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EXAMINER

SEREBOFF, NEAL

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PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SUMATHI PATURU

Appeal 2012-006892
Application 10/461,603¹
Technology Center 3600

Before: HUBERT C. LORIN, JOSEPH A. FISCHETTI, and
JAMES A. WORTH, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's Final rejection of claims 26–33 and 35–44. Claims 1–25 and 34 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

¹ Appellant identify Dr. Sumanthi Paturu, MBBS, MD., as the real party in interest. App. Br. 4.

Claim 26 reproduced below, is representative of the subject matter on appeal.

An embodiment of invention directed to an innovative model of file encompassing a method of diligent implementation of scheduling, filing, and tracking of anyone of periodically administered PAPANICOLAOU (PAP) testing, the test being a means of studying uterine cervical cytology as diagnostic/preventive screening, intended for early detection/subsequent follow up surveillance of eligible average or high risk, symptomatic or asymptomatic female population in all ambulatory primary care clinics, the invention carried out by means of a manually operable paper file, individually made or manufactured, having measures for methods involving -

(a) initiating the logging of targeted patient pool into the said paper filing,

(b) periodically scheduling targeted patients for screening, subject to built in automated tracking system involving to no extra efforts.

THE REJECTION

The following rejections are before us for review.

Claims 26–33 and 35–45 are rejected under 35 U.S.C. § 101.²

² The Examiner has withdrawn the rejection of claims 26–33 and 35–45 under 35 USC § 112 second paragraph. (Answer 7).

ANALYSIS

35 U.S.C. § 101 REJECTION

We will affirm the rejection of claims 26–33 and 35–45 under 35 U.S.C. § 101.

Appellant argues that,

Examiner had not defined what involves a “sufficient recitation of machine.[”] The [Appellant’s] question is - how a machine / object / article (in this situation the model file, a prior art of utility patent, without dispute) can insufficiently exist? The point is – ‘either it exists or not’ as a machine (an ‘object’ or ‘article’ that is particular).

(App. Br. 28).

We are not persuaded by Appellant’s arguments here because there is no requirement for the Examiner to define a “sufficient recitation of machine”. Rather, we look to the record to determine whether the Examiner made findings sufficient to established a prima facie case to reject the involved claims under 35 U.S.C. § 101. We find here that the Examiner has done so correctly. Specifically, the Examiner uses Appellant’s own claim limitation(s) to support the 35 U.S.C. § 101 rejection. In particular, the Examiner cites to Appellant’s claim recitation of: “the invention is carried out by means of a manually operable paper file, individually made or manufactured having measures for methods involving.” (Answer 7). Thus, the claims make clear that the significant functions of the claims are accomplished through manual operations.

[The Supreme Court] set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First . . . determine whether the claims at

issue are directed to one of those patent-ineligible concepts [] If so, we then ask, “[w]hat else is there in the claims” To answer that question, [] consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. [The Court] described step two of this analysis as a search for an “‘inventive concept’”—*i.e.*, an element or combination of elements that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.”

Alice Corp. Pty. Ltd. v CLS Bank Intl., 134 S.Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S.Ct. 1289–97 (2012)). We must first determine whether the claims at issue are directed to a patent-ineligible concept. We conclude that they are. The claims before us are drawn to the abstract idea of logging names into a paper file and periodically scheduling targeted names for screening. It follows from our prior cases, and *Bilski* in particular, that the claims at issue here are directed to an abstract idea. On its face, the claims before us are drawn to the concept of scheduling appointments from names in a log based on preset criteria. Like the risk hedging in *Bilski*, the concept of scheduling appointments based on preset criteria of names of people on a list who need appointments for follow up attention is fundamental to our human thought process. Thus, the idea of scheduling appointments for people listed on paper for follow up attention, like hedging, is an “abstract idea” beyond the scope of § 101.

The Court found that it need not labor to delimit the precise contours of the “abstract ideas” category in a case such as this. It is enough to recognize that there is no meaningful distinction between the conceptual

abstraction of risk hedging in *Bilski* and the concept of using a paper file to note who needs follow up attention, here. Both are squarely within the realm of “abstract ideas” as the Court has used that term. *See Alice Corp.*

We find also that the mere addition of having a computer perform certain steps as recited, e.g., in claim 29, does not add any meaningful limitation beyond generally linking the abstract method to a general purpose computer. Here the computer contribution merely is one which provides only a general target list from which the appointments are scheduled without automation. *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). Adding a nominal recitation of a computer to a claim covering an abstract concept is insufficient to make a claim patent eligible. *See Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Canada (U.S.)*, 687 F.3d 1266, 1278 (Fed. Circ. 2012). *See also Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012) (a claim cannot simply state the abstract idea and add the words “apply it.”).

Under our precedents, this is not enough to transform an abstract idea into patent-eligible subject matter.

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Application 10/461,603

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 26–33 and 35–45 under § 35 U.S.C. § 35 U.S.C. § 101.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

DECISION

AFFIRMED

rvb