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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TY B. GOODWIN, JEFFREY A. FLOOD,
and MARK A. FRITZKE

Appeal 2017-010611¹
Application 14/041,707²
Technology Center 3600

Before BRUCE T. WIEDER, AMEE A. SHAH, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 1–5, 7–14, and 16–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our Decision references Appellants’ Appeal Brief (“Appeal Br.,” filed April 6, 2017) and Reply Brief (“Reply Br.,” filed August 10, 2017), and the Examiner’s Answer (“Ans.,” mailed June 12, 2017) and Final Office Action (“Final Act.,” mailed November 14, 2016).

² Appellants identify Wilson Sporting Goods Co. as the real party in interest. Appeal Br. 3.

CLAIMED INVENTION

Appellants' claims relate to a system and method of customizing a baseball or softball bat (Spec. ¶¶ 2–3).

Claims 1 and 11 are the independent claims on appeal. Claim 1, reproduced below with bracketed notations added, is illustrative of the claimed subject matter:

1. A method of producing a customizable ball bat using an electronic device having a processor, a display operably coupled to the processor, an input mechanism, and a memory operably coupled to the processor, the method comprising:
 - [a] presenting to the user on the display of the electronic device representations of a plurality of handle portions of the ball bat, the plurality of handle portions varying from one another according to at least one handle portion characteristic;
 - [b] receiving user input through the input mechanism selecting the one of the plurality of handle portions;
 - [c] presenting to the user on the display of the electronic device representations of a plurality of barrel portions of the ball bat, each of the barrel portions having an outer diameter and a length, the plurality of barrel portions varying from one another according to at least one barrel portion ornamental characteristic and at least one functional characteristic;
 - [d] receiving user input through the input mechanism selecting the one of the plurality of barrel portions including the selection of at least one ornamental characteristic and the selection of at least one functional characteristic;
 - [e] presenting to the user on the display of the electronic device representations of a plurality of elements, the elements configured to fixedly engage to the handle portion and to fixedly engage to the barrel portion, the element separating the handle portion from the barrel portion and including an inner tubular wall for engaging the handle portion and a frusto-conical shaped barrel engaging region for engaging the barrel portion, the plurality of elements varying from one another according to at least one ornamental element characteristic and at least one functional element characteristic;

[f] receiving user input through the input mechanism selecting the one of the plurality of elements including the selection of at least one ornamental characteristic and the selection of at least one functional characteristic;

[g] presenting a representation of the ball bat in an assembled state on the display with the selected handle portion, barrel portion and element included in the representation;

[h] receiving user input through the input mechanism confirming the selection of the handle portion, the barrel portion and the element; and

[i] producing the customized ball bat with a handle portion including the selected handle portion characteristic, a barrel portion including the selected barrel portion characteristics, and an element including the selected element characteristics, the barrel portion at least partially overlapping the element and the element at least partially overlapping the handle portion.

REJECTION

Claims 1–5, 7–14, and 16–20 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

ANALYSIS

Patent-Ineligible Subject Matter

Appellants argue claims 1–5, 7–14, and 16–20 as a group (Appeal Br. 8–11; Reply Br. 1–4). We select independent claim 1 as representative. The remaining claims stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. Yet, subject matter belonging to any of the statutory categories may, nevertheless, be ineligible for patenting. The Supreme

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Court has interpreted § 101 to exclude laws of nature, natural phenomena, and abstract ideas, because they are regarded as the basic tools of scientific and technological work, such that including them within the domain of patent protection would risk inhibiting future innovation premised upon them. *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013).

Of course, “[a]t some level, ‘all inventions . . . embody, use, reflect, rest upon, or apply’” these basic tools of scientific and technological work. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014) (internal citation omitted). Accordingly, evaluating ineligible subject matter, under this judicial exclusion, involves a two-step framework for “distinguish[ing] between patents that claim the buildin[g] block[s] of human ingenuity and those that integrate the building blocks into something more, thereby transform[ing] them into a patent-eligible invention.” *Id.* (internal quotation marks and citation omitted). The first step determines whether the claim is directed to judicially excluded subject matter (such as a so-called “abstract idea”); the second step determines whether there are any “additional elements” recited in the claim that (either individually or as an “ordered combination”) amount to “significantly more” than the identified judicially excepted subject matter itself. *Id.* at 217–18.

The USPTO recently published revised guidance on the application of § 101, in accordance with judicial precedent. USPTO, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50, 57 (Jan. 7, 2019) (“2019 Revised Guidance”). Under the 2019 Revised Guidance, a claim is “directed to” an abstract idea, only if the claim recites any of (1) mathematical concepts, (2) certain methods of organizing human activity, and (3) mental processes — without integrating such abstract idea into a

“practical application,” i.e., without “apply[ing], rely[ing] on, or us[ing] the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *Id.* at 53–55. A claim so “directed to” an abstract idea constitutes ineligible subject matter, unless it recites an additional element (or combination of elements) amounting to significantly more than the abstract idea. *Id.* at 56.

With regard to the first step of the *Alice* framework, the Examiner determines that independent claim 1 is directed towards “the abstract idea of customizing a ball bat” (Final Act. 3; Ans. 6). More particularly, the Examiner states that exemplary independent claim 1

recites, in part, a method for customizing a ball bat comprising: (1) presenting to the user representations of a plurality of handle portions of the ball bat, (2) receiving user input selecting the one of the plurality of handle portions, (3) presenting to the user representations of a plurality of barrel portions of the ball bat, (4) receiving user input selecting the one of the plurality of barrel portions, (5) presenting to the user representations of a plurality of elements, (6) receiving user input selecting the one of the plurality of elements, (7) presenting a representation of the ball bat in an assembled state (8) receiving user input confirming the selection and (9) producing the customized ball bat. The steps outlined in claim 1 represent the abstract idea of customizing a ball bat, such as by receiving user input of selected ball bat features and generating a presentation of the customized ball bat.

(Final Act. 2–3).

When viewed through the lens of the 2019 Revised Guidance, the Examiner’s analysis depicts the claimed subject matter as one of the ineligible “[c]ertain methods of organizing human activity” that include “commercial . . . interactions,” such as “advertising, marketing or sales activities or behaviors” and “business relations,” as well as “managing

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personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions)” under Prong One of Revised Step 2A. *See* 2019 Revised Guidance, 84 Fed. Reg. at 51–52.

In response to the Examiner’s determination, Appellants argue that independent claim 1 is “not directed toward an abstract idea, rather they are directed toward a method and a system to improve existing technology” (Appeal Br. 9; Reply Br. 2). More particularly, Appellants argue that

Claims 1 and 11 are directed toward a method and a system of structural details for producing a customizable ball bat that includes a unique element that is fixedly engaged to the handle portion and the barrel portion of the bat. The element separates the handle portion from the barrel portion and includes an inner tubular wall for engaging the handle portion and a frusto-conical shaped barrel engaging region for engaging the barrel portion. Additionally, the barrel portion at least partially overlaps the element, and the element at least partially overlaps the handle portion. These limitations are not abstract ideas but rather provide for a unique construction of a multi-piece ball bat.

(Appeal Br. 9; Reply Br. 2).

Under the first prong of step 2A of the 2019 Revised Guidance, we first determine if the claims recite an abstract idea. In this regard, we note that the Specification is titled “SYSTEM FOR CUSTOMIZING A BALL BAT.” The Specification discloses that “[t]he present invention relates to an element for coupling a handle portion to a barrel portion of a ball bat, and a system and method of customizing a ball bat” (Spec. ¶ 2). According to the Specification, “[t]he cost of many existing bat constructions can be very high due to the complexity of the construction, the cost of the materials, and the time required to produce the finished ball bat” and “[t]he wide variety of bat constructions and materials can make it difficult for bat retailers to know

which bats to stock” (*id.* ¶ 4). Thus, “[a] need exists for bat configurations that provide exceptional performance, durability and reliability characteristics without excessive material and/or manufacturing costs” (*id.* ¶ 5). To address this need, the present invention “provide[s] an efficient, easy to use tool, system or method that would allow a user to customize his or her bat and obtain a bat that matches that player’s particular needs including design, skill level, performance and durability” (*id.*).

Consistent with this description, independent claim 1 recites broadly a method for “producing a customizable ball bat” including a series of steps for presenting a user with customizable options and receiving the user’s selections for each of the customizable options. More particularly, independent claim 1 includes steps for [a] “presenting . . . a plurality of handle portions of the ball bat,” [b] “receiving user input,” [c] “presenting . . . a plurality of barrel portions of the ball bat,” [d] “receiving user input,” [e] “presenting . . . a plurality of elements” (e.g., “the element separating the handle portion from the barrel portion”), [f] “receiving user input,” [g] “presenting a representation of the ball bat in an assembled state on the display” according to the user’s selections, [h] “receiving user input . . . confirming the selection[s],” and [i] “producing the customized ball bat” based on the user’s selections.

Upon reviewing the Specification and the claim as whole, as summarized above, we agree with the Examiner that exemplary independent claim 1 is directed to a series of steps for “customizing a ball bat,” and thus, directed to a form of marketing and sales activities. Here, exemplary independent claim 1 simply runs a user through a bat-customization process by presenting a user with several customizing options, receiving the user’s selection for each of the options, presenting a representation of the ball bat

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based on the user’s selections, receiving a confirmation based on the representation, and “producing the customized ball bat.” Because independent claim 1 recites marketing and sales activities, it recites fundamental economic practices and/or commercial interactions that, under the Guidance, fall under the category of “certain methods of organizing human activity.” Thus, exemplary independent claim 1 recites an abstract idea. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed Cir. 2014) (holding that claim “describ[ing] only the abstract idea of showing an advertisement before delivering free content” is patent ineligible); *In re Ferguson*, 558 F.3d 1359, 1364 (Fed Cir. 2009) (holding methods “directed to organizing business or legal relationships in the structuring of a sales force (or marketing company)” to be ineligible).

Next, we turn to the second prong of step 2A of the 2019 Revised Guidance and determine whether the claims recite a practical application of the recited judicial exception. Here we look to see if, for example, (i) any additional elements of the claims reflects an improvement in the functioning of a computer or to another technological field, (ii) an application of the judicial exception with, or by use of, a particular machine, (iii) a transformation or reduction of a particular article to a different state or thing (iv) or a use of the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment. *See* 2019 Revised Guidance, 84 Fed. Reg. at 55; *See also* MPEP § 2106.05(a)–(c), (e)–(h).

Appellants argue that the present claims “are directed toward a method and a system to improve existing technology” (Appeal Br. 9; Reply Br. 2). However, we find no indication in the Specification that the present invention improves a computer or other technology, invokes any assertedly

inventive programming, requires any specialized computer hardware or other inventive computer components (*see, e.g.*, Spec. ¶¶ 67–87), i.e., a particular machine, or that the claimed invention is implemented using other than generic computer components to perform generic computer functions. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”) (*see also* Ans. 6–7). Instead, we agree with the Examiner that “any improvement found in the claim is to the method of performing the commercial activity itself (i.e. customizing a ball bat)” (*id.* at 6; *see also* Final Act. 3–4). Thus, the “improvement” to which Appellants refer is a business improvement rather than an improvement to a technological or technical field (*see OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (“[R]elying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.”) (*see also* Ans. 7).

Appellants also argue that the present claims “transform the unique group of selections into a unique customized ball bat” inasmuch as exemplary independent claim 1 “produc[es] the customized ball bat” (Appeal Br. 10–11; Reply Br. 3–4). However, we find no indication in the Specification that the claimed invention effects a transformation or reduction of a particular article to a different state or thing. Here, as the Examiner points out:

there is no disclosure of the physical production of the ball bat recited in [Appellants’] claims or [S]pecification. Specification paragraph [0074] states that “the device interface 214 can transfer the selected information or process selection information to a retailer, manufacturer, or supplier of the customized bat for

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processing.” As such, [limitation [i]] is merely the transmission of the user’s selections to a third party, not the physical creation of the ball bat.

(Ans. 9 (emphases omitted); *see also* Final Act. 3). Nor do we find anything of record, short of attorney argument, that attributes any improvement in computer technology and/or functionality to the claimed invention or that otherwise indicates that the claimed invention “appl[ies], rel[ies] on, or us[es] the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *See* 2019 Revised Guidance, 84 Fed. Reg. at 54.

Turning to Step 2B of the of the 2019 Revised Guidance, we determine whether the additional elements (1) add a specific limitation or combination of limitations that is not well-understood, routine, and conventional activity in the field, which is indicative that an inventive concept may be present or (2) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception, which is indicative that an inventive concept may not be present. *See* 2019 Revised Guidance, 84 Fed. Reg. at 56.

The Examiner determines under step two in the *Alice* framework that “Claim 1 does not include additional elements sufficient to amount to more than the judicial exception” (Final Act. 3). More particularly, the Examiner states that limitations [a]–[h] “are directed to mere data gathering and transmission” (Final Act. 3), and as discussed above, limitation [i] merely “[t]ransmit[s] the selected customized features of the ball bat to a manufacturer” which “again amounts to mere data transmission” (*id.*).

In response, Appellants argue that independent claim 1 “provide[s] an ‘inventive concept’ that improves technology by providing a method and system of assembling a unique multi-piece ball bat that includes a novel element” (Appeal Br. 9–10 (citing *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016))).

However, Appellants do not point to anything in the claims that resembles the improvement to the technical field of computer animation that was not simply the use of a generic computer in *McRO*. Appellants do not direct our attention to anything in the Specification to indicate that the present invention provides an improvement in the computer’s technical functionality. The claims do not recite assembling a bat, but merely “producing” that can comprise manual selection based on the data gathered. *See Spec. para. 74–75*. The claims also fail to include any technical element or details for implementing the steps, and the “improvement” to which Appellants refer is a business improvement rather than a technological one.

Appellants also argue that the present claims are similar to those at issue in *Trading Technologies Int’l, Inc. v. CQG, Inc.*, 675 F. App’x 1001 (Fed. Cir. 2017) because

the use of the unique element separating the barrel portion of the bat from the handle portion of the bat provides the bat with a unique construction, and the method and system of the pending claims significantly enhances the ability of a user to customize a bat that is ideal for his or her particular application or organized league. The pending claims provide a solution to users by significantly increasing the level of customization of the ball bat. (Appeal Br. 10; *see also* Reply Br. 3–4). We cannot agree.

In *Trading Technologies*, the district court found that the claimed devices “have no ‘pre-electronic trading analog,’” and “do not simply claim displaying information on a graphical user interface.” *Trading Techs.*, 675

Fed. Appx. at 1004. The court concluded “the claimed subject matter is ‘directed to a specific improvement to the way computers operate,’ . . . for the claimed graphical user interface method imparts a specific functionality to a trading system ‘directed to a specific implementation of a solution to a problem in the software arts.’” *Id.* at 1006. We distinguish the claims before us from those in *Trading Technologies*, because, unlike in *Trading Technologies*, independent claim 1 merely guides a user through a bat customization process and then “produc[es] the customized ball bat” by “transfer[ing] the selection information or process selection information to a retailer, manufacturer or supplier of the customized bat for processing” (*see* Spec. ¶ 74). Here, the Specification describes that “[i]f the information is being provided to a retailer, for example the retailer can review its stock and select the bat components having the feature characteristics specified by the user” (*id.* ¶ 75), and as such, “producing” may simply comprise manual selection based on the information provided. Thus, independent claim 1 does not overcome a problem associated with prior art user interfaces or improve the way computers operate, but rather, addresses a business problem relating to the customization of bats using generic computer systems operating in their ordinary capacity (*cf.* Spec. ¶¶ 67–87; Ans. 9–10).

We are not persuaded, on the present record, that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection of independent claim 1, and claims 2–5, 7–14, and 16–20, which fall with independent claim 1.

DECISION

The Examiner’s rejection of claims 1–5, 7–14, and 16–20 under 35 U.S.C. § 101 is affirmed.

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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