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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID R. BACON

Appeal 2017-007610
Application 12/474,015¹
Technology Center 3600

Before HUBERT C. LORIN, DAVID M. KOHUT, and
BRADLEY B. BAYAT, Administrative Patent Judges.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

David R. Bacon (Appellant) seeks our review under 35 U.S.C. § 134(a) of the Final Rejection of claims 1–5, 8–14, 17–23, and 26–31. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

¹ The Appellant identifies 3M Innovative Properties Company as the real party in interest. App. Br. 3.

THE INVENTION

Claim 1, reproduced below with indentation added, is illustrative of the subject matter on appeal.

1. A computer-implemented method comprising:

receiving, by a processor of a computing device and from one or more electronic document databases, a plurality of uncoded electronic documents associated with a patient's encounter with a health care organization;

receiving, by the processor, a set of rules from a rules database, the set of rules defining, for given types of electronic documents, a plurality of terms of interest to a coder and relevant to medical coding;

generating, by the processor, subsets of the plurality of uncoded electronic documents by applying the set of rules to the plurality of electronic documents,

wherein each subset comprises a respective extract of the plurality of uncoded electronic documents comprising one or more terms of the plurality of terms defined by the rules as being of interest to the coder, and

wherein the subsets comprise a first portion of the plurality of uncoded electronic documents comprising at least some terms of the plurality of terms instead of a second portion of the plurality of electronic documents that does not comprise any terms of the plurality of terms, the one or more terms of the plurality of terms being received from a terms database that includes a relevance score for the one or more terms,

wherein the relevance score is indicative of the relevance of the respective one or more terms to the coder, and wherein generating the subsets by applying the set of rules comprises selecting subsets of the plurality of uncoded electronic documents that include terms with respective relevance scores indicative of greater relevance than terms of other subsets of the

second portion of the plurality of uncoded electronic documents; and

generating, by the processor and in a user interface, a display area that includes at least one subset of the subsets of the plurality of uncoded electronic documents to present the first portion of the electronic documents instead of the second portion of the electronic documents, the one or more terms of the plurality of terms defined by the rules as of interest to the coder being associated with visual indicia identifying the one or more terms within the at least one subset visible in the display area.

App. Br. 26–27 (Claims Appendix).

THE REJECTION

The following rejection is before us for review:

Claims 1–5, 8–14, 17–23, and 26–31 are rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

ISSUE

Did the Examiner err in rejecting claims 1–5, 8–14, 17–23, and 26–31 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter?

ANALYSIS

Although the Appellant ostensibly argued these claims under three separate headings entitled “GROUP 1,” “GROUP 2,” and “GROUP 3,” the Appellant’s arguments are the same for each group. *See* App. Br. 8–24. We select claim 1 as the representative claim for this group, and the remaining

claims 2–5, 8–14, 17–23, and 26–31 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

Alice Corp. v. CLS Bank International, 134 S. Ct. 2347 (2014), identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent-eligibility under 35 U.S.C. § 101.

According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

In that regard, the Examiner determined that the claims are directed to “presenting an interface to assist in the coding of medical documents according to a series of rules through the communication, storage, processing and display of data.” Final Act. 12. According to the Examiner, “these concepts relate to the handling of data through the communication, storage, processing and display of data” and are “not meaningfully different than those concepts found by the courts in *SmartGene*² and *CyberFone*³ to be abstract ideas.” Responding to Appellant’s arguments in the Answer, the Examiner characterized the claims as directed to the abstract idea of “generating subsets of uncoded documents by applying rules, wherein each subset comprises extracted terms of interest to a coder, the rules extracting terms for a subset of a relevance score greater than terms of another subset.” Ans. 9 (citing *Digitech Image Technologies, LLC v. Electronics for Imaging, Inc.*, 758 F.3d 1344 (Fed. Cir. 2014), *Electric Power Group, LLC v. Alstom*

² *SmartGene, Inc. v. Advanced Biological Laboratories, SA*, 555 Fed.Appx. 950 (Fed. Cir. 2014)

³ *Cyberfone Sys., LLC v. CNN Interactive Grp., Inc.*, 558 F. Appx 988 (Fed. Cir. 2014) (nonprecedential)

S.A., 830 F.3d 1350 (Fed. Cir. 2016), and *Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057 (Fed. Cir. 2011)).

The Appellant argues that “the Office has overly generalized the features of claim 1, which is improper as stated in *Enfish*” and that “leaving out features recited in the claim results in an overly generalized concept that is untethered from the claims.” App. Br. 10 (citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016)). The Appellant reproduces language of claim 1 and argues that “the actual claimed features of claim 1 are directed to concepts that are not abstract, but specific for providing a technical solution for a technical problem of automatically reducing the amount of medical documentation that a coder needs to review.” *Id.* at 11. According to Appellant, “the recited steps results in, for example, a medical documentation analysis and extraction system that generates subsets of electronic documents and displays only these subsets in a user interface to ‘allow[s] a coder to concentrate his or her time and effort on the most relevant portions of electronic documents.’” *Id.* at 13 (citing Spec. para. 4).

Before we can determine whether claim 1 is directed to an abstract idea, we must first resolve the question of what claim 1 is directed to. Is it directed to “presenting an interface to assist in the coding of medical documents” (Final Act. 12), “generating subsets of uncoded documents by applying rules” (Ans. 9), or is it directed to “automatically reducing the amount of medical documentation that a coder needs to review” (App. Br. 11)? This question implicates the “directed to” inquiry.

The “directed to” inquiry applies a stage-one filter to the claims, considered in light of the Specification, based on whether “their character as

a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015); *see also Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016); *Enfish*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (Inquiring into “the focus of the claimed advance over the prior art.”).

“In determining the eligibility of respondents’ claimed process for patent protection under § 101, their claims must be considered as a whole.” *Diamond v. Diehr*, 450 U.S. 175, 188 (1981). 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, we find that claim 1, as a whole, is focused on identifying and displaying relevant portions of electronic documents. We do not see that claim 1 is focused on an improvement to any technology such as an improved process for filtering data in a computer or an improved user interface.

Claim 1 recites four steps including “[a] receiving documents from a database,” “[b] receiving rules from a database, the rules defining terms of interest to a coder,” “[c] generating subsets of the documents by applying the rules,” and “[d] generating a display that includes the subset of documents.” Step [c] also includes three “wherein” clauses. The first “wherein” clause specifies that the composition of each subset includes terms of interest to the coder. The second “wherein” clause specifies that the subsets comprise a

first portion of the documents that comprises some terms of interest and a second portion that does not. The third “wherein” clause recites selecting subsets of documents based on respective relevance scores of terms in the documents.

“The ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)). The court in *Enfish* put the question as being “whether the focus of the claims is on [a] specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish*, 822 F.3d at 1335–36. The court found that the “plain focus of the claims” there was on “an improvement to computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity.” *Id.* at 1336.

In that regard, the Background section of the Specification discusses the problem, which is that

Many [medical] documents do not adhere to particular formatting. Some of the documents are hand written, or scanned. Medical coders review these documents and identify billable aspects of the patient encounter, and then associate these billable aspects with codes. This review process, which includes reading, navigating, and assessing documentation, is cumbersome, sometimes requiring up to 70% of a medical coder’s time.

Spec. 1, ll. 26–32. According to the Specification, the inventors solved the problem by providing

Systems and methods for creating one or more subsets of electronic documents associated with a patient's encounter with a healthcare organization. In various embodiments described herein, these subsets may contain information of particular relevance to a coders' job of sifting through the electronic documents and associating codes with billable aspects of the patient's encounter. In various embodiments, these subsets allow a coder to concentrate his or her time and effort on the most relevant portions of electronic documents, which may save the coder time, and thus the coder' employer money.

Id. at 1, l. 35 – 2, l. 9. In light of the Specification's description of the problem and solution, the advancement over the prior art by the claimed invention is in identifying and displaying relevant portions of medical documents.

Given the focus of claim 1 as a whole, in light of the Specification, is on data gathering activities⁴ in support of identifying and displaying relevant portions of medical documents, the claims are properly characterized as being “directed to” and identifying and displaying relevant portions of electronic documents. Identifying and displaying relevant portions of electronic documents is an abstract idea. *Cf. Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass'n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014), cert. denied, 136 S. Ct. 119 (2015) (holding that claims

⁴ *Cf. Elec. Power Grp., LLC*, 830 F.3d at 1353 (When “[t]he focus of the asserted claims” is “on collecting information, analyzing it, and displaying certain results of the collection and analysis,” the claims are directed to an abstract idea.)

reciting “1) collecting data, 2) recognizing certain data within the collected data set, and 3) storing that recognized data in a memory” were drawn to an abstract idea); *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369 (Fed. Cir. 2015)

(the claim relates to customizing information based on (1) information known about the user and (2) navigation data. [. . .] There is no dispute that newspaper inserts had often been tailored based on information known about the customer – for example, a newspaper might advertise based on the customer’s location. Providing this minimal tailoring – e.g., providing different newspaper inserts based upon the location of the individual – is an abstract idea.);

Affinity Labs of Tex., LLC v. Amazon.com, Inc., 838 F.3d 1266, 1271 (Fed. Cir. 2016) (“tailoring of content based on information about the user – such as where the user lives or what time of day the user views the content – is an abstract idea that is as old as providing different newspaper inserts for different neighborhoods”) (citing *Intellectual Ventures I*); *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1311–14 (Fed. Cir. 2016) (holding claims that called for receiving data, determining whether the received data matched certain characteristics, and outputting data based on the determining step were “directed to methods of screening emails and other data files for unwanted content” and that that was an abstract idea because filtering mail (and likewise filtering e-mail) according to known characteristics was a “long-prevalent practice.”).

The Appellant makes various statements on the theme that the claimed subject matter is rooted in computer technology rather than an abstract idea. App. Br. 13–16, 20. For example, the Appellant argues that “the claims are

necessarily rooted in existing technology related to the analysis of electronic documents, and provide an improvement to such processes such that a system reduces the medical documentation to subsets of medical documents such that [a] medical coder does not need to manually review all documents for the patient.” *Id.* at 15. But we do not see, and the Appellant does not adequately explain, how the claimed process improves a generic computer. To the extent the Appellant contends that a computer makes the medical coding process more efficient (*id.* 14), the inclusion of a generic computer *per se* for its routine or generic functions cannot alone turn what is an abstract idea into one that is not. *See, e.g., OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (“[R]elying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.”); *W. View Research, LLC v. Audi AG*, 685 F. App’x 923, 926 (Fed. Cir. 2017) (non-precedential) (“These claims do not go beyond receiving or collecting data queries, analyzing the data query, retrieving and processing the information constituting a response to the initial data query, and generating a visual or audio response to the initial data query.”); *Glasswall Solutions Ltd. v. Clearswift Ltd.*, No. 2018-1407, slip op. at 3 (Fed. Cir. Dec. 20, 2018) (non-precedential) (“comparing [a] file’s content to a set of rules [and] extracting conforming data [are] generic computer functions.”).

The features argued by the Appellant simply narrow the abstract idea to particular information. Identifying information in “uncoded electronic documents associated with a patient’s encounter with a health care organization” in particular, and displaying the identified information in “a

display area,” with “visual indicia identifying the one or more terms within the at least one subset visible in the display area” further limit the type of information displayed, but only as to content. They do not, however, render the abstract idea any less abstract. *Cf. SAP America, Inc. v. Investpic, LLC*, 898 F.3d 1161, 1167 (Fed. Cir. 2018) (“Contrary to InvestPic’s suggestion, it does not matter to this conclusion whether the information here is information about real investments. As many cases make clear, 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.”) (quoting *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016)) (citing cases).

We cannot agree with the Appellant’s contention that the claims before us are similar to the claims held eligible in *McRO*, 837 F.3d 1299. *See* App. Br. 16–19; Reply Br. 5–7. The claims in *McRO* were directed to an improvement to computer technology – namely, the display of “lip synchronization and facial expressions” of animated characters. *Id.* at 1313. The claimed improvement was to how the computer operated to produce better quality synchronized images. Here, the claimed improvement relates to analyzing and filtering information in support of identifying and displaying relevant portions of electronic documents, and not any improved way of synchronizing or displaying images. For example, the Specification describes the claimed “visual indicia” as follows:

The visual indicia associated with the terminology species may be associated with the typeset (for example, different fonts, different levels of bolding, underlying, italicizing, and so forth). Also, specific terms may be highlighted or outlined with a colored box, the box in one embodiment defining an area that

may be selected by coder 10 via a pointing device such as a mouse.

Spec. 10, l. 33 – 11, l. 5. The Appellant cannot reasonably argue that applying italics or highlighting to certain terms in a document amounts to an improvement to computer technology. *Cf. Move, Inc. v. Real Estate All. Ltd.*, 721 F. App'x 950, 954 (Fed. Cir. 2018) (non-precedential) (“we agree with the district court that claim 1 of the '989 patent is directed to the abstract idea of ‘a method for collecting and organizing information about available real estate properties and displaying this information on a digital map that can be manipulated by the user.’”).

We find that the claims here are similar to the claims in *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332 (Fed. Cir. 2017), where the claims recited systems and methods for preserving compatibility between XML documents after they had been edited by different users. *Id.* at 1339–40. According to the claims at issue in that case, a “dynamic document” containing data extracted from the original XML document would be created, users could edit the data displayed in the dynamic document, and the changes would then be “dynamically propagated” back into the original XML document. *Id.* at 1339. The Federal Circuit concluded that the claims were, “at their core, directed to the abstract idea of collecting, displaying, and manipulating data.” *Id.* at 1341.

The Appellant next argues that “claim 1 clearly does not seek to tie up any judicial exception such that others cannot practice it.” App. Br. 18.

It is true that the Supreme Court has characterized pre-emption as a driving concern for patent eligibility. *See Alice*, 134 S. Ct. at 2354. But

characterizing pre-emption as a driving concern for patent eligibility is not the same as characterizing pre-emption as the sole test for patent eligibility. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice Corp.*, 134 S. Ct. at 2354). However, “[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Id.* at 1379. *Cf. OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (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.”). “What matters is whether a claim threatens to subsume the full scope of a fundamental concept, and when those concerns arise, we must look for meaningful limitations that prevent the claim as a whole from covering the concept’s every practical application.” *CLS Bank Int’l. v. Alice Corp.*, 717 F.3d 1269, 1281 (Fed. Cir. 2013) (Lourie, J., concurring). Here, we find the claimed subject matter covers patent-ineligible subject matter. Accordingly, the pre-emption concern is necessarily addressed. “Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, [] preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics*, 788 F.3d at 1379.

In view of the above, we see no error in the Examiner’s determination that claim 1 is directed to an abstract idea. We now turn to step two.

Step two of the *Alice/Mayo* framework is “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*, 134 S. Ct. at 2355 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 73 (2012)).

In that regard, the Examiner determined that:

The independent claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional elements when considered both individually and as an ordered combination do not amount to significantly more than the abstract idea. The independent claims recite the additional limitations of a computer and related components (“computer”, “computing device”, “processor”, “memory”, “microprocessor”), as well as other conventional functionality that may be composed of hardware (“database”, “user interface”, “computer readable medium”) that merely make generic determinations based on available data, store, communicate and display data. The additional limitations are recited at a high level of generality and are recited as performing generic computer functions routinely used in computer applications, such as receiving, generating, applying, associating and displaying data. Applicant’s [S]pecification discloses the following material, at the corresponding paragraphs, to be composed of conventional hardware: processor (24), computing device (24), database (24), user interface (22), computer readable medium (24), computer (24), memory (24), system (24) and microprocessor (24).

Generic computer components recited as performing generic computer functions that are well-understood, routine and conventional activities amount to no more than implementing the abstract idea with a computerized system. The use of generic computer components to make generic determinations based on available data, store, communicate and

display data does not impose any meaningful limit on the computer implementation of the abstract idea. Thus, taken alone, the additional elements do not amount to significantly more than the above-identified judicial exception (the abstract idea). Looking at the limitations as an ordered combination adds nothing that is not already present when looking at the elements taken individually. There is no indication that the combination of the elements improves the functioning of a computer or improves any other technology. Their collective functions merely provide conventional computer implementation.

Final Act. 13–14.

The Appellant argues that claim 1 requires “significantly more” than an abstract idea. App. Br. 19–22. According to the Appellant, “the claimed features provide an improvement to the technical field of medical information management and provides a technical improvement that includes automatically reducing the amount of medical documents that a medical coder needs to review.” *Id.* at 20 (citing *Bascom Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)); *see also*, Reply Br. 7–10.

We do not see how, and the Appellant does not persuasively explain how, the claims before us are similar to the claims in *Bascom*. For example, the Appellant has not argued that the claims require the installation of a filtering engine “at a specific location, remote from the end-users, with customizable filtering features specific to each end user,” as was the case in *Bascom*. 827 F.3d at 1350.

Computer-based “filtering” operations *per se* have not been found sufficient to add significantly more. *See, e.g., Mortg. Grader, Inc. v. First*

Choice Loan Servs. Inc., 811 F.3d 1314, 1317, 1324 (Fed. Cir. 2016) (holding ineligible claims that required an interface that “provides functionality for the borrower to search the database to identify a set of loan packages for which the borrower qualifies” because “the claims ‘add’ only generic computer components such as an ‘interface,’ ‘network,’ and ‘database.’”); *LendingTree, LLC v. Zillow, Inc.*, 656 F. App’x 991, 993 (Fed. Cir. 2016) (non-precedential) (holding ineligible claims that required “a filter comprising the plurality of selection criteria of the database to select without manual intervention each one of said plurality of lending institutions associated with a match”); *Intellectual Ventures I LLC v. J. Crew Grp., Inc.*, No. 6:16-CV-196-JRG, 2016 WL 4591794, at *6 (E.D. Tex. Aug. 24, 2016), *aff’d sub nom Intellectual Ventures I LLC v. FTD Companies, Inc.*, 703 F. App’x 991 (Fed. Cir. 2017) (Mem) (“The computer components that adorn the preamble, such as a distributed network, an information processing system, and database storage, are inarguably generic.”). *See also I/P Engine, Inc. v. AOL Inc.*, 576 F. App’x 982, 994–95 (Fed. Cir. 2014) (non-precedential) (Mayer, H., concurring):

I/P Engine’s claimed invention, which describes a system which filters information for relevance to a user’s query using combined content and collaborative data [citations omitted], does not pass muster under section 101. The asserted claims do not meet subject matter eligibility requirements because they do not “improve the functioning of the computer itself” or “effect an improvement in any other technology or technical field.” *Alice*, 134 S.Ct. at 2359. To the contrary, the use of search engines was well-established and the clear advantages of combining content-based and collaborative filtering were widely recognized at the time of the claimed invention.

We also do not see how the claimed “user interface” amounts to significantly more than an instruction to apply the abstract idea using generic computer functionality as a tool. For example, as discussed *supra*, the claimed “visual indicia” encompass simply highlighting or italicizing terms displayed in a display area. *Cf. RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1324 (Fed. Cir. 2017) (claim reciting “selecting a facial feature image from the first area of the first display via a user interface” held to be patent ineligible).

The Appellant next argues that “claim 1 recites unconventional activity because no art of record discloses the features of claim 1, as indicated by the Examiner withdrawing the art based rejection of the claims.” App. Br. 21.

To the extent that the Appellant maintains that the elements of claim 1 necessarily amount to “significantly more” than the abstract idea, because the method of claim 1 is allegedly patentable over the prior art, the Appellant misapprehends the controlling precedent. Although the second step in the *Alice* framework is termed 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*, 573 U.S. at 217–18 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73). In other words, a novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent ineligible. *See Mayo*, 566 U.S. at 89–90 (rejecting the suggestion that Sections 102, 103, and 112 might perform the appropriate screening function

and noting that in *Mayo* such an approach “would make the ‘law of nature’ exception . . . a dead letter”); *see also Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016) (“[U]nder the *Mayo/Alice* framework, a claim directed to a newly discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the novelty of that discovery for the inventive concept necessary for patent eligibility”). “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). Indeed, “[t]he ‘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.” *Diamond v. Diehr*, 450 U.S. 175, 188–189 (1981).

We have considered all of the Appellant’s remaining arguments (including those made in the Reply Brief) and find them unpersuasive. Accordingly, because we are not persuaded as to error in the determinations that representative claim 1, and claims 2–5, 8–14, 17–23, and 26–31 that fall with claim 1, are directed to an abstract idea and do not present an “inventive concept,” we sustain the Examiner’s conclusion that they are directed to patent-ineligible subject matter for being judicially-excepted from 35 U.S.C. § 101. *Cf. LendingTree*, 656 F. App’x 991, 997 (“We have considered all of LendingTree’s remaining arguments and have found them unpersuasive. Accordingly, because the asserted claims of the patents in suit are directed to an abstract idea and do not present an “inventive concept,”

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we hold that they are directed to ineligible subject matter under 35 U.S.C. § 101.”).

DECISION

The decision of the Examiner to reject claims 1–5, 8–14, 17–23, and 26–31 under 35 U.S.C. § 101 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)(1)(iv).

AFFIRMED