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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAYMOND ANTHONY JOAO

Appeal 2016-002070[1]
Application 12/589,294
Technology Center 3600

Before JASON V. MORGAN, JON M. JURGOVAN, and AMBER L. HAGY, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant[2] appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 21–41, which are all of the pending claims.[3] We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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[1] Application Serial No. 11/978,366 is identified by Appellant as related (Br. 2), and is addressed in co-pending Appeal No. 2016-002062. In addition, Application Serial No. 11/978,461 is identified by Appellant in co-pending Appeal No. 2016-003277 as related to both the present appeal as well as Appeal No. 2016-002062.

[2] Appellant identifies the real party in interest as GTJ Ventures, LLC. (Br. 1.)

[3] Claims 1–20 have been canceled. (Br. 2.)

Introduction

According to Appellant, "[t]he present invention pertains to an apparatus and a method for processing and/or for providing healthcare information and/or healthcare-related information and, in particular, to an apparatus and a method for processing and/or for providing healthcare information and/or healthcare-related information for a variety of healthcare and healthcare related applications." (Spec. 1.)

Exemplary Claim

Claims 21, 22, and 41 are independent. Claim 21, reproduced below, is exemplary of the claimed subject matter:

> 21. An apparatus, comprising:
>
> a receiver, wherein the receiver receives information regarding an individual, wherein the information regarding an individual is transmitted from a first computer or from a first communication device, wherein the first computer or the first communication device is associated with a healthcare provider, wherein the information regarding an individual contains information regarding a symptom, an examination finding, a diagnosis, a treatment, an administration of a treatment, or a procedure;
>
> a database or a memory device, wherein the database or the memory device is associated with the receiver and is located at a location remote from the first computer or remote from the first communication device, wherein the database or the memory device stores information regarding a plurality of individuals, a plurality of healthcare providers, and at least one healthcare insurer or healthcare payer, and further wherein the information regarding a plurality of individuals, a plurality of healthcare providers, and at least one healthcare insurer or healthcare payer, includes a healthcare record or a healthcare history of, for, or associated with, each individual of a plurality of individuals, including a healthcare record or a healthcare history of, for, or

associated with, the individual, information regarding a healthcare practice of, and an insurance accepted by or a payer from whom payment will be accepted by, each of the plurality of healthcare providers, including information regarding a healthcare practice of, and an insurance accepted by or a payer from whom payment will be accepted by, the healthcare provider, information for processing or for storing information regarding a healthcare diagnosis or a healthcare treatment, and information for submitting an insurance claim or a claim for payment to a healthcare insurer or a healthcare payer associated with the individual; and

a processing device, wherein the processing device processes the information regarding an individual, and further wherein the processing device processes information for storing the information regarding an individual in the database or the memory device or for updating the healthcare record or the healthcare history of, for, or associated with, the individual, and further wherein the processing device automatically generates an insurance claim or a claim for payment in response to the storing of the information regarding an individual in the database or the memory device or the updating of the healthcare record or the healthcare history of, for, or associated with, the individual, wherein the insurance claim or the claim for payment is suitable for being automatically submitted to the healthcare insurer or the healthcare payer associated with the individual or is suitable for being automatically transmitted to a second computer or to a second communication device, wherein the second computer or the second communication device is associated with the healthcare insurer or the healthcare payer associated with the individual, and further wherein the processing device transmits the insurance claim or the claim for payment to the second computer or to the second communication device, wherein the apparatus stores information regarding the insurance claim or the claim for payment in the database or the memory device.

REJECTION

Claims 21–41 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter. (Final Act. 2–4.)

ANALYSIS

We have reviewed the Examiner's rejection in light of Appellant's arguments the Examiner has erred. We disagree with Appellant's conclusions and we adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken (Final Act. 2–4) and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellant's Appeal Brief. (Ans. 2–6.) We concur with the conclusions reached by the Examiner, and we highlight the following for emphasis.[4]

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).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1300 (2012), "for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim

[4] Only those arguments made by Appellant have been considered in this decision. Arguments Appellant did not make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2014).

patent-eligible applications of those concepts." *Alice Corp.*, 134 S. Ct. at 2355. The first step in that analysis is to "determine whether the claims at issue are directed to one of those patent-ineligible concepts," *id.*, e.g., to an abstract idea. If the claims are not directed to a patent-ineligible concept, the inquiry ends. Otherwise, the inquiry proceeds to the second step, where the elements of the claims are considered "individually and 'as an ordered combination'" to determine whether there are additional elements that "'transform the nature of the claim' into a patent-eligible application." *Alice Corp.*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1297).

The Court acknowledged in *Mayo* that "all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas." *Mayo*, 132 S. Ct. at 1293. We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

Here, in rejecting claims 21–41 under 35 U.S.C. § 101, the Examiner concludes the claims are directed "the abstract idea of creating and submitting a claim for payment," which the Examiner finds is "a fundamental economic practice and/or a method of organizing human activities." (Final Act. 2.) Appellant argues the Examiner's conclusions and findings are in error. In particular, with regard to independent claim 21, Appellant argues the claim is not directed to an abstract idea because it is "directed to an *apparatus or machine which provides an electronic healthcare record* which can provide up-to-date information to and for, any and/or all of an individual's or a patient's healthcare providers or healthcare

insurers . . . ." (Br. 23 (emphasis added).) Similarly, with regard to independent claims 22 and 41, Appellant argues the claims are not directed to an abstract idea because they are directed to a "*method or process for using an electronic healthcare record* to provide accessible, updatable, and up-to-date information to and for any and/or all of an individual's or a patient's healthcare providers or healthcare insurers . . . ." (Br. 32, 40–41 (emphasis added).) Appellant then emphasizes the problems that the claimed invention purportedly solves—namely, a patient's healthcare record being "incomplete, outdated, and/or . . . not readily made available" and "inefficiencies and delays associated with billing." (*Id.* at 24.)

We are not persuaded of error. The Examiner concludes, and we agree, each independent claim is "directed to a series of functions that define[] an abstract idea similar to using categories to organize, store, and transmit information and a fundamental economic practice which are concepts that have previously been found by the courts to be abstract." (Ans. 2, 4–5.) In particular, the Examiner concludes, and we agree, claim 21 "is directed to receiving information regarding an individual, storing information regarding an individual, provider, and payer, arranged according to various categories, using the stored information or updated information to generate an insurance claim, and transmitting the insurance claim." (*Id.* at 2.) The Examiner further concludes, and we agree, the recited functions "amount to an abstract idea of using health and insurance-related categories to organize health and insurance-related information, store information, and transmit information along with the fundamental economic practice of creating and submitting an insurance claim." (Ans. 2–3.)

The claims presented here are similar in that regard to those found by the Board, and affirmed by the Federal Circuit, to be directed to the "abstract idea of billing insurance companies and organizing patient health information" in *In re Salwan*, No. 2016-2079, 2017 WL 957239 *3 (Fed. Cir. Mar. 13, 2017) (nonprecedential). As the Federal Circuit recognized in *Salwan*, although the concepts recited in the claims may be "practical concepts," they are nevertheless "fundamental economic and conventional business practices," and thus are abstract ideas. *Id.*

Because we agree with the Examiner, at step one of the analysis, that the claims are directed to an abstract idea, we turn to the second step of the analysis, in which we must determine whether the additional elements of the claims transform them into patent-eligible subject matter. In that regard, Appellant argues the claims contain "an inventive concept" and are directed to "a special application" of the "identified abstract idea." (*E.g.*, Br. 25, 29.) As the Examiner notes, and we agree, Appellant merely argues that "the additional features recited in the claim amount to significantly more than the abstract idea." (Ans. 3.) Appellant does not, however, identify any particular feature, and we are not persuaded that any such feature is recited. We additionally note the Supreme Court has rejected the notion that "'implement[ing] a principle in some specific fashion' will 'automatically fal[l] within the patentable subject matter of § 101.'" *Alice*, 134 S. Ct. at 2358 (alterations in original) (citation omitted). Here, the Examiner finds, and we agree:

> [T]he additional features recited in [claim 21] are not sufficient to amount to significantly more than the judicial exception because the additional features amount to no more than generic computer components that serve to merely link the abstract idea

> to a particular technological environment (i.e. a receiver, a computer or communication device, a database or memory device, and a processing device) performing routine and conventional activities that are well-understood in the health and insurance industries (i.e. receiving information from a computer or communication device, storing information in a database or memory device, arranging information, and transmitting information).

(Ans. 3; *see also* Final Act. 2–4.) The Examiner makes similar findings as to independent claims 22 and 41. (Ans. 4–6.) In addition, as the Examiner also finds, and we agree, Appellant's Specification "describes conventional computer hardware for implementing the above described functions including 'a central computer or central processing computer system which can be a network or server computer.'" (*Id.* at 3 (citing Spec. 5:1–2).) We, therefore, are not persuaded the Examiner erred in concluding the claims "do[] not recite additional elements that amount to significantly more than the abstract idea." (*Id.* at 3.)

Finally, we are not persuaded of Examiner error by Appellant's argument that the "the issuance of a patent for Claim 21 would not preempt, or monopolize, the identified abstract idea or the field of the identified abstract idea." (Br. 29.) Appellant makes similar arguments for independent claims 22 and 41. (Br. 38, 46–47.) We agree the Supreme Court has described "the concern that drives this exclusionary principle [i.e., the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption." *Alice*, 134 S. Ct. at 2354. But characterizing pre-emption as a driving concern for patent eligibility is not the same as characterizing preemption as the sole test for patent eligibility. As our reviewing court has explained, "[t]he Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability" and "[f]or

this reason, questions on preemption are inherent in and resolved by the § 101 analysis." *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice*, 134 S. Ct. at 2354). And although "preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility." *Id.* Moreover, "[w]here a patent's claims are deemed only to disclose patent ineligible subject matter under the [*Alice/Mayo*] framework . . . , preemption concerns are fully addressed and made moot." *Id.*; *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 701 (2015)("[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the ecommerce setting do not make them any less abstract.").

For the foregoing reasons, we are not persuaded the Examiner erred in rejecting independent claims 21, 22, or 41 under 35 U.S.C. § 101, and we therefore, sustain the Examiner's rejection of those claims, along with the rejection of dependent claims 23–40, which Appellant does not argue separately.

DECISION

For the above reasons, the Examiner's rejection of claims 21–41 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)(1)(iv).

<u>AFFIRMED</u>