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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MAURICE STANLEY
and
TEJ PAUL KAUSHAL

Appeal 2012-011572
Application 12/119,593
Technology Center 3600

Before MURRIEL E. CRAWFORD, BIBHU R. MOHANTY, and NINA L. MEDLOCK, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1–8, 10, 11, 16, and 20. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

BACKGROUND

Appellants' invention is directed to "a method of providing accurate fit recommendations for individuals for footwear and/or garments" (Spec. 1:5–6).

Claim 1 is illustrative:

> 1. A method of providing a user with an indication of fit for at least one article of interest comprising using a computer to perform the steps of:
>
> taking user body size data relating to the user;
>
> taking reference body size data associated with the at least one article wherein the reference body size data comprises a set of critical dimensions ranges or limits or a set of clusterings or groupings of measurements derived from body size data of a plurality of people known to fit the particular article; the method previously comprising the step of obtaining body size data from a plurality of people along with details of at least one article known to fit each of said people; and
>
> comparing the user body size data with the reference body size data and indicating whether said article would fit the user wherein the method of providing an indication of fit does not involve using measurements of the particular article.

Appellants appeal the following rejections:

Claims 1–8, 10, 11, 16, and 20 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–8, 10, 11, 16, and 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1–4, 8, 10, and 11 are rejected under 35 U.S.C. § 102(b) as anticipated by Cook (US 6,879,945 B1, iss. Apr. 12, 2005).

Claims 5–7 are rejected under 35 U.S.C. § 103(a) as unpatentable over Cook and Nguyen (US 7,114,260 B2, iss. Oct. 3, 2006).

Claim 16 is rejected under 35 U.S.C. § 103(a) as unpatentable over Cook.

Claim 20 is rejected under 35 U.S.C. § 103(a) as unpatentable over Cool and Genest (US 6,741,728 B1, iss. May 25, 2004).

ANALYSIS

Rejection under 35 U.S.C. § 101

The Examiner finds that claims 1–8, 10, 11, 16, and 20 fail the machine-or-transformation test because the claimed steps are neither tied to a particular machine or apparatus nor physically transform the underlying subject matter to a different state or thing (Ans. 6–7). The Examiner found that the inclusion of a "computer" in the preamble of claim 1 was a nominal recitation, and as such, determined that claim 1 fails to satisfy the first prong of the test (*id.*) The Examiner also found that claim 1 fails to include any steps that would result in an article being transformed from one state into another, and determined that claim 1 also fails the second prong of the test (*id.* at 7) Although the Examiner appears to acknowledge that the Supreme Court clarified in *Bilski v. Kappos,* 561 U.S. 593 (2010) that "[t]he machine-or-transformation test is not the sole test for deciding whether an invention is a patent-eligible 'process'" (*see* Ans. 6; *see also Bilski*, 561 U.S. at 604), the Examiner nevertheless concludes that claims 1–8, 10, 11, 16, and 20 are directed to non-statutory subject matter, based solely on their failure to satisfy the machine-or-transformation test.

Accordingly, the Examiner's analysis is incomplete inasmuch as it reflects consideration of the machine-or-transformation test, only, which the Supreme Court has made clear is not dispositive of the § 101 inquiry. As such, the Examiner has failed to establish a prima facie case of patent-

ineligibility. In view of the foregoing, we do not sustain the Examiner's rejection of claims 1–8, 10, 11, 16, and 20 under 35 U.S.C. § 101.

Rejection under 35 U.S.C. § 112, second paragraph

Appellants argue the Examiner erred in rejecting claims 1–8, 10, 11, 16, and 20 under 35 U.S.C. § 112, second paragraph, as indefinite (App. Br. 7–8; Reply Br. 4–5). The Examiner maintains that independent claim 1 is indefinite because "it is unclear how a proper fit is determined without tak[ing] in[to] consideration the size of the particular article" (Ans. 5 and 16). However, we agree with Appellants that a person of ordinary skill in the art would understand what is claimed when claim 1 is read in light of the Specification (App. Br. 7–8). In particular, the Specification describes that it determines a proper fit by comparing the user's body size data with body size data of other people to determine a match in body size (Spec. 4:20–27) and "[o]nce such a match has been determined the particular article known to fit the particular body data size can be identified" (*id.* at 9:25–29).

In view of the foregoing, we do not sustain the Examiner's rejection of independent claim 1, and its dependent claims 2–8, 10, 11, 16, and 20 under 35 U.S.C. § 112, second paragraph. *See, e.g.*, *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether those skilled in the art would understand what is claimed when the claim is read in light of the specification).

Rejections under 35 U.S.C. §§ 102(b) and 103(a)

Appellants argue that the Examiner erred in asserting that Cook discloses "indicating whether said article would fit the user wherein the method of providing an indication of fit does not involve using measurements of the particular article," as recited in claim 1. (App. Br. 8–10; Reply Br. 5–7).

In contrast, the Examiner has determined that the argued limitation is found in the Abstract of Cook. (Ans. 9–10 and 17).

We have reviewed the Examiner's rejection in light of Appellants' arguments that the Examiner has erred. We concur with Appellants' contention that the Examiner erred because 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 measurements of the particular article," as claim 1 requires.

In this regard, we agree with Appellants that the shoe recommendation described in Cook "utilizes size measurements and fit assessments made for the current production run for each respective footwear model that is available for purchase." (App. Br. 9; citing Cook 5:23–28). The portion of Cook, cited by the Examiner, discloses that "recommended footwear size is determined for the selected footwear model based on the received foot size information, a length adjustment factor for the selected footwear model and past product fit information" (Abstr.). Based on this disclosure, the Examiner concluded that Cook's length adjustment factor is "determined based on the human assessments regarding sizing received from the plurality of human subjects known to fit the particular article," and as such, discloses the argued limitation (*see* Ans. 17;

citing Cook 6:35–60). However, Cook describes that its length adjustment factor is based on both fit assessment (i.e., human assessment) and size measurements of the shoe model (e.g., Brannock adjusted size) when used as a basis for generating a foot size recommendation (Cook 5:28–30; *see also* Cook 7:20–8:61). Therefore, although the length adjustment factor described in Cook is based on a human assessment component, the Examiner fails to appreciate that the human assessment component is just one component of the length adjustment factor described by Cook, and as such, fails to provide an indication of fit without using measurements of the particular article, as called for in claim 1.

In view of the foregoing, we do not sustain the Examiner's rejections of independent claim 1, and its dependent claims 2–8, 10, 11, 16, and 20.

DECISION

We reverse the Examiner's rejection of claims 1–8, 10, 11, 16, and 20 under 35 U.S.C. § 101 as directed to non-statutory subject matter.

We reverse the Examiner's rejection of claims 1–8, 10, 11, 16, and 20 under 35 U.S.C. § 112, second paragraph, as being indefinite.

We reverse the Examiner's rejections of claims 1–8, 10, 11, 16, and 20 under 35 U.S.C. §§ 102(b) and 103(a).

REVERSED

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