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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 14/060,657 | 10/23/2013 | Tim Felke | H0040194-5634 | 9524 |
| 89953 | 7590 | 07/24/2018 | EXAMINER | |
| HONEYWELL/FOGG Patent Services 115 Tabor Road P.O. Box 377 MORRIS PLAINS, NJ 07950 | | | PIERRE LOUIS, ANDRE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2123 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 07/24/2018 | ELECTRONIC |

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TIM FELKE and JEFF VAN DER ZWEEP

Appeal 2018-002150
Application 14/060,657
Technology Center 2100

Before JOHN A. JEFFERY, BRUCE R. WINSOR, and
JUSTIN BUSCH, *Administrative Patent Judges*.

WINSOR, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellants¹ appeal from the Examiner's decision to reject claims 1–20, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify the real party in interest as Honeywell International Inc. App. Br. 1. Honeywell International Inc. is the Applicant for the instant patent application. Bib. Data Sheet.

STATEMENT OF THE CASE

Appellants' disclosed invention relates to "automatically generating a fault model from a network diagram." Abstract. Claim 1, which is illustrative, reads as follows:

1. A method of automatically generating a fault model from a network diagram comprising:

 parsing a network diagram to identify schematic components and schematic interfaces;

 mapping each schematic component to a respective standard component;

 mapping each schematic interface to a respective standard interface;

 generating component failure information for each schematic component based on the respective standard component, wherein component failure information includes standard failure modes of the respective standard component;

 generating interface failure information for each schematic interface based on the respective standard interface, wherein interface failure information includes standard failure modes of the respective standard interface; and

 constructing a fault model specific to the network diagram based on component failure information and interface failure information.

Claims 1–20 stand rejected under 35 U.S.C. § 101² as being directed to ineligible subject matter. *See* Final Act. 3–4.

² All rejections are under the provisions of 35 U.S.C. in effect after the effective date of the Leahy-Smith America Invents Act of 2011 (AIA). *See, e.g.,* Final Act. 2.

Rather than repeat the arguments here, we refer to the Briefs (“App. Br.” filed Nov. 3, 2017; “Reply Br.” filed Dec. 22, 2017) for Appellants’ positions; the Final Office Action (“Final Act.” mailed July 26, 2017) and Examiner’s Answer (“Ans.” mailed Dec. 14, 2017) for the reasoning, findings, and conclusions of the Examiner; and the Specification (“Spec.” filed Oct. 23, 2013). Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2016).

ISSUE

The issue presented by Appellants’ arguments is whether the Examiner errs in concluding that claims 1–20 are directed to ineligible subject matter under 35 U.S.C. § 101.

ANALYSIS

Patent eligibility is a question of law that is reviewable *de novo*. *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012). To be statutorily eligible, the subject matter of an invention must be a “new and useful process, machine, manufacture, or composition of matter, or [a] new and useful improvement thereof.” 35 U.S.C. § 101. We initially note that claims 1–9 are directed to a “method,” i.e., a process; claims 10–16 are directed to a “system” comprising a diagnostic device, i.e., a machine; and claims 17–20 are directed to a “program product comprising a non-transitory processor readable medium,” i.e., an article of manufacture. Thus, each of

the claims is directed to one of the four statutory categories of patentable subject matter.

The Supreme Court, however, has held there are implicit exceptions to the categories of patentable subject matter identified in § 101, including (1) laws of nature, (2) natural phenomena, and (3) abstract ideas. *Alice Corp. Proprietary Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014). To determine whether claims are patent eligible under § 101, we apply the Supreme Court's two-step test as articulated in *Alice*. First, we determine whether the claims are directed to a patent-ineligible concept: laws of nature, natural phenomena, and abstract ideas. *Id.* at 2354–55. If so, we then proceed to the second step and examine the claim's elements—both individually and as an ordered combination—to determine whether the claims contain an “inventive concept” sufficient to transform the claimed abstract idea into a patent-eligible application. *Id.* at 2357.

Alice Step One

Appellants rely on the arguments made for claim 1 to argue the patentability of the remaining pending claims. *See generally* App. Br. 6–12. We, therefore, select independent claim 1 as the representative claim for this group, and the remaining claims 2–20 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

Claim 1 recites four key functions—(a) (one recited step) identifying schematic components and schematic interfaces in a network diagram, (b) (two recited steps) mapping each schematic component and schematic interface to respective standard components and standard interfaces, (c) (two recited steps) generating component failure information for each schematic component and interface failure information for each schematic interface,

and (d) (one recited step) constructing a fault model based on the component failure information and the interface failure information. At a high level of abstraction claim 1, as a whole, is directed to collecting and analyzing data, albeit described more narrowly by limiting its practical application to generating fault models. *See Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240–41 (Fed. Cir. 2016) (finding “[a]n abstract idea can generally be described at different levels of abstraction”).

There is no definitive rule to determine what constitutes an “abstract idea.” Rather, our reviewing court has explained that “both [it] and the Supreme Court have found it sufficient to compare claims at issue to those claims already found to be directed to an abstract idea in previous cases.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016). In that regard, we see little difference between claim 1 here directed to collecting and analyzing data and those in, for example, *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016). Similar to the claims in *Electric Power*,

the claims do not go beyond requiring the collection, analysis, and display of available information in a particular field, stating those functions in general terms, without limiting them to technical means for performing the functions that are arguably an advance over conventional computer and network technology. The claims, defining a desirable information-based result and not limited to inventive means of achieving the result, fail under §101.

Elec. Power, 830 F.3d at 1351. And just as in *Electric Power*, we find that “collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.” *Id.* at 1353.

Nor do Appellants persuasively rebut the Examiner’s conclusion that claim 1 is similar to other abstract ideas our reviewing court has found abstract: a process of organizing information through mathematical correlations, *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344 (Fed. Cir. 2014); and collecting data, recognizing certain data within the collected data set, and storing the recognized data in a memory, *Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass’n.*, 776 F.3d 1343 (Fed. Cir. 2014), *cert denied*, 136 S. Ct. 119 (Mem) (2015). See Final Act. 2–3. Appellants’ argument that the Examiner’s citation to *Digitech* and *Content Extraction* is merely a general assertion that is contrary to more recent precedential case law on subject matter eligibility is unavailing. Reply Br. 2 (citing *Enfish; BASCOM Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016); and *McRO, Inc. v. Bandai Namco Games America, Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016)). The Examiner citing to *Digitech* and *Content Extraction* is consistent with the current decisional mechanism courts now apply. See *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (“Instead of a definition [for what an ‘abstract idea’ encompasses], then, 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.”). Appellants do not identify any case that overrules *Digitech* or *Content Extraction*. Nor do Appellants persuasively identify cases that involved claims more akin to claim 1 than those in *Digitech* and *Content Extraction*. For example, although Appellants assert that, like the claim in *Enfish*, the method of claim 1 improves the capability of a system as a whole (Reply Br.

4–5), Appellants merely identify a more generalized statement of the claim, i.e., the abstract idea, as the “system” being improved (Reply Br. 5). In *Enfish*, it was not the performance of the self-referential data table that was being improved, but rather the performance of the computer system on which the self-referential data tables were used, so that the claim did not present “a situation where general-purpose computer components are added post-hoc to a fundamental economic practice or mathematical equation.” *Enfish*, 822 F. 3d at 1339.

Moreover, a method is merely an abstract idea and is not patent-eligible under § 101 if the method can be performed by human thought alone, or by a human using pen and paper. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011); *see also Gottschalk v. Benson*, 409 U.S. 63, 67 (1972). A human can use pen and paper to perform the four key functions of claim 1 described above. Appellants’ Specification admits fault models can be constructed manually. *See Spec.* ¶ 1. That claim 10 adds a system comprising a diagnostic device and an interface device, and claim 17 adds a program product to perform the four key functions described above does not change our conclusion. *See Alice*, 134 S. Ct. at 2357–58.

For the above reasons, Appellants provide no persuasive argument or evidence showing the claims are not directed to an abstract idea. Thus, we are unpersuaded the Examiner erred in concluding the claims are directed to an abstract idea.

Alice Step Two

Turning to the second step of the *Alice* analysis, because we find that claim 1 is directed to an abstract idea, we “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 Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78 (2012)). “[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Id.* at 2358. The “computer functions must be more than ‘well-understood, routine, and conventional activit[ies]’ previously known to the industry.” *Id.* at 2359 (quoting *Mayo*, 566 U.S. at 73).

We find unavailing Appellants’ argument that claim 1 recites a specific technical solution for automatically generating a fault model. App. Br. 11. The “parsing” and “mapping” functions describe formulating database queries, the “generating” function describe executing the queries, and the “constructing” function describes putting the results of the generating function into a particular report format—all well understood, routine, and conventional functions. Nor is the recited use of generic computer hardware enough to confer subject matter eligibility. *See id.* at 2358 (“[I]f a patent’s recitation of a computer amounts to a mere instruction to ‘implement]’ an abstract idea ‘on . . . a computer,’ that addition cannot impart patent eligibility.”). As to Appellants’ contention that claim 1 represents an “improvement to the capability of the system as a whole,” *see* App. Br. 5, 7–9; Reply Br. 4–5, we are not persuaded that the improvement is to any technology, but rather mere data manipulation to generate a fault model. That is, the asserted improvement to fault model generation does not parallel any improvement to computer functionality itself, such as with

Enfish's "self-referential table for a computer database." *Enfish*, 822 F.3d at 1336.

Nor do we find availing Appellants' argument that claim 1 recites an inventive concept comprising a non-conventional and non-generic arrangement of known, conventional pieces because the Examiner withdrew an obviousness rejection under § 103. App. Br. 11. "[P]atent-eligibility does not turn on ease of execution or obviousness of application. Those are questions that are examined under separate provisions of the Patent Act." *Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1052 (Fed. Cir. 2016) (citing *Mayo*, 566 U.S. at 89–90); see also *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 590–91 (2013). Thus, the mere fact that the Examiner withdrew an obviousness rejection under § 103 does not alter our § 101 analysis.

Nor does Appellants' preemption argument alter our § 101 analysis. App. Br. 11; Reply Br. 5. Preemption concerns are fully addressed and made moot where a claim is deemed to disclose patent ineligible subject matter under the two-part framework described in *Alice*. *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). "While preemption may signal patent ineligible matter, the absence of complete preemption does not demonstrate patent eligibility." *Id.*

Lastly, Appellants contend, for the first time in the Reply Brief, that the Examiner provides no analysis that "the claims do not recite any additional elements that amount to significantly more than an abstract concept, except for mere instructions and elements that are well-understood, routine, and conventional activities." Reply Br. 3. This newly-raised contention is waived as untimely. See 37 C.F.R. § 41.41(b)(2). The

Examiner made a similar finding on pages 2 and 3 of the Final Rejection to which Appellants could have responded in the Appeal Brief. Appellants' belated contention provides the Examiner no opportunity to respond to this contention made only in the Reply Brief. *See Ex parte Borden*, 93 USPQ2d 1473, 1475 (BPAI 2010) (informative). A contention not raised in an appeal brief and raised for the first time in a reply brief and "not responsive to an argument raised in the examiner's answer, including any designated new ground of rejection, will not be considered by the Board for purposes of the present appeal, unless good cause is shown." 37 C.F.R. § 41.41(b)(2).

Even assuming, without deciding, that Appellants' contention is timely, which it is not, the Examiner's findings are Officially Noticed facts "capable of such instant and unquestionable demonstration as to defy dispute." *See In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970) (citations omitted). On this record, then, Appellants' belated challenge did not reasonably comply with the requirements of challenging such Officially Noticed facts. *See* MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 2144.03 (9th ed. Rev. 08.2017, Jan. 2018).

Thus, "the claims at issue amount to 'nothing significantly more' than an instruction to apply the abstract idea . . . using some unspecified, generic computer." *Alice*, 134 S. Ct. at 2360 (citing *Mayo*, 566 U.S. at 71). Accordingly, we are not persuaded the Examiner erred in rejecting the claims as directed to ineligible subject matter under 35 U.S.C. § 101.

CONCLUSION

The Examiner did not err in rejecting claims 1–20 under § 101.

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DECISION

The Examiner's decision to reject claims 1–20 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). *See* 37 C.F.R. §§ 41.50(f), 41.52(b).

AFFIRMED