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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRYAN MARC FAILING

Appeal 2017-004852
Application 13/015,957
Technology Center 3600

Before CAROLYN D. THOMAS, KARA L. SZPONDOWSKI, and
MICHAEL J. ENGLE, *Administrative Patent Judges*.

ENGLE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 20–43, which are all of the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Technology

The application relates to “managing an energy transfer between a vehicle and an energy transfer system.” Spec. Title (capitalization omitted).

Illustrative Claim

Claim 20 is illustrative and reproduced below with certain limitations at issue emphasized:

20. A method of managing at least one transfer of energy, said method comprising:

determining a plurality of attributes associated with a transfer of energy between a vehicle and an energy transfer system;

determining a plurality of costs associated with said plurality of attributes;

determining a selection, input via a user interface, associated with at least one attribute of said plurality of attributes, wherein *said user interface includes a first listing of said plurality of attributes and a second listing of said plurality of costs*, and wherein each attribute of said first listing of said plurality of attributes corresponds to a respective cost of said second listing of said plurality of costs; and

generating a request to perform, in accordance with said at least one attribute, an energy transfer between said vehicle and said energy transfer system, and

wherein said generating is performed using a processor.

Rejections

Claims 20–43 stand rejected under 35 U.S.C. § 101 as being directed to ineligible subject matter. Final Act. 3.

Claims 20–43 stand rejected under 35 U.S.C. § 103(a) as obvious over Ambrosio et al. (US 2009/0313103 A1; Dec. 17, 2009). Final Act. 5.

ISSUES

1. Did the Examiner err in concluding that claims 20–43 were directed to ineligible subject matter without significantly more under § 101?
2. Did the Examiner err in finding Ambrosio teaches or suggests “said user interface includes a first listing of said plurality of attributes and a second listing of said plurality of costs,” as recited in claim 20?

ANALYSIS

§ 101

Section 101 defines patentable subject matter: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. The Supreme Court, however, has “long held that this provision contains an important implicit exception” that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012) (quotation omitted). “Eligibility under 35 U.S.C. § 101 is a question of law, based on underlying facts.” *SAP Am., Inc. v. InvestPic, LLC*, 890 F.3d 1016, 1020 (Fed. Cir. 2018). To determine patentable subject matter, the Supreme Court has set forth a two part test.

“First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts” of “laws of nature, natural phenomena, and abstract ideas.” *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). A court must be cognizant that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas” (*Mayo*, 566 U.S. at 71), and “describing the claims at . . . a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016). Instead, “the claims are considered in their entirety to ascertain whether their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

In the second step, we “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.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79, 78). The Supreme Court has “described step two of this 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.* (quotation omitted).

Here, the Examiner determines that “[t]he claimed invention is directed to managing energy transfer by selecting at least one energy transfer attribute, with each attribute having a corresponding cost; and generating a request to perform said energy transfer based on the selected attribute.”

Ans. 2. The Examiner explains that the “claimed invention could be performed in the human mind, or by a human using a pen and paper” because “the attributes and the corresponding costs can be determined from a piece of paper/book/human mind, and selection made from said paper/book/human mind.” *Id.* at 3. The Examiner analogizes to “determining the cost of repairing a vehicle part” using a “paper guide” with a “plurality of parts and their corresponding labor costs.” *Id.*

Appellant argues that the Examiner’s abstract idea relies on “several phrases which are not recited in the Claims,” such as “managing energy transfer” and “with each attribute having a corresponding cost.” Reply Br. 4; *see also* App. Br. 17–20. However, the Examiner’s abstract idea merely paraphrases certain claim language, and repeating claim language verbatim is not required. For example, in *Alice*, the Supreme Court condensed the entire abstract idea into the phrase “intermediated settlement,” even though

those express words never appeared in the claim. *Alice*, 134 S. Ct. at 2355. The same applies here. For example, claim 20 recites “each attribute of said first listing of said plurality of attributes corresponds to a respective cost of said second listing of said plurality of costs,” which the Examiner reasonably condensed to “each attribute having a corresponding cost.” Thus, we are not persuaded the Examiner erred in paraphrasing or summarizing the claim language.

Appellant also argues that a “user interface” and “processor” require “hardware and/or software, and therefore . . . cannot be performed in the human mind, or by a human using a pen and paper.” Reply Br. 5 (quotation omitted); App. Br. 20–21. We are not persuaded by Appellant’s argument. “[M]erely configuring generic computers in order to supplant and enhance an otherwise abstract manual process is precisely the sort of invention that the *Alice* Court deemed ineligible for patenting.” *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1057 (Fed. Cir. 2017) (quotation omitted). As the Supreme Court has said, “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 134 S. Ct. at 2358.

Instead, we agree with the Examiner that “with the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper.” *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1318 (Fed. Cir. 2016); *see also* Ans. 2. Other than a generic “processor” and “user interface,” the Examiner is correct in analogizing the present claims to a price list in the human mind or on paper. Ans. 3. A price list is a “listing of [a] plurality of attributes” and the “respective cost” of

each attribute. “[M]ere automation of manual processes using generic computers does not constitute a patentable improvement in computer technology.” *Credit Acceptance*, 859 F.3d at 1055; *see also Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324–25 (Fed. Cir. 2016) (“generic computer components such as an ‘interface,’ ‘network,’ and ‘database’ do not satisfy the inventive concept requirement”).

Further, limiting the field of use to an energy transfer to or from a vehicle does not render them patentable. “The Supreme Court and this court [i.e., the Federal Circuit] 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 recites nearly the entirety of the claim and asserts that it is significantly more, but that is an insufficient argument because it fails to explain *why* the claim recites significantly more than the abstract idea. *See* Reply Br. 9–10; App. Br. 23–24. As discussed above, the claim elements relied upon by Appellant either are part of the abstract idea (e.g., with minor paraphrasing) or are things that the Federal Circuit has held do not amount to significantly more (e.g., a processor).

For dependent claim 33, Appellant argues § 101 does not apply because that claim recites “performing said energy transfer using an interface between said vehicle and said energy transfer system.” App. Br. 25. But we agree with the Examiner that “[t]his is simply a post-solution activity” and “does not make it less abstract.” Ans. 4; *see also Diamond v. Diehr*, 450 U.S. 175, 191–92 (1981) (“Similarly, insignificant post-solution activity will not transform an unpatentable principle into a patentable

process.”). For example, nothing in claim 33 provides a technical solution for how the generic “interface” performs an energy transfer; it merely recites the desired result, which is the same next step one would have expected from “generating a request to perform . . . an energy transfer” in independent claim 20, from which claim 33 depends. *See RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1326 (Fed. Cir. 2017) (“The inquiry often is whether the claims are directed to ‘a specific means or method’ for improving technology or whether they are simply directed to an abstract end-result.”).

For the remaining dependent claims, Appellant argues the Examiner has not included any detailed discussion of each and every limitation. App. Br. 25–26. Yet Appellant also does not identify any particular limitation which adds significantly more than the abstract idea, whereas the Examiner has determined that “the dependent claims do not resolve the issues raised in the independent claim 20.” Ans. 4. The Federal Circuit has held that “[c]ourts may treat a claim as representative in certain situations, such as if the patentee does not present any meaningful argument for the distinctive significance of any claim limitations not found in the representative claim.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1365 (Fed. Cir. 2018). That is the case here.

Accordingly, we sustain the § 101 rejection of claims 20–43.

§ 103

Independent claims 20, 42, and 43 each recite “said user interface includes a first listing of said plurality of attributes and a second listing of said plurality of costs.”

The Examiner finds that “Ambrosio teaches different costs for different attributes,” such as “the night price of electricity (attribute 1) as 9

cents, and the noon time price of electricity (attribute 2) as 15 cents.” Ans. 4 (citing Ambrosio ¶ 95). Thus, we agree with the Examiner that Ambrosio teaches a plurality of attributes and a plurality of costs.

Nevertheless, we agree with Appellant that the Examiner fails to show Ambrosio teaches or suggest a user interface that includes *listings* of the plurality of attributes and respective costs. App. Br. 35–38. The Examiner points to paragraph 36 of Ambrosio as disclosing “[e]lectric vehicle 116 and charging station 118 send and receive data associated with . . . the price of electricity received from a power grid . . . and/or any other data relevant to charging or de-charging electric vehicle 116.” Ans. 4–5. The Examiner then states “[t]his is considered to include the lists of said attributes and their corresponding costs.” *Id.* at 5. However, even if “price” were considered plural rather than singular, this would merely disclose *sending* and *receiving* multiple prices, not necessarily *displaying* or *listing* multiple prices (i.e., “said user interface includes a first listing . . .”). The Examiner has given no further explanation why it would have been obvious for Ambrosio’s user interface to include the claimed listings.

Accordingly, we reverse the § 103 rejection of independent claims 20, 42, and 43, and their dependent claims 21–41.

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DECISION

For the reasons above, we affirm the Examiner's decision rejecting claims 20–43 under § 101, but we reverse the Examiner's decision rejecting claims 20–43 under § 103.

Because we affirm at least one rejection for every appealed claim, we designate this Decision as an affirmance.

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. § 41.50(f).

AFFIRMED