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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOZEF HABDANK and
KRISTIAN LOEKKEGAARD

Appeal 2017-007043
Application 14/132,968¹
Technology Center 2400

Before IRVIN E. BRANCH, JOSEPH P. LENTIVECH, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

BRANCH, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1, 3–9, 11, and 13–21, 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 scheduling network scanning tasks and modifying the execution frequency based on the results of the scanning. Spec. Abstract.

¹ According to Appellants, the real party in interest is Camelot UK Bidco Limited. App. Br. 2.

Illustrative Claim

Claim 1 is illustrative and reproduced below with the limitations at issue emphasized:

1. A computer-implemented method for dynamically scheduling network scanning tasks, the method comprising:

receiving an identification of a scanning task associated with an electronic item that is accessible via a network;

scheduling, using a processor, the scanning task to be repeatedly executed according to an execution frequency, wherein the execution frequency corresponds to a time interval between each execution of the scanning task;

receiving a first set of scan results generated by a first execution, at a first execution time, of the scanning task, the first set of scan results comprising information associated with a first set of detected activities associated with the electronic item;

receiving a second set of scan results generated by a second execution, at a second execution time, of the scanning task, the second set of scan results comprising information associated with a second set of detected activities associated with the electronic item;

comparing the first and second sets of scan results, wherein the information associated with the first and second sets of detected activities associated with the electronic item comprises a first set of network identifiers and a second set of network identifiers, respectively; and

in response to determining that the second set of network identifiers contains network identifiers not included in the first set of network identifiers, increasing the execution frequency.

Rejections

Claims 1, 3–9, 11, and 13–21 stand rejected under 35 U.S.C. § 101 because the claims are directed to patent ineligible subject matter. Final Act. 3–4.

Claim 3 stands rejected under 35 U.S.C. § 112(a) as lacking enablement. Final Act. 4.

Claims 1, 3–9, 11, and 13–21 stand rejected under 35 U.S.C. § 112(a) for failing to comply with the written description requirement and under 35 U.S.C. § 112(b) as being indefinite. Final Act. 5.

Claims 1, 3–6, 8, 18, 19, and 21 stand rejected under 35 U.S.C. § 103 as unpatentable over the combination of BitTorrent (“Measuring the BitTorrent Ecosystem: Techniques, Tips, and Tricks,” Kryczka, September, 2011) and Shah (US 2006/0182115 A1; published Aug. 17, 2006). Final Act. 6–10.

Claims 7 and 20 stand rejected under 35 U.S.C. § 103 as unpatentable over BitTorrent, Shah, and Gutiérrez (US 2010/0257051 A1; published Oct. 7, 2010). Final Act. 10–11.

ANALYSIS

The 35 U.S.C. § 101 Rejection

Section 101 defines patent-eligible subject matter as “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101. The Supreme Court has “long held that this provision contains an important implicit exception[:]
Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013) (internal brackets omitted) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012)).

To distinguish “patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts,” the Supreme Court has set up an analytical framework. *Alice*

Corp. v. CLS Bank Int'l, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo*, 566 U.S. at 71–73). In the first step of the analysis, we determine whether the claims at issue are “directed to” a judicial exception, such as an abstract idea. *Alice*, 134 S. Ct. at 2355. If not, the inquiry ends. *Thales Visionix Inc. v. U.S.*, 850 F.3d 1343, 1346 (Fed. Cir. 2017); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016). If the claims are determined to be directed to an abstract idea, then we consider under step two whether the claims contain an “inventive concept” sufficient to “transform the nature of the claim into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quotations and citation omitted).

Noting that the two stages involve “overlapping scrutiny of the content of the claims,” the Federal Circuit has described “the first-stage inquiry” as “looking at the ‘focus’ of the claims, their ‘character as a whole,’” and “the second-stage inquiry (where reached)” as “looking more precisely at what the claim elements add—specifically, whether, in the Supreme Court’s terms, they identify an ‘inventive concept’ in the application of the ineligible matter to which (by assumption at stage two) the claim is directed.” *Electric Power Grp, LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). In considering whether a claim is directed to an abstract idea, we acknowledge, as did the Court in *Mayo*, 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. We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that in itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish*, 822 F.3d at 1336.

Step One: Whether the Claims Are Directed to a Patent-Ineligible Concept (Abstract Idea)

Claim 1 is directed to scheduling network scanning tasks that includes scanning a network for electronic items, gathering results, including network identifiers, and changing the frequency of the tasks based on results of scans. Independent claim 18 recites similar subject matter. Other claims specify information to be scanned (e.g., claim 7 searches for “a uniform resource locator linking to [an] electronic item”), the type of network (e.g., claim 6 scans “the Internet”), and/or a specific methodology for changing the scan frequency (e.g., claims 9, 11, 13, 14, and/or 16 recite statistically analyzing the results to determine “swarm size” and “device identifiers included in [a] list of previously captured network identifiers”). The Examiner concludes that the claims are directed towards the “abstract idea” of “comparing new and stored information and using rules to identify options.” Ans. 6. We agree, and adopt the Examiner’s findings as our own.

Appellants raise several arguments challenging the Examiner’s conclusion that the claims are directed to an abstract idea. *See* App. Br. 6–9. We are not persuaded by Appellants’ arguments for the reasons stated by the Examiner (Ans. 5–11). We do not find Appellants to have persuasively rebutted (*see* Reply Br. 2–3) the Examiner’s conclusion that the claims are directed to the abstract idea of “comparing new and stored information and using rules to identify options.” Contrary to Appellants’ contention (*id.* at 3), we find the claims here similar to those the Federal Circuit has found ineligible in *SmartGene, Inc. v Advanced Biological Labs.*, 555 Fed. Appx. 950 (Fed. Cir. 2014).

Accordingly, because we agree with the Examiner, at step one of the *Alice* analysis, that the claims are directed to an abstract idea, we turn to the second step of the *Alice* analysis, in which we must determine whether the additional elements of the claims transform them into patent-eligible subject matter.

Step Two: Whether Additional Elements Transform the Abstract Idea Into Patent-Eligible Subject Matter

The Examiner finds that the claims do not amount to significantly more than the abstract idea. Ans. 12–16. In particular, the Examiner finds it is conventional “to respond to piracy by performing scans to identify infringers to take legal action against them, and it is entirely conventional to perform scans on a scheduled basis and to modify that schedule in response to information that motivates one to want a different scan schedule.” *Id.* at 12. We agree with and adopt the Examiner’s conclusion that the claims do not include limitations that amount to “significantly more,” such that the abstract idea becomes patent eligible.

We have reviewed Appellants’ rebuttal to the Examiner’s findings that the Examiner’s assertions are not supported by a preponderance of the evidence of record and/or are presented for the first time in the Examiner’s Answer. Reply Br. 3–4. Appellants do not persuasively rebut the Examiner’s findings and conclusion. To the extent Appellants argue error because the newly-presented material amounts to an undesignated new ground of rejection, Appellants waived the right to petition to have the material designated a new ground upon filing a Reply Brief. *See* 37 C.F.R. § 41.40. The alleged new grounds of rejection are properly before us for consideration.

Accordingly, for the foregoing reasons, we are not persuaded the Examiner erred in rejecting all pending claims as directed to patent ineligible subject matter.

The Enablement Rejection of Claim 3

Claim 3 recites “wherein the first set of detected activities associated with the electronic item comprises instances of legally unauthorized access of electronic items via the network.” The Examiner rejects claim 3 under 35 U.S.C. § 112(a), finding that claim 3 “fails to find any enabling support in the specification for teaching one of skill in the art how to code determining legally unauthorized access to a work.” Final Act. 4.

Appellants contend that the Examiner’s rejection of claim 3 based on enablement is reversible because “the Examiner failed to consider the *Wands* factors.” Reply Br. 4 (referring to *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988)).

We are unpersuaded of error at least because Appellants do not point to – and we do not find – the required enabling disclosure in Appellants’ Specification for coding a computer to detect instances of legally unauthorized access.

Should further prosecution of the presently-pending claim ensue, the Examiner might also consider whether claim 3 is unpatentable under 35 U.S.C. § 112(b) as indefinite because the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

See Morton Int’l, Inc. v. Cardinal Chem. Co., 5 F.3d 1464, 1470, (Fed. Cir. 1993).

*The Rejections of Claims 1, 3–9, 11, and 13–21 Under
35 U.S.C. §§ 112(a) and (b)*

We are persuaded of error, and we do not sustain, the Examiner’s rejections of claims 1, 3–9, 11, and 13–21 under 35 U.S.C. § 112(a) for failing to comply with the written description requirement and § 112(b) for the reasons stated by Appellants. In particular, on this record, we do not find an adequate explanation for the basis of these rejections.

The Obviousness Rejection

The Examiner finds BitTorrent discloses all elements of claim 1, except that “BitTorrent does not explicitly teach scheduling.” Final Act. 6–7. The Examiner finds Shah discloses scheduling and the combination of BitTorrent and Shah discloses “in response to determining that the second set of network identifiers contains network identifiers not included in the first set of network identifiers, increasing the execution frequency.” *Id.* at 7–8. The Examiner concludes that “[i]t would have been obvious to an artisan of ordinary skill at the time of Applicant’s invention to combine the method of BitTorrent with the schedule in order to perform scans on a regular basis.” *Id.* at 8.

Appellants argue error in the Examiner’s obviousness rejection as follows: “Because Shah scans less frequently when Shah identifies a problem, Shah cannot be interpreted to teach the claimed increase in execution frequency.” App. Br. 19; *see* Reply Br. 6. Appellants also argue error because Shah is non-analogous art. App. Br. 20–21; *see* Reply Br. 6–7.

We are unpersuaded of error based on Appellants’ argument that Shah scans less frequently when Shah identifies a problem. *See* App. Br. 19.

Appellants do not persuasively rebut that Shah discloses a “dynamic” scanning interval that “increases when reachability events are rapidly received and it decreases when the time between received events increases.” Shah ¶ 5.

We also are unpersuaded of error based on Appellants’ assertion that Shah is non-analogous art. *See* App. Br. 20–21. Our reviewing court has set forth a two-prong test for determining whether a prior art reference is analogous: (1) whether the reference is from the same field of endeavor as the claimed invention, and (2) if the reference is not within the same field of endeavor, whether the reference is reasonably pertinent to the particular problem with which the inventor is involved. *In re Klein*, 647 F.3d 1343 (Fed. Cir. 2011). The Examiner finds that Shah’s disclosure of “scanning techniques” is reasonably pertinent to Appellants’ particular problem. Ans. 32. Appellants do not provide sufficient persuasive argument or evidence to convince us that either Shah does not disclose scanning techniques or that scanning techniques would not have been at least reasonably pertinent to Appellants’ problem. Accordingly, even if Shah were found not to be from Appellants’ field of endeavor, we are persuaded that Shah is analogous art because it meets at least the second prong of the analogous art test. *Klein*, 647 F.3d at 1343.

In view of the foregoing, we are unpersuaded of error in the Examiner’s obviousness rejection of claim 1 and of claims 3–6, 8, 18, 19, and 21, argued collectively. *See* App. Br. 18–21. Because Appellants do not present arguments for claims 7 and 20, we also affirm the Examiner’s rejection of these claims.

CONCLUSION

We affirm the Examiner's rejection of claims 1, 3–9, 11, and 13–21 under 35 U.S.C. § 101.

We affirm the Examiner's rejection of claim 3 under 35 U.S.C. § 112(a) as lacking enablement.

We reverse the Examiner's rejections of claims 1, 3–9, 11, and 13–21 under 35 U.S.C. §§ 112(a) and (b) as being indefinite and failing to comply with the written description requirement.

We affirm the Examiner's rejections of claims 1, 3–8, 18, and 19–21 as obvious under 35 U.S.C. § 103.

DECISION

Because all pending claims stand rejected under at least one ground, we affirm the Examiner's decision that claims 1, 3–9, 11, and 13–21 are unpatentable.

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