



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/246,060	09/27/2011	Christopher Henderson	283191	4238
23460	7590	06/13/2019	EXAMINER	
LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6731			TOMASZEWSKI, MICHAEL	
			ART UNIT	PAPER NUMBER
			3686	
			NOTIFICATION DATE	DELIVERY MODE
			06/13/2019	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Chgpatent@leydig.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER HENDERSON, STEPHEN BAINES,
and ROBERT GRAYBILL

Appeal 2017-002725
Application 13/246,060
Technology Center 3600

Before NINA L. MEDLOCK, AMEE A. SHAH, and
MATTHEW S. MEYERS, *Administrative Patent Judges*

SHAH, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

STATEMENT OF THE CASE

The Appellants have filed a request for rehearing under 37 C.F.R. § 41.52 (hereinafter “Request”), dated April 8, 2019. The Request seeks reconsideration of our Decision (hereinafter “Decision”), mailed February 8, 2019, affirming the Examiner’s rejection of claims 1–3, 6–13, and 15–20 under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more.

¹ Throughout this Decision, we refer to the Appellants’ Appeal Brief (“Appeal Br.,” filed June 20, 2016, as amended Aug. 22, 2016).

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

Requests for Rehearing are limited to matters misapprehended or overlooked by the Board in rendering the original decision, to responses to a new ground of rejection designated pursuant to § 41.50(b), or presentations of new arguments based upon recent decisions of the Federal Circuit. 37 C.F.R. § 41.52.

ISSUE ON REHEARING

The Appellants argue that the Board

does not provide a basis for its conclusion that Appellant’s claims do not recite additional elements that “integrate the judicial exception into a practical application” under the *second prong* of the two-prong first step of the analytical framework (for initially determining whether an invention is directed to an “abstract idea”) set forth in the USPTO’s *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Revised Guidance”) that provides a revised framework for determining patent eligible subject-matter under Section 101.

Request 1. Thus, the

Appellant [sic] seeks clarification of the previous conclusion set forth at pages 9–10 of the Decision regarding the analytical basis for concluding the combination of elements recited in the three closing “wherein” clauses of Appellant’s claim 1 do not constitute a “practical application” in light of *prong 2* (of the two-pronged first step) of the Revised Guidance.

Id. at 2 (emphases omitted).

DISCUSSION

On January 7, 2019, the USPTO issued revised guidance regarding patent eligibility under 35 U.S.C. § 101. 2019 Revised Patent Subject

Matter Eligibility Guidance, 84 Fed. Reg. 50 (“2019 Revised Guidance”). The 2019 Revised Guidance “applies to all applications, and to all patents resulting from applications, filed before, on, or after January 7, 2019.” *Id.* However, the 2019 Revised Guidance “does not constitute substantive rulemaking and does not have the force and effect of law.” *Id.* at 51. In particular, the Guidance “does not create any right or benefit, substantive or procedural, enforceable by any party against the USPTO” and although USPTO personnel are “expected to follow the guidance,” failure to do so “is not, in itself, a proper basis for either an appeal or a petition.” *Id.* Thus, to the extent the Appellants contend that there is “an error” in the Decision because the Board failed to follow the guidelines (*see* Request 1), we disagree. The Board applied the Supreme Court’s two-step framework, described in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012) and *Alice Corp. v. CLS Bank*, 573 U.S. 208, 216–18 (2014), and considered the guidelines in that application. Furthermore, any alleged failure to follow the guidelines is not a proper basis for rehearing.

The 2019 Revised Guidance provides, in relevant part, that “in revised Step 2A examiners should ensure that they give weight to all additional elements, whether or not they are conventional, when evaluating whether a judicial exception has been integrated into a practical application.”

2019 Revised Guidance, 84 Fed. Reg. at 55. The Guidance provides “exemplary considerations [that] are indicative that an additional element (or combination of elements) may have integrated the exception into a practical application” and notes that some of these considerations were previously discussed in the context of Step 2B (step two of the *Alice/Mayo* framework). *Id.* (footnote omitted). Relevant among those examples are whether “[a]n

additional element reflects an improvement in the functioning of a computer, or an improvement to other technology or technical field” (*id.* citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1258–59 (Fed. Cir. 2015), whether “an additional element implements a judicial exception with, or uses a judicial exception in conjunction with, a particular machine or manufacture that is integral to the claim” (*id.*), and whether “an additional element applies or uses the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception” (*id.* citing *Diamond v. Diehr*, 450 U.S. 175, 192 (1981)). “[E]xamples in which a judicial exception has not been integrated into a practical application” include whether “[a]n additional element merely recites the words ‘‘apply it’’ (or an equivalent) with the judicial exception, or merely includes instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea” (*id.* citing *Alice*), whether “an additional element adds insignificant extra-solution activity to the judicial exception” (*id.* citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012) and *Parker v. Flook*, 437 U.S. 584, 594–95 (1978)), and whether “an additional element does no more than generally link the use of a judicial exception to a particular technological environment or field of use” (*id.* citing *Flook* and *Bilski v. Kappos*, 561 U.S. 593, 611 (2010)).

The Decision specifically states “the claim does not ‘integrate the judicial exception into a practical application.’” Decision 9 (quoting 2019 Revised Guidance, 84 Fed. Reg. at 55)). The Decision provides reasoning that the claim uses generic or conventional technology to apply the abstract

idea (*id.* at 10), that the claim does not address “problems ‘necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks’ (*id.* quoting *DDR Holdings*, 773 F.3d at 1257), and that there is no “improvement to computer technology and/or functionality” (*id.* at 11). The Decision also specifically addresses the “‘wherein’ clauses” in determining that the purported improvement of generating a ranking using a weighted average reimbursement and for a particular procedure associated with codes merely elaborates on the abstract idea without providing any technological benefits or improvements. *Id.* Thus, to the extent the Appellants contend that there is “an error” in the Decision because the Board did not provide analysis why “the three closing ‘wherein’ clauses of Appellants’ claim 1 do not constitute a ‘practical application’ in light of *prong 2*” (Request 2), we disagree.

In the Request at pages 2 and 5, the Appellants repeat the arguments presented in the Appeal Brief at pages 8 and 10 regarding the claimed invention reciting a particular solution to remedy a problem. The Decision addresses this argument at pages 7 through 11.

The Appellants’ argument that the

claims recite an invention that can only be implemented in a meaningful way using a networked computer system including a database and various querying modules that retrieve and process specifically identified information to render the ranking of providers for a particular medical procedure that is in turn used to generate a particular incentive that is provided to the medical services consumer.

(Request 5) is a new argument not presented in the Appeal or Reply Briefs. Even so, the Appellants do not provide reasoning how such an implementation provides “an additional element that applies or uses the

Appeal 2017-002725
Application 13/246,060

judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment” of a networked computer system with a database and modules, “such that the claim as a whole is more than a drafting effort designed to monopolize the exception.” 2019 Revised Guidance, 84 Fed. Reg. at 55.

DECISION

The Appellants’ Request has been granted to the extent that we have reconsidered our Decision in light of the Appellants’ Request, but is denied in all other respects.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

DENIED