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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HANS-DIETER HUMPERT, DIETER KLEYER, and
KLAUS WENDELBERGER

Appeal 2019-002535
Application 13/983,115
Technology Center 3600

Before HUNG H. BUI, ADAM J. PYONIN, and
DAVID J. CUTITTA II, *Administrative Patent Judges*.

CUTITTA, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 16–24.² We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “[A]pplicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Siemens Aktiengesellschaft. Appeal Br. 2.

² Claims 1–15 are cancelled. Non-Final Act. 2.

STATEMENT OF THE CASE

Invention

Appellant's recited "invention relates to a method for producing a specific planning document for instrumentation and control equipment to be planned for a technical system, in particular for power plant instrumentation and control equipment to be planned for a power plant." Spec. ¶ 2.³

Exemplary Claim

Independent claim 16 is exemplary of the claimed subject matter and is reproduced below with claim element labels added in brackets and limitations at issue in italics:

16. A method for controlling a power plant comprising:

[a] providing a database comprising selectable standard objects including function plans, operator displays and descriptions for designing power plants,

[b] providing a specification of a power plant including a definition list and a function list for the power plant, the definition list including a number of lines, a number of stages including at least a first stage and a second stage, and presence of gate valves including a complete gate valve of the power plant and common gate valves of the first and second stages,

[c] generating a control system for the power plant comprising:

[c1] selecting multiple standard objects including a function plan, an operator display and a description from

³ We refer to: (1) the originally filed Specification filed August 1, 2013 ("Spec."); (2) the Non-Final Office Action mailed April 20, 2018 ("Non-Final Act."); (3) the Appeal Brief filed October 22, 2018 ("Appeal Br."); (4) the Examiner's Answer mailed December 12, 2018 ("Ans."); and (3) the Reply Brief filed February 11, 2019 ("Reply Br.").

the database based on the definition list and function list of the specification,

[c2] adapting selected standard objects based on the definition list and function list, thereby creating the control system comprising selected and adapted standard objects, *the adapting comprising actuating switches in the function plan depending on the presence of the complete gate valve of the power plant,*

[c3] implementing the control system comprising the selected and adapted standard objects on a computer of the power plant, and

[c4] controlling, by the computer, the power plant based on the control system.

Appeal Br. 9 (Appendix of Claims on Appeal).

REJECTIONS

The Examiner rejects claims 16–24 under 35 U.S.C. § 101 as reciting patent-ineligible subject matter. Non-Final Act. 5–6.

The Examiner rejects claims 16–24 under 35 U.S.C. § 103(a) as obvious over S. Lu et al., “An Object-Oriented Power Plant Adaptive Control System Design Tool,” *IEEE Transactions on Energy Conversion*, Vol. 10, No. 3, September 1995, (“Lu”) in view of Parikh et al. (US 2005/0086635 A1, published April 21, 2005) (“Parikh”), and R. L. Clark, “Effects of Aging and Service Wear on Main Steam Isolation Valves and Valve Operators,” Oak Ridge National Laboratory, Prepared for U.S. Nuclear Regulatory Commission, NUREG/CR-6246, ORNL-6814, March 1996 (“Clark”). *Id.* at 7–10.

ANALYSIS

We review the appealed rejections for error based upon the issues identified by Appellant and in light of Appellant’s arguments and evidence. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2017).

Rejection under 35 U.S.C. § 101

I. Principles of Law

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 US 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. *See, 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 Court’s two-step framework, described in *Alice* and *Mayo*. *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 217.

If the claim recites an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, in which “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 (internal quotation marks 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.*

The Office published revised guidance on the application of § 101. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (hereinafter “Guidance”). Recently, the USPTO published an update to that guidance. *October 2019 Patent Eligibility Guidance Update*, 84 Fed. Reg. 55,942 (hereinafter “Guidance Update”).⁴ Under the Guidance and the Guidance Update, in determining whether a claim falls within an excluded category, we first look to whether the claim recites:

- (1) Step 2A — Prong One: 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) Step 2A — Prong Two: additional elements that integrate the judicial exception into a practical application (*see* MPEP⁵ § 2106.05(a)–(c), (e)–(h)).

See Guidance, 84 Fed. Reg. 54–55 (“Revised Step 2A”). 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 (Step 2B):

- (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 The Guidance, as revised by the October 2019 Update, supplements previous guidance memoranda. Guidance, 84 Fed. Reg. 51 (“All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.”).

⁵ All Manual of Patent Examining Procedure (“MPEP”) citations herein are to MPEP, Rev. 08.2017, January 2018.

(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 id. at 56 (“*Step 2B: If the Claim Is Directed to a Judicial Exception, Evaluate Whether the Claim Provides an Inventive Concept.*”).

II. The Examiner’s § 101 Rejection

The Examiner determines that exemplary⁶ claim 16 is directed to a judicial exception: an abstract idea. Non-Final Act. 2–6; Ans. 3–5. According to the Examiner, claim 16 recites a mental process “similar to *Electric Power Group*⁷ where data is collected (e.g. selecting standard objects), analyzed and certain results are produced (e.g. adapting the standard objects to create the control system).” Non-Final Act. 5. The Examiner identifies the claimed “database” and “computer” as additional elements and determines “[t]he claim does not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional elements when considered both individually and as an ordered combination do not amount to significantly more than the abstract idea.” *Id.* at 5–6. We adopt the Examiner’s findings and conclusions as our own and add the following primarily for emphasis.

⁶ Appellant argues claims 16–24 as a group with respect to the § 101 rejection. Appeal Br. 5–6. We, thus, select independent claim 16 as representative of the claims. *See* 37 C.F.R. § 41.37(c)(1)(iv).

⁷ *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016).

III. Appellant's Arguments

We summarize Appellant's arguments in favor of eligibility as follows: (1) "[t]he recited subject matter of the claims is directed to an improvement to technology that can solve such a technological problem . . . [and] is thus inherently a technical process in the field of planning and controlling a technical system, i.e. power plant, and is not an abstract idea" (Appeal Br. 5); (2) "the recited claims do not preempt all possible solutions for controlling a power plant" (*id.*); (3) "the claims recite novel and non-obvious steps/functions which clearly constitute(s) significantly more than the alleged abstract idea, which is provided below with respect to the rejections under 35 U.S.C. § 103" (*id.* at 6).

IV. Our Review, Guidance, Step 1

We analyze the exemplary claim and the Examiner's rejection in view of the Guidance, and we adopt the nomenclature for the steps used in the Guidance. As an initial matter, the claims must recite at least one of four recognized statutory categories, namely, machine, process, article of manufacture, or composition of matter. MPEP § 2106(I); *see* 35 U.S.C. § 101. Appellant's independent claim 16 recites a method (i.e., a "process") and independent claim 21 recites a system (i.e., a "machine"). Thus, the pending claims recite a recognized statutory category of § 101 and we turn to the two-step *Alice/Mayo* analysis applied in accordance with the Guidance.

V. *Step 2A, Prong 1 in the Guidance (Alice/Mayo–Step 1)*
(*Judicial Exceptions*)

Next, we determine whether claim 16, being directed to a statutory class of invention, nonetheless falls within a judicial exception. Guidance, 84 Fed. Reg. 51.

Claim 16 recites “[a] providing a database,” “[b] providing a specification of a power plant including a definition list and a function list for the power plant,” “[c] generating a control system” . . . [by] “[c1] selecting multiple standard objects,” and “[c2] adapting selected standard objects based on the definition list and function list.” Appeal Br. 9. Apart from additional elements and post-solution activity discussed separately below, claim 16, under a broadest reasonable interpretation, recites “a method” having steps that can be practically performed in the mind. We, therefore, agree with the Examiner’s determination that claim 1 recites an abstract idea because the “steps of generating a control system by selecting standard objects and adapting the selected standard objects to create a control system [are] similar to *Electric Power Group* where data is collected (e.g. providing a database with standard objects), analyzed, and certain results are produced (e.g. adapting the standard objects to create the control system).” Non-Final Act. 5; *see* Guidance Update 7 (“a claim to ‘collecting information, analyzing it, and displaying certain results of the collection and analysis,’ where the data analysis steps are recited at a high level of generality such that they could practically be performed in the human mind, *Electric Power Group, LLC v. Alstom, S.A.*”); *see also* Spec. ¶¶ 10, 14.

Because claim 16 analyzes information by steps people may go through in their minds or with pen and paper, we conclude the claim recites a mental process as provided for in the Guidance.

VI. Step 2A, Prong Two in the Guidance
(Integration into a Practical Application)

Because claim 16 recites an abstract idea, we now determine whether the claim is directed to the abstract idea itself or whether it is instead directed to some technological implementation or application of, or improvement to, this idea, i.e., integrated into a practical application. *See, e.g., Alice*, 573 U.S. at 223 (discussing *Diamond v. Diehr*, 450 U.S. 175 (1981)). We determine whether the recited judicial exception is integrated into a practical application of that exception by: (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception or exceptions; and (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application. Guidance 84 Fed. Reg. 54–55. This evaluation requires an additional element or a combination of additional elements in the claim to apply, rely on, or use 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 exception. *See id.*

The Examiner finds claim 16 recites additional elements including a database and “a computer, where the control system is implemented on the computer and the computer is used to control the power plant.” Non-Final Act. 6. The Examiner determines the additional elements do not integrate the exception into a practical application because “[t]he computer components are recited at a high level of generality and recited as performing generic computer functions routinely used in computer applications.” *Id.*

Appellant argues “[t]he recited subject matter of the claims is directed to an improvement to technology that can solve such a technological problem,” i.e., reducing expense and errors in “creating power plant instrumentation and control equipment.” Appeal Br. 5.

We find Appellant’s argument unpersuasive. The Examiner points out that “[b]ased on the Specification the described problems are related to the control of a great number of variants used in each standard when designing a control system which may lead to considerable expense, probable errors, require expert knowledge, maintaining a library/database, etc. in the planning process.” Ans. 3 (citing Spec. ¶¶ 23–28). We agree with the Examiner that “[t]he described issues are related to the overall control system planning process, not the actual controlling of the control system, including producing planning documents and human activities (not an automated process), which is more of a business challenge than a technical problem.” Ans. 3. Here, the described improvement is to reduce expense and errors because “[m]annual adaptation of a standard to the respective project-specific requirements is always associated with considerable expense and corresponding susceptibility to errors.” Spec. ¶ 14. Essentially, the disclosed invention seeks to implement “the production of a planning document for instrumentation and control equipment of a technical system . . . at low cost and lower susceptibility to errors.” Spec. ¶ 17. To solve this non-technical problem, claim 16 collects data ([a], [b]), selects multiple standard objects from the collected data ([c1]), and adapts the selected standard objects to create a control system ([c2]). Appeal Br. 9. Claim 16 does not, for example, use technology to improve how the control system is implemented or how the database performs. Rather, claim 16 merely

automates, using generic computer technology, a pre-internet process. In this way, claim 16 is unlike the technology-based integrations cited by Appellant. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016) (holding that the patent-eligible claim was directed to a self-referential table to improve computer databases). Considering the claim as a whole, Appellant’s invention lacks a technical solution to a technical problem.

Appellant argues “the Claims as a whole integrate the (alleged) judicial exception into *a practical application* of that exception” because “the present Claims are directed to *improving a method for controlling a power plant.*” Reply Br. 4. This argument is unpersuasive because, as noted by Appellant, claim 16 is actually directed to more efficiently “generating and creating planning documents for the controlling of the power plant.” *Id.* Thus, limitation [c4] recites insignificant post-solution activity. *See* MPEP § 2106.05(g); *cf. ChargePoint, Inc. v. SemaConnect, Inc.*, 920 F.3d 759, 771 (Fed. Cir. 2019) (“[T]he fact that the electricity flow is modified based on demand response principles does nothing to make this claim directed to something other than the abstract idea.”). Considered in the context of claim 16 as a whole, the claimed additional elements do not integrate the abstract idea into a practical application. Guidance, 84 Fed. Reg. 55 nn.25 & 27–32 (citing MPEP §§ 2106.05(a)–(c), (e)–(h)). Fundamentally, Appellant argues that, because the claim uses a database and a computer, it is not directed to an abstract idea. Reply Br. 3–4. We are unpersuaded, however, because the mere presence of a database and computer in the claim does not necessarily indicate a technical solution. So, although claim 16 recites a computer and a database, this does not preclude the claim from being directed to the recited

judicial exception. To be sure, the recited processor may perform the calculations faster than a human could. Yet using a computer to achieve a solution more quickly may not be sufficient to show an improvement to computer technology. *See Versata Dev. Grp. v. SAP Am., Inc.*, 793 F.3d 1306, 1335 (Fed. Cir. 2015); *see also* MPEP § 2106.05(a)(II) (instructing examiners that a “commonplace business method being applied on a general purpose computer” may not be sufficient to show an improvement).

Likewise, Appellant has not disclosed a technical improvement to a database—e.g., an improvement to the way the database stores or retrieves information. Apart from the judicial exception, claim 16 does not use any particular database feature. Using a database to store data in its ordinary capacity, without more, is not sufficient to integrate the abstract idea into a practical application. *See, e.g., Accenture Glob. Servs. GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1343–44 (Fed. Cir. 2013) (explaining that the generic database components did not make the claims patent eligible in that case).

In addition, Appellant’s claimed additional elements do not transform matter; at best, they transform *information*. That is, the claim simply collects, manipulates, and outputs data, thereby “implementing the control system comprising the selected and adapted standard objects on a computer of the power plant.” Appeal Br. 9; *see* MPEP § 2106.05(c); *see also* *Gottschalk v. Benson*, 409 U.S. 63, 71–72 (1972) (holding that a computer based algorithm that merely transforms data from one form to another is not patent-eligible). As such, the claim has no other meaningful limitations (*see* MPEP § 2106.05(e)), and merely recites instructions to execute an abstract idea on generic computer hardware (*see* MPEP § 2106.05(f)).

Moreover, we are not persuaded by Appellant’s argument that claim 16 does not “preempt all possible solutions for controlling a power plant.” Appeal Br. 5. “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). “[Q]uestions on preemption are inherent in and resolved by the § 101 analysis,” which has been applied here. *Id.*

We, therefore, determine claim 16 is not directed to a specific asserted improvement in computer-related technology or otherwise integrated into a practical application and thus is ***directed to*** a judicial exception.

VII. Step 2B in the Guidance (Alice/Mayo, Step 2) (Inventive Concept)

Next, we determine whether the claim includes additional elements that provide significantly more than the recited judicial exception, thereby providing an inventive concept. *Alice*, 573 U.S. at 221 (quoting *Mayo*, 566 U.S. at 72–73). To determine whether the claim provides an inventive concept, the additional elements are considered—individually and in combination—to determine whether they (1) add a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field or (2) simply append well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. Guidance, 84 Fed. Reg. 56.

The Examiner identifies the claimed database, and computer “implementing and controlling the system” as additional elements. Non-Final Act. 6. Specifically, the Examiner finds:

The computer components are recited at a high level of generality and recited as performing generic computer functions routinely used in computer applications. The database, specification, and selecting/adapting elements are well-known in the art. Thus, implementing and controlling the system is considered well-understood, routine and conventional activity. Generic computer components recited as performing generic computer functions that are well-understood, routine and conventional activities amount to no more than implementing the abstract idea with a computerized system. Thus, taken alone, the additional elements do not amount to significantly more than the above-identified judicial exception (the abstract idea). Thus, implementing and controlling the system is considered well-understood, routine and conventional activity.

Id.

Appellant argues “the claims recite novel and non-obvious steps/functions which clearly constitute(s) significantly more than the alleged abstract idea, which is provided below with respect to the rejections under 35 U.S.C. § 103 and thus cannot be construed as ‘well-understood, routine and conventional activity previously known in the industry.’”

Appeal Br. 6.

We are unpersuaded. Although the second step in the *Alice/Mayo* analysis includes a search for an inventive concept, the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for “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.’” *Alice*, 573 U.S. at 217–18 (quoting *Mayo*, 566 U.S. at 72). A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 89 (rejecting the suggestion that Sections 102, 103, and 112 might perform the appropriate screening function and noting that in *Mayo* such an approach “would make

the ‘law of nature’ exception . . . a dead letter”). Further, “under the *Mayo/Alice* framework, a claim directed to a newly discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the novelty of that discovery for the inventive concept necessary for patent eligibility.” *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016).

Considering the additional elements individually, we agree with the Examiner that the elements simply append well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. Non-Final Act. 6; Guidance, 84 Fed. Reg. 56.

“*computer*”

Claim 16’s method uses a computer for storing and manipulating data and implementing the abstract idea. According to Appellant’s Specification, the claimed computer/generator may be a general-purpose computer. Spec. ¶ 95; Fig. 1. Thus, the claim essentially uses a general-purpose processor to execute the abstract idea. We, therefore, agree with the Examiner’s finding that claim 16’s “implementing and controlling the system” with a computer “amount[s] to no more than implementing the abstract idea with a computerized system.” Non-Final Act. 6. For these reasons, the recited computer adds nothing more than well-understood, routine, conventional activities, specified at a high level of generality, to the abstract mental process. *See* MPEP § 2106.05(d)(II)(ii).

“*a database*”

The Federal Circuit has recognized that a generic database may not satisfy the inventive-concept requirement. *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324–25 (Fed. Cir. 2016). Also,

the MPEP instructs examiners that courts recognize that storing and retrieving information in memory may be well-understood, routine, and conventional when claimed generically. MPEP § 2106.05(d)(II)(iv) (citing *Versata*, 793 F.3d at 1334; *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015)).

In claim 16, the recited database stores various data structures that include “function plans, operator displays and descriptions for designing power plants.” Appeal Br. 9. The stored data structures are not defined with particularity, nor does claim 16 use any specific technical features of database technology in an unconventional way. In this regard, the claim uses the database generically for data storage and retrieval. Thus, we agree with the Examiner that the recited database is well-understood, routine, and conventional. Non-Final Act. 5; *See* MPEP § 2106.05(d)(II)(iv); *see also* Spec. ¶ 29.

Next, considering the additional elements in combination, Appellant fails to provide specific arguments indicating which limitations, in combination, amount to more than the abstract idea. Analyzing the additional elements as an ordered combination, we agree with the Examiner that “[l]ooking at the limitations as an ordered combination adds nothing that is not already present when looking at the elements taken individually.” Non-Final Act. 6.

We, therefore, conclude that claim 16 does not provide an inventive concept because the additional elements recited in claim 16 do not provide significantly more than the recited judicial exception. For the reasons discussed, claim 16 does not recite patent-eligible subject matter. Because claim 16 is argued as representative of the other claims, we also conclude

that claims 17–24, do not recite patent-eligible subject matter and we sustain the rejection of claims 16–24 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

Rejection under 35 U.S.C. § 103(a)

In rejecting claim 16 as obvious over Lu, Parikh, and Clark, the Examiner finds the combination of Parikh and Clark teaches “adapting selected standard objects . . . the adapting []comprising actuating switches in the function plan depending on the presence of the complete gate valve of the power plant[],” as recited in claim 16. Non-Final Act. 8–10 (citing Parikh ¶¶ 42–47, Figs 1, 2, Clark 6–8, 22) (emphasis omitted).

Appellant argues: (1) “Lu . . . may describe valves such as main steam valves and intermediate steam valves, but does not disclose that selected standard objects are adapted such that switches are actuated depending on a presence of a complete gate valve of the power plant”; (2) “Parikh relates to a visual programming system and . . . may disclose valves in general in connection with actuator/control devices, but does also not disclose that selected standard objects are adapted such that switches are actuated depending on a presence of a complete gate valve of the power plant”; and (3) “While Clark may disclose actuation of certain switches, Clark does not disclose that switches of a function plan are actuated depending on a presence of a specific element as claimed.” Appeal Br. 6–7 (emphasis omitted).

The Examiner responds:

Examiner respectfully disagrees. Parikh discloses a visual programming system using a GUI for selecting components and linking the components to form logic strings to define a control flow sequence (Abstract). The adapting of the standard objects is

found in the control flow sequence process of Parikh where the logic strings are examined to map the data associated with each component to source code and generating the source code for compiling (see ¶¶0042-¶¶0043). Clark discloses major components of a nuclear power plant including valves that may operate in manual mode or control switch actuation (see pg. 6). Clark in combination with Lu and Parikh provide for additional components that would be used in a control flow system such as actuating switches. Therefore, Lu, Parikh and Clark do teach and suggest these limitations.

Ans. 5–6.

We find Appellant’s arguments persuasive. The Examiner does not establish that Parikh’s discussion of using a visual programming system to define a control flow sequence in components and Clark’s discussion of actuating switches of gate valves, alone or in combination, teach “actuating switches in the function plan *depending on the presence of the complete gate valve of the power plant*,” as recited in claim 16. Appeal Br. 9 (emphasis added). Because we agree with at least one of the dispositive arguments advanced by Appellant for claim 16, we need not reach the merits of Appellant’s other arguments.

Accordingly, based on the record before us, we do not sustain the Examiner’s 35 U.S.C. § 103(a) rejection of independent claim 16, and, for the same reasons, the rejection of dependent claims 17–20, which depend from claim 1. Independent claim 21 includes a substantially similar limitation. Appeal Br. 11. We, therefore, do not sustain the Examiner’s 35 U.S.C. § 103(a) rejection of independent claim 21, and, for the same reasons, the rejection of dependent claims 22–24, which depend from claim 21.

CONCLUSION

We affirm the Examiner's patent eligibility rejections of claims 16–24, under 35 U.S.C. § 101.

We reverse the Examiner's rejection of claims 16–24 under 35 U.S.C. § 103(a) as obvious over Lu, Parikh, and Clark.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	References/Basis	Affirmed	Reversed
16–24	101	Eligibility	16–24	
16–24	103(a)	Lu, Parikh, Clark		16–24
Overall Outcome			16–24	

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