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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* JOHN E. YOPP and CHARLES T. PILON

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Appeal 2017-007076  
Application 13/738,231  
Technology Center 3600

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Before MARC S. HOFF, JUSTIN BUSCH, and JASON M. REPKO,  
*Administrative Patent Judges.*

BUSCH, *Administrative Patent Judge.*

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellants appeal from the Examiner’s decision to reject claims 1–20, which constitute all the claims pending in this application. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b). We affirm and enter a new ground of rejection.

CLAIMED SUBJECT MATTER

Appellants’ claimed invention relates to a computer system and method for a guided walkthrough of a retail store. Spec. ¶ 1. The system determines a “representative path” based on previous paths taken by a set of customers (i.e., a “customer segment”) and provides instructions that guide a

user along the representative path. Spec. ¶ 4. According to Appellants' Specification, the user following the guided walkthrough may be affiliated with the retail store, in which case the user may use the system to understand how a customer in a particular customer segment walks through, shops in, and views the store. Spec. ¶¶ 17, 21, 57. Claims 1, 8, and 15 are independent claims. Claim 8 is reproduced below:

8. A method for providing a guided walkthrough of a retail store to a user, the method comprising:

receiving by a processor at least one criteria, wherein the at least one criteria defines a customer segment, and the customer segment corresponds to a set of customers of the store;

determining by the processor a representative path, wherein the representative path is determined based upon paths previously taken through the store by the set of customers of the customer segment using an indoor tracking system; and

transmitting instructions by the processor to a portable viewing device to guide the user along the representative path to simulate shopping at the store from a perspective of one of the customers from the set of customers;

wherein determining the representative path comprises merging a plurality of paths previously taken through the store by each customer of the set of customers;

wherein the set of customers represent a particular demographic of all customers of the retail store, and the simulated shopping is from the perspective of a customer within the demographic;

wherein the simulated shopping comprises instructions to pause along the path that represents a pause from the previously taken paths, and the simulated shopping comprises providing sales data of a product for the particular demographic as the user progresses through the store along the path.

#### REJECTIONS

Claims 1–20 stand rejected under 35 U.S.C. § 101 as being directed to ineligible subject matter. Final Act. 5–7.

Claims 1, 4, 8, 11, 15, and 18 stand rejected under 35 U.S.C. § 112 failing to comply with the written description requirement. Final Act. 8–9.

Claims 1, 2, 4, 6–9, 11, 13–16, 18, and 20 stand rejected under 35 U.S.C. § 103 as obvious in view of Curlander (US 2012/0239504 A1; Sept. 20, 2012), Busche (US 2003/0055707 A1; Mar. 20, 2003), and Figueroa (US 2011/0225068 A1; Sept. 15, 2011). Final Act. 10–22.

Claims 3, 10, and 17 stand rejected under 35 U.S.C. § 103 as obvious in view of Curlander, Busche, Figueroa, and Otto (US 2009/0125394 A1; May 14, 2009). Final Act. 22–25.<sup>1</sup>

Claims 5, 12, and 19 stand rejected under 35 U.S.C. § 103 as obvious in view of Curlander, Busche, Figueroa, and Kurtti (US 2010/0145608 A1; June 10, 2010). Final Act. 25–27.

#### ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments that the Examiner erred. In reaching this decision, we have considered all evidence presented and all arguments Appellants made. Arguments Appellants could have made, but chose not to make in the Briefs, are deemed waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

#### THE 35 U.S.C. § 101 REJECTION

The Examiner concludes claims 1–20 are directed to judicially excepted subject matter. Final Act. 5–7; Ans. 3–5. Appellants argue the § 101 rejection of all claims as a group. *See* App. Br. 3–8; Reply Br. 2–3.

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<sup>1</sup> The section heading for this rejection incorrectly identifies the rejection as being based on Curlander, Busche, Figueroa, and Kurtti. Final Act. 22. The body of the rejection, however, correctly identifies Otto as teaching certain limitations. *See* Final Act. 23–24. We consider this typographical mistake to be harmless error.

We select independent claim 8 as representative and decide the appeal of the § 101 rejection based on claim 8. *See* 37 C.F.R. § 41.37(c)(1)(iv).

*Appellants' Arguments*

Appellants assert the Examiner failed to present a prima facie case that the claims are directed to an abstract idea. *See* App. Br. 4–6; Reply Br. 2–3. Specifically, Appellants initially contend “it is unclear what the Examiner alleges is the abstract idea.” App. Br. 5. Appellants, however, acknowledge that the Examiner identified the abstract idea as “steps for data acquisition, data manipulation, and data processing,” and then argue “this alleged abstract idea has no relationship to what is recited in the claims.” App. Br. 5. Appellants argue that the Examiner did not identify cases in which the courts determined such concepts were abstract ideas. App. Br. 5; Reply Br. 2–3. Appellants also assert the Examiner failed to identify cases in which a court determined a concept similar to “providing a guided walkthrough of a retail store” was abstract. App. Br. 5. Appellants argue the claims cannot be done mentally or on paper because they include certain limitations that cannot be performed manually. App. Br. 5. Finally, Appellants argue the Examiner has not demonstrated the claims are directed to an abstract idea because the Examiner failed to provide evidence that Appellants’ claimed functionality was previously performed manually or using a computer. App. Br. 6 (citing *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016)).

Appellants also argue the Examiner failed to consider the claimed elements in combination, which amount to significantly more. App. Br. 6–7. In particular, Appellants assert (1) using an “indoor tracking system” to determine a representative path, (2) guiding a user along the representative

path using a portable viewing device, and (3) providing data during the guided path, when considered in combination, amount to significantly more than the abstract idea. App. Br. 7 (citing *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016)).

Appellants also argue the claims are patent-eligible because the claims do not preempt an abstract idea. App. Br. 8 (citing *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014); *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 85 (2012)). Specifically, Appellants argue the claims are limited to a specific process and “do not preempt all systems and methods for performing the alleged abstract idea, even if the Examiner clearly had identified an abstract idea.” App. Br. 8 (citing *McRO*, 837 F.3d at 1316).

#### *Prima Facie Case*

Many of Appellants' arguments address whether the Examiner properly identified the abstract idea or came to the correct conclusion about whether the claim elements recite significantly more than the abstract idea rather than whether the Examiner presented a prima facie case of patent-ineligibility. *See, e.g.*, App. Br. 4–6; Reply Br. 2–3. To the extent Appellants' arguments assert the Examiner failed to present a prima facie case, we disagree.

The Federal Circuit has repeatedly noted that “the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). The court has, thus, held that the U.S. Patent and Trademark Office (USPTO) carries its

procedural burden of establishing a prima facie case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011). Thus, all that is required of the Office is that it set forth the statutory basis of the rejection, and the reference or references relied on, in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. *Id.*; *see also Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (Section 132 “is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

The Examiner’s rejection, as discussed further below, presents a prima facie case by identifying that Appellants’ claims are directed to particular concepts, which the Examiner explains are similar to abstract ideas courts have found ineligible, and explains why the additional elements do not amount to significantly more than the abstract idea (e.g., “*generally* and *generically* recited ‘indoor tracking system’” and “portable viewing device” are used for extra-solution activities of acquiring or viewing data to implement the idea). *See* Final Act. 2–3, 5–7; Ans. 3–5. Thus, the Examiner: set forth the statutory basis for the rejection, namely 35 U.S.C. § 101; concluded that the claimed invention is directed to a judicial exception to § 101, namely an abstract idea; and, contrary to Appellants’ contention, explained and analyzed the rejection in sufficient detail to permit Appellants to respond meaningfully. *See Jung*, 637 F.3d at 1362.

The Examiner notified Appellants of the reasons for the rejection “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.”

35 U.S.C. § 132. In doing so, the Examiner set forth a prima facie case of ineligibility.

*Step One of Alice Framework*

In step one of the *Alice* analysis, we “determine whether the claims at issue are directed to” a patent-ineligible concept, such as an abstract idea. *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347, 2354–55 (2014). The Examiner determines the claims are directed to “providing a guided walkthrough of a retail store,” which merely involves steps for data acquisition, processing and reporting. Final Act. 2–3, 6–7; Ans. 3–4. The Examiner concludes that the claims, therefore, are directed to an abstract idea (i.e., an idea of itself and a process that, other than generically recited computer elements, can be performed mentally or on paper) of organizing, storing, and transmitting information. Final Act. 2–3, 6–7; Ans. 3 (citing *Cyberfone Sys., LLC v. CNN Interactive Grp., Inc.*, 558 F. App’x 988 (Fed. Cir. 2014)). The Examiner explains the three steps (i.e., the receiving, determining, and transmitting steps) recited in claim 1, commensurately recited in claim 8, could be performed mentally or on paper, and that claim 1 simply uses general purpose computer components (i.e., an “indoor tracking system” and a “portable viewing device”) to execute the steps. Ans. 4.

We agree with the Examiner’s conclusions because representative claim 8 focuses on receiving, selecting, and displaying information. In particular, claim 8 recites collecting data (previous customer path information and criteria that defines a customer segment representative of a

particular demographic), processing it (merging the prior paths taken to determine a representative path), and transmitting (and implicitly displaying or presenting) data (instructions to follow the representative path). Although claim 8 recites a “processor” to perform the receiving, determining, and transmitting steps, a “portable viewing device” to which instructions are transmitted, and an “indoor tracking system”<sup>2</sup> used to track customer paths, these elements do not change the character of claim 8 as a whole.

The Federal Circuit has concluded similar concepts were directed to abstract ideas. Specifically, in *Electric Power Group*, the Federal Circuit concluded claims reciting a method of collecting data from various sources, “detecting and analyzing events” by identifying information in the received data, reporting the event analysis results and visualizations of measurements, aggregating the event analysis information, and providing a composite indicator were directed to an abstract idea because the claims were directed to “collecting information, analyzing it, and displaying certain results of the collection and analysis.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1351–53 (Fed. Cir. 2016).

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<sup>2</sup> Appellants’ claims simply recite “using an indoor tracking system,” but do not recite how the “indoor tracking system” is used. *See* App. Br. 21 (claim 8). Based on the Specification, we presume Appellants’ intend the claim to require using the indoor tracking system to track customer routes taken through the retail store. *See* Spec. ¶ 33 (“Wireless access points (202, 203, and 204) in one embodiment are part of a system for providing indoor location functionality that tracks the position of mobile devices or smartphones, such as a ‘Micro-Location’ system from NearBuy Systems.”); *see generally* Spec. ¶¶ 31–44 (discussing tracking users walking through a store). For purposes of our analysis of Appellants’ claims under 35 U.S.C. § 101, we treat the claims as reciting the use of the indoor tracking system to track customer paths taken through the retail store.

Similarly, the Federal Circuit concluded that claims directed to collecting and analyzing information and presenting the results were ineligible as claiming no more than an abstract idea. *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347 (Fed. Cir. 2014); *see also Smart Sys. Innovations, LLC v. Chicago Transit Auth.*, 873 F.3d 1364, 1372 (Fed. Cir. 2017) (concluding “claims directed to the collection, storage, and recognition of data are directed to an abstract idea”); *SAP Am., Inc. v. InvestPIC, LLC*, 898 F.3d 1161, 1167 (Fed. Cir. 2018) (“merely presenting the results of abstract processes of collecting and analyzing information . . . is abstract as an ancillary part of such collection and analysis”) (quotations omitted).

Moreover, limiting the particular data analyzed does not change the character of the claim. *See Elec. Power*, 830 F.3d at 1353 (stating that “collecting information, including when limited to particular content (which does not change its character as information)” is treated as “within the realm of abstract ideas”). Thus, the particular instructions transmitted to the user that guide the user along the representative path (instructions to pause and sales data for products) do not change the character of claim 8.

Furthermore, and despite the recitation of a processor, indoor tracking system, and portable viewing device, we agree with the Examiner that claim 8 is directed to a process that can be done mentally or with pen and paper. The Federal Circuit has concluded mental processes, *even when performed by a computer*, are ineligible abstract ideas. Specifically, the Federal Circuit explained that “purely mental processes can be unpatentable, even when performed by a computer.” *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375–76 (Fed. Cir. 2011). The claims in *CyberSource*

recited steps for verifying credit card transactions over the Internet. *CyberSource*, 654 F.3d at 1370. The Federal Circuit agreed with the district court that the claimed method “simply requires one to ‘obtain and compare intangible data pertinent to business risks.’” *CyberSource*, 654 F.3d at 1370 (quoting *CyberSource Corp. v. Retail Decisions, Inc.*, 620 F.Supp.2d 1068, 1078 (N.D. Cal. Mar. 27, 2009)). The Federal Circuit also determined a computer-implementation of essentially the same method claiming a mental process was ineligible. *CyberSource*, 654 F.3d at 1375 (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*.”).

We agree with the Examiner that claim 8 is directed to an abstract idea and, thus, turn to step 2 of the *Alice* analysis.

*Step Two of Alice Framework*

In step two of our *Alice* analysis, we determine whether the *additional* limitations, when considered both “individually and ‘as an ordered combination’” contain an “inventive concept” sufficient to transform the claimed “abstract idea” into a patent-eligible application. *Alice*, 134 S. Ct. at 2355–58.

The Examiner concludes the recited limitations are all just steps for data acquisition, processing, and reporting, which do not add significantly more to the abstract idea. Final Act. 2, 7. In other words, the Examiner concludes the claims recite only elements that are part of the abstract idea and does not recite additional elements. Final Act. 2. The Examiner also explains that the recited “indoor tracking system” and “portable viewing device” are generically and generally recited computer hardware used to acquire and output data, which is simply insignificant extra-solution activity.

Final Act. 2–3 (citing Spec. ¶¶ 31, 34); Ans. 4. The Examiner concludes the dependent claims simply recite additional steps, or further refinement of the already recited steps, of data acquisition, processing, and reporting. Final Act. 7. The Examiner concludes the claims, therefore, do not amount to significantly more because the claims: require only a generic computer to perform generic, well-understood, routine, and conventional computer functions (i.e., acquiring, processing, and reporting data is old and well known); do not recite an improvement to another technology or technical field; and are not rooted in computer technology. Final Act. 2, 7; Ans. 4.

As mentioned above, Appellants assert the recited “indoor tracking system,” using that system to determine a representative path, guiding a user along the representative path using a portable viewing device, and providing data during the guided path, when considered in combination, amount to significantly more than the abstract idea. App. Br. 7 (citing *BASCOM*, 827 F.3d at 1348). Appellants’ argument is unavailing. Reply Br. 4–6. Notably, unlike the claims in *BASCOM*, claim 8 does not require any particular configuration of components. Nor have Appellants persuasively explained how the particular combination of steps (acquiring data using the indoor tracking system, processing that data to determine a representative path, and transmitting data to a portable viewing device) amounts to significantly more than the abstract idea itself.

An inventive concept “cannot be furnished by the unpatentable law of nature (or natural phenomenon or abstract idea) itself.” *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016); *see also Alice*, 134 S. Ct. at 2355 (explaining that, after determining a claim is directed to a judicial exception, “we then ask, ‘[w]hat else is there in the claims before

us?” (emphasis added, brackets in original) (quoting *Mayo*, 566 U.S. at 78)). Instead, an “inventive concept” is furnished by an element or combination of elements that is recited in the claim *in addition to* the judicial exception and sufficient to ensure the claim as a whole amounts to significantly more than the judicial exception itself. *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 566 U.S. at 72–73); see *BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018) (explaining that the Supreme Court in *Alice* “only assessed whether the claim limitations *other than the invention’s use of the ineligible concept* to which it was directed were well-understood, routine and conventional,” (emphasis added)).

On the other hand, “[i]f a claim’s only ‘inventive concept’ is the application of an abstract idea using conventional and well-understood techniques, the claim has not been transformed into a patent-eligible application of an abstract idea.” *BSG Tech*, 899 F.3d at 1290–91 (citing *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1370 (Fed. Cir. 2018)). “[I]t is irrelevant whether [the claimed abstract idea] may have been non-routine or unconventional as a factual matter . . . narrowing or reformulating an abstract idea does not add ‘significantly more’ to it.” *BSG Tech*, 899 F.3d at 1291.

The only components recited in claim 8 are an “indoor tracking system” used to collect previous path data, a “portable viewing device” that receives the transmitted instructions, and a processor that performs the receiving, determining, and transmitting steps. However, as stated by the Examiner, both the tracking system and viewing device are generally and generically recited, and Appellants’ Specification suggests that these are well-known elements being used as intended. See Spec. ¶¶ 33, 47, 50

(disclosing the tracking system can be the Micro-Location system from NearBuy Systems), 41 (disclosing the viewing device can be a smartphone), Figs. 2, 5. The processor that performs the steps is also generically and generally recited and Appellants do not argue the processor executing the method steps provides an inventive concept. In other words, claim 8 invokes computers merely as a tool to implement an abstract idea for analyzing and presenting information in a particular way. *See BSG Tech*, 899 F.3d at 1286. Simply using generic computing devices is not “an improvement in computers as tools,” like those claims found patent-eligible. *Elec. Power*, 830 F.3d at 1354.

Appellants do not persuasively explain how or why the particular arrangement (or the recited ordered combination) amounts to “significantly more” sufficient to render the claimed abstract idea patent-eligible subject matter. Claim 8’s steps relating to acquiring, processing, and reporting the data are the steps that comprise the abstract idea itself and, therefore, are insufficient to provide an inventive concept that would render claim 8 patent-eligible.

Moreover, simply using a generic computer to automate a process does not confer eligibility onto an otherwise abstract idea because it does not improve a computer or technology, but rather improves the process itself. *See Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (explaining that the claimed steps could easily “be carried out in existing computers long in use, no new machinery being necessary”); *CyberSource*, 654 F.3d at 1375–76 (explaining that “purely mental processes can be unpatentable, even when performed by a computer”); *see also Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015) (“[O]ur precedent is

clear that merely adding computer functionality to increase the speed or efficiency of the process does not confer patent eligibility on an otherwise abstract idea.”). Thus, claim 8’s mere recitation of an indoor tracking system and a portable viewing device neither changes claim 8’s character (as discussed above) nor confers patent-eligibility.

Finally, Appellants contend claim 8 is not directed to an abstract idea because it does not pre-empt all ways of providing guided walkthroughs of a store. App. Br. 8. We disagree that this demonstrates patent eligibility in this case. Claim 8 limits the identified abstract idea only by limiting the type of information acquired, processed, and reported. Moreover, although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility. . . . Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP Techs. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“And [the fact] that the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do[es] not make them any less abstract.”).

Thus, the claimed limitations, considered both individually and together, do not add significantly more to the abstract idea and, therefore, do not render the subject matter patent eligible.

*Summary*

For the above reasons, Appellants have not persuaded us the Examiner erred in rejecting claims 1–20 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

NEW GROUND OF REJECTION OF CLAIM 15

*Construction*

Claim 15 recites “a determining module that determines a representative path.”<sup>3</sup> Even though claim 15 recites a “module,” rather than a “means,” we construe this limitation as a means-plus-function limitation because the recited “determining module” would not be “understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure” that is capable of carrying out the recited functions. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015) (en banc) (citing *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1584 (Fed. Cir. 1996)). More specifically, the presumption against applying 35 U.S.C. § 112, sixth paragraph, is overcome because the claim merely “recites ‘function without reciting sufficient structure for performing that function.’” *Williamson*, 792 F.3d at 1348 (quoting *Watts v. XL Sys., Inc.*, 232 F.3d 877, 880 (Fed. Cir. 2000)).

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<sup>3</sup> Although claim 15 also recites “a first transmitting module that transmits instructions to a portable viewing device,” we do not treat this limitation as a means-plus-function limitation for purposes of this Decision because the only function recited is transmitting information—a function which, on its face, appears to be a basic function such that a person of ordinary skill in the art would have understood the “transmitting module” to provide sufficient structure for that function. Should claim 15 undergo further prosecution, we leave to the Examiner and Appellants to further explore whether this limitation is a means-plus-function limitation.

As in *Williamson*, the claims here do not recite the term “means,” but “the [determining module] limitation is drafted in the same format as a traditional means-plus-function limitation, and merely replaces the term ‘means’ with ‘nonce’ word ‘module,’ thereby connoting a generic ‘black box’ for performing the recited computer-implemented functions.”

*Williamson*, 792 F.3d at 1350. The term “module” in this context is used as a generic term tantamount to reciting a means because “module” provides no indication of the structure necessary to perform the recited functions.

Similarly, the prefix “determination” provides one of ordinary skill in the art no insight on the structure necessary to perform the recited functions. Here, as in *Williamson*, even if one of ordinary skill in the art would be capable of programming a computer to perform the recited functions, it is not sufficient to create the structure not otherwise disclosed. *Williamson*, 792 F.3d at 1351.

The Specification’s disclosure that the system may be implemented using “software modules that provide functionality when executed by processor 22” suggests the modules may simply be software executing on generic computer components, which, without specific programming, are not capable of performing each of the recited functions. Spec. ¶ 25; *see Williamson*, 792 F.3d at 1350–51 (finding the presumption against invoking § 112, sixth paragraph, is overcome because the recitation of a “distributed learning control module” connotes insufficient structure for carrying out the recited functions). The Specification provides no explanation or support for implementing the determining module other than in software. *See* Spec. ¶ 25. Claim 15’s “determining module” “recites ‘function without reciting sufficient structure for performing that function,’” because Appellants’

system is unable to perform the recited function without specific programming. *Williamson*, 792 F.3d at 1349 (quoting *Watts*, 232 F.3d at 880).

Because claim 15 recites a “determining module,” which is merely a substitute for the phrase “means for,” associated with functional language, claim 15 invokes 35 U.S.C. § 112, sixth paragraph.

#### *Indefiniteness*

Given that the determining module is a means-plus-function limitation, we look to Appellants’ Specification to determine whether there is sufficient structure to support the recited functions in claim 15 and, in particular, “determin[ing] a representative path,” which “comprises merging a plurality of paths previously taken through the store by each customer of the set of customers.” The Specification describes determining a representative path only in functional terms. We see nothing in the Specification describing any structure for the recited determining module.

For software means-plus-function limitations, the Federal Circuit has held that corresponding structure may be sufficiently disclosed in the form of an algorithm. *Aristocrat Techs. Austl. Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008); *WMS Gaming, Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1348 (Fed. Cir. 1999) (“A general purpose computer, or microprocessor, programmed to carry out an algorithm creates ‘a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.’” (quoting *In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994))). Nevertheless, the Examiner finds the Specification does not provide any algorithm or flowchart to support the

claimed elements and Appellants do not dispute that finding. *See* Reply Br. 3 (arguing “a specific flowchart or algorithm is not required to satisfy 35 U.S.C. §112(a), first paragraph”). Moreover, we do not see, nor have Appellants pointed to, any structure in the Specification sufficient to perform at least the determining function.

For the above reasons, we enter a new ground of rejection of claim 15 as being unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 16–20 depend from claim 15 and, therefore, also are indefinite under 35 U.S.C. § 112, second paragraph, and we enter a new ground of rejection of claims 16–20 on this basis. Because we determine claim 15 is indefinite, determining the necessary structure required by claim 15 would require speculative assumptions. Therefore, we reverse the Examiner’s rejection of claim 15 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. *Cf. In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (determining a prior art rejection cannot be sustained if a person of ordinary skill in the art would have to make speculative assumptions concerning the meaning of claim language). Claim 15 recites commensurate functional limitations to claims 1 and 8. Thus, if we did not construe claim 15 under 35 U.S.C. § 112, sixth paragraph, we would treat the rejection of claim 15 under 35 U.S.C. § 112, first paragraph, the same as we treat the rejection of claims 1 and 8 under 35 U.S.C. § 112, first paragraph, discussed below.

THE 35 U.S.C. § 112 REJECTIONS

*Rejection of Claims 1 and 8*

The Examiner rejects claims 1, 8, and 15<sup>4</sup> under 35 U.S.C. § 112 for failing to comply with the written description requirement. Final Act. 8–9; Ans. 6–7. Specifically, the Examiner finds Appellants’ Specification does not provide written description support for “determining a representative path . . . wherein determining the representative path comprises merging a plurality of paths previously taken through the store by each customer of the set of customers,” as recited in each of the independent claims. Final Act. 8–9. The Examiner finds Appellants’ Specification does not disclose how to determine a representative path or how to merge paths in sufficient detail to clearly define “what kind of processes ‘merging’ would involve.” Final Act. 9; Ans. 6–7. The Examiner finds the Specification provides insufficient information (e.g., steps, flowcharts, algorithms) describing how to determine representative paths and how customer paths are merged. Ans. 6–7 (citing MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) § 2161.01). Specifically, the Examiner finds that, although paragraph 52 “states that paths are merged for” three customers “into a single blended path,” the Specification fails to provide an explanation of the steps necessary to merge or blend the paths. Ans. 7.

Appellants argue no flowchart or algorithm is necessary to satisfy 35 U.S.C. § 112 because the relevant question is whether the written description describes the claimed invention in sufficient detail such that an

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<sup>4</sup> As explained in the prior section, we do not address the Examiner’s rejection of claim 8 as failing to comply with the written description requirement because we newly reject claim 8 as indefinite.

ordinarily skilled artisan could reasonably conclude the inventor possessed the claimed invention. App. Br. 10 (citing MPEP § 2163(I)); Reply Br. 3. Appellants assert the Specification supports the determining a representative path and merging paths steps recited in the claims 1, 8, and 15. App. Br. 9–11 (citing Spec. ¶¶ 47–51).

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact. *Regents of Univ. of Cal. v. Eli Lilly and Co.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997) (citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)). The Examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976). The Federal Circuit has explained the test for written description support as follows:

[T]he test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.

....

... Thus, we have recognized that determining whether a patent complies with the written description requirement will necessarily vary depending on the context. *Capon v. Eshhar*, 418 F.3d 1349, 1357–58 (Fed. Cir. 2005). Specifically, the level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology. *Id.* For generic claims, we have set forth a number of factors for evaluating the adequacy of the disclosure, including “the existing knowledge in the particular field, the extent and content of the

prior art, the maturity of the science or technology, [and] the predictability of the aspect at issue.” *Id.* at 1359.

*See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (brackets in original).

Thus, as Appellants argue, the question before us is whether a person of ordinary skill in the art reviewing the Specification objectively would have considered the inventor to have invented the subject matter of claim 1, including the recited determining step. In the pending obviousness rejections, the Examiner cites prior art references that Appellants acknowledge disclose “merging paths and determining a most popular path.” App. Br. 10 (citing Final Act. 11, 25; Kurtti ¶ 15; Busch ¶¶ 59–60).

The Specification discloses that “[g]uided walkthrough server 504 . . . automatically identifies representative paths taken by representative customers for a given store.” Spec. ¶ 48. The Specification describes storing customer routes through a store as a collection of coordinates taken at certain intervals and stored with a customer identification, date, and time. Spec. ¶ 48. The Specification discloses “[u]sing configurable location precision to allow for close paths to be deemed similar” to calculate “the most ‘popular’ route of a combination of coordinate-to-coordinate segments” and identifying a representative path, which may involve one or a combination of: using the most popular route, “a path chosen of a single customer who has the most route segments that match the most popular route,” or “both single and merged customer paths” weighted based on certain factors. Spec. ¶ 48.

The Specification also discloses that “in one embodiment, upon receiving the criteria for determining the representative path, a server may merge paths of customers meeting the criteria of the filter into a single

blended path.” Spec. ¶ 51; *see also* Spec. ¶ 52 (“At 704, one embodiment merges paths of different customers who meet the criteria of the filter.”). Within the context of these disclosed embodiments, the Specification then discloses selecting a “best fit” path as “the one customer path that is most representative of the blended path.” Spec. ¶¶ 51–52.

Appellants’ disclosure and the cited prior art indicates the technology of determining and merging paths was relatively advanced and that a person of ordinary skill in the art would have known what Appellants’ recited determining steps encompassed. When a claim limitation involves elements that were “well known as of the filing date, the inventors” need not describe the details of the known aspects. *See EnOcean GmbH v. Face Int’l Corp.*, 742 F.3d 955, 961 (Fed. Cir. 2014) (citing *Webster Loom Co. v. Higgins*, 105 U.S. 580, 586 (1881)); *see also Webster Loom*, 105 U.S. at 586 (“That which is common and well known is as if it were written out in the patent and delineated in the drawings”). “This enables patents to remain concise statements of what is new, not cumbersome repetitions of what is already known and readily provided by reference.” *EnOcean*, 742 F.3d at 961–62 (quoting *Pressure Prods. Med. Supplies, Inc. v. Greatbatch Ltd.*, 599 F.3d 1308, 1324 (Fed. Cir. 2010)).

Thus, we agree with Appellants that their Specification provides sufficient support for the determining step recited in claims 1 and 8 to meet the written description requirement of 35 U.S.C. § 112.

#### *Rejection of Claims 4, 11, and 18*

The Examiner rejects claims 4, 11, and 18 under 35 U.S.C. § 112 for failing to comply with the written description requirement. Final Act. 9. Specifically, the Examiner finds Appellants’ Specification does not provide

written description support for “providing stock-outs for products within a location of the store where the pause occurs,” as recited in claims 4, 11, and 18. Final Act. 9. The Examiner also finds the Specification identifies “two kinds of ‘pauses’”—either stopping playback of the instructions that guide a user through the store or “a user pause along a path.” Ans. 8 (citing Spec. ¶¶ 26, 28). The Examiner states that the pause recited in claims 4, 11, and 18 must be interpreted as “a user pause along a path” based on the independent claims’ recitation that the “‘pause’ is based on ‘instructions to pause along the path.’” Ans. 8. The Examiner finds the Specification, therefore, discloses “that pauses that do not lead to sales may indicate stock-outs,” but does not disclose “providing stock-outs where pauses occur.” Final Act. 4 (citing Spec. ¶ 30), 9; Ans. 7–8 (“The disclosure never teaches instructions to pause, and then providing stock-outs in the location of the pause. The written description may teach providing stock-outs after a pause in playback, but not after a pause in the path.”).

Appellants argue the Specification clearly discloses providing turn-by-turn instructions, including an instruction to pause at points along a representative path where a customer paused along that path. App. Br. 11 (citing Spec. ¶ 26). Appellants also contend the Specification discloses pausing playback and activating a filter to show stock-outs for the area of the store in which the user is located. App. Br. 12 (citing Spec. ¶ 28).

We first look to the proper construction of claims 4, 11, and 18. Claim 4, for example, depends from claim 1. Claim 1 recites, in relevant part, “transmitting instructions to a portable viewing device to guide the user along the representative path . . . wherein the simulated shopping comprises instructions to pause along the path that represent *a pause* from the

previously taken paths.” Claim 4 also recites that “transmitting instructions to guide the user comprises providing stock-outs for products within a *location* of the store *where the pause occurs*.” Thus, claim 4 also defines claim 1’s step of “transmitting instructions” to include “providing stock-outs for products within a location of the store *where the pause occurs*.”

We agree with the Examiner that “the pause” recited in claim 4 refers back to claim 1’s “a pause from the previously taken paths.” The pause necessarily occurs prior to providing stock-outs because: “providing stock-outs” is part of the transmitting instructions step; the instructions guide the user along the recited representative path; and determining the representative path includes merging the paths previously taken. In other words, the recited pause in the previously taken paths must have occurred prior to determining the representative path (which is made up of the previously taken paths) that, in turn, necessarily occurs before transmitting instructions to guide the user along the representative path.

Claim 4, however, recites using the pause to identify the *location* of products for which the method provides stock-outs, not to identify a point in time at which the stock-outs are provided. Put another way, the “within a location of the store where the pause occurs” clause recited in claim 4 modifies the recited products and identifies the location of the products for which the method provides stock-outs (i.e., those products within the location where the pause occurred). Claim 4, therefore, simply adds the limitation that the transmitting instructions step includes providing stock-outs for the products at the identified location.

As Appellants argue, the Specification discloses providing “turn-by-turn instructions [that] may also instruct the user to pause at certain points

along the representative path.” Spec. ¶ 26. The Specification also discloses “[t]he pauses may correspond to pauses taken by a customer whose actions are represented by the representative path” and the guided walkthrough may provide business intelligence data “relate[d] to the visible items or store areas, as seen by the user.” Spec. ¶ 26. The Specification also discloses that a representative path may include lengthy pauses without purchases and a user may “activate a business intelligence filter to show stock-outs . . . for that area of the store.” Spec. ¶ 28. Given these disclosures and our construction of claim 4, we agree with Appellants that the Specification provides written description support for claims 4, 11, and 18.

For the above reasons, we are persuaded the Examiner erred in rejecting claims 4, 11, and 18 under 35 U.S.C. § 112 for failing to comply with the written description requirement.

THE 35 U.S.C. § 103 REJECTIONS

*Rejection of Claims 1, 2, 6–9, 13–16, and 20*

The Examiner finds the combination of Curlander, Busche, and Figueroa teaches or suggests every limitation recited in independent claims 1, 8, and 15. Final Act. 10–21. Of particular note, the Examiner finds: Curlander teaches or suggests “determining a representative path . . . based upon paths previously taken through the store by the set of customers” and “providing sales data of a product”; Busche teaches or suggests “merging a plurality of paths previously taken through the store by each customer of the set of customers” (“merging step”); and Figueroa teaches or suggests “the simulated shopping comprises instructions to pause along the path that represent a pause from the previously taken paths” (“pause limitation”). Final Act. 4–5 (citing Curlander ¶¶ 149–152; Busche ¶ 39), 10–13 (citing

Curlander ¶¶ 21, 35, 149–152, 163; Busche ¶¶ 59–60; Figueroa (claim 11)). The Examiner also provides a rationale for combining the cited teachings from Curlander, Busche, and Figueroa. Final Act. 11–12.

Appellants argue claims 1–3, 5–10, 12–17, 19, and 20 as a group. *See* App. Br. 12–16. Claims 3, 5, 10, 12, 17, and 19 stand rejected under different grounds than the rest of the claims. Appellants present a separate argument for claims 4, 11, and 18. We select independent claim 1 as the representative claim for claims 2, 6–9, 13–16, and 20, which stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv). We address claims 3–5, 10–12, and 17–19 in subsequent subsections.

Appellants assert the claimed invention’s purpose of simulating a shopping experience to glean insight into customer behavior differs from the prior art’s purpose of providing information while guiding a customer through an actual shopping experience. App. Br. 13–15. Appellants acknowledge that “Curlander discloses guiding a customer through a store through instructions,” but contend that Curlander’s instructions are “NOT from the perspective of a customer (i.e., simulating the shopping of a customer) based on ‘paths **previously** taken’, so it fails to disclose ‘simulated shopping’ from the perspective of a customer that is **not the current customer.**” App. Br. 14–15. Appellants also argue Curlander’s previous routes “are for the **SAME** shopper that the profile is being determined for.” Reply Br. 4.

The Examiner finds that Curlander teaches “shopping characteristics such as previous routes through the store are used to segment customers and suggest products or services and create a shopping list which in turn is used to propose a route.” Final Act. 10 (citing Curlander ¶¶ 21, 35, 149, 163);

Ans. 8–9. The Examiner finds Curlander, therefore, “uses history of previous customers to provide shopper assistance as claimed in the present claims.” Ans. 9.

We are not persuaded the Examiner erred. To the extent Appellants argue the different purposes of the prior art and the claimed invention confer patentability without identifying particular limitations the prior art allegedly fails to teach, such an argument does not identify error in the Examiner’s findings. Moreover, Appellants’ arguments that Curlander’s previous routes do not teach or suggest the determining step because Curlander’s previous routes are for the shopper being guided (i.e., the same shopper rather than different shoppers) is not commensurate with the scope of the claims. Nothing in the claims precludes the recited user from being one of the “customers from the set of customers.” Furthermore, claim 1’s recitation of guiding a user along a path “to simulate shopping” does not preclude the user from following that user’s own prior path(s) because the user is still guided along a prior path and is, therefore, “simulating” the prior shopping experience. Finally, we agree with the Examiner that Curlander teaches segmenting customers to suggest products to create a shopping list that, in turn, is used to create a route through a store; Appellants provide no persuasive argument to the contrary. *See* Curlander ¶¶ 21, 35, 149, 163; Final Act. 10. For these reasons, we disagree with Appellants that Curlander fails to teach the determining limitation recited in claim 1.

Appellants also argue Busche and Figueroa fail to cure Curlander’s deficiencies. App. Br. 15–16. Specifically, Appellants argue Busche’s “disclosure of generic ‘historical data’” does not teach the merging step because “the ‘historical data’ must be ‘a plurality of paths previously taken

through the store by each customer of the set of customers.” App. Br. 15. Appellants assert that, although Figueroa discloses instructions to stop at a certain location, Figueroa fails to teach or suggest its “determined stop is based on a stop on a path made by a previous customer.” App. Br. 16.

To the extent these arguments constitute an assertion that neither Busche nor Figueroa cures Curlander’s alleged deficiency with respect to teaching determining a representative path based on paths previously taken, these arguments are unpersuasive because, as discussed above, we agree with the Examiner that Curlander teaches determining a representative path based on paths previously taken and, therefore, is not deficient. To the extent these arguments constitute an assertion that Busche fails to teach or suggest “merging a plurality of paths previously taken through the store” and Figueroa fails to teach or suggest the pause limitation, we address such arguments below.

As already discussed above, the Examiner finds Curlander teaches or suggests “determining a representative path . . . *based upon paths previously taken.*” See Final Act. 10–11. The Examiner finds Busche teaches merging paths based on previous paths taken and finds the *combination* of Curlander and Busche teaches the merging step. See Final Act. 10–11 (citing Busche ¶¶ 59–60), 25. Similarly, the Examiner Curlander teaches or suggests providing instructions to guide a user along a route based on paths previously taken and Figueroa teaches or suggests displaying a route that includes a stop at merchandise in finding the *combination* of Curlander and Figueroa teaches the pause limitation. Final Act. 12. The Examiner provides a rationale for combining Busche and Figueroa with Curlander. Final Act. 11–12. Appellants argue neither Busche nor Figueroa cure the

deficiencies of Curlander. However, as discussed above, the Examiner's findings with respect to Curlander's teachings are not deficient. Thus, Appellants arguments do not persuade us that Busche, in combination with Curlander, fails to teach or suggest the merging step recited in claim 1 or that Figueroa, in combination with Curlander, fails to teach or suggest the pause limitation recited in claim 1.

For the above reasons, we are not persuaded the Examiner erred in rejecting representative claim 1 as obvious in view of the combination of Curlander, Busche, and Figueroa. For the same reasons, claims 2, 6–9, 13–16, and 20 fall with representative claim 1.

*Rejection of Claims 4, 11, and 18*

Appellants argue claims 4, 11, and 18 as a group. *See* App. Br. 16–17. We select claim 14 as the representative claim for claims 11 and 18, which stand or fall with claim 4. 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds the combination of Curlander, Busche, and Figueroa teaches or suggests every limitation recited in claims 4, 11, and 18. Final Act. 13, 17, 22. Of particular relevance to Appellants' arguments addressing the additional limitations recited in these claims, the Examiner finds Curlander teaches or suggests "providing stock-outs for products within a location of the store where the pause occurs" ("providing stock-outs step"), as recited in representative claim 4. Final Act. 13 (citing Curlander ¶ 79). The Examiner finds Curlander discloses providing in-stock quantities, which includes stock-outs (i.e., an in-stock quantity of zero). Final Act. 13; Ans. 10.

Appellants assert "a mere disclosure of inventory, in-stock quantity, etc., which are clearly known concepts, is not a disclosure of the inventive

functionality of” the providing stock-outs step. App. Br. 16. Appellants contend the recited providing stock-outs step provides a certain advantage not provided in Curlander. App. Br. 17 (citing Spec. ¶ 28). The Examiner finds Appellants’ alleged advantage is not recited in claims 4, 11, and 18. Ans. 10.

As the Examiner finds, Curlander discloses that its system includes information about products including an “In-stock quantity” of each product. Final Act. 13 (citing Curlander ¶ 79); *see* Curlander ¶ 89.<sup>5</sup> Curlander also discloses that its virtual shopping assistance system can access product information and the disclosed user interface can “display promotional information and other product information.” Curlander ¶¶ 34, 40–41. These disclosures teach, or at least suggest, displaying an in-stock quantity of a product, which would include a quantity of zero (i.e., a “stock-out”). Because Curlander suggests displaying a product’s in-stock quantity for products generally, Curlander also suggests displaying the quantity for products at locations where the recited pause occurs, as recited in the providing stock-outs step.

For the above reasons, we are not persuaded the Examiner erred in rejecting representative claim 4 as obvious in view of the combination of Curlander, Busche, and Figueroa. For the same reasons, claims 11 and 18 fall with representative claim 4.

*Rejections of Claims 3, 5, 10, 12, 17, and 19*

The Examiner finds the combination of Curlander, Busche, Figueroa, and Otto teaches or suggests every limitation recited in claims 3, 10, and 17.

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<sup>5</sup> The Examiner cites Curlander’s paragraph 79, but the “In-stock quantity” is actually disclosed in paragraph 89.

Final Act. 22–24. The Examiner finds the combination of Curlander, Busche, Figueroa, and Kurtti teaches or suggests every limitation recited in claims 5, 12, and 19. Final Act. 24–27. Appellants do not argue claims 3, 5, 10, 12, 17, and 19 separately with particularity. Thus, for the reasons discussed above, we are not persuaded the Examiner erred in rejecting claims 3, 10, and 17 as obvious in view of Curlander, Busche, Figueroa, and Otto or claims 5, 12, and 19 as obvious in view of Curlander, Busche, Figueroa, and Kurtti.

#### SUMMARY

We affirm the Examiner’s decision to reject claims 1–20 under 35 U.S.C. § 101.

We enter a new ground of rejection of claims 15–20 under 35 U.S.C. § 112, second paragraph.

We reverse the Examiner’s decision to reject claims 1, 4, 8, 11, 15, and 18 under 35 U.S.C. § 112, first paragraph.

We affirm the Examiner’s decision to reject claims 1–20 under 35 U.S.C. § 103.

#### DECISION

Because we affirm at least one ground of rejection with respect to each claim on appeal, the Examiner’s decision to reject claims 1–20 is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

We enter a new ground of rejection of claims 15–20 within our authority under 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new

ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

Section 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Patent Trial and Appeal Board for final action on the affirmed rejection, including any timely request for rehearing thereof.

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