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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EDWARD K.Y. JUNG,
ROYCE A. LEVIEN,
ROBERT W. LORD,
MARK A. MALAMUD,
JOHN D. RINALDO JR.,
and LOWELL L. WOOD JR.

Appeal 2014-005401
Application 11/314,949
Technology Center 3600

Before ANTON W. FETTING, JAMES A. WORTH, and BRUCE T. WIEDER, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE[1]

Edward K.Y. Jung, Royce A. Levien, Robert W. Lord, Mark A. Malamud, John D. Rinaldo Jr., and Lowell L. Wood Jr. (Appellants) seek

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[1] Our decision will make reference to the Appellants' Appeal Brief ("Br.," filed November 27, 2013) and the Examiner's Answer ("Ans.," mailed January 31, 2014), and Final Action ("Final Act.," mailed August 27, 2013).

review under 35 U.S.C. § 134 of a final rejection of claims 1, 32, 34, 36, 39–41, 43–52, 54–56, 59–62, 64 and 71–73, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

The Appellants invented a characterization tag associated with one or more health regimen data entities. Specification 3:6–8.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below (bracketed matter and some paragraphing added).

> 1. A method at least partially implemented using one or more processing components, the method comprising:
>
> [1] accepting information related to a characterization tag,
>
> the characterization tag associated with one or more health regimen data entities identifying at least one substance,
>
> the information characterizing the one or more health regimen data entities;
>
> [2] adding the information to the characterization tag

The Examiner relies upon the following prior art:

Epstein	US 2002/0049738 A1	Apr. 25, 2002
Goldenberg	US 2002/0065682 A1	May 30, 2002
Weiner	US 2006/0136259 A1	Jun. 22, 2006

Claim 1 stands rejected under 35 U.S.C. § 101 as directed to non–statutory subject matter.

Claims 1, 32, 34, 36, 39–41, 43–51, 54–56, 59–62, 64, and 71–73 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Goldenberg and Weiner.

Claim 52 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Goldenberg, Weiner, and Epstein.

ISSUES

The issues of eligible subject matter turn primarily on whether accepting data and adding it to data is an abstract idea. The issues of obviousness turn primarily on whether accepting data and adding it to data was known to be in the prior art.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure contains no lexicographic definition of "characterization tag."

Facts Related to Appellants' Disclosure

02. A characterization tag is something that can be stored on and deleted from a computer in the disclosed embodiments. Spec. 17–18.

Facts Related to the Prior Art

Goldenberg

03. Goldenberg is directed to the accessing of medical information. Goldenberg para. 2.

04. Goldenberg allows the processor to transmit an inquiry to the user asking for the desired level of sophistication. The system may transmit this information in any suitable form, for example, by requesting information about the user's level of education or by using a sliding scale reflecting the sophistication of the information to be transmitted. If the system is programmed to transmit such an inquiry, then the response is received. Goldenberg para. 46.

05. A monitoring device or monitoring equipment may communicate the patient's body functions or chemistry to a central monitoring system. The information can be used for diagnostic and therapeutic purposes. A treatment signal can control a device or equipment which is connected to the patient. A treatment can include effecting a change in body function or chemistry, such as by administering a drug or impulse, and it can include performing a test of the body, such as a blood test. The device may be remotely-controlled or the practitioner can transmit control information to the patient, or another individual, who would then have to control the equipment. The device may deliver a treatment using myriad methods. For example, it may stimulate

the patient with an electrical or other impulse, or it may release a chemical or drug. Goldenberg para. 62.

Weiner

06. Weiner is directed to techniques for computer-assisted definition of relevant domains and to the automated classification of documents and other data entities based upon such definitions. Weiner para. 2.

07. Weiner may be used to identify and analyze structured data entities 28 or unstructured entities. Structured data entities may include such structured data as bibliography content, pre-identified fields, tags. Weiner para. 46.

08. Weiner's entities are selected for inclusion in the integrated knowledge base (IKB), but additional data, such as indexing where performed, analysis, tagging, and so forth accompany the entities to permit and facilitate their further analysis, representation, selection, searching, and so forth. Weiner para. 46.

09. Depending upon the information of interest, the analysis and presentation techniques Weiner describes may be employed, and adapted to the particular type of entity. For example, a text document such as a patient record, laboratory results, physician annotation, medical article, and so forth may be displayed in a highlight view with certain pertinent words or phrases highlighted. Weiner para. 116.

10. The data entities identified, classified, and analyzed may originate from various types of resources, such as data resources and controllable and prescribable resources. Controllable and prescribable resources may include various laboratory, imaging, clinical examination and other resources available for collecting information from patients. Weiner para. 118.

11. The data resources may include databases such as pathology databases. Such databases may be widely ranging in nature, such as databases of reference materials characterizing populations, medical events and states, treatments, diagnosis and prognosis characterizations, and so forth. Weiner para. 120.

12. The resource data may also be population-specific so as to permit analysis of specific patient risks and conditions based upon comparisons to known population characteristics. Weiner para. 123.

ANALYSIS

Claim 1 rejected under 35 U.S.C. § 101 as directed to non–statutory subject matter

To understand the nature of the claimed subject matter, one must first understand that a characterization tag is not a physical tag like a dog tag. Instead, it is a piece of data. FF 01–02. Thus independent claim 1 adds data to an item of data.

The Examiner finds the claims are drawn to an abstract idea. Final Act. 3–4. We are not persuaded by Appellants' argument that the recital of processing components is sufficient to show claim 1 is directed to more than the abstract idea of adding data to data. App. Br. 12.

> the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea "while adding the words 'apply it'" is not enough for patent eligibility. Nor is limiting the use of an abstract idea "'to a particular technological environment.'" Stating an abstract idea while adding the words "apply it with a computer" simply combines those two steps, with the same deficient result. Thus, if a patent's recitation of a computer amounts to a mere instruction to "implemen[t]" an abstract idea "on . . . a computer," that addition cannot impart patent eligibility. This conclusion accords with the pre-emption concern that undergirds our §101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of "additional featur[e]" that provides any "practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself."

Alice Corp., Pty. Ltd. v CLS Bank Intl, 134 S.Ct. 2347, 2358 (2014) (citations omitted).

Claims 1, 32, 34, 36, 39–41, 43–51, 54–56, 59–62, 64, and 71–73 rejected under 35 U.S.C. § 103(a) as unpatentable over Goldenberg and Weiner

Independent claims 1, 32, 34, and 36 are similar in terms of the substantive limitations and differ only in their characterization of the category of patentable subject matter they are directed to. All four claims accept information and add the information to a characterization tag.

Appellants' arguments go to the nature of the information so added. App. Br. 13–20 and 54–78.

Claims 32, 34, and 36 are apparatus claims with two recited parts, viz. something to accept information and something to add that information to a tag. Although all of these parts are labeled as circuitry, interface device, processing component, and media, the claim does not recite any manner in which these words affect the structure or function of the parts.

As to structural inventions, such claims must be distinguished from the prior art in terms of structure rather than function, *see, e.g.*, *In re Schreiber*, 128 F.3d 1473, 1477–78 (Fed. Cir. 1997). In order to satisfy the functional limitations in an apparatus claim, however, the prior art apparatus as disclosed must be capable of performing the claimed function. *Id.* at 1478. When the functional language is associated with programming or some other structure required to perform the function, that programming or structure must be present in order to meet the claim limitation. *Typhoon Touch Techs., Inc. v. Dell, Inc.*, 659 F.3d 1376, 1380 (Fed. Cir. 2011) (discussing *Microprocessor Enhancement Corp. v. Texas Instruments, Inc.*, 520 F.3d 1367 (Fed. Cir. 2008)). In some circumstances generic structural disclosures may be sufficient to meet the functional requirements, *see Ergo Licensing, LLC v. CareFusion 303, Inc.*, 673 F.3d 1361, 1364 (Fed. Cir. 2012) (citing *Telcordia Techs., Inc. v. Cisco Sys., Inc.*, 612 F.3d 1365, 1376–77 (Fed. Cir. 2010)).

Also, a structural invention is not distinguished by the work product it operates upon, such as data in a computer. "[E]xpressions relating the apparatus to contents thereof during an intended operation are of no

significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Otto*, 312 F.2d 937, 940 (CCPA 1963).

Claim 1 recites two steps, viz., accepting information X and adding that information to Y, where X is labeled as information related to a characterization tag, the characterization tag associated with one or more health regimen data entities identifying at least one substance, the information characterizing the one or more health regimen data entities, and Y is labeled as a characterization tag. Thus the claim is drawn to accepting data and adding it to data. Nothing in the claim depends on or enforces the perceptual labels the claim suggests. Mental perceptions of what data represents are non–functional and given no weight. *King Pharm., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1279 (Fed. Cir. 2010) ("[T]he relevant question is whether 'there exists any new and unobvious functional relationship between the printed matter and the substrate.'") (citations omitted). *See also In re Lowry*, 32 F.3d 1579, 1583 (Fed.Cir.1994) (describing printed matter as "useful and intelligible only to the human mind") (quoting *In re Bernhart*, 417 F.2d 1395, 1399 (CCPA 1969)). Data labels are just examples of such mental perceptions. Data, being a succession of binary digits, are just those digits, not perceptual labels of those digits. The binary digits may impose some functional consequence, but absent some recitation of how so, such consequence is not an issue.

As to structural claims 32, 34, and 36, any generic computer has the capacity to accept data and add it to other data by virtue of the operating

system support for such primitive operations. As to method claim 1 and the structural claims, again no patentable weight is afforded the mental perceptions attributed to data absent some recited limitations enforcing such perceptions.

But even were we to attribute patentable weight, as the Examiner did, Goldenberg describes accepting information related to the characterization of a medical regimen using a device that delivers substances such as drugs and Weiner describes the virtues of creating indexing tags that characterize the nature of the data so indexed in the context of medical delivery.

The limitation at issue is "information related to a characterization tag, the characterization tag associated with one or more health regimen data entities identifying at least one substance, the information characterizing the one or more health regimen data entities." The manner, implementation, and degree of such relation, association, identification, and characterization are neither recited nor narrowed. Clearly information that is related to the index to that information is related to that index and the index is associated with the information so indexed. As Goldenberg extends the idea of such index tagging to medical regimens and Weiner shows that such regimens would include drug delivery by medical devices, such a drug would be a substance characterizing the regimen. It is the health regimen data entities that identify a substance, not the tag. The regimen for delivering a drug would inherently, not to say tautologically, identify the drug so delivered.

Separately argued claims 71–73 depend from structural claim 32 and recite additional data about personal experience related to a personal notes tag being accepted and added to a tag. Again, structural claims are defined

by their structure, not their result or data operated upon, and any generic computer has the capacity to so accept and add data. Further, as the Examiner found, even granting weight to the data so recited, Goldenberg describes patients adding information to the system, which would be at least in that sense, be personal to the patient.

Claim 52 rejected under 35 U.S.C. § 103(a) as unpatentable over Goldenberg, Weiner, and Epstein

Appellants do not separately argue this rejection.

CONCLUSIONS OF LAW

The rejection of claim 1 under 35 U.S.C. § 101 as directed to non–statutory subject matter is proper.

The rejection of claims 1, 32, 34, 36, 39–41, 43–51, 54–56, 59–62, 64, and 71–73 under 35 U.S.C. § 103(a) as unpatentable over Goldenberg and Weiner is proper.

The rejection of claim 52 under 35 U.S.C. § 103(a) as unpatentable over Goldenberg, Weiner, and Epstein is proper.

DECISION

The rejection of claims 1, 32, 34, 36, 39–41, 43–52, 54–56, 59–62, 64, and 71–73 is affirmed.

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) (2011).

AFFIRMED