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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID A. WALL

Appeal 2014-005276
Application 13/035,030
Technology Center 3600

Before JOSEPH A. FISCHETTI, BIBHU R. MOHANTY, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1–22 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

THE INVENTION

The Appellants' claimed invention is directed to administering medical digital images in a distributed medical digital image computing environment (Spec. 1, lines 12–14). Claim 1, reproduced below with the numbering in brackets added, is representative of the subject matter on appeal.

1. A method of administering medical digital images in a distributed medical digital image computing environment, the method comprising:

[1] receiving a request for an image processing transaction to process the medical digital image, the request containing a medical image to be processed, metadata describing the medical image, and a type of service request for the image;

[2] storing the medical image in one or more of the medical image caches;

[3] creating, in dependence upon transaction parsing rules and the contents of the request, a medical image business object representing the image processing transaction;

[4] wherein the medical image business object also includes a ticket to access the medical image in the cache and wherein the ticket includes a symbolic representation of the location of the medical image in the cache, the symbolic representation including the location of the medical image in the cache, an identification of a protocol to be used to access the medical image, and an identification of a type of storage upon which the cache is implemented;

[5] selecting, in dependence upon workflow selection rules and the attributes of the medical image business object, one or more clinical workflows to process the medical image; and

[6] processing the medical image of the request with the clinical workflows, thereby creating a resultant business object and resultant medical image including accessing the medical image in the cache using the ticket.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 1–12 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
2. Claims 1, 7, 13, and 18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Falchuk et al. (US 6,256,613 B1, issued July 3, 2001), Konig (US 2007/0192408 A1, published Aug. 16, 2007), and Appellants admission of the prior art.
3. Claims 2–6, 8–12, 14–17, and 19–22 are rejected under 35 U.S.C. § 103(a) as unpatentable over Falchuk, Konig, Appellants admission of the prior art, and Official Notice.
4. Claims 1, 7, 13, and 18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Falchuk, Konig, and Dinh et al. (US 2005/0028079 A1, published Feb. 3, 2005).
5. Claims 2–6, 8–12, 14–17, and 19–22 are rejected under 35 U.S.C. § 103(a) as unpatentable over Falchuk, Konig, Dinh, and Official Notice.

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence¹.

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

ANALYSIS

Rejection under 35 U.S.C. § 101

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In judging whether claim 1 falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. If so, we then consider the elements of the claim both individually and as “an ordered combination” to determine assess whether the additional elements “transform the nature of the claim” into a patent-eligible application of the abstract idea. *Id.* This is a search for an “inventive concept” an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.* The Court also stated that “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention”. *Id.* at 2358.

Here, we find that the claim is directed to the concept of storing and retrieving data, which in this case, are images. This is a fundamental economic practice long prevalent in our system of commerce, and is an abstract idea beyond the scope of § 101. Many long prevalent economic

practices have stored data and images and retrieved them when needed. The process is directed to the abstract idea of merely storing data and creating a way to retrieve it.

We next consider whether additional elements transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the abstract idea using generic computer components. We conclude that it does not.

Appellant argues that the claims recite a distributed medical digital image computing environment and medical image caches, which are both computer hardware machinery (Appeal Br. 7–8). However, considering each of the claim elements in turn, the function performed in the computer environment at each step of the process is purely conventional. Each step of the claimed method does no more than require a generic computer to perform a generic computer function. For these reasons this rejection of claim 1 and its dependent claims is sustained. Claim 7 contains similar subject matter and the rejection of this claim and its dependent claims is sustained as well.

Rejection under 35 U.S.C. § 103(a)

The Appellant argues that the rejection of claim 1 under 35 U.S.C. § 103(a) under Falchuk, Konig, and the Appellant's admission of prior art is improper because the cited prior art fails to disclose or render obvious claim limitation [4], as listed in the claims above (Appeal Br. 8–11).

In contrast, the Examiner has determined that the cited claim limitation is found in Falchuk at column 4, lines 36–52, and that the cited combination would have been obvious (Final Rej. 5; Ans. 3, 4).

We agree with the Appellant. Claim limitation [4] requires:

[4] wherein the *medical image business object* also includes a ticket to access the medical image in the cache and wherein the *ticket includes a symbolic representation* of the location of the medical image in the cache, the *symbolic representation including* the location of the medical image in the cache, *an identification of a protocol to be used to access the medical image*, and *an identification of a type of storage upon which the cache is implemented*.

(Claim 1, emphasis added). Here, the citation to Falchuk at col. 4, lines 36–42 fails to specifically disclose the entirety of the cited claim limitation. The Examiner has determined that the claimed “medical image business object” is shown by Falchuk’s “case file history” and that “ticket” is disclosed by the “pointer” to the database (Ans. 3, 4). However, the above cited recitation in the claim also requires the ticket, which includes the symbolic representation, to include also the “identification of a protocol to be used to access the medical image” and an “identification of the type of storage upon which the cache is implemented.” Here, there is no specific disclosure that those elements are specifically in the pointer of Falchuk. Further, the rationale for further modifying the teachings of Falchuk including the data pointer of the database in the manner by Konig and the citation to Appellant’s disclosure claimed lacks articulated reasoning with rational underpinnings without impermissible hindsight. Therefore, the rejection of claim 1 under Falchuk, Konig, and the Appellant’s disclosure is not sustained.

Claim 1 has also been rejected under 35 U.S.C. § 103(a) under Falchuk, Konig, and Dinh (Final Rej. 9–12). In order to meet the requirements of the same cited claim limitation above, this rejection also cites to Dinh at paragraph 68 as disclosing a symbolic representation in a hyperlink, and sets forth that the cited combination would have been obvious in order to allow for effective processing (Final Rej. 12). We have reviewed this rejection and determine that the rationale for modifying Falchuk including the data pointer of the database in the manner by Konig and Dinh also lacks articulated reasoning with rational underpinnings without impermissible hindsight. The remaining claims contain a similar limitation and the rejection of these claims is not sustained for the same reasons given above. For this reason, the rejection of claim 1 under Falchuk, Konig, and Dinh is also not sustained.

The remaining claims contain limitations similar to those addressed above, and the rejection of those claims is not sustained for the same reasons given above.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 101 as listed in the Rejections section above.

We conclude that Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a) as listed in the Rejections section above.

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DECISION

The Examiner's rejection of claims 1–12 is sustained. The Examiner's rejection of claims 13–22 is reversed.

AFFIRMED-IN-PART