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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TRAVIS M. GRIGSBY and SUNIL KUMAR MISHRA

Appeal 2017-007505¹
Application 12/131,084²
Technology Center 3600

Before NINA L. MEDLOCK, PHILIP J. HOFFMANN, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellants’ Appeal Brief (“App. Br.,” filed December 16, 2016) and Reply Brief (“Reply Br.,” filed April 11, 2017), and the Examiner’s Answer (“Ans.,” mailed March 9, 2017) and Final Office Action (“Final Act.,” mailed August 30, 2016).

² Appellants identify International Business Machines Corporation as the real party in interest. App. Br. 1.

CLAIMED INVENTION

Appellants' claimed invention "relates to customer experience with sales associates, and more particularly to assessing the personality and mood characteristics of a customer to enhance the customer's satisfaction with his/her shopping experience and improve the chances of a sale" (Spec. 1, ll. 5–8).

Claims 1, 7, 12, and 17 are the independent claims on appeal.

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

1. A method for enhancing customer satisfaction with his/her shopping experience and improving the chances of a sale, the method comprising:

capturing a facial image of a customer by a camera in a store;

comparing, by a customer relationship management unit, said captured facial image with a set of facial expressions stored in a database to associate said captured facial image with an emotional state;

analyzing, by said customer relationship management unit, said captured facial image to assess personality and mood characteristics of said customer; and

generating, by a processor of said customer relationship management unit, a report recommending a sales approach to obtain a sale from said customer, wherein said report is based on said analysis of said captured facial image.

REJECTIONS

Claims 1–20 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

Claims 1–20 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1–20 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter that Appellants regard as the invention.

ANALYSIS

Patent-Ineligible Subject Matter

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “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.*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78).

The Court acknowledged 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. Therefore, the Federal Circuit has instructed that claims are to be considered in their entirety to determine “whether their character as a whole is directed to excluded subject matter.” *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1312

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(Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

We are not persuaded, as an initial matter, by Appellants' argument that the Examiner has failed to perform a proper § 101 analysis (App. Br. 6). Appellants charge that the Examiner concludes that claims 1–20 are directed to an abstract idea simply because the independent claims include the terms “capturing,” “comparing,” and “analyzing,” without providing any articulated reasoning or legal analysis to support that conclusion, and that the Examiner has, thus, failed to establish a prima facie case of patent-ineligibility (*id.*). We disagree.

The Federal Circuit has repeatedly observed 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 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 the 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) (alteration in original). Thus, all that is required of the Office is that it sets forth the statutory basis of the rejection 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.”).

Here, in rejecting the pending claims under 35 U.S.C. § 101, the Examiner analyzed the claims using the *Mayo/Alice* two-step framework, consistent with the guidance set forth in the USPTO’s “2014 Interim Guidance on Patent Subject Matter Eligibility,” 79 Fed. Reg. 74618 (Dec. 16, 2014) and “July 2015 Update: Subject Matter Eligibility,”³ in effect at the time the Final Office Action was mailed. Specifically, the Examiner notified Appellants that the claims are directed to “analyzing customer behavior in a store,” and that the claims involve no more than collecting and comparing known information, which the courts have held is “An Idea of Itself,” and, therefore, an abstract idea (Final Act. 20–21 (citing the July 2015 Quick Reference Sheet)).⁴ The Examiner also determined that the claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the “recitation of a camera, a customer relationship management unit, and a database are conventional computer or computerized elements” and “it is a routine and nominal use of a computer to generate a document, i.e., a report” (*id.* at 21). The Examiner, thus, set forth the bases for the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. And we find that, in doing so, the Examiner set forth a *prima facie* case of patent-ineligibility.

We also are not persuaded of Examiner error to the extent that Appellants maintain that the claims are patent-eligible because, like the claims held patent-eligible in *Classen Immunotherapies, Inc. v. Biogen*

³ Available at <https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf>.

⁴ Available at <https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-qrs.pdf>.

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IDEA, 659 F.3d 1057 (Fed. Cir. 2011), the present claims do not simply collect and compare data but instead actually put the data to use, i.e., the captured facial image is analyzed to assess customer personality and mood characteristics and, based on the analysis, a report recommending a sales approach is generated (independent claims 1, 7, and 12) or appropriate sales professionals best suited to approach the customer are identified (independent claim 17) (App. Br. 8–11). *Classen* was decided before *Alice* and *Mayo* and, in view of these later and controlling precedent, cannot be relied on to support the notion that putting information to practical use, e.g., immunizing a patient, in a claim otherwise directed to collecting and comparing known information automatically transforms the claim into patent-eligible subject matter.

The present claims, in our view, are substantially similar to the claims that the Federal Circuit determined were patent-ineligible in *Electric Power Group, LLC v. Alstom, S.A.*, 830 F.3d 1350 (Fed. Cir. 2016), and subsequently in *FairWarning IP, LLC v. Iatric Systems, Inc.*, 839 F.3d 1089 (Fed. Cir. 2016). In *Electric Power*, the court found that the claims were directed to an abstract idea because “[t]he advance they purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions.” *Electric Power*, 830 F.3d at 1354; *see also id.* at 1353–54 (characterizing collecting information, analyzing information by steps people go through in their minds, or by mathematical algorithms, and presenting the results of collecting and analyzing information, without more, as matters within the realm of abstract ideas). Citing *Electric Power* in *FairWarning*, the Federal Circuit held that the claims were directed to collecting and analyzing information to detect misuse and notifying a user

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when misuse is detected, i.e., to a combination of abstract idea categories, *FairWarning*, 839 F.3d at 1093–94, and that, as in *Electric Power*, “the focus of the claims is not . . . on an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools.” *Id.* at 1095 (alteration in original) (citation omitted)

Similarly here, the claims involve nothing more than (1) collecting data (i.e., a captured facial image of a customer in a store); (2) analyzing the data (i.e., comparing the facial image with a set of facial expressions to associate the facial image with an emotional state and analyzing the facial image to assess personality and mood characteristics); and (3) presenting the results of the collection and analysis (i.e., generating a report recommending a sales approach or identifying and assigning an appropriate sales professional to approach the customer) — without any asserted inventive technology for performing these functions. For example, there is no indication in the record that the particular operations called for in the claims require any specialized computer hardware or other inventive computer components, invoke any assertedly inventive programming, or that the claimed invention is implemented using other than generic computer components to perform the claimed method steps. Instead, the Specification suggests just the opposite, i.e., that the claimed invention is implemented using only generic computer components to perform generic computer functions, e.g., receiving and processing information (*see, e.g.*, Spec. 9–10), which is not enough for patent-eligibility. *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”).

Addressing step two of the *Mayo/Alice* framework, Appellants assert that the claimed invention includes meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment (App. Br. 26–28). But, aside from paraphrasing the claim language, Appellants offer no persuasive argument or technical reasoning to support that position (*id.*).

Appellants further maintain that the § 101 rejection cannot be sustained because the claimed invention is directed to “an improvement in computer capabilities or an improvement of an existing technological process” (*id.* at 29). Yet, we are not persuaded that “enhancing [a] customer’s shopping experience by reducing the possibility of an unpleasant shopping experience [and] increasing the chances of a consummated sale” is an improvement to an existing technological process, as opposed to an improvement in a marketing practice (*id.*). We also are not persuaded that using computer technology in the manner claimed (e.g., to compare a captured facial image to a set of facial expressions; analyze the facial image to assess the customer’s personality and mood characteristics; and generate a report recommending a sales approach) is an improvement in computer-related technology (*id.* at 31). For example, we fail to see how, and Appellants do not explain how, enhancing a customer’s shopping experience in order to increase the chances of a sale somehow improves the way a computer operates or otherwise enhances computer functionality. At best, in our view, the claimed invention constitutes an improvement in a business sales/marketing practice for which a computer is used as a tool in its ordinary capability.

Finally, to the extent Appellants maintain that the claimed invention is patent-eligible, i.e., that the claims amount to “significantly more” than an

abstract idea, and/or that the recited functions are not “well-understood, routine, and conventional activities,” because the claims are allegedly novel and/or non-obvious in view of the prior art (App. Br. 20–21), Appellants misapprehend the controlling precedent.

A finding of novelty or non-obviousness does not automatically lead to the conclusion that the claimed subject matter is patent-eligible. Although the second step in the *Mayo/Alice* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, 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 Corp.*, 134 S. Ct. at 2355 (citation omitted). “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90; *see also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (“The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.”).

We are not persuaded, on the present record, that the Examiner erred in rejecting claims 1–20 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection.

Written Description

Whether a Specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact and is assessed on a case-by-case basis. *See, e.g., Purdue Pharma L.P. v.*

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Faulding, Inc., 230 F.3d 1320, 1323 (Fed. Cir. 2000) (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991)). The disclosure, as originally filed, need not literally describe the claimed subject matter (i.e., using the same terms or *in haec verba*) in order to satisfy the written description requirement. But the Specification must convey with reasonable clarity to those skilled in the art that, as of the filing date, Appellants were in possession of the claimed invention. *See id.*

The Examiner maintains here that there is no written description support in the Specification for the “analyzing”; “comparing”; “circuitry for analyzing”; and “circuitry for comparing” limitations, as variously recited in claims 1–20 (Final Act. 25–32). However, we agree with Appellants that the Specification provides the requisite written description support such that a person skilled in the art would understand that Appellants were in possession of the claimed invention, including the limitations identified by the Examiner, at the time the application was filed (*see* App. Br. 34–37 (identifying the portions of the Specification where the requisite written description may be found)).

Therefore, we do not sustain the Examiner's rejection of claims 1–20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Indefiniteness

In rejecting claims 1–20 under 35 U.S.C. § 112, second paragraph, the Examiner takes the position that the metes and bounds of what constitutes the “analyzing”; “comparing”; “circuitry for analyzing”; and “circuitry for comparing” are not clear because the Specification fails to adequately describe the structure and functionality of the circuitry responsible for performing these functions (Final Act. 33). Therefore, according to the

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Examiner, “one of ordinary skill in the art would not be reasonably apprised of what would infringe the circuitry and what would not infringe the circuitry” (*id.*).

We agree with Appellants that a person of ordinary skill in the art would understand from the Specification, particularly including the portions of the Specification identified by Appellants in response to the written description rejection, that the terms “comparing” and “analyzing” are used in accordance with their ordinary and customary meaning, i.e., that comparing refers, for example, to examining a captured facial image with a set of facial expressions to identify resemblances or differences, and that analyzing refers, for example, to studying or determining the nature or relationship of the captured facial image to assess personality and mood characteristics (App. Br. 39–42).

We are not persuaded that a person of ordinary skill in the art would be unable to determine the metes and bounds of the claims, when read in light of the Specification. *See In re Zletz*, 893 F.2d 319, 321–22 (Fed. Cir. 1989) (During examination, after applying the broadest reasonable interpretation to the claim, if the metes and bounds of the claimed invention are not clear, the claim is indefinite and should be rejected.); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (The test for definiteness under 35 U.S.C. § 112, second paragraph is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.”). Therefore, we do not sustain the Examiner’s rejection of claims 1–20 under 35 U.S.C. § 112, second paragraph, as indefinite.

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DECISION

The Examiner's rejection of claims 1–20 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejection of claims 1–20 under 35 U.S.C. § 112, first paragraph, is reversed.

The Examiner's rejection of claims 1–20 under 35 U.S.C. § 112, second paragraph, is reversed.

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