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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ELIE GENDLOFF

Appeal 2019-001163
Application 14/145,972
Technology Center 3600

Before BIBHU R. MOHANTY, MICHAEL C. ASTORINO, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

MOHANTY, *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 22 and 40–44. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We REVERSE.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Elie Gendloff. (Appeal Br. 2).

CLAIMED SUBJECT MATTER

The Appellant's claimed invention relates to a restaurant that serves an ingredient to a customer before the ingredient is harvested (Abstract). Claim 22, reproduced below, is representative of the subject matter on appeal.

22. A method of serving a customer of a restaurant, the method comprising an employee of the restaurant serving an ingredient of an item to the customer before the ingredient is harvested, wherein the ingredient is part of a plant growing in a container.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 22 and 40–44 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
2. Claims 22, 41, 42, and 44 are rejected under 35 U.S.C. § 102(b) as anticipated by Farmer Chefs, July 2010, Alaska Airlines Magazine, pages 66–74 (hereinafter “Farmer Chefs”).
3. Claims 40 and 43 are rejected under 35 U.S.C. § 103(a) as unpatentable over Farmer Chefs.

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.²

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellant argues that the rejection of claim 22 is improper because the claim is not directed to an abstract idea (App. Br. 6–8; Reply Br. 12).

In contrast, the Examiner has determined that the rejection of record is proper (Final Action 2–5, 11, 12, Ans. 3–10). The Examiner has first asserted that the claimed subject matter is not “transformed” into a different state or thing (Final Action 3, Ans. 4, 5). The Examiner has also determined that the claim is directed to an abstract idea without “significantly more” (Final Action 3–5).

We agree with the Appellant. An invention is patent eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, 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. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

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*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). 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 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; *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” (*Diamond v. Diehr*, 450 U.S. 175, 192 (1981)); “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 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 that “[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; *see also id.* at 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.* (internal citation omitted) (citing *Benson* and *Flook*); *see, e.g., id.* at 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.”).

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) (“Guidance”). Under 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); and
- (2) additional elements that integrate the judicial exception into a practical application, i.e., evaluate whether the claim “appl[ies], rel[ies] on, or use[s] 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.” (*see* Guidance, 84 Fed. Reg. at 54; *see also* MPEP § 2106.05(a)–(c), (e)–(h)).

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.

See Guidance.

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.* (alterations in original) (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.*

Here, the Examiner has first asserted that the claimed subject matter is not “transformed” into a different state or thing (Final Action 3, Ans. 4, 5). However, although the “machine-or-transformation test is a useful and important clue,” the test “is not the sole test for deciding whether an invention is a patent-eligible” process. *See Bilski v. Kappos*, 561 U.S. at 604.

The Examiner has also determined that the claim is directed to an abstract idea without “significantly more” (Final Action 3–5, Ans. 8). The rejection of record states that the claim is directed to “methods of organizing human activity” and abstract concept (Final Action 3, 4, Ans. 8).

We determine the rejection has not provided a sufficient rationale to clearly establish that the claim is directed to a “certain method of organizing human activity”. The *2019 Revised Patent Subject Matter Eligibility Guidance*, sets forth in the abstract idea sections as examples of “(b) [c]ertain methods of organizing human activity [as] 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).” Here, the rejection of record does not

clearly establish how the subject matter of the claim is drawn to be encompassed in the abstract subject matter outlined in the *Guidance* as a “certain method of organizing human activities”. Here it is unclear on the record before us for example how “serving of an ingredient of an item to the customer before the ingredient is harvested, wherein the ingredient is part of a plant growing in a container” is a fundamental economic practice, commercial or legal interaction, or managing personal behavior or interactions between people. Thus, we determine that the rationale provided before us in the rejection has failed to establish the claim is directed to a “certain method of organizing human activity” as set forth. As the rejection has failed to procedurally put forth a sufficient rationale to determine that the claim is directed to an abstract concept, the rejection of record is not sustained.

Rejections under 35 U.S.C. § 102(a) and 35 U.S.C. § 103(a)

The Appellant argues that the rejection of claim 22 is improper because the cited prior art fails to disclose the claim limitation for “an employee of the restaurant serving an ingredient of an item to the customer before the ingredient is harvested, wherein the ingredient is part of a plant growing in a container” (App. Br. 8-10, Reply Br. 2).

In contrast, the Examiner has determined that the cited claim limitation is shown by Farmer Chefs at page 69, paragraph 6; page 70, paragraph 5; page 71, paragraph 1; page 72, paragraph 2; and page 73, page 1 (Ans. 11). The Examiner has also determined that the limitation “wherein the ingredient is part of a plant growing in a container” is a mere label and does not distinguish the claim (Ans. 12).

We agree with the Appellant. Here, the claim limitation “wherein the ingredient is part of a plant growing in a container” is not a mere label, but a limitation to the claim. The argued claim limitation requires “an employee of the restaurant serving an ingredient of an item to the customer *before* the ingredient is harvested, wherein the ingredient is part of a plant growing in a container.” The Specification at page 6, paragraph 3, provides support for this claim limitation. Here, the above citations to the Farmer Chefs reference fail to disclose this argued claim limitation. As the above citations to the prior art fail to disclose the argued claim limitation the rejection under 35 U.S.C. § 102(a) is therefore not sustained.

With respect to the rejection of dependent claims 40 and 43 under 35 U.S.C. § 103(a), the rejection of record fails to cure the deficiency of the argued missing claim limitation or provide a rationale for such a modification with rational underpinnings without impermissible hindsight and this rejection is not sustained as well.

CONCLUSIONS OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting claims 22 and 40–44 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

We conclude that Appellant has shown that the Examiner erred in rejecting claims 22, 41, 42, and 44 under 35 U.S.C. § 102(b) as anticipated by Farm Chefs.

We conclude that Appellant has shown that the Examiner erred in rejecting claims 40 and 43 under 35 U.S.C. § 103(a) as unpatentable over Farm Chefs.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
22, 40–44	101	Eligibility		22, 40–44
22, 41, 42, 44	102(a)	Farmer Chefs		22, 41, 42, 44
40, 43	103(a)	Farmer Chefs		40, 43
Overall Outcome				22, 40–44

REVERSED