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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD P. MANSOUR

Appeal 2017-001082
Application 14/299,460¹
Technology Center 3600

Before ERIC S. FRAHM, CATHERINE SHIANG, 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 Non-Final Rejection of claims 66–84, which are all of the claims pending in this application.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellant, the real party in interest is Allscripts Healthcare Solutions, Inc. App. Br. 3.

² Claims 1–65 and 85 have been canceled. Non-Final Act. 2.

INVENTION

Appellant's application relates to intelligent tokens for automated health care information systems. Abstract. Claim 66 reads as follows:

66. A health care computer network system in which the manual creation of patient documentation is facilitated by automatic inclusion of information in the patient documentation based on an electronic patient medical record of the patient, comprising:

(a) a server, by which electronic patient medical records are accessible; and

(b) at least one computing device configured to communicate electronically with the server for accessing, through the server, the electronic patient medical records;

(c) wherein the computing device comprises computer executable instructions contained in non-transitory computer readable medium which, when executed for generating patient documentation regarding an episode of health care services rendered to a particular patient,

(i) provide a user interface for receiving user input for construction of the patient documentation to be created regarding the episode of health care services rendered to the particular patient, wherein the user input includes a token comprising a character string to be replaced with information determined based on the electronic patient medical record of the particular patient,

(ii) identify the token contained in the user input, the token comprising a character string that is associated with a sequence of computer executable instructions for,

(A) accessing, through the server, data from the electronic patient medical record for the particular patient,

(B) correlating accessed data and applying rules-based medical logic associated with a quality scoring system to generate, based on the accessed data, a new result that was not previously stored in the electronic patient medical record,

(C) inserting information, including the new result, in place of the identified token contained in the user input, and

(iii) cause the sequence of computer executable instructions associated with an identified token to be executed, when invoked, for generating the patient documentation regarding the episode of health care services rendered to the particular patient.

REJECTION

Claims 66–84 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to a judicial exception (i.e., abstract idea) without significantly more. Non-Final Act. 3.

ANALYSIS

We have reviewed the rejection of claims 66–84 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 deemed 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. 4–8) and in the Action from which this appeal was taken (Non-Final Act. 3–4). We provide the following explanation for emphasis.

Appellant contends the Examiner failed to establish a *prima facie* case of patent ineligibility under § 101. App. Br. 16. 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 Non-Final Office Action adequately explains the § 101 rejection. *See* Non-Final Act. 3–4. 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* App. Br. 8–20. Appellant has not responded by alleging a failure to understand the rejection. *Id.* To the contrary, Appellant clearly identifies the abstract ideas identified by the Examiner. *See, e.g.*, App. Br. 12, 17.

Appellant also contends the Examiner erred in rejecting the pending claims as directed to patent-ineligible subject matter. App. Br. 8. Appellant argues claim 66 as representative of rejected claims. *Id.*

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 66 are directed to the abstract idea of inserting information in place of character string tokens in the generation of patient documentation because they involve receiving user input for construction of patient documentation including a character string token to be replaced with information determined based on the patient record, identifying the character string token, accessing data from the patient medical record, correlating accessed data, applying rules associated with a quality scoring system to generate a new result not previously in the patient record, inserting information including the new result in place of the character string token, and generating the patient documentation. *See* Ans. 4. We agree with the Examiner that, here, the concept of inserting information in place of character string tokens in the generation of patient

documentation is similar to the concept of comparing new and stored information and using rules to identify options, which is an abstract idea. Ans. 4–5 (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 “accessed data” and “new result” are nothing more than data used in an algorithm process that uses a “computing device” to adjust the data using mathematical comparisons and rule-based processes. 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-based medical logic associated with a quality scoring system” used to generate a “new result” in claim 66.

We also agree with the Examiner that the concept of inserting information in place of character string tokens in the generation of patient documentation is similar to the abstract idea of using categories to organize, store, and transmit information. Ans. 4–5. In *Cyberfone*, the Court held that “using categories to organize, store, and transmit information is well-established,” and “the well-known concept of categorical data storage, the idea of collecting information in classified form, then separating and transmitting that information according to its classification, is an abstract idea that is not patent-eligible.” *Cyberfone Systems, LLC v. CNN Interactive Group, Inc.*, 558 F. App'x. 988, 992 (Fed. Cir. 2014). Here, as in

Cyberfone, information is collected and organized or manipulated, because the limitations outline obtaining patient data from patient records, forming multiple data transactions involving the patient data, and inserting the multiple pieces of patient data into a patient document.

Appellant also argues claim 66 poses no risk of preempting the abstract idea. *See* Reply Br. 2. 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.

Turning to step two of the *Alice* analysis, Appellant contends that, even if claim 66 recites generic computer components, those components are “programmed to in combination perform functions that are not merely generic.” App. Br. 14. In particular, Appellant argues the components enable use of a token comprising a character string to be replaced with information based on the electronic patient medial record of a particular patient. *Id.* Appellant further argues the associated “accessing,” “correlating,” and “inserting” steps of claim 66 represent “novel and non-obvious subject matter” and, thus, are not are “well-understood, routine, and conventional activities previously known to the industry.” *Id.*

Appellant misapprehends the controlling precedent. Although the second step in the *Alice/Mayo* 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*, 134 S. Ct. at 2355 (alteration in original) (quoting *Mayo*, 132 S. Ct. at 1294). A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 132 S. Ct. at 1304.

We agree with the Examiner that claim 66 recites a generic computer component that performs generic computer functions that are well-understood, routine, and conventional activities previously known to the industry. *See Ans. 5–6*. Appellant’s own disclosure at page 8 states that the workstations 14 of Figure 1 can be general purpose computers. Spec. ¶¶ 38–40. Additional elements (such as the server, computing device, non-transitory computer readable medium, and user interface) are recited at a high level of generality in claim 66 and do not add meaningful limitations to the abstract idea beyond generally linking the system to a particular technological environment. *See Ans. 5–6*. Moreover, providing a user interface, accessing patient records, and correlating accessed data are merely extra-solution and/or post solution activity that does not add meaningful limitations to the abstract idea. Furthermore, inserting information into patient documentation merely limits the claims to a particular field of use. *See id.*

For these reasons, the claims do not amount to significantly more than the underlying abstract idea of inserting information in place of character string tokens in the generation of patient documentation, which is similar to the abstract ideas identified by the courts of comparing new and stored

information and using rules to identify options and using categories to organize, store, and transmit information.

Finally, Appellant argues that, under a proper construction of 35 U.S.C. §101 that takes into account existing international agreements such as TRIPS, the claimed invention should be patent eligible. App. Br. 17–20. We remind Appellant that precedential decisions from the Court of Appeals for the Federal Circuit and the Supreme Court of the United States, including any statutory interpretations therein, are binding authority on this Board. To the extent Appellant invites us to apply a statutory interpretation in contravention of Federal Circuit or Supreme Court precedent, we decline.

For these reasons, we are not persuaded of error in the Examiner’s conclusion that the claims are judicially-excepted from patentability under § 101.

Accordingly, we sustain the Examiner’s § 101 rejection of independent claim 66, as well as the Examiner’s § 101 rejection of independent claim 84, which the Appellant argues are patentable for similar reasons. App. Br. 8. We also sustain the Examiner’s rejection of dependent claims 67–83, not argued separately. *Id.*

DECISION

We affirm the Examiner’s decision rejecting claims 66–84.

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