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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* JORDAN SHLAIN, MAYANK THANAWALA, BENJAMIN  
ROSNER, CHERYL TOTH, TED MEISEL,  
and STEVEN COHEN

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Appeal 2017-006645  
Application 13/617,774<sup>1</sup>  
Technology Center 3600

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Before, MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU  
R. MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's Non-Final rejection of claims 1–42, and 47–48. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

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<sup>1</sup> Appellants identify HealthLoop, Inc. as the real party in interest. Appeal Br. 1.

## THE INVENTION

Appellants' claims generally relate to computer systems in healthcare. Spec. 1, ¶ [0002].

Claim 1 reproduced below, is representative of the subject matter on appeal.

1. A data processing method comprising:
  - receiving at a server computer, from one or more user terminals each hosting a browser and associated with one or more users, during a period relating to a healthcare interaction between one or more managers and the one or more users, one or more structured healthcare data items representing objective conditions and subjective conditions of the one or more users;
  - facilitating an exchange, using the server computer, between user terminals of the one or more managers and user terminals of the one or more users over an internet, of the structured data items;
  - using the server computer, forming and causing a display, on a computer display unit, of one or more of the structured data items in comparison to comparative healthcare information based upon one or more electronic protocols that define plural different e-mail messages to be individually delivered to user terminals according to a communications schedule between a start date and end date that is created and stored before the exchange and identifies a plurality of communications to be sent a plurality of different times at least after, and optionally before, a specified procedure day, and tracking of changes in specified healthcare conditions or procedures;
  - using the server computer, automatically generating and sending, to one of the user terminals over the internet, the different e-mail messages at different individual times according to the schedule between the start date and end date and a plurality of different times at least after, and optionally before, the specified procedure day, in which each of the different e-mail messages prompts the one of the user terminals to provide different structured healthcare data items representing different objective conditions and subjective conditions of particular user; receiving, at the server

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computer using a web-based graphical user interface, response input from the one of the user terminals comprising the different structured healthcare data items representing different objective conditions and subjective conditions of the particular user; automatically updating the changes in specified healthcare conditions or procedures based upon the response input;

using the server computer, based upon the structured healthcare data items and the automatically updating, generating and displaying one or more tracking graphs for the subjective conditions, wherein each of the one or more tracking graphs comprises a graphical representation of historic performance of the user with respect to a tracked metric associated with one of the subjective conditions;

generating and sending, using the server computer, to user terminals of the one or more of the managers, one or more automated alerts about impending failures or worsening of one or more of the objective conditions or subjective conditions;

wherein the method is performed by one or more computing devices.

#### THE REJECTION

The following rejection is before us for review.

Claims 1–42, and 47–48 are rejected under 35 U.S.C. § 101.

#### ANALYSIS

#### 35 U.S.C. § 101 REJECTION

We will sustain the rejection of claims 1–42, and 47–48 under 35 U.S.C. § 101.

The Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that

claim patent-eligible applications of those concepts. First, . . . determine whether the claims at issue are directed to one of those patent-ineligible concepts. If so, we then ask, “[w]hat else is there in the claims before us?” To answer that question, . . . 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. [The Court] 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.”

*Alice Corp., Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

Although the Court in *Alice* made a direct finding as to what the claims were directed to, we find that this case’s claims themselves and the Specification provide enough information to inform one as to what they are directed to.

The steps in claim 1 result in: generating and sending...one or more automated alerts about impending failures or worsening of one or more of the objective conditions or subjective conditions....” The Examiner found that the claims are directed to “processing data to determine a schedule for notification of [a] patient.” (Non-Final Act. 4).

The Specification states,

Follow-up care may be defined as aspects of healthcare that occur after a clinical visit, procedure, hospitalization, or other encounter with a healthcare provider. While the effectiveness of follow-up care is known to have a significant impact on treatment failure, hospital readmissions, morbidity or mortality, in current practice the processes for carrying out follow-up care are poorly defined. Inadequate follow-up care also may be associated with increased healthcare costs arising from complications, treatment failures or readmissions.

Specification ¶ [0005]. Thus, all this evidence shows that claim 1 is directed to alerting about impending failures or worsening of one or more objective or subjective medical conditions. It follows from prior Supreme Court cases, and *Gottschalk v. Benson*, 409 U.S. 63 (1972) in particular, that the claims at issue here are directed to an abstract idea. Alerting about impending failures or worsening of one or more of the objective or subjective medical conditions is a method of organizing human behavior, which is not patentable subject matter. *See Alice*, 134 S. Ct. at 2355–56.

As in *Alice Corp. Pty. Ltd.*, we need not labor to delimit the precise contours of the “abstract ideas” category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of an intermediated settlement in *Alice* and the concept of alerting about impending failures or worsening of one or more of the objective or subjective medical conditions, at issue here. Both are squarely within the realm of “abstract ideas” as the Court has used that term. That

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the claims do not preempt all forms of the abstraction or may be limited to medical conditions, does not make them any less abstract. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1360–61 (Fed. Cir. 2015).

Further, claims involving data collection, analysis, and display are directed to an abstract idea. *Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent ineligible concept”); *see also In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016). Claim 1, unlike the claims found non–abstract in prior cases, uses generic computer technology to perform data reception, transmission, and linkage and does not recite an improvement to a particular computer technology. *See, e.g., McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314–15 (Fed. Cir. 2016) (finding claims not abstract because they “focused on a specific asserted improvement in computer animation”).

The introduction of a computer into the claims does not alter the analysis at *Mayo* step two.

the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility. Nor is limiting the use of an abstract idea “to a particular technological environment.” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same

deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implement[t]” an abstract idea “on ... a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our § 101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional feature[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

*Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2358 (alterations in original) (citations omitted).

“[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2359. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to retrieve, select, and apply decision criteria to data and modify the data as a result amounts to electronic data query and retrieval—one of the most basic functions of a computer. A wherein clause is not a step, but a recitation of how the data and rules are characterized, *viz.* an interpretation, which is perceptible only to the human mind. All of these computer functions are well-understood, routine, conventional activities previously known to the industry. *See Elec. Power Grp. v. Alstom S.A.*, *supra*. Also see *In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303, 1316 (Fed. Cir. 2011) (“Absent a possible narrower construction of the terms

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“processing,” “receiving,” and “storing,” . . . those functions can be achieved by any general purpose computer without special programming.”). In short, each step does no more than require a generic computer to perform generic computer functions. As to the data operated upon, “even if a process of collecting and analyzing information is ‘limited to particular content’ or a particular ‘source,’ that limitation does not make the collection and analysis other than abstract.” *SAP America Inc. v. InvestPic LLC*, 890 F.3d 1016, 1022 (Fed. Cir. 2018).

Considered as an ordered combination, the computer components of Appellants’ method add nothing that is not already present when the steps are considered separately. The sequence of data reception-analysis-access is equally generic and conventional or otherwise held to be abstract. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (sequence of receiving, selecting, offering for exchange, display, allowing access, and receiving payment recited an abstraction), *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (sequence of data retrieval, analysis, modification, generation, display, and transmission), *Two-Way Media Ltd. v. Comcast Cable Communications, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017)(sequence of processing, routing, controlling, and monitoring). The ordering of the steps is therefore ordinary and conventional.

Viewed as a whole, Appellant’s claims simply recite the concept

of alerting about impending failures or worsening of one or more of the objective or subjective medical conditions. The claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than instructions to alert to impending failures or worsening of one or more of the objective or subjective medical conditions. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2360.

The Specification spells out different generic equipment and parameters that might be applied using this concept and the particular steps such conventional processing would entail based on the concept of information access under different scenarios. *See Spec.* ¶¶ 68–71. They do not describe any particular improvement in the manner of computer functions, at least with respect to the claims in the instant application. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of information access using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp. Pty. Ltd.* at 2360.

As to the structural claims, they are no different from the method claims in substance. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic

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computer components configured to implement the same idea. This Court has long “warn[ed] ... against” interpreting § 101 “in ways that make patent eligibility ‘depend simply on the draftsman’s art.’”

*Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2360 (alterations in original).

We have reviewed all the arguments (Appeal Br. 4–25). Appellants have submitted concerning the patent eligibility of the claims before us which stand rejected under 35 U.S.C. § 101. We find that our analysis above substantially covers the substance of all the arguments which have been made. But, for purposes of completeness, we will address various arguments in order to make individual rebuttals of same.

Appellants argue, “[h]ere, the Examiner has provided no evidence or other rational basis to establish that every one of the steps recited in the lengthy, detailed independent claims can and is performed mentally by doctors.” (Appeal Br. 6).

We disagree with Appellants. In this regard, there is no requirement that Examiners must provide evidentiary support in every case before a conclusion can be made that a claim is directed to an abstract idea. *See, e.g.*, para. IV, “JULY 2015 UPDATE: SUBJECT MATTER ELIGIBILITY” to 2014 INTERIM GUIDANCE ON PATENT SUBJECT MATTER ELIGIBILITY (2014 IEG), 79 Fed. Reg. 74618 (Dec. 16, 2014):

The courts consider the determination of whether a claim is eligible (which involves identifying whether an exception such as an abstract idea is being claimed) to be *a question of law*. Accordingly, courts do not rely on evidence that a claimed concept is a judicial exception, and in most cases resolve the

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ultimate legal conclusion on eligibility without making any factual findings. (Emphasis added.)

We agree that evidence may be helpful in certain situations where, for instance, facts are in dispute.<sup>2</sup> But, it is not always necessary. Based on the above analysis and that set forth by the Examiner (Non-Final Act. 2–9; Answer 2–8), we are unpersuaded it is necessary in this case. In addition, the Examiner made findings (Answer 3, and 6) of the well-understood, routine, conventional nature of the combination. The Examiner analyzed the claims using the *Mayo/Alice* two-step framework, consistent with the guidance set forth in the USPTO’s 2015 UPDATE OF THE INTERIM GUIDANCE ON PATENT SUBJECT MATTER ELIGIBILITY. *See id.* at 2–9. Accordingly, we find no error with the Examiner’s prima facie case that the claimed implementation does not rise to more than the performance of well-understood, routine, conventional activities previously known to the industry.

Appellants argue against the Examiner’s citation of *SmartGene* (Non-Final Act. 4) arguing *SmartGene* is not an “abstract idea” case. It is a “mental steps” case. (Appeal Br. 6).

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<sup>2</sup> *See, e.g.*, MPEP 2106.07(a)(III) (2018) (“The courts consider the determination of whether a claim is eligible (which involves identifying whether an exception such as an abstract idea is being claimed) to be a question of law. Thus, the court does not require ‘evidence’ that a claimed concept is a judicial exception, and generally decides the legal conclusion of eligibility without resolving any factual issues.” (citations omitted.))

We disagree with Appellants. Whether a claim is found patent ineligible based on one of either mental activity or abstraction is not dispositive because in both cases the ultimate result is patent ineligibility. See *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011). In fact, the Federal Circuit confirmed that Appellants’ argument is a distinction without a difference stating that it “recognized that ‘mental processes’ and ‘abstract ideas’ (whatever may be the precise definition and relation of those concepts) are excluded from section 101.” *SmartGene, Inc.*, 555 Fed. Appx. at 955.

Appellants further argue, “[m]oreover, claims purporting to improve the functioning of the computer itself, or improving an existing technological process, do not necessarily succumb to the abstract idea exception.” (Appeal Br. 8).

We disagree with Appellants. Claim 1, unlike the claims found non-abstract in prior cases, uses generic computer technology to perform data reception, transmission, and linkage and does not recite an improvement to a particular computer technology. See, e.g., *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016) (finding claims not abstract because they “focused on a specific asserted improvement in computer animation”).

Appellants list selected claim limitations on pages 19–20 of the Appeal Brief maintaining that these “limitations ... provide details about the

*application* of an idea are exactly the type of limitations that are considered ‘significantly more’”. (Appeal Br. 18). Appellants then argue,

the above quoted features describe a specific process for obtaining patient information about the progress of subjective conditions such as pain, and generating a graphical display that shows historic progress for that subjective condition. The specification takes pains to show that the disclosed embodiments provide the numerous benefits stated at [0234]-[0235].

*Id.* at 20.

We disagree with Appellants. The question is whether the claims as a whole “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). In this case, claim 1 as a whole is focused on satisfying certain contingencies for managing the progress of subjective conditions such as, pain, fatigue, wellness, etc. (Specification. ¶ 129) – which is an effect and not an improvement in relevant technology, e.g., chip architecture, etc. Insofar as Appellants maintain that “generating a graphical display that shows historical progress for that subjective condition,” create eligibility in the claims before us, we decline to accept this argument because we find such a step to be a mere extra solution activity not meriting patent eligibility. We thus find that the extent of computerization display required by the claim is limited to insignificant extra solution activity not covered under 35 U.S.C. §

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35 U.S.C. § 101. *See, In re Schrader*, 22 F.3d 290, 294 (Fed. Cir. 1994) (recording step of the claimed process is incapable of imparting patent-eligibility under 35 U.S.C. § 101).

Appellants argue,

The “additional limitations” in the present claims qualify as “significantly more” at least because the “additional elements” add “a specific limitation other than what is well-understood, routine and conventional in the field, or adding unconventional steps that confine the claim to a particular useful application,” including all those stated above in prior sections.

(Appeal Br. 23).

The Federal Circuit recently explained, “[w]hether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination.” *Berkheimer*, 881 F.3d at 1369. We understand the Examiner, through citation to the July 2015 Update (Answer 5), to rely on prior court decisions finding that certain computer functions are well-understood, routine, and conventional functions. *See id.* at 2, 6. These prior court decisions adequately support this finding to satisfy the requirement to set forth a prima facie case of unpatentability under 35 U.S.C. § 101.

The question in step two of the Alice framework is not whether an additional feature is novel but whether the implementation of the abstract idea involves “more than the performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content*

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*Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass'n*, 776 F.3d 1343, 1347–48 (quoting *Alice*, 134 S.Ct. at 2359). Based on the Examiner's findings and our own, we conclude that the claimed implementation does not rise to the level required to show unconventional function.

#### CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 1–42, and 47–48 under 35 U.S.C. § 101.

#### DECISION

The decision of the Examiner to reject claims 1–42, and 47–48 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED