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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PETER L. HAGELSTEIN, RODERICK A. HYDE,
MURIEL Y. ISHIKAWA, JORDIN T. KARE,
LOWELL L. WOOD JR., and
VICTORIA Y.H. WOOD

Appeal 2015-007625
Application 13/550,816
Technology Center 3600

Before MURRIEL E. CRAWFORD, BIBHU R. MOHANTY, and MATTHEW S. MEYERS, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 3–7, 9, 11, 15–19, 22, 24–28, 32, 34–39, 50–53, 55–58, 61–62, 67–70, 75–80, 82, and 83 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 collecting insurance related information (Spec. 1, lines 8–10). Claim 1, reproduced below, is representative of the subject matter on appeal.

> 1. A data acquisition apparatus for collecting insurance-related information, comprising:
>
> memory including personal identification information stored thereon, wherein the personal identification information is associated with insurance of an insurance policyholder;
>
> a data acquisition unit configured to acquire environmental data associated with at least one environmental condition to which the insurance policyholder is exposed, the data acquisition unit operably coupled to the memory, the memory being configured to store the acquired environmental data thereon; and
>
> at least one processor having access to the memory, the at least one processor configured to instruct a data transmitter to transmit one or more data signals from the insurance policyholder, wherein the one or more data signals encode the personal identification information and information related to at least part of the acquired environmental data; and
>
> a biocompatible packaging enclosing the memory, the data acquisition unit, and the at least one processor, the biocompatible packaging being configured to be implanted into the insurance policyholder, or provisions configured to temporarily attach the memory, the data acquisition unit, and the at least one processor of the data acquisition apparatus to the insurance policyholder.

THE REJECTIONS

The following rejections are before us for review[1]:

1. Claims 67–70, 75–80, 82, and 83 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

2. Claims 1, 3–7, 9, 11, 15–19, 22, 24–28, 32, 34–39, 50–53, 55-58, 61–62, 67–70, 75–80, 82, and 83 are rejected under 35 U.S.C. § 103(a) as unpatentable over Joao (US 2001/0032099 A1, published Oct. 18, 2001), Lane et al. (US 2006/0155589 A1, published July 13, 2006), and Campbell et al. (US 2012/0068848 A1, published Mar. 22, 2012) [2].

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 evidence[3].

ANALYSIS

Rejection under 35 U.S.C. § 101

The Examiner made a rejection of claims under 67–70, 75–80, 82, and 83 under 35 U.S.C. § 101 (Ans. 4–6).

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[1] The Answer at page 3 and Final Rejection at pages 13 and 14 includes a rejection on the grounds of nonstatutory double patenting in reference to Patent Application No. 13/494, 190. This application was abandoned on Dec. 23, 2015. Accordingly, this rejection is considered withdrawn.

[2] This rejection is taken as being listed on page 8 of Answer. We note that the rejection listed at page 16 of the Final Rejection mailed April 8, 2014 lists slightly different claim numbers but this is considered to be a typographical error.

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

The Appellants have not provided any arguments in response to this rejection. Accordingly, this rejection is summarily affirmed.

Rejection under 35 U.S.C. § 103(a)

The Appellants argue that the rejection of claim 1 is improper because the rejection fails to disclose the claim limitation requiring

> a data acquisition unit configured to acquire environmental data associated with at least one environmental condition to which the insurance policyholder is exposed.

(App. Br. 10–21). The Appellants also argue that the no proper rationale has been provided for the cited combination (App. Br. 21–24).

In contrast, the Examiner has determined that the prior art discloses the cited claim limitation by Campbell at paras. 2, 31, 32, 34, 35, 36, 56, 72, 102; and Joao at paras. 34, 62, 83, 119, 120, 123, 151, 174, and 175 (Ans. 15–18). The Examiner has also determined that the references are properly combined (Ans. 18, 19, Final Rej. 16–20).

We agree with the Examiner. Here, Campbell at para. 36 for instance discloses the use of a remote environmental sensors including temperature, relative humidity, light, carbon dioxide, carbon monoxide, smoke, and biohazard sensors. Campbell at para. 32 discloses measuring environmental data as well. Joao at para. 34 discloses using information deemed essential to an individual's healthcare analysis. Thus, the cited prior art has disclosed the elements of the argued claim limitation.

The Appellants have also argued that the combination of references is improper for failing to provide a proper rationale (App. Br. 21–24). We have considered but are not persuaded by this argument and instead agree

with and adopt the Examiner's rationale for the cited combination being obvious as found in the Final Rejection at pages 16–20.

With regard to claim 7, the Appellants argue that the cited prior art fails to disclose "determining the information related to the at least part of the acquired environmental data is the type of data specified by the insurer" (App. Br. 25, 26).

In contrast, the Examiner has determined that the claim limitation is shown by Campbell at Fig. 8, and paras. 8, 83–86, and 106 (Ans. 19–22, Final Rej. 21, 22).

We agree with the Appellants in regard to claim 7. For example, Campbell at para. 8 discloses that the environmental sensor may include a "threshold value" but it is not specifically disclosed that this is "specified by the insurer" as claimed at this citation, or the other citations in rejection of record as well. For this reason, this rejection is not sustained.

The Appellants have provided essentially the same arguments for independent claims 22, 50, 67, and 79, which contain a limitation similar to that addressed above, as well as the remaining dependent claims not specifically argued. The rejection of these claims is affirmed for the same reasons as given above for claim 1.

CONCLUSIONS OF LAW

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

We conclude that Appellants have not shown that the Examiner erred in rejecting the claims 1, 3–6, 7, 9, 11, 15–19, 22, 24–28, 32, 34–39, 50–53, 55–58, 61–62, 67–70, 75–80, 82, and 83 under 35 U.S.C. § 103(a).

We conclude that Appellants have shown that the Examiner erred in rejecting the claim 7 under 35 U.S.C. § 103(a).

DECISION

The Examiner's rejection of claims 1, 3–6, 9, 11, 15–19, 22, 24–28, 32, 34–39, 50–53, 55–58, 61–62, 67–70, 75–80, 82, and 83 is sustained.

The Examiner's rejection of claim 7 is not sustained.

AFFIRMED-IN-PART