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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MICHAEL C. POPE and CHRISTOPHER P. SCHMIDT

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Appeal 2016-002868<sup>1</sup>  
Application 13/450,725  
Technology Center 3600

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Before ANTON W. FETTING, BIBHU R. MOHANTY, and  
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

FINAMORE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellants appeal from the Examiner's decision to reject claims 1–20. We have jurisdiction under § 6(b).

We AFFIRM.

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<sup>1</sup> Our Decision references Appellants' Specification ("Spec.," filed Apr. 19, 2012), Appeal Brief ("Appeal Br.," filed July 13, 2015), and Reply Brief ("Reply Br.," filed Jan. 19, 2016), as well as the Examiner's Final Office Action ("Final Act.," mailed Feb. 12, 2015) and Answer ("Ans.," mailed Nov. 17, 2015).

SUBJECT MATTER ON APPEAL

The invention relates to a method and system for providing dermatologic treatment. Spec., Title, ¶ 12. Claims 1, 12, and 17 are the independent claims on appeal. Independent claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method for providing dermatologic treatment, said method comprising:

receiving, performed by a computer system, a treatment request from a seeking entity, said treatment request comprising an image of a skin of a patient, said treatment request associated with patient information of said patient;

sending, performed by the computer system, a notification of receipt of said treatment request to a providing entity, wherein said providing entity is a dermatologist;

presenting, performed by the computer system, a plurality of diagnoses groups in response to said providing entity accessing said treatment request, wherein a diagnosis group of said diagnoses groups comprises a plurality of diagnoses that are grouped together according to types of skin conditions;

presenting, performed by the computer system, said plurality of diagnoses in accordance with a selection of said diagnoses group;

presenting, performed by the computer system, a plurality of treatment options in response to receiving a selection of a diagnosis of said plurality of diagnoses, wherein at least one treatment option of said plurality of treatment options comprises a medication placed within said plurality of treatment options as an advertisement;

generating, performed by the computer system, a selected treatment option in response to receiving a selection of a treatment option of the plurality of treatment options; and

sending, performed by the computer system, said selected treatment option to said seeking entity.

## REFERENCES

The Examiner relies on the following prior art in rejecting the claims on appeal:

Pak	US 2005/0251415 A1	Nov. 10, 2005
Hoffner et al. (“Hoffner”)	US 2007/0038484 A1	Feb. 15, 2007
Wong et al. (“Wong”)	US 2013/0018672 A1	Jan. 17, 2013
O’Halloran	US 8,392,244 B1	Mar. 5, 2013

## REJECTIONS<sup>2</sup>

The Examiner rejects the claims on appeal as follows:  
claims 1–20 under 35 U.S.C. § 101 as non-statutory subject matter;  
claims 1–5, 9, 11–13, 17, and 18 under 35 U.S.C. § 103(a) as unpatentable over Pak and O’Halloran;  
claims 6–8, 14, 15, 19, and 20 under 35 U.S.C. § 103(a) as unpatentable over Pak, O’Halloran, and Wong; and  
claims 10 and 16 under 35 U.S.C. § 103(a) as unpatentable over Pak, O’Halloran, and Hoffner.

## ANALYSIS

### *Non-Statutory Subject Matter*

As an initial matter, we are not persuaded of error by Appellants’ argument that “the claim scope is clearly circumscribed in such a manner that it does not cover the entire use of any overarching idea, abstract or otherwise.” Reply Br. 5. Although preemption may be the concern behind

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<sup>2</sup> The Examiner has withdrawn the rejection of claims 1–20 under 35 U.S.C. § 112, second paragraph. Ans. 17.

the judicial exceptions to statutory subject matter, preemption is not the test for eligibility. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability. For 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) (citation omitted).

Appellants further argue that the Examiner has failed to set forth a prima facie case of patent-ineligible subject matter. Appeal Br. 7–8; Reply Br. 6. According to Appellants, the Examiner has not provided documentary evidence that all of the claim elements have been considered (Appeal Br. 7), and Appellants similarly assert that there is no indication that the Examiner considered the dependent claims (*id.*; Reply Br. 6). Appellants also argue that there is no objective evidence for the Examiner’s determination that the claims are directed to an abstract idea. Appeal Br. 8. Appellants do not apprise us of error.

With respect to the requirement to make a prima facie case, the Federal Circuit has held that

the PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies 35 U.S.C. § 132, in “notify[ing] the applicant ... [by] stating the reasons for [its] rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.”

*In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (alterations in original) (quoting § 132). All that is required of the Office is to set forth the statutory basis of the rejection in a sufficiently articulate and informative manner. *Id.* at 1363; *see also Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (“Section 132 is violated when a rejection is so uninformative that it

prevents the applicant from recognizing and seeking to counter the grounds for rejection.”). Furthermore, although evidence may be necessary to meet the notice requirement of § 132 in some cases, it is not necessary in every case.

Here, in determining that the claims are patent-ineligible, i.e., judicially-excepted from statutory subject matter under § 101, the Examiner analyzes the claims using the two-step framework set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1296–97 (2012) and reiterated in *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347, 2355 (2014), which, in the first step, considers whether a claim is directed to a patent-ineligible concept, e.g., an abstract idea, and, if so, considers, in the second step, whether the claim recites an inventive concept—an element or combination of elements sufficient to ensure the claim amounts to significantly more than the abstract idea and transform the nature of the claim into a patent-eligible application. Final Act. 2–3. More specifically, pursuant to the first step, the Examiner determines the claims are directed to the abstract idea of “organizing diagnosis and treatment decision support including relevant advertising.” *Id.* at 3. In doing so, the Examiner explains that the concept of “organizing diagnosis and treatment decision support including relevant advertising” is similar to other concepts the courts have held to be abstract ideas, namely using categories to organize, store, and transmit information in *Cyberfone Systems, LLC v. CNN Interactive Group, Inc.*, 558 F. App’x 988 (Fed. Cir. 2014) and comparing new and stored information and using rules to identify options in *SmartGene v. Advanced Biological Laboratories, S.A.*, 555 F. App’x 950 (Fed. Cir. 2014). Ans. 18.

Under the second step, the Examiner determines that the claims do not include additional elements amounting to significantly more than the abstract idea because the additional limitations amount to mere instructions to implement the idea on a computer. Final Act. 3. The Examiner also determines that the claimed steps require only generic computer structure that performs generic computer functions that are well-understood, routine, and conventional, such as receiving, sending, and presenting information in response to accessing, selecting, and generating data. *Id.*; Ans. 18.

Although the Examiner does not explicitly mention each claim limitation or the dependent claims, we understand the Examiner's analysis to include each limitation and the dependent claims. Final Act. 2–3; Ans. 19. For example, we understand the Examiner determines that the dependent claims are patent ineligible for the same reasons as the independent claims. Ans. 19.

As such, the Examiner sufficiently informs Appellants that the claims are ineligible pursuant to the two-step framework for determining patent eligibility. Furthermore, there is no indication that Appellants do not recognize or understand the Examiner's rejection, as Appellants' understanding is manifested in their arguments traversing it. Accordingly, the Examiner's rejection satisfies the notice requirement of § 132 and sets forth a prima facie case of patent-ineligible subject matter. We, therefore, consider Appellants' remaining arguments to determine whether the Examiner erred in determining that the claims are patent ineligible.

Appellants argue the Examiner erred in determining that the claims are directed to an abstract idea pursuant to the first step of the patent-eligibility analysis. Appeal Br. 5–6; Reply Br. 2–3. According to

Appellants, the claims are not directed to “organizing diagnosis and treatment decision support including relevant advertising,” but rather require a computer and therefore provide technological improvements to the pertinent technology. Appeal Br. 5. Appellants also assert that the claimed invention does not fall within one of the categories of abstract ideas, i.e., fundamental economic practices, certain methods of organizing human activities, an idea of itself, and mathematical relationships/formulas. *Id.* More specifically, Appellants contend that

at least the features of, “presenting, performed by the computer system, a plurality of diagnoses groups in response to said providing entity accessing said treatment request, wherein a diagnosis group of said diagnoses groups comprises a plurality of diagnoses that are grouped together according to types of skin conditions,” “presenting, performed by the computer system, a plurality of treatment options in response to receiving a selection of a diagnosis of said plurality of diagnoses, wherein at least one treatment option of said plurality of treatment options comprises a medication placed within said plurality of treatment options as an advertisement,” and “generating, performed by the computer system, a selected treatment option in response to receiving a selection of a treatment option of the plurality of treatment options” are not Fundamental Economic Practices, Methods of Organizing Human Activity, An Idea of itself, such as a mental process (thinking), or Mathematical Relationships/Formulas.

Reply Br. 3. Appellants’ arguments do not apprise us of error.

In determining what the claims are directed to pursuant to the first step of the patent-eligibility analysis, our reviewing court has instructed that “the claims are considered in their entirety to ascertain whether *their character as a whole* is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015) (emphasis added). Here, independent claim 1, for example, recites a method

for providing dermatologic treatment comprising the steps of:

“receiving . . . a treatment request from a seeking entity, said treatment request comprising an image of a skin of a patient, said treatment request associated with patient information of said patient”; “sending . . . a notification of receipt of said treatment request to a providing entity, wherein said providing entity is a dermatologist”; “presenting . . . a plurality of diagnoses groups in response to said providing entity accessing said treatment request, wherein a diagnosis group of said diagnoses groups comprises a plurality of diagnoses that are grouped together according to types of skin conditions”; “presenting . . . said plurality of diagnoses in accordance with a selection of said diagnoses group”; “presenting . . . a plurality of treatment options in response to receiving a selection of a diagnosis of said plurality of diagnoses, wherein at least one treatment option of said plurality of treatment options comprises a medication placed within said plurality of treatment options as an advertisement”; “generating . . . a selected treatment option in response to receiving a selection of a treatment option of the plurality of treatment options”; and “sending . . . said selected treatment option to said seeking entity.” We agree with the Examiner that these steps are a method for “organizing diagnosis and treatment decision support including relevant advertising.” *See also* Spec. ¶ 12 (“Example techniques, devices, systems, and methods for diagnosing and treating dermatologic conditions are described herein.”). Said differently, a method for providing dermatologic treatment that presents a plurality of diagnoses groups, presents a plurality of treatment options in response to a selection of a diagnosis, whereby at least one treatment option includes an advertisement for a medication, and generating a selected

treatment option in response to receiving a selection of a treatment option is nonetheless a method for “organizing diagnosis and treatment decision support including relevant advertising.”

Independent claim 1 further recites that a computer system performs each of the claimed method steps. Yet, the simple recitation of a computer or computing components, in and of itself, does not mean the claimed invention is an improvement in computer capabilities, as opposed to an abstract idea. According to our reviewing court, “the first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016). As set forth above, independent claim 1 recites a method for providing dermatologic treatment, and further recites that each step of the method is performed by the computer system. Moreover, the Specification describes that the invention relates to “techniques, devices, systems, and methods for diagnosing and treating dermatologic conditions.” Spec. ¶ 12. The Specification also describes that the computer system “can operate on or within a number of different computer systems including, but not limited to, general purpose networked computer systems, embedded computer systems, routers, switches, server devices, client devices, various intermediate devices/nodes, stand alone computer systems, media centers, handheld computer systems, multi-media devices, and the like.” *Id.* ¶ 65. As such, we fail to see how the claimed invention is an improvement in computer capabilities. Rather, the claimed invention simply uses the computer system as a tool to perform the steps for providing dermatological

treatment. Accordingly, Appellants do not apprise us of error in the Examiner's determination that the character of each of the claims, as a whole, is directed to "organizing diagnosis and treatment decision support including relevant advertising."

Turning to whether "organizing diagnosis and treatment decision support including relevant advertising" is an abstract idea, the Federal Circuit has explained that "the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided." *Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016). As the Examiner points out, the concept of "organizing diagnosis and treatment decision support including relevant advertising" is similar to other concepts the courts have held to be abstract ideas, namely using categories to organize, store, and transmit information in *Cyberfone* and comparing new and stored information and using rules to identify options in *SmartGene*. Ans. 18. Appellants do not assert, and we fail to see, any meaningful distinction between the concept of "organizing diagnosis and treatment decision support including relevant advertising" and these abstract ideas. Accordingly, we see no error in the Examiner's determination that the claims are directed to "organizing diagnosis and treatment decision support including relevant advertising," which is an abstract idea.

Seeing no error in the Examiner's determination that the claims are directed to an abstract idea pursuant to the first step of the patent-eligibility analysis, we turn to Appellants' arguments under the second step. Appellants allege that the claims amount to significantly more than the

abstract idea because the claimed invention provides an improvement to the technical field of medical diagnostics. Appeal Br. 6–7; Reply Br. 3–5. Appellants’ arguments do not apprise us of error.

At the outset, we disagree with Appellants that medical diagnostics, in general, is a technical field. A medical diagnosis involves the analysis of a patient’s symptoms to determine a cause or a condition. Accordingly, making a medical diagnosis may simply involve a series of mental steps, such that making medical diagnoses, i.e., medical diagnostics, is not a technical field.

That notwithstanding, we nonetheless fail to see how the claimed invention is an improvement to medical diagnostics. Independent claim 1, for example, recites the steps of receiving, sending, presenting, generating, and sending data. Even if we agree with Appellants that independent claim 1 recites an improvement, the claimed invention is simply an improved way of organizing, analyzing, and presenting data that is applied to the field of medical diagnostics. In other words, the improvement is to the handling of data, not to the field of medical diagnostics.

Furthermore, independent claim 1 is linked to the field of medical diagnostics by only the nature of the data. According to the Federal Circuit, “merely selecting information, by content or source, for collection, analysis, and display does nothing significant to differentiate a process from ordinary mental processes, whose implicit exclusion from § 101 undergirds the information-based category of abstract ideas.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016). Accordingly, the claim limitations relating to the field of medical diagnostics do not amount to significantly more than the abstract idea.

We are also unpersuaded of error by Appellants' argument that the claims recite features other than what is well-known, routine, and conventional in the field. Reply Br. 5. Notwithstanding that “the § 101 patent-eligibility inquiry and, say, the § 102 novelty inquiry might sometimes overlap’ . . . a claim for a *new* abstract idea is still an abstract idea.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (quoting *Mayo*, 132 S. Ct. at 1304). The question in the second step of the patent-eligibility analysis is not whether a claim limitation is novel, but rather whether the implementation of the abstract idea involves “more than performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347–48 (Fed. Cir. 2014) (quoting *Alice*, 134 S. Ct. at 2359).

Here, the claims recite that the abstract idea is implemented on a computer system. As set forth above, the Specification describes that the computer system can be a general purpose networked computer system. Spec. ¶ 65. Moreover, there is no indication that the implementation of the claimed steps requires something apart from the well-known, routine, and conventional computer functions of receiving, analyzing, presenting, and sending data. Ans. 18. Accordingly, even if the claims recite steps that are novel and nonobvious, we fail to see how the claimed invention is something other than the generic computer implementation of the abstract idea, which does not amount to significantly more than the abstract idea.

In view of the foregoing, Appellants do not apprise us of error in the Examiner's determination that the claims are patent-ineligible, i.e., judicially

excepted from statutory subject matter. Accordingly, we sustain the rejection of claims 1–20 under 35 U.S.C. § 101.

*Obviousness*

Appellants argue that Pak does not disclose “presenting . . . a plurality of diagnoses groups in response to said providing entity accessing said treatment request, wherein a diagnosis group of said diagnoses groups comprises a plurality of diagnoses that are grouped together according to types of skin conditions,” as recited in independent claim 1. Appeal Br. 11–13. More specifically, Appellants contend that Pak does not disclose a plurality of diagnoses groups as recited in this limitation. *Id.* at 12. Appellants’ argument is persuasive.

In rejecting independent claim 1, the Examiner relies on paragraphs 352, 353, and 355 of Pak for disclosing the disputed limitation. Final Act. 5. Paragraph 352 discloses that when a consulting teledermatologist selects a diagnosis, a list of differential diagnosis options is automatically generated. Paragraph 353 similarly discloses that when a requesting physician selects a diagnosis, a list of related diagnostic options is automatically generated. Paragraph 355 discloses that the consulting teledermatologist may use “a pre-formed template of common diagnoses such as ‘Actinic Keratosis, Urticaria, etc.’”

Pak discloses a plurality of diagnoses, namely the common diagnoses and the diagnosis options, but Pak does not expressly disclose that either the common diagnoses or the diagnosis options are in groups. The Examiner, however, finds that “each diagnosis is itself functionally a diagnosis group.” Ans. 21. Although Pak discloses that the selection of a diagnosis results in

the display of diagnosis options, we fail to see how a single diagnosis discloses a diagnoses group.

In view of the foregoing, the Examiner has not sufficiently shown that Pak discloses “presenting . . . a plurality of diagnoses groups in response to said providing entity accessing said treatment request, wherein a diagnosis group of said diagnoses groups comprises a plurality of diagnoses that are grouped together according to types of skin conditions,” as recited in independent claim 1. Independent claims 12 and 17 include limitations that are similar to the disputed limitation of independent claim 1, and the Examiner’s rejection of independent claims 12 and 17 is based on the same deficient finding. Final Act. 8, 11. We, therefore, do not sustain the Examiner’s rejection of independent claims 1, 12, and 17 and dependent claims 2–5, 9, 11, 13, and 18.

The Examiner does not rely on Wong or Hoffner in any way that cures the deficiency in the rejection of the independent claims. Final Act. 15–18. Accordingly, we do not sustain the Examiner’s rejections of dependent claims 6–8, 10, 14–16, 19, and 20 for the same reasons as the independent claims.

#### DECISION

The Examiner’s decision to reject claims 1–20 under 35 U.S.C. § 101 is affirmed.

The Examiner’s decision to reject claims 1–20 under 35 U.S.C. § 103(a) is reversed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED