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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DIAA HOSNY and SAMIR AHMAD

Appeal 2017-004855
Application 12/467,516¹
Technology Center 2800

Before KAREN M. HASTINGS, BRIAN D. RANGE, and
MERRELL C. CASHION JR., *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants request our review under 35 U.S.C. § 134 of the Final Rejection of claims 1–3 and 5–19 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Honeywell International, Inc. is identified as the real party in interest. Appeal Br. 3.

THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for initiating bearing failure-condition actions for a turbocharger, comprising the steps conducted by a control system apparatus of:

a) establishing present indicia of off-axis rotor motion of a turbocharger rotor based upon a signal from a sensor, wherein the sensor is configured for sensing information about off-axis rotor motion of the turbocharger rotor;

b) if the present indicia of off-axis rotor motion indicate a rotor bearing failure condition has occurred from among a set of one or more rotor bearing failure conditions, initiating a rotor bearing failure-condition action; and

c) unless the rotor bearing failure condition is a final rotor bearing failure condition, selecting a new and different interval of time until indicia of off-axis rotor motion will again be established, and repeating steps (a) through (c) after that new and different interval of time has passed, wherein the new and different interval of time is selected based upon the present indicia of off-axis rotor motion.

Appeal Br. 10 (Claims Appendix).

ANALYSIS

The rejection under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Alice Corp. Pty. Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014), identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under § 101.

According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an

abstract idea. *Alice*, 134 S. Ct. at 2355. In that regard, the Examiner determined that the claims are directed to determining bearing failure condition actions by establishing an indicia of bearing health for a turbocharger and concluded that the subject matter of the claims is directed to the judicial exception of abstract ideas. Final Act. 4–6.

The Appellants challenge the Examiner’s articulation of what the claims are directed to, but the challenge is unfounded. *See* Appeal Br. 6–8. For example, the fact that the claims are drafted to include repeating the steps at a new and different time interval to allow the bearing to operate closer to its failure condition is not dispositive. The question is what the claims are “directed to.”

[T]he “directed to” inquiry applies a stage-one filter to claims, considered in light of the specification, based on 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); *see Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1375, 2016 WL 1393573, at *5 (Fed. Cir. 2016) (inquiring into “the focus of the claimed advance over the prior art”).

Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1335 (Fed. Cir. 2016). “The ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas v. DirectTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)). “In determining the eligibility of respondents’ claimed process for patent protection under § 101, their claims must be considered as a whole.” *Diamond v. Diehr*, 450 U.S. 175, 188 (1981).

As set out in the Background section of Appellants' Specification, it was known to detect a bearing condition so as to allow for corrective measures to be taken to avoid catastrophic failure. The claims are directed to establishing a number representative of bearing health. "These indicia may be in a variety of formats, and could be as simple as a single numerical rating (i.e., the indicia could be a single indicium." (Spec. ¶ 47). The claims repeat sensing/inspection of the bearing health using this indicia.

Accordingly, the claims as a whole, in light of the Specification, are directed to monitoring bearing health by establishing an indicia indicative thereof, which is consistent with the Examiner's position (Final Act. 5–7). There appears to be no dispute that establishing the indicia is an abstract idea (Appeal Br. 7, admitting the process "might involve abstract ideas, but [the steps] are far more than that").

Step two is "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.'" *Alice*, 134 S. Ct. at 2355 (alteration in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)). In this regard, the Examiner determined that, generically linking the use of a judicial exception to a particular technological environment or field of use is insufficient; sensing, processing and comparing data and repeating is likewise insufficient to qualify as significantly more (Final Action 6), and finally "nothing of the steps add unconventional steps that confine the claim to a particular useful application other than what is well-understood" (Final Action 7; *see also* Ans. 3, 4). The claims employ

conventional devices (control system apparatus, sensor, turbocharger, processing device (claim 7)) for their common functions.

The Specification supports the view that said device/system are conventional. (*See, e.g.*, Spec. ¶¶ 32, 34, 35). *Cf. Alice*, 134 S. Ct. 2358 (citation omitted). “[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.*

The Appellants further argue that the present invention is not simply data gathering because the method “improves turbocharger functionality (by extending its life)” (Reply Br. 5), similar to the claims in *Enfish* which were held to improve computer functionality (*id.*). A preponderance of the evidence supports the Examiner’s position that Appellants’ mere assertion that the claims generically improve turbocharger operation is not meaningful, as “initiating a rotor bearing failure–condition action” as recited in claim 1 does not specifically explain the use of the derived result/indicia to improve the machine functionality (e.g., Ans. 3; Final Action 3). Indeed, the Specification explains that initiating this action may mean merely “signaling an engine operator of the failure condition.” Spec. 2:14–17. Telling an operator that failure is imminent does not, in itself, improve the turbocharger’s functionality.

For the foregoing reasons, the Appellants have not shown error in the Examiner’s *Alice* step two determination that the claims do not include an

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element or combination of elements sufficient to ensure that in practice they amount to significantly more than to be upon the ineligible concept itself.

The remaining arguments have been carefully considered but are unpersuasive as to error in the rejection.

The rejection of claims 1–3 and 5–19 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is sustained.

DECISION

The decision of the Examiner to reject claims 1–3 and 5-19 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