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EXAMINER

FERNSTROM, KURT

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BERND BICKEL, GAURAV BHARAJ,
BERNHARD THOMASZEWSKI, and STELIAN COROS

Appeal 2017-009436
Application 14/476,269¹
Technology Center 3700

Before MICHAEL L. HOELTER, MICHELLE R. OSINSKI, and
JEREMY M. PLENZLER, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's Final Decision rejecting claims 1–7, 9–17, and 19–22 under 35 U.S.C. § 101 and claims 21 and 22 under 35 U.S.C. § 112(a). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellant is the Applicant, Disney Enterprises, Inc., a wholly owned subsidiary of The Walt Disney Company, identified by the Appeal Brief as the real party in interest. Appeal Br. 2.

CLAIMED SUBJECT MATTER

Claims 1 and 11 are independent, with claims 2–7, 9, 10, 12–17, and 19–22 depending from claim 1 or 11. Claim 1 is representative of the claims on appeal, and is reproduced below:

1. A system comprising:

a memory storing a software application; and

a processor configured to execute the software application to:

receive a character design from a user, the character design having walking mechanisms including one or more of mechanical assemblies, gears, linkages and geometric shapes that are connectable to build a walking machine;

determine optimal design parameters for the walking mechanisms based on the character design;

alter one or more of the walking mechanisms of the character design based on the optimal design parameters for use by the walking machine to walk in a stable manner; and

generate instructions for a machine to build the one or more altered walking mechanisms of the walking machine.

OPINION

Enablement

The Examiner rejects claims 21 and 22, which depend from claims 1 and 11, respectively, under 35 U.S.C. § 112(a) for failure to comply with the enablement requirement. Claim 21 recites that “[t]he system of claim 1 further compris[es] the machine [to build the one or more altered walking mechanisms of the walking machine], wherein the machine is configured to: receive the instructions; and build the one or more altered walking mechanisms of the walking machine.” Claim 22 is similar to claim 21, reciting that “[t]he method of claim 11 further compris[es]: receiving, by the

machine [to build the one or more altered walking mechanisms of the walking machine], the instructions; and building, by the machine, the one or more altered walking mechanisms of the walking machine.” That is, claims 21 and 22 add a machine that builds another machine based on instructions, at the most basic and broadest level possible.

We agree with Appellant that a machine that builds another machine based on instructions (at the basic level of detail recited in the claims) is well-known in the art. *See* Appeal Br. 6–7. Accordingly, we agree that the Examiner erred in the rejection of those claims based on lack of enablement under 35 U.S.C. § 112(a).

Patent Eligibility

Appellant argues claims 1–7, 9–17, and 19–22 as a group.² Appeal Br. 7–15. We select claim 1 as representative. Claims 2–7, 9–17, and 19–22 stand or fall with claim 1. *See* 37 C.F.R. 41.37(c)(1)(iv).

Under 35 U.S.C. § 101, we must first identify whether an invention fits within one of the four statutorily provided categories of patent-eligibility: “processes, machines, manufactures, and compositions of matter.” *Ulramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 713–714 (Fed. Cir. 2014). Here, claim 1 falls within one of those categories. Section 101, however, “contains an important implicit exception [to subject matter eligibility]: Laws of nature, natural phenomena, and abstract ideas are not

² In its arguments, Appellant recites the limitations of claims 21 and 22 (Appeal Br. 15), which does not amount to separate argument for those claims. *See* 37 C.F.R. 41.37(c)(1)(iv) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”). Nevertheless, we note, as explained in our discussion of the enablement rejection, those claims simply add features that Appellant acknowledges were well-known, routine, and conventional.

patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l.*, 134 S. Ct. 2347, 2354 (2014) (citing *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013) (internal quotation marks and brackets omitted)). In *Alice*, the Supreme Court reiterated the framework set forth previously in *Mayo Collaborative Servs. v. Prometheus Labs*, 132 S. Ct. 1289, 1293 (2012) “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts.” *Alice*, 134 S. Ct. at 2355. We first “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If so, 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.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1298, 1297).

The Examiner characterizes claim 1 as “directed to a system and method for altering walking mechanisms of a character” and determines that “[e]ach of these steps amounts to mental activity,” which is an abstract idea. Final Act. 4. We agree. See *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) (“[U]npatentable mental processes” include “steps [that] can be performed in the human mind, or by a human using a pen and paper.”). Appellant does not dispute this understanding of the claim, and there is no dispute as to any underlying fact findings. Rather, Appellant argues that claim 1 is somehow similar to those found to be patent-eligible by the Federal Circuit in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016). Appeal Br. 8–11.

To be clear, claim 1 is nothing like those at issue in *Enfish*. In *Enfish*, the claim at issue was directed to a data storage and retrieval system for a

computer memory. *Enfish*, 822 F.3d at 1336–37. The court noted that “[s]oftware can make non-abstract improvements to computer technology just as hardware improvements can[.]” *Enfish*, 822 F.3d at 1335. The court put the question as being “whether the focus of the claims is on [a] specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Id.* at 1335–36. In *Enfish*, the court found that the “plain focus of the claims” was on “an improvement to computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity.” *Id.* at 1336.

Here, claim 1 is effectively drawn to an idea, itself. There is no detail, whatsoever, as to how the character design is optimized, just that “walking mechanisms of the character design [are altered] based on the optimal design parameters for use by the walking machine to walk in a stable manner,” in some unspecified way, with instructions also generated in some unspecified manner for another unspecified machine to build the walking mechanisms. Claim 1 involves no improvement to the computer itself. Appellant admits as much, noting that rather than an improvement to the computer, itself, “claim 1 is aimed at improving another technology area by generating instructions for a machine to build walking mechanisms.” Appeal Br. 10.

We also agree with the Examiner that there is nothing further in the claim that transforms the nature of the claim into a patent-eligible application of the abstract idea. *See* Final Act. 5 (“The claims . . . requir[e] no more than . . . generic computer components to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry.”). Again, we note that there is no dispute

that the steps in claim 1 can be performed in the human mind, or by a human using a pen and paper. Appellant alleges that “claim 1 goes beyond the mere concept of simply receiving and optimizing parameters” because it “combines various steps to generate instructions for a machine to build one or more altered walking mechanisms of the walking machine, such that the walking machine can walk in a stable manner.” Appeal Br. 13; *see also id.* at 15 (“claim 1 recites a specific algorithm that generates instructions for a machine to build the one or more altered walking mechanisms of the walking machine.”).

Because the claim lacks any specificity, Appellant has not persuaded us that claim 1 is directed to anything more than “a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as tool.” *Enfish*, 822 F.3d at 1336. Appellant identifies nothing that transforms the nature of claim 1 into a patent-eligible application of the abstract idea. For at least these reasons, we are not apprised of Examiner error in the rejection of claims 1–7, 9–17, and 19–22 under 35 U.S.C. § 101.

DECISION

We REVERSE the Examiner’s decision to reject claims 21 and 22 under 35 U.S.C. § 112(a).

We AFFIRM the Examiner’s decision to reject claims 1–7, 9–17, and 19–22 under 35 U.S.C. § 101.

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