



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|--------------------------|----------------------|------------------|
| 13/614,705 | 09/13/2012 | Nathan Pieter Den Herder | 880417-0123-US00 | 5602 |
| 134795 | 7590 | 10/02/2020 | EXAMINER | |
| MICHAEL BEST & FRIEDRICH LLP (DC) 790 N WATER ST SUITE 2500 MILWAUKEE, WI 53202 | | | RUHL, DENNIS WILLIAM | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3687 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 10/02/2020 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCipdocket@michaelbest.com
nbenjamin@michaelbest.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NATHAN PIETER DEN HERDER, JOHN BREVARD SIGMAN,
NATHAN LANDE, and ERIC ROSENBLATT

Appeal 2019-002838
Application 13/614,705
Technology Center 3600

Before BRUCE T. WIEDER, TARAL HUTCHINGS, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

HUTCHINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 51–70. An oral hearing in this appeal was held on May 11, 2020. We have jurisdiction under 35 U.S.C. § 6(b).

¹ We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Our decision references Appellant's Appeal Brief (“Appeal Br.,” filed Sept. 5, 2018) and Reply Brief (“Reply Br.,” filed Feb. 27, 2019); the Examiner's Answer (“Ans.,” mailed Dec. 27, 2018) and Final Office Action (“Final Act.,” mailed Apr. 4, 2018), and the Oral Hearing Transcript (“Tr.,” mailed May 26, 2020). Appellant identifies Fannie Mae as the real party in interest. Appeal Br. 3.

We AFFIRM, designating the affirmance as a NEW GROUND OF REJECTION, pursuant to 37 C.F.R. § 41.50(b).

CLAIMED INVENTION

The claimed invention “relates generally to a photograph initiated appraisal process and application for evaluating a subject property.”

Spec. ¶ 1.

Claim 51, reproduced below with bracketed notations added, is the sole independent claim on appeal, and is representative of the claimed subject matter:

51. A method for producing a photograph initiated property assessment, the method comprising:

[(a)] after an electronic device acquires property data for the subject property, the electronic device determines whether or not the property data includes property location information, wherein the property location information identifies an address of the subject property; and

[(b)] when the electronic device determines that the property data does not include the property location information, the electronic device detects a physical location of the electronic device, wherein the electronic device is configured to use location technology to detect the physical location of the electronic device.

REJECTIONS

Claims 51–71 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

Claims 51–71 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 55, 59, and 70 are rejected under 35 U.S.C. § 112, second paragraph as indefinite.²

Claims 51, 53–55, 57–70 are rejected under 35 U.S.C. § 103(a) as unpatentable over Almeida (US 2006/0155571 A1, pub. July 13, 2006) and Graboske (US 2011/0258127 A1, pub. Oct. 20, 2011).

Claim 52 is rejected under 35 U.S.C. § 103(a) over Almeida, Graboske, and Lalik (US 2005/0253752 A1, pub. Nov. 17, 2005).

ANALYSIS

Patent-Ineligible Subject Matter

Appellant argues the pending claims as a group. Appeal Br. 6. We select independent claim 51 as representative. The remaining claims stand or fall with claim 51. *See* 37 C.F.R. §41.37(c)(1)(iv).

Under 35 U.S.C. § 101, an invention is patent eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp.*, 573 U.S. at 217.

² The Examiner withdrew the rejection of claim 54 under 35 U.S.C. § 112, second paragraph in the Answer. Ans. 3.

The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78). This is “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.* at 217–18 (alteration in original).

In rejecting the pending claims under 35 U.S.C. § 101, the Examiner determined that the claims are directed to

producing a photographic initiated property assessment by receiving and analyzing property data to determine a location for a property, so the property type can be discerned and used to generate the assessment for the property, where the assessment is used to guide a person through the process of taking photos for a subject property by receiving information and correlating it to stored information.

Final Act. 4. The Examiner found that this concept is a mental process that can be performed in the human mind, or by a human using pen and paper.

Id. The Examiner additionally found that the claims are analogous to several cases involving collecting and analyzing information that the court has held to be patent ineligible. *Id.* at 5–7 (collecting cases). The Examiner also determined that the claims do not include additional elements, considered

individually and as an ordered combination, sufficient to amount to significantly more than the abstract idea itself. *Id.* at 7– 8.

After Appellant’s Appeal Brief and the Examiner’s Answer mailed, the U.S. Patent and Trademark Office (the “USPTO”) published revised guidance for use by USPTO personnel in evaluating subject matter eligibility under 35 U.S.C. § 101. 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50, 57 (Jan. 7, 2019) (the “Revised Guidance”). That guidance revised the USPTO’s examination procedure with respect to the first step of the *Mayo/Alice* framework by (1) “[p]roviding groupings of subject matter that [are] considered an abstract idea”; and (2) clarifying that a claim is not “directed to” a judicial exception if the judicial exception is integrated into a practical application of that exception. *Id.* at 50. The Revised Guidance, by its terms, applies to all applications, and to all patents resulting from applications, filed before, on, or after January 7, 2019. *Id.*^{3,4}

³ The 2019 Revised Guidance supersedes MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) § 2106.04(II) and also supersedes all versions of the USPTO’s “Eligibility Quick Reference Sheet Identifying Abstract Ideas.” *See* Revised Guidance, 84 Fed. Reg. at 51 (“Eligibility-related guidance issued prior to the Ninth Edition, R-08.2017, of the MPEP (published Jan. 2018) should not be relied upon.”). Accordingly, Appellant’s arguments challenging the sufficiency of the Examiner’s rejection will not be addressed to the extent those arguments are based on now superseded USPTO guidance.

⁴ The USPTO issued an update on October 17, 2019 (the “October 2019 Update: Subject Matter Eligibility,” available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf) (hereinafter “October 2019 Update”) clarifying the Revised Guidance in response to comments received from the public.

Step One of the Mayo/Alice Framework (Revised Guidance, Step 2A)

The first step in the *Mayo/Alice* framework, as mentioned above, is to determine whether the claims at issue are “directed to” a patent-ineligible concept, e.g., an abstract idea. *Alice Corp.*, 573 U.S. at 217. This first step, as set forth in the Revised Guidance (i.e., Step 2A), is a two-prong test; in Step 2A, Prong One, we look to whether the claim recites a judicial exception, e.g., one of the following three groupings of abstract ideas: (1) mathematical concepts; (2) certain methods of organizing human activity, e.g., fundamental economic principles or practices, commercial or legal interactions; and (3) mental processes. Revised Guidance, 84 Fed. Reg. at 54. If so, we next consider whether the claim includes additional elements, beyond the judicial exception, that “integrate the [judicial] exception into a practical application,” i.e., that 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 judicial exception (“Step 2A, Prong Two”). *Id.* at 54–55. Only if the claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application do we conclude that the claim is “directed to” the judicial exception, e.g., an abstract idea. *Id.*

We are not persuaded here that the Examiner erred in determining that claim 51 is directed to an abstract idea. *See* Appeal Br. 6–7. The Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir.

2015)). It asks whether the focus of the claims is on a specific improvement in relevant technology or on a process that itself qualifies as an “abstract idea” for which computers are invoked merely as a tool. *See id.* at 1335–36. Here, it is clear from the Specification (including the claim language) that claim 51 focuses on an abstract idea, and not on any improvement to technology and/or a technical field.

The Specification is titled “PHOTOGRAPH INITIATED APPRAISAL PROCESS AND APPLICATION,” and describes, in the Background section, that a conventional property valuation and data gathering method is “a home inspection in which a home inspector performs a review of a subject property by surveying the rooms and fixtures of the subject property and estimating the subject property’s value based upon the review.” Spec. ¶ 2. Typically, the home inspector records written notes of the review. *Id.* However, the notes are not especially useful when data is incomplete, inaccurate, and/or subjective. *Id.* For example, an inspector may mistakenly record that a kitchen has an unfinished wood floor when it has a stone tile floor. *Id.* “If a picture of the kitchen was associated with an appraisal report, an evaluator of the appraisal could easily see the entry mistake without physically visiting the property.” *Id.* However, “there is no such procedure for associating pictures with a home evaluation.” *Id.* Appellant, thus, describes that “there is a need for a sophisticated[,] regimented procedure of implementing a home inspection in accordance with photographs that may be evaluated at a later time without the evaluator’s physical presence at a subject property.” *Id.*

The claimed invention is intended to address this shortcoming. Claim 51 recites a method for producing a photograph initiated property

assessment of a subject property comprising two steps: (1) “after an electronic device acquires property data for the subject property, the electronic device determines whether or not the property data includes property location information, wherein the property location information identifies an address of the subject property” (step (a)); and (2) “when the electronic device determines that the property data does not include the property location information, the electronic device detects a physical location of the electronic device, wherein the electronic device is configured to use location technology to detect the physical location of the electronic device” (step (b)).

These limitations, when given their broadest interpretation, recite a method for producing a property assessment of a subject property. The concept of producing a property assessment, as set forth above by limitations (a) and (b) of claim 51, pertains to sales activities or behaviors (i.e., a commercial interaction), which is a certain method of organizing human activity and, therefore, an abstract idea. *See Revised Guidance*, 84 Fed. Reg. at 52.

Having concluded that claim 1 recites a judicial exception, i.e., an abstract idea (Step 2A, Prong One), we next consider whether the claim recites additional elements that integrate the judicial exception into a practical application (Step 2A, Prong Two).

Beyond the abstract idea, claim 51 recites an “electronic device” for performing steps (a) and (b), and the electronic device is “configured to use location technology to detect the physical location of the electronic device.” Appellant argues that claim 51 sets forth a specific structure. Appeal Br. 6. However, Appellant’s argument is not persuasive, at least because

Appellant's Specification makes clear that the claimed invention is implemented using a generic computer components performing generic computer functions. *See, e.g.*, Spec. ¶¶ 12 (describing that the claimed invention “provides an application for a tablet, a smartphone, a laptop, or a similar device that utilizes imaging technology and numerous data sources to provide an assessment of a subject property”), 20–23 (providing “[a]ny computer system . . . may be used”), 23, 34 (“location control module 207 determines the physical location using any location determination technology”). For example, the Specification describes that any computer system can implemented the claimed invention. *See id.* ¶ 20. The Specification also describes the use of location determination technology at a high level of generality. For example, the Specification provides that location determination technology includes

time of flight (measuring distance by the time of propagation of pulsed signals, e.g. global positioning systems), spatial scan (triangulating using a beacon and sensor), inertial sensing (measuring position with an accelerometer), phase difference (measuring the shift in phase for incoming signals), or a hybrid thereof. Some of these technologies may be referred to as network-based, handset-based, or SIM-based technologies. Regardless of the colloquial term, any of the numerous location determination technologies that would be readily apparent to an artisan may be employed by the location control module 207.

Id. ¶ 34.

We find no indication in the Specification that the operations recited in claim 51 require any specialized computer hardware or other inventive computer components, i.e., a particular machine, invoke any allegedly

inventive programming, or that the claimed invention is implemented using other than generic computer components to perform generic computer functions. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”).

We also find no indication in the Specification that the claimed invention effects a transformation or reduction of a particular article to a different state or thing. Nor do we find anything of record, short of attorney argument, that attributes an improvement in technology and/or a technical field to the claimed invention or that otherwise indicates that the claimed invention integrates the abstract idea into a “practical application,” as that phrase is used in the Revised Guidance.⁵

Appellant argues that claim 51, like the claims at issue in *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016), is “directed to an improvement in how an object is analyzed.” Appeal Br. 8–10 (citing Spec. ¶¶ 34, 45). Appellant further contends that claim 51 provides “an unconventional technological solution (detecting a physical location of the electronic device when the electronic device determines that the property data does not include the property location information) to a

⁵ The Revised Guidance references MPEP § 2106.05(a)–(c) and (e) in describing the considerations that are indicative that an additional element or combination of elements integrates the judicial exception, e.g., the abstract idea, into a practical application. Revised Guidance, 84 Fed. Reg. at 55. If the recited judicial exception is integrated into a practical application, as determined under one or more of these MPEP sections, the claim is not “directed to” the judicial exception.

technological problem.” Appeal Br. 12 (citing *Amdocs*, 841 F.3d at 1300). Appellant’s reliance on *Amdocs* is misplaced.

There, the Federal Circuit held that the claim at issue was patent eligible because the claim entailed an unconventional technological solution (enhancing data in a distributed fashion) to a technological problem (massive record flows which previously required massive databases). *Amdocs*, 841 F.3d at 1300. Although the solution required generic components, the court determined that “the claim’s enhancing limitation necessarily requires that these generic components operate in an unconventional manner to achieve an improvement in computer functionality” and that the “enhancing limitation depends not only upon the invention’s distributed architecture, but also depends upon the network devices and gatherers -- even though these may be generic -- working together in a distributed manner.” *Amdocs*, 841 F.3d at 1300–01.

Here, contrary to Appellant’s assertions, Appellant’s Specification does not describe the solution as necessarily rooted in technology or the problem as a technological problem. *See, e.g.*, Spec. ¶¶ 34, 45. For example, Appellant does not identify any “distributed architecture” comparable to that in *Amdocs*. There also is no persuasive evidence of record that the generic components recited in claim 51 operate in an unconventional manner, as in *Amdocs*, to achieve an improvement in computer functionality. Instead, Appellant’s claimed invention seeks to improve a process that is itself an abstract idea by applying it to a particular technological environment involving known computer components and technology. *See, e.g.*, Spec. ¶ 3 (describing “a need for a . . . procedure of implementing a home inspection in accordance with photographs that may

be evaluated at a later time without the evaluator’s physical presence at a subject property.”

Appellant asserts that claim 51 is similar to the claims at issue in *SiRF Technology Inc. v. International Trade Commission*, 601 F.3d 1319, 1332–33 (Fed. Cir. 2010), because “an electronic device . . . is configured to use location technology to detect the physical location of the electronic device” and this feature is “integral” to the claim and places a meaningful limit on [its] scope.” Appeal Br. 12 (emphasis omitted).

In *SiRF* the Federal Circuit found that the claims were “directed to various improvements over conventional A-GPS technology.” *SiRF Tech.*, 601 F.3d at 1323. Stated another way, the claims were not directed to abstract-idea processes, but rather to an improvement over conventional GPS technology itself. *See id.* (finding the ’801 patent “allow[s the GPS] receiver to calculate its position more quickly and even in weak-signal environments,” and the ’187 patent “extends the solution of the ’801 patent . . . [to] allow[] the improved, repeated calculation of a GPS receiver’s position as it changes over time”).

Appellant’s claimed invention uses location technology. However, there is no indication that claim 51 improves location determination technology or any other relevant technology. Nor is there any indication that claim 51 solves a problem rooted in technology. Instead, claim 51 is directed to an improvement in producing a property assessment. Improving a process for producing a property assessment may well provide a solution to a real estate problem, i.e., providing photographs with a property assessment that may be evaluated at a later time without the evaluator’s presence at a subject property.

We conclude, for the reasons outlined above, that claim 51 recites a method of organizing human activity, i.e., an abstract idea, and that the additional elements recited in the claim are no more than generic computer components used as tools to perform the recited abstract idea. As such, they do not integrate the abstract idea into a practical application. *See Alice Corp.*, 573 U.S. at 223–24 (“[W]holly generic computer implementation is not generally the sort of ‘additional featur[e]’ that provides any ‘practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.’” (quoting *Mayo*, 566 U.S. at 77)). Accordingly, we agree with the Examiner that claim 51 is directed to an abstract idea.

Step Two of the Mayo/Alice Framework (Revised Guidance, Step 2B)

Having determined under step one of the *Mayo/Alice* framework that claim 51 is directed to an abstract idea, we next consider under Step 2B of the Revised Guidance, the second step of the *Mayo/Alice* framework, whether claim 51 includes additional elements or a combination of elements that provide an “inventive concept,” i.e., whether the additional elements amount to “significantly more” than the judicial exception itself. Revised Guidance, 84 Fed. Reg. at 56. As stated in the Revised Guidance, many of the considerations to determine whether the claims amount to “significantly more” under step two of the *Alice* framework have been considered as part of determining whether the judicial exception has been integrated into a practical application. *Id.* Thus, at this point of our analysis, we determine if the claims add a specific limitation, or combination of limitations, that is not well-understood, routine, conventional activity in the field, or simply

appends well-understood, routine, conventional activities at a high level of generality. *Id.*

On the record before us, claim 51 fails to recite specific limitations (or a combination of limitations) that are not well-understood, routine, and conventional. Rather, the only additional elements (i.e., an electronic device, and using “location technology” to detect a location of the electronic device) are generic computer components and actions recited at a high level of generality, none of which Appellant persuasively argues is beyond what was well-understood, routine, and conventional in the art.

To the extent Appellant maintains that claim 51 is patent eligible because the claim is novel and/or non-obvious, Appellant misapprehends the controlling precedent. *See* Appeal Br. 12 (asserting that the claimed invention provides an “unconventional” technological solution). Neither a finding of novelty nor a non-obviousness determination automatically leads to the conclusion that the claimed subject matter is patent eligible. A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent ineligible. *See Mayo*, 566 U.S. at 90.

We are not persuaded, on the present record, that the Examiner erred in rejecting independent claim 51 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection of claim 51, and claims 52–70, which fall with claim 51. Because our rationale differs from the Examiner’s, we designate our affirmance as a new ground of rejection.

Written Description

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact and is assessed on a case-by-case basis. *See, e.g., Purdue Pharma L.P. v. Faulding*

Inc., 230 F.3d 1320, 1323 (Fed. Cir. 2000) (citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991)). The disclosure, as originally filed, need not literally describe the claimed subject matter (i.e., using the same terms or *in haec verba*) in order to satisfy the written description requirement. But, the specification must convey with reasonable clarity to those skilled in the art that, as of the filing date, the inventors were in possession of the claimed invention. *See id.*

Independent Claim 51, and Dependent Claims 52–70

In rejecting claims 51–70 as failing to comply with the written description requirement, the Examiner notes that

[c]laim 51 recites that an electronic device acquires property data. According to the specification this is the act of a user entering either the property address or property type. In paragraphs 044 and 045 the operation of the method is disclosed. It is disclosed that when a user is making a request for a photographic assessment itinerary, property information such as property location or property types is received or determined. Disclosed is that the request for the assessment itinerary may include the user entering the property type, in which case the system then generates the assessment itinerary for that given property type. However, a user may also enter the property address and the specification discloses that this is used to determine the property type. A third option is disclosed as occurring in paragraph 045, which is that if the request does not contain the property type of [sic] location, then the system can use location determining technology to determine the location of the device so that the property type can be discerned. The problem with the claim is that the applicant has recited that property data is received, and that this is checked to see if it contains the location. This situation where the user has entered either the property location or the property type does not use or involve the location determination technology that is also recited in claim 51. Applicant recites that when the device determines that the property data (disclosed as being either the property

location or property type), then [sic] the device detects the physical location. This is new matter that is not supported by the original disclosure. When property data has been received from a user, there is no use of any location determining technology because the property data (property type or property location) is used to determine the property type so that the proper assessment itinerary can be generated. Therefore, it is new matter for the applicant to claim the use of the location technology determination when property data is received that is either the property type of [sic] the property location. The specification does not disclose that the location determining technology is being used when the property data has been received. This is the reason that the examiner feels that claim 51 contains new matter.

Final Act. 15–16.

The issue underlying the Examiner’s concerns with the written description turns on the proper construction of the term “property data.” The Examiner interprets the claimed “property data” as “property type or property location” based on the example provided in Figure 4 and its description at paragraphs 44 and 45. However, we agree with Appellant that one of ordinary skill in the art would understand, in view of the Specification, that the term “property data” is not limited to information concerning property type or property location. Instead, property data includes all information used in a property assessment. Tr. 7–8. For example, the Specification describes property data used in a property assessment as including square footage, number of units, year built, appliances, foundation, exterior description, number of bedrooms, type of flooring in each bedroom, view from bedroom windows, number of bathrooms, type of fixtures in each bathrooms, neighborhood, appraisal history, lot size, gross living area, age, location specific effects, property condition, property type, and comparable properties. Spec. ¶¶ 15–16, 36

(providing “property data” (e.g., comparable properties)), 37, 42 (describing the amount of property as “rather voluminous”), 45, 47, 48 (describing various categories for describing property data).

The Examiner’s concerns set forth with respect to claim 51, as well as claims 55, 58–60, and 70, resolve themselves once the claim language is properly construed. Therefore, we agree with Appellant that the Specification provides the requisite written description support for each of these claims. *See* Appeal Br. 13–20 (citing Spec. ¶¶ 34, 43, 45, Figs. 2A, 4). For example, the Specification describes that when property data is received that is not a property type (step 402) and not a property location (step 404), the claimed invention uses location determination technology to determine a physical location of the electronic device (step 406). Spec. ¶ 45, Fig. 4.

Regarding claim 56, the Examiner takes the further position that property data being received from the communication network is new matter, because the Specification discloses the property data as being entered by a user, such as a property type or an address. Final Act. 20. However, as described above, the Examiner premises this rejection on property data being limited to property type or address when it is not so limited. We agree with the Appellant that the Specification provides the requisite support for this limitation. Appeal Br. 21 (citing Spec. ¶¶ 23, 40–42, Figs. 2A–3B). For example, the Specification describes with reference to Figures 2A through 3B connecting to a communication network with an electronic device. Spec. ¶ 40; *see also id.* ¶ 42 (describing connections to various sources of property data, including financial institution databases, MLS listings, GIS data, tax assessors, and appraising services).

Accordingly, we do not sustain the Examiner's rejection of claims 51–70 under 35 U.S.C. § 112, first paragraph.

Indefiniteness

Dependent Claims 55

In rejecting claim 55 under 35 U.S.C. § 112, second paragraph, as indefinite, the Examiner takes the position that the scope of the claim is not clear “because it is confusing to recite that the location detection occurs when no property data is found, but that it also occurs upon user request.” Final Act. 21; *see also id.* at 22. We agree with Appellant that a person of ordinary skill in the art would understand what is claimed, when the claim language is read in light of the Specification, namely, that claim 55 specifies that the user can requests the step of detecting and in claim 51 the detecting could be automatically or by user request. Appeal Br. 16; Reply Br. 15–16.

Dependent Claims 59

In rejecting claim 59 under 35 U.S.C. § 112, second paragraph, as indefinite, the Examiner also takes the position that the scope of this claim is not clear “because it is confusing to recite that the location detection occurs when no property data is found, but that it also occurs upon user request.” Final Act. 21; *see also id.* at 22; Ans. 18–19. This confusion stems from the incorrect construction of “property data,” described above. When “property data” is construed properly, we agree with Appellant that a person of ordinary skill in the art would understand what is claimed, when the claim language is read in light of the Specification. Appeal Br. 16; Reply Br. 15–16.

Dependent Claim 70

In rejecting claim 70 under 35 U.S.C. § 112, second paragraph, as indefinite, the Examiner takes the position that claim 70 is “an improper dependent claim” because it changes statutory class from a method to a computer. Final Act. 22. However, we agree with Appellant that a person of ordinary skill in the art would understand that claim 70 recites a non-transitory computer readable medium storing computer code that, when executed, performs the method of claim 1. Appeal Br. 29.

Therefore, we do not sustain the Examiner’s rejection of claims 55, 59, and 70 under 35 U.S.C. § 112, second paragraph, on this basis. *See Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.”).

Obviousness

Independent Claim 51 and Dependent claims 53–55 and 57–70

We are persuaded by Appellant’s argument that the Examiner erred in rejecting claim 51 under 35 U.S.C. § 103(a), because Graboske does not teach checking if property data includes location information and detecting a physical location of the electronic device “when the electronic device determines that the property data does not include the property location information,” as recited in claim 51. Appeal Br. 34–35. The Examiner relies on paragraph 5, 10, 25, 26, and 31 of Graboske for disclosing the argued limitations. Final Act. 24.

Graboske discloses using a computing device with a built in Global Positioning Feature (GPS). Graboske ¶ 25. The GPS feature allows for automatic population of a form based on the device location. *Id.* In particular, the computing device uses the location of the device to query a public records database for records associated with the property. *Id.* Graboske's method includes an appraiser receiving an electronic appraisal form on computing device 16 (step 510). *Id.* ¶ 31, Fig. 2. Then, the GPS locates the geographic position of computing device 16. *Id.* Next, the appraisal system uses the geographic position to locate data for a corresponding property stored in real estate database 12, and the data is used to populate data fields on the electronic appraisal form. *Id.* ¶ 32.

Because Graboske first obtains GPS location data and then retrieves property information, we agree with Appellant that Graboske fails to teach or suggest determining whether the property data includes property location *after* an electronic device acquires property data for the subject property.

In view of the foregoing, we do not sustain the Examiner's rejection of independent claims 51 and dependent claims 53–55 and 57–70 under 35 U.S.C. § 103(a).

Dependent Claim 52

The additional art cited in the rejection of dependent claim 52 does not cure the deficiencies in the rejection of independent claim 51. Therefore, we also do not sustain the Examiner's rejection of dependent claim 52 under 35 U.S.C. § 103(a) for the same reasons set forth above with respect to claim 51.

CONCLUSION

In summary:

| Claims Rejected | 35 U.S.C. § | References/Basis | Affirmed | Reversed | New Ground |
|------------------------|-----------------------|--------------------------|----------|------------------|------------|
| 51-70 | 101 | Eligibility | 51-70 | | 51-70 |
| 51-70 | 112, first paragraph | Written Description | | 51-70 | |
| 55, 59, 70 | 112, second paragraph | Indefiniteness | | 55, 59, 70 | |
| 51, 53-55, 57-70 | 103(a) | Almeida, Graboske | | 51, 53-55, 57-70 | |
| 52 | 103(a) | Almeida, Graboske, Lalik | | 52 | |
| Overall Outcome | | | 51-70 | | 51-70 |

37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points

Appeal 2019-002838
Application 13/614,705

believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in MPEP § 1214.01.

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; NEW GROUND 37 C.F.R. § 41.50(b)