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tlopez@slk-law.com
dmiller@slk-law.com
egolupski@slk-law.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEVEN T. PARKER, NICHOLAS J. NICKLYN and
JONATHAN E. ZIEBELL¹

Appeal 2017-003068
Application 13/436,266
Technology Center 3600

Before ROBERT E. NAPPI, ERIC S. FRAHM, and LARRY J. HUME,
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 rejection of claims 25–28. Claims 1–24 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellants, the real party in interest is ORS, INC.
App. Br. 3.

INVENTION

Appellants' disclosed invention is directed to "standardizing patient registration." Abstract. Claim 25 is representative of the invention and reproduced below.

25. A method for standardizing patient registration to maintain a constant workflow in regards to data capture from a patient regardless of whether the patient registers electronically over the Internet or non-electronically with a healthcare provider, using a computer network system having a data management server with a processor and a database storing a record with information of the patient, the record having a plurality of universal pre-defined fields for population by the patient, the data management server including a telephone/facsimile device configured to generate automated phone calls and facsimiles with an authorization code, a patient interface in communication with the data management server over the Internet and configured to transfer the information of the patient to and from the record of the patient, the patient interface presenting an Internet-accessible data gathering form structure for collecting the information of the patient to populate the pre-defined fields of the record of the patient in the database, and a healthcare provider interface in communication with the data management server and configured both to create an electronic form on the data management server having a standardized format and to present the patient information in the standardized format to the healthcare provider, the data gathering form structure presented at the patient interface being different from the electronic form having the standardized format defined by the healthcare provider and presented at the healthcare provider interface, the data gathering form structure dynamically shown to the patient using the patient interface, the data gathering form structure presenting only a subset of questions from the electronic form to the patient to answer using the patient interface, the subset of questions limited by the information of the patient already stored in the pre-defined fields of the record of the patient and appropriate questions for

purposes of the healthcare provider, the method comprising the steps of:

enrolling the healthcare provider with the data management server using the healthcare provider interface, wherein the enrolling includes the creation of a record of the healthcare provider in the database of the data management server and an association of at least one of a phone number and a facsimile number with the healthcare provider in the record of the healthcare provider for a later transmission of the authorization code to permit access by the healthcare provider to the record of the patient on the data management server;

defining by the healthcare provider with the healthcare provider interface the electronic form having the standardized format of the information of the patient to be accessed from the data management system, the standardized format being the same for all patients of the healthcare provider;

permitting the patient to selectively register with the healthcare provider either electronically over the Internet using the data gathering form structure presented at the patient interface prior to an actual office visit or non-electronically with the electronic form printed on paper in a blank format for data gathering outside of the data management server using the standardized format, and where the patient selects to register electronically over the Internet and authorizes the sharing with the healthcare provider using the patient interface, receiving the authorization code to access the information in the record of the patient on the data management system, the authorization code provided to the healthcare provider from the data management server by either an automated phone call to the phone number associated with the healthcare provider or an automated facsimile to the facsimile number associated with the healthcare provider, the patient interface further permitting the patient to authorize a sharing of the patient information in the record of the patient with another entity different from the healthcare provider;

entering by the healthcare provider the authorization code at the healthcare provider interface to permit access by the

healthcare provider to the record of the patient on the data management server; and

accessing by the healthcare provider the information of the patient in the record of the patient via the healthcare provider interface, the information presented at the healthcare provider interface in the electronic form having the standardized format.

REJECTION AT ISSUE²

The Examiner has rejected claims 25–28 under 35 U.S.C. § 101 for being directed to patent-ineligible subject matter. Non-Final Act. 2–3.

PRINCIPLES OF LAW

Patent-eligible subject matter is defined in 35 U.S.C. § 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 35 U.S.C. § 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

² Throughout this Decision we refer to the Reply Brief (Reply Br.) filed December 12, 2016, Appeal Brief (App. Br.) filed April 11, 2016, Non-Final Office Action (Non-Final Act.) mailed September 14, 2015, and Examiner’s Answer (Ans.) mailed October 11, 2016.

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.

ANALYSIS

We have reviewed Appellants’ arguments on pages 11 through 18 of the Appeal Brief and pages 4 through 11 of the Reply Brief, the Examiner’s rejections, and the Examiner’s response to Appellants’ arguments.

Appellants’ arguments have not persuaded us of error in the Examiner’s conclusion that the claims are directed to patent-ineligible subject matter.

Regarding the first part of the *Alice/Mayo* analysis, the Examiner concludes that claims 25–28 are directed to the abstract idea of “processing healthcare information and patient management.” Non-Final Act. 2; Ans. 3–4. The Examiner concludes the claims are directed to concepts similar to those found patent-ineligible in *Cyberfone Sys., LLC v. CNN Interactive Group, Inc.*, 558 F. App’x. 988, 992 (Fed. Cir. 2014) (nonprecedential) and *SmartGene Inc. v. Adv. Bio. Labs. SA*, 555 F. App’x 950 (Fed. Cir. 2014) (nonprecedential). Ans. 3. In *Cyberfone*, the Federal Circuit 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*, 558 F. App’x. at 992. Similar to the claims in *Cyberfone* that use categories to organize, store, and transmit information, the instant claims “define using a form with fields or categories to gather, organize, store and transmit patient information.” Ans. 3. In *SmartGene*, the patent-ineligible claims were directed to guiding a selection of a therapeutic treatment using knowledge bases, generating ranked lists of treatment routines, and generating advisory information for treatment. *SmartGene*, 555 F. App’x at 954. Similar to the claims in *SmartGene* that compare information and use rules to identify options, the instant claims compare “a healthcare provider authorization code to a stored authorization code to identify system information access options.” Ans. 3.

Moreover, limitations similar to those of the instant claims were held to be abstract in *HealthTrio LLC v. Aetna, Inc.*, 2017 WL 192962 (mem.) (Fed. Cir. 2017), in which the Federal Circuit affirmed a District Court’s

decision holding collection of data from various sources with the goal of compiling a single, comprehensive, patient health record is patent ineligible. Also applicable to the instant claims, our reviewing court has said that abstract ideas include the concepts of collecting data, recognizing certain data within the collected data set, and storing the data in memory. *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347 (Fed. Cir. 2014). Additionally, much like the instant claims, the collection of information and analysis of information (e.g., recognizing certain data within the dataset) are also abstract ideas. *Elec. Power*, 830 F.3d at 1353. Similarly, “collecting, displaying, and manipulating data” is an abstract idea. *Intellectual Ventures I LLC v. Capital One Financial Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017). Further, to the extent the Examiner determines that the instant claims comprise a combination of abstract ideas, combining several abstract ideas (such as the organization of human activity in the healthcare field and a fundamental business practice) does not render the combination any less abstract. *RecogniCorp*, 855 F.3d at 1327 (“Adding one abstract idea ... to another abstract idea ... does not render the claim non-abstract.”); *see also FairWarningIP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1094 (Fed. Cir. 2016) (determining the pending claims were directed to a combination of abstract ideas). Thus, we determine no error in the Examiner’s conclusion that the claims are directed to patent-ineligible subject matter.

Regarding the second part of the *Alice/Mayo* analysis, the Examiner concludes additional elements or combination of elements in the claims do not provide meaningful limitations to transform the abstract idea into a patent-eligible application of the abstract idea. Non-Final Act. 2–3;

Ans. 4–5. Appellants argue the claims are directed to significantly more than an abstract idea because the claims provide a technical solution to the Internet-centric challenge of maintaining a constant workflow in regards to data capture where registration is permitted to take place both electronically over the Internet and non-electronically using conventional paper forms. App. Br. 12–14; Reply Br. 5–7.

Appellants’ support their argument by arguing that permitting a patient to selectively register electronically over the Internet or non-electronically via paper, “advantageously results in constant workflow for the healthcare provider, no matter whether the patient registers over the Internet or not.” App. Br. 12. Appellants proffer further support, arguing that the claimed invention improves computer-related technology by allowing computer performance of a function not previously performable by a computer. Reply Br. 6–7. Appellants additionally argue that the use of specific claimed hardware, such as a telephone/facsimile device, facilitates a solution to the Internet-centric problem. App. Br. 12–14.

Appellants have not persuasively argued the claims solve a technical problem rather than a business problem. Unlike the claims in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), the instant claims address a business problem, i.e., lack of standardized patient registration. Spec. ¶¶ 15–17; Abstract. Appellants’ claimed solution (i.e., standardizing patient registration) is not rooted in computer technology, such that the invention on appeal overcomes a problem specifically arising in the realm of computers, including computer networks, as was the case with the type of claim the court concluded was patent-eligible in *DDR*. *DDR*, 773 F.3d at 1257. Further, our reviewing court has “made clear that mere

automation of manual processes using generic computers does not constitute a patentable improvement in computer technology.” *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017). Similar to the claims in *Credit Acceptance*, the focus of the instant claims is on a business practice (patient registration), “and the recited generic computer elements [such as a telephone/facsimile device *et al.*] ‘are invoked merely as a tool.’” *Id.* (citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016)); *see also Versata Dev. Grp.*, 793 F.3d at 1334.

Appellants additionally argue the claims are directed to significantly more than an abstract idea because they are novel and nonobvious, as acknowledged by the Examiner. App. Br. 14–17. This argument is not persuasive. Although the second step in the *Alice/Mayo* analysis includes a search for an inventive concept, the analysis is not an evaluation of novelty or nonobviousness, 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. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 132 S. Ct. at 1304; *see also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (“The novelty of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.”); *see also Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1315 (Fed. Cir. 2016) (explaining that a jury's determination that certain prior art did not anticipate or render obvious the asserted claims did “not resolve the

question of whether the claims embody an inventive concept at the second step of *Mayo/Alice*").

In addition, Appellants argue, for the first time in the Reply Brief, the Examiner erred because “[c]laims 25–28 as a whole [] do not unduly preempt all computer network systems for registering patients over the Internet.” Reply Br. 10–11. This new argument could have been presented in the Appeal Brief, was not prompted by the Examiner’s Answer, and is not based on any new arguments or grounds of rejection in the Examiner’s Answer. As a result, Appellants have waived such untimely argument because Appellants have not shown good cause for belatedly raising the new argument. *See* 37 C.F.R. § 41.41(b)(2).

Nevertheless, Appellants’ argument is not persuasive. A lack of complete preemption does not make the claims any less abstract. *See buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014); *see also Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–1363 (Fed. Cir. 2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”). Accordingly, we are unpersuaded by Appellants’ argument that the claims do not preempt every manner of registering patients over the Internet. Reply Br. 10–11.

Because Appellants do not argue the claims separately, we sustain the rejections of claims 26–28 under 35 U.S.C. § 101 for the same reasons as claim 25. *See* 37 C.F.R. § 41.37(c)(1)(iv).

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DECISION

We affirm the Examiner's rejections of claims 25–28 under 35 U.S.C. § 101.

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