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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* RODERICK A. HYDE, EDWARD K.Y. JUNG,  
JORDIN T. KARE, ERIC C. LEUTHARDT, ROYCE A. LEVIEN,  
RICHARD T. LORD, ROBERT W. LORD, MARK A. MALAMUD,  
JOHN D. RINALDO JR., DENNIS J. RIVET, CLARENCE T. TEGREENE  
and LOWELL L. WOOD JR.<sup>1</sup>

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Appeal 2017-000826  
Application 13/374,750  
Technology Center 3600

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Before ROBERT E. NAPPI, CARL L. SILVERMAN, and  
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1, 3 through 19, 21 through 23, 25 through 29, 49 through 69 and 89. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> According to Appellants, the real party in interest is Elwha LLC. App. Br. 4.

## INVENTION

Appellants' disclosed invention is directed to an electronic healthcare information management system where a record indicating that a patient received of a first protocol (e.g. one or more instances of diagnostic evaluations, regimen implementations, or medical interventions) is updated to include an effectiveness indication. *See Spec. paras. 5, 97.* Claim 1 is representative of the invention and reproduced below.

1. A healthcare information management system comprising:

    circuitry for obtaining an indication of a first protocol being employed in relation to a particular condition in a first patient;

    circuitry for requesting an effectiveness indication for the first protocol from an entity partly based on responsive to the entity validating the first protocol and partly based on responsive to a first communication delay associated with the first protocol, the first communication delay exceeding one hour, the entity being or not being the first patient; and

    circuitry for signaling a decision whether to update a prominence indication of the first protocol in response to the effectiveness indication for the first protocol received from the entity.

## REJECTIONS AT ISSUE<sup>2</sup>

The Examiner has rejected claims 1, 3 through 19, 21 through 23, 25 through 29, 49 through 69 and 89 under 35 U.S.C. § 101 for being directed to patent-ineligible subject matter. Answer 2.

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<sup>2</sup> Throughout this Decision we refer to the Appeal Brief filed January 11, 2016, Reply Brief filed October 12, 2016, Final Office Action mailed April 9, 2015, Appellants' Specification submitted January 9, 2012, and the Examiner's Answer mailed August 12, 2016.

The Examiner has rejected claims 1, 3 through 19, 21 through 23, 25 through 29, 49 through 69 and 89 under 35 U.S.C. § 103 as being unpatentable over Farooq (US 2011/0295622 A1; published Dec. 1, 2011) and Dempsey (US 2010/0321180 A1; published Dec. 23, 2010). Answer 3–22.

### PRINCIPLES OF LAW

Patent-eligible subject matter is defined in § 101 of the Patent Act, which recites:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

There are, however, three judicially created exceptions to the broad categories of patent-eligible subject matter in § 101: laws of nature, natural phenomena, and abstract ideas. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012). Although an abstract idea, itself, is patent-ineligible, an application of the abstract idea may be patent-eligible. *Alice*, 134 S. Ct. at 2355. Thus, we must 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.* (citing *Mayo*, 566 U.S. at 78–80). The claim must contain elements or a combination of elements that are “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [abstract idea] itself.” *Id.* (citing *Mayo*, 566 U.S. at 72–73).

The Supreme Court sets forth a two-part “framework for distinguishing patents that claim laws of nature, natural phenomena, and

abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355.

First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. [*Mayo*, 566 U.S. at 76–77]. If so, we then ask, “[w]hat else is there in the claims before us?” *Id.*, at [77–78]. To answer that question, we 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.*, at [77–78]. We have described step two of this 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.*, at [71–73].

*Id.*

Our reviewing court has said the “relevant inquiry at step one [of the *Alice* steps] is ‘to ask whether the claims are directed to an improvement to computer functionality versus being directed to an abstract idea.’” *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 612 (Fed. Cir. 2016) (internal cite omitted).

Under the second step of the *Alice/Mayo* framework, we examine the claim limitations “more microscopically,” (*Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016)), to determine whether they contain “additional features” sufficient to “transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355, 2357 (quoting *Mayo*, 566 U.S. at 78). “Mere recitation of concrete, tangible components is insufficient to confer patent eligibility to an otherwise abstract idea. Rather, the components must involve more than performance

of ‘well-understood, routine, conventional activit[ies]’ previously known to the industry.” *TLI*, 823 F.3d at 613 (citing *Alice*, 134 S. Ct. at 2359).

## ANALYSIS

We have reviewed Appellants’ arguments in the Briefs, the Examiner’s rejections, and the Examiner’s responses to Appellants’ arguments. Appellants’ arguments have not persuaded us of error in the Examiner’s determination that the claims are directed to patent-ineligible subject matter. Appellants’ arguments, however, have persuaded us of error in the Examiner’s obviousness rejection.

### *Rejection under 35 U.S.C. § 101*

Appellants argue on pages 7 through 9 of the Appeal Brief that the Examiner has not established the claims are directed to an abstract idea. Appellants argue that the Patent Office “has provided no evidence demonstrating that the ‘obtaining, requesting and signaling steps as recited in Claims 1, 29, 49, 69 and 89’ could be properly interpreted as “comparing new and stored information and using rules to identify options.” App. Br. 8.<sup>3</sup>

The Examiner has found that the claims are directed to an abstract idea stating:

The Examiner respectfully notes that the claims as currently submitted by the Appellant are directed to the abstract idea of "comparing new and stored information and using rules

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<sup>3</sup> Appellants also argue, on page 6 and 7 of the Reply Brief, that the Examiner’s response to this argument is an improper new ground of rejection. We have not considered this issue as it relates to a petitionable issue, and is waived. *See* 37 C.F.R. § 41.40 (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.)

to identify options". Several cases have found concepts relating to processes of comparing data that can be performed mentally abstract, such as comparing new and stored information and using rules to identify options (*SmartGene*). While the claims as currently amended and submitted by the Appellant may not explicitly recite "comparing new and stored information and using rules to identify options", the concept of "comparing new and stored information and using rules to identify options" is described, for example, by the obtaining, requesting and signaling steps as recited in independent Claims 1, 29, 49, 69 and 89.

Answer 3. Further, the Examiner finds that the recitation of "circuitry" in the claims, when interpreted in light of the Specification, involves nothing more than use of general purpose computers. Answer 25.

We concur with the Examiner's analysis on pages 25 through 27 of the Answer. Appellants' arguments have not persuaded us that representative claim 1 does not recite an abstract idea.

The Federal Circuit has explained that, in determining whether claims are patent-eligible under Section 101, "the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided." *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016). The Federal Circuit also noted in that decision that "examiners are to continue to determine if the claim recites (i.e., sets forth or describes) a concept that is similar to concepts previously found abstract by the courts." *Id.* at 1294 n.2.

In the instant case the Examiner has compared the steps of the claims with claims held to be abstract by the court in *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 Fed. App'x 950 (Fed. Cir. 2014) (non-precedential). Answer 25. Further, the Examiner notes that although the

claims do not explicitly recite comparing new and stored information and using rules to identify options as in *SmartGene*, the claims recite similar steps. *Id.*

Representative independent claim 1 recites limitations directed to: obtaining information (of a first protocol), requesting an effectiveness indication (requesting information based upon some conditions (i.e. rules)) and signaling the update of a prominence indication in response to the effectiveness indication. Thus, we concur with the Examiner that the claims are directed to the abstract idea of comparing new and stored information and using rules to identify options. We also concur with the Examiner that the claims are similar to those held to be abstract in by the court in *SmartGene* (the court held the claims to be abstract where they do “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 Fed. App’x at 954. Further, the claims are similar to those considered to be abstract by the court in *Electric Power Group*, 830 F.3d at 1354 (holding that claims directed to a process of gathering and analyzing information of a specific content are directed to an abstract idea) and *Content Extraction and Transmission LLC. v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (holding that the claims were “drawn to the abstract idea of 1) collecting data, 2) recognizing certain data within the collected data set, and 3) storing that recognized data in a memory.”).

In *Electric Power Group*, the court stated “we have treated collecting information including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.”

*Id.* at 1353. Further, the court stated that “merely presenting the results of abstract processes of collecting and analyzing information, without more (such as a identifying a particular tool for presentation), is abstract as an ancillary part of such collection and analysis.” *Id.* at 1354. Thus, Appellants’ arguments have not persuaded us the Examiner erred in finding the claims are directed to an abstract idea as representative claim 1 recites a concept similar to those held to be abstract by the courts.<sup>4</sup>

Appellants argue on pages 9 through 11 of the Appeal Brief, that the Examiner’s rejection is in error, as the claims do not pre-empt others from using the abstract idea as claims are directed to the specific context of signaling whether to update a prominence indication.

This argument is not persuasive of error. As stated by the Examiner, while “preemption is the concern driving judicial exceptions to patent eligibility, preemption is not a stand-alone test for eligibility.” Answer 26. Our reviewing court has said “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, [] preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015).

Appellants argue on pages 11 through 14 of the Appeal Brief that the rejection under 35 U.S.C. § 101 is in error as the claims recite significantly more. Specifically, Appellants argue that the claims effectuate a transformation of an article to different thing, as the “prominence indication” is “representative of a physical object or substance” and is updated with a

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<sup>4</sup> Appellants’ arguments directed to the rejection of under 35 U.S.C. §101 address the claims as a group. Accordingly, we select claim 1 as representative of the claims rejected under 101. See 37 C.F.R. §41.37(c)(iv).

transformation. App. Br. 12–13. Further, Appellants argue that the limitation directed to signaling an update to the prominence indicator is not a well understood, routine and conventional in the field. App. Br. 13–14.

We are not persuaded of error by these arguments. Initially, we note that while the indication may be of a physical object, changing the indication is not the same thing as changing the physical object, thus we do not find that the claims recite transformation of an article to different thing. Second, Appellants’ Specification contradicts Appellants’ assertion that the “update to the prominence indicator is not a well understood, routine and conventional.” Paragraph 98 of Appellants’ Specification states, “numerous existing techniques may be applied for configuring special purpose circuitry or other structures effective for calculating and disseminating prominence indications.” Thus, demonstrating that calculation of prominence indications is accomplished using existing techniques (conventional techniques). As such, Appellants have not persuaded us that representative claim 1 recites significantly more than the abstract idea and we sustain the Examiner’s rejection of claims 1, 3 through 19, 21 through 23, 25 through 29, 49 through 69 and 89 under 35 U.S.C. § 101.

*Rejection under 35 U.S.C. § 103*

Appellants argue on pages 15 through 34 of the Appeal Brief that the Examiner’s obviousness rejection of independent claims 1, 29, 49, 69 and 89 is in error. The dispositive issue presented by these arguments is: did the Examiner err in finding that the combination of Farooq and Dempsey teach requesting an effectiveness indication protocol from an entity party based

upon a response to the entity validating the first protocol and partly on a communication delay, as recited in each of the independent claims.

The Examiner's rejection cites to and quotes paragraphs 5, 6, 8, 18, 20, 21, 24, 25, 26, 29, 34, 35, 44, 46 and 52 of Farooq with respect to teaching this limitation. Final Act. 4–5, Answer 4–5. In response to Appellants' arguments, the rejection cites to these passages and states that the paragraphs arguably includes the Appellants' recitation in part of "requesting an effectiveness indication for the first protocol . . . ." *See e.g.*, Answer 27.

We are persuaded of error by Appellants' arguments as we do not find that the Examiner has provided sufficient rationale or explanation as to what teaching of Farooq corresponds to the claimed effectiveness indication and how Farooq teaches that the indications are provided in the manner claimed. It is unclear as to whether the Examiner is equating the remittance or lack of remittance to the claimed effectiveness indication, or if there is some other data point the Examiner is equating with the claimed effectiveness indication. Similarly, the Examiner has not shown where or explained how the references teach an effectiveness parameter is provided in the manner claimed. Thus, we do not find the Examiner has identified sufficient evidence to show that the combination of the references teaches the limitations directed to requesting an effectiveness indication protocol from an entity partly based upon a response to the entity validating the first protocol and partly on a communication delay, as recited in each of the independent claims. Accordingly, we do not sustain the Examiner's obviousness rejection of claims 1, 3 through 19, 21 through 23, 25 through 29, 49 through 69 and 89.

DECISION

We affirm the Examiner's rejection of claims 1, 3 through 19, 21 through 23, 25 through 29, 49 through 69 and 89 under 35 U.S.C. § 101.

We reverse the Examiner's rejection of claims 1, 3 through 19, 21 through 23, 25 through 29, 49 through 69 and 89 under 35 U.S.C. § 103.

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