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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SABRINA TAI-CHEN YEY and DAVID ANDREW YOUNG

Appeal 2018-003584
Application 14/037,286
Technology Center 3600

Before HUBERT C. LORIN, KENNETH G. SCHOPFER, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–8 and 25–32. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. The Appellant identifies the real party in interest as Sony Corp. Appeal Br. 2.

ILLUSTRATIVE CLAIM

1. A device comprising:
 - at least one computer memory that is not a transitory signal and that comprises instructions executable by at least one processor for:
 - accessing map information;
 - accessing location information indicating location of the device;
 - presenting on a display at least one user interface (UI);
 - receiving, from the UI, user input including a margin of error;
 - using the location information, map information, and user input from the UI to determine a route associated with at least one of: an exercise period, a distance, the exercise period and/or distance being one of plural exercise periods and/or distances falling within the margin of error; and
 - outputting the route on a presentation device.

CITED REFERENCES

The Examiner relies upon the following references:

Endo et al. (hereinafter "Endo")	US 2003/0191580 A1	Oct. 9, 2003
Krull et al. (hereinafter "Krull")	US 6,901,330 B1	May 31, 2005
Brooks	US 2006/0206258 A1	Sept. 14, 2006
Shirai et al. (hereinafter "Shirai")	US 2010/0191454 A1	July 29, 2010
Tang et al. (hereinafter "Tang")	US 2012/0130630 A1	May 24, 2012
Van Hende	US 2013/0304377 A1	Nov. 14, 2013
Holm et al. (hereinafter "Holm")	US 2014/0074392 A1	Mar. 13, 2014

IX. Claim 30 is rejected under 35 U.S.C. § 103 as unpatentable over Van Hende, Krull, and Endo.

X. Claim 31 is rejected under 35 U.S.C. § 103 as unpatentable over Van Hende and Lee.

XI. Claim 32 is rejected under 35 U.S.C. § 103 as unpatentable over Van Hende, Lee, and Kuri.

RELATED CASES

At the time the Appeal Brief was filed in the present case, a Notice of Appeal had been filed in at least the related U.S. Application 14/037,263 (Appeal 2016-007380). The Appellant fails to cite this related Appeal as required by 37 C.F.R. § 41.37(c)(ii). *See* Appeal Br. 2.

We remind the Appellant and counsel to review prior and pending proceedings before the Board, as well as any other qualifying matters, so as to ensure that all related cases are identified. Representations to the Office are subject to requirements of, e.g., 37 C.F.R. §§ 1.56, 11.18, and 11.303.

FINDINGS OF FACT

The findings of fact relied upon, which are supported by a preponderance of the evidence, appear in the following Analysis.

ANALYSIS

Subject-Matter Eligibility

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. Yet, subject matter belonging to any of the statutory categories may, nevertheless, be ineligible for patenting. The Supreme Court has interpreted § 101 to exclude laws of nature, natural phenomena,

and abstract ideas, because they are regarded as the basic tools of scientific and technological work, such that including them within the domain of patent protection would risk inhibiting future innovation premised upon them. *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013).

Of course, “[a]t some level, ‘all inventions . . . embody, use, reflect, rest upon, or apply’” these basic tools of scientific and technological work. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014). Accordingly, evaluating ineligible subject matter, under these judicial exclusions, involves a two-step framework for “distinguish[ing] between patents that claim the buildin[g] block[s] of human ingenuity and those that integrate the building blocks into something more, thereby transform[ing] them into a patent-eligible invention.” *Id.* (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 88–89 (2012)). The first step determines whether the claim is directed to judicially excluded subject matter (such as a so-called “abstract idea”); the second step determines whether there are any “additional elements” recited in the claim that (either individually or as an “ordered combination”) amount to “significantly more” than the identified judicially excepted subject matter itself. *Id.* at 217–18.

The USPTO recently published revised guidance on the application of § 101, in accordance with judicial precedent. 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50, 52 (Jan. 7, 2019) (“*2019 Revised Guidance*”). Under the *2019 Revised Guidance*, a claim is “directed to” an abstract idea, only if the claim recites any of (1) mathematical concepts, (2) certain methods of organizing human activity, and (3) mental processes — without integrating such abstract idea into a “practical

application,” i.e., without “apply[ing], rely[ing] on, or us[ing] the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *Id.* at 52–55. The considerations articulated in MPEP § 2106.05(a)–(c) and (e)–(h) bear upon whether a claim element (or combination of elements) integrates an abstract idea into a practical application. *Id.* at 55. A claim that is “directed to” an abstract idea constitutes ineligible subject matter, unless the claim recites an additional element (or combination of elements) amounting to significantly more than the abstract idea. *Id.* at 56.

Although created “[i]n accordance with judicial precedent” (*id.* at 52), the *2019 Revised Guidance* enumerates the analytical steps differently than the Supreme Court’s *Alice* opinion. Step 1 of the *2019 Revised Guidance* addresses whether the claimed subject matter falls within any of the statutory categories of § 101. *Id.* at 53–54. Step 2A, Prong One, concerns whether the claim at issue recites ineligible subject matter and, if an abstract idea is recited, Step 2A, Prong Two, addresses whether the recited abstract idea is integrated into a practical application. *Id.* at 54–55. Unless such integration exists, the analysis proceeds to Step 2B, in order to determine whether any additional element (or combination of elements) amounts to significantly more than the identified abstract idea. *Id.* at 56.

Independent claim 31 and dependent claim 32 stand rejected as ineligible subject matter. Claim 31 recites:

31. A device comprising:
 - at least one presentation device, the at least one presentation device being a video display and/or an audio speaker;

- at least one computer memory;
- at least one processor configured to access instructions on the memory for:
 - accessing map information;
 - accessing location information indicating location of the device;
 - presenting on the presentation device at least one user interface (UI);
 - accessing a database of routes determined to be popular based on plural user ratings and/or user reviews;
 - using the map information and information from the database to determine a route; and
 - outputting the route on a presentation device.

With respect to Step 1 of the *2019 Revised Guidance*, the Examiner does not determine that the claims are outside the identified categories of § 101.

Turning to Step 2A, Prong One, of the analytical framework delineated in the *2019 Revised Guidance*, the Examiner addresses the following limitations of claim 31: “accessing map information”; “accessing location information indicating location of the device”; “presenting on the presentation device at least one user interface (UI)”; “accessing a database of routes determined to be popular based on plural user ratings and/or user reviews”; “using the map information and information from the database to determine a route”; and “outputting the route on a presentation device.” *See* Answer 3. The Examiner regards these limitations as embodying an abstract idea, comparing the claim limitations to those addressed in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016). *Id.*

Viewed through the lens of the *2019 Revised Guidance*, 84 Fed. Reg. at 52, the identified limitations of claim 31 depict the claimed subject matter as a mental process. Specifically, the use of map information to determine a route is the sort of activity that may be reasonably “performed in the human mind.” *Id.* See also *Electric Power Group*, 830 F.3d at 1354 (“[W]e have treated analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.”)

The Appellant argues that *Electric Power Group* is inapposite:

There is nothing in the electric grid-related claims at issue in [*Electric Power Group*] that remotely resemble the provisioning of map information. Moreover, unlike the CAFC’s criticism of the claims in [*Electric Power Group*], in which the received data is “unidentified” data received from “generic data sources”, in instant Claim 31 a specific source of data — a database of routes determined to be popular based on user ratings and/or reviews — is accessed. Moreover, whereas in [*Electric Power Group*] “events” in the power grid data streams were derived from a list of generic electrical parameters and displayed without stating the use of a computer monitor to do so, in Claim 31 the map information and information from the database is output to determine a route, which in turn is output on a presentation device such as the display/speaker device recited earlier in the claim.

Reply Br. 4–5.

The Appellant’s proposed distinctions between the sources and contents of data in the *Electric Power Group* claims, in contrast to claim 31 in this Appeal (*see* Reply Br. 4–5), do not bear upon the question of whether the Examiner’s identified claim limitations recite a mental process — a category of abstract idea. Indeed, “even if a process of collecting and analyzing information is ‘limited to particular content’ or a particular

‘source,’ that limitation does not make the collection and analysis other than abstract.” *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1168 (Fed. Cir. 2018). Therefore, the Appellant’s arguments do not persuade us of error, in regard to Step 2A, Prong One.

Turning to Step 2A, Prong Two, unless a claim that recites a judicial exception (such as an abstract idea) “integrates the recited judicial exception into a practical application of that exception,” the claim is “directed to” the judicial exception. *Id.* at 53. The analysis of such an “integration into a practical application” involves “[i]dentifying . . . any additional elements recited in the claim beyond the judicial exception(s)” and “evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application.” *Id.* at 54–55. Among the considerations “indicative that an additional element (or combination of elements) may have integrated the exception into a practical application” is whether “[a]n additional element reflects an improvement in the functioning of a computer, or an improvement to other technology or technical field.” *Id.* at 55 (footnote omitted). “[W]hether an additional element or combination of elements integrate the exception into a practical application should be evaluated on the claim as a whole.” *Id.* at 55 n.24.

In regard to the inquiries of Step 2A, Prong Two, the Appellant argues that claim 31 is similar to claims determined to be patent-eligible in *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, 800 F.3d 1356 (Fed. Cir. 2018), by providing “an improved user interface.” Reply Br. 5. The Appellant states:

As is the case with Claim 31, the claims in *Core Wireless* were directed to a particular manner of summarizing and presenting information in electronic devices. While Appellant recognizes

that the UI of *Core Wireless* is not identical to Claim 31, Appellant believes that as was the case with *Core Wireless*, in which the claim “disclose[s] a specific manner of displaying a limited set of information to the user”, Claim 31 likewise presents displaying a limited set for information to the user. The claim in *Core [Wireless]* was said by the CAFC have the effect of “bringing together ‘a limited list of common functions and commonly accessed stored data’”, which can be said of Claim 31. While the *Core [Wireless]* opinion also discussed other claim limitations peculiar to the claim at issue, what was true in *Core [Wireless]* is true of Claim 31: “the claims are directed to an improvement in the functioning of computers, particularly those with small screens.”

Id.

Yet, the Appellant does not identify any feature set forth in claim 31 that might signify the alleged “improved user interface.” *Id.* Contrary to the Appellant’s assertion that claim 31 is akin to the claim at issue in *Core Wireless (id.)*, claim 31 contains no element that purportedly accomplishes “an improvement in the functioning of computers, particularly those with small screens.” *Core Wireless*, 800 F.3d at 1363. By contrast, the claim at issue in *Core Wireless*:

requires “an application summary that can be reached directly from the menu,” specifying a particular manner by which the summary window must be accessed. The claim further requires the application summary window list a limited set of data, “each of the data in the list being selectable to launch the respective application and enable the selected data to be seen within the respective application.” This claim limitation restrains the type of data that can be displayed in the summary window. Finally, the claim recites that the summary window “is displayed while the one or more applications are in an un-launched state,” a requirement that the device applications exist in a particular state.

Id. at 1362–63.

Therefore, the Appellant does not persuasively argue that the Examiner erred, in regard to Step 2A, Prong Two, of the *2019 Revised Guidance*.

Turning to Step 2B of the *2019 Revised Guidance* (84 Fed. Reg. at 56), a claim that recites a judicial exception (such as an abstract idea) might, nevertheless, be patent-eligible, if the claim contains “additional elements amount[ing] to significantly more than the exception itself” — i.e., “a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field, which is indicative that an inventive concept may be present.” *See Alice*, 573 U.S. at 223 (“[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.”)

The Appellant does not identify any elements of claim 31 that might amount to significantly more than the identified judicial exception, whether individually or in combination, under Step 2B. The only elements of claim 31 that are not part of the Examiner’s identified judicial exception are the recited “presentation device . . . being a video display and/or an audio speaker,” the “computer memory,” and the “processor.” These elements do not amount to significantly more than the identified judicial exception; rather, these elements simply situate the abstract concept in a particular technological environment of an interactive computing device. *See Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1259 (Fed. Cir. 2016) (“[M]erely limiting the field of use of the abstract idea to a particular existing technological environment does not render the claim[] any less abstract.”)

In view of the foregoing, we are not persuaded of error in the rejection of independent 31, or dependent claim 32 (for which the Appellant presents no separate argument), under 35 U.S.C. § 101. The rejection is sustained.

Obviousness

The Appellant contests the obviousness rejections, only with regard to claims 4, 28, 29, and 31. Appeal Br. 8–13. We address these arguments below. The Appellant’s argument for independent claim 31 applies also to dependent claim 32. We summarily sustain the rejections of claims 1–3, 5–8, and 25–27, and 30, under 35 U.S.C. § 103, which the Appellant does not otherwise challenge.

Claim 4

Claim 4 recites:

4. The device of Claim 1, wherein the instructions are executable for:

during user traversal of the route, accessing biometric information of the user; and

altering the route based on the biometric information to render an altered route and presenting the altered route on a presentation device.

Emphasis added.

The Appellant contends that the Examiner erred in rejecting claim 4, because the prior art of record (specifically, the Holm reference) does not teach or suggest the recited feature of “altering the route based on the biometric information.” Appeal Br. 8–11. Although Holm ¶ 53 discloses “determin[ing] the alternate route based on the one or more user parameters” and Holm ¶ 66 states that “the user parameters may be associated directly with the user, such as the physical fitness of the user,” the Appellant

contends that Holm’s “user parameters” do not include the claimed “biometric information.” *Id.* at 10–11. Notably, the Appellant argues that the Specification, at page 19, line 1, “explicitly distinguishes between ‘fitness information’ and ‘biometric information.’” *Id.* at 10. The Appellant further argues: “General fitness information is not ‘unique’ to an individual, but is shared among millions of other people of the same fitness, nor does general fitness information lend itself readily to mathematical or statistical analysis.” *Id.*

The Appellant relies, in part, upon proffered definitions of “biometric”:

Appellant has made of record definitions downloaded from www.dictionary.com. The most relevant definitions include “pertaining to, noting, or using a person’s unique physical and other traits for the purposes of identification and security” and “relating to the analysis of biological data using mathematical and statistical methods”.

Id. at 9. The Appellant contends that these definitions are consistent with the Specification. *Id.* The Specification states that examples of “biometric sensors” include:

[H]eart rate sensors and/or heart monitors, calorie counters, blood pressure sensors, perspiration sensors, odor and/or scent detectors, fingerprint sensors, facial recognition sensors, iris and/or retina detectors, DNA sensors, oxygen sensors (e.g. blood oxygen sensors and/or V02 max sensors), glucose and/or blood sugar sensors, sleep sensors (e.g. a sleep tracker), pedometers and/or speed sensors, body temperature sensors, nutrient and metabolic rate sensors, voice sensors, lung input/output and other cardiovascular sensors, etc.

Spec. 16, ll. 6–12.

The passage of the Specification that, according to the Appellant, draws the asserted distinction (between “fitness” information and “biometric” information) states:

[A]fter block 70 the logic then moves to block 72 where the logic accesses *fitness and/or biometric information* associated with the user (e.g. by receiving/gathering input from biometric sensors in communication the CE [i.e., “consumer electronics”] device and measuring one or more types of biometric information associated with the user, based on user input of biometric information, etc.).

Spec. 18, l. 23–19, l. 4 (emphasis added). Although this passage indicates that there is at least some “biometric information” that would not constitute “fitness” information, the passage does not establish that “fitness” information is wholly distinct from “biometric information.” Indeed, the Specification elsewhere states that “the user’s fitness level” is “based on one or more biometric pieces of information”:

[I]n exemplary embodiments e.g. the CE device may receive input of a desired distance in accordance with present principles, but may then e.g. determine a shorter or longer route than what was indicated by the desired distance that nonetheless would cause the user to exert the same physical effort/output. Thus, for instance, if the user indicated that he or she wished to run five miles on flat ground, but the surrounding terrain was full of hilly terrain, then the CE device may e.g. *determine the user’s fitness level based on one or more biometric pieces of information* from the biometric sensors discussed above, and either shorten or extend the route based on an estimate of what the user’s physical output would have been on flat ground to match that estimate when the hilly terrain is accounted for. Thus, for instance going downhill the user may have to travel further than he or she would on flat ground, and going uphill the user may have to travel shorter than he or she would on flat ground.

Spec. 36, ll. 8–18 (emphasis added). Thus, although a “user’s fitness level” may be derived from more fundamental “biometric pieces of information” obtained with “biometric sensors” (*id.* at 36, ll. 13–14), the Specification does not exclude “fitness” information from the category of “biometric information.” The Examiner emphasizes this point, in regard to paragraphs 41, 44, 53, and 66 of the Holm reference, stating:

Although Holm does not use the term “biometric” in the disclosure, Holm does teach accessing biometric information of the user and altering the route based on the biometric information because the user parameters of Holm relate to the analysis of biological data using mathematical and statistical methods (see Appellant's definition on page 9 of the Brief) and are unique to the individual user. The Examiner respectfully disagrees with Appellant’s interpretation of [0066] of Holm (on page 11 of the Brief) in light of and in combination with at least the cited portions of Holm’s disclosure which describe the user parameters/characteristics as being directly associated with the user and not general physical fitness information.

Answer 5–6.

The Appellant also argues that the Office Action of December 3, 2015, distinguished “fitness” information from “biometric information,” because, “the examiner imposed a restriction on the basis that ‘the inventions of claims 21–24 are distinct from that of claims 1–8’” and, at the time of the Office Action, claim 23 recited “accessing fitness information pertaining to a fitness level of the user, and using the fitness information to determine the route.” Appeal Br. 11. Yet, as of December 3, 2015, none of claims 1–8 recited “biometric information”; moreover, the then-extant version of claim 4 recited the same limitation that appeared in claim 23 (i.e., “accessing fitness information pertaining to a fitness level of the user, and using the fitness information to determine the route”). *See* Response to

Office Action (Sept. 8, 2015) 3, 5. Therefore, we are not persuaded that the Office Action of December 3, 2015, supported the proposed distinction between “fitness” information and “biometric information.”

In view of the foregoing, we sustain the rejection of claim 4 under 35 U.S.C. § 103.

Claim 28

Claim 28 recites:

28. The method of Claim 25 wherein the UI is a first UI and the method comprises:

presenting at least a second UI to provide notification that the route will not be completed in time to meet an upcoming calendar appointment in calendar information.

Claim 28 depends from independent claim 25, which indicates that “UI” refers to “user interface.”

In rejecting claim 28, the Examiner relies, in particular, upon paragraph 21 of the Shirai reference to teach the limitations added in claim 28. Final Action 12; Answer 6–7. Shirai’s paragraph 21 discloses the use of logic to determine whether the estimated time of arrival “is later than the scheduled start time of the event as indicated on the calendar” and, if so, presenting a “visual alert” to this effect, on a “display.” Shirai ¶ 21. The Examiner regards a “UI” as “a display which is configured to provide information to a user.” Answer 6 (citing ¶ 71 of published application US 2015/0081210 A1, corresponding to Spec. 31, ll. 13–23, and Fig. 8, element 206). The Examiner further explains: “[O]ne of ordinary skill in the art would recognize that the personal organizer 10 disclosed in Shirai is not merely a display device (such as a computer monitor or television), but

an interactive user device configured to receive input from a user via one or more input devices 26.” *Id.* at 7 (citing Shirai ¶¶ 14–15, Fig. 1).

Disputing the rejection, the Appellant argues that paragraph 21 of Shirai “does not discuss a user interface, but rather simply an alert that is presented on an otherwise unidentified ‘display’ which is not said to have user interface functionality.” Appeal Br. 12. In addition, the Appellant asserts that the Specification “does not define a UI as a ‘display which is configured to provide information to a user’, so the [Examiner’s] representation in the Answer on this score is misleading.” Reply Br. 8.

The sufficiency of Shirai, in the Examiner’s obviousness analysis, turns upon the construction of the claimed “second UI.” “During examination, ‘claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)). Sources for claim construction may include intrinsic sources (such as the claims, the Specification, and the cited references), as well as extrinsic sources (such as technical treatises and dictionaries). *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582–84 & n.6 (Fed. Cir. 1996).

The Specification refers to “UI 214” of Figure 9 as accomplishing the functionality described in claim 28: “[I]n reference to Figure 9, an exemplary UI 214 is shown that is presentable on a [consumer electronics] device in accordance with present principles to e.g. notify the user that the route being traveled will not be completed within an estimated time and/or before an upcoming calendar appointment.” Spec. 32, ll. 11–14. The UI

214 also permits the user to “select an alternate route(s) selector element 218 for alternate possible routes from the user’s current location as determined by the CE device to arrive and an ending location previously input by the user.” *Id.* at 32, ll. 17–19. Therefore, as employed in claim 28 and the corresponding portion of the Specification, a “user interface” (i.e., a “UI”) constitutes an instrumentality for presenting certain visual information to a user and for the user to input information for the device to act upon. This interpretation is consistent with the general understanding of “user interface” to a person of ordinary skill in the art, as “[a]ll the features of a program or computer that govern the way people interact with the computer.” Bryan Pfaffenberger, Webster’s New World Computer Dictionary (10th ed. 2003) (definition of “user interface”), https://search.credoreference.com/content/entry/webstercom/user_interface/0?institutionId=743 (last visited Nov. 20, 2019).

In view of the foregoing, the Examiner sufficiently establishes that Shirai discloses a user interface having the features of the recited “second UI,” because — as the Examiner points out — Shirai’s device includes equipment for both the display and the input of information. Answer 7 (citing Shirai ¶¶ 14–15, Fig. 1). Accordingly, we sustain the rejection of claim 28 under 35 U.S.C. § 103.

Claim 29

Claim 29 recites:

29. The method of Claim 26, comprising presenting a second UI, wherein the second UI presents an indication of an alternate possible route to be followed to meet a calendar appointment.

Claim 29 depends ultimately from independent claim 25, which indicates that “UI” refers to “user interface.”

In rejecting claim 29, the Examiner relies, in particular, upon paragraph 21 of the Shirai reference to teach or suggest the limitations added in claim 29. *See* Final Action 12–13; Answer 7. According to the Examiner, “claim 29 requires the presentation of an indication of an alternate possible route, which is analogous to the alternate route suggestions in Shirai [0021].” Answer 7. The Examiner regards Shirai as rendering obvious the feature of providing a route to the user that allows the user to arrive on time for calendar appointments. Final Action 13.

Disputing the rejection, the Appellant argues that Shirai’s paragraph 21 “simply states that the ‘alert’ presented in an otherwise unidentified fashion can include alternate route suggestions, but not that those suggestions are tailored to meet the calendar appointment as claimed.” Appeal Br. 12. *See also* Reply Br. 8–9.

Yet, the Examiner regards Shirai as at least suggesting the provision of a route that would allow the user to arrive in time for the calendar appointment. *See* Final Action 12–13; Answer 7. Shirai states that a “visual alert” may be presented on a display, if a user is estimated to arrive “later than the scheduled start time of the event as indicated on the calendar.” Shirai ¶ 21. Shirai further states: “In some embodiments the alert may include optional action suggestions, e.g., alternate route suggestions.” *Id.* Thus, it is reasonable for the Examiner to find that Shirai’s “alternate route suggestions” (*id.*) would include routes that permit the user to arrive in time for the event.

Therefore, we sustain the rejection of claim 29 under 35 U.S.C. § 103.

Appeal 2018-003584
Application 14/037,286

Claims 31 and 32

The Appellant contends that independent claim 31 stands erroneously rejected, because the Lee reference is not prior art to the application at issue in this Appeal. Appeal Br. 13.

The Lee reference is a published patent application, dated September 18, 2014 (Publication Number US 2014/0278064 A1), based upon an application filed on March 12, 2014 (Application Number 14/206,972). In turn, the Lee reference “claims the benefit of provisional U.S. Patent Application No. 61/792,704 . . . filed Mar. 15, 2013.” Lee ¶ 1. We refer to this provisional application as the “Lee Provisional.”

The application that is the subject of this Appeal (Application Number 14/037,286) was filed on September 25, 2013 and “claims priority to U.S. provisional patent application serial no. 61/878,835, filed September 17, 2013.” Spec. 1, ll. 1–2. Therefore, the Lee reference may constitute prior art, only if afforded the filing date of the Lee Provisional.

The Federal Circuit has addressed the matter of determining the priority dates afforded to references based upon U.S. patent applications in *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015), and *Amgen, Inc. v. Sanofi*, 872 F.3d 1367 (Fed. Cir. 2017). In *Dynamic Drinkware*, the Federal Circuit applied the statute governing whether a patent may *claim priority* from the filing date of a provisional application (35 U.S.C. § 119(e)(1)) to the matter of determining the availability of the provisional application’s filing date, when such a patent is used as a prior-art reference: “A reference patent is only entitled to claim the benefit of the filing date of its provisional application if the disclosure of the provisional application provides support for the *claims* in the reference

patent in compliance with § 112, ¶ 1.” *Dynamic Drinkware*, 800 F.3d at 1382. In *Dynamic Drinkware*, the prior art reference was an issued patent, but *Amgen* states that the principle articulated in *Dynamic Drinkware* also applies to published patent applications. *Amgen*, 872 F.3d at 1380 (“[W]e have previously stated that ‘for the non-provisional utility application to be afforded the priority date of the provisional application, . . . the written description of the provisional must adequately support the claims of the non-provisional application.’ *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002).”)

The MPEP provides additional clarity in determining whether a prior art patent or published application may be afforded the date of a corresponding provisional application. Specifically, the filing date of the provisional application applies, if the provisional application provides written-description support for at least one claim in the issued patent or published application. See MPEP § 2136.03(III) (9th ed., Rev. 08.2017, Jan. 2018) (“[T]he reference date under pre-AIA 35 U.S.C. 102(e) of a U.S. patent may be the filing date of a relied upon provisional application *only if at least one of the claims* in the patent is supported by the written description of the provisional application in compliance with pre-AIA 35 U.S.C. 112, first paragraph.”) (emphasis added).

In the present Appeal, establishing a prima facie case of obviousness for claim 31, based upon the Lee reference in the manner set forth, requires the Examiner not only to demonstrate the availability of the Lee Provisional’s filing date (per *Dynamic Drinkware* and *Amgen*), but also to demonstrate that the relied-upon teachings of Lee are also disclosed in the

Lee Provisional. *See Ex parte Yamaguchi*, Appeal 2007-004412, 2008 WL 4233306, at *10 (BPAI Aug. 29, 2008) (precedential).

Rather than addressing the relationship between the Lee reference and the Lee Provisional, the Appellant's argument focuses on whether the Lee Provisional provides written-description support for the *patent* (US 9,255,807) that issued, based upon the non-provisional application corresponding to the Lee reference. *See* Appeal Br. 13; Reply Br. 10–12. However, the Examiner's rejection relies upon the Lee reference — not the patent that issued from its corresponding application.⁴

⁴ The Appellant's argument illustrates the potential for paradoxical outcomes, in applying the *Dynamic Drinkware/Amgen* approach for determining whether a patent or published application (when used as prior art) may be afforded the filing date of a respective provisional application. Multiple published non-provisional applications and/or issued patents may claim priority from a single provisional application. Yet, the provisional application may provide written-description support for at least one claim in some of these applications/patents, but not others — notwithstanding the contents of their disclosures. With regard to the present Appeal, for example, the claims of the published Lee reference (US 2014/0278064 A1) differ from those in the patent that ultimately issued on the corresponding application (US 9,255,807), creating the possibility that these two documents might have different effective dates, when used as prior art. Furthermore, even if written-description support (for published or issued claims) were lacking, the potential remains for future published applications (or issued patents) with claims having such written-description support, thereby unlocking the availability of the provisional application's filing date.

The United States Solicitor General has advocated an approach that would avoid such conundrums, arguing that the requirements of 35 U.S.C. § 119 (for determining whether a non-provisional application might be afforded the benefit of an earlier provisional application's filing date) should not dictate whether a patent or published application constitutes prior art:

In the view of the United States, . . . Section 119(e) has no bearing on the date on which a patent application qualifies as

Although the Examiner takes the position that the relied-upon disclosures of the Lee reference also appear in the Lee Provisional (*see* Answer 8–9), the Examiner does not address whether the Lee Provisional provides written-description support for any claim in the Lee reference, in the manner articulated in *Dynamic Drinkware, Amgen*, and MPEP § 2136.03(III). In view of the absence of such an inquiry, we do not sustain the rejection of independent claim 31 and its dependent claim 32 under 35 U.S.C. § 103.

prior art under [pre-AIA] Section 102(e). Section 119 is directed to the separate question of when patent applicants are entitled to claim priority for *their own* applications. There is no textual basis for using that provision’s priority rules to backdate patent applications sought to be relied on as prior art under Section 102(e). . . .

Given that Section 102(e) focuses on questions of *novelty* and *public disclosure*, imposing on that inquiry the stringent claim-based requirements set out in Section 119(e) therefore would serve no purpose. Nor does any other Patent Act provision suggest that the applicability of Section 102(e) should turn on whether the applicant named in a prior-art application satisfied Section 119(e).

Brief for the United States as Amicus Curiae at 11–12, 14 (May 21, 2019), *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, 139 S. Ct. 2740 (2019) (petition for writ of certiorari denied) (No. 18-109) (https://www.supremecourt.gov/DocketPDF/18/18-109/100530/20190521150718908_18-109%20Ariosa%20Diagnostics%20Inc..pdf).

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
31, 32	101	Eligibility	31, 32	
1, 2, 5–7	103	Van Hende, Brooks	1, 2, 5–7	
3	103	Van Hende, Brooks, Tang	3	
4	103	Van Hende, Brooks, Holm	4	
8	103	Van Hende, Brooks, Kuri	8	
25, 26	103	Van Hende, Krull	25, 26	
27	103	Van Hende, Krull, Kuri	27	
28, 29	103	Van Hende, Krull, Shirai	28, 29	
30	103	Van Hende, Krull, Endo	30	
31	103	Van Hende Lee		31
32	103	Van Hende, Lee, Kuri		32
Overall Outcome			1–8, 25–32	

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

Notice of References Cited	Application/Control No. 14/037,286	Applicant(s)/Patent Under Reexamination	
	Examiner	Art Unit	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification	
1	A	US-			1	1
	B	US-				
	C	US-				
	D	US-				
	E	US-				
	F	US-				
	G	US-				
	H	US-				
	I	US-				
	J	US-				
	K	US-				
	L	US-				
	M	US-				

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*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification	
	N						
	O						
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	Q						
	R						
	S						
	T						

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	https://search.credoreference.com/content/entry/webstercom/user_interface/0?institutionId=743 (last visited Nov. 20, 2019).
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

user interface

from *Webster's New World™ Computer Dictionary*

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All the features of a program or computer that govern the way people interact with the computer. See [command-driven program](#), [graphical user interface \(GUI\)](#).



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APA

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