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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KOJI TOYAMA, SATOSHI SUEHIRO, and
YOSHIHIRO NAKAYAMA

Appeal 2018-001319
Application 14/226,925
Technology Center 2800

Before KAREN M. HASTINGS, JAMES C. HOUSEL,
and DEBRA L. DENNETT, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ requests our review under 35 U.S.C. § 134 of the Final Rejection of claims 1, 3–8, and 10 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellant is the Applicant, Mitsubishi Aircraft Corporation, which is also identified as the real party in interest (Appeal Br. 2).

THE INVENTION

Claim 1 reproduced below, is illustrative of the subject matter on appeal:

1. A safety analysis system for wiring in a wiring structure in which each of a plurality of electric wires belonging to a wire harness is connected to a pair of connectors located at terminals via a relay element, the safety analysis system comprising:
 - a storage unit that stores:
 - electric wire-terminal connector correlation information in which each of the plurality of electric wires and the pair of connectors are correlated with each other,
 - terminal connector-function correlation information in which the pair of connectors located at the terminals and a function of a device to which the connectors are connected are correlated with each other, and
 - function determination information including a combination of a plurality of functions that are not allowed to be lost at the same time; and
 - a processing unit that matches the electric wire-terminal connector correlation information and the terminal connector-function correlation information when the wire harness is identified, and generates electric wire-function correlation information in which each of the plurality of electric wires and the function of the device are correlated with each other,

wherein the processing unit determines whether or not the combination of the plurality of functions included in the function determination information exists in the generated electric wirefunction correlation information, and evaluates that the wire harness has safety when the combination does not exist.

Appeal Br. 17 (Claims Appendix).

Independent claim 8 is similar to claim 1, however, claim 8 requires that

the processing unit determines whether or not the plurality of separation requirement codes included in the generated electric wire-separation requirement correlation information are identical, and evaluates that the wire harness has safety when the plurality of separation requirement codes are identical.

Appeal Br. 19 (Claims Appendix).

ANALYSIS

The rejection under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Alice Corp. Pty. Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014), identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under § 101.

According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355. In that regard, the Examiner determined that the claims are directed to a system and “that the claims recite an abstract idea as the claims recite a system that employs mathematical algorithms for gathering and combining data to generate additional information using a generic processor” and concluded that the subject matter of the claims is directed to the judicial exception of abstract ideas. Ans. 3; Final Act. 3–6.

Appellant challenges the Examiner’s articulation of what the claims are directed to, but the challenge is unfounded. *See* Appeal Br. 6–9. For example, the fact that the claims are drafted to “describe particular types of

information that are stored and particular processing as part of a safety analysis” (Appeal Br. 8) is not dispositive. The question is what the claims are “directed to.”

[T]he “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.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015); *see Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1375, 2016 WL 1393573, at *5 (Fed. Cir. 2016) (inquiring into “the focus of the claimed advance over the prior art”).

Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1335 (Fed. Cir. 2016). “The ‘abstract idea’ step of the inquiry calls upon us to 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 Texas v. DirectTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)). “In determining the eligibility of respondents’ claimed process for patent protection under § 101, their claims must be considered as a whole.” *Diamond v. Diehr*, 450 U.S. 175, 188 (1981).

As set out in the Description of the Related Art section of Appellant’s Specification, it was known to check whether a wire harness is wired with required safety before using it (Spec. ps. 1, 2). Claim 1 is directed to qualitatively analyzing the safety of the wiring using, e.g., stored electric wire-terminal connector correlation information, and a

processing unit may determine whether or not the combination of the plurality of functions included in the function determination information exists in the generated electric wire

function correlation information, and may evaluate that the wire harness has safety when the combination does not exist.

(Spec. 3, second full paragraph)

As pointed out by the Examiner, Appellant's Specification also states

Although the evaluation may also be performed by a person referring to the generated electric wire-function correlation information, a more quick and accurate evaluation result can be obtained by the processing unit.

(Spec. 3, third full paragraph; emphasis added)

Independent claim 8 is similarly directed to qualitatively analyzing the safety of the wiring using stored correlation information.

Accordingly, the claims as a whole, in light of the Specification, are directed to performing mathematical functions, which is consistent with the Examiner's position (Final Act. 5–6). Thus, the claims are directed to using abstract ideas. However, a patentable invention must do more than use or apply abstract ideas. *See Electric Power v. Alstom*, 830 F.3d at 1354 (Claims for “a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions . . . are . . . directed to an abstract idea.”).

Step two is “a search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 134 S. Ct. at 2355 (alteration in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73

(2012)). Appellant’s argument that the Examiner has not established that the claims are not directed to significantly more because only a conclusory statement was made with no analysis (Appeal Br. 10) is not persuasive of reversible error. The Examiner determined that, generically linking the use of a judicial exception to a particular technological environment or field of use (i.e., optical profilometry) is insufficient because the claims do not include additional elements that are sufficient to constitute significantly more than the abstract idea because they do not “provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claims amounts to significantly more than the abstract idea itself” (Ans. 10). Notably, the Supreme Court has also rejected the idea that claims become patent eligible simply because they disclose a specific solution to a particular problem; *Alice*, 134 S. Ct. 2358 (“patenting abstract ideas cannot be circumvented by attempting to limit the use of [the idea] to a particular technological environment”).

The Specification does not support Appellant’s argument that the claims comprise additional elements that constitute significantly more than the abstract idea of using mathematical correlation information and equations to determine wire harness safety. The claims do not specify any devices as performing the mathematical steps other than “a storage unit” and “a processing unit”. These are references to well-understood, routine, and conventional techniques and devices known in the art. *See Mayo*, 566 U.S. at 73 (claims directed to an ineligible concept must do more than add steps that “involve well-understood, routine, conventional activity previously engaged in by researchers in the field”). In addition, the Specification does

not disclose the mathematical steps as being tied to any special or non-generic hardware. *Cf. Alice*, 134 S. Ct. 2358 (citation omitted). “[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea ‘while adding the words ‘apply it’” is not enough for patent eligibility.” *Id.*

Further, the Examiner concluded that the claims in Appellant’s invention do not even measure any data, and “nothing concrete is done with the information” (Ans. 6) and that there is “no concrete industrial process recited” and thus no specific application of the safety analysis for example “for a computer server, an airplane, a boat, or a car” (Ans. 7).

Indeed, the value or usefulness of the safety analysis is not dispositive of patent eligibility. *Parker v. Flook*, 437 U.S. 584, 594–95 (1978) (cited with approval in *Alice*, 134 S. Ct. 2347) (Determining claims to “a new and presumably better method for calculating alarm limit values,” which were of undisputed usefulness, to be directed to nonstatutory subject matter.). Rather, “[w]ithout additional limitations, a process that employs mathematical algorithms to manipulate existing information to generate additional information is not patent eligible.” *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 1351 (Fed. Cir. 2014).

For the foregoing reasons, the Appellant has not shown error in the Examiner’s *Alice* step two determination that the claims do not include an element or combination of elements sufficient to ensure that in practice they amount to significantly more than to be upon the ineligible concept itself.

In light of all these principles, a preponderance of the evidence supports the Examiner's conclusion that the claims are directed to patent ineligible subject matter.

The remaining arguments have been carefully considered but are unpersuasive as to error in the rejection.

The rejection of claims 1, 3–8, and 10 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is sustained.

DECISION

The decision of the Examiner is affirmed.

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