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.
10/818,879	04/05/2004	Stephen J. Brown	7553.00105 / 04-0400	4924

60683 7590 03/23/2018

Robert Bosch LLC
1800 W. Central Road
Mount Prospect, IL 60056

EXAMINER	
SEOH, MINNAH L	

ART UNIT	PAPER NUMBER
3686	

MAIL DATE	DELIVERY MODE
03/23/2018	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 STEPHEN J. BROWN

Appeal 2016-006469[1]
Application 10/818,879[2]
Technology Center 3600

Before MURRIEL E. CRAWFORD, BIBHU R. MOHANTY, and NINA L. MEDLOCK, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–17 and 19–23. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

---

[1] Our decision references Appellant's Appeal Brief ("Br.," filed July 22, 2015) and the Examiner's Answer ("Ans.," mailed March 30, 2016) and Non-Final Office Action ("Non-Final Act.," mailed January 22, 2015).

[2] Appellant identifies Robert Bosch Healthcare, Inc. as the real party in interest. Br. 2.

CLAIMED INVENTION

Appellant's claimed invention "relates to healthcare and, in particular, to an improved method and system of monitoring a patient's condition" (Spec. 1, ll. 16–17).

Claims 1, 12, and 19 are the independent claims on appeal. Claims 1 and 12, reproduced below, are illustrative of the claimed subject matter:

> 1. A system for processing personal health information associated with at least one individual, the system comprising:
>
> a plurality of remote devices, each remote device being associated with an individual; and
>
> at least one server configured to (i) store content for communication to the plurality of remote devices, the content comprising general health-related information or general non-health-related information, and said plurality of remote devices and said at least one server communicate via a communications network, (ii) communicate the content requested by the individual to the associated remote device via the communication network, (iii) determine personalized health-related information by correlating the content communicated to the individual with a known health condition of the individual and (iv) automatically deliver the personalized health-related information to the individual via the communications network, wherein the personalized health-related information comprises information related to the known health condition of said individual.
>
> 12. A method for processing personal health information associated with at least one individual, the method comprising:
>
> (A) storing content on at least one server for communication to at least one of a plurality of remote devices, each remote device being associated with an individual, the content comprising general health-related information or general non-health-related information;

(B) communicating the content requested by the individual to the remote device associated with the individual via a communication network,

(C) determining personalized health-related information by correlating the content communicated to the individual with a known health condition of the individual in the at least one server; and

(D) automatically delivering the personalized health-related information from the at least one server to the individual via the communication network wherein the personalized health-related information comprises information related to the known health condition of said individual.

REJECTIONS

Claims 1–17 and 19–23 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–5, 12–16, and 19–21 are rejected under 35 U.S.C. § 102(b) as anticipated by Olson et al. (US 7,447,643 B1, iss. Nov. 4, 2008) (hereinafter "Olson").

Claims 6, 7, and 10 are rejected under 35 U.S.C. § 103(a) as unpatentable over Olson and Iliff (US 6,022,315, iss. Feb. 8, 2000).

Claims 8 and 9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Olson, Iliff, and Detjen et al. (US 5,970,466, iss. Oct. 19, 1999) (hereinafter "Detjen").

Claims 11, 22, and 23 are rejected under 35 U.S.C. § 103(a) as unpatentable over Olson and Ilsen et al. (US 6,757,898 B1, iss. June 29, 2004) (hereinafter "Ilsen").

Claim 17 is rejected under 35 U.S.C. § 103(a) as unpatentable over Olson and Detjen.

Claims 1–5, 12–16, and 19–22 are also rejected under 35 U.S.C. § 102(b) as anticipated by Goldman et al. (US 5,542,420, iss. Aug. 6, 1996) (hereinafter "Goldman").

Claims 6, 7, and 10 are also rejected under 35 U.S.C. § 103(a) as unpatentable over Goldman and Iliff.

Claims 8 and 9 are also rejected under 35 U.S.C. § 103(a) as unpatentable over Goldman, Iliff, and Detjen.

Claims 11 and 23 are also rejected under 35 U.S.C. § 103(a) as unpatentable over Goldman and Ilsen.

Claim 17 is also rejected under 35 U.S.C. § 103(a) as unpatentable over Goldman and Detjen.

ANALYSIS

Non-Statutory Subject Matter

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 Laboratories, Inc.*, 566 U.S. 66 (2012), "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.*, 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.* If the

claims are not directed to a patent-ineligible concept, e.g., an abstract idea, 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." *Id.* (quoting *Mayo*, 566 U.S. at 79, 78).

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*, 566 U.S. at 71. Therefore, the Federal Circuit has instructed that claims are to be considered in their entirety to determine "whether their character as a whole is directed to excluded subject matter." *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

Appellant maintains here that the § 101 rejection cannot be sustained, because the Examiner "offers no analysis or evidence" to support the Examiner's finding that the claims are directed to an abstract idea (Br. 6). However, there is no requirement that an examiner provide evidentiary support in every case before a determination can be made that a claim is directed to an abstract idea. Evidence may be helpful, e.g., where facts are in dispute. But, it is not always needed. *See Mortgage Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325–26 (Fed. Cir. 2016) ("[I]t is also possible, as numerous cases have recognized, that a § 101 analysis may sometimes be undertaken without resolving fact issues."). Appellant's bare assertion that evidence is needed here, without any supporting reasoning as

to why, is insufficient to require the Examiner to provide evidentiary support.[3]

The Federal Circuit, moreover, has repeatedly observed that "the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production." *Hyatt v. Dudas*, 492 F.3d. 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). The court has, thus, held that the USPTO carries its procedural burden of establishing a prima facie case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for the rejection, "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) (alteration in original). Thus, all that is required of the Office is that it sets forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. *Id.*; *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.").

Here, in rejecting the pending claims under § 101, the Examiner analyzed the claims using the *Mayo/Alice* two-step framework, consistent with the guidance set forth in the USPTO's "2014 Interim Guidance on Patent Subject Matter Eligibility," 79 Fed. Reg. 74618 (Dec. 16, 2014), in effect at the time the Non-Final Office Action was mailed. Specifically, the Examiner notified Appellant that the claims are directed to "providing

[3] We note that the Appellant has put forward no rebuttal evidence showing the claims are not directed to an abstract idea.

healthcare by processing, correlating, and communicating data," i.e., to a method of organizing human activity, and, therefore, to an abstract idea; applying the second step of the *Mayo/Alice* framework, the Examiner further found that the additional elements or combination of elements in the claims, other than the abstract idea, amounts to "no more than: (i) mere instructions to implement the idea on a computer, and/or (ii) recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the pertinent industry" (Non-Final Act. 3). The Examiner, thus, notified Appellant of the reasons for the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. And we find that, in doing so, the Examiner set forth a proper rejection under § 101 such that the burden shifted to Appellant to demonstrate that the claims are patent-eligible.

Independent Claim 1

Focusing specifically on independent claim 1, Appellant argues that claim 1 is patent-eligible because the claim does not monopolize an abstract idea (Br. 8–9). That argument is unpersuasive.

Although the Supreme Court has described "the concern that drives [the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption," *Alice Corp.*, 134 S. Ct. at 2354, characterizing preemption as a driving concern for patent eligibility is not the same as characterizing preemption as the sole test for patent eligibility. "The 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 Corp.*, 134 S. Ct. at 2354). Although "preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility." *Id.*

Appellant further argues that the rejection cannot be sustained because the "delivering of personalized health related information *in addition* to content requested by an individual[, as called for in claim 1,] is inventive" (Br. 10). In this regard, Appellant asserts that "no known process looks to content delivered in response to a request for the content *and* the health of the individual making the request for content to determine and communicate both the requested content and personalized health-related content" (*id.*). Yet, to the extent Appellant maintains that the claimed invention is patent-eligible, i.e., that claim 1 amount to "significantly more" than an abstract idea, because the claim is allegedly novel, Appellant misapprehends the controlling precedent.

A finding of novelty or non-obviousness does not automatically lead to the conclusion that the claimed subject matter is patent-eligible. Although the second step in the *Mayo/Alice* framework is termed a search for an "inventive concept," the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for "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.'" *Alice Corp.*, 134 S. Ct. at 2355 (citation omitted). "Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry." *Ass'n. for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). A novel and non-obvious claim directed to a purely abstract idea is,

nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90. *See also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) ("The 'novelty' of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.").

We also cannot agree with Appellant that claim 1 is patent-eligible because the claimed method involves a transformation, i.e., that the claim satisfies the transformation prong of the *Bilski* machine-or-transformation test (Br. 11).[4] Appellant argues that claim 1 requires delivery of content that was not requested, in addition to delivery of the requested data and that "[t]he original content request, which may or not be health-related, is thus transformed into a provision of personalized health-related information which is further related to the content of the initial request" (*id.*). But this alleged "transformation" is, at best, merely a manipulation of data, which is not sufficient to meet the transformation prong under 35 U.S.C. § 101. *See Gottschalk v. Benson*, 409 U.S. 63, 71–72 (1972) (a computer based algorithm that merely transforms data from one form to another is not patent-eligible).

Independent Claims 12 and 19 and Dependent Claims 2–11, 13–17, and 20–23

Turning to claims 2–17 and 19–23, Appellant argues that the rejection of these claims cannot be sustained because the Examiner failed to provide any analysis of the claim limitations (Br. 11–12). Ostensibly referring specifically to dependent claims 2–11, 13–17, and 20–23, Appellant asserts that a proper rejection under § 101 "*must* consider each of the limitations

[4] *Bilski v. Kappos*, 561 U.S. 593 (2010).

which are added by the dependent claims in determining if the limitations recited in the dependent claim are 'sufficient to 'transform' the claimed abstract idea into a patent-eligible application'" (*id.* (citation omitted)).

We are not persuaded, on the present record, that claims 2–17 and 19–23 have been improperly rejected without individually considering their claimed features. In rejecting the claims under § 101, the Examiner explained that claims 1–17 and 19–23 are directed to "providing healthcare by processing, correlating, and communicating data," i.e., to a method of organizing human activity, and, therefore, to an abstract idea; and that the additional elements or combination of elements in the claims, other than the abstract idea, does not amount to significantly more than the abstract idea itself (Non-Final Act. 3). The Examiner further explained that the additional recited limitations in dependent claims 2–11, 13–17, and 20–23 "merely add further details of the invention recited in [independent claims 1, 12 and 19], without including statutory subject matter and fail to establish that the claims are not directed to an abstract idea" (*id.*).

We decline to find error here in the Examiner's decision not to address the patent-eligibility of each of claims 2–17 and 19–23 separately inasmuch as the claims are all directed to the same abstract idea. *See Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass'n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014) (explaining that when all claims are directed to the same abstract idea, "addressing each claim of the asserted patents [is] unnecessary").

Independent claims 12 and 19 are substantially similar to independent claim 1, and respectively recite a method and computer-readable medium, which correspond to the system recited in claim 1. The dependent claims

merely further detail how the health-related information is selected, customized to an individual user, and delivered. Aside from asserting that the Examiner failed to consider the limitations of claims 2–17 and 19–23 individually, Appellant offers no separate arguments for the patent-eligibility of these claims.

We are not persuaded, for the reasons outlined above, that the Examiner erred in rejecting claims 1–17 and 19–23 under 35 U.S.C. § 101. Therefore, we sustain the Examiner's rejection.

Rejections Based on Olson

Anticipation

Independent Claim 12 and Dependent Claims 13–16

We are persuaded by Appellant's argument that the Examiner erred in rejecting independent claim 12 under 35 U.S.C. § 102(b) because Olson does not disclose that personalized health-related information is determined by correlating content previously delivered to a requester, in response to a request for content, with a known health condition of the requestor, i.e., limitation (C), as recited in claim 12 (Br. 12–15).

Olson is directed to a decision-support system comprising one or more decision-support modules in communication with one or more user modules via a network; Olson discloses that through this configuration, as shown in Figure 2, a patient or clinician may input data regarding the patient's health, medical conditions, billing information, and past and current medical care, i.e., "patient data" (Olson, col. 7, ll. 7–20). This patient data are stored and analyzed, e.g., together with other stored patient data (*id.* at col. 6, ll. 62–65), to generate decision-supported patient data, i.e., data that assist the clinician in making a medical diagnosis or medical care decision (*id.*

at col. 7, ll. 20–24). The decision-supported patient data then are provided to the clinician in real-time or perceived real-time (*id.* at col 6, l. 65 – col. 7, l. 2; *see also* col. 8, ll. 15–30; col. 9, ll. 28–49).

Olson further details, at column 8, lines 15–30 and column 9, lines 28–49, cited by the Examiner (Non-Final Act. 5), that patient data are collected and analyzed by decision-support module 210a–210n, and that decision-supported patient data, e.g., recommended treatments, procedures, tests, therapeutic drugs, are subsequently transmitted to user module 214a–214n. Olson, thus, plainly discloses that information specific, i.e., personalized, to a particular patient is delivered to a clinician and patient (*see, e.g.*, Olson, col. 9, ll. 28–30 ("Generally, the configuration of system 200 facilitates the gathering of patient data and delivery of decision-supported patient data to a clinician and patient.")). But we find nothing in the cited portions of Olson that discloses that this personalized information, i.e., the decision-supported patient data, is determined by correlating content, previously delivered to the patient, in response to a request for content, with a known health condition of the patient, as claim 12 requires.

Therefore, we do not sustain the Examiner's rejection of independent claim 12 under 35 U.S.C. § 102(b) as anticipated by Olson. For the same reasons, we also do not sustain the rejection of dependent claims 13–16.

Independent Claims 1 and 19 and Dependent Claims 2–5, 20, and 21

Independent claims 1 and 19 include language substantially similar to the language or independent claim 12. Therefore, we do not sustain the Examiner's rejection of 1–5 and 19–21 under 35 U.S.C. § 102(b) as anticipated by Olson for the same reasons set forth above with respect to claim 12.

Obviousness

Dependent Claims 6–11, 17, 22, and 23

Each of dependent claims 6–11, 17, 22, and 23 depends from one of independent claims 1, 12, and 19. The Examiner's rejections of these dependent claims under 35 U.S.C. § 103(a) are based on the same rationale with respect to Olson applied in the anticipation rejection of independent claims 1, 12, and 19. Therefore, we do not sustain the rejections of dependent claims 6–11, 17, 22, and 23 under § 103(a) for substantially the same reasons set forth above with respect to the independent claims.

Rejections Based on Goldman

Anticipation

Independent Claim 12 and Dependent Claims 13–16

For reasons substantially similar to those set forth above, we are persuaded by Appellant's argument that the Examiner erred in rejecting independent claim 12 under 35 U.S.C. § 102(b) because Goldman does not disclose that personalized health-related information is determined by correlating content previously delivered to a requester, in response to a request for content, with a known health condition of the requestor, i.e., limitation (C), as recited in claim 12 (Br. 40–45).

Goldman is directed to a health care system for specifying edibles to individual subjects, and discloses that data (e.g., personal, physical, and health, information) are collected for an individual (e.g., from the individual himself/herself, doctor's offices, hospitals, etc.) and evaluated to, thus, provide the individual with a personalized prescription (e.g., comprising one or more drugs, food products, or other combinations) designed to address the individual's needs and compensate for any deficiencies.

We have carefully reviewed the portions of Goldman cited by the Examiner (Non-Final Act. 15). But, as with Olson, we find nothing in the cited portions of Goldman that discloses that personalized information, i.e., a personalized prescription, is determined by correlating content, previously delivered to an individual, in response to a request for content, with a known health condition of that individual, as claim 12 requires.

Therefore, we do not sustain the Examiner's rejection of independent claim 12 under 35 U.S.C. § 102(b) as anticipated by Goldman. For the same reasons, we also do not sustain the rejection of dependent claims 13–16.

Independent Claims 1 and 19 and Dependent Claims 2–5 and 20–22

Independent claims 1 and 19 include language substantially similar to the language or independent claim 12. Therefore, we do not sustain the Examiner's rejection of 1–5 and 19–22 under 35 U.S.C. § 102(b) as anticipated by Goldman for the same reasons set forth above with respect to claim 12.

Obviousness

Dependent Claims 6–11, 17, and 23

The Examiner's rejections of dependent claims 6–11, 17, and 23 under 35 U.S.C. § 103(a) are based on the same rationale with respect to Goldman applied in the anticipation rejection of independent claims 1, 12, and 19. Therefore, we do not sustain the rejections of dependent claims 6–11, 17, and 23 under § 103(a) for substantially the same reasons set forth above with respect to the independent claims.

DECISION

The Examiner's rejection of claims 1–17 and 19–23 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejections of claims 1–5, 12–16, and 19–22 under 35 U.S.C. § 102(b) are reversed.

The Examiner's rejections of claims 6–11, 17, 22, and 23 under 35 U.S.C. § 103(a) are reversed.

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).

AFFIRMED