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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/860,542	09/21/2015	Danuta Highet	66866-9	8652

35161 7590 01/31/2019
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EXAMINER

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ART UNIT	PAPER NUMBER
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3711

MAIL DATE	DELIVERY MODE
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01/31/2019

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DANUTA HIGHET and ROBERTA CAHN

Appeal 2017-010805
Application 14/860,542
Technology Center 3700

Before JAMES P. CALVE, BRANDON J. WARNER, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

WARNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Foqus, Inc. (“Appellant”)¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 12–16 and 19–22, which are all the pending claims. Appeal Br.1, 5. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

¹ Foqus, Inc. is the applicant, as provided in 37 C.F.R. § 1.46, and is identified as the real party in interest. Appeal Br. 3.

CLAIMED SUBJECT MATTER

Appellant's disclosed invention "relates to an incrementally-sized standard-sized eating-ware system and processes for weight management." Spec., p. 1, ll. 13–14. Claim 12, reproduced below with emphasis added, is the sole independent claim and is representative of the subject matter on appeal.

12. A method, comprising:

selecting a plate with a surface area within a range of 11-13 in² and designating the selected plate as a zero on a whole-number numerical index;

selecting a plate increment between 1/16-inch and 1 inch;

starting at one, designating a whole number (N) in the index to correspond with a plate having a first dimension equal to the plate increment plus a first dimension of a corresponding plate (N-1);

providing a series of different-sized plates, each successive-sized plate's first dimension differing from its series neighbor by the plate increment;

on each of the series of different-sized plates, marking an indicia representing the plate's relative position in a hierarchical order of the index;

assigning a value of zero on the whole-number numerical index to a utensil with an ellipsoid circumscribing a food-carrying portion of the utensil, the ellipsoid having equal minor radii of 0.25 inches and a major radius of 0.5 inches;

selecting a positive utensil increment of 0.025 inches or less[], the increment being an increment of a minor radius of an ellipsoid with equal minor radii and a major radius equal to 1.5 times the minor radii plus 0.125 inches, the ellipsoid circumscribing a food-carrying portion of a utensil;

providing a series of different-sized eating utensils, each successive-sized utensil differing from its series neighbor by the utensil increment;

starting at one, designating a whole number (N) in the index to correspond with a utensil having a first minor radius equal to the utensil increment plus the minor radius of a corresponding utensil (N-1); and

on each of the series of different-sized utensils, marking an indicia representing the utensil's relative position in the hierarchical order of the index using the *same indicia* that the plates are marked with.

EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

Montesi	US 4,043,203	Aug. 23, 1977
Matson	US 7,044,739 B2	May 16, 2006

REJECTIONS

The following rejections are before us for review:²

- I. Claims 12–16 and 19–22 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 3–5; Ans. 2–4.
- II. Claims 12–16 and 19–22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Matson and Montesi. Final Act. 6–9; Ans. 4–8.

² We note that a rejection of claims 12 and 19 under 35 U.S.C. § 112, second paragraph, as being indefinite has been withdrawn by the Examiner and thus is not before us for review as part of the instant appeal. Ans. 8; *see also* Final Act. 2–3.

ANALYSIS

Rejection I – Ineligible Subject Matter

The Examiner rejects claims 12–16 and 19–22 under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more, asserting that the claims are directed to “an abstract idea in the form of mental or abstract steps for correlating and defining relationships between numbers and plates/utensils.” Final Act. 3; *see id.* at 3–5; Ans. 2–4.

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. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014) (emphasis added) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012)). Under that framework, we first “determine whether the claims at issue are directed to one of those patent-ineligible concepts”—i.e., a law of nature, a natural phenomenon, or an abstract idea. *Id.* (citing *Mayo*, 132 S. Ct. at 1296–97).

The Federal Circuit has instructed that “[t]he ‘directed to’ inquiry . . . [does not] simply ask whether the claims *involve* [or *encompass*] a patent-ineligible concept, because essentially every routinely patent-eligible claim involving physical products and actions *involves* a law of nature and/or natural phenomenon.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). Rather, “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Id.* (citing *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

It is only after the claims have been determined to be “directed to” a patent-ineligible concept that we 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.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1298, 1297).

Although not explained in the rejection, the Examiner—presumably under the first step of the *Alice* framework—concludes that the claims are directed to an abstract idea, stating that “[t]he inventive concept of the claims is directed to [an] abstract concept in the form of relationships between plate surface areas/utensil sizes and corresponding whole number values,” which the Examiner asserts is a concept that “is not patent eligible.” Ans. 4. However, simply because the present claims “include” these relationships, the Examiner has not sufficiently shown that the claims, as a whole, are “*directed to*” an abstract idea itself. Rather, as Appellant explains, the present claims include the *application* of such relationships in the provision of particularly-sized series of both plates and eating utensils. *See* Appeal Br. 11–13; Reply Br. 1–2; *see also* Appeal Br., Claims App.

Upon review of the record before us, the claims are directed to a method that expressly recites providing a series of specifically-sized plates (the plates being particularly size-incremented relative to one another), as well as providing a series of specifically-sized eating utensils (the utensils also being particularly size-incremented relative to one another), where indices of the respective series of plates and utensils are marked on the same scale. *See* Appeal Br., Claims App. This is not merely an abstraction; rather, it is a concrete implementation of a method that requires providing

particular physical things—namely, the respective series of specific, incrementally-sized plates and utensils—not just any generic dishware that the Examiner mentions as being conventional.

Although the Examiner may be correct that generic “plates and utensils would be used in nearly every diet system as they are common eating components” (Ans. 4), the claims do not merely recite generic plates and utensils, as explained above (*see* Appeal Br., Claims App.). In other words, while generic plates and utensils may be conventional, the record does not establish that the same could be said for the respective series of specific, incrementally-sized plates and utensils, where indices of the respective series of plates and utensils follow the same scale, as recited in the claims.

As to the initial abstract idea determination here, and critical to our resolution of the issue before us for review, we agree with Appellant’s argument that the plain language of the claims “recites more than [a] method of organizing human activity and more than an alleged abstract idea itself.” Appeal Br. 12. Thus, even though the claims *involve* relationships between whole numbers and plates/utensils, the rejection presented fails the initial threshold step of explaining why the claims, as a whole, are “*directed to*” nothing more than an abstract idea itself.

In light of this deficiency, we do not sustain the Examiner’s rejection.

Rejection II – Obviousness

As discussed above, the claims here require providing a series of specifically-sized plates (the plates being particularly size-incremented relative to one another), as well as providing a series of specifically-sized

eating utensils (the utensils also being particularly size-incremented relative to one another), where indices of the respective series of plates and utensils are marked on the same scale. *See* Appeal Br., Claims App. In rejecting the claims, the Examiner relies on a combination of teachings from Matson and Montesi. *See* Final Act. 6–9; Ans. 4–8.

As the requisite articulated reasoning for combining the teachings from these individual references, the Examiner states that it would have been obvious to provide Matson’s series of plates with the feature of “selecting and providing a series of eating utensils as taught by the controlled nutritional system of Montesi for the purpose of further providing for precise measurements of food portions.” Final Act. 7–8. But this reasoning, which is based on evidence from dissociated series of plates and utensils, does not adequately account for the fact that the claims recite that the indices of the respective series of specifically-sized plates and utensils are made according to the same scale.

In short, we agree with Appellant that the rejections do not sufficiently explain *why* a person of ordinary skill in the art would have combined these disparate teachings to provide both a series of plates and a series of utensils, with each series having a constant and indexed size increment, where both of the respective series use the same index. *See* Appeal Br. 13–16; Reply Br. 2–4.

Stated another way, the Examiner has not sufficiently articulated reasoning based on rational underpinnings as to why one skilled in the art would have been prompted to combine the teachings of Matson and Montesi in the manner proposed. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (stating that “[r]ejections on obviousness grounds cannot be

sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006))). Moreover, in response to Appellant’s arguments, the Examiner does not provide any additional explanation as to why such individual teachings would be combined to arrive at the *same index* being used for both a series of incrementally-sized plates and a series of incrementally-sized utensils. *See* Ans. 12–13.

Although we agree with the Examiner that marking the index values on each of the plates and utensils, by itself, would be insufficient to convey patentability (*see* Final Act. 8–9; Ans. 13), the underlying structural limitations of the respective series of incrementally-sized plates and incrementally-sized utensils (which the markings simply label for convenience) must be accounted for. In other words, setting aside the Examiner’s printed matter position with respect to the marking alone, a reason to arrive at the two series being physically sized according to a common index remains unexplained.

Rejections based on obviousness must rest on a factual basis; in making such a rejection, the Examiner has the initial burden of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in the factual basis. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). Here, absent improper hindsight reconstruction, we do not see a sufficient reasoned explanation based on a rational underpinning as to why one of ordinary skill in the art would have been led to modify Matson with Montesi to use the *same index* for the

respective series of plates and utensils, and a reason for such modification is not otherwise evident from the record.

A sustainable obviousness rejection needs to explain the reasoning by which those findings support the Examiner's conclusion of obviousness. *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328–30 (Fed. Cir. 2009). In this case, the rejections fail to meet this required standard.

Accordingly, based on the record before us, the Examiner has not met the burden of establishing a proper prima facie case of obviousness. On this basis, we do not sustain the Examiner's rejection.

DECISION

We REVERSE the Examiner's decision rejecting claims 12–16 and 19–22 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

We REVERSE the Examiner's decision rejecting claims 12–16 and 19–22 under 35 U.S.C. § 103(a) as being unpatentable over Matson and Montesi.

REVERSED