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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YASSER ALSAFADI

Appeal 2016-008129
Application 11/572,669
Technology Center 3600

Before ANTON W. FETTING, BIBHU R. MOHANTY, and MICHELLE R. OSINSKI, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1–16 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention is directed to a decision support system for use in healthcare (Spec. 1:3–5)[1]. Claim 12, reproduced below, is representative of the subject matter on appeal.

> 12. A method for exchanging data between an executable guideline decision support system and a local information storage system, comprising:
>
> executing with a processor at least one guideline of a plurality of guidelines stored in an executable guideline storage system of a decision support system, and executing includes processing data associated with a second data element, and corresponding data is associated with a plurality of first data elements stored in a local information storage system, and the corresponding data of the plurality of first data elements include at least one of an imaging result by an imaging device or a lab result by a lab device; and
>
> generating a request to exchange data between the local information system and the decision support system, wherein the data being exchanged is included in the data associated with the second data element and generating includes:
>
> determining a first data element of the plurality of first data elements that corresponds to the second data element, and at least one interoperability parameter defining how the first and second data elements correspond and establishing semantic interoperability;
>
> processing the data associated with the second data element being exchanged in accordance with the determined at least one interoperability parameter which modifies the data associated with the second data element to the corresponding data associated with the first data element; and
>
> transmitting the processed data being exchanged between the first and second data elements to the local information storage system.

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[1] We herein refer to the Specification, filed Jan 25, 2007 ("Spec."); Final Office Action, mailed Oct. 21, 2015 ("Final Act."); Appeal Brief, filed Feb. 1, 2016 ("App. Br."); Examiner's Answer, mailed July 1, 2016 ("Ans."). A Reply Brief, filed Aug. 25, 2016 was not cited in this Decision.

THE REJECTION

The following rejection is before us for review:

Claims 1–16 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence[2].

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellant argues that the rejection of claim 12 is improper because the claim is not directed to an abstract idea, and is also more than the alleged abstract idea (App. Br. 2–5, Reply Br. 2–5).

In contrast, the Examiner has determined that the rejection of record is proper (Final Act. 2, 3, Ans. 2–5).

We agree with the Examiner. 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: "laws 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).

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[2] *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

In judging whether claim 12 falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court's two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is "directed to" a patent-ineligible abstract idea. If so, we then consider the elements of the 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 of the abstract idea. *Id.* This is a search for an "inventive concept" an element or combination of elements sufficient to ensure that the claim amounts to "significantly more" than the abstract idea itself. *Id.* The Court also stated that "the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention". *Id.* at 2358.

Here, we determine that the claim is directed to comparing new and stored data using guidelines to identify options for decision making. This is an idea in itself or a method of organizing human activities and is an abstract idea beyond the scope of § 101. The claim preamble is directed to "exchanging data between an executable decision support system and local information storage system". The Specification states that the invention is directed to a "decision support system" in paragraph 1. *See Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016) where collecting information, analyzing it, and displaying certain results of the collection and analysis was held to be an abstract idea.

We next consider whether additional elements of the claim, both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the abstract idea over using generic computer components. We conclude that it does not. The Specification at page 4 states the method uses generic components including a processor, LAN and WAN networks, CD-ROM, and the Internet to operate.

Considering each of the claim elements in turn, the function performed by the computer system at each step of the process is purely conventional. Each step of the claimed method does no more than require a generic computer to perform a generic computer function.

We note the point about pre-emption (App. Br. 7). While pre-emption "might tend to impede innovation more than it would tend to promote it, 'thereby thwarting the primary object of the patent laws"' (*Alice*, 134 S. Ct. at 2354 (quoting *Mayo*, 132 S. Ct. at 1293), "the absence of complete preemption does not demonstrate patent eligibility" (*Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015)). *See also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015), cert, denied, 136 S. Ct. 701, 193 (2015)("[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.").

For these above reasons, the rejection of claim 12 and its dependent claims which were not separately argued is sustained.

We reach the same conclusion as to independent system claim 1 and its dependent claims. Here, as in *Alice*, "the system claims are no different

in substance from the method claims. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea." *Alice* 134 S. Ct. at 2351. "[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea 'while adding the words "apply it"' is not enough for patent eligibility." *Id.* at 2358 (quoting *Mayo*, 132 S. Ct. at 1294).

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1–16 under 35 U.S.C. § 101.

DECISION

The Examiner's rejection of claims 1–16 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)(1)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED