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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* LUIS JOAQUIN RODRIGUEZ

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Appeal 2018-006667  
Application 14/245,859  
Technology center 2100

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Before St. JOHN COURTENAY, III, JOHN A. EVANS, and JOHN D. HAMANN, *Administrative Patent Judges*.

EVANS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> seek our review under 35 U.S.C. § 134(a) of the Examiner’s Final rejection of Claims 41–60. App. Br. 4. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.<sup>2</sup>

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<sup>1</sup> Appellant, inventor Luis Joaquin Rodriguez, argues *pro se* and identifies himself as the real party in interest. App. Br. 1. We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42.

<sup>2</sup> Rather than reiterate the arguments of Appellant and the Examiner, we refer to the Appeal Brief (filed September 6, 2017, “App. Br.”), the Reply Brief (filed January 16, 2018, “Reply Br.”), the Examiner’s Answer (mailed December 14, 2017, “Ans.”), the Non-Final Action (mailed February 21,

## STATEMENT OF THE CASE

The claims relate to a drawing apparatus. *See* Abstract.

## INVENTION

Claims 41, 47, 55, and 57 are independent. An understanding of the invention can be derived from a reading of Claim 41, which is reproduced In Table I, *infra*.

### *References and Rejections*<sup>3</sup>

Banning '494 <sup>4</sup>	US 2005/0270494	Dec. 8, 2005
Nishikawa	US 2009/0319237 A1	Dec. 24, 2009
Banning '321	US 7,746,321 B2	June 29, 2010

1. Claims 41–60 stand rejected under 35 USC § 101 as directed to non-statutory subject matter.<sup>5</sup> Non-Final Act. 5.
2. Claims 41–60 stand rejected under 35 USC § 103(a) as unpatentable over Banning '494 and Nishikawa. Final Act. 6–13.

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2017, “Non-Final Act.”), and the Specification (filed July 24, 2016, “Spec.”) for their respective details.

<sup>3</sup> The Application was examined under the first inventor to file provisions of the AIA.

<sup>4</sup> Banning '494 issued as Banning '321.

<sup>5</sup> The Examiner has withdrawn the rejection of Claims 33–35 as mooted by their cancellation. Ans. 2. The Examiner has withdrawn the separate rejection of Claim 51 as directed to human activity. Ans. 2.

## ANALYSIS

We have reviewed the rejections of Claims 41–60 in light of Appellant’s arguments that the Examiner erred.

### IMPROPER EXAMINATION.

Variouly throughout the Briefs, Appellant complains the Examiner has improperly conducted the examination of the present Application. *Cf.* App. Br. 7; Reply Br. 2, *ff.*

We do not reach the merits of Appellant’s contentions in this regard. The Director of the United States Patent and Trademark Office, not the Board, supervises examination and examiners. 35 U.S.C. §§ 3(a)(2)(A), 132(a). If an Examiner has procedurally erred, the remedy lies exclusively in petitioning the Director for supervisory review. 37 C.F.R. § 1.181; *cf.* 35 U.S.C. § 6(b) (giving substantive review powers directly to the Board). The Director has not delegated this supervisory authority to the Board. *Cf.* 37 C.F.R. § 41.3 (delegating some petition authority to the Chief Administrative Patent Judge, not the Board) and § 41.50(b) (delegating to the Board the discretion to enter a new ground, propose a curative amendment or order additional briefing).

### Claims 41–60: INELIGIBLE SUBJECT MATTER

Appellant argues all claims as a group without reference to any, particular claim. App. Br. 8–9. Therefore, we decide the appeal of the 35 U.S.C. § 101 rejections with reference to independent Claim 41, and refer to the rejected claims collectively herein as “the claims.” *See* 37 C.F.R. § 41.37(c)(1)(iv); *see also In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986).

## PRINCIPLES OF LAW

### A. 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.<sup>6</sup>

Appellant contends his invention falls within at least one statutory class and that “Anything under the sun that is made by humans, except for laws of nature, natural phenomena, abstract ideas, humans and processes which do not use or transform hardware are patentable.”<sup>7</sup> App. Br. 8–9.

As Appellant suggests (*see* App. Br. 8–9), the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012) (citing *Diamond v. Diehr*, 450 U.S. 175, 185 (1981)).

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, 217–18 (2014) (citing *Mayo*, 566 U.S. at 75–77). 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

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<sup>6</sup> This threshold analysis of whether a claim is directed to one of the four statutory categories of invention, i.e., a process, machine, manufacture, or composition of matter, is referred to as “*Step 1*” in the patent-eligibility inquiry under 35 U.S.C. § 101.

<sup>7</sup> The material in quotes is similar, but not identical, to material from *Diamond v. Chakrabarty*, 447 U.S. 303, 304, 309 (1980)).

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 certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *see also Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diehr*, 450 U.S. at 191); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. (15 How.) 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held “a claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 187, 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* at 191 (citing

*Benson and Flook*), 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

Abstract ideas may include, but are not limited to, fundamental economic practices, methods of organizing human activities, and mathematical formulas or relationships. *Alice*, 573 U.S. at 217–21. Under this guidance, we must therefore ensure at step one that we articulate what the claims are directed to with enough specificity to ensure the step one inquiry is meaningful. *Id.* at 217 (“[W]e tread carefully in construing this exclusionary principle lest it swallow all of patent law.”).

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 (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.*

B. USPTO Revised Guidance<sup>8</sup>

The PTO recently published revised guidance in the Federal Register

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<sup>8</sup> 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (January 7, 2019) (hereinafter “Revised Guidance,” or “Rev. Guid.”)

concerning the application of § 101.

Under the Revised 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);<sup>9</sup> and

(2) additional elements that integrate the judicial exception into a practical application (*see* Manual for Patent Examining Procedure (“MPEP”) §§ 2106.05(a)–(c), (e)–(h)).<sup>10</sup>

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.<sup>11</sup>

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(<https://www.govinfo.gov/content/pkg/FR-2019-01-07/pdf/2018-28282.pdf>).

<sup>9</sup> Referred to as “*Revised Step 2A, Prong 1*” in the Revised Guidance (hereinafter “*Step 2A(i)*”).

<sup>10</sup> Referred to as “*Revised Step 2A, Prong 2*” in the Revised Guidance (hereinafter “*Step 2A(ii)*”).

<sup>11</sup> Items (3) and (4) continue to be collectively referred to as “*Step 2B*” of the Supreme Court’s two-step framework, described in *Mayo* and *Alice*.

*See Revised Guidance.*

*Step 2A(i) — Abstract Idea*

Informed by our judicial precedent, the Revised Guidance extracts and synthesizes key concepts identified by the courts as abstract ideas to explain that the abstract idea exception includes the following groupings of subject matter, when recited as such in a claim limitation:

(a) Mathematical concepts—mathematical relationships, mathematical formulas or equations, mathematical calculations;

(b) Certain methods of organizing human activity — fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions); and

(c) Mental processes—concepts performed in the human mind (including an observation, evaluation, judgment, opinion).

Under the Revised Guidance, if the claim does not recite a judicial exception (a law of nature, natural phenomenon, or subject matter within the enumerated groupings of abstract ideas above), then the claim is patent-eligible at *Step 2A(i)*. This determination concludes the eligibility analysis, except in rare situations identified in the Revised Guidance.<sup>12</sup>

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<sup>12</sup> In the rare circumstance in which an Examiner believes a claim limitation that does not fall within the enumerated groupings of abstract ideas should

However, if the claim recites a judicial exception (i.e., an abstract idea enumerated above, a law of nature, or a natural phenomenon), the claim requires further analysis for a practical application of the judicial exception in *Step 2A(ii)*.

*Step 2A(ii) — Practical Application*

If a claim recites a judicial exception in *Step 2A(i)*, we determine whether the recited judicial exception is integrated into a practical application of that exception in *Step 2A(ii)* by: (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application.

The seven identified “practical application” sections of the MPEP,<sup>13</sup> cited in the Revised Guidance under *Step 2A(ii)*, are:

- (1) MPEP § 2106.05(a) Improvements to the Functioning of a Computer or To Any Other Technology or Technical Field
- (2) MPEP § 2106.05(b) Particular Machine
- (3) MPEP § 2106.05(c) Particular Transformation
- (4) MPEP § 2106.05(e) Other Meaningful Limitations

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nonetheless be treated as reciting an abstract idea, the procedure described in of the Guidance for analyzing the claim should be followed. *See* Guidance, Section III.C.

<sup>13</sup> *See* MPEP § 2106.05(a)–(c), (e)–(h). Citations to the MPEP herein refer to revision [R-08.2017].

- (5) MPEP § 2106.05(f) Mere Instructions To Apply An Exception
- (6) MPEP § 2106.05(g) Insignificant Extra-Solution Activity
- (7) MPEP § 2106.05(h) Field of Use and Technological Environment

If the recited judicial exception is integrated into a practical application as determined under one or more of the MPEP sections cited above, then the claim is not directed to the judicial exception, and the patent-eligibility inquiry ends. If not, then analysis proceeds to *Step 2B*.

*Step 2B — “Inventive Concept” or “Significantly More”*

Under our precedent, it is possible that a claim that does not “integrate” a recited judicial exception under *Step 2A(ii)* is nonetheless patent eligible. For example, the claim may recite additional elements that render the claim patent eligible even though a judicial exception is recited in a separate claim element.<sup>14</sup> The Federal Circuit has held claims eligible at the second step of the *Alice/Mayo* test (USPTO *Step 2B*) because the additional elements recited in the claims provided “significantly more” than the recited judicial exception (e.g., because the additional elements were unconventional in combination).<sup>15</sup> Therefore, if a claim has been determined to be directed to a judicial exception under *Revised Step 2A*, we must evaluate the additional elements individually and in combination under

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<sup>14</sup> See, e.g., *Diehr*, 450 U.S. at 187.

<sup>15</sup> See, e.g., *Amdocs (Israel), Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1300, 1304 (Fed. Cir. 2016); *BASCOM Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349–52 (Fed. Cir. 2016); *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257–59 (Fed. Cir. 2014).

*Step 2B* to determine whether they provide an inventive concept (i.e., whether the additional elements amount to significantly more than the exception itself).<sup>16</sup>

Under the Revised Guidance, we must consider in *Step 2B* whether an additional element or combination of elements: (1) “Adds 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;” or (2) “simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception, which is indicative that an inventive concept may not be present.” *See* Revised Guidance, III.B.<sup>17</sup>

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<sup>16</sup> The patent eligibility inquiry may contain underlying issues of fact. *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325. (Fed. Cir. 2016). In particular, “[t]he question of whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018).

<sup>17</sup> In accordance with existing *Step 2B* guidance, an Examiner’s finding that an additional element (or combination of elements) is well understood, routine, conventional activity must be supported with at least one of the four specific types of evidence required by the USPTO *Berkheimer* Memorandum, as shown above. For more information concerning evaluation of well-understood, routine, conventional activity, *see* MPEP § 2106.05(d), as modified by the USPTO *Berkheimer* Memorandum (USPTO Commissioner for Patents Memorandum dated Apr. 19, 2018, “Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*)” (hereinafter “*Berkheimer Memo*”).

In the *Step 2B* analysis, an additional element (or combination of elements) is not well-understood, routine or conventional unless the examiner finds an evidentiary basis, and expressly supports a rejection in writing with, one or more of the following:

1. A citation to an express statement in the specification or to a statement made by an applicant during prosecution that demonstrates the well-understood, routine, conventional nature of the additional element(s). . . .
2. A citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s).
3. A citation to a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s)  
. . . .
4. A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s)

*See Berkheimer Memo.*

The analysis in *Step 2B* further determines whether an additional element or combination of elements:

- (a) Adds 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; or
- (b) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception, which is indicative that an inventive concept may not be

present.

Revised Guidance, *and see Berkheimer* Memo.

If the Examiner or the Board determines under *Step 2B* that the element (or combination of elements) amounts to significantly more than the exception itself, the claim is eligible, thereby concluding the eligibility analysis.

However, if a determination is made that the element and combination of elements does not amount to significantly more than the exception itself, the claim is ineligible under *Step 2B*, and the claim should be rejected for lack of subject matter eligibility.

## ANALYSIS

### *Step 1*

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof may obtain a patent therefor . . .” M.P.E.P. § 2104 (quoting 35 U.S.C. § 101).

Independent Claim 41 recites, *inter alia*, a “power device”; Independent Claim 47 recites, *inter alia*, a “device for calculating dimensions”; Independent Claim 55 recites, *inter alia*, a “point and click drawing and measuring device”; Independent Claim 57 recites, *inter alia*, a “drawing and measuring device.” Thus, each independent claim is a machine under § 101. Therefore, the issue before us is whether the claims, despite reciting a statutory class, are nonetheless directed to a judicial exception without significantly more.

*Step 2A(i): Does the Claim Recite a Judicial Exception?*

The Examiner finds the claims fall within a statutory category, but finds the concept which underlies each claim is “equivalent to a drawing an application on a computer - this concept is not meaningfully different than those concepts found by the courts to be abstract.” Ans. 3 (analogizing to *Electric Power Group*, i.e., collecting information, analyzing it, and displaying certain results of the collection and analysis; *Classen*, collecting and comparing known information, and *Affinity Labs*, delivering user-selected media content to portable devices).

We review the claims, *de novo*, to determine whether they comply with 101. “Whether a claim is drawn to patent-eligible subject matter is an issue of law that we review *de novo*.” *SiRF Tech., Inc. v. Int’l Trade Common*, 601 F.3d 1319, 1331 (Fed. Cir. 2010); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016).

The preamble of Claim 41 recites a “power device to draw and measure real world dimensions, comprising.” The remaining limitations of Claim 41 are set forth in the left column of Table I and analyzed according to the Revised Guidance in the right column.

**Table I**

<b>Claim 41</b>	<b>Revised Guidance</b>
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[a] <sup>18</sup> a) central processing unit, wherein said central processing unit further has a point and click mechanism,	A machine, a statutory subject class under 35 U.S.C. § 101, and a non-abstract limitation.
[b] b) a drawing and measuring software program installed on said central processing unit,	Mental processes—concepts performed in the human mind. <sup>19</sup> (including an observation, evaluation, judgment, opinion).
[c] c) a viewing display unit,	A structural machine, a non-abstract additional limitation.
[d] wherein upon pointing with said point and click mechanism to a first point in a real world area, a first cursor position is defined and displayed on said viewing display unit,	“Point and click mechanism” recitation ties method to a machine.
[e] wherein upon clicking on said first cursor position with said point and click mechanism, a first node is defined and displayed on said viewing display unit,	“Point and click mechanism” recitation ties method to a machine.
[f] wherein upon pointing with said	“Point and click mechanism”

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<sup>18</sup> Step designators, e.g., “[a]” were added to facilitate discussion.

<sup>19</sup> If a claim, under its broadest reasonable interpretation, covers performance in the mind but for the recitation of generic computer components, then it is still in the mental processes category unless the claim cannot practically be performed in the mind. *See Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1318 (Fed. Cir. 2016) (“[W]ith the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper.”).

<p>point and click mechanism to a second point in a real world area, a second cursor position is defined and displayed on said viewing display unit,</p>	<p>recitation ties method to a machine.</p>
<p>[g] wherein upon clicking on said second cursor position with said point and click mechanism, a second node is defined and displayed on said viewing display unit,</p>	<p>“Point and click mechanism”        recitation ties method to a machine.</p>
<p>[h] wherein the distance of said first node and said second node is proportional to the distance between said first point and said second point in said real world area,</p>	<p>Mental processes: concepts performed in the human mind (including an observation, evaluation, judgment, opinion).</p>
<p>[i] wherein said drawing and measuring software calculates the distance between said first point and said second point in said real world area,</p>	<p>Mental processes: concepts performed in the human mind (including an observation, evaluation, judgment, opinion).</p>
<p>[j] wherein said drawing and measuring software connects said first node and said second node with a straight line and displays said line on said viewing display unit,</p>	<p>Mental processes: concepts performed in the human mind (including an observation, evaluation, judgment, opinion).</p>
<p>[k] wherein upon pointing with said point and click mechanism to at least one more point in said real world area, at least one more cursor position is defined and displayed on said viewing display unit,</p>	<p>“Point and click mechanism”        recitation ties method to a machine.</p>
<p>[l] wherein upon clicking on said at least one more cursor position with</p>	<p>“Point and click mechanism”</p>

<p>said point and click mechanism, at least one more node is defined, and displayed on said viewing display unit,</p>	<p>recitation ties method to a machine.</p>
<p>[m] wherein said drawing and measuring software calculates the distance between said second point and said at least one more point in said real world area,</p>	<p>Mental processes: concepts performed in the human mind.</p>
<p>[n] wherein said drawing and measuring software connects said second node and said at least one more node with a straight line and displays said straight line on said viewing display unit,</p>	<p>Mental processes: concepts performed in the human mind.</p>
<p>[o] wherein upon pointing again to said first point on said rea world area with said point and click mechanism, a final cursor position coincides with said first cursor position,</p>	<p>“Point and click mechanism”        recitation ties method to a machine.</p>
<p>[p] wherein upon pointing with said point and click mechanism on said first cursor position, a final node coinciding with said first node is defined and a two dimensional area is defined,</p>	<p>“Point and click mechanism”        recitation ties method to a machine.</p>
<p>[q] wherein said drawing and measuring software calculates the square dimension of said two dimensional area and displays on a proportional scale said square dimension of said two dimensional</p>	<p>Mental processes: concepts performed in the human mind.</p>

area on said viewing display unit.	
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Limitations [b], [h]–[j], [m], [n], and [q] recite what may appear to be “mental processes.” *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372 (Fed. Cir. 2011) (holding that the incidental use of “computer” or “computer readable medium” does not make a claim otherwise directed to process that “can be performed in the human mind, or by a human using a pen and paper” patent eligible). However, *CyberSource* distinguished the incidental use of a computer from those inventions that “could not, as a practical matter, be performed entirely in a human’s mind.” *Id.* at 1376 (citing *Research Corp. Techs. v. Microsoft Corp.*, 627 F.3d 859 (Fed. Cir. 2010), and *SiRF Tech., Inc. v. Int’l Trade Comm’n*, 601 F.3d 1319 (Fed. Cir. 2010)), as directed to inventions that “could not, as a practical matter, be performed entirely in a human’s mind”). *See Rev. Guid.*, 52, n. 14.

In *Thales Visionix*, the Court analyzed independent system Claim 1 which “requires: (1) a first inertial sensor mounted on the tracked object; (2) a second inertial sensor mounted on the moving platform; and (3) an element that uses the data from the two inertial sensors to calculate the orientation of the tracked object relative to the moving platform. *Thales Visionix, Inc. v. U. S.*, 850 F.3d 1343, 1348 (Fed. Cir. 2017). The Court found that the claims utilized abstract ideas, but that the claims describe a system which is not directed to the underlying abstract ideas. *Id.* Similarly, Appellant discloses the pointing/measurement apparatus includes, *inter alia*, optical tracking, laser, ultrasonic, high frequency radio wave, and GPS distance measurement devices. *See Spec.*, 4. Appellant discloses the output of the

measurement devices is fed into a drawing application such as CorelDraw™ or architectural or technical tracing programs. *Id.* 3. We find the present claims, similarly as those of *Thales*, utilize, but are not directed to, the underlying abstract ideas.

The *Thales* Court, reviewed cases where the Federal Circuit held claims valid at *Alice* Step 1 because “they did not claim the natural law itself, but a particular application of the natural [law.]” *Thales*, at 1347 (citing *Rapid Litigation Management Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1045 (Fed. Cir. 2016) and *Enfish LLC v. Microsoft Corp.*, 822 F.3d 1327, 1330 (Fed. Cir. 2016)). Because we find the claims are not “directed to” an abstract idea, we find the claims recite patent-eligible subject matter. In view of the foregoing, we reverse the rejection of Claims 41–60.

#### CLAIMS 41–60: OBVIOUSNESS OVER BANNING AND NISHIKAWA.

The Examiner finds “Banning discloses a power device to draw and measure real world dimensions.” Non-Final Act. 6 (“wherein upon pointing with said point and click mechanism to a first point in a real world area, a first cursor position is defined and displayed on said viewing display unit.”) (citing Banning, ¶¶ 63–65). The Examiner finds Banning fails to teach a drawing and measuring software program for which the Examiner cites Nishikawa. Non-Final Act. 8.

Appellant contends, contrary to the Examiner, that Banning discloses a device “to control a cursor within a computer environment.” App. Br. 10. Appellant argues Banning fails to teach measurement of real world dimensions. *Id.*, 9.

In response to Appellant’s contention that Banning fails to teach measurement of real world dimensions, the Examiner finds Appellant advances a non-analogous art argument. Ans. 5. The Examiner finds Banning teaches measurement of a real world surface. *Id.*

Contrary to the Examiner’s finding, we find Banning fails to teach measurement of real-world surfaces. Banning discloses a display system comprising a portable projection device 40 and a projection surface 60 wherein the display system is connected to a computer which may be in base station 30. Banning, ¶ 60. Projection device 40 projects an image 70 onto surface 60. *Id.*, ¶ 61. Image 70 comprises interaction region 71 and substantially coincident interaction structure 72. *Id.* The projection device 40 projects a computer-generated image 70 onto projection surface 60. *Id.*, ¶56. Banning discloses an “aspect of the invention is a method for controlling a parameter related to a position of a computer display cursor based on a point-of-aim of a pointing device within an interaction region. *Id.*, ¶ 28. Thus, Banning fails to disclose pointing at a real-world region, as claimed. Claim 41, Limitation [d] (“wherein upon pointing with said point and click mechanism to a first point in a real world area, a first cursor position is defined and displayed on said viewing display unit”). Rather, Banning discloses the use of a pointer to interact with a computer-generated image.

Because the prior art fails to teach at least one claimed limitation, we decline to sustain the rejection of Claims 41–60.

## DECISION

The rejection of Claims 41–60 under 35 U.S.C. § 101 is reversed.

The rejection of Claims 41–60 under 35 U.S.C. § 103 is reversed.

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
41–60	101	Abstract Ideas		41–60
41–60	103	Banning and Nishikawa		41–60
<b>Overall Outcome</b>				41–60

REVERSED