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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN DELANEY, REED SMITH, and MICHAEL MARINO

Appeal 2019-002045
Application 14/303,064
Technology Center 2100

Before JEFFREY S. SMITH, DAVID J. CUTITTA II, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* BENNETT.

Opinion Dissenting-in-Part filed by *Administrative Patent Judge* SMITH.
BENNETT, *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 1–46. We have jurisdiction under 35 U.S.C. § 6(b).

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 ESGI, LLC. Appeal Br. 2.

We affirm.

CLAIMED SUBJECT MATTER

The claims are directed to a tracking system and method. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A computer-implemented method of tracking a tracked entity, comprising:

obtaining identifying image feature data from the tracked entity;

generating, by a tracking entity, characteristic data relevant to the tracked entity at a first location, wherein the characteristic data includes the identifying image feature data;

storing the characteristic data at a server; and

accessing, by at least one of the tracking entity and another tracking entity, at least a portion of the stored characteristic data at at least one of the first location and another location in order to track a current physical location and condition of the tracked entity.

Appeal Br. 155 (Appendix A).

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Daniel	US 2003/0228033 A1	Dec. 11, 2003
Kenedy	US 2010/0169340 A1	July 1, 2010
Shaw	US 2010/0198650 A1	Aug. 5, 2010

REJECTIONS

The Examiner rejects claims 1–46 under 35 U.S.C. § 101 as being directed to ineligible subject matter. Non-Final Act. 2–5.

The Examiner rejects claims 1–23 and 30–46 under 35 U.S.C. § 103 as being unpatentable over Kenedy and Daniel. Non-Final Act. 6–22.

The Examiner rejects claims 24–29 under 35 U.S.C. § 103 as being unpatentable over Kenedy, Daniel, and Shaw. Non-Final Act. 6–22.

REJECTION UNDER 35 U.S.C. § 101

Standard for Patent Eligibility

In issues involving subject matter eligibility, our inquiry focuses on whether the claims satisfy the two-step test set forth by the Supreme Court in *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208 (2014). The Court instructs us to “first determine whether the claims at issue are directed to a patent-ineligible concept,” *id.* at 218, and, in this case, the inquiry centers on whether the claims are directed to an abstract idea. If the initial threshold is met, we then move to the second step, in which we “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.* at 217–18 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 79, 78 (2012)). The Court describes the second step as a search for “an ‘inventive concept’”—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (quoting *Mayo*, 566 U.S. at 72–73).

The USPTO has published revised guidance on the application of § 101 consistent with *Alice* and subsequent Federal Circuit decisions. USPTO, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”), updated by USPTO, *October 2019 Update: Subject Matter Eligibility* (available at <https://www.uspto.gov/sites/>

default/files/documents/peg_oct_2019_update.pdf) (“October 2019 Guidance Update”).

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) (referred to Step 2A, prong 1 in the Guidance); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)) (referred to Step 2A, prong 2 in the Guidance).

See 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 move to Step 2B of the Guidance. There, we 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, 84 Fed. Reg. at 56.

*Examiner’s Findings and Conclusions*²

The Examiner rejects claim 1 as being directed to a judicial exception without significantly more under *Alice*. Non-Final Act. 2–5; Ans. 4–7.

Under the first step of the *Alice* inquiry, the Examiner determines claim 1 is

² Each of the relevant documents in this appeal was filed or mailed prior to the issuance of the Guidance. As such, they each applied the case law-based approach from previous eligibility guidance in rejecting the claims under § 101. Our analysis of the § 101 rejection is made under the Guidance.

directed to a judicial exception. Non-Final Act. 2–3. Specifically, the Examiner determines that the recited “generating,” and “accessing” steps of claim 1 recite an abstract idea because “[t]his process is simply the mere aggregation of data in order [to] present that mere data back to the requestor, along with additional related content” and “is nothing more than the mere manipulation and presentation of data.” Non-Final Act. 3. The Examiner determines that the recited process is similar to those found abstract in prior cases such as *Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315 (Fed. Cir. 2017) and *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332 (Fed. Cir. 2017).

Under the second step of the *Alice* inquiry, the Examiner determines that “[t]he recited additional elements of Claim 1 are not considered ‘significantly more’ than the abstract idea presented within Claim 1 and provide the mere storage of information.” Non-Final Act. 4. The Examiner further determines that “[l]ooking at the limitations as an ordered combination adds nothing that is not already present when looking at the elements taken individually. There is no indication that the combination of elements improves the functioning of a computer or improves any other technology.” Non-Final Act. 4.

Appellant’s Contentions

Appellant argues the cases cited by the Examiner are distinguishable because in those cases “already-existing data was manipulated according to the invention.” Appeal Br. 17. Appellant further asserts that claim 1 “does more than manipulate already-existing data . . . [because] a human participant must provide new data, such as by identifying image feature data

from the tracked entity and generating characteristic data relevant to the tracked entity.” Appeal Br. 17.

Revised Guidance, Step 2A, Prong One³
The Judicial Exception

Applying the Guidance, we are not persuaded the Examiner has erred in determining that the claims recite a judicial exception to patent eligible subject matter. The Guidance identifies three judicially-excepted groupings: (1) mathematical concepts, (2) certain methods of organizing human activity such as fundamental economic practices and commercial interactions, and (3) mental processes. We focus our analysis on the second and third groupings—certain methods of organizing human activity and mental processes.⁴

³ Throughout this opinion, we give the claim limitations the broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

⁴ Although Appellant’s Brief purports to argue each claim separately, the arguments presented for each claim are substantially identical in form. In each case, the argument: (1) summarizes what the claim recites, (2) restates the Examiner’s position, (3) notes the claim is a dependent claim, and (4) asserts that the claim “does more than merely provide data manipulation.” Appeal Br. 19–76. This form of repetitive and conclusory argument “will not be considered an argument for separate patentability.” 37 C.F.R. § 41.37(c)(1)(iv) (2018). As such, we consider Appellant’s arguments against the § 101 rejection to be made to the claims generally, and we treat claim 1 as representative. 37 C.F.R. § 41.37(c)(1)(iv) (2018) (“When multiple claims subject to the same ground of rejection are argued as a group or subgroup by Appellant, the Board may select a single claim from the group or subgroup and may decide the appeal as to the ground of rejection with respect to the group or subgroup on the basis of the selected claim alone.”).

We conclude the limitations of claim 1 recite both a mental process and a commercial interaction, which amounts to a combination of abstract ideas under the Guidance.⁵ For example, claim 1 recites (1) “obtaining identifying image feature data from the tracked entity,” and (2) “generating, by a tracking entity, characteristic data relevant to the tracked entity at a first location, wherein the characteristic data includes the identifying image feature data,” (3) “storing the characteristic data,” (4) “accessing, by at least one of the tracking entity and another tracking entity, at least a portion of the stored characteristic data at at least one of the first location and another location in order to track a current physical location and condition of the tracked entity.” As a whole, these limitations recite tracking of items in transit. Accordingly, they may be categorized as a commercial interaction that falls within the enumerated group of “certain methods of organizing human activity.” Guidance, 84 Fed. Reg. at 52. Separately, these limitations each recite an abstract mental process under the Guidance because they each can be performed by a human in their mind either through observation, evaluation and judgment, and also because they can be performed by a human with the aid of pen and paper. *See* October 2019 Guidance Update at 7 (“examples of mental processes include observations, evaluations, judgments, and opinions”), 9 (“A claim that encompasses a human performing the step(s) mentally with the aid of a pen and paper recites a mental process”) (emphasis omitted).

⁵ *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“Adding one abstract idea . . . to another abstract idea . . . does not render the claim non-abstract.”); *see also FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (patent-ineligible claims were directed to a combination of abstract ideas).

For example, limitation (1), which recites obtaining identifying image feature data from the tracked entity, can be performed by a person through observation by visually inspecting the tracked item. Limitation (2), which recites “generating, by a tracking entity, characteristic data relevant to the tracked entity at a first location, wherein the characteristic data includes the identifying image feature data,” is also an action that can be performed mentally, as a person, having inspected the item, could readily draw the observed image on a piece of paper. Limitations (3) and (4), which recite storing and accessing the data at a location also can be performed mentally by a person. Storing the observed characteristic data can be stored by a person remembering the data, and accessing the data can be performed by mentally recalling that same data while the person is at the location.

Under the Guidance, these limitations recite both a mental process and a commercial interaction of tracking items in transit. Accordingly, we conclude the claimed process set forth in claim 1 *recites* judicial exceptions of both a mental process and of a commercial interaction, which is a certain method of organizing human activity under the Guidance.

Revised Guidance, Step 2A, Prong Two
Integration of the Judicial Exception into a Practical Application

Having determined that claim 1 recites a judicial exception, our analysis under the Guidance turns now to determining whether claim 1 recites any additional elements that integrate the judicial exception into a practical application. *See* Guidance, 84 Fed. Reg. at 54–55 (citing MPEP § 2106.05(a)–(c), (e)–(h)).

Under the Guidance, limitations that are indicative of “integration into a practical application” include:

1. Improvements to the functioning of a computer, or to any other technology or technical field — *see* MPEP § 2106.05(a);
2. Applying the judicial exception with, or by use of, a particular machine — *see* MPEP § 2106.05(b);
3. Effecting a transformation or reduction of a particular article to a different state or thing — *see* MPEP § 2106.05(c); and
4. Applying or using the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception — *see* MPEP § 2106.05(e).

In contrast, limitations that are not indicative of “integration into a practical application” include:

1. Adding the words “apply it” (or an equivalent) with the judicial exception, or merely include instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea — *see* MPEP § 2106.05(f);
2. Adding insignificant extra-solution activity to the judicial exception — *see* MPEP § 2106.05(g); and
3. Generally linking the use of the judicial exception to a particular technological environment or field of use — *see* MPEP § 2106.05(h).

See Guidance, 84 Fed. Reg. at 54–55 (“Prong Two”).

As shown above, most of the claim limitations in claim 1 recite abstract ideas. The only limitation in the claim additional to those abstract limitations recites that characteristic data is stored “at a server.” The use of

a generic server, however, merely evinces the use of conventional computer technology to implement the otherwise abstract process on a computer. It is well-established, however, that the use of generic technology to implement an abstract idea is insufficient to integrate it into a practical application. *See* MPEP 2106.05(f) (explaining that it is not indicative of integration into a practical application where the claims “merely include instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea”).

In sum, Appellant’s invention is focused on improving the commercial practice of tracking items as they are in transit. The purported improvement identified provided by the claims is not to technology, but instead to a business process, and therefore constitutes an improvement to the abstract idea itself. It is well-established, however, that improvements in the abstract idea are insufficient to confer eligibility on an otherwise ineligible claim. *SAP Am. Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1168 (Fed. Cir. 2018). We conclude claim 1 is *directed to* a judicial exception under step 2A, prong 2, of the Guidance.

The Inventive Concept – Step 2B

Having determined the claim is directed to a judicial exception, we proceed to evaluating whether claim 1 adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)) or 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, 84 Fed. Reg. at 56.

Our review of the Examiner’s rejection under Step 2B is guided by the *Berkheimer Memorandum*, which sets forth what fact finding requirements are applicable to rejections under § 101. Consistent with the *Berkheimer Memorandum*, we agree with the Examiner that claim 1 does not add specific limitations beyond what is well-understood, routine, and conventional.

Our analysis focuses largely on the same limitation addressed in Step 2A, prong 2, above. We agree with the Examiner that the addition of a generic “server” does not supply an inventive concept under Step 2B because the server is described at a high level, in functional terms, without any detail in the Specification regarding how those functions are achieved. Spec. 13–14 (section entitled “Cloud or Server”). This lack of detailed description evidences the well-understood, routine, and conventional nature of the recited “server.”

Because the Examiner correctly concluded claim 1 is directed to a judicial exception, and because Appellant does not identify any error in the Examiner’s determination under step 2B of the Guidance, we sustain the rejection of representative claim 1 under 35 U.S.C. § 101, as well as of the remaining claims.

REJECTION UNDER 35 U.S.C. § 103

We reverse the prior art rejections. The Examiner rejects claim 1 as obvious over the combined teachings of Kenedy and Daniel. The Examiner finds that Kenedy teaches a computer-implemented method of tracking a tracked entity which generates data relevant to the tracked entity at a first location and storing that data. Non-Final Act. 6 (citing Kenedy ¶¶ 63, 64, 111, 139, 153). The Examiner finds that Kenedy does not teach either the

“obtaining” or “accessing” limitations of claim 1, and introduces Daniels to address the deficiency. Non-Final Act. 6–7 (citing Daniels ¶¶ 22, 51–53, and 58).

Appellant argues the Examiner has erred in several respects (Appeal Br. 77–90), but we need only address one here. Appellant argues Kenedy is deficient in that “[t]he system does not generate data relevant to a tracked entity at a first location.” Appeal Br. 77. We agree.

Kenedy is directed to monitoring user behavior online in order to provide “personalized online recommendations of web items that are based on the user’s pangenetic makeup.” Kenedy, Abstract. The Examiner cites tracking user behavior as described in paragraph 153 of Kenedy as teaching the recited “generating, by a tracking entity, characteristic data relevant to the tracked entity at a first location.” Non-Final Act. 6. However, we agree with Appellant that Kenedy does not track the location of the user either in the cited paragraph or otherwise. In fact, in the cited passage, Kenedy makes no reference whatsoever to the location of the user. As such, we agree with Appellant that Kenedy does not teach the disputed limitation. The Examiner makes no finding with respect to Daniels that cures this deficiency in Kenedy. Accordingly, we do not sustain the rejection of claim 1 under 35 U.S.C. § 103.⁶

⁶ In the event of further prosecution of this patent application, we suggest the Examiner consider whether Shaw, cited in connection with certain dependent claims, remedies the identified deficiencies in Kenedy.

Remaining Claims

The remaining claims each incorporate the argued limitation of claim 1 by virtue of their claim dependencies. As such, we also do not sustain the rejections of the remaining claims.

CONCLUSION

We affirm the Examiner's rejection of claims 1–46 under 35 U.S.C. § 101.

We reverse the Examiner's rejections of the claims under 35 U.S.C. § 103.

Because we have affirmed at least one ground of rejection for each claim on appeal, we affirm the Examiner's decision to reject the claims. 37 C.F.R. § 41.50(a)(1).

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–46	101	Eligibility	1–46	
1–23, 30–46	103	Kenedy, Daniel		1–23, 30–46
24–29	103	Kenedy, Daniel, Shaw		24–29
Overall Outcome			1–46	

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

SMITH, *Administrative Patent Judge*, dissenting-in-part.

I disagree with the decision to reverse the rejection under 35 U.S.C. § 103. Claim 1 recites “generating, by a tracking entity, characteristic data relevant to the tracked entity at a first location.” Appellant argues Kenedy is deficient in that “[t]he system does not generate data relevant to a tracked entity at a first location.” Appeal Br. 77. According to Appellant, the “individual terms must be given their usual definitions unless otherwise noted in the specification.” *Id.* at 85. Appellant contends that “track” as claimed, according to a dictionary definition, means to “follow the course or trail of (someone or something), typically in order to find them or note their location at various points.” *Id.* at 85–86.

However, Appellant incorrectly states the standard for broadest reasonable interpretation. The *claims* measure the invention. *See SRI Int’l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). During examination, the Office must apply *the broadest reasonable meaning* to the claim language (and not, as Appellant contends, the “usual definitions”), taking into account any definitions *presented in the specification*. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Under the broadest reasonable interpretation, “[a]bsent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO’s definition unreasonable when the PTO can point to other sources that support its interpretation.” *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

Our reviewing court guides that extrinsic evidence, such as a dictionary definition, is unlikely to result in a reliable interpretation of patent

claim scope unless considered in the context of the intrinsic evidence. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1319 (Fed. Cir. 2005). The court in *Phillips* states that “heavy reliance on the dictionary divorced from the intrinsic evidence risks transforming the meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context, which is the specification.” *Id.* at 1321. The court further states that “a general-usage dictionary cannot overcome art-specific evidence of the meaning of a claim term. . . . The dictionary does not always keep abreast of the inventor. It cannot.” *Id.* at 1322 (citations omitted).

When determining the meaning of a claim term, the court states that the Specification “is always highly relevant to the claim construction analysis. Usually, it is dispositive; *it is the single best guide to the meaning of a disputed term.*” *Id.* at 1315 (citation omitted). In particular, “[a] claim construction that excludes a disclosed embodiment is rarely, if ever, correct and would require highly persuasive evidentiary support.” *Adams Respiratory Therapeutics, Inc. v. Perrigo Co.*, 616 F.3d 1283, 1290 (Fed. Cir. 2010)(citation omitted). Here, Appellant’s Specification does not provide an express definition of “track” that is limited to tracking a location. Rather, Appellant’s Specification provides several non-limiting examples of “track,” in addition to tracking location, that include tracking various other things such as a person’s status or treatment history, tracking time, or tracking changes in data. Spec. 1 (“However, it is important to track not only the person’s location, but also his or her status and treatment history”), 2 (“Currently, known tracking systems focus on time and location, and do not provide additional details”), 9 (“Thus, the system . . . provides the ability to track pets, livestock, people, and objects at various levels of treatment,

aid, care, or service”), 14 (“These correlations . . . help track the progression of Patient 1 through the various stages of treatment”), claim 5 (“tracking chronological changes in biometric data”). The Specification concludes by stating that the “*exemplary embodiments* are illustrative of the inventive concept recited in the appended claims, and *are not limiting of the scope or spirit of the present invention* as contemplated by the inventors.” Spec. 18:19–20. Thus, the scope of “track” encompasses, but is not limited to, at least these disclosed non-limiting examples.

In particular, the scope of “track” is broader than the disclosed non-limiting examples, and the claims are not confined to the specific embodiments described in the specification. *See Phillips*, 415 F.3d at 1323. Here, the Examiner finds that Paragraph 64 of Kenedy discloses “monitoring users’ (tracked entities) online behavior to track and record what each user clicks on” Ans. 9. Also, Paragraph 93 of Daniel discloses that “observations by the practitioner . . . may be tracked.” Kenedy and Daniel provide art-specific evidence of the meaning of “track” to a person of ordinary skill in the art. Appellant’s citation to “a general-usage dictionary cannot overcome art-specific evidence of the meaning of” track provided by Kenedy and Daniels. *See Phillips*, 415 F.3d at 1322.

Appellant’s contention, that the meaning of “track” is limited by an extrinsic dictionary definition to mean “following the course or trail of (someone or something) typically in order to find them or note their location at various points,” is (a) not recited in the claim, (b) not a limiting definition found in Appellant’s Specification, (c) excludes the Specification’s disclosed embodiments of tracking things other than location, and (d) excludes art-specific evidence of tracking things other than location. Excluding disclosed

embodiments is “rarely, if ever, correct and would require highly persuasive evidentiary support,” which Appellant has not provided. *Adams*, 616 F.3d at 1290. Further, the dictionary definition cited by Appellant does not overcome the art-specific evidence cited by the Examiner. *Phillips*, 415 F.3d at 1322. “[T]he fact that appellants can point to [a] definition[] . . . that conform[s] to their interpretation does not make the PTO’s definition unreasonable when the PTO can point to other sources that support its interpretation,” such as the Specification’s and the prior art’s disclosures of tracking things other than location. *Morris*, 127 F.3d at 1056.

The Examiner finds that both Kenedy and Daniel teach “generating, by a tracking entity, characteristic data relevant to the tracked entity at a first location” as claimed. Ans. 8–11. For example, the Examiner finds that Kenedy teaches a system that generates behavioral data relevant to the behavior characteristic of a user at the user’s zip code location. Ans. 8–9. The Examiner’s findings are supported by the record. Both the behavioral “characteristic data” and the zip code “characteristic data,” which are “relevant to the” user, or “tracked entity,” are generated by the system, or “tracking entity,” when the “tracked entity” is “at a first location” as indicated by the user’s zip code, as taught by Kenedy. *See* Kenedy ¶ 97, Fig. 8. I agree with the Examiner, that Kenedy teaches “generating, by a tracking entity, characteristic data relevant to the tracked entity at a first location” within the scope of claim 1 as read in light of Appellant’s Specification. The Examiner makes similar findings regarding the teachings of Daniel. Ans. 10–11.

Appellant does not respond to the Examiner’s findings in the Reply. Because Appellant has not identified any specific deficiencies in the

Examiner’s findings showing Examiner error, Appellant has not provided persuasive evidence or argument to rebut the Examiner’s prima facie case. *See In re Jung*, 637 F.3d 1356, 1365–66 (Fed. Cir. 2011) (citing *Ex Parte Frye*, 94 USPQ2d 1072 (BPAI 2010) (precedential)).

Further, the scope of “generating . . . characteristic data” is not limited to generating tracking data. Under the broadest reasonable interpretation, this claim limitation does not recite that the step of “generating . . . characteristic data” performs generating data for tracking a location of the tracked entity, nor does this limitation recite generating data for tracking any other feature of the tracked entity. Rather, the scope of the claimed “generating . . . characteristic data” encompasses “generating” data that is “relevant to the tracked entity,” regardless of whether such data is used for tracking or not. The term “at a first location” does not limit the characteristic data to be location data, but rather, limits either the “tracking entity” or the “tracked entity” to be located at “a first location” when the “characteristic data” is generated.⁷ Appellant’s contention that this limitation requires generating data for tracking a location, or anything else, is not commensurate with the broadest reasonable interpretation of the claim.

“Construing claims broadly during prosecution is not unfair to the applicant . . . because the applicant has the opportunity to amend the claims to obtain more precise claim coverage.” *Am. Acad.*, 367 F.3d at 1364. “An essential purpose of patent examination is to fashion claims that are precise,

⁷ The claim language is vague as to whether the tracking entity or the tracked entity is at the first location. Given that this claim term, along with several other claim terms, are amenable to two or more plausible interpretations, the Examiner should consider whether the claim satisfies the requirements of 35 U.S.C. § 112, second paragraph.

clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989). Here, if Appellant intends the claimed “tracking entity” to generate location data of the “tracked entity,” then Appellant has the opportunity to amend the claims to obtain more precise claim coverage. If Appellant intends that the claimed “tracking entity” actually tracks the location of a tracked entity by following the course or trail of (someone or something), typically in order to find them or note their location at various points, then Appellant has the opportunity to amend the claims to actually recite this limitation.

Similarly, contrary to Appellant’s contention, the claim limitation “accessing by at least one of the tracking entity and another tracking entity, at least a portion of the stored characteristic data at at least one of the first location and another location” does not require accessing location data of the tracked entity, nor does this limitation require tracking anything. This claim limitation does not recite that the “stored characteristic data” that is accessed is location data. Rather, this limitation recites accessing “a portion of the stored characteristic data,” where the “characteristic data” is data that is “relevant to the tracked entity” as discussed in the analysis of the “generating” step above. The scope of the at least one “location” recited in this limitation encompasses the location of the entity that is “accessing” the data. In particular, the claim recites that the “accessing” is performed by one of the tracking entities that is located at either “the first location,” or at “another location.” If Appellant intended “the first location” and “another location” to mean something other than the location of the entity that is accessing the data, then Appellant has the opportunity to amend the claims.

If Appellant intended to limit the “stored characteristic data” to mean location data of the tracked entity, then Appellant has the opportunity to amend the claims to obtain more precise claim coverage.

Even were this limitation construed to be limited to accessing location data of the tracked entity, the scope of “accessing . . . characteristic data at at least one of a first location and another location” only requires, under this unduly narrow construction, accessing location data for “the first location” of the tracked entity. Contrary to Appellant’s contention, the claim does not track an entity by following the trail of a tracked entity, because the claim, even under this unduly narrow construction, only accesses one location, which is not a trail, but a single location.⁸ The Examiner finds that both Kenedy and Daniel teach accessing the first location of the tracked entity, even under this unduly narrow claim interpretation. *See* Ans. 9 (citing Kenedy ¶ 97 (“[F]or example a zip code value which indicates a user location.”)). Appellant does not rebut the Examiner’s findings in the Reply.

The claim limitation “in order to track a current physical location and condition of the tracked entity” is not positively recited as a method step in the claim. The “in order to” clause does not affect any steps of the method of claim 1. Rather, this limitation recites the intended result of the “accessing” step. The “in order to” clause is not entitled to patentable weight. *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329 (Fed. Cir. 2005) (The court held that a “clause in a method claim is not given weight when it

⁸Appellant’s Specification does not disclose how the claimed step of “accessing” a single location would result in tracking a location of an entity by following a trail of the entity. The Examiner should consider whether the claims satisfy the requirements of 35 U.S.C. § 112, first paragraph, as well as second paragraph.

simply expresses the intended result of a process step positively recited.”).
If Appellant intended “track[ing] a current physical location and condition of the tracked entity” to be a step that is positively performed by the method of claim 1, then Appellant has the opportunity to amend the claims.

Given (a) the scope of the claim under broadest reasonable interpretation, (b) Appellant’s incorrect claim interpretation, (c) that Appellant’s arguments regarding the teaching of the prior art are not commensurate with the scope of the claim, and (d) that Appellant has failed to rebut the Examiner’s findings regarding both the scope of the claim and the teaching of the prior art, I would affirm the Examiner’s rejection.