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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MONIQUE M. HENDRIKS, AART VAN HALTEREN,
and LU WANG¹

Appeal 2017-008715
Application 14/202,796
Technology Center 3700

Before WILLIAM A. CAPP, ERIC C. JESCHKE, and
FREDERICK C. LANEY, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants² seek our review under 35 U.S.C. § 134(a) of the final rejection of claims 1–15. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The subject application identifies Koninklijke Philips N.V. as the Applicant.

² Appellants identify Koninklijke Philips N.V. as the real party in interest. Br. 3.

THE INVENTION

Appellants' invention is an automated life coach. Spec. ¶¶ 1–3.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. An apparatus for increasing the likelihood of inducing behavior change in a lifestyle management program for a user, which apparatus is arranged to:

sense, at a processor, at least one behavior parameter of a user;

store, in a database, a quality of at least one behavior parameter of the user;

identify, by the processor, at least one intention-behavior gap based on the sensing of the at least one behavior parameter;

generate, by the processor, and using a genetic algorithm, a personalized, quantified profile of the at least one intention-behavior gap of the user;

provide, by the processor, and via a user interface, at least one action that the user can accept or reject; and

vary, by the processor, the personalized, quantified profile based on the at least one action accepted or rejected by the user.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Tran	US 2008/0004904 A1	Jan. 3, 2008
Cuthbert	US 2013/0216989 A1	Aug. 22, 2013

The following rejections are before us for review:

1. Claims 1–15 are rejected under 35 U.S.C. § 112(a) for failure to comply with the written description requirement.
2. Claims 1–15 are rejected under 35 U.S.C. § 112(b) as indefinite for failing to particular point out and distinctly claim the subject which the inventors regard as the invention.

3. Claims 1–15 are rejected under 35 U.S.C. § 101 as directed to ineligible subject matter.

4. Claims 1–15 are rejected under 35 U.S.C. § 103 as being unpatentable over Cuthbert and Tran.

OPINION

Section 112(a) – Written Description

The Examiner determines that a newly added limitation to claims 1 and 14, directed to “storing, in a database, a quality of at least one behavior parameter of the user,” is not supported by the Specification and, therefore, constitutes impermissible new matter. Final Action 3.

Appellants do not challenge, address or even mention this ground of rejection in the Appeal Brief. *See generally* Br. The Examiner takes note of this lack of opposition in the Answer. Ans. 12.

Under the circumstances, we deem Appellants to have waived the right to argue against this ground of rejection. *See Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir. 2008) (“When the appellant fails to contest a ground of rejection to the Board, . . . the Board may treat any argument with respect to that ground of rejection as waived.”). Accordingly, we summarily sustain the Examiner’s Section 112(a) rejection of claims 1–15.

Section 112(b) – Indefiniteness

The Examiner determines that the term “quality of at least one behavior parameter” in claims 1 and 14 is a relative term that renders the claims indefinite. Final Action 3. The Examiner states that “quality” is not defined by the claims and further states that the Specification does not provide a standard for ascertaining the requisite degree. *Id.* Consequently,

according to the Examiner, one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. *Id.* The Examiner further considers that dependent claims 2–13 and 15 are infected by the deficiencies in their respective parent claims and are, therefore, rejected under the same rationale. *Id.*

Appellants argue that the disputed term is “well-understood” in view of the pending claims and Specification. Br. 10. According to Appellants:

“*quality* of at least one behavior parameter”

means

“a *value* of at least one behavior parameter.”

Id. Appellants contend that, because the claimed “quality” is stored in a database, it plainly refers to the “value” of a behavior parameter. *Id.*

Appellants direct our attention to passages in the Specification where a database stores factor implication values 3202. *Id.* (citing Spec. ¶ 106).

Appellants also refer to the Specification as disclosing that “action properties” are stored in database 3222 along with predicted context properties that are stored in database 3224. *Id.* (citing Spec. ¶ 123).

The Examiner disputes Appellants’ position that “a *quality* of at least one behavior parameter” is “well-understood” to mean “a *value* of at least one behavior parameter.” Ans. 13. The Examiner observes that “[t]he alleged support in the specification provided by the Appellant makes no reference to behavior parameters nor to a quality of at least one behavior parameter.” *Id.* Referring to the only example of an actual “behavior parameter” disclosed in the Specification, the Examiner states:

The specification does however provide examples of behavior parameters to be “such as whether the user 1102 is walking, running or at rest, etc. (specification, pg. 45, para. 246).” Thus,

a “quality” of the user “walking, running or at rest, etc.” is ambiguous at best, particularly when the specification is completely silent to the term “quality”. Therefore, since the term itself is ambiguous in light of the specification, it is further indefinite as to how a “quality” could be stored.

Id.

The controlling statute provides, in pertinent part, that:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

35 U.S.C. § 112(b). The test for definiteness under Section 112 is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

“There is no requirement that the words in the claim must match those used in the specification disclosure,” *In re Skvorecz*, 580 F.3d 1262, 1268–69 (Fed. Cir. 2009); MPEP § 2173.05(e). However, the PTO can properly reject a claim as indefinite if the claim is ambiguous, vague, incoherent, opaque, or otherwise unclear. *In re Packard*, 751 F.3d 1307, 1311 (Fed. Cir. 2014). Section 112 places the burden of precise claim drafting on the applicant. *See In re Morris*, 127 F.3d 1048, 1056–57 (Fed. Cir. 1997).

Careful and straightforward claim drafting by prosecuting attorneys and agents, and rigorous application by examiners of the statutory standard to particularly point out and distinctly claim the subject matter regarded to be the invention, *see* 35 U.S.C. § 112, ¶ 2 (2000), serve an important public notice function.

Predicate Logic, Inc. v. Distributive Software, Inc., 544 F.3d 1298, 1300 (Fed. Cir. 2008). Thus, during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language

explored, and clarification imposed. *See In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

In the instant case, the word “quality” does not appear anywhere in the Specification, whether in relation to a “behavior parameter” or any other context. *See generally* Spec. The Specification is replete with references to sensing a behavior parameter, but there is no accompanying disclosure as to how such sensation is converted to either a cognizable qualitative or quantitative “value” that is capable of being stored in a database. Spec. ¶¶ 13–15. Appellants do not direct our attention to any passage in the Specification that identifies a “behavior parameter,” recognizable as such. *See generally* Br. The only “behavior parameter,” recognizable as such, that we have been able to locate in the Specification is “whether the user 1102 is walking, running[,] or at rest.” Spec. ¶ 246. The Specification fails to teach, describe, or explain how sensing whether a user is walking, running, or resting, is converted into either a qualitative or quantitative value that can be stored in a database.

Thus, it is unclear as to what constitutes a “quality” or “value” of a “behavior parameter.” Moreover, it is equally unclear how such a behavior parameter can be reduced to something that can be stored and processed by a computer system.³ A claim is properly rejected as indefinite if it is ambiguous, vague, incoherent, opaque, or otherwise unclear. *Packard*, 751 F.3d at 1311. A satisfactory response to such a rejection “can take the form of a modification of the language identified as unclear, a separate definition of the unclear language, or, in an appropriate case, a persuasive explanation

³ For example, are expressions of “anger” or “joy” considered to be “behavior parameters” and, if so, how are relative degrees of anger or joy reduced to “values” that can be stored in and processed by a computer?

for the record of why the language at issue is not actually unclear.” *Id.* Here, Appellants response to the rejection fails to clarify the meaning of “quality” as it applies to a behavior parameter. *Id.* We sustain the Examiner’s Section 112(b) rejection of claims 1–15.

Patent Eligibility under 35 U.S.C. § 101

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.*, 566 U.S. 66, 72–73 (2012)). According to the Supreme Court’s framework, we must first determine whether the claims at issue are directed to one of those concepts. *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.* (brackets in original) (quoting *Mayo*, 566 U.S. at 72–73).

With respect to the first step, the Examiner determines that the claims are directed to an abstract idea. According to the Examiner, the claims are directed to a method of organizing human activity. Final Action 4. According to the Examiner, managing intrapersonal activities, such as human behavior, is commonly performed by a mental health professional,

life coach, or physical trainer. *Id.* The Examiner further finds that the claims represent an idea of itself, which is an abstract idea. *Id.* The Examiner further finds that the claims are directed to a mathematical relationship or formula, which is also an abstract idea. *Id.*

With respect to the second step of the *Alice/Mayo* analysis, the Examiner finds:

The 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 are simply a generic recitation of a processor, a memory, a user interface, and a computer that serve to merely link the abstract idea to a processing device that are well understood, routine, and conventional activities previously known to the pertinent industry.

Id. at 4–5.

Regarding step 1, Appellants argue that the claims are not “directed to” an abstract idea. Br. 11. Appellants analogize the instant case to that *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (2016). In response, the Examiner faults Appellants for not identifying and explaining how *Enfish* applies to the facts of this case. Ans. 15–16.

It is well settled that an idea, in and of itself, is not patentable. *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972). An abstract idea does not become nonabstract by limiting the invention to a particular technological environment. *Intellectual Ventures I LLC v. Capital One Bank*, 792 F.3d 1363, 1367 (Fed. Cir. 2015); *see also Affinity Labs of Texas, LLC v. DirecTV, LLC*, 838 F.3d 1253, 1259 (Fed. Cir. 2016) (Merely limiting the field of use of the abstract idea to a particular existing technological environment does not render the claims any less abstract); *see also Alice*,

134 S.Ct. at 2358 (the fact a computer exists in the physical realm is beside the point).

Appellants' *Enfish* argument is not persuasive. In *Enfish*, the court determined that “the claims at issue . . . are not directed to an abstract idea within the meaning of *Alice*. Rather, they are directed to a specific improvement to the way computers operate.” *Id.* at 1336.

In contrast, Appellants' claim 1 is directed to an apparatus that is arranged to perform six functional limitations “at” or “by” a processor, namely: (1) sense; (2) store; (3) identity [sic “identify”]; (4) generate; (5) provide; and (6) vary. The processor merely implements, on a computer, the abstract idea of organizing human behavior in the form of life coaching activities. Thus, the claims in this case fall into a familiar class of claims directed to the patent ineligible concept of an abstract idea. *See Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016).

The focus of the asserted claims . . . is on collecting information, analyzing it, and displaying certain results of the collection and analysis. We need not define the outer limits of “abstract idea,” or at this stage exclude the possibility that any particular inventive means are to be found somewhere in the claims, to conclude that these claims focus on an abstract idea. *Id.* The courts treat analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract idea category. *Id.* at 1354 (citing *TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016)). The courts treat claims to organizing human activity as an abstract idea as the Examiner correctly finds (Final Act. 4–5). *See Alice*, 134 S.Ct. at 2356 (hedging is method of organizing human activity); *Voter Verified, Inc. v. Election Sys. & Software LLC*, 887 F.3d 1376, 1385 (Fed. Cir. 2018)

(fundamental human activity of voting). Furthermore, merely displaying the results of abstract processes of collecting and analyzing information, without more, is abstract as an ancillary part of such collection and analysis. *Electric Power Group*, 830 F.3d at 1354 (citing *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014)). The Examiner is correct in determining that claims 1–15 are directed to an abstract idea.

Next, Appellants take the position that the claims contain patentable subject matter because they are limited so as not to preempt a significant amount of inventive activity. Br. 13–14 (“Applicant seeks only to foreclose others from the use of that particular idea in conjunction with the particular configured apparatus and particular configured method”). In response, the Examiner points out that “preemption” is not a standalone test for patent eligibility and that any preemption concerns have been addressed through the application of the *Alice/Mayo* two-step framework. Ans. 15. We agree with the Examiner on this point as “the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (2015).

Regarding step 2 of the *Alice/Mayo* analysis, Appellants next argue that the claimed apparatus and method alleviate shortcomings of existing automated coaching methods. Br. 16. “Advantages of the present application over existing automated coaching systems include, for example, low cost and providing support throughout the day (as opposed to for example once a week, when using a human coach).” *Id.* at 17. Appellants analogize the claimed invention to a hypothetical rubber molding process used as an example in the PTO’s 2014 interim guidelines. *Id.* at 17–19.

Appellants' arguments with respect to step 2 or the "something more" step of the *Alice/Mayo* analysis are not persuasive. At the outset, we do not find life coaching to be analogous to rubber molding. Appellants' Specification discloses that their invention is facilitated by a "computer resource 201" that may be a server, computer, or another device that provides "computing capability." Spec. ¶ 94. Appellants disclose a "client device 102" that may be coupled to a network and is configured to communicate with an activity monitor 105. *Id.* ¶ 95. Client device 102 may include a computer system in the form of a desktop computer, a laptop computer, a tablet computer, a personal digital assistant, a mobile device, a smart phone, a gaming console, or "other devices with like capability." *Id.* ¶ 96. The client device 102 executes applications such as a browser to access web pages or other network content. *Id.* The client device may also execute applications other than a browser such as email, instant messaging, and other unspecified applications. *Id.* Appellants' network 104 includes the internet, intranets, extranets, wired networks, wireless networks, wide area networks, local area networks, and other unspecified but "suitable" networks. *Id.* ¶ 97. The computing resource 201 and client device 102 each include a processor and memory. *Id.* ¶ 98. The processor is configured to process any of the steps or functions of computer resource 201, system 200, or any of the modules, units or components thereof. *Id.* ¶ 99. The processor may be comprised of single integrated circuit or use a plurality of integrated circuits that are connected together. *Id.* Appellants' memory 108 may include both volatile and nonvolatile memory and data storage components including RAM, ROM, hard disk drives, USB flash drives, memory cards,

optical disk drives, and magnetic tapes. *Id.* ¶ 100. The memory 108 may store instructions that are executable by the processor. *Id.* ¶ 102.

In short, the computer implementation of Appellants’ abstract idea is described at a high level of generality that presumes familiarity on the part of the reader. Appellants do not cite or otherwise direct our attention to any teaching disclosure in the Specification that purports to show that computer implementation of the abstract idea is performed in a manner that transcends well-understood, routine, and conventional computer technology. *Alice*, 134 S.Ct. at 2359. There is nothing in the description of the computer equipment, software, and user interface components that purports to be a breakthrough or advancement in computer technology. *Id.*

A patent applicant is required to submit a specification that contains a written description of the invention in “full, clear, concise, and exact terms.” 35 U.S.C. § 112(a). Generally, for purposes of the *Alice/Mayo* analysis, a specification demonstrates the well-understood, routine, conventional nature of step 2 “*additional elements*” when it describes them in a manner that indicates they are sufficiently well-known that they need not be described with particularity to satisfy 35 U.S.C. § 112(a).⁴ That is certainly the case here. Under the circumstances, we agree with the Examiner that Appellants’ competitive activity challenge system does not require anything outside of a generic computer. Final Action 4. Indeed, Appellants do not argue that their invention requires, discloses, or claims more than generic computers

⁴ Memorandum from the U.S. Patent & Trademark Office, *Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision* (April 19, 2018).

that may be coupled to a generic network, such as the internet. *See generally* Br.

It is now well settled that mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. *See Alice*, 134 S.Ct. at 2358. Thus, merely stating an abstract idea while adding the words “apply it” is not enough to confer patent eligibility. *Id.*

[I]f that were the end of the § 101 inquiry, an applicant could claim any principle of the physical or social sciences by reciting a computer system configured to implement the relevant concept.

Id. at 2359.

In accordance with the foregoing legal principles, we have considered whether the claim elements, both individually and “as an ordered combination,” “transform the nature of the claim’ into a patent-eligible application.” *See id.* at 2355. We are not persuaded that using a computer system to automate the manual and mental tasks typically performed by a human “life coach” satisfies the “significantly more” criteria under the second prong of *Alice/Mayo*. *Id.* at 2359. Essentially, all Appellants have done here is use generic computer data gathering, processing, and display technology to automate the functions of a “life coach” or similar mental health professional. As in *Alice*, “each step does no more than require a generic computer to perform generic computer functions.” *Id.*

We have considered Appellants’ remaining arguments and find them to be without merit. Accordingly, we sustain the Examiner’s Section 101 rejection of claims 1–15.

*Unpatentability of Claims 1–15
over Cuthbert and Tran*

We do not reach the obviousness rejections because an affirmance of the lack of written description rejection disposes of all claims on appeal. *See* 37 C.F.R. § 41.50(a)(1) (The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed). It is not necessary to address the obviousness of claims, which contain a limitation not described by the specification, as filed. *Ex parte Smith*, Case No. 2008-5902, 2008 WL 4998624 (BPAI Nov. 24, 2008)

DECISION

The decision of the Examiner to reject claims 1–15 for lack of written description under 35 U.S.C. § 112(a) is affirmed.

The decision of the Examiner to reject claims 1–15 as indefinite under 35 U.S.C. § 112(b) is affirmed.

The decision of the Examiner to reject claims 1–15 as being directed to unpatentable subject matter under 35 U.S.C. § 101 is affirmed.

We do not reach the Examiner’s art rejection. *See* 37 C.F.R. § 41.50(a)(1).

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