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12/119,593	05/13/2008	Maurice Stanley	08-568	3332

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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

EXAMINER

NGUYEN, THUY-VI THI

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3689

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09/04/2015

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.

The present application is being examined under the pre-AIA first to invent provisions.

RESPONSE TO BPAI DECISION

In the decision by the Board of Patent Appeals and Interferences mailed 03/26/15, the rejections of Claims 1-8, 10, 11, 16 and 20 were reversed. The reason for the reversal of Claims 1-8, 10, 11, 16 and 20 were, in substance, that the Board of Patent Appeals was persuaded by Appellant's argument that the reference Cook fails to disclose "indicating whether said article would fit the user wherein the method of providing an indication of fit does not involve using measurement of the particular article" as claim 1 requires (see pages 5-6 BPAI decision).

However, upon review, the claims are directed to non-statutory subject matter with respect to 101 eligibility guidance. Therefore, under 37 CFR 1.198, prosecution is hereby reopened (see MPEP 1214.04). The new grounds of rejection are detailed below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth

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in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Technology Center Director has approved of reopening prosecution by signing below:

/GREG VIDOVICH/

Director, Technology Center 3600

The present application is being examined under the pre-AIA first to invent provisions.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 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.

2. Claims 1-8, 10-11, 16 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because the independent process claim 1 (i.e., method claim) as a whole, considering all claim elements both individually and in combination, do not amount to significantly more than an abstract idea. Part I: The invention of claim 1 is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more. For example, the process of claim 1 is directed to “*taking user body size data....; taking reference body size data....; comparing the user body size data with the reference body size data....*” which falls under the abstract idea of organizing human activities (e.g.

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similar to comparing new and stored information and using rules to identify options, that has been held to be abstract in Smartgene)". Therefore, because independent claim 1 includes an abstract idea, the claim must be reviewed under Part II of the Alice Corp. analysis to determine whether the abstract idea has been applied in an eligible manner. Part II: The claim(s) does not include additional element that are sufficient to amount to significantly more than the judicial exception because the claim generically recites computer elements (e.g. a computer) which do not add a meaningful limitation to the abstract idea because they would be routine in any computer implementation. Viewed as a whole, these additional claim elements do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself. Therefore, the independent 1 is rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. See Alice Corporation Pty. Ltd. v. CLS Bank International, et al.

Dependent claims 2-8, 10-11, 16 and 20 are merely add further details of the abstract steps/elements recited in claim 1 without including an improvement to another technology or technical field, an improvement to the functioning of the computer itself, or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment. Further, using scanning apparatus with 2D imaging system is well-understood, routine and conventional activities previously known to the industry. Therefore, dependent claims 2-8, 10-11, 16 and 20 are also non-statutory subject matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kira Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KIRA NGUYEN/

Primary Examiner, Art Unit 3689