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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JURGEN HERRMANN and ALOIS MONZEL

Appeal 2018-003391
Application 13/120,194
Technology Center 2800

Before THU A. DANG, ELENI MANTIS MERCADER, and
HUNG H. BUI, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeal from the
Examiner's Final Rejection to reject claims 1–13, and 16–29. App. Br. 1.
We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “Applicant[s]” as defined in 37
C.F.R. § 1.42. Appellant identifies the real party in interest as KHS GmbH.
Appeal Br. 1.

CLAIMED SUBJECT MATTER

According to Appellant, the invention “relates to a method and a device for identifying objects, in particular, machines, consumer items such as bottles as well as parts hereof,” wherein “a surface of the relevant object is scanned entirely or at least in the region of a part surface and at least one result is derived herefrom.” Spec. 1.

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

1. A method comprising[:]
 - identifying an object,
 - [1] wherein identifying said object comprises scanning at least part of a surface of the object,
 - [2] wherein said at least part of a surface comprises a plurality of points,
 - [3] wherein each point in said plurality of points has an associated value of a physical property,
 - [4] wherein said at least part of a surface defines a domain of a physical property function,
 - [5] wherein a range of said physical property function is the set of all possible values of said physical property,
 - [6] wherein said physical-property function is defined by values of said physical property at each point in said domain,
 - [7] wherein said values are randomly distributed such that, given a first subset of said domain and a second subset of said domain,
 - [8] wherein said first subset and said second subset are disjoint, locations of said first and second subsets cannot be identified based only on said values of said physical property within each subset,
 - [9] wherein scanning comprises measuring values of a physical property at a plurality of points within said at least part of a surface,
 - [10] wherein measuring values of a physical property at a plurality of points within said at least part of a surface

comprises measuring said physical property at a first point, and then, after having measured said physical property at a first point, measuring said physical property at a second point, deriving at least one result from the scanning,

[11] wherein said at least one result is based at least in part on said values of said physical properties, converting the at least one result into characteristic digital values representative of a natural surface of the object; and combining the characteristic digital values together to form at least one key that uniquely identifies the object,

[12] wherein said object is a member of a set of objects, wherein each object in said set of objects has an associated key, wherein each object in said set of objects has a different value of said associated key.

App. Br. 31 (Claim App.) (bracketing added for clarity).

REJECTIONS

Claims 1–13, and 16–29 stand rejected under 35 U.S.C. § 112(a) for lack of written description. Final Act. 6–8.

Claims 20, and 24–29 stand rejected under 35 U.S.C. § 112(a) for lack of enablement. Final Act. 8–9.

Claims 1–13, and 16–29 stand rejected under 35 U.S.C. § 112(b) as being indefinite. Final Act. 9–11.

Claims 1–13, 17–22, and 25 stand rejected under 35 U.S.C. § 101 as being directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea); and not directed to significantly more than the abstract idea itself. Final Act. 4–6.

ANALYSIS

Except where indicated, we adopt the Examiner's findings in the Answer and Final Office Action and we add the following primarily for emphasis. We note that if Appellant failed to present arguments on a particular rejection, we decline to review unilaterally those uncontested aspects of the rejection. *See Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential); *Hyatt v. Dudas*, 551 F.3d 1307, 1313–14 (Fed. Cir. 2008) (the Board may treat arguments Appellant failed to make for a given ground of rejection as waived).

Rejection of claims 1–13, and 16–29 under 35 U.S.C. § 112 (Lack of Written Description)

The Examiner rejects claims 1–13, and 16–29 as lacking of written description in the Specification as originally filed. Ans. 20. In particular, “the amended language which attempts to convey the idea of ‘randomness’ is not taught or implied by the specification.” *Id.* According to the Examiner, “the word ‘random’ itself does not appear to be used in the specification, nor does a discussion of the disjoint subsets and whether or not locations of the subsets can be identified based on the physical properties within each subset.” *Id.* at 21. Although the Examiner acknowledges that “Fig. 3, as drawn, appears somewhat random,” the Examiner finds that “there does not appear to be a suggestion that the Applicant had possession of the concept of the specific property of randomness now claimed.” *Id.*

In order to satisfy the written description requirement, “the specification must describe an invention understandable to [a] skilled artisan and show that the inventor actually invented the invention claimed.” *Ariad*

Pharms., Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1351 (Fed. Cir. 2010) (*en banc*). *Id.* Compliance with the written description requirement set forth in 35 U.S.C. § 112 does not require that the claimed subject matter be described identically in the Specification. *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983). The drawings in an application can be relied upon to show that an inventor was in possession of the claimed invention as of the filing date. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565 (Fed. Cir. 1991) (“[D]rawings alone may be sufficient to provide the ‘written description of the invention’ required by § 112, first paragraph.”).

Here, Appellant contends that “the randomness limitation is a precise and mathematically rigorous statement of what the inventor had in his possession all along.” Appeal Br. 10. According to Appellant, “[t]he randomness limitation describes a common variation in nature, perhaps in the most common.” *Id.* Thus, Appellants contend “[u]pon a fair reading of the entire specification, . . . the ordinary artisan would have recognized that what the inventor was describing could be expressed mathematically by claim 1’s randomness limitation.” *Id.* at 15.

We are not persuaded by Appellant’s arguments.

By contending that “the ordinary artisan *would have recognized* that what the inventor was describing *could be* expressed mathematically by claim 1’s randomness limitation” (Appeal Br. 15 (emphasis added)), Appellant appears to be arguing that, given the disclosure in the Specification, it would have been obvious to a skilled artisan that Appellant had possession of the contested limitations at the filing of the application. However, a Specification which merely renders obvious the claimed invention (i.e., which relies on possession or reduction to practice outside of

the Specification) is not sufficient to satisfy the written description requirement. Our reviewing court guides “actual ‘possession’ or reduction to practice outside of the specification is not enough. Rather, . . . it is the specification itself that must demonstrate possession.” *Ariad Pharm*, 598 F.3d at 1352; *see also PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306–07 (Fed. Cir. 2008) (explaining that § 112, ¶ 1 “requires that the written description actually or inherently disclose the claim element”).

[I]t is ‘not a question of whether one skilled in the art might be able to construct the patentee’s device from the teachings of the disclosure. . . . Rather, it is a question whether the application necessarily discloses that particular device.’ . . . A description which renders obvious the invention for which an earlier filing date is sought is not sufficient.

Lockwood v. Am. Airlines, Inc., 107 F.3d 1565, 1572 (Fed. Cir. 1997) (quoting *Jepson v. Coleman*, 314 F.2d 533, 536 (CCPA 1963)).

Applying this reasoning here, we are not persuaded by Appellant’s statements that “[u]pon a fair reading of the entire specification, . . . the ordinary artisan would have recognized that what the inventor was describing *could be* expressed mathematically by claim 1’s randomness limitation.” Appeal Br. 15 (emphasis added). In particular, although we understand that 35 U.S.C. § 112 does not require that the claimed subject matter be described identically in the Specification and that Appellant can rely on the drawings to show that an inventor was in possession, we find no clear support in the Specification for randomly distributed values that define a physical-property function at each point in the domain, as required in the claim. *See* claim 1.

Thus, we are persuaded by the Examiner’s determination that the limitation “said physical-property function is defined by values of said

physical property at each point in said domain,” wherein “said values are randomly distributed” (claim 1) is not supported by the disclosure as originally filed. Ans. 21. That is, “the amended language which attempts to convey the idea of ‘randomness’ is not taught or implied by the specification.” *Id.* at 20.

On this record, we sustain the Examiner’s rejection of representative claim 1, and claims 2–13, and 16–29, not separately argued and thus falling therewith, under 35 U.S.C. § 112(a) for failing to comply with the written description requirement.

Rejection of claims 20, and 24–29 under 35 U.S.C. § 112 (Lack of Enablement)

The Examiner rejects claims 20, and 24–29 as lacking of enablement. Ans. 22. In particular, according to the Examiner, “[t]he claim recites evaluating the object’s surface finishing, color, transparency, strength, ohmic resistance, or capacitance and structural conditions,” but “the specification does not disclose the process, if any, or the steps used to evaluate the object’s surface finishing, color, transparency, strength, ohmic resistance, or capacitance.” Final Act. 8.

The Examiner concedes that the Specification discloses:

The characteristics of the surface of the object to be examined scanned in this manner can, for example, be its structural conditions, its surface finish or surface finish parameters, the colour or colour combination, the reflection behaviour, the transparency of the object, its strength, etc. In principle, along with these optical and mechanical characteristics described, electrical characteristics can also be evaluated such as the ohmic and also capacitive resistance of the surface or at least of a part surface. Determining the chemical characteristics of the surface and its characterisation thereby is also conceivable. Thus, for example, the adsorption capacity or even the oxidation capacity

can be evaluated and be utilized for the unique characteristic identification in terms of the key.

Final Act. 8–9 (citing Spec. ¶ 9).

In particular, the Examiner concedes that “[t]here is sufficient disclosure in the specification to allow one of ordinary skill in the art to make and use the invention of claim 1, in the embodiment related to the roughness of the surface or its form and shape,” wherein a POSITA “would know how to make the required measurements at a necessary level of precision and, without experimentation, convert this data into a unique identifying key.” Ans. 22. However, the Examiner asserts that “the specification does not appear to be enabling for use with the other physical properties recited” because, although “[t]hese other properties can be readily measured, but it does not appear that one would have been able, based on the Applicant’s disclosure and without undue experimentation, to use such measurements of the natural surface of an object to form a key that uniquely identifies the object.” Ans. 22–23.

“[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without ‘undue experimentation.’” *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993).

The enablement requirement ensures that the public knowledge is enriched by the patent specification to a degree at least commensurate with the scope of the claims. . . . The scope of enablement, in turn, is that which is disclosed in the specification plus the scope of what would be known to one of ordinary skill in the art without undue experimentation.

National Recovery Techs. Inc. v. Magnetic Separation Sys., Inc., 166 F.3d 1190, 1195–96 (Fed Cir. 1999).

The Examiner bears the burden of explaining why the scope of . . . claimed is not adequately enabled by the description of the invention provided in the specification including, “providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement.” *In re Wright*, 999 F.2d 1557, 1561–62 (Fed. Cir. 1993). However, on this record, the Examiner has not carried this burden.

In particular, as Appellant contends, the Examiner merely states that “it does not appear that one of ordinary skill in the art would simply be able to take the general idea of forming unique identifiers and apply it to each of the physical properties recited without undue experimentations” (Reply Br. 16 (citing Ans. 24)), but the Examiner is making a “conclusory” statement. *Id.* That is, although “[t]he examiner states that it does not ‘appear’ that a particular task would be possible to do without undue experimentation,” the Examiner “does not offer any intrinsic difference.” *Id.*

As Appellant points out, “[t]he specification does offer (see page3) the fact that an area of about a square centimeter has been determined to be sufficient to reduce the probability of two identical keys to essentially zero.” *Id.* at 27. According to Appellant, “[t]his specification does not distinguish between the various properties,” which “would suggest that this value would be useful to them” and thus “the same length scales are applicable to all of them.” *Id.*

A disclosure does not have to describe a claimed method in all its particulars in order to be enabling wherein some additional research and development is expected. (*Id.* at 7–8). See *Amgen, Inc. v. Hoechst Marion Roussel, Inc.* 314 F.3d 1313, 1334 (Fed. Cir. 2003) (“The specification need not explicitly teach those in the art to make and use the invention; the

requirement is satisfied if, given what they already know, the specification teaches those in the art enough that they can make and use the invention without ‘undue experimentation.’”). Here, as the Examiner finds, the claimed subject matter is in an old and well developed technology of making “required measurements” and “convert[ing] this data into a unique identifying key,” wherein there is a high level of predictability in the art.

Ans. 22–23. Accordingly, we find the Examiner does not provide “sufficient reasons for doubting” Appellants’ assertion that the Specification provides enabling support for using measurements of all physical properties recited to form a unique identifying key. *In re Wright*, 999 F.2d at 1561–62.

Given the developed technology, high predictability in the art, and the description in the Specification, the Examiner has not shown persuasively that undue experimentation would have been required to make and use the claimed invention. Thus, we do not sustain the rejection of claims 11–13, 15, 17–20, and 24–44 for lack of enablement.

Rejection of claims 1–13, and 16–26 under 35 U.S.C. § 112(b)
(Indefiniteness)

The Examiner rejects claims 1–13, and 16–29 as being indefinite. Final Act. 9–11. In particular, the Examiner finds that the term “natural surface” is “unclear.” *Id.* at 10. In particular, the Examiner contends that “the specification is unclear what makes up that natural surface.” *Id.*

However, as the Examiner points out, “[t]he specification states that [‘natural surface’] means ‘the surface originating during its actual production process.’” *Id.* In light of this particular definition of “natural surface,” a person of ordinary skill in the art would understand the metes and bounds of the term as used in the claims to be the originated surface during

the production process. In other words, by not specifying “what makes up that natural surface” (Final Act. 10), the claim is merely broad, not indefinite.

For the foregoing reasons, we do not sustain the indefiniteness rejection of claims 1–13, and 16–29 under 35 U.S.C. § 112(b).

Claims 1–13, 17–22, 25 rejected under 35 U.S.C. § 101

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216–218 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” See *Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, i.e., the use of a third party to mitigate settlement risk.”); see also *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”). Concepts determined to be abstract ideas, and, thus, patent ineligible, include (1) certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); (2) mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and (3) mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-

eligible application.” *Alice*, 573 U.S. at 221 (internal citation omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of § 101. USPTO’s January 7, 2019 Memorandum, 2019 Revised Patent Subject Matter Eligibility Guidance (“Memorandum”). Under that guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (see Manual of Patent Examining Procedure (MPEP) § 2106.05(a)–(c), (e)–(h) (9th Ed., Rev. 08.2017, Jan. 2018)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

- (3) adds a specific limitation beyond the judicial exception that are not “well-understood, routine, conventional” in the field (see MPEP § 2106.05(d)); or
- (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See Revised Guidance, 84 Fed. Reg. 56.

Revised Guidance Step 1

Step 1 of the Revised Guidance asks whether the claimed subject matter falls within the four statutory categories of patentable subject matter identified by 35 U.S.C. § 101: process, machine, manufacture, or composition of matter. Independent claim 1 recites a “method comprising identifying an object.” Independent claim 8 recites an “apparatus for identifying an object.” Here, claim 1 falls within the process category and claim 8 falls within the machine category.

Revised Guidance Step 2A, Prong 1

Under Step 2A, Prong 1 of the Revised Guidance, we determine whether the claims recite any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes). *See* Revised Guidance.

The Examiner determines claim 1 recites “an algorithm for identifying an object” which includes limitations that are similar to “organizing information through mathematical correlations” (*Digitech*), and “[a]n algorithm for calculating parameters indicating an abnormal condition” (*In re Grams*). Final Act. 4; Ans. 3 (citing *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); *In re Grams*, 888 F.2d 835, 840 (Fed. Cir. 1989)). The Examiner reasons that these limitations are considered (1) “an idea of itself,” i.e., mental processes that can be performed by the human mind, or with pen and paper, and (2) “a mathematical algorithm, in which results obtained from the scanning (a process which is recited at a high level of generality) are converted through a fixed and deterministic process . . . to obtain a unique key.” Ans. 3–4.

Independent claim 1 recites, in relevant part, “identifying an object” which comprises “scanning” part of the object which in turn comprises “measuring” values, “deriving” a result, and “combining” the values. Independent claim 8 recites an “apparatus” comprising a “scanning unit” being configured to perform steps similar to those in claim 1.

We agree with the Examiner that these limitations, under their broadest reasonable interpretation, recite “an algorithm for identifying an object.” Final Act. 4. That is, these limitations are directed to a scanning step which merely comprises measuring, deriving and combining various data, constituting an evaluation or judgment. We agree that the scanning step can be identified as an exemplary mathematical concept or “a mental process which can be performed by the human mind, and it is a mathematical calculation” in the Revised Guidance. *See* Ans. 3–4; Revised Guidance, 84 Fed. Reg. at 52.

In particular, these steps of measuring, deriving and combining data constitute mental steps because they involve merely making a mental observation of data and evaluating/judging the data, which can be carried out either in the human mind (e.g., in the form of noting an observation) or with the aid of pencil and paper. *See* 2019 Guidance 52 n.14; *see CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) (“[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.”); *see also In re Comiskey*, 554 F.3d 967, 979 (Fed. Cir. 2009) (“[M]ental processes—or processes of human thinking—standing alone are not patentable even if they have practical application.”); *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (“Phenomena of nature, . . . mental processes, and abstract intellectual

concepts are not patentable, as they are the basic tools of scientific and technological work.” (Emphasis added)). Additionally, mental processes remain unpatentable even when automated to reduce the burden on the user of what once could have been done with pen and paper. *CyberSource*, 654 F.3d at 1375 (“That purely mental processes can be unpatentable, even when performed by a computer, were precisely the holding of the Supreme Court in *Gottschalk v. Benson*.”). Acts that can be performed in the human mind fall within the abstract idea exception subgrouping of mental processes. Furthermore, measuring and deriving various data is also mathematical calculation, a mathematical concept falling within the abstract idea exception.

Thus, under the broadest reasonable interpretation, we conclude claims 1 and 8 recite an evaluation or judgment of data, which falls within the mental processes category as well as the mathematical concept category, identified in the Revised Guidance.

Revised Guidance Step 2A, Prong 2

Under Step 2A, Prong 2 of the Revised Guidance, we next determine whether the claims recite additional elements that integrate the judicial exception into a practical application (*see* MPEP §§ 2106.05(a)–(c), (e)–(h)). However, we discern no additional element (or combination of elements) recited in Appellant’s claims 1 and 8 that integrates the judicial exception into a practical application. *See* Revised Guidance, 84 Fed. Reg. at 54–55 (“Prong Two”).

Although claim 8 recites a “scanning unit” and “identification unit,” these elements do not (1) improve the functioning of a computer or other technology, (2) are not applied with any particular machine (except for

generic computer components), (3) do not effect a transformation of a particular article to a different state, and (4) are not applied in any meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception. *See MPEP* §§ 2106.05(a)–(c), (e)–(h).

Appellants contend that “the claimed method recites a practical solution to a difficult technical problem, namely the problem of detecting counterfeit bottles.” App. Br. 7. Thus, according to Appellants, “[t]he claim involves using an actual machine, i.e., a scanner, to interact with an actual physical object.” *Id.* We are not persuaded by Appellants’ arguments.

Notably, Appellant has not persuasively explained how claim 1 and/or claim 8 recites improvements to any *technology* or *technical* field (*see MPEP* § 2106.05(a)), improves *a particular machine* (*see MPEP* § 2106.05(b)), transforms or reduces a particular article *to a different state* or thing (*see MPEP* § 2106.05(c)), or describes a process or product that applies the exception *in a meaningful way, such that it is more than a drafting effort designed to monopolize the exception* (*see MPEP* § 2106.05(e)). *See* App. Br. 7–8 (emphasis added).

Appellant argues the claimed invention is directed using a scanner to interact with an object, and to use the result for detecting counterfeit bottles. *Id.* at 7. However, claim 1 recites a scanning step but does not recite any scanner to interact with an object, and in fact, does not recite any step of using a scanning result for detecting counterfeit bottles. *See* claim 1. Although claim 8 does recite a “scanning unit” and “identification unit,” the claim does not recite any mechanism to use the result for detecting

counterfeit bottles. *See* claim 8. As the Examiner explains, the claimed elements “are recited at a high level of generality and do not sufficiently narrow the claim as a whole to a particular application of the abstract idea.” Final Act. 5–6.

For these reasons, we are not persuaded that claims 1 and 8 recite “additional elements” that integrate the abstract idea into a practical application. As such, we agree with the Examiner that the claims are “directed to” an abstract idea.

Revised Guidance Step 2B

Under Step 2B of the Revised Guidance, only if a claim: (1) recites a judicial exception, and (2) does not integrate that exception into a practical application, do we then look to whether the claim adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (see MPEP § 2106.05(d)); or, simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. *See* 2019 Revised Guidance, 84 Fed. Reg. at 56. However, we find no element or combination of elements recited in Appellant’s claims 1 and 8, either individually or “as an ordered combination,” recite an “inventive concept” or add anything “significantly more” to transform the abstract idea into a patent-eligible application. *Alice*, 573 U.S. at 221.

Appellant does not identify any specific limitation of claims 1 and 8 beyond the judicial exception that is not “well-understood, routine, conventional’ in the field” as per MPEP § 2106.05(d). Instead, Appellant contends that the claimed method “is not some business method that involves doing nothing but moving data between bank accounts,” but rather,

“[t]he claim involves using an actual machine, i.e., a scanner, to interact with an actual physical object, and to use the result of that interaction to accomplish a useful result, i.e. detecting counterfeit bottles.” App. Br. 7. According to Appellant, “the existing technological process is that of object identification,” and the invention “represents an improvement because it simplifies the task of key generation.” Reply Br. 5. However, we are not persuaded by Appellant’s argument.

To the extent Appellant contends that the recited limitations add significantly more than the abstract idea (*id.*), generating key/data is not an additional element beyond the abstract idea, but rather is part of the abstract idea itself. *See BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018) (explaining that the Supreme Court in *Alice* “only assessed whether the claim limitations other than the invention’s use of the ineligible concept to which it was directed were well understood, routine and conventional”).

We briefly look to whether any additional limitations in claims 1 and 8 include an inventive concept. Here, although Appellant contends that “[t]he claim involves using an actual machine, i.e., a scanner” (App. Br. 7), limitations of “scanning” which comprises “measuring,” “deriving” and “combining” various data, even if performed using “an actual machine,” as set forth in claims 1 and 8, do not individually or as an order combination define ways of measuring, deriving, and combining that is different than any of the myriad conventional ways in which a computer can measure, derive and combine data, and thus do not provide an inventive concept. *See, e.g., 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.”). The focus of claims 1 and 8 is not on an improvement in computer processors as tools, but on certain independently abstract ideas that use generic computing components as tools. *See FairWarning IP, LLC v. IA*, 839 F.3d 1089, 1095 (Fed. Cir. 2016). As with the ineligible claimed invention in *BSG*, the elements in the claims both individually and “as an ordered combination” do not improve a computer’s functionality or that of its associated components, but rather the benefits flow from performing the abstract idea in conjunction with those generic computer components. *See BSG*, 899 F.3d at 1288 (“While the presentation of summary comparison usage information to users improves the quality of the information added to the database, an improvement [in] . . . the information stored by a database is not equivalent to an improvement in the database’s functionality.”).

Therefore, claims 1 and 8 do not recite an inventive concept. Accordingly, we agree with the Examiner that independent claims 1 and 8, and claims depending respectively therefrom and not specifically argued separately, are directed to patent-ineligible subject matter.

CONCLUSION

The Examiner’s rejection of claims 1–13, and 16–29 under 35 U.S.C. § 112(a) for lack of written description is affirmed.

The Examiner’s rejection of claims 20, and 24–29 under 35 U.S.C. § 112(a) for lack of enablement is reversed.

The Examiner’s rejection of claims 1–13, and 16–29 under 35 U.S.C. § 112(b) as being indefinite is reversed.

The Examiner’s rejection of claims 1–13, 17–22, and 25 under 35 U.S.C. § 101 as being directed to a judicial exception (i.e., a law of

nature, a natural phenomenon, or an abstract idea); and not directed to significantly more than the abstract idea itself is affirmed.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-13, 16-29	112(a)	Written description	1-13, 16-29	
20, 24-29	112(a)	Enablement		20, 24-29
1-13, 16-29	112(b)	Indefiniteness		1-13, 16-29
1-13, 17-22, 25	101	Eligibility	1-13, 17-22, 25	
Overall Outcome:			1-13, 16-29	

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED