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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
10/431,548 05/07/2003 Laura Kathleen Serrano CRNI.104358 4795

46169 7590 03/13/2018
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Table with 1 column: EXAMINER

MISIASZEK, AMBER ALTSCHUL

Table with 2 columns: ART UNIT, PAPER NUMBER

3624

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

03/13/2018

ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LAURA KATHLEEN SERRANO, JOHN LEE MOORE III,
and JUDITH ANN ZAKUTNY

Appeal 2016-005939
Application 10/431,548¹
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
THOMAS F. SMEGAL, *Administrative Patent Judges*.

FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The real party in interest is Cerner Innovation, Inc. App. Br. 3.

STATEMENT OF THE CASE²

Laura Kathleen Serrano, John Lee Moore III, and Judith Ann Zakutny (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1–17, 19, and 20, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

The Appellants invented a way of correlating pathology specimen results for breast tissue with mammography reports. Specification para. 3.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below (bracketed matter and some paragraphing added).

1. A method in a computing environment for associating mammography reports with pathology results for one or more patients, the method comprising:

[1] automatically determining on a computing device whether a patient has both

one or more pathology results for breast tissue

and

one or more mammography reports;

[2] if so, identifying the patient having both and automatically associating the identified patient's one or more pathology results with the identified patient's one or more mammography reports,

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed September 25, 2015) and Reply Brief ("Reply Br.," filed May 20, 2016), and the Examiner's Answer ("Ans.," mailed March 21, 2016), and Final Action ("Final Act.," mailed June 26, 2015).

wherein the one or more pathology results and the one or more mammography reports are used to perform a statistical audit for the at least one patient,

and

wherein the statistical audit determines at least one of

a percentage of the one or more mammography reports interpreted as positive that have a positive pathology result

and

a percentage of the one or more mammography reports interpreted as positive that have a negative pathology result;

and

[3] presenting simultaneously, in a pathology correlation window of the computing device, text of the one or more pathology results and text of the one or more mammography reports.

Claims 1–17, 19, and 20 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

ISSUES

The issues of eligible subject matter turn primarily on whether the claims recite more than abstract conceptual advice of what a computer is to provide without implementation details.

ANALYSIS

The Examiner determines

Claims 1–17, 19, and 20 are directed to associating mammography reports with pathology results for one or more patients. The claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the claims do not amount to an improvement to another technology or technical field; the claims do not amount to an improvement to the functioning of a computer itself; the claims do not move beyond a general link of the use of an abstract idea to a particular technological environment; the claims merely amount to the application or instructions to apply the abstract idea on a computer; and the claims amount to nothing more than requiring a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry.

For example, the claims require only a generic “computer system” to perform generic computer functions such as determining, identifying, auditing, and presenting, which are well-understood, routine and conventional activities previously known to the industry.

Final Act. 3–4. We adopt the Examiner’s determinations and analysis from the Final Action and Answer and reach similar legal conclusions. In reply, Appellants argue the Examiner made new determinations and analysis in the Answer. Appellants do not directly challenge these determinations and analysis, but instead argue that their very existence proves the rejection in the Final Action was deficient. Appellants accordingly argue that this is a new ground of rejection, but do not request remand to the Examiner to reopen prosecution, but instead ask for reversal based on the state of the rejection as of the Final Action. Even though Appellants’ contend that “all previously presented arguments as set forth in the Appellants’ Appeal Brief

filed September 25, [2015] are considered relevant to this Reply Brief” (Reply Br. 3), Appellants’ argument is itself an admission that the Examiner’s determinations in the Answer include more than those in the Final Action and therefore Appellants have not as of the Appeal Brief argued the determinations in the Answer. Therefore, Appellants admit that the rejection before us after the Answer differs from that prior to the Answer.

Appellants argue they have not been provided a “fair opportunity to react to the thrust of the rejection.” Reply Br. 6. Appellants, however, fail to make use of the Reply Brief to do just that. MPEP § 1207.03(b), based on 37 C.F.R. § 41.40, sets out the exclusive procedure for an appellant to request review of the primary examiner’s failure to designate a rejection in the Answer as a new ground of rejection via a petition to the Director under 37 C.F.R. § 1.181.

1207.03(b) Petition to Designate a New Ground of Rejection
and to Reopen Prosecution [R-11.2013]

[37 C.F.R. § 41.40] Tolling of time period to file a reply brief.

(a) *Timing.* Any request to seek review of the primary examiner’s failure to designate a rejection as a new ground of rejection in an examiner’s answer must be by way of a petition to the Director under § 1.181 of this title filed within two months from the entry of the examiner’s answer and before the filing of any reply brief. Failure of appellant to timely file such a petition will constitute a waiver of any arguments that a rejection must be designated as a new ground of rejection.

(b) *Petition granted and prosecution reopened.* A decision granting a petition under § 1.181 to designate a new ground of rejection in an examiner’s answer will provide a two-month time period in which appellant must file a reply under § 1.111

of this title to reopen the prosecution before the primary examiner. On failure to timely file a reply under § 1.111, the appeal will stand dismissed.

(c) *Petition not granted and appeal maintained.* A decision refusing to grant a petition under § 1.181 of this title to designate a new ground of rejection in an examiner's answer will provide a two-month time period in which appellant may file only a single reply brief under § 41.41.

(d) *Withdrawal of petition and appeal maintained.* If a reply brief under § 41.41 is filed within two months from the date of the examiner's answer and on or after the filing of a petition under § 1.181 to designate a new ground of rejection in an examiner's answer, but before a decision on the petition, the reply brief will be treated as a request to withdraw the petition and to maintain the appeal.

(e) *Extensions of time.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

Appellant cannot request to reopen prosecution pursuant to [37 C.F.R. § 41.39(b)] if the examiner's answer does not have a rejection that is designated as a new ground of rejection.

[37 C.F.R. § 41.40] sets forth the exclusive procedure for an appellant to request review of the primary examiner's failure to designate a rejection as a new ground of rejection via a petition to the Director under [37 C.F.R. § 1.181]. This procedure should be used if an appellant feels an answer includes a new ground of rejection that has not been designated as such and wishes to reopen prosecution so that new amendments or evidence may be submitted in response to the rejection. However, if appellant wishes to submit only arguments, the filing of a petition under [37 C.F.R. § 1.181] would not be necessary because appellant may submit the arguments in a reply brief. Any such petition

under [37 C.F.R. § 1.181] must be filed within two months from the entry of the examiner's answer and prior to the filing of a reply brief.

MPEP § 1207.03(b)(emphasis added). Of particular pertinence is the phrase "if appellant wishes to submit only arguments, the filing of a petition under [37 C.F.R. § 1.181] would not be necessary because appellant may submit the arguments in a reply brief." As Appellants did not petition to reopen prosecution, the Examiner's rejection, including the determinations and analysis from the Answer, are before us in the record. Appellants do not argue the Examiner's determinations and analysis in the Answer. Appellants therefore do not challenge the rejection as it stands before us. Accordingly, we summarily affirm the rejection.

CONCLUSIONS OF LAW

The rejection of claims 1–17, 19, and 20 under 35 U.S.C. § 101 as directed to non-statutory subject matter is proper.

DECISION

The rejection of claims 1–17, 19, and 20 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) (2011).

AFFIRMED