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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes application details for 15/483,474 and 112978, 7590, 12/19/2019, listing inventor Hernan A. Cunico and attorney Cuenot, Forsythe & Kim, LLC. Also includes examiner ZEWDU, MELESS NMN, art unit 2643, and notification date 12/19/2019 via electronic mode.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HERNAN A. CUNICO and ASIMA SILVA

Appeal 2018-007261
Application 15/483,474
Technology Center 2600

Before ALLEN R. MacDONALD, JAMES B. ARPIN, and
NABEEL U. KHAN, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 21–40. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellant identifies the real party-in-interest as IBM Corporation.
Appeal Br. 1.

CLAIMED SUBJECT MATTER

Claim 21 is illustrative of the claimed subject matter (emphasis, formatting, and bracketed material added):

21. A computer-implemented method, comprising:

[A.] *sending*, responsive to detecting an unanswered message sent by a sender to a receiving mobile device of a recipient of the unanswered message and based upon an escalation plan for the recipient, *a first escalation message to a first contact of the recipient*; and

[B.] *sending*, responsive to determining that the unanswered message is still unanswered subsequent to the sending the first escalation message, *a second escalation message to a second contact of the recipient*, wherein the second contact of the recipient is determined using:

[i.] the escalation plan,

[ii.] a relationship between the sender and the recipient,

[iii.] a relationship between the second contact and the recipient, and

[iv.] a proximity of the second contact to a last known location of the receiving mobile device.

REFERENCES²

The prior art relied upon by the Examiner is:

Name	Reference	Date
Jordan	US 8,611,869 B2	Dec. 17, 2013
Fisher	US 2014/0179354 A1	June 26, 2014

² All citations herein to patent and pre-grant publication references are by reference to the first named inventor only.

REJECTIONS

A.

The Examiner rejects claims 35–40 under 35 U.S.C. § 101 because “the claimed invention is directed to non-statutory subject matter.” Final Act. 9.

We select claim 35 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv). Appellant does not separately argue claims 36–40. Except for our ultimate decision, we do not discuss the § 101 rejection of claims 36–40 further herein.

B.

The Examiner rejects claims 21–40 under 35 U.S.C. § 103 as being unpatentable over the combination of Jordan and Fisher. Final Act. 6–8.

As to the § 103 rejection, Appellant presents separate arguments for claims 21–25. Appeal Br. 10–19.³ Appellant does not argue separate patentability for claims 26–40. We select:

claim 21 as representative of claims 21, 26–28, 33–35, and 40;

claim 22 as representative of claims 22, 29, and 36;

claim 23 as representative of claims 23, 30, and 37;

claim 24 as representative of claims 24, 31, and 38; and

claim 25 as representative of claims 25, 32, and 39.

Except for our ultimate decision, we do not address claims 26–40 further herein.

³ We read any reference to “claim 1” on page 10 of the Appeal Brief as to –claim 21–. Examiner does similarly. Ans. 7.

OPINION

We have reviewed the Examiner’s rejections in light of Appellant’s Appeal Brief and Reply Brief arguments.

A. USPTO § 101 Guidance

The United States Patent and Trademark Office (USPTO) has published revised guidance on the application of § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (“2019 Memorandum”). Under that guidance,

As before, Step 1 of the USPTO’s eligibility analysis entails considering whether the claimed subject matter falls within the four statutory categories of patentable subject matter identified by 35 U.S.C. 101: Process, machine, manufacture, or composition of matter.

2019 Memorandum 14.

B. The Panel’s § 101 Analysis

Claim 35 recites in-part “[a] computer program product, comprising: *a computer readable storage medium* having program code stored therein.” (Emphasis added.)

The Examiner determines that claims 35–40 “do not fall within at least one of the four categories of patent eligible subject matter.” May 18, 2017 Non-Final Act. 2.

Citing to paragraph 65 of the Specification, Appellant contends raises the following argument in contending that the Examiner erred in rejecting claim 35 under 35 U.S.C. § 101.

[A] portion of paragraph [0065] is reproduced below:

A computer readable storage medium, as used herein, is not to be construed as being transitory signals per se,

Consequently, Appellants' specification discloses the opposite to that described by the Examiner. . . . Examiner cannot construe the claim language of claim 35 as encompassing transitory signals per [se].

Appeal Br. 8–9; *see In re Morris*, 127 F.3d 1048, 1053 (Fed. Cir. 1997) (“[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, *taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.*” (emphasis added)).

We do not find in the Answer any Examiner response to Appellant’s § 101 contention. Therefore, based on Appellant’s contention, we determine the Examiner’s analysis fails to demonstrate that claim 35 does not fall within at least one of the four categories of patent-eligible subject matter.

C. § 103 – Claim 21

C. 1.

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 21 under 35 U.S.C. § 103.

Independent claim [21] recites, in part, the limitations of “the second contact of the recipient is determined using: . . . a relationship between the sender and the recipient.” Regarding these limitations, on page 9 of the First Office Action, the Examiner relied solely upon Jordan to teach these limitations. Specifically, the Examiner cited column 5, lines 47-65 of Jordan

without any additional explanation. . . . Appellants respectfully disagree.

While this passage refers to relationships between the mobile device user (i.e., corresponding to the claimed recipient) and the alternate contact (i.e., corresponding to the claimed second contact), ***absent from this passage is any mention of using the relationship between the sender and the recipient as a basis for determining the second contact.*** . . . Consequently, Jordan fails to teach the limitations for which Jordan alone is being relied upon to teach.

Appeal Br. 10–11.

We are unpersuaded by Appellant’s contention. Appellant restrictively limits his contention to Jordan’s teachings at column 5, lines 47–65. We look in addition to Jordan’s teachings at column 5, lines 28–31, and column 4, line 66, through column 5, line 10, which were cited by the Examiner. At column 4, line 67, through column 5, line 1, Jordan teaches that “priority may be based on the communication initiator (e.g., spouse, child, co-worker),” which is a relationship between the sender and recipient. At column 5, lines 57–60, Jordan teaches that “[o]ne or more alternate contacts 16 are identified based on the location of the mobile device 12 and relationships between the mobile device user [i.e., recipient] and the alternate contacts 16 (step 66).” At column 5, lines 64–65, Jordan teaches that “[t]he alternate contact 16 may also have a relationship with the communication initiator 10.”

We determine that these teachings of Jordan are suggestive to an artisan that, in addition to determining priority using the relationship between the sender and recipient, the alternative contact can be determined based on the relationship between the sender and recipient.

C. 2.

Also, Appellant raises the following argument in contending that the Examiner erred in rejecting claim 21 under 35 U.S.C. § 103.

Appellants respectfully submit that Fisher is non[-]analogous prior art that cannot be properly applied against the claimed invention. The determination that a prior art reference is analogous prior art is an issue of fact. . . . Whether a prior art reference is from a non[-]analogous art involves (a) determining whether the reference is within the same field of endeavor and (b) determining whether the reference is reasonably pertinent to *a known problem in the art*. *In re Bigio*, 381 F.3rd [sic] 1320, 1325 (Fed Cir. 2004).

Appeal Br. 13 (emphasis added).

The claimed invention is within the field of message escalation (i.e., in the context of an unanswered message from a sender to a recipient). Fisher, however, is not within the field of message escalation. Instead, Fisher is directed to identifying contact opportunities (e.g., “use the obtained contact information to make sales pitches to the potential customers ... or by visiting the potential customers at their residence or business address”). Moreover, the Examiner has not alleged that Fisher is reasonably pertinent to a *known* need or problem in the field of endeavor. Thus, Fisher is non[-]analogous prior art that cannot be applied against the claimed invention.

Appeal Br. 14 (emphasis added).

The Examiner also asserts that “both Jordan and Fisher deal with identifying contact based on location.” However, “identifying contact based on location” is *not the field of endeavor* to which Appellants’ invention is directed.

Appeal Br. 15 (emphasis added).

We are unpersuaded by Appellant’s contention. First, Appellant misstates the holding in *Bigio*. The correct statement in *Bigio* is:

Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent *to the particular problem with which the inventor is involved*.

Bigio, 381 F.3d at 1325. Stated differently, a reference may be properly considered analogous art if it is reasonably pertinent to a problem addressed by the inventor; that is, if it would have logically commended itself to an inventor's attention. *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

Second, even if we accept Appellant's contention that "'identifying contact based on location' is not the field of endeavor to which Appellants' invention is directed" (Appeal Br. 15), we determine that identifying a contact based on location is a particular problem with which the inventor is involved (Spec. ¶ 4), and Fisher is reasonably pertinent (Fisher ¶ 43) to that particular problem.

D. § 103 – Claim 22

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 22 under 35 U.S.C. § 103.

As claimed, the plan involves a "number of escalation messages and category of relationship." While the Examiner's cited passage [of column 5, lines 18–32 of Jordan] makes a passing mention to "repeated communications are received from the same person," the Examiner's cited passage is silent as to the claimed "category of relationship." Therefore, Jordan fails to teach the limitations at issue recited in claim 22.

Appeal Br. 16.

We are unpersuaded by Appellant's contention. At, column 4, line 66, through column 5, line 10, Jordan explicitly teaches using a category of

relationship, as do column 5, lines 58–59 and 64–65; and column 6, lines 22–47.

E. § 103 – Claim 23

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 23 under 35 U.S.C. § 103.

As claimed, the plan involves “rules for posting an escalation message to a social networking system.” While the Examiner’s cited passage [of column 4, lines 31–39 of Jordan] uses a social networking site to identify relationships between the user and other contacts, this does [not] involve posting an escalation message to the social networking site. Therefore, Jordan fails to teach the limitations at issue recited in claim 23.

Appeal Br. 17.

As to Appellant’s contention, we are unpersuaded. Jordan states:

The user may limit the people that can be identified as an alternate contact 16. For example, the user may tag people within their social network that the alternate contact notifier 18 may contact.

Jordan, column 4, lines 36–39. We agree with the Examiner that Jordan’s teaching of tagging people within their social network as contacts equates to rules for posting an escalation message to a social networking system.

F. § 103 – Claim 24

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 24 under 35 U.S.C. § 103.

As noted above, the limitations at issue recognize the escalation plan specifies rules that recognize different categories of relationship exist between the contact and the recipient and between the sender and the recipient. While the Examiner’s cited

column 5, lines 47-65 refers to relationships, this passage is silent as to different categories of relationships.

Appeal Br. 18.

As to Appellant's contention, we are unpersuaded. As we have already noted above, at Column 4, line 66, through column 5, line 10, Jordan explicitly teaches using a category of relationship, as do column 5, lines 58–59 and 64–65; and column 6, lines 22–47.

G. § 103 – Claim 25

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 25 under 35 U.S.C. § 103.

The Examiner's cited passage [of column 4, line 58 through column 5, line 17 of Jordan] initially describes how priority information 24 is used to identify a communication as a "priority communication." This passage also explains how priority may be based upon a number of factors. Referring to column 5, Jordan also explains how a user may configure preferences, such as when a particular person attempts to contact the user with a communication, that communication will be labeled as priority. Finally, Jordan identifies other types of communications that can be designated as priority. Notably, nothing about the Examiner's cited passage within Jordan refers to "an amount of the unanswered message to expose within the first and second escalation messages." Therefore, Jordan fails to teach the limitations at issue recited in claim 25.

Appeal Br. 19.

As to Appellant's contention, we are unpersuaded. At column 6, lines 23–47, Jordan teaches that a message to a "daughter" contact may vary in content. The daughter contact message may be a basic message (e.g., "tell her mother to check her phone") or "it may be more detailed." *Id.* We deem

this to reasonably suggest that any part or all of the unanswered message may be part of that more detailed contact message.

CONCLUSION

Appellant has shown the Examiner erred in rejecting claims 35–40 under 35 U.S.C. § 101, as directed to patent-ineligible subject matter.

The Examiner has not erred in rejecting claims 21–40 as unpatentable under 35 U.S.C. § 103.

The Examiner’s rejection of claims 35–40 as patent ineligible under 35 U.S.C. § 101 is **reversed**.

The Examiner’s rejection of claims 21–40 as being unpatentable under 35 U.S.C. § 103 is **affirmed**.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
35–40	101	Eligibility		35–40
21–40	103	Jordan, Fisher	21–40	
Overall Outcome			21–40	

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