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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRENT BACKHAUS

Appeal 2017-005057
Application 13/966,594
Technology Center 3600

Before ELENI MANTIS MERCADER, LINZY T. MCCARTNEY, and JOHN P. PINKERTON, *Administrative Patent Judges*.

PINKERTON, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant[1] appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 24–30, 32–38, 40–44, and 46–48. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] Appellant identifies Virtual Radiologic Corporation as the real party in interest. App. Br. 2. Virtual Radiologic Corporation identifies that it is wholly owned by American Radiology, LLC, which is wholly owned by MEDNAX Services, Inc., which is wholly owned by MEDNAX, Inc. *Id.*

STATEMENT OF THE CASE

Introduction

Appellant describes the disclosed and claimed invention as follows:

> A teleradiology image processing system configured to receive, process, and transmit radiology read requests and digital radiology image data is disclosed herein. In one embodiment, a radiology processing system includes a series of processing components configured to receive digital radiology data from a medical provider, extract relevant information and radiology scan images from the digital radiology data, and initiate and control a workflow with a qualified remote radiologist who ultimately performs a read of the radiology scan images. Further embodiments also facilitate data processing within the image processing system in response to medical facility rules and preferences; translation or conversion of digital images to other formats; compilation of patient and medical facility data obtained from the digital radiology data into medical records or data stores; assignment of radiology studies within a teleradiology workflow in response to licensing and credentialing rules; and billing functions in response to completed reads by the remote radiologist.

Abstract.[2]

Claim 40 is representative and reproduced below:

> 40. A method for processing medical images in a workflow through use of an image processing system, the image processing system comprising at least one hardware processor configured to perform operations, the operations including:

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[2] Our Decision refers to the Final Office Action mailed May 13, 2016 ("Final Act."); Appellant's Appeal Brief filed Oct. 17, 2016 ("App. Br.") and Reply Brief filed Feb. 1, 2017 ("Reply Br."); the Examiner's Answer mailed Dec. 1, 2016 ("Ans."); and the original Specification filed Aug. 14, 2013 ("Spec.").

processing electronic imaging data, wherein the electronic imaging data includes a plurality of digital medical images that originate from a medical imaging procedure performed by a medical imaging modality;

processing medical information included in the electronic imaging data, the processing including performing a determination of at least one requirement for a diagnostic evaluation of the plurality of digital medical images generated from the medical imaging modality based on the medical information included in the electronic imaging data;

maintaining electronic worklists associated with respective evaluators of a plurality of evaluators, the electronic worklists for the respective evaluators being maintained at the image processing system, and the electronic worklists for the respective evaluators providing a listing of one or more pending diagnostic evaluations designated for performance by the respective evaluators, wherein the electronic worklists for the respective evaluators include an electronic worklist for a particular evaluator from the plurality of evaluators;

designating the particular evaluator for performance of the diagnostic evaluation of the plurality of digital medical images generated from the medical imaging modality, the particular evaluator designated from among the plurality of evaluators, wherein the particular evaluator is designated based on a corresponding match of at least one qualification of the particular evaluator with the at least one requirement for the diagnostic evaluation; and

updating the electronic worklist for the particular evaluator in response to designating the particular evaluator, wherein the electronic worklist for the particular evaluator is updated to include a pending evaluation for the performance of the diagnostic evaluation of the plurality of digital medical images in the listing of the one or more pending diagnostic evaluations designated for performance by the particular evaluator; and

> transmitting the electronic imaging data for the plurality of digital medical images to a computing device associated with the particular evaluator, wherein the plurality of digital medical images are viewable at the computing device associated with the particular evaluator in response to acceptance of the diagnostic evaluation of the plurality of digital medical images from the electronic worklist for the particular evaluator.

App. Br. 32–33 (Claims Appx.).

Rejections on Appeal[3]

Claims 24–30, 32–38, 40–44, and 46–48 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to patent-ineligible subject matter.

Claims 24–30, 32–38, 40–44, and 46–48 stand rejected on the ground of nonstatutory double patenting over claims 1–24 of US 8,515,778 B2.[4]

ANALYSIS

We have reviewed the Examiner's rejection of claims 24–30, 32–38, 40–44, and 46–48 under 35 U.S.C. § 101, in light of Appellant's arguments in the Briefs. For the reasons discussed *infra*, we are not persuaded by

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[3] The rejection of claims 24–30, 32–38, 40–44, and 46–48 under 35 U.S.C. § 112, first paragraph, has been withdrawn by the Examiner. Ans. 9.

[4] Appellant states that the Examiner's nonstatutory double patenting rejection of claims 2–9, 12–17, 19–24, and 26–28 "is not being appealed." App. Br. 11. In the Reply Brief, Appellant confirms that "the nonstatutory double patenting rejection that is outstanding for claims 24–30, 32–38, 40–44, and 46–48 is not being appealed." Reply Br. 1. Because Appellant is required to present arguments with respect to each ground of rejection, but does not do so with respect to the nonstatutory double patenting rejection, we summarily sustain the rejection of claims 24–30, 32–38, 40–44, and 46–48 on the ground of nonstatutory double patenting over claims 1–24 of US 8,515,778 B2. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Appellant's arguments that the Examiner erred in rejecting these claims under 35 U.S.C. § 101.

Applicable Law

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a "new and useful process, machine, manufacture, or composition of matter." 35 U.S.C. § 101. The Supreme Court, however, has long interpreted 35 U.S.C. § 101 to include an implicit exception: "Laws of nature, natural phenomena, and abstract ideas" are not patentable. *See, e.g.*, *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S.Ct. 2347, 2354 (2014) (citation omitted).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 75–77 (2012), "for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts." *Alice*, 134 S.Ct. at 2355. The first step in the analysis is to "determine whether the claims at issue are directed to one of those patent-ineligible concepts." *Id.* For example, abstract ideas include, but are not limited to, fundamental economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Id.* at 2355–57. The "directed to" inquiry asks not whether "the claims *involve* a patent-ineligible concept," but instead whether, "considered in light of the [S]pecification,[] 'their character as a whole is directed to excluded subject matter.'" *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (citations omitted). In that regard, we determine whether the claims "focus on a specific means or method that improves the relevant technology" or are "directed to a result or effect that itself is the abstract idea and merely invoke

generic processes and machinery." *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016) (citation omitted).

If, at the first stage of the *Alice* analysis, we conclude that the claim is not directed to a patent-ineligible concept, it is considered patent eligible under 35 U.S.C. § 101 and the inquiry ends. *Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1047 (Fed. Cir. 2016).

If the claims are directed to a patent-ineligible concept, the second step in the analysis 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." *Alice*, 134 S.Ct. at 2355 (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.* (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).

Appellant's Arguments[5]

Appellant argues the Examiner failed to establish a prima facie case of subject matter ineligibility because the Examiner: (1) did not fully articulate the abstract idea; (2) did not establish that the respective elements of the claims are directed to an abstract idea; and (3) "failed to provide proper evidence that the claims do not amount to significantly more than an abstract idea." App. Br. 17–18. According to Appellant, even assuming arguendo that the claims are directed to an abstract idea, the elements of the claims "amount to significantly more" than an abstract idea under the principles confirmed by the *Enfish, BASCOM, and McRO* cases. *Id.* at 18.

In particular, Appellant argues the Examiner failed to articulate how the claimed invention is directed to a judicial exception by identifying certain claim elements or concepts individually and not in the context in which these operations are conducted in the claims. *Id.* Appellant also argues the Examiner erred in finding the claims recite the abstract idea of "organizing human activity (i.e., managing human behavior—managing tasks by assigning them to qualified radiologists as well as maintaining and updating worklists)" because this ignores recited computer-implemented claim elements and actions. *Id.* at 19 (emphasis omitted). Appellant further argues that the combination of elements in the claims are not directed to an ineligible concept and "[s]imply because the claims have a relationship to

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[5] Appellant argues claims 24–30, 32–38, 40–44, and 46–48 as a group. *See* App. Br. 17–25; *see also* Reply Br. 2–8. We consider method claim 40 to be representative of the claimed subject matter on appeal and, therefore, we decide the 35 U.S.C. § 101 rejection of claims 24–30, 32–38, 40–44, and 46–48 on the basis of representative claim 40. *See* 37 C.F.R. § 41.37(c)(1)(iv).

information, rules and tasks" does not prove the claims are directed to abstract concepts. *Id.* In the Reply Brief, Appellant further argues the Examiner failed to consider the claims as a whole and that the Examiner's finding that the claim steps are an "abstract method of organizing human activity" assumes the claims can be rewritten and recharacterized "to remove the actual technical context and limitations." Reply Br. 2–3. Appellant also argues the Examiner's oversimplification and comparison of the claims to those in *SmartGene*, *Cyberfone*, *In re Meyer*, *and Accenture* "might be relevant if the appealed claims actually recited any of these concepts[]," but "[t]hey do not." *Id.* at 3.

Regarding Appellant's contention that the Examiner failed to establish that the claimed subject matter is abstract, Appellant argues "[t]he involvement of specific computer elements and data processing, transmission, and actions in the claims calls the entire premise of abstractness into question." App. Br. 20. Appellant argues that, like *Enfish*, the "claims are directed to an improvement in computer technology; the claims result in an improvement to the functioning of the computer network and computer system itself even before a diagnostic evaluation (e.g., a radiological read of the image data) is performed." *Id.* at 21. In that regard, Appellant argues that the claims solve "an Internet-centric problem (determining which computer system to send data to) that is necessarily rooted in computer technology." *Id.* Appellant further argues "[t]he recited operations are performed electronically and in a computer, excluding any possibility that the claims are directed to human activities or mental ideas by themselves." *Id.* at 21. Appellant also argues that, based on *Amdocs*, in which the claims were found patent eligible where "generic components

operate in an unconventional manner to achieve an improvement in computer functionality," and the computer operations directly recited in the claims, "the Examiner's findings of abstractness cannot be sustained as a matter of law." Reply Br. 4–5.

Regarding Appellant's contention that the Examiner failed to establish the claimed subject matter is not "significantly more" than a judicial exception, Appellant argues this prong of the analysis need not be performed because of "the Examiner's own concession that at least some of the claims include novel features over the prior art of record." App. Br. 22. Appellant asserts it is not understood how the claims can be considered novel and nonobvious, and yet still be "characterized as abstract and 'well understood, routine, and conventional' in light of the same art." *Id.*at 23. Appellant also argues that, "[e]ven so, the remaining claims are significantly more than the alleged judicial exception, and invoke elements that are not well-understood, routine, or conventional in the art." *Id.* Citing *McRO,* Appellant argues that "the use of a computer-driven mechanism to automatically transfer data in a network, manage an electronic worklist, and process medical data characteristics cannot be excluded from subject matter eligibility even if they are simplified down to 'tasks.'" *Id.* Appellant further argues *BASCOM* held that "a claim can . . . recite 'known, conventional pieces'" but still result in "'significantly more' than an abstract idea" and that the claims here "provide meaningful limits, with anything but a conventional or generic arrangement." *Id.* at 24. In the Reply Brief, Appellant argues the Examiner erred by not considering "all claim elements as a whole for significantly more." Reply Br. 6. Appellants also argue that "the Examiner's reading of an 'unconventional feature' requirement in *DDR Holdings* is quite narrow

and suggests that there was a new protocol involved in the invention." *Id.* at 6–7.

Pima Facie Case

Before substantively analyzing claim 40 under the two-step *Alice* test, we address Appellant's contention that the Examiner failed to establish a prima facie case of subject matter ineligibility. *See* App. Br. 17–18. Here, the Examiner stated the statutory basis for the rejection, namely, "under 35 U.S.C. [§] 101 because the claimed invention is directed to a judicial exception . . . without significantly more." Final Act. 3. The Examiner also performed the two-step *Alice* test. *Id.* at 3–6; *see also* Ans. 3–9. Thus, we conclude the Examiner provided an adequate explanation of the rejection under 35 U.S.C. § 101 and met the notice requirement of 35 U.S.C. § 132. *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011).

In view of the Examiner's findings and conclusions in the Answer and Final Office Action, we also are not persuaded by Appellant's argument that the Examiner did not fully articulate the abstract idea (*see* App. Br. 17–18), particularly in view of the Examiner's finding that the claims recite the abstract idea of "organizing human activity (i.e. managing human behavior – managing tasks by assigning them to qualified radiologists as well as maintaining and updating worklists)." Final Act. 4 (emphasis omitted). Furthermore, we are not persuaded by Appellant's argument the Examiner failed to establish a prima facie case of ineligibility because the Examiner "failed to provide proper evidence" that the claims do not amount to significantly more than an abstract idea. *See* App. Br. 17–18. We disagree that the Examiner failed to provide evidence because the Examiner cited to the claims and the Specification in finding that the claims amount to no more

than a recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine, and conventional activities. *See* Final Act. 4–6; *see also* Ans. 4–9 (citing Spec. ¶¶ 3, 26–30, 33, 51–55, 136, 145–149, and 182). We also find that Appellant's argument is conclusory and fails to identify any device, component, system or process recited in the claims that Appellant contends is not well-understood, routine, and conventional in the art, much less present any arguments in support of such contention. Thus, although our reviewing court recently held that "[t]he patent eligibility inquiry may contain underlying issues of fact" (*see Berkheimer v. HP Inc.*, 881 F.3d 1360, 1365 (Fed. Cir. 2018)), we determine that Appellant's argument is insufficient to raise an issue of fact requiring the Examiner to present additional evidence showing that any aspect of the claims is well-understood, routine, and conventional in the art.

Step One of *Alice*

Regarding claim 40, the preamble recites "[a] method for processing medical images in a workflow through use of an image processing system," comprising at least one hardware processor configured to perform 6 operations or steps. Claim 40 then recites the following 6 steps (which the Examiner finds are described in the cited portions of the Specification): (1) processing image data that originate from an imaging modality (*see* Spec. ¶¶ 33, and 51–55); (2) processing medical information in the images to determine a requirement for a diagnostic evaluation based on the medical information (*see* Spec. ¶¶ 27–29, and 33); (3) maintaining worklists associated with evaluators, wherein the worklists include a worklist for a particular evaluator (*see* Spec. ¶¶136, 149, and 182); (4) designating an

evaluator for performance of the evaluation based on a match between an evaluator qualification and a diagnostic evaluation requirement (*see* Spec. ¶¶ 145–146); (5) updating the worklist for the evaluator in response to designating the particular evaluator (*see* Spec. ¶ 149); and (6) transmitting the image data to a computing device associated with the particular evaluator, wherein the images are viewable in response to acceptance of the diagnostic evaluation from the worklist for the particular evaluator (*see* Spec. ¶¶ 30, and 147–148).

Considering the focus of claim 40 as a whole, in view of Appellant's Specification, we agree with the Examiner that claim 40 is directed to an abstract idea—a method of organizing human activity, i.e., managing the performance of diagnostic evaluations by assigning them to qualified evaluators, as well as maintaining and updating worklists. Final Act. 4. As discussed *infra*, claim 40 is directed to a combination of features that we conclude are similar or analogous to claims in other cases that courts have found are directed to an abstract idea. *See Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) ("The concept of data collection, recognition, and storage is undisputedly well-known."); *Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016) (claims focus on the abstract idea of collecting information, analyzing it, and displaying certain results of the collection and analysis); *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1341 (Fed. Cir. 2017) (holding that the claimed invention is directed "to the abstract idea of collecting, displaying, and manipulating data of particular documents"); *SmartGene, Inc. v. Advanced*

Biological Labs., SA, 555 F.Appx. 950, 954 (Fed. Cir. 2014) (claims recite comparing new and stored information and using rules to identify options).

In particular, consistent with the Examiner's conclusions, we conclude step (1) of "processing image data that originate from an imaging modality," and step (2) of "processing medical information in the images to determine a requirement for a diagnostic evaluation based on the medical information," are directed to collecting and analyzing information, which courts have held are in the realm of abstract ideas. *See Electric Power*, 830 F.3d at 1353–54. We also conclude that step (3) of "maintaining worklists associated with evaluators, wherein the worklists include a worklist for a particular evaluator," step (4) of "designating an evaluator for performance of the evaluation based on a match between an evaluator qualification and a diagnostic evaluation requirement," and step (5) of "updating the worklist for the evaluator in response to designating the particular evaluator," could be performed by a human with pen and paper. In that regard, our reviewing court has held that "analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, [are] essentially mental processes within the abstract-idea category." *Electric Power*, 830 F.3d at 1354; *see also Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146 (Fed. Cir. 2016). "[T]he fact that the required calculations could be performed more efficiently via a computer does not materially alter the patent eligibility of the claimed subject matter." *Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012).

We also conclude, as does the Examiner, that step (5) of "designating an evaluator. . . based on a match" of a qualification of the evaluator and a

diagnostic evaluation requirement is directed to "using rules to identify options as in *SmartGene*." Ans. 14 (emphasis omitted). We further conclude that step (6) of "transmitting the image data to a computing device associated with the particular evaluator" where they are viewable in response to acceptance of the diagnostic evaluation from the worklist "as an ancillary part of such collection and analysis" of information as set forth in steps (1)–(5) of claim 40. *See Electric Power*, 830 F.3d at 1354.

Appellant argues the Examiner failed to articulate how the claimed invention is directed to a judicial exception by identifying certain claim elements or concepts individually and not in the context in which these operations are conducted in the claims. *See* App. Br. 18. We do not agree. As reflected in the foregoing analysis of claim 40, it is directed to a combination of features, as set forth in steps (1)–(6). Thus, it was necessary for the Examiner to consider these various features, individually or as groups, and in doing so, the Examiner properly considered all of the limitations of claim 40.

As discussed *supra*, we conclude, as does the Examiner, that the various features of claim 40 are directed to abstract ideas. In that regard, we note that merely combining several abstract ideas does not render the combination any less abstract. *RecogniCorp, LLC v. Nintendo Co., Ltd.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) ("Adding one abstract idea . . . to another abstract idea . . . does not render the claim non-abstract."); *see also FairWarning IP, 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, for these same reasons, we also are not persuaded by

Appellant's argument that the Examiner did not establish that the respective elements of claim 40 are directed to an abstract idea. *See* App. Br. 18–19.

Although Appellant argues that the claims are directed to "an improvement to the functioning of the computer network and computer system itself," even before a diagnostic evaluation is performed (*see* App. Br. 21), this argument is not convincing because it is conclusory and unsupported by the claim language. *See Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1345 (Fed. Cir. 2013) (admonishing that "the important inquiry for a § 101 analysis is to look to the claim[;]" "the complexity of the implementing software or the level of detail in the specification does not transform a claim reciting only an abstract concept into a patent-eligible system or method"). Nor has Appellant identified any portion of the Specification, or provided any evidence or technical reasoning, demonstrating that claim 40 achieves a technical advance or improvement to the computer network and computer system.

Although Appellant argues that the decisions in *DDR,*[6] *Enfish, BASCOM,*[7] *McRO,* and *Amdocs*[8] support Appellant's argument that claim 40 is directed to an improvement in computer technology or the functioning of a computer, Appellant's arguments are not persuasive because Appellant has not shown that the claims in the cited cases are similar or analogous to claim 40. In *DDR Holdings*, the disputed claims solved an Internet-specific

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[6] *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014).
[7] *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016).
[8] *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1300, 1302 (Fed. Cir. 2016).

problem with an Internet-based solution that was "necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks." *DDR Holdings*, 773 F.3d at 1257–58. That is not the case here. Instead, as the Examiner's finds, "[d]etermining which computer to send data to is not an 'Internet-centric problem[.]' The [S]pecification discloses that the network (an intranet or the Internet) operates in a purely conventional manner. . . . The problem is where to send the data; once that is decided, the Internet operates in a typical manner."[9] Ans. 18–19.

Regarding *Enfish*, Appellant has not demonstrated that the claims "improve the way a computer stores and retrieves data in memory," as the claims in *Enfish* did via a "*self-referential* table for a computer database." *See Enfish*, 822 F.3d at 1336, 1339. In *BASCOM*, the court held that an inventive concept can be found in a non-conventional and non-generic arrangement of known, conventional pieces. *See BASCOM*, 827 F.3d at 1350. Here, as the Examiner finds, the claims are distinguishable from those in *BASCOM*. Ans. 23–24. In *BASCOM*, the system claims were directed to a "content filtering system for filtering content retrieved from an Internet computer network," which the court held were directed to an abstract idea. *Id.* at 13, 48–49. The court further held the claims included an inventive concept in the ordered combination of system components, including a local client computer and a remote ISP server connected to the client computer and Internet computer network providing for "the installation of a filtering tool at a specific location, remote from the end-users, with customizable

[9] Contrary to Appellant's argument, we are not persuaded that the Examiner read an "unconventional feature" requirement in *DDR*. See Reply Br. 6–7.

filtering features specific to each end user." *BASCOM*, 827 F.3d at 1350. Appellants have failed to establish that claim 40 includes a similar or analogous arrangement or "ordered combination" of components. Instead, Appellant makes only the conclusory statement that Appellant "has referred to numerous technical advantages that occur in processing and bandwidth resources of computer networks, data processing, and computer systems as a result of the claimed invention." Reply Br. 7 (citing App. Br. 21, 23).

In *McRO*, the court held the claims were patent-eligible because the claims recited specific computer-implemented rules that allowed a computer to produce accurate and realistic lip synchronization and facial expressions in animated characters that previously could only be produced by human animators. *See McRO*, 837 F.3d at 1313. Although Appellant argues the Federal Circuit confirmed in *McRO* that "processes that automate tasks that humans are capable of performing are patent eligible if properly claimed" (*see* App. Br. 23), claim 40 fails to recite the technical details of "rules" that allegedly provide an improvement over manual worklist and data management techniques. At best, as the Examiner finds, claim 40 suggests the use of "one rule," "matching an evaluator qualification with a diagnostic evaluation requirement," which is widely known and fails to recite "some unspecified complexity."[10] Ans. 23. Thus, contrary to Appellant's assertion, claim 40 fails to recite the improvement to the claimed system that Appellant argues the claim is directed to.

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[10] Appellant argues the Examiner erred in finding that claim 40 involves only "one rule" and that the rule was widely known. Reply Br. 7. We are not, however, persuaded by Appellant's arguments because they are conclusory and unsupported by any citation to the Specification or persuasive technical reasoning or evidence.

Regarding *Amdocs*, Appellant's argue that "[a]t least this minimum level of computer functionality can be found in the unconventional operations of the recited claims." Reply Br. 5. This argument is not persuasive, however, because Appellant has not demonstrated that the claims provide an "unconventional technological solution . . . to a technological problem" that "improve[s] the performance of the system itself," as explained in *Amdocs*. *See Amdocs,* 841 F.3d at 1300, 1302. Thus, we agree with the Examiner's finding that "the claims do not recite an asserted improvement to the functioning of the computer itself, but rather recite using a computer to lend speed and efficiency to an abstract idea." Ans. 20.

Step Two of *Alice*

Regarding step two of the *Alice* analysis, even though the Examiner's analysis in the Final Office Action is brief, as Appellant notes (*see* App. Br. 22), based on the Examiner's findings and reasons, we agree with the Examiner's determination that the elements of the claims do not provide "significantly more" than the abstract idea. *See* Final Act. 4–6; *see also* Ans. 2–9, 20–24. We also are not persuaded by Appellant's arguments that the Examiner erred.

First, we not persuaded by Appellant's argument that Appellant does not understand how the Examiner can find some of the claims are novel and non-obvious, and still be characterized as abstract and well-understood, routine, and conventional in light of the same art. App. Br. 23. As Appellant acknowledges in the Reply Brief, a finding of novelty or non-obviousness does not automatically lead to the conclusion that the claimed subject matter is patent-eligible. *See* Reply Br. 6. Although the second step in the *Mayo/Alice* 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 Corp.*, 134 S.Ct. at 2355 (quoting *Mayo*, 566 U.S. at 72–73). "Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the [section] 101 inquiry." *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90; *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 [section] 101 categories of possibly patentable subject matter.").

Second, we are not persuaded by Appellant's argument that the remaining claims are "significantly more" and "invoke elements that are not well-understood, routine, or conventional in the art" because it is conclusory and unsupported by any citation to the Specification, claims or other evidence. App. Br. 23. Third, Appellant's arguments that *BASCOM* held a claim can recite known, conventional pieces and still result in "significantly more" and that the claims here provide meaningful limits, with anything but a conventional or generic arrangement are unpersuasive. *Id.* at 24. As discussed *supra*, we agree with Appellant that the court in *Bascom* noted that an inventive concept can be found in a non-conventional and non-generic arrangement of known, conventional pieces, but the claims here are distinguishable from those in *Bascom* because they do not include a similar or analogous arrangement or "ordered combination" of components.

Fourth, Appellant's arguments that *McRO,* and other Federal Circuit precedent, show that the use of a computer-driven performance of a process performed with rules or simplified down to tasks cannot be excluded from subject matter eligibility are unpersuasive because, although the process of claim 40 may be novel and non-obvious, Appellant has failed to show that claim 40 recites a "technological improvement" as Appellant asserts. App. Br. 23; *see also* Reply Br. 8. Unlike the claims in *McRO*, claim 40 does not "focus on a specific means or method that improves the relevant technology," but is "directed to a result or effect that itself is the abstract idea and merely invoke[s] generic processes and machinery." *McRO*, 837 F.3d at 1314 (citation omitted). This is not enough to transform an abstract idea into patent-eligible subject matter. *See, e.g.*, *Alice*, 134 S.Ct. at 2360 (explaining that claims that "amount to 'nothing significantly more' than an instruction to apply the abstract idea . . . using some unspecified, generic computer" "is not *'enough'* to transform an abstract idea into a patent-eligible invention" (quoting *Mayo*, 566 U.S. at 77, 79)); *Intellectual Ventures*, 850 F.3d at 1342 ("[T]he claim language here provides only a result-oriented solution, with insufficient detail for how a computer accomplishes it. Our law demands more.").

Thus, we see nothing in the limitations of claim 40, considered both "individually and 'as an ordered combination,'" that transforms the claimed abstract idea into patent-eligible subject matter.

Accordingly, we sustain the Examiner's rejection of claim 40 under 35 U.S.C. § 101. For the same reasons, we sustain the rejection of independent claims 24 and 34, and dependent claims 25–30, 32, 33, 35–38, 41–44, and 46–48, which are not separately argued, under 35 U.S.C. § 101.

DECISION

We affirm the Examiner's decision rejecting claims 24–30, 32–38, 40–44, and 46–48 under 35 U.S.C. § 101.

We summarily sustain the rejection of claims 24–30, 32–38, 40–44, and 46–48 on the ground of nonstatutory double patenting over claims 1–24 of US 8,515,778 B2.

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). *See* 37 C.F.R. § 1.136(a)(1)(iv)(2016).

AFFIRMED