UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL MULLER

Appeal 2009-005312
Application 10/331,389
Technology Center 3600

Decided: November 17, 2009


FETTING, Administrative Patent Judge.

DECISION ON APPEAL
STATEMENT OF THE CASE

Michael Muller (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-19, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The Appellant invented a scheduling system for calendaring a meeting according to the schedules of participants in the meeting (Specification ¶ 0001).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

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1 Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed May 15, 2008) and Reply Brief (“Reply Br.,” filed September 24, 2008), and the Examiner’s Answer (“Ans.,” mailed July 24, 2008), and Final Rejection (“Final Rej.,” mailed November 19, 2007).
1. A method for scheduling a task based upon a measure of graduated availability for a specified time frame, the method comprising the steps of:

[1] identifying tasks which previously had been scheduled about a specified time frame;

[2] weighting each of said identified tasks according to a likelihood that a newly scheduled task when combined with said weighted identified tasks would interfere with completing said weighted identified tasks through overloading by scheduling too many tasks about the specified time period;

[3] computing an average of said weighted identified tasks, said average producing a graduated availability for said specified time frame; and,


**THE REJECTIONS**

The Examiner relies upon the following prior art:

Silverberg US 6,216,110 B1 Apr. 10, 2001
Levinson US 7,027,996 B2 Apr. 11, 2006

Claims 1-8 stand rejected under 35 U.S.C. § 101 as being directed towards non-statutory subject matter.

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Levinson and Silverberg.

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2 The Appellant speaks to a 35 U.S.C. 112, first paragraph, rejection and a 35 U.S.C. 102(b) rejection (App. Br. 7), however, no evidence of any such rejection is found on the record.
ISSUES

The issues pertinent to this appeal are:

• Whether the Appellant has sustained the burden of showing that the Examiner erred in rejecting claims 1-8 under 35 U.S.C. § 101 as being directed toward non-statutory subject matter.
  ○ This pertinent issue turns on whether the claimed process steps are tied to an apparatus or machine or whether the claimed process steps transform an article into a different state or thing.

• Whether the Appellant has sustained the burden of showing that the Examiner erred in rejecting claims 1-19 under 35 U.S.C. § 103 as unpatentable over Levinson and Silverberg.
  ○ This pertinent issue turns on whether Levinson describes limitation [2] of claim 1.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure contains no lexicographic definition of “weighted.”
02. The ordinary and customary meaning of “weighted” is adjusted to reflect value or proportion.3

Facts Related to Appellant’s Disclosure

03. A task can be an event, to-do, or reminder (Specification 00016).

Facts Related to the Prior Art

Silverberg

04. Silverberg is directed to a system and method for providing public access to availability information associated with an individual’s computerized calendar (Silverberg 1:7-10).

Levinson

05. Levinson is directed to a calendaring system and method for reminding a user of upcoming tasks and appointments and for automatically planning a user’s calendar, based on inputted tasks and goals of a user and cueing the user at the beginning and end of a task or appointment (Levinson 1:11-15).

06. A user of the system can enter a script into the system, where a script is a set of specific appointments or tasks and may have a specific order (Levinson 6:22-24). A task is an act that needs to be performed at sometime during the day and an appointment is a task that has a specific start time (Levinson 6:26-30). A task may also be defined to have an earliest start time, a latest stop time, and

a duration of time required to complete the act (Levinson 6:36-40).

07. In operation, once a user has entered task and goal information, the system planner automatically generates a schedule for the user based on priorities and goals (Levinson 9:51-54). If there is an unexpected event delaying the performance of another task, the system may cancel a task that has the lowest priority and provide the user with an updated schedule (Levinson 9:54-58). Additionally, a revised schedule is rendered if there is an interference or conflict in the plan, such as a plan that requires a user to purchase a book with the same money (same resource) that is to be used to purchase lunch (Levinson 12:1-2).

Facts Related To The Level Of Skill In The Art

08. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent art meeting scheduling systems. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. See Okajima v. Bourdeau, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting Litton Indus. Prods., Inc. v. Solid State Sys. Corp., 755 F.2d 158, 163 (Fed. Cir. 1985).
Facts Related To Secondary Considerations

There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

101 - Bilski

The law in the area of patent-eligible subject matter for process claims has recently been clarified by the Federal Circuit in In re Bilski, 545 F.3d 943, 950-952 (Fed. Cir. 2008) (en banc), petition for cert. filed, 77 USLW 3442 (U.S. Jan. 28, 2009) (No. 08-964).

The en banc court in Bilski held that “the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101.” Bilski, 545 F.3d at 956. The court in Bilski further held that “the ‘useful, concrete and tangible result’ inquiry is inadequate [to determine whether a claim is patent-eligible under § 101.]” Bilski, 545 F.3d at 959-60.

The court explained the machine-or-transformation test as follows: “A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” Bilski, 545 F.3d at 954 (citations omitted). The court explained that “the use of a specific machine or transformation of an article must impose meaningful limits on the claim’s scope to impart patent eligibility” and “the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.” Bilski, 545 F.3d at 961-62 (citations omitted).
The court declined to decide under the machine implementation branch of the inquiry whether or when recitation of a computer suffices to tie a process claim to a particular machine. *Bilski*, 545 F.3d at 962. As to the transformation branch of the inquiry, however, the court explained that transformation of a particular article into a different state or thing “must be central to the purpose of the claimed process.” *Id.* As to the meaning of “article,” the court explained that chemical or physical transformation of physical objects or substances is patent-eligible under § 101. *Id.* The court also explained that transformation of data is sufficient to render a process patent-eligible if the data represents physical and tangible objects, *i.e.*, transformation of such raw data into a particular visual depiction of a physical object on a display. *Id.* at 962-63. The court further noted that transformation of data is insufficient to render a process patent-eligible if the data does not specify any particular type or nature of data and does not specify how or where the data was obtained or what the data represented. *Id.* at 962 (citing *In re Abele*, 684 F.2d 902, 909 (CCPA 1982) (process claim of graphically displaying variances of data from average values is not patent-eligible) and *In re Meyer*, 688 F.2d 789, 792-93 (CCPA 1982) (process claim involving undefined “complex system” and indeterminate “factors” drawn from unspecified “testing” is not patent-eligible)).

*Obviousness*

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill

In *Graham*, the Court held that the obviousness analysis is bottomed on several basic factual inquiries: “[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” *Graham*, 383 U.S. at 17. See also *KSR*, 550 U.S. at 406. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416.

**ANALYSIS**

*Claims 1-8 rejected under 35 U.S.C. § 101 as being directed towards non-statutory subject matter*

The Examiner found that claims 1-8 failed to tie the steps to a machine and can be performed within the human mind without the use of a particular apparatus (Ans. 4). The Appellant contends that claim 1 provides for the transformation of subject matter from one state to another (Reply. Br. 2).

We disagree with the Appellant. The Examiner and Appellant are correct in asserting that the machine-or-transformation test, described in *Bilski*, controls whether claims 1-8 are directed towards statutory subject matter. The Appellant is also correct that so long as the claims satisfy the transformation prong of the test, the claims will satisfy the machine-or-transformation test of *Bilski* (Reply Br. 3). However, claim 1 fails to transform an *article* into a different state or thing. Claim 1 does not recite the use of any article, or of any data indicative of physical characteristics of
articles, in scheduling a task. The Appellant specifically contends that an “average of weighted identified tasks” are transformed to produce a “graduated availability”, which is subsequently stored (Reply Br. 3). However, an “average of weighted identified tasks” is not article. Furthermore, the “average of weighted identified tasks” is used in a computation and therefore is not transformed at all. The average is merely used to compute another numerical value.

Additionally, as noted by the Examiner, claim 1 does not recite the use of machine or apparatus (Ans. 4). As such, the method steps of claim 1 are not tied to a particular machine or apparatus. The Appellant does not contest this finding of the Examiner. As such, claims 1-8 fail to satisfy both prongs of the machine-or-transformation test and are rejected under 35 U.S.C. § 101 as being directed towards non-statutory subject matter.

Claims 1-19 rejected under 35 U.S.C. § 103(a) as unpatentable over Levinson and Silverberg

The Appellant first contends that (1) the Examiner inappropriately submitted a final office action dated November 17, 2007 (App. Br. 5). However, this relates to a petitionable matter and not to an appealable matter. See In re Schneider, 481 F.2d 1350, 1356-57 (CCPA 1973) and In re Mindick, 371 F.2d 892, 894 (CCPA 1967). See also the MPEP § 1002.02(c), item 3(a) and § 1201. Thus, the relief sought by the Appellant would have been properly presented by a petition to the Commissioner under 37 C.F.R. § 1.181 instead of by appeal to this Board. Accordingly, we will not further consider this issue.
The Appellant also contends that (2) Levinson and Silverberg fail to describe that the scheduling of a new task is likely to result in an overload condition by scheduling too many tasks about a specific time period, as required by limitation [2] of claim 1 (App. Br. 6). We disagree with the Appellant. Limitation [2] specifically requires assigning a weight value to tasks such that when new tasks are added to the schedule they will conflict with performing the weighted tasks. The plain meaning of the term “weighted” is adjusted to reflect proportion or value (FF 02) and in the context of the claim language and consistent with the Specification a weighting a task is assigning a priority or proportion value to the task.

Levinson describes a system that uses tasks and appointments (FF 07). Each of the tasks has a priority and goal associated to the task (FF 07). The assignment of priorities and goals is same functionality as assigning a weight to each of the tasks. Levinson further describes that tasks will be cancelled based on the goals and priorities of the user and the cancellation of tasks will be represented in a revised schedule (FF 07). That is, if a schedule becomes overloaded with tasks at a particular time period, the system will adjust the schedule based on the priority or weighted values assigned to each task in order to correct the schedule. As such, Levinson describes limitation [2] of claim 1.

The Appellant further contends that (3) the Examiner’s use of the term “task” is inconsistent with the plain meaning of the term and its use in the Specification (Reply Br. 5). The Appellant specifically contends that the Examiner has construed a task to mean a script and Levinson describes a script as a set of steps. We disagree with the Appellant. The term “task” used in the claimed invention is an event, to-do, or reminder (FF 03). This is
consistent with the plain meaning of a task. Levinson describes a task as an action that needs to be performed (FF 06). In other words, a task is an event or a to-do. Levinson further describes a script as a set of tasks (FF 06). As such, the Examiner’s construction of the term task and the aggregation of tasks into a script are consistent with its plain meaning and is consistent with its use in the claim invention.

The Appellant has not sustained the burden of showing that the Examiner erred in rejecting claims 1-19 under 35 U.S.C. § 103(a) as unpatentable over Levinson and Silverberg.

CONCLUSIONS OF LAW

The Appellant has not sustained the burden of showing that the Examiner erred in rejecting claims 1-8 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter.

The Appellant has not sustained the burden of showing that the Examiner erred in rejecting claims 1-19 under 35 U.S.C. § 103(a) as unpatentable over Levinson and Silverberg.

DECISION

To summarize, our decision is as follows.

• The rejection of claims 1-8 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter is sustained.
• The rejection of claims 1-19 under 35 U.S.C. § 103(a) as unpatentable over Levinson and Silverberg is sustained.

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)(iv)(2007).

AFFIRMED

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