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EXAMINER

DICKERSON, TIPHANY B

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3623

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PAPER

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.



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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Application Number: 12/586,574
Filing Date: September 24, 2009
Appellant(s): Doyle et al.

Martin Sultana
Reg. No. 57,739
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/14/2014.

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(1) Grounds of Rejection to be Reviewed on Appeal

Every ground of rejection set forth in the Office action dated 05/14/2014 from which the appeal is taken is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading “WITHDRAWN REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

(2) New Grounds of Rejection

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-20 are directed to a judicial exception (*i.e.*, law of nature, natural phenomenon, or abstract idea), specifically an abstract idea of collecting and communicating inspection information for a vehicle or mechanism. After considering all claim elements, both individually and in combination, it has been determined that the claim does not amount to significantly more than the abstract idea itself. While the claims suggest a computing environment as evidenced by the terms electrically transmitting, receiving or otherwise electrically performing the steps, these limitations are not enough to qualify as “significantly more” than being recited in the claim along with the abstract idea. Therefore, since there are no limitations in the claims that transform the

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exception into a patent eligible application such that the claims amount to significantly more than the exception itself, the claims are rejected under 35 USC § 101 as being directed to non-statutory subject matter.

(3) Response to Argument

The Appellant's remarks made in the Appeal Brief dated 10/14/2014 have been fully considered but are not persuasive. Appellant arguments are discussed below.

Regarding claim 1, Appellant argues that Wepfer fails to teach a) *electronically receiving a notification indicative of the technician receiving the repair order information; and b) electronically generating an electronic inspection form including a questionnaire in response to the notification to receive inspection information from the technician* (Br. 5). Examiner respectfully disagrees on both points. Regarding argument a), the point of disagreement lies in how the Office and Appellant interpret a notification. Examiner finds that a prompt on the technician's screen is a notification. Wepfer states that the technician is prompted to enter information after receiving the work order at paragraphs [12-13], and also explained in the Final Action (Final Action, p. 4, Response to Arguments). Appellant further argues that Wepfer's prompt is in relation to work that has been performed rather than future work (Br. 6, quoting Wepfer, paragraph [13]). In response, this is a moot point since claim 1 merely requires "electronically receiving a notification indicative of the technician receiving the repair order information." Alternatively, the list in Wepfer, paragraph 13 provides mere examples of information to be captured. The recitation clearly states "or any other information that is desirable to be captured about service or maintenance work for the equipment." Regarding

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argument b), the references disclose electronically generating an electronic inspection form including a questionnaire in response to the notification to receive inspection information from the technician (Final Action, p. 7). Appellant's basis for this argument seems to be rooted in want for the *notification* step above. Examiner disagrees as stated above and also notes that Figures 6, 7, and 8 disclose the inspection form questionnaire.

Regarding claim 10, Appellant argues that Wepfer in view of Beamon fails to disclose *determining a value for a cashier based metric which corresponds to a number of printed electronic appended repair orders based on the number of times the steps of causing the original electronic repair order to be appended with the at least a portion of the received inspection information; and determining whether the electronic appended repair order is available to print is executed* (Br. 8-9). In response, Beamon discloses a software application that counts all customer trouble reports since a specific work order was issued or completed (Beamon, [61]). Appellant argues that Beamon is silent on the subject limitation and then asserts that Appellant is not claiming determining a value for a metric that corresponds to a number of customer trouble tickets (Br. 9-10). In response, the Action stated that the metric was interpreted as representing a number of times a work order has been updated or re-worked (i.e., appended to) which may reflect on a worker quality of performance as required by the claim (Final Action, pp. 14-15). Examiner also, notes that that the prosecution history reflects unanswered questions regarding clarification of how this limitation, and more specifically, the term electronic appended orders was to be interpreted (Non-Final Action dated 09/18/2013, p. 4 and Final Action dated 05/14/2014, p. 2-3). Since neither the Specification nor Appellant further described the term, it

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was given the broadest reasonable interpretation in light of the specification. Applying a plain meaning interpretation of *electronic appended repair order*, examiner interpreted it as an updated or changed work order. Given this interpretation, Beamon sufficiently discloses such a metric, as claimed.

4) Conclusions

For the above reasons, it is believed that the rejections should be sustained.

Requirement to pay appeal forwarding fee. In order to avoid dismissal of the instant appeal in any application or ex parte reexamination proceeding, 37 CFR 41.45 requires payment of an appeal forwarding fee within the time permitted by 37 CFR 41.45(a), unless appellant had timely paid the fee for filing a brief required by 37 CFR 41.20(b) in effect on March 18, 2013.

This examiner's answer contains a new ground of rejection set forth in section (2) above. Accordingly, appellant must within TWO MONTHS from the date of this answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (1) above by signing below:

For Greg Vidovich

Director 3600

/Vincent Millin/

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(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection in an arguments section as set forth in 37 CFR 41.37(c)(1) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/TIPHANY DICKERSON/
Primary Examiner, Art Unit 3623

Conferees:

/BETH V BOSWELL/

Supervisory Patent Examiner, Art Unit 3623

/Vincent Millin/