

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/119,593	05/13/2008	Maurice Stanley	08-568	3332
	7590 09/04/201 BOEHNEN HULBER	5 RT & BERGHOFF LLP	EXAMINER	
300 S. WACKE 32ND FLOOR			NGUYEN, THUY-VI THI	
CHICAGO, IL	60606		ART UNIT	PAPER NUMBER
			3689	
			MAIL DATE	DELIVERY MODE
			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.

	Application No. 12/119,593	Applicant(s) STANLEY ET AL.	
Office Action Summary	Examiner KIRA NGUYEN	Art Unit 3689	AIA (First Inventor to File) Status No
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondend	ce address
A SHORTENED STATUTORY PERIOD FOR REPLY THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	6(a). In no event, however, may a reply be timil apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	nely filed the mailing date of D (35 U.S.C. § 133	this communication.
Status	decision dated 02/26/15		
1) Responsive to communication(s) filed on board A declaration(s)/affidavit(s) under 37 CFR 1.13			
.,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,			
,	action is non-final.	aat farthadurir	a tha intervious an
3) An election was made by the applicant in response	·		ig the interview on
 the restriction requirement and election Since this application is in condition for allowan closed in accordance with the practice under E 	ce except for formal matters, pro	secution as t	o the merits is
Disposition of Claims*			
5) Claim(s) 1-8,10,11,16 and 20 is/are pending in 5a) Of the above claim(s) is/are withdraw 6) Claim(s) is/are allowed. 7) Claim(s) 1-8,10,11,16 and 20 is/are rejected. 8) Claim(s) is/are objected to. 9) Claim(s) are subject to restriction and/or are any claims have been determined allowable, you may be elimentaricipating intellectual property office for the corresponding apattp://www.uspto.gov/patents/init_events/pph/index.jsp or send	on from consideration. election requirement. gible to benefit from the Patent Pros polication. For more information, plea an inquiry to <u>PPHfeedback@uspto.c</u>	ise see	way program at a
10) The specification is objected to by the Examiner 11) The drawing(s) filed on is/are: a) access Applicant may not request that any objection to the of Replacement drawing sheet(s) including the correction	epted or b) objected to by the Edrawing(s) be held in abeyance. See	9 37 CFR 1.85	
Priority under 35 U.S.C. § 119			
12) ☐ Acknowledgment is made of a claim for foreign Certified copies: a) ☐ All b) ☐ Some** c) ☐ None of the:	, , , , , , , , , , , , , , , , , , ,	-(d) or (f).	
 Certified copies of the priority documents Certified copies of the priority documents Copies of the certified copies of the priority application from the International Bureau 	s have been received in Applicat rity documents have been receive		
** See the attached detailed Office action for a list of the certifie	d copies not received.		
Attachment(s)	_		
1) Notice of References Cited (PTO-892)	3) Interview Summary		
2) Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/S Paper No(s)/Mail Date	B/08b) Paper No(s)/Mail Da	ite	

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

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.

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.

Application/Control Number: 12/119,593

Art Unit: 3689

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.

Page 4

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.

Application/Control Number: 12/119,593 Page 5

Art Unit: 3689

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