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ALLISON JOHNSON, P.A. 3600 AMERICAN BLVD. W., SUITE 410 MINNEAPOLIS, MN 55431			BULLINGTON, ROBERT P	
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allison@ajiplaw.com
patent@ajiplaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARIT SOLHEIM WITT

Appeal 2017-009450
Application 13/760,715
Technology Center 3700

BEFORE MICHAEL L. HOELTER, JEREMY M. PLENZLER, and
BRANDON J. WARNER, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Pursuant to 37 C.F.R. § 41.52(a), Appellant¹ filed a Request for Rehearing on October 31, 2019 (“Req. Reh’g”) seeking reconsideration of our Decision on Appeal mailed October 7, 2019 (“Dec.”). We have jurisdiction over the Request for Rehearing under 35 U.S.C. § 6(b). Except for any portion specifically withdrawn on rehearing, this Decision on Request for Rehearing incorporates the Decision on Appeal, including any

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a).

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abbreviations defined therein for citations to the record, in accordance with 37 C.F.R. § 41.52(a)(1).

ANALYSIS

Appellant’s Request for Rehearing alleges that we “overlooked certain steps (i.e., limitations) in some of the claims, ha[ve] misapprehended the inventive concept of some of the claims, and ha[ve] misapprehended how new case law and USPTO guidelines apply to these limitations.” Req. Reh’g 1. The Request for Rehearing “focuses solely on claim 33 and the step of holding at least four metal palettes near the face of an individual.” *Id.* Specifically, Appellant contends that “[t]he Board overlooked the fact that a number of the claims include the step of holding at least four metal palettes near the face of an individual (see, claims 30, 2–4, 33, 36–41 and 15).” *Id.* at 2.

Appellant contends that holding metal palettes near the face of an individual cannot be performed in the human mind and, because this step cannot be performed in the human mind, there can be no question that the method of analyzing the personality of an individual has been integrated into a practical application. Req. Reh’g 3–4. Referencing *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018), Appellant contends that “holding at least four metal palettes near the face of an individual” is not “well-understood, routine, and conventional activity.” Req. Reh’g 2 (internal quotations omitted); *see also id.* at 4–7 (providing further discussion related to *Berkheimer*).

Appellant’s contentions are not persuasive. As explained above, the sole issue presented in this Request for Rehearing related to “the step of holding at least four metal palettes near the face of an individual.” Req.

Reh’g. 1. Our Decision explained, and Appellant does not dispute, that “‘holding’ various objects [near the face of an individual] to facilitate comparison to an individual” is “no more than insignificant extra-solution activity, which cannot integrate the mental processes into a practical application.” Dec. 7. Nor is there any dispute that holding objects near an individual’s face for these comparisons is well-understood, routine, and conventional, as explained in our Decision. *See id.* at 7–9. Rather, the present dispute relates to the specific content of the objects held up to an individual’s face.

As explained above, the claims recite holding “metal palettes” near an individual’s face. Claim 33, for example, does not include further detail on those “metal palettes,” only that the “metal palettes” are somehow used to “identify[] a mind-body temperament” based on a predetermined “correlation of the mind-body temperament and the selected metal palette.” The Specification explains that these “metal palettes” are simply a structure that has metallic colors thereon. Spec. 20–22. That is, the “metal palettes” are used to display metallic colors.

This issue before us is similar to that presented in *In re Guldenaar*, 911 F.3d 1157, 1162 (Fed. Cir. 2018). There, “[t]he claims . . . recite[d] the steps of placing a wager, rolling the dice, and paying a payout amount if at least one wagered outcome occurs—none of which Appellant . . . dispute[d] is conventional, either alone or in combination.” *Guldenaar*, 911 F.3d at 1161. In that case, Appellant “contend[ed] that ‘the specifically-claimed di[c]e’ that have markings on one, two, or three die faces are not conventional and their recitation in the claims amounts to ‘significantly more’ than the abstract idea.” *Id.* The court determined that “[t]he markings on Appellant’s dice, however, constitute printed matter” because “[e]ach

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die’s marking or lack of marking communicates information to participants indicating whether the player has won or lost a wager, similar to the markings on a typical die or a deck of cards,” making “the recited claim limitations . . . directed to information,” and “the printed indicia on each die are not functionally related to the substrate of the dice.” *Id.*

The metallic colors on Appellant’s palette do not cause that palette to become a manufacture with different functionality, just like “the markings on each . . . dice [in *Guldenaar*] d[id] not cause the die itself to become a manufacture with new functionality.” *Guldenaar*, 911 F.3d at 1161. “Because the only arguably unconventional aspect of the recited method . . . is printed matter, which falls outside the scope of § 101,” Appellant does not apprise us of a sufficient basis to modify our Decision affirming the Examiner’s rejection of the claims under § 101. *Id.* at 1162.

Accordingly, we deny Appellant’s Request for Rehearing.

CONCLUSION

Outcome of Decision on Rehearing:

Claims Rejected	35 U.S.C. §	Basis	Granted	Denied
2–8, 15–20, 30–41	101	Patent Eligibility		2–8, 15–20, 30–41

Final Outcome on Appeal after Rehearing:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
2–8, 15–20, 30–41	101	Patent Eligibility	2–8, 15–20, 30–41	

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TIME PERIOD FOR RESPONSE

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

DENIED