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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/448,974	07/31/2014	ELBERT HARRIS	155711-4.4	7907
97242	7590	06/02/2020	EXAMINER	
Kutak Rock LLP 2300 Main Street, Suite 800 Kansas City, MO 64108			APPLE, KIRSTEN SACHWITZ	
			ART UNIT	PAPER NUMBER
			3697	
			NOTIFICATION DATE	DELIVERY MODE
			06/02/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ELBERT HARRIS

Appeal 2019-004452
Application 14/448,974
Technology Center 3600

Before RICHARD M. LEBOVITZ, RYAN H. FLAX, and
CYNTHIA M. HARDMAN, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

The Examiner rejected the claims under the judicially-created doctrine of obviousness-type double patenting, under 35 U.S.C. § 103 as obvious, and under 35 U.S.C. § 101 as lacking patent-eligibility. Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject the claims. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM and set forth a NEW GROUND OF REJECTION.

¹ We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Elbert Harris Living Trust. Appeal Br. 2.

STATEMENT OF THE CASE

The claims stand rejected by the Examiner as follows:

Claims 1–10 under the judicially-created doctrine of obviousness-type double patenting over US 7,062,514 B2 (“the ’514 patent”). Final Act. 2. As indicated by the Appellant, all the claims in US 7,062,514 were canceled in an *inter partes* reexamination. Certificate issued Mar. 7, 2013 in US 7,062,514 C1 (stating that “Claims 1–23 are cancelled” as a result of reexamination).

Claims 1–10 under 35 U.S.C. § 103(a) as obvious in view of Thompson (US 6,393,410 B1, issued May 21, 2002), Cornelius (US Patent Pub. 2003/0101127 A1, published May 29, 2003), and Lawrence (US Patent Pub. 2004/0083165 A1, published Apr. 29, 2004). Final Act. 7.

Claims 1–10 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1, which is the only independent claim under review, is reproduced below (bracketed numbering has been added for reference to the specific limitations in the claim):

1. A method of planning a construction project including the steps of:
 - [1] storing material specification information on a component of a computer network, said component of said computer network being controlled by a subscription service provider;
 - [2] storing user information on said component of said computer network, said user information including user credentials;
 - [3] receiving design parameters for a construction project;
 - [4] providing a list of materials capable of meeting said design parameters for said construction project from said computer network; and

[5] providing a list of users with credentials necessary to complete said construction project.

OBVIOUSNESS-TYPE DOUBLE-PATENTING REJECTION

The Examiner rejected the pending claims under the judicially-created doctrine of obviousness-type double patenting as obvious over the claims of the '514 patent. Final Act. 2. The 14/448,974 application (“the '974 application”) in this appeal claims, through a chain of application, priority to the same application on which the '514 patent is based.

The '514 patent was filed as application 10/694,590 on October 24, 2003, claiming priority to Provisional Application 60/469,678, filed April 28, 2003. It issued as a patent on June 13, 2006. An *inter partes* reexamination certificate was issued March 7, 2013 in which claim 1–23, all the claims of the '514 patent, were cancelled. *Inter partes* Reexamination 95/001,478. The claims were canceled before their statutory expiration date.

Appellant argues that the obviousness-type double patenting rejection is improper because all the claims of the '514 patent were cancelled in the *inter partes* reexamination. Appeal Br. 5. The Examiner acknowledged that claims in the patent had been cancelled, but maintained the rejection. Ans. 3.

This issue is one not seen very often. However, we found that related issues had been decided in *In re Fischel*, 136 F.2d 254 (CCPA 1943) and *Ex Parte Personalized Media Communications, LLC*, 2009 WL 1689317 (Bd. Pat. App. & Interf. 2009). Based on these cases, as explained in more detail below, we conclude that the Examiner properly maintained the obviousness-type double-patenting rejection over the canceled claims of the '514 patent.

We begin the discussion with *In re Fischel*, where an applicant appealed a decision of the Board affirming a double-patenting rejection of

pending claims over cancelled claims in a reissued patent. *Fischel*, 136 F.2d at 255. The patent originally had claims 7 and 8, which were identical to pending claims 27 and 28 in the application. An application for reissue of the patent was filed in which claims 7 and 8 were omitted because these claims were said by the appellant to be invalid. *Id.* The claims in the application were rejected on the ground of double-patenting over the claims in the patent, which were found to be “generic” to the rejected claims. *Id.* The examiner had found that it would be extending the ““monopoly beyond the statutory period provided by the law”” to grant claims in the application of similar scope to claims 7 and 8 in the patent. *Id.* at 255–256. The appellant argued that the rejection should be reversed because “claims 7 and 8 of the . . . patent were void ab initio and were surrendered and therefore not in a patent at the time of rejection of the instant claims.” *Id.* at 258. The appellant also argued it was a mistake to have inserted claims 7 and 8 into the patent. *Id.*

The CCPA held that the appellant is bound by the assignee’s election to claim the invention broadly in the patent. *Fischel*, 136 F.2d at 258. The court further held “that to allow the instant claims would be to extend the monopoly which the assignee has enjoyed in the subject-matter embraced in said claims 7 and 8 in the *Fischel* and *Thiry* patent, regardless of the said admitted invalidity.” *Id.* The court concluded that “appellants’ assignee enjoyed, for about fifteen months, a prima facie monopoly of the subject-matter involved in said broad claims 7 and 8, and that to allow the instant claims would be an extension of monopoly.” *Id.* at 259. Consequently, the double-patenting rejection was affirmed.

In the second relevant case, *Ex Parte Personalized Media Communications, LLC*, the Board had affirmed an obviousness-type double-patenting rejection over two expired patents. Appellant argued, in a Request for Rehearing, that the Board had failed to consider that certain claims had been canceled in reexamination of the two patents and thus the claims were “void ab initio.” *Id.* The Board stated that the claims had issued and received 17 years of protection. *Id.* In reaching the conclusion that the double-patenting rejection was proper, the Board reasoned “[i]f the obviousness-type double patenting rejection could be overcome by canceling the earlier patent claims, the term of protection would be unjustifiably extended. Thus, canceling the claims of the earlier patents [in a reexamination] does not overcome the double patenting rejection.” *Id.*

In this appeal, the claims of the '514 patent were canceled in a reexamination prior to the expiration of the patent. The patent in *Fischel* had also not expired prior to the cancellation of the claims, and therefore the claims had not enjoyed their full statutory term. *Fischel*, 136 F.2d at 258. Yet, the court affirmed the double patenting rejection in the application over the canceled patent claims. *Id.* Canceling claims in an earlier filed patent cannot overcome a double-patenting rejection in a later filed patent application because the claims already enjoyed patent term, and granting claims to obvious variants in a later patent application is inconsistent with cancellation of the claims in the earlier patent. *See supra Fischel; Personalized Media Commc'ns.* To grant the claims in the '974 application ignores the benefit already received by the patent owner for the '514 patent for similar claims. The '514 claims were canceled in a reexamination proceeding and therefore Appellant should not receive an additional,

unjustified extension of the right to exclude based on claims that are not patentably distinct from claims in the '514 patent.

Appellant attempted to file a terminal disclaimer to overcome the obviousness type double-patenting rejection. The terminal disclaimer was not entered by the U.S.P.T.O. for procedural reasons because it was found that the terminal disclaimer was not signed by an authorized party. Terminal disclaimer review (entered May 2, 2017). Even if the disclaimer is properly executed, it is not sufficient to overcome the rejection. According to M.P.E.P. § 804.02 (Ninth Edition, Revision 08.2017, last revised Jan. 2018), “a terminal disclaimer filed after the expiration of the reference patent is not effective to obviate a nonstatutory double patenting rejection. See *Boehringer Ingelheim Int’l v. Barr Laboratories*, 592 F.3d 1340, 93 USPQ2d 1417 (Fed. Cir. 2010).” Similarly, *In re Lonardo*, 119 F.3d 960 (Fed. Cir. 2007), the court stated:

Obviousness-type double patenting . . . is judicially created and prohibits an inventor from obtaining a second patent for claims that are not patentably distinct from the claims of the first patent. . . . With obviousness-type double patenting, however, a terminal disclaimer may overcome that basis for unpatentability, assuming that the first patent has not expired. In this case, the '762 patent, over which the claims have been rejected, has expired, so a terminal disclaimer cannot cure these rejections.

Lonardo, 119 F.3d at 965 (citation omitted).

For the foregoing reason, the obviousness-type double-patenting rejection over the claims in the '514 patent is affirmed. Appellant did not argue the claims separately and therefore all the claims fall together.

37 C.F.R. § 41.37(c)(1)(iv).

OBVIOUSNESS REJECTION

The Examiner found that Thompson describes substantially steps [1]–[5] of claim 1. Final Act. 7. The Examiner stated that it is inherent that there is a “subscription service” as recited in step [1] of the claim 1. *Id.* However, the Examiner additionally cited Cornelius and Lawrence for disclosing computer networks controlled by a subscription service provider. *Id.* The Examiner stated that it would have been obvious to have used subscription services in Thompson’s method. *Id.* at 8. The Examiner also found that all three of the cited publications “relate to same subject area of managing construction projects.” *Id.*

Appellant argues that “nothing in Thompson Figures 2, 9, or 6,” cited by the Examiner, teaches step [5] of claim 1 of “providing a list of users with credentials necessary to complete said construction project.” Appeal Br. 8.

In response, the Examiner directed Appellant to Figure 2, items 140–170, of Thompson which the Examiner stated show “each discipline” which “inherently would have the ‘credentials necessary to complete a construction project.’” Ans. 5. The Examiner cited the disclosure in Thompson of various users: “subcontractor=80, architects=40, engineers=70, general contractors=50, suppliers=30, builders=95 or customers=80” as evidence. *Id.* The Examiner also cited disclosures in Lawrence and Cornelius as disclosing users of their systems. *Id.* at 5–6.

The Examiner did not fully address the limitation recited in step [5] of “providing a list of users with credentials necessary to complete said construction project.” The Examiner only identified the disclosure of “users” in the cited references, but did not establish that any of the three cited

references describe or suggest “providing a list of users” with the “credentials necessary to complete said construction project,” as required by all rejected claims. Consequently, as the Examiner did not meet the burden to establish that all the limitations of claim 1 are described or suggested by the combination of Thompson, Cornelius, and Lawrence,² we are compelled to reverse the obviousness rejection of claims 1–10.

New Ground of Rejection

The Examiner did not identify disclosure in Cornelius where step [5] of claim 1 is taught. However, upon review of Cornelius’s complete disclosure, we identified the following pertinent disclosure: “For example, an end user can enter data related to his state and local licenses and bonding status, his MBEWBE certifications, and his area of work.” Cornelius ¶ 32. Based on the ordinary meaning of “credentials,”³ we consider licenses and certifications to meet the claimed “user credentials.”

² An examiner bears the initial burden of presenting a prima facie case of obviousness and only then does the burden shift to applicant to rebut the case. *In re Huai-Hung Kao*, 639 F.3d 1057, 1066 (Fed. Cir. 2011).

³ The Specification does not provide a definition of “credentials.” We therefore consult a general purpose dictionary for its meaning. The dictionary defines “credentials” as “something that gives a title to credit or confidence” and “testimonials or certified documents showing that a person is entitled to credit or has a right to exercise official power.” <https://www.merriam-webster.com/dictionary/credential> (last accessed Feb. 23, 2020).

Cornelius also teaches displaying a list “of those end users who have expressed an intent to bid on projects.” Cornelius ¶ 26. Cornelius expressly teaches:

This listing of the pool of intended bidders can include information regarding each intended bidder, such as the name, date and time of the intent to bid posting, a work description, contact information, and an active icon or hyperlink leading to more detailed information.

Cornelius ¶ 42.

It would have been obvious to one of ordinary skill in the art to have used a list of bidders as disclosed by Cornelius in Thompson’s system, and to include the credential information for the bidders as described by Cornelius (¶ 32), so the project owners would know the bidder and the bidder’s ability to complete the project based on the bidder’s credentials. Accordingly, claim 1 is rejected as obvious in view of Thompson, Cornelius, and Lawrence. This a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

With respect to claims 2–10, we leave it to the Examiner to determine whether these claims are obvious in view of the cited, or any additional, prior art (e.g., based on the same reasoning that these dependent claims were originally rejected as obvious in view of Thompson, Cornelius, and Lawrence).

§ 101 REJECTION

Principles of Law

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.” However, not every discovery is eligible for patent protection. *Diamond v. Diehr*, 450 U.S. 175, 185 (1981). “Excluded from such patent protection are

laws of nature, natural phenomena, and abstract ideas.” *Id.* The Supreme Court articulated a two-step analysis to determine whether a claim falls within an excluded category of invention. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014); *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 566 U.S. 66, 75–77 (2012).

In the first step, it is determined “whether the claims at issue are directed to one of those patent-ineligible concepts.” *Alice*, 573 U.S. at 217. If it is determined that the claims are directed to an ineligible concept, then the second step of the two-part analysis is applied in which it is asked “[w]hat else is there in the claims before us?” *Id.* The Court explained that this step involves:

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.’

Alice, 573 U.S. at 217–18 (citing from *Mayo*, 566 U.S. at 75–77).

Alice, relying on the analysis in *Mayo* of a claim directed to a law of nature, stated that in the second part of the analysis, “the elements of each claim both individually and ‘as an ordered combination’” must be considered “to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 573 U.S. at 217.

The PTO published revised guidance on the application of 35 U.S.C. § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50, 51–57 (2019) (“Eligibility Guidance”). This guidance provides additional direction on how to implement the two-part analysis of *Mayo* and *Alice*.

Step 2A, Prong One, of the Eligibility Guidance, looks at the specific limitations in the claim to determine whether the claim recites a judicial exception to patent eligibility. In Step 2A, Prong Two, the claims are examined to identify whether there are additional elements in the claims that integrate the exception into a practical application, namely, is there a “meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” 84 Fed. Reg. 54 (2. Prong Two).

If the claim recites a judicial exception that is not integrated into a practical application, then as in the *Mayo/Alice* framework, Step 2B of the Eligibility Guidance instructs us to determine whether there is a claimed inventive concept to ensure that the claims define an invention that is significantly more than the ineligible concept, itself. 84 Fed. Reg. 56. In making this determination, we must consider whether there are specific limitations or elements recited in the claim “that are not well-understood, routine, conventional activity in the field, which is indicative that an inventive concept may be present” or whether the claim “simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception, indicative that an inventive concept may not be present.” 84 Fed. Reg. 56 (footnote omitted).

With these guiding principles in mind, we proceed to determine whether the claimed subject matter in this appeal is eligible for patent protection under 35 U.S.C. § 101.

Discussion

Claim 1 recites a “method of planning a construction project.” Following the first step of the *Alice/Mayo* analysis, we find that the claim is directed to a “process,” and therefore falls into one of the broad statutory categories of patent-eligible subject matter under 35 U.S.C. § 101. We thus proceed to Step 2A, Prong One, of the Eligibility Guidance.

Step 2A, Prong One

In Step 2A, Prong One, per the Eligibility Guidance, the specific limitations in the claim are examined to determine whether the claim recites a judicial exception to patent eligibility, namely whether the claim recites an abstract idea, law of nature, or natural phenomenon.

The Examiner found, *inter alia*, that the claims are directed to “Concepts Related [to] Processes of Organizing Information that can be Performed Mentally.” Final Act. 6. “Mental processes” is one of the three categories of abstract ideas enumerated in the Eligibility Guidance. 84 Fed. Reg. 52. The Examiner stated that mental processes “remain unpatentable even when automated to reduce the burden on the user of what once could have been done with pen and paper.” Ans. 4. The Examiner explained that the claims “could have been performed by a human doing the normal[] business processes of manageing [*sic* managing] a construction project.” Final Act. 4.

The Examiner’s determination is reasonable. The information on materials and users that are stored on the computer network (steps [1] and [2] of claim 1) can just as well be recorded on paper with a pen or, for that matter, merely remembered in the human mind. The design parameters of

step [3] can also be written down. The list of materials and users with credentials (steps [4] and [5]) can also be written down based on the information in steps [1] and [2]. The claim does not recite anything about how these steps are carried out that would exclude them from being performed in the human mind with the aid of pen and paper.⁴ Therefore, the claim was properly characterized by the Examiner as reciting a mental process.

Appellant contends that the Examiner did not meet the burden of establishing that the claims are patent ineligible and did not address the dependent claims. Appeal Br. 6. Appellant makes the same assertions in the Reply Brief, further stating that the analysis lacks clarity. Reply Br. 3.

This argument is not persuasive because the Examiner expressly identified a category of abstract ideas that rendered the claim ineligible, providing Appellant with sufficient notice of the basis of the rejection. Final Act. 4–5; Ans. 4. Further, the Examiner explained that the certain steps of the claim can be performed with the aid of pen and paper and therefore are mental processes. Ans. 4. Accordingly, we conclude that the Examiner met the burden of establishing that claim 1 recites an abstract idea.

Appellant criticizes the Examiner for not addressing each of the dependent claims. Appeal Br. 6. However, Appellant did not identify any limitation in the dependent claims that would move the ineligible abstract

⁴ “The use of a physical aid (i.e., the pen and paper) to help perform a mental step (e.g., a mathematical calculation) does not negate the mental nature of this limitation.” October 2019 Update to Subject Matter Eligibility at 9. Available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf (last accessed May 25, 2020) (“PEG Update”).

idea recited in claim 1 into eligibility territory. Therefore, we do not consider this argument to be a separate argument for patentability.

37 C.F.R. § 41.37(c)(1)(iv) (“[T]he failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.”).

Step 2A, Prong Two

Prong Two of Step 2A per the Eligibility Guidance requires us to ask whether there are additional elements that integrate the exception into a practical application. As discussed in the Eligibility Guidance, “[a] claim that integrates a judicial exception into a practical application will apply, rely on, or use the judicial exception in a manner that places a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” Eligibility Guidance, 84 Fed. Reg. 54. Integration into a practical application is evaluated by identifying whether there are additional elements individually, and in combination, which go beyond the judicial exception. *Id.* at 54–55.

Appellant argues that “the claims recite specific, discrete implementations of such abstract idea. As such, the claims cannot possibly preempt all ways of performing the alleged abstract idea.” Appeal Br. 6.

We do not agree with Appellant that that steps are recited with sufficient specificity to avoid encompassing a mental process. We compare the facts here with those of *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016), because the steps in the *McRO* claims were determined by the court to be recited with sufficient specificity to avoid the judicial restrictions on patent eligibility under § 101.

In *McRO*, the claim was directed to a “method for automatically animating lip synchronization and facial expression of three-dimensional characters.” *Id.* at 1307–08. The claim recited a series of steps that “produce[d] lip synchronization and facial expression control of said animated characters.” *Id.* The court found that the claimed “automation goes beyond merely ‘organizing [existing] information into a new form’ or carrying out a fundamental economic practice.” *Id.* at 1315 (citation omitted). Instead, the court found that the “claimed process uses a combined order of specific rules that renders information into a specific format that is then used and applied to create desired results: a sequence of synchronized, animated characters.” *Id.* In *McRO*, the Federal Circuit found that the recited rules “are limiting in that they define morph weight sets as a function of the timing of phoneme sub-sequences.” *Id.* at 1313. The claims were found to be directed to a “technological improvement over the existing, manual 3-D animation techniques.” *Id.* at 1316.

In finding the claim patent-eligible, the *McRO* court noted that the “abstract idea exception has been applied to prevent patenting of claims that abstractly cover results where ‘it matters not by what process or machinery the result is accomplished.’ [*O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 113]; *see also Mayo*, 132 S. Ct. at 1301.” *McRO*, 837 F.3d at 1314. The *McRO* court stated that therefore, a court must “look to whether the claims in these patents focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *Id.* at 1314.

Here, none of the steps recited in the claim on appeal describe the “specific means” by which the step is accomplished. For example, claimed steps [1] and [2] refer to “storing” information, but do not specifically disclose the method by which the information is stored. Step [3] recites “receiving design parameters,” but does not state the means by which the parameters are received. Steps [4] and [5] recite the desired result of “providing” lists of materials and users, but do not describe how the result is achieved.

In *McRO*, the court held that the “limitations in claim 1 prevent preemption of all processes for achieving automated lip-synchronization of 3–D characters.” *McRO*, 837 F.3d at 1315. The court explained that “[t]he specific structure of the claimed rules would prevent broad preemption of all rules-based means of automating lip synchronization.” *Id.* In contrast, the steps of rejected claim 1 are recited in general terms, namely, “storing,” “receiving,” and “providing.” Unlike *McRO*, none of these steps recite how the desired result is accomplished or implemented.

In sum, we have not been guided to an additional element in the claim, beyond the abstract idea, that integrates the judicial exception into practical application.

Step 2B

Because we determined that the judicial exception is not integrated into a practical application, we proceed to Step 2B per the Eligibility Guidelines, which instruct us to ask whether there is an inventive concept in the claimed invention. In making this Step 2B determination, we must consider whether there are specific limitations or elements recited in the claim “that are not well-understood, routine, conventional activity in the

field, which is indicative that an inventive concept may be present” or whether the claim “simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception, indicative that an inventive concept may not be present.” Eligibility Guidance, 84 Fed. Reg. 56 (footnote omitted). We must also consider whether the combination of steps perform “in an unconventional way and therefore include an ‘inventive step,’ rendering the claim eligible at Step 2B.” *Id.* In this part of the analysis, 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.” *Alice*, 573 U.S. at 217.

Appellant has not established that the claims, when considered as an ordered combination, provide “inventive” step. Appellant states that the claims “recite unconventional limitations” (Reply Br. 3), but fails to identify the “unconventional” limitation in the claim. To the contrary, as indicated in the cited Thompson, Cornelius, and Lawrence references, each of the steps in the claim appear to be conventional. Appellant did not explain how the steps, when considered as an ordered combination, constitute an unconventional and inventive process.

Accordingly, we conclude that claim 1 does not provide an inventive step. Claims 2–10 were not argued separately and therefore fall with claim 1.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed	New Ground
1-10	103	Thompson, Cornelius, Lawrence		1-10	
1	103	Thompson, Cornelius, Lawrence			1
1-10	101	Obviousness-type double patenting	1-10		
1-10	101	Eligibility	1-10		
Overall Outcome			1-10		1

TIME PERIOD FOR RESPONSE

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

When the Board enters such a non-final decision, 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 prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection

designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(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 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 the 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)(1). *See* 37 C.F.R. §§ 41.50(f), 41.52(b).

AFFIRMED; 37 C.F.R. § 41.50(b)