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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KEVIN C. DREW and DANA S. LEWIS

Appeal 2017-009213
Application 13/629,426¹
Technology Center 3600

Before ST. JOHN COURTENAY III, JASON J. CHUNG, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

McNEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–14, which are all the claims pending in this application. Claims 15–30 are withdrawn. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellants, the real party in interest is the Applicant, Physio-Control, Inc. App. Br. 3.

STATEMENT OF THE CASE

Introduction

Appellants' application relates to sending software application upgrades to medical devices over a network. Spec. 3:1–30. Claim 1 illustrates the appealed subject matter and reads as follows:

1. A computer, comprising:
 - a first communication port for establishing a first connection with a medical device;
 - a second communication port for establishing a second connection with a network;
 - an agent configured to query a collection of device records within the network to determine whether a device record specific to the medical device exists; and
 - a processor configured to receive over the second connection a message from the network responsive to the query, the message including an upgrade link specific to a device type corresponding to the device, and the processor also configured to send to the medical device over the first connection an upgrade of a software application on the medical device responsive to a user selecting the upgrade link, the software application structured to cause the device to operate.

The Examiner's Rejections

Claims 1–14 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Ans. 9–12.

Claims 1–14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Price (US 2006/0026304 A1; Feb. 2, 2006) and Medema (US 2003/0025602 A1; Feb. 6, 2003). Final Act. 3–11.

ANALYSIS

Patent-Ineligible Subject Matter

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (citation omitted).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk . . .”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India

rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 187; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (citation omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (alterations in original) (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of § 101. USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Revised Guidance”). Under that guidance, we first look to whether the claim recites:

(1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and

(2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

(3) adds a specific limitation beyond the judicial exception that are not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or

(4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See Revised Guidance.

Revised Guidance Step 1

Step 1 of the Revised Guidance asks whether the claimed subject matter falls within the four statutory categories of patentable subject matter identified by 35 U.S.C. § 101: process, machine, manufacture, or composition of matter. Claim 1 recites a “computer.” Appellants do not argue the Examiner erred in concluding claim 1 falls within the four

statutory categories of patentable subject matter. We agree with the Examiner's conclusion because claim 1 falls within the machine category.

Revised Guidance Step 2A, Prong 1

Under Step 2A, Prong 1 of the Revised Guidance, we determine whether the claims recite any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes). *See* Revised Guidance.

Claim 1 recites the following limitations: (1) “a first communication port for establishing a first connection with a medical device,” (2) “a second communication port for establishing a second connection with a network,” (3) “an agent configured to query a collection of device records within the network to determine whether a device record specific to the medical device exists;” (4) “a processor configured to receive over the second connection a message from the network responsive to the query, the message including an upgrade link specific to a device type corresponding to the device;” and (5) “the processor also configured to send to the medical device over the first connection an upgrade of a software application on the medical device responsive to a user selecting the upgrade link, the software application structured to cause the device to operate.”

The Examiner concludes claim 1 is directed to the abstract idea of “querying and distributing message(s).” Ans. 9. The Examiner further concludes claim 1 is directed to the concept of “receiving, screening and distributing data/messages” and that this concept falls within “certain methods of organizing human activity.” *Id.* at 9–10 (citing *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307 (Fed. Cir. 2016)).

Appellants argue the Examiner erred in concluding claim 1 is directed to an abstract idea. *See* Reply Br. 4–6. In particular, Appellants argue the Examiner oversimplifies claim 1, mischaracterizing the claim as a method claim. *Id.* at 4.

We agree with Appellants because claim 1 does not recite an abstract idea under the Revised Guidance. The Examiner concludes claim 1 is directed to an abstract idea because it is directed to “certain methods of organizing human activity.” Ans. 9. Under the Revised Guidance, abstract ideas include “certain methods of organizing human activity.” Revised Guidance, 84 Fed. Reg. at 52. These “certain methods of human activity” include:

fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions).

Id.

The Examiner concludes claim 1 is directed to “querying and distributing message(s)” and “receiving, screening and distributing data/messages.” Ans. 10. We agree with the Examiner’s characterization of the claims because the limitations discussed above, under their broadest reasonable interpretation, characterize sending messages to medical devices, where those messages include upgrade links, a particular type of data. However, we disagree with the Examiner’s conclusion that the claims are directed to an abstract idea because these concepts do not fit within the “certain methods of organizing human activity,” or any of the other

categories, identified in the Revised Guidance. Accordingly, we agree with Appellants that the Examiner erred in concluding claim 1 is directed to an abstract idea. Because claim 1 does not fit within any of the categories of abstract idea identified in the Revised Guidance, we need not proceed to Step 2A, prong 2 of the analysis.

Obviousness

Appellants argue the Examiner erred in rejecting claim 1 as unpatentable over Price and Medema because Price does not teach or suggest “an agent configured to query a collection of device records within the network to determine whether a device record specific to the medical device exists.” App. Br. 5. In particular, Appellants argue the Examiner’s rejection does not address the notion of querying device records within a network, and Price does not teach or suggest this limitation. *Id.*

Appellants have not persuaded us of Examiner error. The Examiner finds, and we agree, Price teaches a coordinating computer (the claimed “agent”) that performs continuous or non-continuous surveillance of primary and secondary software entities or services (“querying” of the “device records”) to determine whether a software upgrade is required. Ans. 12 (citing Price ¶¶ 43–44). Appellants have not identified persuasively error in the Examiner’s findings and reasoning, instead offering conclusory assertion of error. *See* App. Br. 5.

Appellants also argue the Examiner erred in rejecting claim 1 as unpatentable over Price and Medema because Prices does not teach or suggest “a processor configured to receive over the second connection a message from the network responsive to the query, the message including an upgrade link specific to a device type corresponding to the device,” and “the

processor also configured to send to the medical device over the first connection an upgrade of a software application on the medical device responsive to a user selecting the upgrade link, the software application structured to cause the device to operate,” as recited in claim 1. *See App. Br. 6–7* (emphasis omitted). In particular, Appellants argue Price merely describes a software update is delivered from the coordinating computer to the software-controlled devices for updating. *Id.* at 7 (citing Price Fig. 3, ¶ 44). According to Appellants, Price does not teach or suggest an upgrade link or message including an upgrade link from a network responsive to a query. *Id.* at 7.

Appellants have not persuaded us of Examiner error. The Examiner finds, and we agree, Price teaches a user is notified regarding the need for a software update. Ans. 14 (citing Price ¶ 30). The notification may be via email, instant message, or on-screen pop-up. *Id.* The coordinating computer may provide software updates via the Internet using HTTP. Price ¶ 43. Thus, Price at least suggests providing an “upgrade link” as claimed by providing software updates via the Internet using HTTP. *See id.* Appellants have not persuasively identified error in the Examiner’s findings and reasoning, instead offering conclusory assertion of error. *See App. Br. 6–8.* Accordingly, Appellants have not persuaded us of Examiner error.

For these reasons, we sustain the Examiner’s rejection of claim 1 as unpatentable over Price and Medema. We also sustain the Examiner’s obviousness rejection of dependent claims 2–14, for which Appellants offer no separate argument. *See App. Br. 6–8.*

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DECISION

Because we have sustained at least one ground of rejection with respect to each claim on appeal, we affirm the decision of the Examiner rejecting claims 1–14. *See* 37 C.F.R. § 41.50(a)(1).

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED