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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/909,267	06/04/2013	David George Thiele	201304783.01	8551

36738 7590 08/23/2018
ROGITZ & ASSOCIATES
4420 Hotel Circle Court
SUITE 230
SAN DIEGO, CA 92108

EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
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3625

NOTIFICATION DATE	DELIVERY MODE
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08/23/2018

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID GEORGE THIELE, MARVIN DeMERCHANT, DAVID
ANDREW YOUNG, and STEVEN FRIEDLANDER

Appeal 2017-004090
Application 13/909,267
Technology Center 3600

Before JOSEPH A. FISCHETTI, BIBHU R. MOHANTY, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–3, 5–8, and 21–36 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to smart shopping reminders while driving (Spec., page 1, line 3). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. Apparatus comprising:
 - at least one computer memory that is not a transitory signal and that comprises instructions executable by at least one processor for:
 - determining whether a user activity trigger satisfies a test, the activity trigger not being a user input to a wireless communication device (WCD) associated with the at least one processor;
 - responsive to a determination that the user activity trigger satisfies the test, presenting a shopping list on the WCD, the shopping list being derived at least in part by electronic images of products generated by a camera and/or electronically scanned bar codes of purchased products; and
 - responsive to a determination that the user activity trigger does not satisfy the test, not presenting the shopping list on the WCD, wherein the user activity trigger includes an establishment of communication between the WCD and a vehicle.

THE REJECTION

The following rejection is before us for review¹:

Claims 1–3, 5–8, and 21–36 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

¹ The rejections of claims 14–18 and 20 under 35 U.S.C. § 101 and 35 U.S.C. § 103(a) has been withdrawn as those claims have been cancelled (Ans. 6 and 8).

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence².

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellants argue that the rejection of claim 1 is improper because it is not directed to an abstract idea (App. Br. 3–6, Reply Br. 2–4). The Appellants also argue that the claim is “significantly more” than the alleged abstract idea (App. Br. 6, 7, Reply Br. 4–7).

In contrast, the Examiner has determined that the rejection is proper (Final Rej. 2–6, 13, Ans. 2–5, 13–24).

We agree with the Examiner. Under 35 U.S.C. § 101, 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 an implicit exception: “laws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In judging whether claim 1 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

² *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

claim is “directed to” a patent-ineligible abstract idea. If so, we then consider the elements of the 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 of the abstract idea. *Id.* 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.* The Court also stated that “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention”. *Id. at 2358.*

Here, we determine that the claim is directed to the concept of presenting a shopping list of items to a user based on data. This is a method of organizing human activities or a fundamental economic practice long prevalent in our system of commerce, and is an abstract idea beyond the scope of § 101. The Specification states that the invention is directed to smart shopping reminders while driving (Spec., page 1, line 3). See *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016) where collecting information, analyzing it, and displaying results from certain results of the collection and analysis was held to be an abstract idea.

We next consider whether additional elements of the claim, both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the abstract idea using generic computer components. We conclude that it does not. The Specification at pages 5–8 discloses using generic computer components in a conventional manner for their known functions.

Considering each of the claim elements in turn, the function performed by the computer system at each step of the process is purely conventional. Each step of the claimed method does no more than require a generic computer to perform a generic computer function.

“[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea ‘while adding the words ‘apply it’ is not enough for patent eligibility.” *Id.* at 2358 (quoting *Mayo*, 132 S. Ct. at 1294).

The Appellants at page 5 of the Appeal Brief have also cited to *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016) to show that the claim is not abstract but the claims in that case are not similar in scope to those here, and in contrast were directed to a self-referential data table. The Appellants cite to *DDR Holdings, LLC v. Hotels, L.P.*, 773 F. 3d 1245 (Fed. Cir. 2014) and argue that the claim is “rooted in computer technology” (App. Br. 5, Reply Br. 3, 4). We disagree as the Appellants have not shown how the claimed subject matter is rooted in technology given that the Specification describes only the use of generic computer equipment used in routine, conventional, and generic manner.

For these above reasons the rejection of claim 1 is sustained. The Appellants have presented the same arguments for the remaining claims which are drawn to similar subject matter and the rejection of these claims is sustained as well.

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CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1–3, 5–8, and 21–36 under 35 U.S.C. § 101.

DECISION

The Examiner’s rejection of claims 1–3, 5–8, and 21-36 is 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)(1)(iv).

AFFIRMED