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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN Y. WILKERSON

Appeal 2017-007411
Application 12/831,307
Technology Center 3600

Before BRETT C. MARTIN, LYNNE H. BROWNE, and
MICHELLE R. OSINSKI, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the rejection of claims 1–3, 8, 10, 14, 15, and 19–21. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm and enter a New Ground of Rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

CLAIMED SUBJECT MATTER

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A system comprising:
 - a processor configured to:
 - receive at least one digital communication including text in a body of the communication corresponding to a schedulable event;
 - identify the schedulable event in the text of the body of the communication;
 - query a user to determine if the schedulable event should be scheduled; and
 - responsive to user confirmation to the query, schedule the schedulable event.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Murray	US 2002/0068583 A1	June 6, 2002
Oral	US 2008/0140488 A1	June 12, 2008
Coughlin	US 2008/0167937 A1	July 10, 2008
Heinley	US 2008/0294663 A1	Nov. 27, 2008
Begeja	US 2012/0030713 A1	Feb. 2, 2012

REJECTIONS¹

- I. Claims 1, 10, 14, and 21 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

¹ The rejection of claims 1–3, 8, 10, 14, and 19–21 under 35 U.S.C. § 112, second paragraph as being indefinite was withdrawn by the Examiner. *See* Ans. 13.

- II. Claims 10, 14, 15, 19, and 20 stand rejected under 35 U.S.C. § 101.
- III. Claims 1, 2, 8, 10, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Coughlin, Oral, and Begeja.
- IV. Claims 3 and 19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Coughlin, Oral, Begeja, and Heinley.
- V. Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Coughlin, Oral, Begeja, and Murray.

DISCUSSION

Rejection I: Failure of Claims 1, 10, 14, and 21 to Comply with the Written Description Requirement

The Examiner determines that claims 1, 10, 14, and 21 fail to comply with the written description requirement because the “limitation ‘schedulable event’ . . . is not supported or described in the published specification.” Final Act. 4. In support of this determination, the Examiner finds that “[w]hile the published specification recites, in numerous paragraphs, the following terms and limitations: ‘unscheduled personal event;’ ‘previously scheduled personal events;’ ‘personal events pending for scheduling;’ ‘personal event that should be scheduled;’ ‘scheduled and unscheduled events,’ the published specification is silent on ‘schedulable event.’” *Id.*

The Examiner’s determination appears be premised on the idea that if the Specification does not provide antecedent basis for the claim terminology, it does not provide written descriptive support for that terminology. *See id.* The test for compliance with the written description requirement, however, does not require that the claims use the same

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terminology as the Specification. Rather, the test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (citations omitted).

In this case, as noted by Appellant, “the Examiner’s own definition proves that the specification provides adequate support for the term ‘schedulable event,’ through recitation of numerous examples of the same.” Appeal Br. 5. In other words, the events enumerated by the Examiner, such as personal events pending for scheduling, provide adequate evidence that Appellant had possession of the subject matter encompassed by the claim term “schedulable event” at the time of filing of the instant application. Accordingly, we do not sustain the Examiner’s decision rejecting claims 1, 10, and 21 as lacking written descriptive support on this basis.

Regarding claim 14, the Examiner relies on similar analysis to determine that:

While the published specification recites, in numerous paragraphs, the following terms and limitations: “triggers for identifying the unscheduled personal events;” “triggers found in the personal communications;” “triggers that may be used to trigger information handling logic of the manager 100 to be run ;” “triggers that may include, but are not limited to, keywords, names, phrases, abbreviations, various permutations of words, various permutations of syntax, numbers, phone numbers, time, acronyms, misspellings of words, and the like,” the published specification is silent on “a trigger predefined as indicating a schedulable event.”

Final Act. 4. The Examiner’s analysis is flawed for the reasons discussed *supra*. Accordingly, we do not sustain the Examiner’s further rejection of claim 14 as lacking written descriptive support.

*Rejection II: Failure of Claims 10, 14, 15, 19, and 20 to be
Directed to Patent-Eligible Subject Matter*

Appellant argues claims 10, 14, 15, 19, and 20 together. Appeal Br. 6–7. We select claim 10 as the representative claim, and claims 14, 15, 19, and 20 stand or fall with claim 10. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Supreme Court has set forth “a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l.*, 134 S.Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 132 S Ct. 1289, 1294 (2012)). According to the Supreme Court’s framework, we must first determine whether the claims at issue are directed to one of those concepts (i.e., laws of nature, natural phenomena, and abstract ideas). *Id.* If so, we must secondly “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.” *Id.* The Supreme Court characterizes the second step of the 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.*

The Examiner determines that claim 10 is directed to patent-ineligible subject matter. *See* Final Act. 6. Specifically, the Examiner determines that claim 10 claims a “method of organizing human activities (e.g., concepts relating to interpersonal and intrapersonal activities, such as managing relationships or transactions between people, social activities, and human behavior along with . . . managing human mental activity).” *Id.* The

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Examiner further determines that claim 10 claims an algorithm for identifying scheduling conflicts. *See id.* The Examiner explains that methods of organizing human activities and algorithms for identifying scheduling conflicts are abstract ideas. *See id.* at 6–7.

Having determined that claim 10 is directed to abstract ideas pertaining to the organization of human activities and identification of scheduling conflicts, the Examiner reviews claim 10 for limitations which “transform the claimed invention into more than an abstract idea.” Final Act. 7, emphasis added. Noting that “the claims repeatedly recite the element ‘a processor,’” the Examiner, nevertheless, determines that “this element comprises no more than [a] generic computer with its components that are performing generic computer functions that are well-understood, routine and conventional.” *Id.* Thus, the Examiner concludes that “the claimed generic computer does not amount to significantly more than Applicant’s algorithm.” *Id.* In other words, the Examiner determines that the limitations pertaining to the processor do not transform claim 10 such that it recites patent-eligible subject matter.

Appellant concedes that claim 10 is drawn to an abstract idea stating, “[s]ince the Examiner claims that the independent claim 10 relates to an abstract idea, the question of patent eligibility turns around whether or not ‘something more’ is included in the claims, that, when the claims are considered as a whole, provides sufficient basis for patentability.” Appeal Br. 6. Appellant contends that claim 10 represents “novel application of technology (obtaining the text corresponding to the event and scheduling it) in an atypical manner, [such that it passes] the ‘something more’ test.” *Id.*

Although the second step in the *Alice* analysis includes a search for an inventive concept, the analysis is not an evaluation of novelty or

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nonobviousness, but rather, a search for “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 (quoting *Mayo*, 132 S. Ct. at 1294). A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 132 S. Ct. at 1304. Further, “under the [*Alice*] framework, a claim directed to a newly discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the novelty of that discovery for the inventive concept necessary for patent eligibility.” *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016). Thus, Appellant’s argument that the claims are novel does not apprise us of error.

Accordingly, we sustain the Examiner’s decision rejecting claim 10, and claims 14, 15, 19, and 20 which fall therewith, as being directed to patent-ineligible subject matter.

*New Ground of Rejection of Claims 1–3, 8, and 21 as
Being Directed to Patent-Ineligible Subject Matter*

The subject matter of claims 1 and 21 is similar to the subject matter of claim 10 in that all of these claims are directed to the abstract idea of organizing human activities as discussed *supra*. Claims 1 and 21 do not recite additional elements which amount to significantly more than an attempt to patent the ineligible concept itself. Claim 1 merely includes the post solution activities of querying a user and responding to the user’s confirmation of the query, while claim 21 merely specifies that the processor used to implement the abstract idea be a vehicle computer.

For the reasons discussed *supra* with respect to claim 10, claims 1 and 21 are directed to patent-ineligible subject matter. Claims 2, 3, and 8 also do

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not amount to significantly more than an attempt to patent the ineligible concept set forth in claim 1. Accordingly, claims 2, 3, and 8 are also directed to patent-ineligible subject matter.

*Rejection III: Obviousness of Claims 1, 2, 8, 10, 20, and 21
Based on Coughlin, Oral, and Begeja*

The Examiner finds that Coughlin, Oral, and Begeja disclose or suggest all of the limitations of claim 1. *See* Final Act. 8–16. In particular, the Examiner finds that Begeja teaches “a natural language filter, filtering out any word not found in a directory of known words of one or more predetermined languages.” *Id.* at 14. The Examiner cites various portions of Begeja describing this filter. *See id.* at 14–15. In view of these portions of Begeja, the Examiner finds that:

the assignment of additional keyword attributes (e.g., keywords may be assigned to predetermined categories such as “current events”) and association of keywords in time (e.g., to identify overlap or proximity in time using start time and duration data) in the Begeja reference teach . . . identifying conflicting events in text of a digital communication

as required by claim 1. *Id.* at 15 (emphasis omitted). Based on these findings, the Examiner determines that it would have been obvious to apply and utilize “the steps, technique and features for the text recognition in digital communication and the assignment of additional keyword attributes . . . as taught by Begeja in order to improve accuracy of the automated processing, and to reduce the required amount of downstream processing.” *Id.* at 15–16 (citing Begeja ¶ 44).

Appellant contends that “[i]n all of the categories enumerated in Begeja, however, there is nothing remotely close to ‘identifying text corresponding to a schedulable event.’” Appeal Br. 7. In support of this contention, Appellant argues that “[s]ince Begeja is concerned with filtering words out of television or video media content, it is unclear what ‘a schedulable event’ would even be, and more importantly, what, exactly, the Examiner is alleging is the ‘body’ of the communication.” *Id.* Appellant further argues

When the communication is in text form, “body” is understood terminology. Applicant submits that there is no evidence, and it is certainly not common parlance, to refer to some portion of a media segment as “the body” of the segment nor would an image of, for example, a billboard in a video stream ever be called “text in the body of the communication.”

Id.

Responding to these arguments, the Examiner refers to numerous filters disclosed by Begeja. *See* Ans. 9–10. The Examiner, however, does not adequately explain how any of these filters pertain to schedulable events. *See id.* Further, the Examiner does not adequately explain why one skilled in the art would apply Begeja’s filters to schedulable events. Accordingly, Appellant’s argument is persuasive.

For these reasons, we do not sustain the Examiner’s decision rejecting claim 1 and claims 2, 8, 10, 20, and 21, which depend therefrom, as unpatentable over Coughlin, Oral, and Begeja.

Rejections IV and V: Obviousness of

Claims 3 and 19 Based on Coughlin, Oral, Begeja, and Heinley

Claims 14 and 15 Based on Coughlin, Oral Begeja, and Murray

The rejections of claims 3, 14, 15, and 19 rely on the same insufficient reasoning as the rejection of claim 1 discussed *supra*. Accordingly, we do not sustain the Examiner's decision rejecting these claims for the same reasons.

DECISION

The Examiner's rejection of claims 1, 10, 14, and 21 under 35 U.S.C. § 112, first paragraph is REVERSED.

The Examiner's rejection of claims 10, 14, 15, 19, and 20 under 35 U.S.C. § 101 is AFFIRMED.

The Examiner's rejections of claims 1–3, 8, 10, 14, 15, and 19–21 under 35 U.S.C. § 103(a) are REVERSED.

We enter a NEW GROUND OF REJECTION for claims 1–3, 8, and 21 under 35 U.S.C. § 101.

FINALITY OF DECISION

This decision contain a new ground of rejection pursuant to 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:

When the Board enters such a non-final decision, the Appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground 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. The new ground of rejection is binding upon the examiner unless an amendment or new

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Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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; 37 C.F.R. § 41.50(b)