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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK A. HOFFMAN

Appeal 2016-008486
Application 12/860,663[1]
Technology Center 3600

Before ST. JOHN COURTENAY III, MICHAEL R. ZECHER, and JOYCE CRAIG, *Administrative Patent Judges*.

CRAIG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–7 and 10–20, which are all of the claims pending in this application.[2] We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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[1] According to Appellant, the real party in interest is Cerner Innovation, Inc. Br. 3. This appeal is related to Appeal No. 2017-003857. *See id.*

[2] Claims 8 and 9 have been canceled. Br. 21 (Claims App'x).

INVENTION

Appellant's application relates to dynamically adjusted rules-based decision support using site-specific mapped values. Abstract. Claim 1 reads as follows:

> 1. One or more non-transitory computer storage media storing computer-useable instructions that cause one or more computing devices at a central system to perform a method comprising:
>
> receiving site-specific codes that identify a category of summary data at a healthcare site system;
>
> mapping each of the site-specific codes to a standard code;
>
> receiving a request for a set of site-specific codes corresponding to the summary data that is to be extracted from the healthcare site system;
>
> at a web service of the central system, receiving a request from the healthcare site system for one or more dynamic threshold values that are dynamically changeable values associated with healthcare data, the dynamically changeable values defining a set of data to be extracted from the healthcare site system and having one or more portions of logic associated with one or more rules;
>
> determining the one or more dynamic threshold values;
>
> communicating the set of site-specific codes, to be identified in a set of one or more extraction scripts, and the one or more dynamic threshold values to the healthcare site system;
>
> receiving, from the healthcare site system, a request for an update to the one or more rules associated with the one or more portions of logic of the dynamic threshold values;
>
> communicating a portion of logic to the healthcare site system in response to receiving the request for the update to the one or more rules, wherein the one or more rules are tuned at the healthcare site system based on the communicated portion of logic, thereby updating the dynamic threshold values; and

> in response to execution of the set of one or more extraction scripts on the healthcare site system, receiving summary data defined by the one or more rules having the updated dynamic threshold values, wherein the set of one or more extraction scripts is tuned based on the set of site-specific codes and the updated dynamic threshold values.

REJECTION

Claims 1–7 and 10–20 stand rejected under 35 U.S.C. § 101 because the claimed subject matter is judicially-excepted from patentability. Final Act. 12–13; Ans. 3–4.

ANALYSIS

We have reviewed the rejection of claims 1–7 and 10–20 in light of Appellant's arguments that the Examiner erred. We have considered in this decision only those arguments Appellant actually raised in the Briefs. Any other arguments Appellant could have made, but chose not to make, in the Briefs are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Appellant's arguments are not persuasive of error. We agree with and adopt as our own the Examiner's findings of facts and conclusions as set forth in the Answer (Ans. 4–16) and in the Action from which this appeal was taken (Final Act. 12–13). We provide the following explanation for emphasis.

Appellant first contends the Examiner failed to establish a prima facie case of patent ineligibility under § 101. Br. 8. We disagree. The Federal Circuit has repeatedly explained 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 Examiner carries

the burden of establishing a prima facie case when its rejection satisfies 35 U.S.C. § 132 by setting forth a rejection in a sufficiently articulate and informative manner. *In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011). If the Examiner "adequately explain[s] the shortcomings . . . the burden shifts to the applicant to rebut the prima facie case with evidence and/or argument." *Hyatt*, 492 F.3d at 1370.

The Final Office Action adequately explains the § 101 rejection. *See* Final Act. 3, 14–15. The Examiner's statements satisfy § 132 because they apply the *Mayo/Alice* analytical framework and apprise Appellant of the reasons for the § 101 rejection under that framework. Appellant has recognized the Examiner's *Mayo/Alice* analysis and has presented arguments regarding each step. See Br. 7–18. Appellant has not responded by alleging a failure to understand the rejection. *Id.*

Appellant also contends the Examiner erred in rejecting the pending claims as directed to patent-ineligible subject matter. Br. 8. Appellant argues claims 1–7 and 10–20 as a group (Br. 8), and we choose claim 1 as representative of the group. *See* 37 C.F.R. § 41.37(c)(1)(iv).

In *Alice*, the Supreme Court set forth an analytical "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. Pty. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012)). The first step is to "determine whether the claims at issue are directed to one of those patent-ineligible concepts," such as an abstract idea. *Id.* (citing *Mayo*, 566 U.S. at 77–78). If the claims are directed to a patent-ineligible concept, the second step is to consider the elements of the claims

"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). In other words, the second step is to "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.* (alterations in original) (quoting *Mayo*, 566 U.S. at 72–73). The prohibition against patenting an abstract idea "'cannot be circumvented by attempting to limit the use of the formula to a particular technological environment' or adding 'insignificant postsolution activity."' *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (citation omitted).

Turning to the first step of the *Alice* inquiry, we agree with the Examiner that limitations of claim 1 are directed to a series of steps related to the communication of healthcare data. Final Act. 13; Ans. 5–7. We also agree with the Examiner that, here, the concept of the communication of healthcare data is similar to the concept of comparing new and stored information and using rules to identity options, which is an abstract idea. Ans. 5–7 (citing *SmartGene Inc. v. Adv. Bio. Labs. SA*, 555 F. App'x 950 (Fed. Cir. 2014)).

In *SmartGene*, the Federal Circuit concluded claims were patent ineligible because they did "no more than call on a 'computing device,' with basic functionality for comparing stored and input data and rules, to do what doctors do routinely." *SmartGene*, 555 F. App'x at 954. In the instant case, the recited "site-specific codes" and "dynamic threshold values" are nothing more than data used in an algorithm process that uses a central system (i.e., "computer devices") to adjust the data using mathematical comparisons and

rule-based processes. *See* Ans. 7. The claims at issue in *SmartGene* relied upon "expert rules" for "'evaluating and selecting' from a stored 'plurality of different therapeutic treatment regimens.'" *SmartGene*, 555 F. App'x at 955. The "expert rules" in *SmartGene* are analogous to the "rules having the updated dynamic threshold values" used to tune extraction scripts and define summary data in claim 1. *See* Ans. 7.

Appellant contends the Examiner's "overly broad characterization of the claimed subject matter is inaccurate and ignores the specific features included in the claims." Br. 11. Appellant, however, does not explain persuasively how the Examiner mischaracterized claim 1 (*see* Ans. 5–7) or how the claims differ from those in *SmartGene*.

Appellant further contends the claims are "necessarily rooted" in a computer technology and address a technological challenge confined to computer technology. Br. 12–13 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014)). Appellant argues "various claims of the present Application may address the technological challenge of collecting massive amounts of clinical data from disparate health systems that use different codes representing different types of medical information to scan for potential outbreaks spreading through a local or regional population." *Id.* at 13.

Appellant's arguments are not persuasive at least because they are based upon elements not recited or required by the claims. Moreover, collecting data from more than one system using generic computer components are routine and well-known functions. Appellant has not identified any particular inventive technology for performing those functions. Here, the advance the claims purport to make is a process of

gathering and analyzing information, and "not any particular assertedly inventive technology for performing those functions." *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016).

Appellant also argues the pending claims are similar to hypothetical claim 1 of Example 23 of the Appendix to the July 2015 Update: Subject Matter Eligibility, issued by the PTO. Br. 13–14. Claim 1 of Example 23 is directed to a computer-implemented method for dynamically relocating information on a graphical user interface if a window overlap condition exists. *See id.* Appellant, however, does not explain persuasively how rejected claim 1 is similar to claim 1 of Example 23 apart from arguing that "this Example is similar to the present claims." *Id.* at 14.

For these reasons, we are not persuaded of error in the Examiner's determination that the claims are directed to the abstract idea of comparing new and stored information and using rules to identify options. Final Act. 13; Ans. 7.

Turning to the second step of the *Alice* inquiry, we find nothing in claim 1 that adds anything "significantly more" to transform the abstract concept of comparing new and stored information and using rules to identify options into a patent-eligible application. *Alice*, 134 S. Ct. at 2357.

We are not persuaded by Appellant's arguments that claim 1 includes "elements or computer functions that are not well-understood, routine and conventional in the field, as evidenced by the absence of prior-art-based rejections." Br. 15. Even if we were to conclude Appellant's claims are nonobvious, such finding would not necessarily lead to the conclusion that subject matter is patentable eligible. *See Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2117 (2013).

Appellant's further argument that the recited computers are special-purpose computers (Br. 16–17) is not persuasive in light of the description in the Specification that "[t]he present invention may be operational with numerous other *general purpose* or special purpose *computing system environments or configurations*." Spec. ¶ 29 (emphases added). Simply programming a computer to perform what would otherwise be an abstract idea is not sufficient to impart patent eligibility. *See Alice*, 134 S. Ct. at 2359.

Appellant also argues claim 1 poses no risk of preempting the abstract idea. *See* Br. 17. Appellant's argument is not persuasive because, "'[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.'" *FairWarning IP, LLC, v. Iatric Sys., Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016) (quoting *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015)). Further, "[w]here a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot." *Ariosa*, 788 F.3d at 1379.

For these reasons, we are not persuaded the Examiner erred in concluding the subject matter of claim 1 is judicially-excepted from patentability.

Accordingly, we sustain the Examiner's § 101 rejection of independent claim 1, as well as the Examiner's § 101 rejection of independent claims 11 and 18, and dependent claims 2–7, 10, 12–17, 19, and 20, not argued separately. *See* Br. at 7.

DECISION

We affirm the Examiner's decision rejecting claims 1–7 and 10–20.

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