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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL F. ROIZEN, MEHMET C. OZ,
and JEFFREY D. ROIZEN

Appeal 2016-001648
Application 12/649,661[1]
Technology Center 2600

Before, JOSEPH A. FISCHETTI, PHILIP J. HOFFMANN, and MATTHEW S. MEYERS, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1, 3, 5–11, 14–26, 28, and 30–46. We have jurisdiction under 35 U.S.C. § 6(b).

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[1] Appellants identify The Cleveland Clinic Foundation as the real party in interest. Appeal Br. 3.

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants' claims relate "generally to systems and methods for personalized yet automated or semi-automated coaching using rules to help a client reach one or more goals." (Spec. 1).

Claim 33 reproduced below, is representative of the subject matter on appeal.

33. A non-transitory machine readable medium having instructions executable by a processor and programmed to provide an automated coaching system, the instructions comprising:

a tracking system programmed to receive client data indicative of at least one client condition relevant to a coaching plan designed for a given client, the coaching plan including a plurality of stages to occur over a time period, the tracking system being programmed, in response to the given client failing to meet at least one goal defined by a current stage of the plan, to reset the plan back to another stage of the plurality of stages;

a rules system programmed to process progress data, which is derived at least in part from the client data, relative to a rule set established for the given client and the current stage of the plan to determine an indication of progress for the given client relative to the coaching plan;

profile data identifying at least one characteristic of the given client, the rule set being established for the given client based on the profile data, the rule system being programmed to select another rule set in response to determining a change in personality profile of the given client based on analysis of the client data;

a response generator that automatically generates a message for the given client, the message having content that varies depending on the indication of progress determined for the given client relative to the coaching plan, the response generator selecting the message from a subset of preselected messages for the given client based on the indication of progress,

the subset of preselected messages being preselected for the given client from a plurality of available sets of predefined messages based on the profile data; and

a coaching user interface programmed to enable a coach to approve and selectively modify the content of the message that has been generated for the given client, the message for the given client being transmitted in response to a user input via the coaching user interface.

THE REJECTION

The following rejection is before us for review.

Claims 1, 3, 5–11, 14–26, 28, and 30–46 are rejected under 35 U.S.C. § 101.

ANALYSIS 35 U.S.C. § 101 REJECTION

We will sustain the rejection of claims 1, 3, 5–11, 14–26, 28, and 30–46 under 35 U.S.C. § 101.

The Appellants argued claims 1 and 33 as a group (Appeal Br. 6–10). We select claim 33 as the representative claim for this group, and the remaining independent claim standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2015).

Claim 33 recites, in pertinent part, *viz*.

> a tracking system to receive client data indicative of at least one client condition relevant to a coaching plan designed for a given client, the coaching plan including a plurality of stages to occur over a time period, the tracking system being programmed, in response to the given client failing

to meet at least one goal defined by a current stage of the plan, to reset the plan back to another stage of the plurality of stages;

a rules system to process progress data, which is derived at least in part from the client data, relative to a rule set established for the given client and the current stage of the plan to determine an indication of progress for the given client relative to the coaching plan;

profile data identifying at least one characteristic of the given client, the rule set being established for the given client based on the profile data, the rule system being programmed to select another rule set in response to determining a change in personality profile of the given client based on analysis of the client data;

a response generator that automatically generates a message for the given client, the message having content that varies depending on the indication of progress determined for the given client relative to the coaching plan, the response generator selecting the message from a subset of preselected messages for the given client based on the indication of progress, the subset of preselected messages being preselected for the given client from a plurality of available sets of predefined messages based on the profile data; and

a coaching user interface to enable a coach to approve and selectively modify the content of the message that has been generated for the given client, the message for the given client being transmitted in response to a user input via the coaching user interface.

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 before us?" 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 Int'l, 134 S. Ct. 2347, 2355 (2014) (citations omitted) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012)).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

While the Court in *Alice* made a direct finding as to what the claims were directed to, we find that this case's claims themselves and the Specification provide enough information to inform one as to what they are directed to. The preamble to claim 33 recites that it provides a coaching system. The instructions or steps in claim 33 result in enabling a coach to approve and

selectively modify the content of a coaching message that has been generated for the given client. The Specification at paragraph 3 states:

> In the general sense, coaching is a method of directing, instructing, nudging and training a person or a group of people with the end to achieve some objective, goal or develop a special skill. The particular interaction between the coach and the individual being coached depends on a mutual respect and trust-relationship between the coach and the individual being coached. An important facet for the individual being coached is the end goal and the manner in which the coach interacts with the person by providing motivation and advice to assist the individual along a devised strategy to complete a series of short term goals or action plans intended advance the individual toward one or more final goal.

The Specification further describes, "not only does such coaching provide health education for the patient, but also provides motivation and encouragement to assist the individual patient in reaching his or her goals." Specification 2: ¶ 4. We find the notion of using a coach to interact with a person to provide motivation and advice to assist the individual along a devised strategy to complete a series of short term goals or action plans, is effectively directing and organizing human behavior to effect a desired result/goal. Thus, the claims are drawn to organizing how a person will behave to effect a devised strategy, and hence represents a method of organizing human behavior, which is not patentable subject matter. *See Alice*, 134 S. Ct. at 2355-56.

It follows from prior Supreme Court cases, and *Gottschalk v. Benson*, 409 U.S. 63 (1972) in particular, that the claims at issue here are directed to an abstract idea. Like the algorithm in *Gottschalk*, determining how a person will behave to effect a devised strategy is a mathematical algorithm that preempts all implementations and uses. Thus, organizing how a person will behave to effect a devised strategy is an "abstract idea" beyond the scope of § 101. *See Alice Corp. Pty. Ltd.* 134 S. Ct. at 2356.

As in *Alice Corp. Pty. Ltd.*, we need not labor to delimit the precise contours of the "abstract ideas" category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of performing a mathematical algorithm in *Gottschalk* and the concept of organizing how a person will behave to effect a devised strategy, at issue here. Both are squarely within the realm of "abstract ideas" as the Court has used that term. *See Alice Corp. Pty. Ltd.* 134 S. Ct. at 2357. That the claims do not preempt all forms of the abstraction or may be limited to the abstract idea in the wellness coaching, business or financial coaching, professional coaching, and life coaching settings (Specification 2: ¶ 7), do not make them any less abstract. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1360–1361 (Fed. Cir. 2015). Perhaps more to the point,

claim 33 does no more than offer advice on how to accomplish a goal. Advice, as such, is a disembodied concept that is the epitome of abstraction.

The introduction of a computer and /or computer readable media into the claims does not alter the analysis at Mayo step two.

> 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 "implement[t]" an abstract idea "on ... a computer," that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our § 101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of "additional feature[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., 134 S. Ct. at 2358 (alterations in original) (citations omitted).

"[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer." *Alice Corp. Pty. Ltd.,* 134 S. Ct. at 2359. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a

computer to take in data and compute a result from a database amounts to electronic data query and retrieval—one of the most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the industry. In short, each step does no more than require a generic computer to perform generic computer functions.

Considered as an ordered combination, the computer components of Appellants' method add nothing that is not already present when the steps are considered separately. Viewed as a whole, Appellants' claims simply recite the concept of using a coach to interact with a person to provide motivation and advice to assist the individual along a devised strategy to complete a series of short term goals or action plans, as performed by a generic computer. The claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of forming and giving advice using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp. Pty. Ltd.* 134 S. Ct. at 2360.

As to the structural claims, they

> are no different from the method claims in substance. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea. This Court

> has long "warn[ed] ... against" interpreting § 101 "in ways that make patent eligibility 'depend simply on the draftsman's art.'

Alice Corp. Pty. Ltd. 134 S. Ct. at 2360 (alterations in original).

That said, Appellants argue, "claims 1 and 33 solve the deficiencies in electronic coaching of tracking a client's progress and communicating based on the progress with a message based on the client's progress and data about the client." (Appeal Br. 8).

We disagree with Appellants because we do not agree that problem with tracking of a client progress and communicating are problems with a specific technology, such as 3-D animation techniques, but rather are problems related to socio-interactions. *See McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016) ("directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery").

Likewise, we further disagree with Appellants' argument (Appeal Br. 8) that "claims 1 and 33 are similar to claim 19 of U.S. Patent No. 7,818,399 …which the Court found to be patent eligible" in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), because in *DDR,* the court found claim 19 to be directed to a "claimed solution… necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks" id at 1258. No such computer technology problem resolution is present in the claims before us here.

CONCLUSION OF LAW

We conclude the Examiner did not err in rejecting claims 1, 3, 5–11, 14–26, 28, and 30–46 under 35 U.S.C. § 101.

DECISION

The decision of the Examiner to reject claims 1, 3, 5–11, 14–26, 28, and 30–46 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).

AFFIRMED.