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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* MARK A. HOFFMAN

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Appeal 2017-003857
Application 12/860,646[1]
Technology Center 3600

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Before ST. JOHN COURTENAY III, MICHAEL R. ZECHER, 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 Final Rejection of claims 1–16, 21, 22, and 24,[2] which are all of the claims pending in this application.[3] We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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[1] According to Appellant, the real party in interest is Cerner Innovation, Inc. Br. 3. This Appeal is related to Appeal No. 2016-008486. *See id.*

[2] In the Final Action, the Examiner erroneously included claim 23 in the rejection heading. *See* Final Act. 3.

[3] Claims 17–20 and 23 have been canceled. Br. 23, 24 (Claims App'x).

## INVENTION

Appellant's application relates to centralized data mapping for site-specific data extraction. Title. Claim 1 reads as follows:

> 1. One or more non-transitory computer storage media storing computer-useable instructions that cause one or more computing devices at a central site, to perform a method of extracting summary data from a healthcare related site system, the method comprising:
>
> at a web service of the central site, determining a category of summary data associated with the summary data that is to be retrieved, wherein the category of summary data corresponds to one or more of a healthcare order, a clinical event, or a diagnosis;
>
> receiving a first site-specific code that identifies the category of summary data at a first healthcare related site system, wherein the first site-specific code is different from a second site-specific code, the second site-specific code identifying the category of summary data at a second healthcare related site system;
>
> mapping the first site-specific code to a standard code wherein the standard code is a non-site-specific code that identifies the category of summary data;
>
> receiving a request to determine the first site-specific code to be identified in an extraction script, that when executed, extracts the summary data associated with the first site-specific code;
>
> providing the first healthcare related site system an indication of the first site-specific code to be identified in the extraction script;
>
> directing the first healthcare related site system to execute a set of one or more extraction scripts that are tuned by modifying the behavior of the extraction script by inserting the first site-specific code utilizing the mapping; and
>
> in response to the execution, at the first healthcare related site system, of the set of one or more extraction scripts, receiving the summary data from the first healthcare related site system.

## REJECTION

Claims 1–16, 21, 22, and 24 stand rejected under 35 U.S.C. § 101 because the claimed subject matter is judicially-excepted from patentability. Final Act. 3–4; Ans. 3–4.

## ANALYSIS

We have reviewed the rejection of claims 1–16, 21, 22, and 24 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 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. 3–16). We provide the following explanation for emphasis.

Appellant first contends the Examiner failed to establish a prima facie case of patent ineligibility under § 101. Br. 8. We disagree. "[T]he 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 Final Office Action adequately explains the § 101 rejection. *See* Final Act. 3, 14–15. The Examiner's statements satisfy § 132 because they apply the *Mayo/Alice* analytical framework, particularly the two-step test, 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* Br. 7–18. Appellant has not responded by alleging a failure to understand the rejection. *Id.*

Appellant next contends the Examiner erred in rejecting the pending claims as directed to patent-ineligible subject matter. Br. 8. Appellant argues claims 1–16, 21, 22, and 24 as a group (Br. 8), and we choose claim 1 as representative of the group. *See* 37 C.F.R. § 41.37(c)(1)(iv).

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 1 are directed to a series of steps related to extracting healthcare data from disparate sources. Final Act. 3–4; Ans. 3–4. We also agree that, here, the concept of extracting healthcare data from disparate sources is similar to the concept of comparing new and stored information and using rules to identity options, which is an abstract idea. Ans. 8 (citing *SmartGene Inc. v. Adv. Bio. Labs. SA*, 555 F. App'x 950 (Fed. Cir. 2014)). We further agree with the Examiner that portions of claim 1 are directed to the abstract idea of using categories to organize, store, and transmit information because "data is labeled in particular categories such as summary data categories, site specific codes, extraction scripts, etc. in order to assemble, process and communicate information." Ans. 8.

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 "site-specific codes" are nothing more than data used in an algorithm process that employs a central system (i.e., "computer devices") to modify an execution script using mathematical comparisons and rule-based processes. *See* Ans. 7. 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 for "determining a category of summary data," rules for mapping site-specific codes to standard codes, and rules for tuning extraction scripts required by claim 1. *See* Ans. 10.

Appellant contends the Examiner's "overly broad characterization of the claimed subject matter is inaccurate and ignores the specific features included in the claims." Br. 11. Appellant, however, does not explain persuasively how the Examiner mischaracterized claim 1 (*see* Ans. 5–11) or how the claims differ from those in *SmartGene*.

Appellant further contends the claims are "necessarily rooted" in a computer technology and address a technological challenge confined to computer technology. Br. 12–13 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014)). Appellant argues "various claims of the present Application may address the technological challenge of collecting massive amounts of clinical data in healthcare information technology systems from disparate health systems that have varying levels of integrity which scan for real outbreaks that present risk to public health." *Id.* at 13.

Appellant's arguments are not persuasive at least because they are based upon elements not recited or required by the claims. Moreover, collecting data from more than one system using generic computer components is routine and well-known, and Appellant has not identified any particular inventive technology for performing those functions. Here, the advance the claims purport to make is a process of gathering and analyzing information, and "not any particular assertedly inventive technology for

performing those functions." *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016).

Appellant also argues the pending claims are similar to hypothetical claim 1 of Example 23 of the Appendix to the July 2015 Update: Subject Matter Eligibility, issued by the PTO. Br. 13. Claim 1 of Example 23 is directed to a computer-implemented method for dynamically relocating information on a graphical user interface if a window overlap condition exists. *See id.* Appellant, however, does not explain persuasively how rejected claim 1 is similar to claim 1 of Example 23 apart from arguing that "this Example is similar to the present claims." *See id.*

For these reasons, we are not persuaded of error in the Examiner's determination that the claims are directed to the abstract idea of comparing new and stored information and using rules to identify options. *See* Final Act. 3; Ans. 6–13.

Turning to the second step of the *Alice* inquiry, we find nothing in claim 1 that adds anything "significantly more" to transform the abstract concept of comparing new and stored information and using rules to identify options into a patent-eligible application. *Alice*, 134 S. Ct. at 2357.

We are not persuaded by Appellant's arguments that claim 1 includes "elements or computer functions that are not well-understood, routine and conventional in the field, as evidenced by the absence of prior-art-based rejections." Br. 15. Even if we were to conclude Appellant's claims are nonobvious, such finding would not necessarily lead to the conclusion that subject matter is patentable eligible. *See Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2117 (2013). Appellant's further argument that the recited computers are special-purpose computers (Br. 16–

17) is not persuasive in light of the description in the Specification that "[t]he present invention may be operational with numerous other *general purpose* or special purpose *computing system environments or configurations*." Spec. ¶ 29 (emphases added). That a computer may be programmed to perform the limitations recited in the claims is not sufficient to establish an inventive concept where the limitations involve nothing more than conventional functions computers perform, such as receiving and looking up data, executing requests, and mapping data. Here, we are not persuaded the claims improve the functioning of the computer device. *See Alice*, 134 S. Ct. at 2359.

Appellant also argues claim 1 poses no risk of preempting the abstract idea. *See* Br. 17. 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.

For these reasons, we are not persuaded the Examiner erred in concluding the subject matter of claim 1 is judicially-excepted from patentability.

Accordingly, we sustain the Examiner's § 101 rejection of independent claim 1, as well as the Examiner's § 101 rejection of

independent claims 9 and 21, and dependent claims 2–8, 10–16, 22, and 24, not argued separately. *See* Br. at 7.

## DECISION

We affirm the Examiner's decision rejecting claims 1–16, 21, 22, and 24.

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