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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ANGEL A. PENILLA and ALBERT S. PENILLA

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Appeal 2018-002381  
Application 13/797,982  
Technology Center 3600

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Before JOHN A. JEFFERY, DENISE M. POTHIER, and  
JUSTIN BUSCH, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants request that we reconsider our decision of May 28, 2019 (“Dec.”), where we reversed the Examiner’s rejection of claims 1–8, 20–25, 27, 28, and 30–32 under 35 U.S.C. §§ 112 and 103, but affirmed the rejection of those claims under § 101. Request for Rehearing filed July 29, 2019 (“Req. Reh’g”). In particular, Appellants contend that we misapprehended or overlooked aspects of § 101 analysis in applying the

*2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”)

For the reasons noted below, however, we deny the request to modify our decision.

A.

Appellants assert the Guidance requires determining if “a claim” recites a judicial exception under the first step of the *Alice/Mayo* test. Req. Reh’g 4 (quoting Guidance, 84 Fed. Reg. at 54). According to Appellants, our analysis in the decision allegedly contradicts the Guidance by focusing exclusively on whether each isolated limitation recites a judicial exception and, therefore, ignores the overall claim. *See* Req. Reh’g 4–5.

Appellants’ arguments are unavailing. We noted in our decision that, apart from limitations we identify as additional elements, “all of claim 1’s recited steps [are] . . . *collectively* . . . directed to presenting [charge unit install points (CUIPs)] having registered [charge units (CUs)] based on (1) a vehicle’s geo-location, (2) promotion options currently available at CUIPs, and (3) a user’s preferred promotion options.” Dec. 17 (emphasis added); *see also id.* at 30–31. Our emphasis on the term “collectively” in this passage underscores that the claim limitations were not merely considered in isolation as Appellants allege, but rather were considered *collectively*, namely as a whole.

That is, apart from the recited additional elements, our decision noted that claim 1, as a whole, recites an abstract idea, namely presenting CUIPs having registered CUs based on (1) a vehicle’s geo-location; (2) promotion options currently available at CUIPs; and (3) a user’s preferred promotion

options. *See also* Dec. 37 (indicating, apart from claim elements we identify as additional elements, the limitations of independent claim 6 are *collectively* directed to presenting CUIPs having registered CUs based on (a) a vehicle’s geo-location, (b) promotion options currently available at CUIPs, and (c) a user’s preferred promotion options.). Therefore, our decision is consistent with the substantive § 101 law and the Guidance, which sets out policy with respect to the Office’s interpretation of the subject matter eligibility requirements under § 101. *See* Guidance, 84 Fed. Reg. at 51. That the claimed invention recites a combination of abstract ideas as indicated on our decision is of no consequence, for it is well settled that adding one abstract idea to another does not render the claims non-abstract. *See Recognicorp, LLC v. Nintendo Co., Ltd.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017).

B.

Appellants also assert that the Guidance requires considering the claim “as a whole” when evaluating whether the abstract idea is meaningfully limited by integration into a practical application. *See* Req. Reh’g 5 (quoting Guidance, 84 Fed. Reg. at 55). According to Appellants, our analysis misunderstands the Guidance because we referred to several claimed features as the “only” recited elements beyond the abstract idea of claim 1. *See* Req. Reh’g 5 (citing Dec. 24–25).

Appellants’ arguments are unavailing. To be sure, we referred to several claimed features as the only recited elements beyond the abstract idea of claim 1, namely (1) computer implementation “*for processing communication to and from a vehicle using a charge cloud service*”; (2) “*server*” and “*charge cloud service*” performing various steps; (3) “*electronics of the vehicle . . . having wireless communication circuitry for*

*connecting to a network and interfacing with the server*”; (4) “*user interface of the vehicle that communicates with the electronics of the vehicle*”; (5) “*selection of at least one control of the user interface*”; (6) “*the charge cloud service provides user interfaces*”; and (7) “*user account being managed by the server of the charge cloud service.*”<sup>1</sup> Dec. 24–25. But we emphasized that the recited additional elements “do not integrate the abstract idea into a practical application when reading claim 1 *as a whole.*” Dec. 25 (emphasis added). Thus, contrary to Appellants’ contention, we considered the claim *as a whole* when determining that the abstract idea was not integrated into a practical application. Therefore, our analysis is consistent with substantive § 101 law and the Guidance.

Appellants contend that *the combination* of elements in the claims provide for a practical application which may not be present when viewing each claim element in isolation. *See* Req. Reh’g 5. According to Appellants, our analysis is ostensibly inconsistent with the Guidance which states that “[s]ome elements may be enough on their own to meaningfully limit an exception, but other times *it is the combination of elements that provide the practical application.*” *Id.* (quoting Guidance, 84 Fed. Reg. at 55) (bolding and underlining omitted); *see also* Req. Reh’g 9 (arguing that we erred in analyzing single specific elements in a claim for integration into a practical application).

Appellants’ arguments are unavailing. As we noted in our decision, “we (1) identify whether there are any additional recited elements beyond the abstract idea, and (2) evaluate those elements individually and

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<sup>1</sup> Unless otherwise indicated, we italicize and/or quote text reproducing various recited limitations for emphasis and clarity.

*collectively* to determine whether they integrate the exception into a practical application.” Dec. 24 (emphasis added). Thus, contrary to Appellants’ contention, we considered whether *the combination* of elements integrates the exception into a practical application—which it does not. In reaching this conclusion, we not only gave weight to the additional elements consistent with substantive § 101 law and the Guidelines, but we also considered them in combination with the other recited elements such that the claim was interpreted as a whole. *See* Guidance, 84 Fed. Reg. at 55; *see also* Dec. 24–31. Rather than repeat that detailed analysis here, it is incorporated in this decision, along with all other aspects of our earlier decision. *See* 37 C.F.R.

§ 41.52(a) (noting that the Board’s decision on the request for rehearing incorporates the earlier opinion reflecting its decision except for those portions specifically withdrawn).

According to Appellants, known technical problems existed in the charge delivery industry, namely a fractured array of charge services requiring users to find charge locations from multiple websites which leads to distracted driving. *See* Req. Reh’g 5–7. Appellants allegedly solved the known technical problems by providing a unifier registration and database that stores dynamic data from CUIPs. *See id.* at 6 (citing Figs. 4–5).

But, as indicated in the decision, we found unavailing Appellants’ contention that the claimed invention is rooted in technology because it is ostensibly directed to a technical solution. *See* Dec. 25. Notably, on page 25 of the decision, we analogized the claimed invention to the network-controlled electric vehicle charge transfer system that the court held ineligible under § 101 in the *ChargePoint* decision, where the invention did

not improve the particular components recited in connection with that system, but rather merely used network communication to interact with the particular devices or network-controlled charging stations, which was the focus of the claimed invention in that case. *See ChargePoint, Inc. v. SemaConnect, Inc.*, 920 F.3d 759, 766–70, 772–73 (Fed. Cir. 2019).

We also noted in the decision that the claimed invention does not improve (1) a computer itself, or (2) another technology or technical field. *See* Dec. 24–29 (discussing, among other things, why claim 1 is not analogous to *Enfish LLC v. Microsoft Corporation*, 822 F.3d 1327 (Fed. Cir. 2016), *McRO, Inc. v. Bandai Namco Games America, Inc.*, 837 F.3d 1299 (Fed. Cir. 2016), and *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)). Among other things, we noted that “[e]ven assuming, without deciding, that the claimed invention can identify, filter, and present certain CUIPs to a user based on predetermined user preferences faster than doing so manually, any speed increase comes from the capabilities of the generic computer components—not the recited process itself.” Dec. 26. In other words, any purported technological improvement of the claimed invention stems solely from the capabilities of the recited generic computer implementation, particularly given its high level of generality. So while an additional element reflecting an improvement to another technology or technical field can integrate an exception into a practical application (*see* Guidance, 84 Fed. Reg. at 55), we did not misapprehend or overlook such an integration as Appellants seem to suggest. Rather, we determined that the claimed invention, as a whole, lacked such an integration.

Therefore, we remain unpersuaded the claims recite a technical solution that solves a technical problem for the reasons indicated in the decision.

C.

Appellants also argue that because we identified certain functions as insignificant extra-solution activity, we allegedly removed over half of claim 1 from consideration in determining whether the claim integrates the abstract idea into a practical application. *See* Req. Reh’g 8–9 (citing Dec. 29–30). Appellants argue our removal is contrary to the Guidance that requires giving weight to all additional elements, whether or not they are conventional, when evaluating whether a judicial exception integrates into a practical application. *See id.* (quoting Guidance, 84 Fed. Reg. at 55).

Appellants’ arguments are unavailing. In our decision, we identified certain recited functions of claim 1 as not only organizing human activity, mental processes, and using generic computing functions (*see* Dec. 17–18), but also insignificant extra-solution activity that does not integrate the abstract idea into a practical application under an *alternative* interpretation (*see id.* at 29–30). In other words, we held that, under an alternative interpretation, certain recited functions of claim 1 can be considered additional elements that do not integrate the abstract idea into a practical application because they are *also* insignificant extra-solution activity.

Thus, we did not remove over half of claim 1 from consideration in determining whether the claim integrates the abstract idea into a practical application as Appellants contend because we gave weight to all recited limitations, including the additional elements in concluding that the recited

abstract idea is not integrated into a practical application. Therefore, our reasoning is consistent with substantive § 101 law and the Guidance.

D.

Appellants argue because we allegedly ignored conventional elements, we ostensibly misunderstood the Guidance which states that a claim including conventional elements may still integrate an exception into a practical application. *See* Req. Reh’g 9 (citing Dec. 24–25 and quoting Guidance, 84 Fed. Reg. at 55). According to Appellants, because we identified that specific recited functions of claim 1 are generic, we allegedly eliminated the recited generic functions from further consideration as to whether the elements of claim 1 integrate the abstract idea into a practical application. *See* Req. Reh’g 9 (citing Dec. 27–28). Appellants argue such an elimination is counter to the Guidelines that require us to consider “both the element and how it is used or arranged in the claim as a whole.” Req. Reh’g 9–10 (quoting Guidance, 84 Fed. Reg. at 55) (emphasis omitted).

Appellants’ arguments are unavailing. Our determination that the additional elements beyond the abstract idea do not integrate the abstract idea into a practical application when reading claim 1 as a whole (*see* Dec. 24–25) does not ignore any additional elements from consideration—whether generic or not—as to whether claim 1’s additional elements integrate the abstract idea into a practical application. Among other things, we explained why claim 1’s additional elements—whether generic or not—do not improve (1) a computer itself, or (2) another technology or technical field. *See* Dec. 24–29 (explaining why claim 1 is not analogous to *Enfish*, *McRO* and *BASCOM*). For example, we determined that the claimed

invention—regardless of whether its additional elements are generic—does not improve a display mechanism as was the case in *McRO*. *See* Dec. 27. We further noted that the claimed invention—regardless of whether its additional elements are generic—is not analogous to the filtering system improvements in *BASCOM*. *See* Dec. 28. Therefore, our decision is consistent with substantive § 101 law and the Guidance requiring our consideration that conventional elements may still integrate an exception into a practical application.

Accordingly, we have considered the arguments raised by Appellants in the Request, but none of these arguments persuade us that the original decision was in error. We are still of the view the invention set forth in claims 1–8, 20–25, 27, 28, and 30–32 is patent ineligible under 35 U.S.C. § 101 for the reasons noted above and in our earlier decision.

## CONCLUSION

For the foregoing reasons, we have granted Appellants’ request to the extent that we have reconsidered our decision of May 28, 2019, but we deny the request with respect to making any changes therein.

DENIED