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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ANTHONY VILLARDITO

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Appeal 2018-004427  
Application 13/770,142  
Technology Center 3600

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Before KALYAN K. DESHPANDE, CHARLES J. BOUDREAU,  
and SHARON FENICK, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1, 3–7, and 9–21, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.<sup>2</sup>

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Sears Brands, L.L.C. as the real party in interest. App. Br. 2.

<sup>2</sup> This Decision refers to the Examiner's Final Office Action mailed September 2, 2016 (“Final Act.”); Appellant's Appeal Brief filed January 30, 2017 (“App. Br.”); the Examiner's Answer mailed January 24, 2018 (“Ans.”); Appellant's Reply Brief filed March 23, 2018 (“Reply Br.”); and the original Specification filed

## STATEMENT OF THE CASE

### *The Claimed Invention*

Appellant’s invention relates to “managing inventory distributed across multiple locations” when “[t]echnicians . . . travel to a customer’s residence or place of business in order to service or repair an item” and “may not have the parts and/or tools desired for the job.” Spec. ¶¶ 1–2.

Claims 1, 10, and 16 are independent. Claim 1, reproduced below, is illustrative of the subject matter on appeal:

1. A method, comprising:
  - dispatching a person to a service location to perform a service;
  - receiving, from the dispatched person at the service location, a request for a part that the dispatched person needs in order to complete the service at the service location;
  - in response to said receiving, identifying one or more vehicles in a vicinity of the service location;
  - selecting, based on an on-board inventory of parts for each vehicle of the identified one or more vehicles, a vehicle that has the requested part in its on-board inventory; and
  - coordinating a transfer of the requested part from the selected vehicle to the dispatched person at the service location.

App. Br. 37 (Claims App’x).

*References and Rejections*

The Examiner relies on the following references as evidence of unpatentability:

Morris et al. ("Morris")	US 7,069,333 B1	Pub. June 27, 2006
O'Meara et al. ("O'Meara")	US 2002/0077876 A1	Pub. June 20, 2002
Nielsen et al. ("Nielsen")	US 8,612,276 B1	Pub. Dec. 17, 2013 (Filed Feb. 4, 2010)
Bruecken	US 7,305,350 B1	Pub. Dec. 4, 2007

Claims 1, 3–7, and 9–21 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Final Act. 4.

Claims 1, 3–7, and 9–21 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Morris in view of O'Meara, Nielsen, and Bruecken. Final Act. 5–14.

ANALYSIS

*Rejection 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, or [a] new and useful improvement thereof.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted § 101 to “contain[] an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014) (quoting *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

In *Alice*, the Supreme Court reiterated the two-step framework previously set forth in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77

(2012) “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent eligible applications of those concepts.” *Alice*, 573 U.S. at 217. The first step in this analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” e.g., to an abstract idea. *Id.* Concepts determined to be abstract ideas include certain methods of organizing human activity, such as fundamental economic practices (*id.* at 219–20; *Bilski v. Kappos*, 561 U.S. 593, 611 (2010)); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). If it is determined that the claims are directed to a patent-ineligible concept, the second step of the analysis requires consideration of the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 78, 79). In other words, the claims must contain an “inventive concept,” or some element or combination of elements “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [abstract idea] itself.” *Id.* at 217–18 (quoting *Mayo*, 566 U.S. at 72–73).

The PTO recently published revised guidance on the application of § 101. 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“2019 Guidance”). 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 fundamental economic practices, or mental processes) (“Step 2A, Prong 1”); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h) (9th ed. Rev. 08.2017, Jan. 2018)) (“Step 2A, Prong 2”).

2019 Guidance, 84 Fed. Reg. at 52–55.

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

(3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, and 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.

2019 Guidance, 84 Fed. Reg. at 56.

The Examiner determines that claims 1, 3–7, and 9–21 are directed to an abstract idea and that the claim elements, considered both individually and in combination, do not include additional elements that are sufficient to amount to significantly more than the abstract idea. Final Act. 4. In particular, the Examiner finds that “the abstract idea of the present invention focuses on a fundamental economic practice (e.g., item delivery).” *Id.* at 2 (emphasis omitted); *see also* Ans. 3–4. The Examiner further determines that the claimed concepts “can further be implemented . . . as a mental process (thinking) that can be performed in the human mind, or by a human using a pen and paper.” Ans. 5 (internal quotation marks omitted).

Appellant argues that the Examiner has failed to establish that the claims are directed to patent ineligible subject matter. App. Br. 13. Specifically, Appellant argues that the claims do not recite “agreements between people in the form of contracts, legal obligations, and business relations” and are thus not directed to a fundamental economic practice. *Id.* at 13–15 (citing PTO’s *July 2015 Update*:

*Subject Matter Eligibility*<sup>3</sup>); *see also* Reply Br. 3–4. Appellant further argues that each claim “includes aspects that simply cannot be performed in the human mind or by a human using pen and paper,” and that “a human would require access to other tools (e.g., computer systems, telephones, etc.) to perform such tasks.” Reply Br. 5. According to Appellant, the invention addresses the problem of a technician being dispatched to a service location without having the parts and/or tools to perform the service, and is “directed to a practical embodiment or implementation of how to deliver parts to a person at a service location.” App. Br. 18–19. Finally, Appellant argues that the claims “are sufficiently narrow enough to avoid preempting an entire field of innovation and are thus directed to significantly more than the abstract idea itself.” *Id.* at 18; *see also* Reply Br. 7–8.

*Step 2A, Prong 1*

Under Step 2A, Prong 1 of the 2019 Guidance, we agree with the Examiner that the claims recite a judicial exception, i.e., an abstract idea. *See* Final Act. 2. Regardless of Appellant’s argument that the claims do not recite a fundamental economic practice (App. Br. 13–15; Reply Br. 3–4), we agree with the Examiner that the claimed concepts “can be performed in the human mind” (*see* Ans. 5). Accordingly, we determine that the claims recite a mental process.

For example, independent claim 1 recites “in response to said receiving [a request for a part], identifying one or more vehicles in a vicinity of the service location” and “selecting, based on an on-board inventory of parts for each vehicle of the identified one or more vehicles, a vehicle that has the requested part in its on-board inventory.” Under their broadest reasonable interpretation, these “identifying” and “selecting” limitations recite steps that can be performed in the

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<sup>3</sup> Available at <https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf>.

mind, as can corresponding limitations in claims 10 and 16, but for the recitation of generic components. That is, other than the “computing system” recited in independent claim 10 and the “management system” recited in independent claim 16 as performing similarly recited steps, nothing in the claim limitations precludes those steps from being performed in the mind. For example, but for the recitation of the “computing system” and “management system,” the claims encompass a method of *mentally* identifying one or more vehicles in a vicinity of the service location in response to receiving a request for a needed part, and *mentally* selecting a vehicle that has the requested part in its on-board inventory.

Accordingly, these limitations recite a mental process as identified in the 2019 Guidance, and, thus, an abstract idea.

*Step 2A, Prong 2*

Under Step 2A, Prong 2 of the 2019 Guidance, we next look to whether the claims recite additional elements that integrate the abstract idea into a practical application. We determine that they do not. For example, claim 1 additionally recites “dispatching a person to a service location to perform a service,” “receiving, from the dispatched person at the service location, a request for a part that the dispatched person needs in order to complete the service at the service location,” and “coordinating a transfer of the requested part from the selected vehicle to the dispatched person at the service location.” The “dispatching” and “receiving” steps are recited at a high level of generality (i.e., as general means of assigning a person, e.g., a technician, to a service job/location and receiving information on what service part is needed) and amount to insignificant pre-solution activity. The “coordinating” step is also recited at a high level of generality (i.e., as a general means of delivering the needed service part) and

amounts to insignificant post-solution activity. *See* 2019 Guidance, 84 Fed. Reg. at 55; MPEP § 2106.05(g).

As discussed above, independent claims 10 and 16 recite that a “computing system” and “management system,” respectively, perform all of the recited steps. Claim 10 additionally recites “processors” and “storage devices” with “instructions,” and claim 16 additionally recites a “tracking system” and an “inventory system.” These additional elements are recited at a high level of generality, i.e., as generic components performing generic functions of computer processing. Notwithstanding Appellant’s argument that a human performing the “receiving,” “identifying,” and “selecting” steps would “require access to other tools (e.g., computer systems, telephones, etc.) to perform such tasks” (*see* Reply Br. 5), we agree with the Examiner that such generic limitations, when recited, merely apply the abstract idea using generic components. *See* Final Act. 2–4; Ans. 5; 2019 Guidance, 84 Fed. Reg. at 55; MPEP § 2106.05(f). The claim limitations do not include any particular machine that is integral to the claim. *See* 2019 Guidance, 84 Fed. Reg. at 55; MPEP § 2106.05(b). And, as noted by the Examiner, the claim limitations do not reflect an improvement in the functioning of a computer, or to any other technology or technical field. *See* Final Act. 3; 2019 Guidance, 84 Fed. Reg. at 55; MPEP § 2106.05(a).

Thus, even in combination, the additional limitations do not integrate the abstract idea into a practical application because they do not impose any meaningful limits on practicing the abstract idea.

Accordingly, we agree with the Examiner that the claims are directed to an abstract idea.

*Step 2B*

Under Step 2B of the 2019 Guidance, we agree with the Examiner that the additional elements recited in the claims (e.g., computing system, processors, storage devices, instructions, tracking system, inventory system, management system) (*see* independent claims 10 and 16) are mere recitations of generic computer structures performing generic computer functions that are well-understood, routine, and conventional, and thus do not amount to significantly more than the abstract idea. *See* Final Act. 2–4. As discussed above, those additional elements amount to no more than mere instructions to apply the abstract idea using generic computer components. Mere instructions to apply an abstract idea on a generic computer do not provide an inventive concept. *Alice*, 573 U.S. at 223–24. Appellant has not shown that the claims on appeal add any specific limitation beyond the judicial exception that is not “well-understood, routine, and conventional” in the field. *See* MPEP § 2106.05(d).

Reevaluating the extra-solution activity of “dispatching a person to a service location to perform a service,” “receiving, from the dispatched person at the service location, a request for a part that the dispatched person needs in order to complete the service at the service location,” and “coordinating a transfer of the requested part from the selected vehicle to the dispatched person at the service location” (*see* 2019 Guidance, 84 Fed. Reg. at 56), we find nothing unconventional in these steps of assigning a person to a service job/location, receiving information on what service part is needed, and arranging for the delivery of the needed service part. Although Appellant argues that the claims “set[] forth an unconventional process of processing requests for parts received from persons dispatched to service locations” (Reply 7), Appellant provides no evidence of how the ordered

combination is unconventional or amounts to significantly more than the abstract idea to which the claims are otherwise directed.

We are unpersuaded by Appellant’s argument that the claims “are sufficiently narrow enough to avoid preempting an entire field of innovation and are thus directed to significantly more than the abstract idea itself.” App. Br. 18; *see also* Reply Br. 7–8. As noted by the Examiner, the absence of complete preemption is not dispositive. Ans. 4; *see, e.g., Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”); *Ultramercial, Inc. v. Hulu, LLC*, 722 F.3d 1335, 1346 (Fed. Cir. 2013) (“[T]he Supreme Court has stated that, even if a claim does not wholly pre-empt an abstract idea, it still will not be limited meaningfully if it contains only insignificant or token pre- or post-solution activity—such as identifying a relevant audience, a category of use, field of use, or technological environment.”) (citations omitted), *vacated and remanded, WildTangent, Inc. v. Ultramercial, LLC*, 573 U.S. 942 (2014) (remanding for further consideration in light of *Alice*). Thus, even if the claims do not preempt the abstract idea, that alone is insufficient to render the claims patent-eligible.

Accordingly, considering the claim elements individually and as an ordered combination, we agree with the Examiner that there are no meaningful claim limitations that represent sufficiently inventive concepts to transform the nature of the claims into a patent-eligible application of the abstract idea.

For the foregoing reasons, we sustain the Examiner’s rejection of claims 1, 3–7, and 9–21 under 35 U.S.C. § 101.

*Rejection Under 35 U.S.C. § 103*

Addressing independent claim 1, Appellant argues that the proposed combination of Morris, O’Meara, Nielsen, and Bruecken fails to teach “selecting, based on an on-board inventory of parts for each vehicle of the identified one or more vehicles, a vehicle that has the requested part in its on-board inventory.” App. Br. 29. Specifically, Appellant argues that while O’Meara teaches assigning taxis based on their location, it does not consider the on-board inventory of each taxi. *Id.* at 24. Appellant further argues that while Nielsen teaches dispatching service technicians based on the inventory available in a technician’s vehicle, Nielsen does not “indicate that a vehicle is selected from one or more vehicles identified in a vicinity of a service location, especially where that selection is based on whether the on-board inventory of the vehicle has a part that was requested by a technician at the service location.” *Id.* at 25. Finally, Appellant argues that, in Bruecken, “the location of vendor vehicles 430 proximate the customer are identified prior to receiving a request from the customer for particular goods,” and vendor vehicles are eliminated from consideration not because they lack a part requested by the customer, but, rather, based on the vendor having insufficient inventory or another incapability to deliver goods and/or perform services. *Id.* at 27; *see also* Reply Br. 10.

Addressing claim 3, which depends from claim 1, Appellant argues that the combination of Morris, O’Meara, Nielsen, and Bruecken fails to teach “requesting each vehicle of the plurality of vehicles to indicate whether the vehicle has the requested part; wherein said selecting comprises selecting the vehicle with which to coordinate the transfer based on indications received from the plurality of vehicles.” App. Br. 29–31. Appellant reiterates that “O’Meara is not concerned with the on-board inventory of the respective taxis,” arguing that a reasonable

construction of “the requested part” as claimed does not include seating in a taxi. *Id.* at 30; *see* Final Act. 8–9. Appellant further argues that, even if “the requested part” included a taxi’s “seating,” “O’Meara is silent with respect to requesting each taxi to provide an inventory of their seats and selecting a taxi based on such inventory.” App. Br. 30. Finally, Appellant argues that, in Bruecken, “vendors 504 inform the host 502 when they have insufficient inventory prior to receiving any request from a customer.” *Id.* at 31.

We find these arguments unpersuasive, as Appellant attacks the references individually without consideration of what the combined teachings would have suggested to one of ordinary skill in the art. As noted by the Examiner, one cannot show nonobviousness by attacking references individually where the rejection is based upon a combination of references. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *see* Ans. 6–11. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). We agree with the Examiner that the method of claim 1, including the step of “selecting, based on an on-board inventory of parts for each vehicle of the identified one or more vehicles, a vehicle that has the requested part in its on-board inventory,” would have been obvious in view of combining O’Meara, Nielsen, and Bruecken with Morris’s teaching of receiving a request for a part from a dispatched person (e.g., technician) at the service location and then coordinating a transfer of the requested part from a mobile warehouse vehicle to the dispatched person at the service location. *See* Final Act. 5–8 (citing Morris 21:40–22:42); Ans. 9–10. We also agree with the Examiner that claim 3 would have been obvious over that teaching by Morris (i.e., first receiving a request for a part from the dispatched person) combined with the teachings of O’Meara and Nielsen, in view of Bruecken’s teaching of vendors

reporting their inventory. *See* Final Act. 8–9 (citing Bruecken 10:20–25; 14:5–11). Accordingly, we are unpersuaded of error in the Examiner’s rejection of claims 1 and 3.

Addressing claims 7 and 9, which both depend from claim 1, Appellant argues that none of the references teach that “the request received from the dispatched person further requests a tool required for the service to be performed at the service location” or that “the request received from the dispatched person further requests a product required for the service to be performed at the service location.” App. Br. 32–34. The Examiner cites Morris’s teaching of receiving a request for a part from a technician at the job site (Morris 22:26–42), Bruecken’s teaching of on-site services such as installation, maintenance, and repair services (Bruecken 4:21–41), and Nielsen’s teaching of scheduling technicians based on “available inventory needed to attend to activities (e.g., is inventory available in technician’s vehicle . . .)” (Nielsen 6:22–33). Final Act. 11–12; *see also* Ans. 12–13. Bruecken’s installation, maintenance, and repair services would generally require tools, and one of ordinary skill would have understood Nielsen’s “inventory needed to attend to activities” to include tools. Thus, we agree with the Examiner that the applied combination of references would have taught or at least suggested “further request[ing] a tool required for the service to be performed at the service location” (claim 7) to one of ordinary skill in the art. We also agree with the Examiner that “a product required for the service to be performed at the service location” (claim 9) encompasses the part requested by the technician in Morris, as well as the inventory available in the technician’s vehicle in Nielsen. Thus, the applied combination of references also teaches or suggests claim 9.

For the foregoing reasons, we sustain the Examiner’s rejection of claims 1, 3, 7, and 9, as well as claims 4–6 and 10–21 not separately argued by Appellant,

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under 35 U.S.C. § 103 as being unpatentable over Morris in view of O’Meara, Nielsen, and Bruecken.

### CONCLUSION

We affirm the Examiner’s rejection of claims 1, 3–7, and 9–21 under 35 U.S.C. § 101.

We affirm the Examiner’s rejection of claims 1, 3–7, and 9–21 under 35 U.S.C. § 103.

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

<b>Claims Rejected</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 3–7, 9–21	§ 101	1, 3–7, 9–21	
1, 3–7, 9–21	§ 103 – Morris, O’Meara, Nielsen, and Bruecken	1, 3–7, 9–21	
<b>Overall Outcome</b>		1, 3–7, 9–21	

**AFFIRMED**