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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/545,512	07/10/2012	Maury Zivitz	ROCHE-P0004-01 23175 US2	1055
63049	7590	06/25/2018	EXAMINER	
FAEGRE BAKER DANIELS LLP / ROCHE 300 NORTH MERIDIAN STREET SUITE 2700 INDIANAPOLIS, IN 46204			RIGGS II, LARRY D	
			ART UNIT	PAPER NUMBER
			1631	
			NOTIFICATION DATE	DELIVERY MODE
			06/25/2018	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MAURY ZIVITZ and LOIS JOVANOVIC

Appeal 2017-008453
Application 13/545,512¹
Technology Center 1600

Before DONALD E. ADAMS, JOHN G. NEW, and
JOHN E. SCHNEIDER, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This Appeal under 35 U.S.C. § 134(a) involves claims 1–19 (App. Br. 5). Examiner entered a rejection under 35 U.S.C. § 101. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellants identify “Roche Diagnostics Operations, Inc.” as the real party in interest (App. Br. 3).

STATEMENT OF THE CASE

Appellants' disclosure "relates to a device and method that provides insulin dosage alterations for various conditions" (Spec. ¶ 2). Appellants' claim 1 is representative and reproduced below:

1. A device for providing improved drug dosing advice to a patient, the device being a portable, handheld and battery powered device and the device comprising:
 - an evaluation and interpretation facility comprising a processor for executing a program,
 - a memory for storing a program to be executed by the processor and for storing and retrieving data used by the program,
 - a display for displaying data and instructions to the user, a human interface for entering data, and instructions stored on the memory as part of the program such that when the program is executed by the processor causes the evaluation and interpretation facility to:
 - determine a first expected dose of the drug;
 - determine a first actually administered dose of the drug,
 - determine whether the first actually administered dose differs from a first expected dose of the drug,
 - determine a second expected dose of the drug;
 - determine a second actually administered dose of the drug,
 - determine whether the second actually administered dose differs from a second expected dose, and
 - calculate a third expected dose on the basis of the first actually administered dose and the second actually administered dose when the first actually administered dose is determined to differ from the first expected dose and the second actually administered dose is determined to differ from the second expected dose.

Appellants' claims 1–19 stand rejected under 35 U.S.C. § 101.

ISSUE

Does the evidence of record support Examiner’s finding that Appellants’ claimed invention is directed to patent ineligible subject matter?

ANALYSIS

Examiner finds that Appellants’ claimed invention is directed to patent ineligible subject matter (*see* Ans. 2–5). We agree.

The scope of 35 U.S.C. § 101 “is subject to an implicit exception for ‘laws of nature, natural phenomena, and abstract ideas,’ which are not patentable.” *Intellectual Ventures I LLC v. Capital One Financial Corp.*, 850 F.3d 1332, 1338 (Fed. Cir. 2017), citing *Alice Corp. Pty. Ltd. v. CLS Bank Int’l.*, 134 S. Ct. 2347, 2355 (2014).

To determine whether the exception applies . . . a court must determine: (1) whether the claim is directed to a patent-ineligible concept, i.e., a law of nature, a natural phenomenon, or an abstract idea [(the “abstract idea” step)]; and if so, (2) whether the elements of the claim, considered “both individually and ‘as an ordered combination,’” add enough to “‘transform the nature of the claim’ into a patent-eligible application [(the ‘inventive concept’ step)].”

(*Intellectual Ventures*, 850 F.3d at 1338, citing *Alice Corp.*, 134 S. Ct. at 2355).

Applying the first step outlined above, Examiner finds that Appellants’ claims are directed to an abstract idea, specifically the mathematical relationships set forth in Appellants’ claims as determining and calculating steps (*see* Ans. 3 and 6). We agree. “[A]n invention directed to collection, manipulation, and display of data [is] an abstract process.” *Intellectual Ventures*, 850 F.3d at 1340; *see generally id.* at 1340–41; *see also CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011) (“The mere manipulation or reorganization of

data . . . does not satisfy the transformation prong”). Thus, collecting information regarding first, second, etc. expected dosages of a drug, when those dosages were administered, manipulating this information to determine whether each dosage was administered when expected and when an additional dose should be administered is an abstract process (*see* Ans. 3–4). Therefore, we find no error in Examiner’s finding that Appellants’ claimed invention is directed to a patent-ineligible concept, specifically an abstract idea (*see* Ans. 2–4).

Without additional limitations, a process that employs mathematical algorithms to manipulate existing information to generate additional information is not patent eligible. “If a claim is directed essentially to a method of calculating, using a mathematical formula, even if the solution is for a specific purpose, the claimed method is nonstatutory.” *Parker v. Flook*, 437 U.S. 584, 595[] (1978) (internal quotations omitted).

Digitech Image Techs., LLC v. Elecs. for Imaging, Inc., 758 F.3d 1344, 1351 (Fed. Cir. 2014); *see also Fair Warning IP, LLC v. Iatric Systems, Inc.*, 839 F.3d 1089, 1093 (Fed. Cir. 2016) (“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”).

Turning to the second, inventive concept, step, Examiner finds that the remaining elements in Appellants’ “claims encompass a general purpose device that recites generic limitations of a processor, memory, display and human interface encompassed on any general purpose [computer]” (Ans. 7). “[M]ere recitation of a generic computer[, however,] cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 134 S. Ct. at 2358; *see also Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S.Ct. 1289, 1301 (2012) (“[S]imply implementing a

mathematical principle on a physical machine, namely a computer, [is] not a patentable application of that principle”). We also agree with Examiner’s finding that the steps of Appellants’ method “do not purport to improve the functioning of [a] computer itself” or “improve[] computer technology” (*see* Ans. 3–4). Thus, as Examiner explains, “[t]he hardware recited by [Appellants’] . . . claims do not offer a meaningful imitation beyond generally linking ‘the use of the method to a particular technological environment,’ that is, implementing via computers’ (Ans. 4). *See Alice*, 134 S. Ct. at 2360.

We recognize Appellants’ contention that Examiner’s rejection is at “odds with the holding of” *Cal. Inst. of Tech. v. Hughes Communs., Inc.*, 59 F. Supp. 3d 974 (CACD 2014) and assertion that Appellants’ claimed “consideration of [doses] is not performed to describe preexisting relationships, but rather creates relationships that generate meaningful information to impact future recommended doses” (Br. 13–14). We are not persuaded. Notwithstanding Appellants’ contentions to the contrary, the *Cal. Inst.* Court found patent eligibility after performing the two-step approach set forth in *Alice* and found that the claims, although directed to abstract ideas, were patent-eligible because they contained additional limitations that provided an inventive concept, i.e., they met the requirements of *Alice*’s second step. *See Cal. Inst.*, 59 F. Supp. 3d at 993–94. In contrast to *Cal. Inst.*, the claims on this record fail to meet the requirements of *Alice*’s second step, for the reasons set forth above, and, therefore, do not amount to significantly more than the abstract idea itself.

Notwithstanding Appellants’ contention to the contrary, Examiner provided reasons for rejecting every claim on Appeal (*see* Ans. 2–5; *cf.* Br.

15 (“no discussion of the dependent claims is provided with respect to the rejection under §[101]”). In addition, although Appellants separately identify the limitations of each rejected claim (*see* Br. 15–18), Appellants fail to provide separate arguments for each claim or separately address Examiner’s rejection as it applies to each claim on Appeal. *Cf. In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[T]he Board [has] reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”) Accordingly, the claims stand or fall together.

CONCLUSION

The evidence of record supports Examiner’s finding that Appellants’ claimed invention is directed to patent ineligible subject matter. The rejection of claim 1 under 35 U.S.C. § 101 is affirmed. Claims 2–19 are not separately argued and fall with claim 1.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this Appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED