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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ZIV GOME, ZIV OFEK, ROBERT WARTENFELD,
SHIRI BEN-TAL, and EYAL GREENBERG

Appeal 2017-007700
Application 13/766,988
Technology Center 3600

Before JAMES R. HUGHES, JOHN A. EVANS, and JASON M. REPKO,
Administrative Patent Judges.

EVANS, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants¹ seek our review under 35 U.S.C. § 134(a) from the Examiner's final rejection of Claims 1 and 21–39. App. Br. 3. Claims 2–20 are canceled. *Id.*

We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.²

¹ Appellants state the real party in interest is Allscripts Healthcare Solutions, Inc. App. Br. 3.

² Rather than reiterate the arguments of the Appellants and the Examiner, we refer to the Appeal Brief (filed November 7, 2016, "App. Br."), the Reply Brief (filed April 24, 2017, "Reply Br."), the Examiner's Answer (mailed March 22, 2017, "Ans."), the Final Office Action (mailed May 5, 2016,

STATEMENT OF THE CASE

The claims relate to a system and method for facilitating clinician-user navigation through a computerized medical information repository. *See* Abstract.

Related Appeals

Appellants state U.S. Patent Applications 12/840,806 and 13/208,417 each include disclosure related to disclosure of the present application and are currently on appeal. App. Br. 3. The appeal of Application 12/840,806 is designated as Appeal 2018-007831 and has been assigned to the present Panel.

Invention

Claims 1, 29, and 36 are independent. An understanding of the invention can be derived from a reading of Claim 1 which is reproduced below:

1. A method for facilitating clinician-user navigation through a computerized medical information repository including utilizing a clinically ontological hierarchy of clinical semantic elements, the method comprising:
 - a) displaying, to a clinician-user, a graphical user interface of a medical software program configured to display patient data, the graphical user interface including
 - i. a search text box configured to receive user input for a search, and
 - ii. a suggested question area configured to display one or more questions based on input in the search text box;

“Final Act.”), and the Specification (filed December 31, 2013, “Spec.”) for their respective details.

- b) receiving, from the clinician-user via one or more input devices associated with an electronic device, input corresponding to input of a search string into the search text box;
- c) automatically determining, and displaying in the suggested question area, one or more suggested questions associated with the input search string based on the input search string and a generated ontology of suggested data requests defined in terms of said ontological hierarchy of clinical semantic elements;
- d) receiving, from the clinician-user, input corresponding to selection of one of the suggested questions;
- e) automatically determining, based on the selected question, first information representing a default answer to the selected suggested question;
- f) displaying, in an answer panel of the graphical user interface, the first information representing the default answer to the selected suggested question;
- g) automatically determining, based on the selected first question, other information representing a plurality of other answers to the selected suggested question;
- h) displaying, in an alternative answer selection area of the graphical user interface, an indication of each of the plurality of other answers available for the selected suggested question;
- i) responsive to the clinician-user's navigation through the medical information repository, presenting suggested data requests to the clinician-user based on predefined rules defined over the ontology of suggested data requests by automatically determining, based on the selected first question, a plurality of related questions, and displaying, in a related question area of the graphical user interface, each of the plurality of related questions.

Rejection

Claims 1 and 21–39 stand rejected under 35 U.S.C. § 101 as directed to a judicial exception. Final Act. 2–8.

ANALYSIS

We have reviewed the rejections of Claims 1 and 21–39 in light of Appellants’ arguments that the Examiner erred. We have considered in this Decision only those arguments Appellants actually raised in the Brief. Any other arguments which Appellants could have made but chose not to make in the Brief are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). We are not persuaded that Appellants identify reversible error.

Upon consideration of the arguments presented in the Appeal Brief, we do not agree with Appellants that the claims are patentable under 35 U.S.C. § 101. With respect to the rejection under § 101, we adopt as our own the findings and reasons set forth in the rejection from which this appeal is taken and in the Examiner’s Answer, to the extent consistent with our analysis below. We provide the following explanation to highlight and address specific arguments and findings primarily for emphasis. We consider Appellants’ arguments as they are presented in the Appeal Brief, pages 10–20.

CLAIMS 1 AND 21–28: INELIGIBLE SUBJECT MATTER.

Appellants argue all claims as a group and designate Claim 1 as representative. App. Br. 10. Therefore, we decide the appeal of the § 101 rejection on the basis of representative Claim 1, and refer to the rejected claims collectively herein as “the claims.” *See* 37 C.F.R. § 41.37(c)(1)(iv); *In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986).

Preemption.

Appellants contend Claim 1 does not pose any risk of preempting, or monopolizing, any idea the Office may identify as abstract. *See* App. Br. 10–11; Reply Br. 2.

While preemption may denote patent ineligibility, its absence does not demonstrate patent eligibility. *See FairWarning, IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016). For claims covering a patent-ineligible concept, preemption concerns “are fully addressed and made moot” by an analysis under the *Mayo/Alice* framework. *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). We conduct such an analysis below.

Prima facie case.

Appellants argue “[t]he PTO bears the initial burden of establishing a prima facie case of patent-ineligible subject matter under 35 U.S.C. § 101.” App. Br. 11 (quoting *Ex parte Poisson*³). Appellants contend the Examiner failed to identify the particular abstract idea to which the claims are found directed. App. Br. 15.

The Examiner finds the claims are directed to the particular abstract idea of “comparing new and stored information and using rules to identify options.” Final Act. 3.

We find the Examiner has adequately made out a prima facie case. The Federal Circuit has explained repeatedly that “the 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

³ *Ex parte Poisson*, Appeal 2012-011084, slip op. at 5 (PTAB Feb. 27, 2015).

Appeal 2017-007700
Application 13/766,988

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.

Statutory Construction in View of International Agreements.

Appellants discuss that in 1994, a number of agreements were signed in Marrakesh, Morocco, pursuant to the Uruguay Round talks. App. Br. 16. According to Appellants, these agreements included an Agreement Establishing the World Trade Organization Appendix 1C of which was an Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). *Id.* Appellants maintain Congress approved these agreements in the Uruguay Round Agreements Act (HR 5110, 103rd Congress) and this Act was codified as, *inter alia*, 19 U.S.C. § 3511. *Id.* at 16–17.

Appellants contend the Supreme Court has held that “an act of congress ought never to be construed to violate the law of nations, if any other possible construction remains.” App. Br. 16 (quoting *Alexander Murray v. The Schooner Charming Betsy*, 6 U.S. 64 (1804)). Appellants argue, thus, if a statute is subject to two different interpretations, one of which would violate an international agreement the U.S. has entered into, and another which is consistent with the international agreement, the statute should be construed so as to be consistent with the international agreement. This has become known as the Charming Betsy canon of statutory construction.

According to Appellants, TRIPS requires that “patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application.” App. Br. 17 (quoting TRIPS § 5, Art. 27). Appellants argue TRIPS provides “the terms ‘inventive step’ and ‘capable of industrial application’ may be deemed by a Member to be synonymous with the terms ‘non-obvious’ and ‘useful’ respectively.” *Id.* at 17–18. Appellants argue 35 U.S.C. § 101 is currently interpreted to “contain an important implicit exception: Laws of nature, natural phenomenon, and abstract ideas are not patentable,” but that this exception violates the *Charming Betsy* canon. *Id.* at 18. Therefore, according to Appellants, because the Examiner finds that the claims “distinguish[] over the prior art,” the claims should be subject matter eligible. App. Br. 18 (internal citation omitted).

Appellants’ invocation of the Trade–Related Aspects of Intellectual Property agreement (“TRIPs”) is unavailing. TRIPs is not self-executing as 19 U.S.C. § 3512(a)(1) specifically provides that “[n]o provision of any of the Uruguay Round Agreements [including TRIPs], nor the application of any such provision to any person or circumstance, that is inconsistent with any law of the United States shall have effect.” 19 U.S.C. § 3512(a)(1) (2000). Congress has also specifically precluded any person other than the United States from using TRIPS as a cause of action or a defense, and from challenging government action on the ground that such action is inconsistent with TRIPs. 19 U.S.C. § 3512(c)(1) (2000). *See In re Rath*, 402 F.3d 1207, 1210 n.2 (Fed. Cir. 2005) (citing 19 U.S.C. § 3512(c)(1)).

In any event, we decline to reach the Constitutional question posed by Appellants. “It is well settled that administrative agencies are without

Appeal 2017-007700
Application 13/766,988

authority to determine the constitutionality of statutes.” *Elgin v. Dept. of Treasury*, 567 U.S. 1, 16 (2012) (internal quotation marks and citation omitted). The Supreme Court has also stated that ““adjudication of the constitutionality of congressional enactments has generally been thought beyond the jurisdiction of administrative agencies.”” *Id.* (quoting *Thunder Basin Coal Co. v. Reich*, 510 U.S. 200, 215 (1994)).

Patent Owner’s arguments, with respect to Constitutional questions, are noted and they are preserved for appeal.

Mayo-Alice Step 1.

The Supreme Court has instructed us to use a two-step framework to “distinguish[] 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. At the first step, we determine whether the claims at issue are “directed to” a patent-ineligible concept. *Id.*

The Examiner finds the claims are directed to the particular abstract idea of “comparing new and stored information and using rules to identify options.” Final Act. 3; Ans. 2 (citing generally *Electric Power Group*).⁴

Appellants do not traverse the Examiner’s finding as to which abstract idea the claims are directed. Rather, Appellants argue:

Thus, although a patent examiner can certainly look at a claim and note that it can in theory be characterized as being directed to an incredibly broad abstract idea, the Mayo/Alice test requires him or her to continue looking at the claim and determine whether the claim includes additional features to ensure that the claim is more than a drafting effort designed to monopolize that abstract idea.

⁴ *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (2016).

Appeal 2017-007700
Application 13/766,988
App. Br. 12; Reply Br. 2.

We address Appellants’ monopolization concerns in the section entitled *Preemption, supra*. We find Appellants’ contention that the claims include “additional features” to sound in Step 2 of the *Mayo/Alice* analysis which we conduct below.

Mayo-Alice Step 2.

Where, as here, the claims are found to be “directed to” a patent-ineligible concept, we then “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.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79, 78). This analysis has been characterized as the search for an “‘inventive concept’”— something sufficient to ensure that the claim amounts to “‘. . . significantly more . . .’” than the abstract idea itself. *Id.* (quoting *Mayo*, 566 U.S. at 72–73).

Appellants quote *BASCOM*⁵ for the proposition that: “[t]he inventive concept inquiry requires more than recognizing that each claim element by itself was known in the art.” App. Br. 13 (quoting *BASCOM*, 827 F.3d at 1350). Appellants note, the court made clear that “an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.” *Id.*

We find Claim 1 recites a generic database, “a computerized medical information repository” and a generic graphical user interface, “an answer

⁵ *BASCOM Global Internet Serv., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (2016).

Appeal 2017-007700
Application 13/766,988

panel of the graphical user interface,” which are not inventive, nor do Appellants so claim. *See BASCOM*, 827 F.3d at 1349 (“the limitations of the claims, taken individually, recite generic computer, network and Internet components, none of which is inventive by itself. *BASCOM* does not assert that it invented local computers, ISP servers, networks, network accounts, or filtering. Nor does the specification describe those elements as inventive”). Similarly, Appellants’ Specification discloses only generic components: “[a]ny suitable processor, display and input means may be used to process, display e.g. on a computer screen or other computer output device, store, and accept information such as information used by or generated by any of the methods and apparatus shown and described herein.” Spec. 10, ll. 19–22.

The individual components of the claimed invention are generic. However, “[t]he inventive concept inquiry requires more than recognizing that each claim element, by itself, was known in the art. As is the case here, an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.” *BASCOM*, 827 F.3d at 1350. Appellants, none-the-less, do not argue how the generic components of their invention may be arranged in a “non-conventional and non-generic” manner. Rather, Appellants note the Examiner finds the claims “distinguish over the prior art.” App. Br. 14 (internal quotation marks, citation, and bracketed alteration omitted). We disagree with Appellants.

Eligibility and novelty are separate inquiries. *Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1340 (2017). “The search for a § 101 inventive concept is . . . distinct from demonstrating § 102 novelty.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016). “Groundbreaking, innovative, or even brilliant discovery

Appeal 2017-007700
Application 13/766,988

does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2117 (2013).

We are not persuaded the Examiner errs in rejecting Claims 1 and 21–28.

CLAIMS 29–35: INELIGIBLE SUBJECT MATTER.

Appellants argue all claims as a group and designate Claim 29 as representative. App. Br. 19. Therefore, we decide the appeal of the § 101 rejection on the basis of representative Claim 29, and refer to the rejected claims collectively herein as “the claims.” *See* 37 C.F.R. § 41.37(c)(1)(iv); *King*, 801 F.2d at 1325.

Appellants contend:

In the Office Action, claim 29 was rejected based in large part on the same reasoning applied to claim 1. Accordingly, . . . [Appellants] respectfully submit[] that this reasoning is flawed, and the Office Action has failed to make out a *prima facie* showing of patent-ineligible subject matter, for the same or similar reasons as noted above with respect to claim 1.

App. Br. 20.

For the reasons discussed above, we are not persuaded the Examiner errs in rejecting Claims 29–35.

CLAIMS 36–39: INELIGIBLE SUBJECT MATTER.

Appellants argue all claims as a group and designate Claim 36 as representative. App. Br. 19. Therefore, we decide the appeal of the § 101 rejection on the basis of representative Claim 36, and refer to the rejected claims collectively herein as “the claims.” *See* 37 C.F.R. § 41.37(c)(1)(iv); *King*, 801 F.2d at 1325.

Appeal 2017-007700
Application 13/766,988

Appellants contend:

In the Office Action, claim 36 was rejected based in large part on the same reasoning applied to claim 1. Accordingly, . . . [Appellants] respectfully submit[] that this reasoning is flawed, and the Office Action has failed to make out a *prima facie* showing of patent-ineligible subject matter, for the same or similar reasons as noted above with respect to claim 1.

App. Br. 20.

For the reasons discussed above, we are not persuaded the Examiner errs in rejecting Claims 36–39.

DECISION

The rejection of Claims 1 and 21–39 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED