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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DONALD J. BOWEN, PATRICIA E. BOWEN,
PAUL D. HEITMANN, and ROBERT R. MILLER II

Appeal 2017-011020
Application 12/628,302¹
Technology Center 2100

Before JUSTIN BUSCH, JAMES W. DEJMEK, and
JOHN D. HAMANN, *Administrative Patent Judges*.

DEJMEK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1, 3, 5–14, and 17–24. Appellants have canceled claims 2, 4, 15, and 16. App. Br. 32–35. We have jurisdiction over the remaining pending claims under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify AT&T Intellectual Property I, L.P. as the real party in interest. App. Br. 3.

STATEMENT OF THE CASE

Introduction

Appellants' disclosed and claimed invention generally relates to "mobile energy storage devices, and more particularly, to a method and system for managing the provisioning of energy to or from the mobile energy storage devices." Spec. ¶ 1. In a disclosed embodiment, the mobile energy storage device provides power to an electric vehicle. Spec. ¶¶ 10, 12.

Claim 1 is representative of the subject matter on appeal and is reproduced below:

1. A method, comprising:

receiving, by a processor of an application server deployed in a communication network operated by a service provider and over the communication network, information pertaining to a current intended energy use for a mobile energy storage device associated with a user, wherein the mobile energy storage device comprises a vehicle;

analyzing, by the processor, whether the current intended energy use is achievable based upon a current energy state of the mobile energy storage device, wherein the current intended energy use comprises a current location of the mobile energy storage device and an intended destination, wherein the analyzing applies energy repository information comprising a charging location, a charging type information pertaining to the charging location, and an opportunity to sell charge that is stored in the mobile energy storage device to generate a first recommendation, wherein the charging type information indicates an availability of a fast charging resource or an availability of a slow charging resource at the charging location, wherein the charging type information further comprises an energy availability of the charging location, wherein the opportunity to sell charge comprises an opportunity to sell charge to another user; and

providing, by the processor over the communication network, the first recommendation to a mobile phone associated with the user in response to the current intended energy use, wherein the first recommendation is to be displayed on a display of the mobile phone.

The Examiner's Rejection

Claims 1, 3, 5–14, and 17–24 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 4–8.

ANALYSIS²

Appellants dispute the Examiner's conclusion that the pending claims are directed to patent-ineligible subject matter under 35 U.S.C. § 101. App. Br. 15–31; Reply Br. 2–9. In particular, Appellants argue the Examiner erred in characterizing the claims as being directed to the “determination, via a processor, of whether a destination is reachable based on charge levels” and that the Examiner failed to consider “substantial features” recited in the pending claims. App. Br. 18–21; Reply Br. 5. Additionally, Appellants assert that by reciting using an application server to generate and provide a recommendation to a mobile device, the claims “clearly describe[] an improvement to a communications network” by allowing for more lightweight mobile devices and/or mobile energy storage devices. App. Br. 21–22, 27–28. Further, Appellants contend the claims recite steps that cannot be performed by a human (i.e., not mere mental steps) and that the

² Throughout this Decision, we have considered the Appeal Brief, filed May 8, 2017 (“App. Br.”); the Reply Brief, filed August 23, 2017 (“Reply Br.”); the Examiner's Answer, mailed June 23, 2017 (“Ans.”); and the Final Office Action, mailed December 5, 2016 (“Final Act.”), from which this Appeal is taken.

“claims recite features that are not practices that are well understood or routine.” App. Br. 23; Reply Br. 4.

The Supreme Court’s two-step framework guides our analysis. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). If a claim falls within one of the statutory categories of patent eligibility (i.e., a process, machine, manufacture, or composition of matter) then the first inquiry is whether the claim is directed to one of the judicially recognized exceptions (i.e., a law of nature, a natural phenomenon, or an abstract idea). *Alice*, 134 S. Ct. at 2355. If so, the second step is to determine whether any element, or combination of elements, amounts to significantly more than the judicial exception. *Alice*, 134 S. Ct. at 2355.

Although the independent claims each broadly fall within the statutory categories of patentability, the Examiner concludes the claims are directed to a judicially recognized exception—i.e., an abstract idea. Final Act. 5–6. In particular, the Examiner concludes the claims are directed to “using a processor of an application server to determine whether a current intended use is achievable based upon a current energy state . . . to generate a recommendation.” Final Act. 5; Ans. 3–4. Additionally, the Examiner concludes the determination of whether a destination is reachable is representative of a mathematical determination and the generation of a recommendation based upon the determination are similar to other concepts that courts have deemed to be abstract. Final Act. 5; Ans. 4.

Instead of using a definition of an abstract idea, “the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.” *Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*,

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841 F.3d 1288, 1294 (Fed. Cir. 2016) (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016)); accord United States Patent and Trademark Office, *July 2015 Update: Subject Matter Eligibility* (July 30, 2015), <https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf> (instructing Examiners that “a claimed concept is not identified as an abstract idea unless it is similar to at least one concept that the courts have identified as an abstract idea.”). As part of this inquiry, we must “look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Tex., LLC v. DirecTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

Here, Appellants’ claims generally relate to receiving information regarding a current intended energy use for a mobile energy storage device, such as a vehicle. Based upon the current energy state of the mobile energy storage device, the current location, and the intended destination of the mobile energy storage device (i.e., vehicle), an analysis—including energy repository information—is performed to determine whether the current intended energy use is achievable. The results of the analysis are presented as a recommendation to a user for display on the user’s mobile phone. Appellants characterize the claims as reciting “a new and non-conventional process for generating and providing a recommendation to a mobile device from an application server in a communication network as to whether a current intended energy use of a mobile energy storage device/vehicle is achievable.” Reply Br. 4.

Our reviewing court has concluded that abstract ideas include the concepts of collecting data, recognizing certain data within the collected data

set, and storing the data in memory. *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347 (Fed. Cir. 2014); *see also Smart Sys. Innovations, LLC v. Chicago Transit Authority*, 873 F.3d 1364, 1372 (Fed. Cir. 2017) (concluding “claims directed to the collection, storage, and recognition of data are directed to an abstract idea”).

Additionally, the collection of information and analysis of information (e.g., recognizing certain data within the dataset) are also abstract ideas. *Elec. Power*, 830 F.3d at 1353. Similarly, “collecting, displaying, and manipulating data” is an abstract idea. *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017); *see also SAP Am., Inc. v. InvestPic, LLC*, No. 2017-2081, slip op. at 8–9 (Fed. Cir. May 15, 2018) (“merely presenting the results of abstract processes of collecting and analyzing information . . . is abstract as an ancillary part of such collection and analysis”) (quotations omitted). Moreover, our reviewing court recently has concluded that acts of parsing, comparing, storing, and editing data are abstract ideas. *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1366 (Fed. Cir. 2018).

Further, merely combining several abstract ideas does not render the combination any less abstract. *RecogniCorp, LLC v. Nintendo Co. Ltd.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“Adding one abstract idea (math) to another abstract idea . . . does not render the claim non-abstract.”); *see also FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (determining the pending claims were directed to a combination of abstract ideas).

Here, the claims are directed to determining whether a current intended energy use for a mobile energy storage device is achievable based

on the current location of the mobile energy storage device, an intended destination, and energy repository information. The results of the determination are presented to a user in the form of a “first recommendation to a mobile phone associated with the user.” The claims recite a processor receives information, and analyzes the received information along with additional information (i.e., energy repository information) to generate a recommendation (i.e., a determination whether the intended use is achievable) to be displayed to a user. Contrary to Appellants’ assertions (*see, e.g.*, App. Br. 21–22), the claims are not directed to an improvement to a communications network, but rather use a communication network as part of performing the abstract idea. We agree with the Examiner that the claims, as a whole, are directed to a combination of abstract concepts.

In particular, the steps of receiving and providing information (e.g., current intended energy use and a recommendation based on an analysis of information) over a communication network are similar to ideas that our reviewing court previously concluded were abstract. *See, e.g., Affinity Labs*, (holding that claims were directed to an abstract idea where they claimed “the function of wirelessly communicating regional broadcast content to an out-of-region recipient, not a particular way of performing that function”); *see also Elec. Power*, 830 F.3d at 1353 (concluding “collecting information, analyzing it, and displaying certain results of the collection and analysis” is abstract). Further, analyzing information either by steps that one may perform in their mind or by mathematical algorithm has also been determined to be abstract. *Elec. Power*, 830 F.3d at 1354.

Because we determine the claims are directed to an abstract idea or combination of abstract ideas, we analyze the claims under step two of *Alice*

to determine if there are additional limitations that individually, or as an ordered combination, ensure the claims amount to “significantly more” than the abstract idea. *Alice*, 134 S. Ct. at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294, 1297–98 (2012)). The implementation of the abstract idea involved must be “more than [the] performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction*, 776 F.3d at 1347–48 (quoting *Alice*, 134 S. Ct. at 2359) (alteration in original). “Whether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination.” *Berkheimer*, 881 F.3d at 1369.

Here, we agree with the Examiner that the additional limitations, separately, or as an ordered combination, do not provide meaningful limitations (i.e., do not add significantly more) sufficient to transform the abstract idea into a patent eligible application. Final Act. 6–7; Ans. 4–6. The Examiner finds, and we agree, reciting a processor as part of the communication network operated by a service provider represents conventional and routine use of an application server and, further, that providing a recommendation from the processor to a mobile phone is merely outputting a result using conventional data transmission methods. Final Act. 7. The Examiner cites several patents and published applications in support of this finding. Final Act. 7.

Appellants dispute that the claims “recite generic computer components that are performing activities that are routine, conventional, or previously known in the pertinent industry,” but do not provide persuasive evidence or argument to support this position. App. Br. 29–30; Reply Br. 6–

9. Further, we note the Specification discloses the use of a “general-purpose computer” for performing the claimed functions. Spec. ¶ 49, Fig. 3; *see also* Spec. ¶¶ 27–28. Additionally, we disagree with Appellants that the claims recite significantly more under step two of *Alice*. Appellants recite the claim language (*see* App. Br. 27–28), but do not provide sufficient persuasive evidence or argument regarding how the recited claim language (e.g., describing the energy repository information) allegedly transforms the abstract idea into a patent-eligible application of that idea. *See also buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (“That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive.”)

To the extent Appellants are asserting a lack of rejection under Sections 102 and/or 103 suggests the instant claims are not “a well-established ‘basic concept’” and/or do not recite well understood, routine, or conventional activities (*see* App. Br. 24–25), we are not persuaded. Subject-matter eligibility under 35 U.S.C. § 101 is a requirement separate from other patentability inquiries. *See Mayo*, 566 U.S. at 90 (recognizing that the § 101 inquiry and other patentability inquiries “might sometimes overlap,” but that “shift[ing] the patent-eligibility inquiry entirely to these [other] sections risks creating significantly greater legal uncertainty, while assuming that those sections can do work that they are not equipped to do”); *see also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (“[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter”); *Two-Way Media Ltd. v.*

Comcast Cable Commc'ns, LLC, 874 F.3d 1329, 1340 (Fed. Cir. 2017) (“[e]ligibility and novelty are separate inquiries”).

Appellants also argue the claims “do not seek to tie up every process” for determining whether a destination is reachable based on charge levels. App. Br. 29; Reply Br. 9.

“[W]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *FairWarning IP*, 839 F.3d at 1098 (quoting *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); see also *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”). Further, “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa*, 788 F.3d at 1379.

For the reasons discussed *supra*, we are unpersuaded of Examiner error. Accordingly, we sustain the Examiner’s rejection of independent claims 1, 14, and 20 under 35 U.S.C. § 101. Additionally, we sustain the Examiner’s rejection of claims 3, 5–13, 17–19, and 21–24, which depend directly or indirectly therefrom and were not argued separately. See App. Br. 18–31; 37 C.F.R. § 41.37(c)(1)(iv)(2016).

DECISION

We affirm the Examiner’s decision rejecting claims 1, 3, 5–14, and 17–24 under 35 U.S.C. § 101.

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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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED