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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SHOJI KANADA

Appeal 2016-005043[1]
Application 13/650,905[2]
Technology Center 3600

Before NINA L. MEDLOCK, BRADLEY B. BAYAT, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

BAYAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 and 3–27. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] Our decision references Appellant's Appeal Brief ("App. Br.," filed Sept. 18, 2015) and Reply Brief ("Reply Br.," filed Apr. 11, 2016), the Examiner's Answer ("Ans.," mailed Mar. 8, 2016), and the Final Office Action ("Final Act.," mailed Mar. 17, 2015).
[2] According to Appellant, the real party in interest is Fujifilm Corporation. App. Br. 1.

CLAIMED INVENTION

Appellant's "invention relates to a clinical information processing apparatus and method for calculating a degree of similarity between a case of a target patient and a case of a comparison target patient" (Spec. 1:5–8). Claims 1, 13, 21, and 22 are independent. Claim 21, reproduced below with bracketed matter, is illustrative of the subject matter on appeal:

> 21. A clinical information processing method, the method comprising:
>
> [1] accessing a memory device which stores a clinical information database, and obtaining from the clinical information database:
>
> [a] registration case information for calculating a likelihood ratio including a multiplicity of registration cases about a plurality of comparison target patients, and to each of the multiplicity of registration cases a plurality of clinical-information items each of which is classifiable into a plurality of groups being correlated; and
>
> [b] registration case information for calculating a degree of similarity including a multiplicity of registration cases about a plurality of comparison target patients, and to each of the multiplicity of registration cases a plurality of clinical-information items each of which is classifiable into a plurality of groups being correlated;
>
> [2] in a processing apparatus comprising a target case obtainment unit and a display control unit, obtaining, as a target classification of a target clinical item, a classification of each of a plurality of clinical-information items about a target patient;
>
> [3] calculating, based on the registration case information for calculating a likelihood ratio, likelihood ratio information for each combination of a classification of a key item of the plurality of clinical-information items and each classification of at least one clinical-information item other than the key item to each classification of the key item included in the registration cases, and the likelihood ratio information being obtained by calculating a likelihood ratio between a likelihood of belonging to one classification of the key item and a likelihood of belonging

to any classification of the key item other than the one classification of the key item when a case belongs to each classification of the at least one clinical-information item other than the key item;

[4] calculating, for each of the combinations, values in such a manner that the weight of the value become greater as the likelihood ratio corresponding to the combination is greater, and determining weighting coefficients by weighting the calculated value in such a manner that a weight of the value corresponding to the target classification is greater than or equal to the weight of the value corresponding to the classification other than the target classification for each of the clinical-information items;

[5] specifying, based on the determined weighting coefficient information, the weighting coefficient corresponding to each classification of the key item and each classification of at least one clinical-information item other than the key item for each of the registration cases included in the registration case information for calculating a degree of similarity, and [6] calculating a degree of similarity by using the specified weighting coefficient;

[7] extracting, from among the registration case information for calculating a degree of similarity, the registration case, the calculated degree of similarity of which is higher than a predetermined value, as a similar case, which is similar to the target case,

[8] retrieving the similar case information related to the extracted similar case;

[9] outputting the retrieved similar case information to the display control unit; and

[10] displaying the similar case information on a display device which is controlled by the display control unit of the processing apparatus.

App. Br. 28–29, Claims Appendix.

REJECTIONS

Claims 1 and 3–27 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1 and 3–27 are rejected under 35 U.S.C. § 112, second paragraph.

ANALYSIS

Non-Statutory Subject Matter

The Supreme Court has 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*, 134 S. Ct. 2347, 2355 (Fed. Cir. 2014) (*citing Mayo*, 132 S. Ct. 1289, 1294 (Fed. Cir. 2012)). According to the Supreme Court's framework, it must first be determined 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, a second determination must be made to "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.*).

To that end, with regard to the first part of the *Alice* inquiry, the Examiner finds that "[c]laims 1 and 3–27 are directed to the abstract idea of calculating a degree of similarity, which has been determined to be a mathematical relationship," and therefore ineligible subject matter under 35 U.S.C. § 101 (Final Act. 2). With regard to the second part of the *Alice* inquiry, the Examiner determines that "[t]he claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the computer as recited is a generic computer component

that performs functions (*i.e.,* stores information, obtains information, performs calculations, extracts/retrieves information, and displays information)," which "are well-understood, routine, and conventional activities previously known to the industry" (*id.* at 2–3). The Examiner concludes that "[t]he claims do not amount to significantly more than the underlying abstract idea of calculating a degree of similarity" (*id.* at 3). In the Answer, the Examiner takes the additional position that "[c]laims 1 and 3–27 are also directed to the abstract idea of comparing new and stored information and using rules to identify options" (Ans. 5). The Examiner then concludes that "[t]he claims do not amount to significantly more than the underlying abstract ideas of mathematical relationships and comparing new and stored information and using rules to identify options" (*id.* at 6). The Examiner has applied this analysis to all the claims in the rejection.

We have considered Appellant's arguments (App. Br. 5–17; Reply Br. 2–18) against the findings set forth by the Examiner in the final rejection (Final Act. 2–3), including the reasons and rebuttals set forth in the Examiner's Answer in response to Appellant's arguments (Ans. 5–7), and on the record before us, we find that the Examiner has not shown that the claims are directed to patent-ineligible subject matter.

The difficulty with the Examiner's finding under the first part of the *Alice* framework is the lack of any analysis or reasoning in arriving at the judicial exception. The Examiner simply asserts that the claims are not eligible because they are directed to calculating a degree of similarity, a mathematical relationship, which is an abstract idea. In other words, the Examiner has not shown that the method simply describes the concept of calculating a degree of similarity through mathematical relationships.

Although the absence of expressly recited mathematical algorithms or equations carries no significance in determining whether a claim falls within the proffered abstract idea, we find that the process of claim 21 as a whole does not seek to "tie up" a mathematical relationship for calculating a degree of similarity. We also disagree with the Examiner's additional position of the abstract idea because the broadest reasonable interpretation of the claim is not directed to comparing new and stored information and using rules to identify options (*see* Ans. 5). Therefore, we find that the Examiner's determination of the abstract idea under the first step of the *Alice* inquiry is unfounded. As such, we need not proceed in analyzing the Examiner's determination as to the second step of the *Alice* inquiry. Accordingly, we do not sustain the rejection under 35 U.S.C. § 101.

Indefiniteness

Appellant has not contested the rejection of claims 1 and 3–27 under 35 U.S.C. § 112, second paragraph. Thus, we summarily sustain the rejection of these claims.

DECISION

The rejection under 35 U.S.C. § 101 is reversed.

The rejection under 35 U.S.C. § 112, second paragraph, is sustained.

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

<u>AFFIRMED</u>