



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/036,783	02/28/2011	Jadran Bandic	SKIN-0025-U01	5588

7590 04/30/2018
MySkin, Inc.
123 Town Square Place, Suite 324
Jersey City, NJ 07310

EXAMINER

JANG, CHRISTIAN YONGKYUN

ART UNIT	PAPER NUMBER
----------	--------------

3735

MAIL DATE	DELIVERY MODE
-----------	---------------

04/30/2018

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JADRAN BANDIC, DJURO KORUGA,
SAVA MARINKOVICH, and RAHUL MEHENDELE

Appeal 2016-004417
Application 13/036,783
Technology Center 3700

Before STEVEN D.A. MCCARTHY, MICHELLE R. OSINSKI, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

KORNICZKY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants Jadran Bandic et al.¹ appeal under 35 U.S.C. § 134(a) from the Examiner's decision, as set forth in the Final Office Action dated February 27, 2015 ("Final Act.") and the Advisory Action dated April 28, 2015 ("Adv. Act."), rejecting claims 27–34 under 35 U.S.C. § 101 because the claimed invention is directed to patent-ineligible subject matter.² We have jurisdiction under 35 U.S.C. § 6(b). A hearing was held on April 17, 2018.

We REVERSE.

THE CLAIMED SUBJECT MATTER

The claims are directed to an analytic method of tissue evaluation. Claim 27, the only independent claim on appeal, is reproduced below with additional bracketed claim lettering to identify the individual limitations for ease of reference:

27. A method for characterizing an epidermis of a person, the method comprising:

[a] subjecting a first sublayer of the epidermis of the person to optomagnetic fingerprinting, yielding first wavelength difference-intensity data to characterize the first sublayer;

[b] subjecting a second sublayer of the epidermis of the person to optomagnetic fingerprinting, yielding second wavelength difference-intensity data to characterize the second sublayer;

[c] comparing the first wavelength difference-intensity data to wavelength difference-intensity data of other persons from the first sublayer of the epidermis of the other persons;

¹ Appellants identify MySkin, Inc. as the real party in interest. Appeal Brief, dated July 28, 2015 ("Appeal Br."), at 2.

² Claims 1–26 are cancelled. Appeal Br. 14 (Claims App.).

[d] comparing the second wavelength difference-intensity data to wavelength difference-intensity data of other persons from the second sublayer of the epidermis of the other persons; and

[e] determining at least one of an age and a state of hydration of the person using the steps of comparing.

DISCUSSION

The Rejection of Claims 27–34 as Directed to Non-statutory Subject Matter

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.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 566 U.S. 66, 71–72 (2012)). According to the Supreme Court’s framework, we must first determine whether the claims at issue are directed to one of those concepts (i.e., laws of nature, natural phenomena, and abstract ideas). *Id.* If so, we must secondly “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.” *Id.* The Supreme Court characterizes the second step of the 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.’” *Id.* (alteration in original). To transform an abstract idea into a patent-eligible concept, the claims require “more than simply stating the abstract idea while adding the words ‘apply it.’” *Id.* at 2357 (citations omitted).

Alice Step One

With respect to the first step of the *Alice* analysis, the Examiner initially states, without explanation, that claims 27–34 “are directed to an abstract idea.” Final Act. 2. The Examiner subsequently explains that “the steps within the method of comparing and determining are directed to an abstract idea as it is directed [to] comparing numerical data (i.e. mathematical algorithms) to characterize an epidermis of a person.” Adv. Act. 2. The Examiner also states that “the abstract idea found within the claim is the comparison and determining steps, which utilize a mathematical algorithm.” Answer, dated January 21, 2016 (“Ans.”), at 2.

In response, Appellants assert that, “[i]n characterizing the claim as an allegedly abstract idea,” the rejection improperly “picks and chooses fragments of the claim language without viewing the claim as whole.” Appeal Br. 7 (citing *Diamond v. Diehr*, 450 U.S. 175, 188 (1981) (“In determining the eligibility of respondents’ claimed process for patent protection under § 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis.”); see also *Parker v. Flook*, 437 U.S. 584, 594 (1978)). Appellants also assert that the rejection does “not allege that the claim itself was directed to an abstract idea, but merely that the steps of comparing and determining were directed to this abstract idea.” Reply Brief, dated March 21, 2016 (“Reply Br.”), at 7.

We agree with Appellants. The Examiner’s asserted abstract idea is based on “the steps *within* the [claimed] method of comparing and determining” and ignores the claim as a whole. Adv. Act. 2; Ans. 2. The asserted abstract idea only addresses claim limitations 27c–e which compare

the first and second wavelength difference-intensity data to wavelength difference-intensity data of other persons. It ignores the claim limitations 27a–b, which require subjecting the first and second sublayer of a person’s epidermis (i.e., physical objects) to optomagnetic fingerprinting. Claims do not become patent-ineligible under § 101 simply because they use mathematical formulas. *See Diehr*, 450 U.S. at 187 (“a claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula”). In that sense, the Examiner’s explicit consideration of only a portion of the claim (i.e., that which is considered mathematical algorithms) oversimplifies the analysis of patent ineligibility under § 101.

Thus, the Examiner’s does not articulate an abstract idea to which claims 27–34 are directed.

Alice Step Two

With respect to the second step of the *Alice* analysis, the Examiner states the “claim(s) does/do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the recited claims are not tied to any particular novel machine or apparatus; in essence, the claims fail to add significantly more in its implementation such that the abstract idea is transformed into a patent eligible invention.” Final Act. 2; Adv. Act. 2. The Examiner also states “any use of a machine that may be inherent to the claims is not recited as a non-obvious device, and would thus be merely a recitation of a device in an insignificant extra-solution activity (e.g. data-gathering). Moreover, there is no physical transformation by the recited methods.” Ans. 3. In response to

Appellants' argument that the Examiner "has failed to produce prior art for optomagnetic fingerprinting, and therefore any device utilized would not be considered part of an insignificant extra-solution activity," the Examiner merely states that "optomagnetic fingerprinting itself is disclosed in disclosures dating back to 2008, prior to the effective filing date of the instant claims." Ans. 3.

The Examiner's analysis of the second step of the Alice analysis is conclusory and unsupported. The Examiner does not persuasively explain why or how subjecting the first and second sublayers of a person's epidermis to optomagnetic fingerprinting recited in claim limitations 27a–b are steps of "data gathering" or "insignificant post-solution activity." Similarly, the Examiner identifies no support for the finding that "optomagnetic fingerprinting itself is disclosed in disclosures dating back to 2008" or that subjecting first and second epidermis sublayers is known in the art. Simply because the additional element of optomagnetic fingerprinting may appear in a prior disclosure is not adequate to show that the additional element would not be an activity sufficient to transform a claim into a patent-eligible application of an abstract idea. *See Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018) (cautioning that "[t]he mere fact that something is disclosed in a piece of prior art [] does not mean it was well-understood, routine and conventional").

Thus, the Examiner does not properly consider the elements of claims 27–34, both individually and "as an ordered combination," to determine whether the additional elements transform the Examiner's asserted abstract idea into a patent-eligible application.

Appeal 2016-004417
Application 13/036,783

DECISION

For the above reasons, the Examiner's rejection of claims 27–34 under 35 U.S.C. § 101 is REVERSED.

REVERSED