does no more than require a generic computer to perform generic computer functions.” *Id.*

We have considered Appellants’ remaining arguments, including the preemption argument at page 14, and find them to be without merit. Although “the principle of preemption is the basis for the judicial exceptions to patentability,” and “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent

² In the instant case, some of the network data transmission occurs wirelessly. Spec. ¶ 42. However, in this modern era of wireless communication, we do not view of the use of wireless communication links as adding “something significantly more” to the computerized implementation of the abstract idea.

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eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice*, 134 S. Ct. at 2354). The Federal Circuit concluded that “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, . . . preemption concerns are fully addressed and made moot.” *Id.* Given this direction from our reviewing court, we decline to apply a preemption standard in our analysis, and instead apply the steps set forth by the Supreme Court in *Alice* and *Mayo*. Accordingly, for the foregoing reasons, we sustain the Examiner’s Section 101 rejection of claims 1–15.

DECISION

The decision of the Examiner to reject claims 1–15 is affirmed.

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