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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* DAVID SCHAEFER and RON LINDAHL

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Appeal 2017-002603  
Application 14/100,254  
Technology Center 3600

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Before JOHN A. EVANS, JASON J. CHUNG, and JAMES W. DEJMEK,  
*Administrative Patent Judges.*

EVANS, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants<sup>1</sup> seek our review under 35 U.S.C. § 134(a) from the Examiner's non-final rejection of Claims 1–19 and 21. Br. 1.

We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.<sup>2</sup>

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<sup>1</sup> Appellants state the real party in interest is AxelaCare Health Solutions, Inc. Br. 5.

<sup>2</sup> Rather than reiterate the arguments of Appellants and the Examiner's findings and conclusions, we refer to the Appeal Brief (filed May 10, 2016, "Br."); the Examiner's Answer (mailed November 8, 2016, "Ans."); the Non-Final Action (mailed February 12, 2016, "Non-Final Act."); and the Specification (filed December 9, 2013, "Spec.") for their respective details.

## STATEMENT OF THE CASE

The claims relate to a computer program for directing operation of a tablet computer or other portable electronic device operated by a caregiver while administering an in-home or outpatient treatment to a patient. *See* Abstract.

### *Related Appeals*

Appellants state the present application is a continuation-in-part of Application Serial No. 13/566,775, which was appealed to the Patent Trial and Appeal Board on August 5, 2015. Br. 6. We note the appeal of the '775 application was docketed to the instant Panel as Appeal 2017-000011.

### *Invention*

Claims 1, 13, and 21 are independent. Claim 1 is illustrative and is reproduced below:

1. A computer program stored on non-transitory computer-readable medium for directing operation of a portable electronic device operated by a caregiver while administering a treatment to a patient, the computer program comprising:

a code segment for receiving with the portable electronic device pre-treatment patient data representative of a condition of the patient before the patient receives the treatment;

a code segment for receiving with the portable electronic device treatment patient data representative of a condition of the patient while or after the patient receives the treatment, the conditions being or relating to an effect of a disease on the patient with or without the treatment;

a code segment for transmitting at least some of the pre-treatment patient data and the treatment patient data from the portable electronic device to a remote computer while or after the patient receives the treatment; and

a code segment for receiving and displaying on the portable electronic device instructions from a doctor and instructions from a pharmacist that are provided in response to the transmitted pre-treatment patient data and the transmitted treatment patient data.

*References and Rejections*

Galipeau et al.,	US 2002/0049925 A1	Apr. 25, 2002
Florio, et al.,	US 2002/0156651 A1	Oct. 24, 2002
Dang	US 2002/0165738 A1	Nov. 7, 2002
Ding	US 2004/0122308 A1	June 24, 2004
Podczerwinski et al.,	US 2005/0278197 A1	Dec. 15, 2005
Reed et al.,	US 2006/0084847 A1	Apr. 20, 2006
Lang et al.,	US 2006/0241972 A1	Oct. 26, 2006
Mahoney	US 2008/0136629 A1	June 12, 2008
Peterson et al.,	US 2008/0161651 A1	July 3, 2008
Cazares et al.,	US 2008/0162182 A1	July 3, 2008
Wekell et al.,	US 2008/0221930 A1	Sep. 11, 2008
Langheier et al.,	US 2009/0070138 A1	Mar. 12, 2009
Tursso et al.,	US 2009/0183410 A1	July 23, 2009
Koike et al.,	US 2010/0094647 A1	Apr. 15, 2010
White	US 2010/0143373 A1	June 10, 2010
Rathmacher et al.,	US 2010/0179112 A1	July 15, 2010
O'Donnell et al.,	US 2011/0082115 A1	Apr. 7, 2011

Sheau-Ling Huang, Ching-Lin Hsieh, Ruey-Meei Wu, Chun-Hwei Tai, Chin-Hsien Lin, and Wen-Shian Lu, *Minimal Detectable Change of the*

*Timed “Up & Go” Test and the Dynamic Gait Index in People With Parkinson Disease*, 91 *PHYS. THER.*, 114–21 (2011).<sup>3</sup>

The claims stand rejected as follows:

1. Claim 21 stands provisionally rejected under the doctrine of non-statutory, obviousness-type double patenting. Non-Final Act. 4.
2. Claims 1–19 and 21 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter. Non-Final Act. 5–7.
3. Claims 1, 6, 8, and 12 stand rejected under 35 U.S.C. § 103 as obvious over Koike, Tursso, and Wekell. Non-Final Act. 8–12.
4. Claims 2 and 3 stand rejected under 35 U.S.C. § 103 as obvious over Koike, Tursso, Wekell, and O’Donnell. Non-Final Act. 12–14.
5. Claim 4 stands rejected under 35 U.S.C. § 103 as obvious over Koike, Tursso, Wekell, and Reed. Non-Final Act. 14–15.
6. Claim 5 stands rejected under 35 U.S.C. § 103 as obvious over Koike, Tursso, Wekell, and Rathmacher. Non-Final Act. 15–16.
7. Claim 7 stands rejected under 35 U.S.C. § 103 as obvious over Koike, Tursso, Wekell, and Mahoney. Non-Final Act. 16–17.
8. Claim 9 stands rejected under 35 U.S.C. § 103 as obvious over Koike, Tursso, Wekell, and Podczerwinski. Non-Final Act. 17–18.

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<sup>3</sup> The face page indicates that the article was originally published online October 14, 2010 and that the online version of this article, along with updated information and services, can be found at:  
<http://ptjournal.apta.org/content/91/1/114>.

9. Claims 10 and 11 stand rejected under 35 U.S.C. § 103 as obvious over Koike, Tursso, Wekell, Podczerwinski, and Cazares. Non-Final Act. 18–19.
10. Claims 13 and 18 stand rejected under 35 U.S.C. § 103 as obvious over Koike, Tursso, Wekell, and Galipeau. Non-Final Act. 19–24.
11. Claims 14 and 15 stand rejected under 35 U.S.C. § 103 as obvious over Koike, Tursso, Wekell, Galipeau, and O’Donnell. Non-Final Act. 24–26.
12. Claim 16 stands rejected under 35 U.S.C. § 103 as obvious over Koike, Tursso, Wekell, and Galipeau. Non-Final Act. 26.
13. Claim 17 stands rejected under 35 U.S.C. § 103 as obvious over Koike, Tursso, Wekell, Galipeau, and Rathmacher. Non-Final Act. 27.
14. Claim 19 stands rejected under 35 U.S.C. § 103 as obvious over Koike, Tursso, Wekell, Galipeau, and Mahoney. Non-Final Act. 28–29.
15. Claim 21 stands rejected under 35 U.S.C. § 103 as obvious over Lang, White, Huang, O’Donnell, Florio, Reed, Ding, Langheier, Tursso, Peterson, and Dang. Non-Final Act. 29–39.

#### ANALYSIS

We have reviewed the rejections of Claims 1–19 and 21 in light of Appellants’ arguments that the Examiner erred. We have considered in this decision only those arguments Appellants actually raised in the Briefs. Any other arguments that Appellants could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2015).

We are not persuaded that Appellants identify reversible error. Upon consideration of the arguments presented in Appellants' Brief, we agree with the Examiner that all the pending claims are unpatentable. We adopt as our own the findings and reasons set forth in the rejection from which this appeal is taken and in the Examiner's Answer, to the extent consistent with our analysis below. We provide the following explanation to highlight and address specific arguments and findings primarily for emphasis. We consider Appellant's arguments *seriatim*, as they are presented in the Appeal Brief, pages 18–31.

CLAIM 21: NON-STATUTORY, OBVIOUSNESS-TYPE DOUBLE PATENTING

Appellants do not contest this ground of rejection. *See* Br. 18. Because Appellants present no arguments directed to this rejection, it is summarily affirmed. *See* 37 C.F.R. § 41.31(c) (“An appeal, when taken, is presumed to be taken from the rejection of all claims under rejection unless cancelled by an amendment filed by the applicant and entered by the Office.”); 37 C.F.R. § 41.37(c)(iv) (“[A]ny arguments or authorities not included in the appeal brief will be refused consideration by the Board for purposes of the present appeal.”); MPEP § 1205.02 (9th ed. March 2014) (“[T]he Board may summarily sustain any grounds of rejections not argued.”).

CLAIMS 1–19 AND 21: NON-STATUTORY SUBJECT MATTER

*Claim Construction*

“As in any other context in which the scope and meaning of the claims bears on the ultimate determination at hand, we must start by

considering the issue of claim construction.” *In re Nuijten*, 500F.3d 1346, 1353 (Fed. Cir. 2007) (citing *State St. Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368, 1370 (Fed.Cir.1998) (stating that “whether the ... patent is invalid for failure to claim statutory subject matter under § 101[ ] is a matter of both claim construction and statutory construction”). Whether a claim is valid in light of § 101 is a question of law that we review *de novo*. See *Nuijten*, at 1352 (citing *AT & T Corp. v. Excel Commc’ns, Inc.*, 172 F.3d 1352, 1355 (Fed.Cir.1999)).

*The Appealed Claims do not Sound in Any Statutory Category*

The Patent Statute provides:

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.

35 U.S.C. § 101.

The preamble of independent claim 21 recites “[a] computer program stored on non-transitory computer-readable medium for directing operation of a computer system for analyzing patient data of patients receiving treatments, the computer program comprising.” The preambles of independent claims 1 and 13 commensurately recite: “[a] computer program stored on non-transitory computer-readable medium for directing operation . . . .” Thus, by their very terms, the claims are directed to a computer program.

1. Process

The Courts have consistently interpreted the statutory term “process” to require action. See *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972) (“A

process is a mode of treatment of certain materials to produce a given result. It is an *act*, or a *series of acts*, performed upon the subject-matter to be transformed and reduced to a different state or thing.” The independent claims recite various “code segments” for performing various functions, but no actual actions are claimed and no subject-matter is transformed into some new state. Therefore, the claims are not statutory as directed to a “process” under § 101.

## 2. Machine

The Supreme Court defines the term “machine” to be “a concrete thing, consisting of parts, or of certain devices and combination of devices.” *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863). This “includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result.” *Corning v. Burden*, 56 U.S. 252, 267 (1853); *See Nuijten*, at 1355. The claimed “computer program” comprises words or symbols written on a substrate, but cannot be considered to comprise “parts” or “devices” in any mechanical sense. Therefore, the claims are not statutory as directed to a “machine” under § 101.

## 3. Manufacture

In its verb form, the Supreme Court defines “manufacture” as “the production of *articles* for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery.” *Nuijten*, at 1356 (quoting *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980) (quoting *Am. Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11 (1931))).

The statute uses the term “manufacture” in its noun form, and thus refers to “articles” resulting from the process of manufacture. *Nuijten*, at 1356 (citing *Bayer AG v. Housey Pharms., Inc.*, 340 F.3d 1367, 1373 (Fed.Cir.2003)).

The same dictionary the Supreme Court relied on for its definition of “manufacture” in turn defines “article” as “a particular substance or commodity.” *Id.* Thus, “articles” of “manufacture” are defined as being tangible articles or commodities. *Id.* The claimed computer program comprises words and symbols, but cannot be considered a tangible article or commodity. The present independent claims are not *Beauregard* claims, i.e., claims to a tangible device. “A *Beauregard* claim—named after *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995)—is a claim to a computer readable medium (e.g., a disk, hard drive, or other data storage device) containing program instructions for a computer to perform a particular process.” *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (2011). Therefore, the claims are not statutory as directed to a “manufacture” under § 101.

#### 4. Composition of Matter

The Supreme Court has defined “composition of matter” to mean “all compositions of two or more substances and all composite articles, whether they be the results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids.” *Nuijten*, at 1357 (quoting *Chakrabarty*, at 308). The claimed computer program is not the result of a “chemical union,” nor is it a gas, fluid, powder, or solid. Therefore, the claims are not statutory as directed to a “composition of matter” under § 101.

The subject matter of the claims on appeal do not fall within any statutory class. All claimed “subject matter must fall into at least one category of statutory subject matter.” *State St. Bank*, at 1375, n. 9. Therefore, the claims are not statutory under 35 U.S.C. § 101.

*New Ground of Rejection*

As a preliminary matter, we find the claims are not directed to statutory subject matter. “[W]e must start by considering the issue of claim construction.” *Nuijten*, at 1353. The question then arises whether our finding must be designated as a “New Ground of Rejection.”

We find Appellants were noticed properly of the grounds of rejection.

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such 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 his application.

35 U.S.C. § 132(a).

Although not set forth under a heading entitled “rejection,” the Examiner set forth a section entitled “Notice to Applicant,” which provides:

It is noted that Claims 1 and 13 recite a computer program stored on a non-transitory computer-readable medium “for” performing various operations, but does *not* recite that the operations are *executed* by any computer hardware (e.g. a computer processor). Hence, as currently claimed, Claims 1 and 13 simply recite code stored on a non-transitory computer-readable medium (e.g. a compact disc) *without* requiring that the code be executed or performed by a computer. It follows then that Claim 1 and 13 would be anticipated by *any* code stored on *any* non-transitory computer-readable medium because the code is *not executed* and hence the operations are

*not performed*. However, as will be shown below, in the interest of compact prosecution, Examiner has interpreted Claims 1–20 to recite the functions actually being executed.

Non-Final Act 2. Thus, Appellants were noticed that their claims were to software, *per se*. The rejections under §§ 101 and 103 merely demonstrate that were the alluded to functionality actually to be executed, the claims would still be unpatentable under those sections. “[A]ll that is required of the office to meet its *prima facie* burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of § 132.” *In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011).

#### CLAIMS 1–19 AND 21: PATENT-INELIGIBLE SUBJECT MATTER

The Examiner finds claim 1 as being directed towards abstract ideas, such as: receiving pretreatment patient data, receiving treatment patient data, transmitting some of these patient data to a remote computer, and displaying healthcare provider instructions. Ans. 4.

Appellants particularly argue that independent claim 21 recites a computer program for performing various activities implicated by the plurality of the claimed “code segment[s] for” limitations. Br. 25.

We agree with the Examiner that each of the four claimed “code segments” is directed to an abstract idea, ultimately (but not claimed as such) to be performed by a computer (*see* Ans. 4). Appellants do not argue the claimed segments encode any particular algorithm for performing a particular computer operation. Nor do Appellants argue persuasively that the claims comprise significantly more because each limitation merely recites a code segment. Moreover, Appellants do not dispute the Examiner’s

findings that computer programs for carrying out the various steps of the implied method were well-known.

In view of the foregoing, Appellants have failed to persuade us the Examiner has erred.

CLAIMS 1–19 AND 21: OBVIOUSNESS.

Appellants argue all claims as a group, specifically contending the Examiner has failed to articulate a motivation for combining the various references. *See* Br. 29–31.

The Examiner finds Koike teaches a computer program stored on non-transitory, computer-readable media for directing the operation of an electronic medical device operated by a caregiver. Non-Final Act. 8. The Examiner finds Turso teaches that it was well-known for a pharmacist to receive patient information and generate patient instructions. *Id.* at 10. The Examiner further finds Wekell teaches that in managing patient data that is well-known to utilize a portable electronic device whereby information is transmitted to and from a separate computer system. *Id.*

Appellants do not dispute the Examiner’s findings. Rather, Appellants argue that the Examiner has failed to demonstrate the obviousness of assembling the various teachings into the claimed computer program. Br. 30.

We find the Examiner has provided “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

Appellants do not reply to the Examiner's Answer and do not persuade us the Examiner has erred.

DECISION

The rejection of Claim 21 under the doctrine of non-statutory, obviousness-type double patenting is AFFIRMED.

The rejection of Claims 1–19 and 21 under 35 U.S.C. § 101 is AFFIRMED.

The rejections of Claims 1–19 and 21 under 35 U.S.C. § 103 is AFFIRMED.

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