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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JONATHON E. GIFTAKIS, NINA M. GRAVES,  
JONATHAN C. WERDER, ERIC J. PANKEN, TIMOTHY J. DENISON,  
KEITH A. MIESEL, and MICHELE H. HERZOG

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Appeal 2016-008368  
Application 12/359,055  
Technology Center 3700

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Before STEVEN D.A. McCARTHY, NATHAN A. ENGELS, and  
ERIC C. JESCHKE, *Administrative Patent Judges*.

JESCHKE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jonathon E. Giftakis et al. (“Appellants”)<sup>1</sup> seek review under 35 U.S.C. § 134(a) of the Examiner’s decision, as set forth in the Final Office Action dated August 7, 2015 (“Final Act.”), and as further explained in the Advisory Action dated October 23, 2015, rejecting claims 33–79 and 86–91. We have jurisdiction under 35 U.S.C. § 6(b).

*We affirm.*

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<sup>1</sup> Appellants identify Medtronic plc of Dublin, Ireland as the real party in interest. Appeal Br. 3.

## BACKGROUND

The disclosed subject matter “relates to patient monitoring, and, more particularly, to collecting information to evaluate a patient condition.” Spec. ¶ 2. Claims 33, 38, and 47 are independent. Claim 33 is reproduced below, with bracketed letters added to identify each clause:

33. A method comprising:

[A] receiving, by a processor, a signal from a motion sensor, wherein the signal is indicative of motion of a patient;

[B] detecting a seizure of the patient;

[C] after detecting the seizure, determining, by the processor, a seizure metric comprising a seizure type based on the signal from the motion sensor by at least selecting the seizure type from a plurality of predetermined seizure types based on the signal from the motion sensor, the plurality of predetermined seizure types comprising a tonic-clonic seizure and a complex partial seizure; and

[D] storing, by the processor, the seizure metric comprising the seizure type in a memory.

## REJECTIONS

1. Claims 33–79 and 86–91 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

2. Claims 33–79 and 86–91 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.<sup>2</sup>

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<sup>2</sup> The Examiner separates the discussion of this Rejection into two groups of claims, however, both groups are rejected on the same basis. *See*

### DISCUSSION<sup>3</sup>

*Rejection 1 – The rejection of claims 33–79 and  
86–91 under 35 U.S.C. § 112, first paragraph*

The Examiner stated that “[t]he independent claims each call for using a motion sensor signal to determine a seizure type, where the type is selected from a group including complex partial seizures” and that “[t]he disclosure does not associate identification of complex partial seizures with detected motion.” Final Act. 2. According to the Examiner, “[t]he disclosure only lists complex partial seizures as a type that may be detected from intracranial pressure monitoring (paragraph [0155])” and “also lists the types of seizures that *can* be detected from a motion signal in paragraph [0178]:”

In the example shown in FIG. 13, the seizure metric is a seizure type, whereby a first seizure type is associated with convulsive patient motion (e.g., a clonic seizure or a tonic-clonic seizure) and a second seizure type is not associated with convulsive patient motion (e.g., an absence seizure, atonic seizure).

Final Act. 2–3 (quoting Spec. ¶ 178). The Examiner stated that “[t]here is no blanket disclosure that extrapolates the disclosure such that all types of signals may be used to identify any desired type of seizure” and that “[t]he disclosure does not provide support for categorizing a complex partial seizure in any type disclosed as being identifiable using a motion signal.”

Final Act. 3.

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Final Act. 3–4 (claims 33–37, 57–66, 86, and 87), 4–5 (claims 38–56, 67–79, and 88–91). We address both sets of claims as part of Rejection 2.

<sup>3</sup> Appellants identify Application No. 12/359,037 as a potentially related application. Appeal Br. 3. The Patent Trial and Appeal Board rendered a decision on appeal in that application on June 26, 2017. We have reviewed that decision and, to the extent relevant to the issues in the present appeal, have taken that decision into account in the analysis below.

For this Rejection, Appellants argue independent claim 33 and rely on the same arguments for independent claims 38 and 47. *See* Appeal Br. 13–17. We address claim 33, with claims 34–79 and 86–91 standing or falling with claim 33. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2015).

First, Appellants argue that the Examiner “has not met the burden of establishing a *prima facie* case of lack of written description support.”

Appeal Br. 13. We disagree.

“In the context of the written description requirement, an adequate *prima facie* case must . . . sufficiently explain to the applicant what, in the examiner’s view, is missing from the written description.” *Hyatt v. Dudas*, 492 F.3d 1365, 1370 (Fed. Cir. 2007); *see also In re Alton*, 76 F.3d 1168, 1175 (Fed. Cir. 1996) (“Insofar as the written description requirement is concerned, th[e] burden [of presenting a *prima facie* case] is discharged by ‘presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.’” (quoting *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976))). Based on the statement of the Rejection (Final Act. 2–3), we determine that the Examiner provided sufficient explanation to present a *prima facie* case, such that Appellants were “properly notified and able to respond.” *Hyatt*, 492 F.3d at 1370. We also determine that the statement of the Rejection provides “acceptable . . . reasoning” to rebut the presumption that the Specification as filed is adequate. *In re Marzocchi*, 439 F.2d 220, 224 (CCPA 1971), *discussed at* Manual of Patent Examining Procedure (“MPEP”) § 2163.04; *see also* Appeal Br. 14 (discussing *In re Marzocchi*).

Second, Appellants argue that the Examiner “has not shown that one of ordinary skill in the art would not have understood a complex partial

seizure to have fallen within either a seizure type associated with convulsive patient motion or a second seizure type not associated with convulsive patient motion.” Appeal Br. 15.

We are not apprised of error by this argument. For the reasons discussed above, the Examiner has presented a prima facie case. After a party has been notified by a prima facie case, “the burden shifts to the [party] to rebut the prima facie case with evidence and/or argument.” *Hyatt*, 492 F.3d at 1370. To overcome the prima facie case here, Appellants were required to “show that the invention as claimed is adequately described to one skilled in the art.” *Alton*, 76 F.3d at 1175; *see also id.* (“After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of the evidence with due consideration to persuasiveness of argument.” (quoting *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992))). The Examiner was not required to show the *absence* of understanding by one of ordinary skill in the art as to the relevant issue.

Third, Appellants contend that the Examiner’s finding that “[t]he disclosure does not provide support for categorizing a complex partial seizure in any type disclosed as being identifiable using a motion signal’ is in error.” Appeal Br. 15 (quoting Final Act. 3). In support, Appellants identify various disclosures of paragraphs 8, 181, 154, and 155 of the Specification. *Id.* According to Appellants,

In view of at least the paragraphs of the [Specification] discussed above, one of ordinary skill in the art would understand that a signal indicative of motion of a patient may be used to differentiate between a variety of seizure types and determine a type of seizure, the types of seizures including “simple partial

seizures, complex partial seizures, absence seizures, tonic-clonic seizures, and the like.”

Appeal Br. 16 (quoting Spec. ¶ 155).

We are not apprised of error by this argument. As noted by the Examiner, paragraph 178 “indicates that a motion signal may be used to distinguish between convulsive and non-convulsive seizures” (Ans. 8), however, Appellants have not shown that one of ordinary skill in the art would have recognized a complex partial seizure as falling into either of these categories. In paragraph 178, “a clonic seizure or a tonic-clonic seizure” are disclosed as examples of “a first seizure type . . . associated with convulsive patient motion” whereas “an absence seizure, atonic seizure” are disclosed as examples of “a second seizure type . . . not associated with convulsive patient motion.” Spec. ¶ 178. As noted by the Examiner, paragraph 155—the only paragraph to discuss “complex partial seizures”—does not address the use of “motion data[] for determining a type of seizure that has been observed.” Ans. 8–9. The Examiner states that “[a] complex partial seizure is one that can include movements, but not necessarily convulsions, whereas a tonic-clonic seizure is a ‘classic’ convulsive seizure, and convulsion[s] are explicitly disclosed as being identifiable using motion signals.” Ans. 8 (internal citations omitted, citing Spec. ¶ 154).

As to paragraphs 8, 154, and 181 of the Specification (also relied on by Appellants), we agree with the Examiner that these paragraphs contain “no description of how a complex partial seizure can be recognized using a motion signal, or even any recognition of any characteristic of a complex partial seizure that is identifiable using a motion signal.” Ans. 9. Paragraph 154, for example, discloses that the system “may monitor the patient’s

activity level and determine a type of seizure (e.g., convulsive or nonconvulsive, or sensory seizure or motor seizure) . . . based on the patient’s activity level during the seizure,” but, as noted by the Examiner, “[t]he disclosure does not categorize a complex partial seizure as non-convulsive, sensory, motor, or any other type that is described as being identifiable using a motion signal” (Ans. 9). *See also* Spec. ¶ 181 (disclosing using a “signal from a motion sensor” to categorize a “seizure as a first type (152) of seizure if the patient activity level exceeds the first threshold value” and “as a second type (154) of seizure [if] the patient activity level is not greater than or equal to the threshold value”).

Further, we agree with the Examiner that Appellants are “essentially arguing that, because the disclosure states that complex partial seizures are a known type of seizure [*see* Spec. ¶ 155] and that some seizures can be identified using motion signals [*see, e.g.,* Spec. ¶¶ 8, 154, 178, 181], one of ordinary skill in the art would be able to use the given disclosure to identify a complex partial seizure using only a motion signal.” Ans. 9; *see also* Appeal Br. 16 (second sentence in first paragraph). We also agree with the Examiner that this argument is not persuasive. *See* Ans. 9 (stating that “[m]erely being present in the same disclosure does not provide possession of this particular correlation between a motion signal and a complex partial seizure”).

Fourth, in the Reply Brief, Appellants argue that “[t]he Examiner appears to be asserting that claim 33 requires using only a motion signal to identify a complex partial seizure,” “[h]owever, claim 33 does not include such a limitation.” Reply Br. 10. Appellants argue that “the [S]pecification



describes that other factors may be used in addition to a motion signal.” *Id.* (discussing Spec. ¶¶ 154, 155).

We disagree that the Examiner has “rel[ie]d on an incorrect interpretation” of claim 33. Reply Br. 10. In clause *C*, claim 33 recites “determining, by the processor, a seizure metric comprising a seizure type *based on the signal from the motion sensor* by at least selecting the seizure type from a plurality of predetermined seizure types *based on the signal from the motion sensor*.” Appeal Br. 19 (Claims App.) (emphasis added). Under the broadest reasonable interpretation, we view claim 33 as at least *including* an embodiment in which the “determining” step is performed based *only* “on the signal from the motion sensor,” as opposed to that signal and other unclaimed and unidentified factors.

Because the Examiner has found that the Specification fails to reasonably convey to those skilled in the art that Appellants had possession of the full scope of independent claim 33, and Appellants have not shown error in this finding, we sustain the rejection of claim 33 for lack of written description support. Claims 34–79 and 86–91 fall with claim 33.

*Rejection 2 – The rejection of claims 33–79  
and 86–91 under 35 U.S.C. § 101*

The Supreme Court has established “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. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 132 S. Ct. 1289, 1294 (2012)). Under the *Alice* framework, we first “determine whether the claims at issue are directed to one of those patent-ineligible concepts”—i.e., a law

of nature, a natural phenomenon, or an abstract idea. *Id.* If so, we 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.* (quoting *Mayo*, 132 S. Ct. at 1298, 1297). The Supreme Court has described 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) (quoting *Mayo*, 132 S. Ct. at 1294).

A. Claims 33–37, 57–66, 86, and 87

As to Rejection 2, for the claims in this group, Appellants argue independent claim 33 and do not separately argue claims 34–37, 57–66, 86, and 87, which depend from claim 33. Appeal Br. 6–10. We address claim 33, with claims 34–37, 57–66, 86, and 87 standing or falling with claim 33. *See* 37 C.F.R. § 41.37(c)(1)(iv).

In the Rejection, the Examiner stated that claim 33 is “directed to the abstract idea of processing data” and that “[t]he additional elements or combination of elements in the claim[] other than the abstract idea per se amount to no more than: mere instructions to implement the idea on a computer/processor.” Final Act. 4. According to the Examiner, when “[v]iewed as a whole, these additional claim elements do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself.” *Id.*

First, Appellants argue that the Examiner “has not met the burden of establishing that Appellant[s]’ claims tie-up or pre-empt others from ‘processing data’ or ‘mathematically correlating a sensed signal with a type of seizure,’ and pre-empt others from ‘data processing.’” Appeal Br. 8; *see also id.* at 7 (“The present claims do not ‘seek to tie up any judicial exception such that others cannot practice it.’” (quoting 2014 Interim Guidance on Patent Subject Matter Eligibility, 79 Fed. Reg. 74,618, 74,625 (Dec. 16, 2014))). According to Appellants, claim 33 “recite[s] a **specific way** of determining a seizure metric comprising a seizure type, which adds meaningful limits on the use of ‘correlating a sensed signal with a type of seizure.’” Appeal Br. 8 (quoting Final Act. 6); *see also* Appeal Br. 8 (highlighting certain language in claim 33).

We are not apprised of error based on this argument. The Supreme Court has stated that “patents that . . . integrate the building blocks [of human ingenuity] into something more, []thereby transform[ing] them into a patent-eligible invention . . . pose no comparable risk of pre-emption, and therefore remain eligible for the monopoly granted under our patent laws.” *Alice*, 134 S. Ct. at 2354–55 (citations and quotations omitted). Although preemption “might tend to impede innovation more than it would tend to promote it, ‘thereby thwarting the primary object of the patent laws’” (*id.* at 2354 (citing *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) (“[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.”). Thus, even assuming claim 33 recites “a **specific way** of determining a seizure metric” (Appeal Br. 8)—such that claim 33 does not preempt the entirety of the identified abstract idea—that does not demonstrate that claim 33 is directed to patent-eligible subject matter.

We are also not apprised of error based on the contention that claim 33 “recite[s] a specific type of sensed signal – a motion signal – as well as [a] specific technique of using the signal to select a seizure type from a plurality of predefined seizure types *in a way that improves the technology itself.*” Appeal Br. 8 (emphasis added); *see also id.* at 9 (discussing certain aspects of the 2014 Interim Guidance on Patent Subject Matter Eligibility related to “Improvements”). As noted by the Examiner, Appellants have not explained how the subject matter of claim 33 is an improvement to the technology itself. *See* Ans. 7 (second paragraph).

Second, Appellants argue that the Examiner “failed to meet the burden of demonstrating that claim 33 fails to recite additional elements that add significantly more to the alleged abstract idea.” Appeal Br. 9. Appellants contend that “[i]t is unclear . . . how the subject matter of claim 33, such as ‘determining . . . a seizure metric . . . based on the signal from the motion sensor,’ amounts to a ‘mere instruction[] to implement the idea [of data processing] on a computer/processor.’” Appeal Br. 10 (quoting *id.* at 19 (Claims App.) and Final Act. 4). According to Appellants, “[t]aking all the claim elements both individually and as an ordered combination, claim 33 as a whole amounts to significantly more than ‘processing data’ and ‘mathematically correlating a sensed signal with a type of seizure.’” Appeal Br. 10 (footnote omitted) (quoting Final Act. 4, 6).

We are not apprised of error by this argument. We conclude that the Examiner’s analysis and remarks (Final Act. 3–4, 6) are sufficient to place Appellants on notice regarding the Examiner’s positions as to step 2 of the *Alice* analysis, as required under 35 U.S.C. § 132. *See also In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (stating that “the PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies 35 U.S.C. § 132, in ‘notify[ing] the applicant . . . [by] stating the reasons for [its] rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application’” (quoting 35 U.S.C. § 132)). Moreover, as stated by the Examiner, Appellants “state[] that it is ‘unclear’ how the claimed subject matter amounts to mere instruction to implement the idea on a computer, but do[] not specifically address how a computer or processor does anything more than automate the task of pattern matching.” Ans. 7. Further, to the extent Appellants rely on the fact that the recited “motion sensor” is physical structure, we note that our reviewing court has affirmed rejections under § 101 when “the only physical step involves merely gathering data for the algorithm.” *See In re Grams*, 888 F.2d 835, 839 (Fed. Cir. 1989).

Third, in the Reply Brief, Appellants argue that the Examiner failed to follow a May 2016 Memorandum<sup>4</sup>, which states:

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<sup>4</sup> *See* Memorandum from Robert W. Bahr, Deputy Commissioner for Patent Examination Policy to the Patent Examiner Corps (May 4, 2016), <https://www.uspto.gov/sites/default/files/documents/ieg-may-2016-memo.pdf> (last visited Dec. 20, 2017).

when an examiner determines that a claim is directed to an **abstract idea** (Step 2A), the rejection should identify the abstract idea as it is recited (*i.e.*, set forth or described) in the claim and explain why it corresponds to a concept that the courts have identified as an abstract idea.

May 2016 Memorandum at 1, *discussed at* Reply Br. 5. Appellants also argue that the Examiner failed to follow a July 2016 Memorandum<sup>5</sup> discussing the Federal Circuit’s decision in *Rapid Litigation Management Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042 (Fed. Cir. 2016):

First, the court emphasized that the “directed to” analysis of a process claim requires more than “merely identify[ing] a patent-ineligible concept underlying the claim” and instead requires an analysis of whether “the end result of the process, the essence of the whole, was a patent-ineligible concept.”

July 2016 Memorandum at 1–2, *discussed at* Reply Br. 5.

Relying on the May 2016 Memorandum, Appellants argue that, in identifying the abstract idea at issue, “the Examiner relied upon the Examiner’s own characterization of the language of claim 33 to identify the alleged non-statutory subject matter, instead of identifying an abstract idea in any portion of claim [33] as recited.” Reply Br. 5. Relying on the July 2016 Memorandum, Appellants argue that the Examiner “failed to provide an analysis of whether ‘the end result of the process, the essence of the whole, was a patent-ineligible concept.’” *Id.* (quoting, with emphasis added, July 2016 Memorandum at 1–2).

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<sup>5</sup> See Memorandum from Robert W. Bahr, Deputy Commissioner for Patent Examination Policy to the Patent Examiner Corps (July 14, 2016), [https://www.uspto.gov/sites/default/files/documents/memo\\_rlm-sequenom.pdf](https://www.uspto.gov/sites/default/files/documents/memo_rlm-sequenom.pdf) (last visited Dec. 20, 2017).

As an initial matter, any examiner’s failure to follow the Director’s guidance is appealable only to the extent that the examiner has failed to follow statute or binding case law. That is, to the extent the Director’s guidance goes *beyond* binding case law and is more restrictive on the examiner than the case law, failure of the examiner to follow those added restrictions is a matter for petition to the Director, not for appeal. Reviewing the argument against the statute and case law, we determine that the Examiner’s identification of the abstract idea—“mathematically correlating a sensed signal with a type of seizure” (Final Act. 6)—properly reflected “the ‘focus’ of the claims, their ‘character as a whole.’” *Elec. Power Grp. LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (quoting *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016) and *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). To the extent argued by Appellants, the fact that claim 33 does not expressly recite “processing data” does not show error in the Examiner’s identification of the abstract idea. *See* Reply Br. 5 (discussing “identifying an abstract idea in any portion of claim [33] as recited”).

Moreover, the Federal Circuit has held claims ineligible under § 101 when directed to a process of measuring parameters indicative of an individual’s condition to determine, using an algorithm, whether the condition is abnormal. *See In re Grams*, 888 F.2d at 836–37; *see also Elec. Power*, 830 F.3d at 1353–54 (“collecting information” and “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more” are abstract ideas); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014) (“Without additional limitations, a process that employs mathematical algorithms to

manipulate existing information to generate additional information is not patent eligible.”). As to the discussion in *Rapid Litigation Management*, 827 F.3d at 1048, of whether “the end result of the process . . . was a patent-ineligible concept” (*see* Reply Br. 5), in the context of claim 33 here, the “end result of the process” is a “seizure metric” (i.e., data)—created during the process and stored “in a memory.” *See* Appeal Br. 19 (Claims App.) (claim 33, clause *D*).

For these reasons, we sustain the rejection of independent claim 33 under 35 U.S.C. § 101. Claims 34–37, 57–66, 86, and 87 fall with claim 33.

B. Claims 38–46, 67–79, 88, and 89

For the claims in this group, Appellants argue independent claim 38 and do not separately argue claims 39–46, 67–79, 88, and 89, which depend from claim 38. Appeal Br. 10–13. We address claim 38, with claims 39–46, 67–79, 88, and 89 standing or falling with claim 38. *See* 37 C.F.R. § 41.37(c)(1)(iv). The Examiner stated that claim 38 is “directed to the abstract idea of processing data by organizing information through mathematical correlations (correlating a sensed signal with a known type of condition), which the courts have found to be abstract.” Final Act. 4; *see also id.* at 6 (stating that “the claims are, as whole, directed to the abstract idea of mathematically correlating a sensed signal with a type of seizure”). The Examiner also stated that claim 38 does not:

include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional elements or combination of elements in the claims other than the abstract idea per se amount to no more than: recitation of generic computer structure (a processor, a memory, a computer) that serves to perform generic computer functions that are well-understood, routine, and conventional activities



previously known to the pertinent industry. [Claim 38] also make[s] reference to a motion sensor, but use of a sensor to perform sensing is considered insignificant extrasolution activity that would be insufficient to provide anything “significantly more” to the claims.

*Id.* at 4–5. According to the Examiner, when “[v]iewed as a whole, these additional claim elements do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself.”

*Id.* at 5.

First, Appellants argue that “while the [Examiner] makes the bare assertion that claim 38 [includes a] ‘recitation of a generic computer structure (a processor, a memory, a computer) that serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the pertinent industry,’ [the Examiner] has provided no evidence of this.” Appeal Br. 11 (quoting Final Act. 4–5) (footnote omitted). Appellants argue that the Examiner “has not even alleged that claim 38 is unpatentable based on prior art or otherwise attempted to show that the alleged ‘well-understood, routine, and conventional activities’ recited in the claims were previously known.” *Id.* (footnote omitted).

We are not apprised of error by this argument. We conclude that the Examiner’s analysis and remarks (Final Act. 4–5, 6) are sufficient to place Appellants on notice regarding the Examiner’s positions as to step 2 of the *Alice* analysis, as required under 35 U.S.C. § 132. *See also In re Jung*, 637 F.3d at 1362. Moreover, Appellants’ more restrictive requirement—that the Examiner identify record evidence supporting the statement at issue—is not supported by case law. *See, e.g., Alice*, 134 S. Ct. at 2359 (stating how

certain “computer functions are ‘well-understood, routine, conventional activit[ies]’ previously known to the industry”). As to the argument that the Examiner is not relying on prior art for the statement at issue, we note that “[t]he ‘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.”

*Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981).

Second, Appellants argue that the Examiner “has not shown that the ‘signal from a motion sensor, wherein the signal is indicative of motion of a patient’ recited in claim 38 is ‘not central to the purpose of the method invented by the applicant.’” Appeal Br. 11 (quoting claim 38 and MPEP § 2106(II)(B)).<sup>6</sup> Appellants contend that “the use of a signal from a motion sensor to determine a seizure metric amounts to an improvement to a technology or technical field” because (1) “use of such a signal from a motion sensor may provide for more specific categorization of seizure types and, thus, more effective treatment, than previous systems” and/or (2) “use of such a signal from a motion sensor may be used, along with one or more signals indicating intracranial pressure, as an alternative to bioelectrical brain signals, to determine seizure types.” Appeal Br. 12 (citing *Alice*, 134 S. Ct. at 2359–60, and Spec. ¶¶ 4, 5, 8, 154–156, 160, 178, 181).

We are not apprised of error here. As noted by the Examiner, “[i]nclusion of a motion sensor for the purpose of obtaining a ‘motion signal’ is insignificant extra-solution activity” because “the central propose of the invention [in claim 38] is the interpretation of that signal, not how it is

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<sup>6</sup> Appellants appear to quote from Section 2106(II)(B) of MPEP, Ninth Edition, Rev. 11.2013 (March 2014).

obtained.” Ans. 7–8; *see also Grams*, 888 F.2d at 839 (affirming a rejection under § 101 when “the only physical step involves merely gathering data for the algorithm”). As to Appellants’ reliance on (a prior version of) the MPEP, we first note that the section quoted relates to method claims. Second, to the extent applicable, the sentence quoted by Appellants is followed by a statement that supports the Examiner’s position: “For example, gathering data to use in the method when all applications of the method would require some form of data gathering would not impose a meaningful limit on the claim.” MPEP § 2106(II)(B) (9th ed., Rev. 11.2013, Mar. 2014).

Moreover, the first purported improvement identified—that “use of . . . a signal from a motion sensor may provide for *more specific categorization* of seizures types . . . than previous systems using only bioelectrical brain signals”—is not supported by the Specification. *See* Appeal Br. 12 (emphasis added) (citing Spec. ¶¶ 4, 5, 8, 154, 155, 160, 178, 181). Appellants have not identified any statements in the Specification (and we do not identify any in our review) that compare the level of categorization provided by the use of motion sensor data with the level of categorization provided in prior systems. As to the second purported improvement—that “use of such a signal from a motion sensor may be used, along with one or more signals indicating intracranial pressure, as an alternative to bioelectrical brain signals, to determine seizure types”—we note that claim 38 does not require the use of a signal from a motion sensor “*along with* one or more signals indicating intracranial pressure.” Appeal Br. 12 (emphasis added). As such, the second purported improvement is not commensurate in scope with claim 38. *See In re Self*, 671 F.2d 1344, 1348

(CCPA 1982) (rejecting arguments “not based on limitations appearing in the claims”).

For these reasons, we sustain the rejection of independent claim 38 under 35 U.S.C. § 101. Claims 39–46, 67–79, 88, and 89 fall with claim 38.

C. Claims 47–56, 90, and 91

As part of Rejection 2, the Examiner addressed independent claim 47 (and claims 48–56, 90, and 91, which depend from claim 47) along with independent claim 38 (and claims 39–46, 67–79, 88, and 89, which depend from claim 38). *See* Final Act. 4–5. For claims 47–56, 90, and 91, Appellants rely on the same arguments discussed above with regard to claims 33 and 38 (*see supra* Rejection 2, §§ A, B). Appeal Br. 13. Because we are not apprised of error based on those arguments, we sustain the rejection of claims 47–56, 90, and 91 under 35 U.S.C. § 101.

DECISION

We *affirm* the decision to reject claims 33–79 and 86–91 under 35 U.S.C. § 112, first paragraph, and we *affirm* the decision to reject claims 33–79 and 86–91 under 35 U.S.C. § 101.

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