

2015 WL 1871422 (Patent Tr. & App. Bd.)

Patent Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

EX PARTE ROBERT C. STEINER

Appeal 2012-0012381 <sup>1</sup>

[Application 11/805,019](#) <sup>2</sup>

Technology Center 3600

April 21, 2015

\*1 Before [JOSEPH A. FISCHETTI](#), [BIBHU R. MOHANTY](#), and TARA L. HUTCHINGS  
Administrative Patent Judges  
HUTCHINGS  
Administrative Patent Judge

#### DECISION ON APPEAL

#### STATEMENT OF THE CASE

Appellant appeals under [35 U.S.C. § 134\(a\)](#) from the Examiner's final rejection of claims 1-5 and 7-18. We have jurisdiction under [35 U.S.C. § 6\(b\)](#).

We REVERSE.

#### CLAIMED INVENTION

Appellant's claimed invention relates to the use of presence information. Spec. 1:4.

Claim 1, reproduced below, is illustrative of the subject matter on appeal:

1. A method comprising:

in response to a request received from a communication device, a provider of a presence service creating a presentity of an issue or a transaction;

the provider of the presence service subscribing a customer as a watcher of the presentity;

the provider of the presence service receiving a state of the issue or the transaction from a handler of the issue or the transaction;

in response to said receiving, the provider of the presence service registering the state in the presentity; and

the provider of the presence service sending a message reporting the registered state to watchers of the presentity.

#### REJECTIONS

Claims 1-5 and 7-11 are rejected under [35 U.S.C. § 101](#) as being directed to non-statutory subject matter.

Claims 1-4, 6-10, 12-15, 17, and 18 are rejected under [35 U.S.C. § 102\(e\)](#) as anticipated by Barta ([US 2007/0095904 A1](#), pub. May 3, 2007).

Claims 5, 11, and 16 are rejected under [35 U.S.C. § 103\(a\)](#) as unpatentable over Barta.

## ANALYSIS

### *Claim Construction*

We begin our analysis by first considering the scope and meaning of the term “presence service,” as used in independent claims 1, 7, 17, and 18. We construe the term “presence service” by giving it its “broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000) (citation omitted). Under this broadest reasonable interpretation standard, claim terms are given their ordinary and customary meaning as it would be understood by a person of ordinary skill in the art in light of the specification. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

\*2 A pertinent dictionary definition is “presence technology *n.* An application, such as instant messaging, which finds specific users when they are connected to the network and which may alert interested users of each other's presence.” MICROSOFT COMPUTER DICTIONARY 418 (5th ed. 2002). We construe “presence service” to encompass a service that implements “presence technology,” i.e., a service that finds specific users when the specific users are connected to the network. We conclude this construction is consistent with how the term would be understood by those skilled in the art and with Appellant's Specification.

For example, the Specification describes in the Background of the Invention that a presence service, as known by one of ordinary skill, receives presence information (called a “presence state”) from a client, stores the presence state in a record (called a “presentity”), and makes the presence state available to users (called “watchers”) who have subscribed with the presence system to receive the client's presence state. *Id.* 1:6-13. Presence information, as provided by a known presence service, drives instant messaging by informing watchers of a client's availability and willingness to communicate (e.g., “free,” “busy,” “away,” and “do not disturb”). *Id.* 1:14-22. The Specification further describes in the Summary of the Invention that the invention expands upon known presence technology by using a presentity in a new way, i.e., to represent and report states of an issue or transaction.” *Id.* 2:18-20. But the presence service creates the presentity “in a conventional manner.” *Id.* 4:11-12.

With this understanding in mind, we turn to the merits of the Examiner's rejections.

### *Non-Statutory Subject Matter*

The Examiner finds that claims 1-5 and 7-11 fail the machine-or-transformation test because the claimed steps are neither tied to a particular machine or apparatus nor physically transform underlying subject matter to a different state or thing. Ans. 3-5. And, based on the failure to satisfy the machine-or-transformation test, the Examiner concludes that claims 1-5 and 7-11 are directed to non-statutory subject matter. *Id.*

Appellant contends that the claims explicitly recite a known apparatus to which the claimed method steps are tied, a presence service, shown in Figure 1 of the Specification. App. Br. 7-8. . Therefore, Appellant maintains that the rejection of claims 1-5 and 7-11 under [35 U.S.C. § 101](#) should be withdrawn. *Id.*

We agree with Appellant that a person of ordinary skill in the art would reasonably understand from the customary definition of “presence service,” as found *supra*, that the presentity limitations recited in claims 1-5 and 7-11 are inextricably tied to a machine for implementing a presence technology service among interconnected communication devices (i.e., a presence

service), and thus cover more than a nominal recitation of a computer to obtain patent eligibility because the claimed presence service is necessary to effect the recited claim steps and device functions. See *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S.Ct. 2347, 2350 (2014), quoting *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S.Ct. 1289, 2353 (2012).

\*3 Therefore, we do not sustain the Examiner's rejection under 35 U.S.C. §101 of claims 1-5 and 7-11.

#### *Anticipation*

*Independent claims 1, 7, 12, 17, and 18, and dependent claims 2-4, 6, 8-10, and 13-15*

We are persuaded by Appellant's argument that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 102(e) because Barta does not disclose "a provider of a presence service creating a presentity for an issue or a transaction," as recited in claim 1. App. Br. 9-10; *see also* Reply Br. 5-6.

The Examiner maintains that the rejection of claim 1 as anticipated by Barta is proper, and cites paragraph 8 and Figures 4A, 6, and 7 of Barta as disclosing the argued limitation (i.e., a provider of a presence service creating a presentity for an issue or a transaction). Ans. 5-6. The Examiner explains that the claimed "presence service" corresponds to a package tracking service as disclosed in Barta, and the claimed "presentity" corresponds to an order pick-up notice as disclosed in Barta. Ans. 13. We disagree.

In our view, a person of ordinary skill in the art would understand from the claim language and the Specification that the term "presence service" does not constitute any service provided by a company concerning a state of a transaction, as the Examiner proposes, but instead requires a service that implements presence technology. We have carefully reviewed the cited portions of Barta, yet find nothing that teaches or suggests a presence service. Rather, the cited portions only disclose a pick-up notice left by a delivery service at a pick-up location.

Accordingly, we do not sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 102(e). For the same reasons, we also do not sustain the Examiner's rejection of claims 2-4 and 6, which depend from claim 1.

Independent claims 7, 12, 17, and 18 include language substantially similar to the language of claim 1. Therefore, we do not sustain the Examiner's rejection under 35 U.S.C. § 102(e) of claims 7, 12, 17, and 18 for the same reasons set forth above with respect to claim 1. We also do not sustain the rejection under 35 U.S.C. § 102(e) of claims 8-10 and 13-15, which depend from claims 7 and 12, respectively.

*Dependent claims 5, 11, and 16*

Each of claims 5, 11, and 16 depends indirectly from claims 1, 7, and 12. The Examiner's further findings with respect to the Barta reference do not cure the deficiency in the Examiner's rejection of the independent claims, as described above. Therefore, we do not sustain the Examiner's rejections of claims 5, 11, and 16 under 35 U.S.C. § 103(a).

#### DECISION

The Examiner's rejection of claims 1-5 and 7-11 under 35 U.S.C. §101 is reversed.

\*4 The Examiner's rejection of claims 1-4, 6-10, 12-15, 17, and 18 under 35 U.S.C. § 102(e) is reversed.

The Examiner's rejection of claims 5, 11, and 16 under 35 U.S.C. § 103(a) is reversed.

#### REVERSED

Footnotes

- 1 Our decision references Appellant's Appeal Brief ("App. Br.," filed May 10, 2012) and Reply Brief ("Reply Br.," filed Sept. 6, 2012), and the Examiner's Answer ("Ans.," mailed July 6, 2012).
- 2 Appellant identifies Avaya, Inc. as the real party in interest. App. Br. 1. However, the USPTO assignment records further show two security agreements by assignors Avaya, Inc., Avaya Technology LLC, Octel Communications LLC, and VPNet Technologies, Inc. to assignee Citicorp USA, Inc. and three security agreements by Avaya, Inc. to The Bank of New York Mellon Trust Company, N.A.  
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