

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS D. POTTER

Appeal 2006-1963
Application 09/951,321
Technology Center 3700

Decided: October 31, 2007

Before MURRIEL, E. CRAWFORD, JENNIFER D. BAHR, ROBERT E.
NAPPI, LINDA E. HORNER, and ANTON W. FETTING,¹ *Administrative
Patent Judges.*

NAPPI, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

¹ The original panel consisted of APJ Crawford, Nappi, and Fetting. The panel has been expanded to consider the issues under 35 U.S.C. § 101.

Appellant has filed a paper under 37 C.F.R. § 41.52(a)(1) requesting that we reconsider our decision of December 13, 2006, wherein we affirmed the rejection of claims 28 through 47 under 35 U.S.C. § 103(a). We have granted Appellant's request for rehearing to the extent that we have reconsidered our decision, but that request is denied with respect to making any changes therein. Additionally, we now enter a new rejection of claims 28 through 47 as being directed to non patentable subject matter under 35 U.S.C. § 101.

Initially, we note that Appellant requested an oral hearing in conjunction with this Rehearing. That request is denied; however, should Appellant request an additional rehearing to address the new rejection under 35 U.S.C. § 101 and desire an oral hearing, the request will be granted.

Appellant contends that our decision is erroneous as Appellant asserts our finding that Lee teaches that retesting said participant using a different subset of said plurality of test questions on a basis independent of said answers which were answered incorrectly, is in error. Request for Rehearing 3. Further, Appellant asserts that our interpretation of the claim 38 limitation of "presenting training materials" is in error. Request for Rehearing 4.

Thus, Appellant's contentions present the issues of whether our findings of fact concerning Lee are in error and whether our interpretation of the scope of claim 38 is proper.

Claim 28 recites "retesting said participant using a different subset of said plurality of test questions, wherein said different subset is selected on a basis independent of said answers which were answered incorrectly." Appellant argued on pages 16-17 of the Brief that "Lee discloses selecting

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new questions based on the wrong answers provided by the student and redisplaying questions previously answered correctly.” In explaining why we did not find Appellant’s argument convincing, we stated in our December 13, 2006 Decision:

Lee teaches that there are two types of re-quiz(es) which can be given a) using the same questions as previously answered incorrectly; or b) using different questions. We note that there is some ambiguity in Lee as to whether the same questions previously answered incorrectly refers to the same group of questions as used in the quiz the student did not pass or whether it refers to the individual questions. Nonetheless, there is no ambiguity in that Lee’s reference to different questions being selected for the retest teaches that the questions in the retest are not the same as those previously presented. Further, as appellant’s argument seem to imply that the newly selected different questions are based upon the individual questions answered incorrectly; we find no teaching in Lee that suggests that the different questions used in the retest are selected based upon the questions incorrectly answered in a previous test.

(Decision 5-6)

Appellant’s argument on rehearing is a subtle shift of the prior argument as Appellant now argues that Lee does not teach selecting new questions independent of questions previously answered incorrectly. Nonetheless, we are not persuaded of error in our earlier decision. As noted in our prior decision there is some ambiguity in Lee as to whether “those questions previously answered incorrectly” refers to the group of questions or the individual questions. In our prior decision, we considered the statement in Lee of “those questions previously answered incorrectly” as referring to the group of questions presented to the user which the user did

not answer correctly.² Lee's statement which refers to "those questions previously answered incorrectly" identifies that the questions are displayed and answered as shown in blocks 182 and 184 of the flow chart in figure 4. These blocks of figure 4 are the same blocks which perform the selection of the initial group of questions. Column 7, lines 7-12. Thus, we consider Lee to teach that a retest group of questions is presented to the student. The group of questions in this retest may use the same group of questions used in a previous quiz the student did not pass, or the group of questions may be a group of questions different from the group of questions used in a previous quiz the student did not pass. As discussed above, there is no teaching in Lee that when a different group of questions is selected, the individual questions selected are based upon the questions previously incorrectly answered. Thus, the selection of a group of questions for the retest is independent of the prior group of questions.

Appellant's arguments on page 3 of the Request for Rehearing appear to interpret the statement in Lee as teaching that individual questions being selected as being either the same or different, thus implying that the selection is based upon the prior question. We do not find that Lee teaches such a selection. We find no teaching, nor does Appellant identify any teaching of Lee where an individual question is selected based upon the questions previously incorrectly answered.

² If one were to construe Lee's statement "the same of different questions as those previously answered incorrectly will again be displayed and answered" as being directed to the individual questions incorrectly answered, we find that it would be construed as merely identifying that the newly displayed questions are not limited to only one of the two types of questions but includes both types (previously presented or different).

Thus, Appellant has not established error in our findings regarding Lee.

Appellant argues, on page 4 of the Request for Rehearing, that our decision erred in determining that claim 38 did not recite that all of the training materials are displayed if the percentage score is below a threshold. Appellant argues that the plain meaning of the claim requires that all of the training materials be displayed.

As we noted on page 6 of our prior decision, the claim recites “displaying said training materials” not displaying all of the training materials. On page 7 of our prior decision, we stated:

[A]ppellant’s specification, while discussing the availability of all of the training material does not automatically present or display all of the training materials as appellant argues is the proper interpretation of claim 38. We consider the scope of the claim limitation “presenting training materials” to include a step of making available to a user a set of information, “training materials”, we do not consider the claim to be limited to the amount of the training materials which are viewed by the training program participant. We consider the scope of the claim limitation “displaying said training materials” to include a step where information, training materials, are displayed for the training program participant to view, we do not find that the limitation necessarily requires that information displayed to be the same as may have been viewed by the participant in the step of “presenting” (i.e., we consider the scope of the claim to include that the material displayed in the step of “displaying” to include a subset of the information made available in the step of “presenting”, however we do not consider the claim to require that all of the information made available in the step of “presenting” is displayed in the step of “displaying.”)

Appellant in the Request for Rehearing has not addressed the findings underlying our determination that the scope of claim 38 is not limited to

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displaying all of the training materials. Thus, Appellant has not persuaded us of error in our claim interpretation.

Accordingly, while we have granted Appellant's request for rehearing to the extent that we have reconsidered our decision, that request is denied with respect to making any changes therein.

NEW GROUNDS OF REJECTION PURSUANT TO 37 C.F.R.
§ 41.50(B).

37 C.F.R. § 41.50(b) states:

(b) Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.

We now enter a new rejection of claims 28 through 47 under 35 U.S.C. § 101. We note that the Examiner previously applied a rejection of these claims under 35 U.S.C. § 101. See page 4 of Final Office Action dated December 30, 2004. The Examiner based this rejection on the "technological arts" test but found that the claims recite a concrete, useful and tangible result. See page 5 of Final Office Action dated Dec. 30, 2004. In the Brief, Appellant argued that as the Examiner found that the claims recite a concrete, useful and tangible result, even though the claims recite a mental process, they are directed to statutory subject matter. Brief 10. The Examiner withdrew the rejection under 35 U.S.C. § 101. Answer

3. We consider the Examiner to have imprudently withdrawn the rejection and in light of our reviewing court's recent decision in *In re Comiskey*, 499 F.3d 1365, (Fed. Cir. Sep. 20, 2007), we now reject claims 28 through 47 under 35 U.S.C. § 101.

Appellant's claims are directed to a method of administering an incentive based training program. We consider these claims to be directed to an abstract mental process and as such not patentable under 35 U.S.C. § 101.

Our reviewing court has recently stated:

The prohibition against the patenting of abstract ideas has two distinct (though related) aspects. First, when an abstract concept has no claimed practical application, it is not patentable....

Second, the abstract concept may have a practical application. The Supreme Court has reviewed process patents reciting algorithms or abstract concepts in claims directed to industrial processes. In that context, the Supreme Court has held that a claim reciting an algorithm or abstract idea can state statutory subject matter only if, as employed in the process, it is embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e., a machine, manufacture, or composition of matter. 35 U.S.C. § 101.

In re Comiskey, 499 F.3d at 1376.

“Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.” *Gottschalk v. Benson*, 409 U.S. 63, 67, 175 USPQ 673, 675 (1972). One may not patent a process that comprises every “substantial practical application” of an abstract idea, because such a patent “in practical effect would be a patent on the [abstract idea] itself.” *Benson*, 409 U.S. at 71-72, 175 USPQ at 676; *cf. Diamond v. Diehr*, 450 U.S. 175, 187, 209 USPQ 1, 8 (1981) (stressing that the patent applicants in that case did “not seek to pre-empt the use of [an] equation,” but instead

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sought only to “foreclose from others the use of that equation in conjunction with all of the other steps in their claimed process”).

First, respondent incorrectly assumes that if a process application implements a principle in some specific fashion, it automatically falls within the patentable subject matter of § 101 and the substantive patentability of the particular process can then be determined by the conditions of §§ 102 and 103. This assumption is based on respondent's narrow reading of *Benson*, and is as untenable in the context of § 101 as it is in the context of that case. It would make the determination of patentable subject matter depend simply on the draftsman's art and would ill serve the principles underlying the prohibition against patents for “ideas” or phenomena of nature. The rule that the discovery of a law of nature cannot be patented rests, not on the notion that natural phenomena are not processes, but rather on the more fundamental understanding that they are not the kind of “discoveries” that the statute was enacted to protect. [footnote omitted] The obligation to determine what type of discovery is sought to be patented must precede the determination of whether that discovery is, in fact, new or obvious.

Parker v. Flook, 437 U.S. 584, 593 (1978).

Independent claims 28 and 38 recite steps of presenting training materials, presenting a test, determining a score on the test, and based upon the score on the test either awarding points or administering and scoring a retest. Although these claim steps admittedly require a certain amount of physical human steps such as presenting training materials or presenting a test, they nonetheless ultimately pertain to a process of human thinking (i.e., a mental process) that is not embodied in and does not operate on, transform, or otherwise involve another class of statutory subject matter, i.e., a machine, manufacture, or composition of matter. Compare *In re Comiskey*, 2007 WL 2728361 at *1 (claims were held to be directed to mental processes even though they recited physical acts such as incorporating

arbitration language into a unilateral document and conducting an arbitration). Dependent claims 29 through 37 and 39 through 46 further limit the method and likewise do not recite another class of statutory subject matter on which the method acts or operates. Thus, claims 28 through 47 in essence pre-empt any and all operations of teaching that involve tests and retests.

The preambles of independent claims 28 and 38 recite the method is administered using a “central processing station.” We do not construe the “central processing station” of the preamble as being limited to a machine. Appellant’s Specification, provides examples of components of the central processing station such as processors, monitors and storage facilities. Specification 12. However, Appellant’s Specification also states “portions of the system can be carried [out] manually such as by having a participant communicate with a live person over telephone lines who then administers one or more of the various functions described below.” Specification 14. Thus, interpreting the claim in light of Appellant’s Specification reveals that the method is not embodied in, and does not operate on, transform or otherwise involve a statutory class of subject matter. Rather, Appellant’s Specification specifically contemplates that the claimed central processing station which performs the method is a person (i.e. the method steps describe a mental process). “[M]ental processes –or processes of human thinking—standing alone are not patentable even if they have practical application.” *In re Comiskey*, 499 F.3d at 1377.

Thus, we consider claims 28 through 47 to be directed to an abstract concept and that the claims are not patentable under 35 U.S.C. § 101.

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Whether or not the claims are drawn to a practical application has no bearing on this determination as the scope of the claims includes the method being performed as a series of mental steps.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2006). 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." Accordingly, a request for rehearing of this decision is permitted under 37 C.F.R. § 41.52(a)(1).

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. . . .

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No time period for taking any subsequent action to connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(i)(iv).

REHEARING DENIED- 37 C.F.R. § 41.50(b)

tdl/gw

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