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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LINDA STEINBERG, ROBERT J. MISLEVY,
and RUSSELL G. ALMOND

Appeal 2017-008423
Application 14/180,456
Technology Center 3700

Before: BENJAMIN D. M. WOOD, ANNETTE R. REIMERS, and
ERIC C. JESCHKE, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants¹ appeal under 35 U.S.C. § 134 from a rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

THE INVENTION

The claims are directed to systems and methods for generating tests for educational purposes. Spec. 1.² Claims 1, 14, and 20 are independent. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A computer-implemented method of designing large numbers of varying assessment tasks for inclusion on different versions of an assessment to be administered in a computer-based assessment, the method comprising:

generating, using a processing system, a plurality of trifles, each trifle being based on subject matter information or requirements information, wherein a first trifle provides a reference to a source of the subject matter information and a second trifle provides the requirements information on which the trifle is based for subsequent access to the source, wherein the subject matter information is related to one or more subject matters of an assessment, and wherein the requirements information is related to one or more requirements for the assessment;

generating, using the processing system, one or more task model data structures, a particular task model data structure (i) defining features of a group of tasks having similar content and response

¹ Appellants state that the real party in interest is Educational Testing Service of Princeton, New Jersey. App. Br. 1.

² The Amended Specification submitted March 26, 2014, lacks pagination and line numbering. Therefore, our citations are to the original Specification submitted February 14, 2014.

requirements, and (ii) being based on the first trifle and the second trifle; and

generating, using the processing system, a plurality of varying assessment tasks and corresponding evidence models for scoring responses received for those varying assessment tasks, wherein each task is based on the particular task model data structure, and wherein at least one of the varying assessment tasks based on the particular task model data structure is included on each of a plurality of versions of the assessment, wherein the at least one varying assessment task having content that differs from all other variants produced using the particular task model data structure is generated during administration of an assessment on which the at least one varying assessment task appears.

REJECTION

Claims 1–20 are rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.

ANALYSIS

Because Appellants argue the claims as a group (App. Br. 6–23), we decide the appeal on the basis of representative claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

Having considered all of Appellants’ arguments and any evidence presented, we are not persuaded that the Examiner erred in rejecting claims 1–20 as directed to patent-ineligible subject matter. We address specific arguments for emphasis in our analysis below.

To determine whether a claim falls within a judicially recognized exception to patent eligibility under 35 U.S.C. § 101, we apply the two-step framework set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), and reaffirmed in *Alice Corporation*

Proprietary LTD. v. CLS Bank International, 134 S. Ct. 2347, 2355 (2014). For the first step, we determine whether the claims at issue are directed to a patent-ineligible concept such as an abstract idea, law of nature, or natural phenomenon. *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 566 U.S. at 78–79). If so, we advance to the second step where “we 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” of the otherwise patent-ineligible concept. *Id.* (quoting *Mayo*, 566 U.S. at 78–79). The Court has described this second step “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.* (citing *Mayo*, 566 U.S. at 72–73 (internal quotation marks and alterations omitted)).

Alice—Step One

The Examiner finds that claim 1 “represents a series of mental steps that could be carried out solely by a person using for example a pen and paper, and is a method of organizing human activities akin to other non-limiting examples of organizing human activities identified by the courts in [*Alice*] and other cases, and is therefore an abstract idea.” Final Act. 2.

Appellants dispute, *inter alia*, that the claims represent a series of mental steps that can be carried out by a person using a pen and paper. Appellants assert that “[t]he claimed subject matter is not merely applying a computer to solve a problem in a manner in which a human would in his or her head or with a pencil and paper,” but “requires a change that cannot be performed in the human mind.” App. Br. 9 (quoting *PNC Bank N.A. v.*

Secure Access LLC, PTAB Case CBM2014-0010, Sept. 9, 2014) (internal alterations omitted). According to Appellants, “it is not practical for a human test administrator to access a computer based-assessment during exam administration to add newly created assessment tasks developed using an evidence-centered approach.” *Id.*

Claim 1 recites a computer-implemented method of designing large numbers of varying assessment tasks comprising “generating, using a processing system:” (1) “a plurality of trifles,” (2) “one or more task model data structures,” and (3) “a plurality of varying assessment tasks.” As described in the Specification, these objects are created by “users” of the described system—i.e., humans. The Specification describes the invention as embodied in the “Portal Assessment Design System.” Spec. 15:7–8. The Portal Assessment Design System is a suite of software tools and a standardized design database that “allows *a user* to *generate* assessments through the evidence-centered design process.” *Id.* at 10:11–15, 15:11–12 (emphasis added); *see also id.* at 19:3–5 (“Management of the evidence-centered design object model is achieved through computer-based tools that *allow the user to create*, edit, store/retrieve, report on and search for assessment design objects” (emphasis added)). Thus, when read in light of the Specification, claim 1’s generating steps are carried out by “users” of the system—i.e., humans—with the assistance of the processing system. We therefore agree with the Examiner that claim 1 recites a series of mental steps. “[M]ental processes are a subcategory of unpatentable abstract ideas.” *Synopsis, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146 (Fed. Cir. 2016) (internal citation and quotation marks omitted). Therefore, we agree with the Examiner that claim 1 is directed to a patent-ineligible abstract idea.

Further, we are not persuaded of Examiner error by Appellants' argument that "it is not practical for a human test administrator to access a computer based-assessment during exam administration to add newly created assessment tasks developed using an evidence-centered approach," because Appellants do not support this statement with evidence or persuasive argument. We are also not persuaded by Appellants' argument that claim 1 is not directed to an abstract idea because "[t]he specific structure of the claim along with the specific limitations make clear that the present claims are not preempting all mechanisms for designing large numbers of assessment varying tasks." App. Br. 15. As our reviewing court has consistently held, "claims that are otherwise directed to patent-ineligible subject matter cannot be saved by arguing the absence of complete preemption." *Return Mail, Inc. v. United States Postal Serv.*, 868 F.3d 1350, 1370 (Fed. Cir. 2017) (citing cases). Thus, "[a]rguments about the lack of preemption risk cannot save claims that are deemed to only be directed to patent-ineligible subject matter." *Id.*

Alice—Step Two

The Examiner finds that "[t]he claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional elements or combination of elements in the claims other than the abstract idea per se amount to no more than: requiring no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry." Final Act. 3.

Appellants responds that "[e]ven if it were determined that the claims were hypothetically directed to an abstract idea as suggested by the

Examiner, the ‘additional elements’ of independent claims 1, 14, and 20 ensure that the claims amount to significantly more than the alleged abstract idea itself.” App. Br. 22. According to Appellants, “[t]he additional elements are not routine activities specified at a high level of generality, and the additional elements go far beyond mere instructions to apply the alleged abstract idea on a computer.” *Id.*

“For the role of a computer in a computer-implemented invention to be deemed meaningful in the context of [the *Alice* step two] analysis, it must involve more than performance of well-understood, routine, and conventional activities previously known to the industry.” *Content Extraction and Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347–48 (Fed. Cir. 2014) (internal citation, quotation marks, and alteration omitted). Claim 1 recites a “computer-based” method comprising a series of mental steps using a generic “processing system.” Generic recitations of computer implementation “cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice Corp. Pty, Ltd. v. CLS Bank Int’l*, 134 S. Ct. at 2358–59. Thus, we are not persuaded that the Examiner erred in determining that the additional limitations do not transform claim 1 into a patent-eligible application of the patent-ineligible abstract idea.

DECISION

For the above reasons, the Examiner’s rejection of claims 1–20 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R.

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§ 1.136(a)(1)(iv).

AFFIRMED