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Keysight Technologies, Inc. In care of: CPA Global 900 Second Avenue South Suite 600 Minneapolis, MN 55402			ZARE, SCOTT A	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GRAHAM S. POLLOCK, STANLEY T. JEFFERSON, and
DANIEL L. PLEASANT

Appeal 2018-004860
Application 14/634,673¹
Technology Center 3600

Before ROBERT E. NAPPI, CATHERINE SHIANG, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants requested rehearing of the Decision entered May 24, 2019 (“Decision” or “Dec.”), which affirmed the Examiner’s rejection of claims 1–20 under 35 U.S.C. § 101. We have considered Appellants’ arguments, and such arguments have not persuaded us that we misapprehended or overlooked any arguments, facts, or points of law in our Decision. Therefore, we deny Appellants’ Request for Rehearing (“Req.”).

¹ Appellants identify Keysight Technologies, Inc. as the real party in interest. App. Br. 1.

THE 35 U.S.C. § 101 GUIDANCE

The USPTO recently published revised guidance on the application of § 101. USPTO, 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”). Under the guidance set forth in the 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) (Step 2A, Prong 1); 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, 2018) (Step 2A, Prong 2).

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 is 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 (Step 2B).

See Guidance, 84 Fed. Reg. at 54–56.

DISCUSSION²

A request for rehearing “must state with particularity the points [of law or fact] believed to have been misapprehended or overlooked by the Board,” and must comply with 37 C.F.R. § 41.52(a)(1).

I

First, Appellants contend “[c]onsider claim 1 . . . the claim is not directed to a mental process that can be performed in the human mind, since all of the steps must be carried out by the data processing system.” Req. 1–2.

We disagree, as Appellants do not persuasively explain why “the claim is not directed to a mental process that can be performed in the human mind.” Req. 2. To the contrary, as discussed in our Decision, independent claims 1 and 11 (with emphases) recite:

1. A method for operating a data processing system to *discover the attributes of instruments in a set of instruments connected* thereto, said method causing said data processing system to:

determine all instruments in said set of instruments connected thereto by sending a first query on each communication link connected to said data processing system;
receive a response that identifies one of said instruments, said response comprising a model identification code;
retrieve model configuration information from an instrument catalog database attached to said data processing system, said model configuration information comprising an option that is available on said one of said instruments and a second query that will cause that instrument to provide

² “Arguments not raised, and Evidence not previously relied upon . . . are not permitted in the request for rehearing except as permitted.” 37 C.F.R. § 41.52(a)(1). Therefore, to the extent Appellants advance new arguments without showing good cause, Appellants’ new arguments are untimely.

information on whether that option is installed on said one of said instruments, said second query being different from said first query, and sending said second query to said one of said instruments to determine if said option is installed on said one of said instruments.

11. A computer readable medium comprising instructions that cause a data processing system to execute a method for operating said data processing system to *discover the attributes of instruments in a set of instruments connected thereto, said method causing said data processing system to:*
determine all instruments in said set of instruments connected thereto by sending a first query on each communication link connected to said data processing system;
receive a response that identifies one of said instruments, said response comprising a model identification code;
retrieve model configuration information from an instrument catalog database attached to said data processing system, said model configuration information comprising an option that is available on said one of said instruments and a second query that will cause that instrument to provide information on whether that option is installed on said one of said instruments, said second query being different from said first query, and sending said second query to said one of said instruments to determine if said option is installed on said one of said instruments.

Claim 1 recites (i) “operating a data processing system to . . . causing said data processing system to”; (ii) “by sending a first query on each communication link connected to said data processing system”; (iii) “database attached to said data processing system, . . . a second query that will cause that instrument to . . .”; and (iv) “said second query being different from said first query, and sending said second query to said one of said instruments” for performing the above italicized functions of claim 1.

Similarly, Claim 11 recites (i) “[a] computer readable medium comprising instructions that cause a data processing system to execute a method for operating said data processing system to . . . causing said data processing system to”; (ii) “by sending a first query on each communication link connected to said data processing system”; (iii) “database attached to said data processing system, . . . a second query that will cause that instrument . . .”; and (iv) “said second query being different from said first query, and sending said second query to said one of said instruments” for performing the above italicized functions of claim 11.

All of the italicized functions can be performed in the human mind, or by a human using a pen and paper. They require acts, performable by a human being, of receiving information and making mental determinations based on that information. Accordingly, the italicized functions are like the mental processes in *CyberSource* and *Synopsys*

Dec. 6–8.

Second, Appellants argue “[c]onsider claim 1 . . . a human could not query the attached instruments, which *may be* remote from the location of the data processing system, using paper and pencil.” Req. 1–2 (emphasis added). That argument is unpersuasive because it is not commensurate with the scope of claim 1, as Appellants acknowledge claim 1 does not require the argued “remote” location. In any event, Appellants’ argument is unpersuasive because a human can travel to the remote location, if necessary.

Third, Appellants argue claim 1 does not recite mathematical concepts or certain methods of organizing human activity under the Guidance. *See* Req. 2. That argument is unpersuasive because our Decision determines claim 1 recites mental processes, and thus an abstract idea under the

Guidance. *See* Guidance, Step 2A, Prong 1 (Groupings of Abstract Ideas).
See Dec. 6–9.

II

Appellants argue “the limitations of the claim do integrate the ‘abstract idea’ identified by the Examiner into a practical application that allows a user to determine if a specific option is available on an instrument that is connected to the data processing system.” Req. 2–3.

That argument is unpersuasive, because Appellants do not provide sufficient evidence or explanation to support the argument. In particular, Appellants’ assertion that “the claimed elements do more than contribute nominally or insignificantly to the method. Without the communication link, instrument catalog database and the data processing system, the user could not ascertain the target information” (Req. 3) is unsubstantiated. As discussed in our Decision (Dec. 6–12) and above, a person can obtain the information mentally via observation. Further, Appellants’ assertion that “the claim links the data processing system to a particular machine, i.e., the instruments being queried, in a manner that is integral to the claim” (Req. 3) does not persuade us of error, as Appellants do not persuasively explain why broadly reciting “instruments” that can be purely software instruments (Spec. ¶ 17) renders the claim patent eligible.

In any event, our Decision (Dec. 9–13) explains in details why the claims do not recite additional elements that integrate the judicial exception into a practical application, and Appellants have not persuasively disputed our analysis.

Therefore, Appellants' arguments about claim 1 are unpersuasive. For similar reasons, Appellants' arguments about claims 2–20 are unpersuasive.

CONCLUSION

For the reasons stated above, Appellants have not persuaded us that we misapprehended or overlooked any issue of fact or law in our Decision.

We have *granted* Appellants' Request for Rehearing to the extent that we have reconsidered our Decision. Appellants have not shown that we misapprehended or overlooked any issue of law or fact in reaching that decision. Accordingly, we deny Appellants' Request for Rehearing.

DENIED