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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS MICHAEL COZAD JR.

Appeal 2017-009044
Application 13/713,962
Technology Center 3600

Before ELENI MANTIS MERCADER, JASON J. CHUNG, and
SCOTT E. BAIN, *Administrative Patent Judges*.

MANTIS MERCADER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant¹ requests rehearing under 37 C.F.R. § 41.52 of our Decision, mailed on February 27, 2019 (“Decision”), in which we affirmed the Examiner’s rejection under 35 U.S.C. § 101 of claims 1–16, 35, 36, 38–40, 51, and 53–57. Appellant timely filed a Request for Rehearing (“Req. Reh’g”) on April 26, 2019.

¹ Appellant is the real party in interest. Br. 1.

We have reconsidered our Decision in light of Appellant's Request for Rehearing, but we decline to change the final disposition of the Decision for the reasons discussed, *infra*.

DISCUSSION

On February 27, 2019, we issued our Decision in which we affirmed the Examiner's Decision rejecting claims 1–16, 35, 36, 38–40, 51, and 53–57 under 35 U.S.C. § 101 and under pre-AIA 35 U.S.C. § 103(a). Decision 4–14. Appellant seeks rehearing of our Decision solely related to our affirmation of the Examiner's rejection under 35 U.S.C. § 101. Req. Reh'g 3–6.

As we stated in our Decision, “[t]he Supreme Court’s two-step framework guides our analysis of patent eligibility under 35 U.S.C. § 101.” Decision 6–9 (citing *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014)). Additionally, we noted that the Office published revised guidance for evaluating subject matter eligibility under 35 U.S.C. § 101, specifically with respect to applying the *Alice* framework. USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Office Guidance”). *Id.* The Decision analyzed claim 1 consistent with the Court’s two-step framework and the Office Guidance. *See* Decision 9–12. We also adopted the Examiner’s findings in the Answer and Final Office Action and we emphasized our findings based on the new guidelines with respect to claim 1 and for at least the same reasons and the Examiner’s findings in the Final Action and Answer we affirmed the Examiner’s rejections for all pending claims 1–16, 35, 36, 38–40, 51 and 53–57. *See* Decision 4–12.

In the Decision, we found that claim 1 as a whole recites a method of mental processes being performed in the mind or by a human using a pen and paper. Decision 9. We explained that claim 1 allows recording store aisle location information for each of multiple items including, for each item, an aisle identifier, a side identifier, a section identifier, a shelf identifier, and an itemization order. *Id.* As we stated in our Decision this limitation, as drafted, is a process that, under its broadest reasonable interpretation, covers performance of the limitation in the mind or by a human using a pen and paper but for the recitation of generic computer components. *Id.* That is, other than reciting “in a mobile computing device” at a high level of generality, nothing in the claim elements precludes the steps from being performed in the mind or by a human using a pen and paper. *Id.* Furthermore, the “in a mobile computing device” language encompasses the user manually recording an aisle identifier, a side identifier, a section identifier, a shelf identifier, and an itemization order. *Id.* Similarly, we found that the steps of keeping track of the direction of the scan and the beginning and the end of a shelf constitute mental processes because it encompasses the user keeping track of the direction of the scan mentally or by using pen and paper. *Id.* Thus, we concluded that the claim recites mental processes. *Id.*

Because the claim recited a method of a mental process which is a judicial exception (i.e., under the analysis according to Memorandum Step 2A, Prong 1) we further determined whether the method of a mental process is integrated into a practical application. *Id.* at 10.

We found that

the claim further recites specifying via a user interface, a pattern of scanning multiple shelves, receiving a series of item identifiers that each correspond to one of the multiple items, the item identifiers received from a scanner operated by a user who is traversing the shelf, in a right or left direction specified via a user interface, from the first end to the second end and receiving an indication that the user has reached the second end of the shelf.

Id. We further found that the claim recites the additional elements of

in response to receiving the indication that the user has reached the second end of the shelf and without receiving any additional inputs from the user, recording store aisle location information for each of the multiple items including, for each item, an aisle identifier, a side identifier, a section identifier, a shelf identifier, and an itemization order

(emphases added). We determined that the “mobile computing device” and the user interface are recited at a high level of generality, i.e., as a generic processor and user interface performing a generic computer function of processing data (receiving information regarding location of store items in a shelf). *Id.* We found that the generic processor limitation is no more than mere instructions to apply the exception using a generic computer component. *Id.* We concluded that the mere nominal recitation of a generic mobile computing device and the use of a GUI to enter the items into a computer listing does not take the claim limitation out of the mental processes grouping. *Id.*

As explained in *OIP Techs, Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015), “relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.” Decision 10–11 (also quoting *Alice*, 573 U.S. at 224 (“use of a computer to

create electronic records, track multiple transactions, and issue simultaneous instructions” is not an inventive concept). “[I]nterchangeability of certain mental processes and basic digital computation . . . help explain why the use of a computer in an otherwise patent-ineligible process for no more than its most basic function . . . fails to circumvent the prohibition against patenting abstract ideas and mental processes.” *Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Can. (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012). In other words, “[u]sing a computer to accelerate an ineligible mental process does not make that process patent-eligible.” *Bancorp Servs*, 687 F.3d at 1279. “Simply adding a ‘computer aided’ limitation to a claim covering an abstract concept, without more, is insufficient to render the claim patent eligible.” *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012). Accordingly, we concluded that the additional elements do not integrate the abstract idea into a practical application because it does not impose any meaningful limits on practicing the abstract idea. Decision 11 (i.e., under the analysis according to Memorandum Step 2A, Prong 2 there are no additional elements that integrate the abstract idea into a practical application).

We note that while we did not explicitly state it in our Decision, in the instant case the same analysis as we discussed above with respect to Step 2A, prong 2 applies in Step 2B, we clarify this premise here. In particular, with respect to the additional elements, i.e., mere instructions to apply an exception using a generic computer component and a user interface performing a generic computer function of processing data cannot integrate a judicial exception into a practical application at Step 2A or provide an inventive concept in Step 2B. While we did not explicitly state it, the

adopted Examiner's findings (*see* Decision 4) state it explicitly. *See* Ans. 5. In particular, the Examiner finds that the representative claims 1, 51 and 54 recite additional elements such as “[m]obile computing device, user interface, first, second and third control, scanner, aisle, shelf, section, location indicator device, counter . . . [. ,] processor, memory” but these additional elements under Step 2B “operate using well-understood, routine and conventional functions . . . such as receiving, processing and storing data, receiving and transmitting data over a network, automating human operations/mental tasks, and/or performing repetitive calculations.” *Id.*

The Examiner more particularly finds that claims 1, 51, and 54 do not require any nonconventional computer, network, or display components, or even a nonconventional and non-generic arrangement of known, conventional pieces, but merely call for performance of the claimed *information collection, storing, analysis, and outputting* functions on a set of generic computer components. *Id.* at 6. Nothing in the claims, understood in light of the Specification, requires anything other than off-the-shelf, conventional computer, network, and display technology for gathering, sending, and presenting the desired information. *Id.*

Furthermore with respect to the dependent claims, including claim 35, we adopted the Examiner's finding that the additional elements recited in the dependent claims is an attempt to further define the field of use of the abstract idea. *See, e.g.,* Ans. 5. In other words the “automatically populating a user interface display of the one section to present identifiers of other of the items in one section . . . without requiring additional scanning” as recited in claim 35 do not improve the computer itself but rather as the Examiner points out “manifested only in the procedure of tracking

individual shelf locations for items” (Ans. 9) and similar to claims 1, 51, and 54 the tracking of inventory items and managing inventory location pertain to the abstract idea of collecting and comparing information which has been repeatedly found by our reviewing Court as an idea itself. *See* Ans. 6–8.

Thus, based on the above analysis we do not agree with Appellant’s argument that the Board misapprehended or overlooked recited features of claims 35, 51, and 54. Req. Reh’g 3. In particular Appellant asserts that the Board did not discuss Appellant’s argument with respect to claim 35. *Id.* According to Appellant, the Board’s incorporation and adoption of the Examiner’s analysis and findings do not cure this deficiency because the Examiner did not separately address dependent claim 35. *Id.* (citing Decision 4).

We do not agree with Appellant’s argument because the adopted Examiner’s finding and our additional findings based on the new Guidelines addressed the rejections of the independent claims 1, 35, 51, and 54 as stated *supra*. *See* Decision 4.

We also do not agree with Appellant’s argument that the Board’s Decision did not fill in the gaps between the Examiner’s analysis and the requirements of the Revised Guidance under the second prong of Step 2A. Req. Reh’g 5. According to Appellant the Board’s analysis, focusing on the use of “generic” computer elements, is just a thinly disguised “significantly more” inquiry, which is specifically forbidden under the second prong of Step 2A. *Id.* We specifically addressed the applicable limitations of claim 1 as indicated above under Step 2A and similarly addressed the applicable limitations of claims 51, 54, and their dependents.

Finally with respect to the efficiencies gained by exploiting planogram data as argued regarding claim 35 and interaction between the scanner and machine-readable location indicators of claims 51 and 54, again these pertain to gathering and organizing data using conventional methods and equipment. As we stated above, and explained in *OIP Techs.*, 788 F.3d at 1363, “relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.” Decision 10–11.

For at least the foregoing reasons, we disagree with Appellant that we misapprehended or overlooked any points in rendering our Decision.

DECISION

We have considered the arguments raised by Appellant in the Request for Rehearing, but Appellant has not persuaded us that we misapprehended or overlooked any points in rendering our Decision. Although we have considered our prior Decision in light of the Request for Rehearing, we decline to modify our prior Decision in any respect.

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).

REHEARING DENIED