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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ADAM S. HEWETT<sup>1</sup>

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Appeal 2017-004391  
Application 13/412,246  
Technology Center 3700

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Before GEORGE R. HOSKINS, BRANDON J. WARNER, and  
LEE L. STEPINA, *Administrative Patent Judges*.

STEPINA, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 1–6. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> Appellant's Appeal Brief lists Adam S. Hewett and Vitrepixel Holdings, LLC as the real parties in interest. Br. 3.

### CLAIMED SUBJECT MATTER

The claims are directed to a method for enhanced memorization and retention of consecutive text using spaced repetition, mnemonics, and adaptation to the user. Spec. ¶ 1. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method for enhanced memorization of a body of text, the method comprising the steps of:

dividing an entire body of text into at least two sub-parts using a microprocessor, wherein when the sub-parts are joined together they represent the entire body of text, wherein each sub-part comprises at least two words, and wherein the at least two subparts comprising a first sub-part and a second sub-part;

saving the sub-parts to a database;

associating a different mnemonic aid with each of the sub-parts;

in a user memorization module, serially presenting at least two sub-parts of text to a user for memorization, each sub-part comprising a problem indicator button for receiving input from the user regarding whether the user request help with the sub-part, the serial presenting controlled in real-time by commands from the user and permitting the user to progress backwards and forwards sequentially through the entire body of text without stopping;

applying an algorithm, using a microprocessor to determine whether additional sub-parts of text should be presented for memorization;

and, scheduling in the future at least one recall review session based on the algorithm results, the recall review session comprising at least two sub-parts in consecutive sequential order.

Br. 29–30 (Claims App.).

## REJECTION

Claims 1–6 are rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 2.

## OPINION

In *Alice*, the Supreme Court applied the framework set forth previously in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (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 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.” *Id.* If so, 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 1297).

### *Step 1*

The Examiner determined that claims 1–6 are directed to an abstract idea, namely, “dividing data and classifying it and determining options by applying rules to known data.” *See* Final Act. 3–5.

Appellant does not present arguments in relation to Step 1 of the *Alice* framework. *See* Br. 17–18. Specifically, in relation to the inquiry as to whether the claims are directed to an abstract idea, Appellant summarizes the steps recited in various claims and concludes, “the claim is directed to at least one exception.” *Id.* at 18.

*Step 2*

Appellant does not contend that any single element recited in the claims adds the kind of inventive concept that would transform the abstract idea into a patent-eligible invention. *See* Br. 18–19. Rather, Appellant’s argument focuses on whether the claimed elements, taken as an ordered combination, require something significantly more than the above-noted abstract idea. *Id.* at 19–27. In support of this argument, Appellant lists certain recitations of claims 1–3 and asserts that “[t]he totality of the steps [in claims 1–3] act in concert to *improve another technical field*, specifically the field of speech memorization, by controlling how quickly a user [is] presented with larger and larger blocks of text -- both in a real time and over time.” *Id.* at 19–20 (emphasis added).<sup>2</sup>

Appellant’s argument on this point is unavailing. We do not agree that an improvement in the field of speech memorization, on the facts of this case, is the kind of improvement that imparts patent eligibility. As Appellant acknowledges, “the claim limitations of performing repetitive calculations and comparisons could be performed by a human using mental steps or basic critical thinking, which are types of activities that have also been found by the courts to represent abstract ideas.” Br. 18. Appellant’s statement is consonant with the Specification, which states, “The present invention is an assisted learning method, and although many highly effective assisted learning methods exist, none have touched on a more effective way

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<sup>2</sup> Appellant does not indicate that this argument is intended to apply to any particular claim. *See* Br. 18–20. As neither claim 1 nor dependent claim 2 recites all the elements referred to by Appellant, we understand this argument to apply to claim 3, which depends from claim 2, and, thus, requires all the elements presented in this portion of Appellant’s argument.

to memorize large, consecutive bodies of text verbatim.” Spec. ¶ 2.  
Appellant provides no persuasive argument as to why such a process, as set forth in claims 1–6 and described in the Specification, qualifies as a “technical field” in the context of step 2 of the *Alice* test, and we do not think it is one. *See Alice*, 134 S. Ct. at 2359–60. Rather, the regimen for presenting text to a user set forth in claims 1–6 is similar, in concept, to the subject matter at issue in *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016) (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent-ineligible concept,” and explaining that the claims were not patent eligible because “[t]he advance they purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions”).

That the claims are for the stated purpose of enhancing memorization of a body of text does not change that the claims are directed to an abstract idea. As the Supreme Court has said, “if a claim is directed essentially to a method of calculating, [(here, for example, determining based on an algorithm)], even if the solution is for a specific purpose, the claimed method is nonstatutory.” *Parker v. Flook*, 437 U.S. 584, 595 (1978) (quoting *In re Richman*, 563 F.2d 1026, 1030 (CCPA 1977)). “The Supreme Court and this court have repeatedly made clear that merely limiting the field of use of the abstract idea to a particular existing technological environment does not render the claims any less abstract.” *Affinity Labs of Texas, LLC v. DirecTV, LLC*, 838 F.3d 1253, 1259 (Fed. Cir. 2016).

Appellant also contends, “the claimed steps taken as a combination effect a *transformation* of known parts into a specific solution. Thus, the claim amounts to significantly more than the use of mnemonic and spaced repetition.” Br. 20 (emphasis added).

To the extent Appellant asserts that the “claimed steps” result in a “transformation” under the “machine-or-transformation” test (*see In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008)), and the claims are therefore patent eligible, we disagree for the following reasons. Our reviewing court explained the machine-or-transformation test as follows, “[a] claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *Id.* The Supreme Court stated, although the machine-or-transformation test may be a useful and important clue or investigative tool, it is not the sole test for deciding whether an invention is a patent-eligible “process” under § 101. *Bilski v. Kappos*, 130 S. Ct. 3218, 3226–27 (2010). Thus, the machine-or-transformation test is helpful in the patent-eligibility analysis, but the outcome of this test is not necessarily dispositive of the patent-eligibility question.

Further, we do not agree with Appellant’s contention regarding the alleged *transformative* effect of “the claimed steps.” Br. 20. The beneficial result produced by the method recited in claims 1–6 is not the kind of transformation that imparts patent eligibility under the machine-or-transformation test because the claimed method does not physically *transform* anything. The fact that the recited method may provide an educational benefit or solution, as Appellant alleges, is not the same thing as a “transformation” under the machine-or-transformation test.

To the extent Appellant’s argument regarding the “transformation of known parts into a specific solution” (Br. 20) is intended to address the second step in the *Alice* analysis, we disagree with Appellant because the second step in this analysis is the “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. 2347, 2355 (quoting *Mayo*, 132 S. Ct. at 1294). The fact that the claimed method may provide a benefit or solution, as Appellant alleges, is a different question from whether the elements of the claim amount to significantly more than claiming the patent ineligible concept. We do not see the particular order of the recited method steps to be anything other than a conventional use of known computer equipment.

Appellant repeatedly quotes portions of the claims on appeal and asserts that the benefit provided by (or novelty of) the claimed subject matter renders the claims patent-eligible. *See* Br. 23–27 (quoting portions of claims 1, 2, and 6). For example, with respect to claim 1, Appellant states, “These three sub elements are significant because they allow a user to do something that that could not be done without this invention: practice a speech and note (in real time and without stopping) the places where the user struggled through the on-screen problem indicator 407.” *Id.* at 24 (emphasis omitted). As discussed above, we do not agree that the provision of a benefit, alone, imparts patent eligibility. As for the alleged novelty of the claimed subject matter, novelty and patent-eligibility are different inquiries. *See Mayo*, 132 S. Ct. 1289 at 1304; *see also Diamond v. Diehr*, 101 S. Ct. 1048, 1058 (1981) (“The ‘novelty’ of any element or steps in a process, or even of the

Appeal 2017-004391  
Application 13/412,246

process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.”). We have considered all of Appellant’s arguments regarding claims 1–6, but determine the Examiner has the better position. We sustain the Examiner’s rejection of claims 1–6 as being directed to patent-ineligible subject matter.

#### DECISION

The Examiner’s rejection of claims 1–6 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).

AFFIRMED