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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* ROBERT E. VANN JR.

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Appeal 2017-009754  
Application 13/478,594  
Technology Center 3700

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Before MICHAEL L. HOELTER, MICHELLE R. OSINSKI, and  
LISA M. GUIJT, *Administrative Patent Judges*.

GUIJT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's rejection<sup>2</sup> of claims 1–13, 15, 19, and 20 under 35 U.S.C. § 101. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Claims 1 and 12 are the independent claims on appeal. Claim 1, reproduced below, is exemplary of the subject matter on appeal.

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<sup>1</sup> Appellant identifies the real party in interest as MedProdigy, Inc. Br. 5.

<sup>2</sup> Appeal is taken from the Final Office Action dated Aug. 12, 2015.

1. A non-transitory computer readable storage medium with an executable program stored thereon for providing access to medical treatment information via an electronic resource wherein the program instructs a processor to perform the following steps:
  - compile medical reference material accessible via the electronic resource, wherein said medical reference material comprises information related to all of the following: diagnoses, treatment options, common complications, patient education, and lectures;
  - compile supplier solution material accessible via the electronic resource, wherein said supplier solution material comprises information related to all of the following: pharmaceutical products, medical equipment, medical devices, and reference articles;
  - compile a patient version of the medical reference material accessible via the electronic resource, wherein the patient version of the medical reference material comprises information related to all of the following: a patient version of treatment options and a patient version of lectures;
  - provide a medical reference mode, a continuing education mode, and a compliance mode;
  - provide options to a user to view medical treatment information in any and all of said medical reference mode, continuing education mode, and compliance mode;
  - receive information indicative of a selection from the user to view medical treatment information in one of said medical reference mode, continuing education mode, and compliance mode;
  - display both the medical reference material and the supplier solution material upon receipt of the user's selection to view medical treatment information in the medical reference mode;
  - display, in the medical reference mode, portions of the medical reference material according to a particular medical issue being focused on by the user;
  - display, in the medical reference mode, portions of the supplier solution material that are directly relevant to the particular medical issue being focused on by the user and the portions of the medical reference material being displayed;

list, in the medical reference mode, supplier solutions from the supplier solutions material in a linkable display format;

display only the medical reference material and do not display the supplier solution material upon receipt of the user's selection to view medical treatment information in the continuing education mode such that only a portion of information displayed in the medical reference mode is displayed in the continuing education mode;

display only the patient version of the treatment options and the patient version of the lectures upon receipt of the user's selection to view the medical treatment information in the compliance mode.

#### ANALYSIS

Appellant argues claims 1–13, 15, 19, and 20 as a group. We select claim 1 as representative, with claims 2–13, 15, 19, and 20 standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Supreme Court has set forth a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under 35 U.S.C. § 101. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012)). Accordingly, we must first “determine whether the claims at issue are directed to one of those patent-ineligible concepts”—i.e., a law of nature, a natural phenomenon, or an abstract idea. *Id.* If so, we secondly “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.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1298, 1297). The Supreme Court has described the second part of the 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.’” *Id.* (alteration in original) (quoting *Mayo*, 132 S. Ct. at 1294).

Applying the first step of the *Alice/Mayo* framework—and notwithstanding that claim 1 recites statutory subject matter (i.e., an apparatus (*see* Ans. 2)), the Examiner determines that claim 1 is judicially-excepted from patent eligibility under 35 U.S.C. § 101, because claim 1 is directed to an abstract idea, and specifically, an idea of itself: “collecting information, analyzing it, and . . . displaying certain results of the collection.” *Id.* at 3 (citing *Elec. Power Grp., LLC v. Alstrom S.A.*, 830 F.3d 1350, 1353, 1354 (Fed. Cir. 2016) (holding that “[c]ollecting information, including when limited to a particular content” is an abstract idea and also that “merely presenting the result of abstract processes of collecting information, without more . . . is abstract as an ancillary part of such collection and analysis”); *cf.* Final Act. 2 (wherein the Examiner determines that claim 1 is directed to “the abstract idea of a certain method of organizing the human activity of learning”). The Examiner determines that the claimed medical treatment information is “collected information which is analyzed and displayed according to the user’s mode selection (reference, continuing education or compliance mode).” Ans. 2.

Appellant argues that “[t]he Examiner has failed to provide a *prima facie* case that [the claims] are directed to a non-statutory subject matter.” Br. 20. In support, Appellant submits that “[t]he Examiner has not provided any objective evidence that the alleged abstract idea is fundamental [(i.e., directed towards fundamental building blocks or the basic tools of scientific or technological work)].” *Id.* at 21. Appellant further argues that

[t]he Examiner also failed to consider each claim element . . . [and] to explain: (1) which claim elements are considered abstract, (2) why these claim elements are considered abstract, and (3) why the additional elements or combinations of elements other than the abstract idea are believed to amount to “no more than: mere instructions to implement the idea on a computer.”

*Id.* at 20.

We determine that the Examiner has set forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of 35 U.S.C. § 132, and therefore, the Examiner has set forth a prima facie case of patent ineligibility. *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (The USPTO carries its procedural burden of establishing a prima facie case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.”). We are also not persuaded by Appellant’s argument that the Examiner must provide evidentiary support (i.e., that the abstract idea identified by the Examiner is fundamental), before a conclusion can be made that a claim is directed to an abstract idea. *See* USPTO’s June 25, 2014 “Preliminary Examination Instructions in view of the Supreme Court Decision in *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*”; *see also, e.g.*, para. IV “July 2015 Update: Subject Matter Eligibility” to 2014 Interim Guidance on 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 ultimate legal conclusion on eligibility without making any factual findings.” (Emphasis added) (Footnote omitted)). We address whether a claim element (or combination of elements) amounts to significantly more than a patent upon the ineligible concept itself *infra*, with respect to the second step of the *Alice/Mayo* framework.

Appellant also argues that, in *Alice Corp.*, “[the] use of the term ‘abstract idea’ refers to concepts that are long prevalent, fundamental, and essential to an area of science or commerce” and that “[a] claim is not patent ineligible merely because it is related to the field of organizing human activity.” Br. 21. However, Appellant’s argument fails to address the Examiner’s determination that claim 1 is directed to the abstract idea of collecting and analyzing data, as set forth *supra*, or put another way, that claim 1 is directed to *an abstract idea itself*.

Moreover, claim 1 is similar to claims directed to the collection, organization, and manipulation of data that our reviewing court has found to be directed to patent-ineligible abstract ideas. For example, in *Electric Power Group*, the court held that claims drawn to systems and methods for performing real-time performance monitoring of an electric power grid by collecting data from multiple data sources, analyzing the data, and displaying the results were directed to the abstract idea of “collecting information, analyzing it, and displaying certain results of the collection and analysis.” 830 F.3d at 1352, 1353. Similarly, in *Content Extraction & Transmission LLC v. Wells Fargo Bank, National Ass’n*, 776 F.3d 1343 (Fed. Cir. 2014), the court held that claims generally reciting “a method of 1) extracting data from hard copy documents using an automated digitizing unit such as a scanner, 2) recognizing specific information from the

extracted data, and 3) storing that information in a memory,” were drawn to an abstract idea. *Id.* at 1345, 1347.

Thus, we are not apprised of error in the Examiner’s determination that claim 1 is directed to the abstract idea of collecting and analyzing data (i.e., medical treatment information), and displaying the data according to user mode selections.

Applying the second step of the *Alice/Mayo* framework, the Examiner determines that the limitations of claim 1 “have routinely been performed pre-computer era” and “simply describe the compiling of medical data which was well known to have been performed using hand written media before the advent of computers.” Final Act. 3. The Examiner concludes that these additional elements do not amount to significantly more than the judicial exception “because the claim recites a generic computer and typical components of a generic computer, performing routine and conventional function of implementing instructions of an abstract idea on a computer.” *Id.* at 3–4. The Examiner does not consider “using a computer to compile medical information directed towards a ‘patient’ user . . . as an improvement to another technology or technical field.” *Id.* at 4.

Appellant argues that the “Examiner does not provide any rationale” for asserting that the claims do not include limitations that are significantly more than the abstract idea itself. Br. 22. Appellant submits that, to the contrary, “the claims do include meaningful limitations beyond generally linking the use of an abstract idea to a computer.” *Id.* at 22–23. In support, Appellant maintains that “[t]he claims are limited by a number of other factors, namely: the type of information gathered and the particular manipulation of the data.” *Id.* at 23.

We are not persuaded by Appellant’s argument. As set forth *supra*, the Examiner’s determination that the limitations of claim 1, considered individually and as an ordered combination, do not amount to significantly more than the abstract idea itself is based on the Examiner’s rationale that claim 1 involves generic computing components, such as a non-transitory computer readable storage medium and an electronic resource for compiling information. *See, e.g.*, Spec. ¶ 21 (computing devices 14 may include any device, component, or equipment with a processing element and associated memory); *see also, e.g.*, Spec. ¶¶ 20–26. Notably, “mere[] . . . generic computer implementation” of an abstract idea does not transform the abstract idea into patent-eligible subject matter. *Alice*, 134 S. Ct. at 2357. Moreover, as set forth *supra* with reference to *Electric Power Group*, limiting information to a particular content is insufficient to transform an abstract idea into a patent-eligible application of the idea. *See Electric Power Group*, 830 F.3d at 1353.

In further support, Appellant maintains that

[t]he *Diehr* example cited by the court in *Alice Corp.* demonstrates that the “significantly more” requirement need not require much more than input of data and performance of repeated calculation of that data by a computer to transform a patent ineligible abstract idea into a patent eligible application of the idea. The claims recite combinations of elements that far surpass the additional limitations of *Diehr* in terms of providing ‘significantly more’ than an abstract idea, when applied as in *Alice Corp.*

Br. 23. However, Appellant does not provide sufficient argument or evidence that claim 1 recites a combination of elements that far surpasses those additional limitations of *Diehr*. Our reviewing court instructs us that lawyer arguments and conclusory statements which are unsupported by

factual evidence are entitled to little probative value. *See In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (“Attorney’s argument in a brief cannot take the place of evidence.”); *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984). Moreover, the Court in *Diehr* explained that the claimed method requires “installing rubber in a press, closing the mold, constantly determining the temperature of the mold, constantly recalculating the appropriate cure time through the use of the formula and a digital computer, and automatically opening the press at the proper time.” *Diamond v. Diehr*, 450 U.S. 175, 187 (1981). The Court found that the respondents’ claims were not an attempt to patent an unpatentable principle (e.g., mathematical formula), but rather an industrial process “which, when considered as a whole, is performing a function which the patent laws were designed to protect” even though it implemented or applied a mathematical formula.” *Id.* at 192. In contrast, claim 1 appears to seek to patent an unpatentable principle (i.e., the abstract idea of the collection, organization, and manipulation of data), rather than an industrial process into which the unpatentable principle has been integrated.

Appellant further argues that “the claims do not seek to tie up the exception so that others cannot practice it,” but “[o]n the contrary, the claims include specific and meaningful limitations restricting them to specific applications rather than merely an abstract idea.” Br. 23 (specifically referring to the recitation of a computer program in claim 12). However, merely because claims do not preempt all forms of the abstraction does not make them any less abstract. *See 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.”). Moreover, characterizing preemption as a driving concern for patent eligibility is not the same as characterizing preemption as the dispositive test for patent eligibility. Instead, “[t]he 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*, 134 S. Ct. at 2354). Although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Id.* The Federal Circuit concluded that “[w]here 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.” *Id.*; *see also id.* (holding that “[i]n this case, Sequenom’s attempt to limit the breadth of the claims by showing alternative uses of cffDNA outside of the scope of the claims does not change the conclusion that the claims are directed to patent ineligible subject matter”). Given this direction from our reviewing court, we decline to apply a preemption standard in our analysis, and instead apply the steps set forth by the Supreme Court in *Alice* and *Mayo*.

Finally, Appellant argues that “the claims are not directed solely to an abstract idea, but rather include manipulating and using specific types of data in specific ways to provide a *novel* information presentation, education, and compilation system.” Br. 24 (emphasis added). However, patent eligibility of an abstract idea does not depend on its alleged novelty (or non-obviousness) in any case. *Mayo*, 132 S. Ct. at 1303–04; *see also Diehr*, 450 U.S. at 188–89 (“The ‘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.”).

Thus, claim 1, when considered “both individually and ‘as an ordered combination,’” amounts to nothing more than an attempt to patent the abstract ideas embodied in the steps of these claims. *See Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1298). Put another way, the limitations of independent claim 1 fail to transform the nature of these claims into patent-eligible subject matter. *See id.* (citing *Mayo*, 132 S. Ct. at 1297, 1298).

Accordingly, we sustain the Examiner’s rejection of independent claim 1, and claims 2–13, 15, 19, and 20 2–11 fall therewith.

#### DECISION

The Examiner’s decision rejecting claims 1–13, 15, 19, and 20 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