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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHEW CHRISTOPHER DOUGLASS and
STEFAN MILLS KLOCEK¹

Appeal 2017-009902
Application 14/454,312
Technology Center 3600

Before HUBERT C. LORIN, BIBHU R. MOHANTY, and
AMEE A. SHAH, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–3, 5–12, and 14–21 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

¹ According to Appellants, the real party in interest is Practice Fusion, Inc. See Appeal Br. 3.

THE INVENTION

The Appellants' claimed invention is directed to recommending medical applications based on a user's electronic medical record system (Spec., para. 1). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A computer-implemented method for providing a physician related medical application electronic marketplace by an electronic health records (EHR) system including an EHR server, comprising:
 - (a) activating, by the EHR server, a plurality of medical applications in the EHR system, the activating including:
for each of the medical applications:
 - (i) receiving information identifying the medical application, and
 - (ii) generating an activation key based on the information identifying the medical application;
 - (b) storing, by the EHR server, feature information associated with each of the activated plurality of medical applications in a database of the EHR system;
 - (c) receiving, at the EHR server from a physician using the EHR system, a request for browsing the physician-related medical application electronic marketplace;
 - (d) retrieving, by the EHR server, medical information describing practice of the physician from the database of the EHR system;
 - (e) filtering, by the EHR server, the plurality of the activated medical applications based on the retrieved medical information describing practice of the physician and the stored feature information associated with the respective medical application to generate a recommended list of medical applications, wherein the filtering (e) further comprises:
 - (i) after the activating, comparing the retrieved medical information describing the practice of the physician to the stored feature information associated with an activated medical application of the plurality of the activated medical applications,

- (ii) calculating a relevancy score between the retrieved medical information describing the practice of the physician and the stored feature information associated the medical application,
- (iii) determining whether the relevancy score exceeds a threshold value,
- (iv) when the relevancy score is determined to exceed the threshold value, incorporating the medical application into the recommended list, and
- (v) ranking medical applications in the recommended list based on a number of the physician's patients diagnosed with the medical problem associated with the respective medical application; and
- (f) outputting, by the EHR server, the recommended list of medical applications, as ranked by the ranking (e)(v), to a device for display to the physician.

THE REJECTION

The following rejection is before us for review:

Claims 1–3, 5–12, and 14–21 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence².

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellants argue that the rejection of claim 1 is improper because the claims are not directed to an abstract idea and are “significantly more” (App. Br. 13–18). The Appellants also argue that the claimed steps do not preempt any well-known business practices (App. Br. 24, 25).

In contrast, the Examiner has determined that that the rejection of record is proper (Final Rej. 2–5, Ans. 3–13).

We agree with the Examiner. Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “laws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In judging whether claim 1 falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. If so, we then consider the elements of the 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 of the abstract idea. *Id.* This is a search for an “inventive concept” an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.* The Court also stated that “the mere

recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention” *Id.* at 2358.

Here, we determine that the claim is directed to the concept of providing a list of recommend medical applications based on data. This is a method of organizing human activities or an idea in itself, and is an abstract idea beyond the scope of § 101. *See Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016) where collecting information, analyzing it, and displaying results from certain results of the collection and analysis was held to be an abstract idea. *See In re Meyer*, 688 F.2d 789, 795–96 (CCPA 1982), which held that “a mental process that a neurologist should follow” when testing a patient for nervous system malfunctions was not patentable.

We next consider whether additional elements of the claim, both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the abstract idea using generic computer components. We conclude that it does not. The Specification at paragraphs 85–102 for example describes using conventional servers, networks, databases, modules, and computing devices in a manner known for their known functions.

Considering each of the claim elements in turn, the function performed by the computer system at each step of the process is purely conventional. Each step of the claimed method does no more than require a generic computer to perform a generic computer function.

The Appellants have also cited to *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016) to show that the claim is not abstract, but the

claims in that case were not similar in scope to those here in contrast and were in contrast directed to a self-referential data table.

The Appellants have also cited to *McRo* but the claims in that case are distinguished from this case in being directed to rules for lip sync and facial expression animation.

The Appellants in the Appeal Brief at page 17 also argue the claim is rooted in retrieving a large amount of candidate data and presenting data to overcome a particular problem in the realm of electronic health records and cite to *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1258–59 (Fed. Cir. 2014). We disagree with this assertion. Here, the claim is not rooted in technology but rather to the abstract concept of providing a list of recommend medical applications based on data as determined above.

We note the point about pre-emption (App. Br. 24, 25). While pre-emption “might tend to impede innovation more than it would tend to promote it, ‘thereby thwarting the primary object of the patent laws’” (*Alice*, 134 S. Ct. at 2354 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012))), “the absence of complete preemption does not demonstrate patent eligibility” (*Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015)). *See also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015), cert. denied, 136 S. Ct. 701, 193 (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.”).

We reach the same conclusion as to independent system claim 10 and its dependent claims. Here, as in *Alice*, “the system claims are no different in substance from the method claims. The method claims recite the abstract

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idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea.” *Alice* 134 S. Ct. at 2351. “[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea ‘while adding the words ‘apply it’ is not enough for patent eligibility.” *Id.* at 2358 (quoting *Mayo*, 132 S. Ct. at 1294).

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1–3, 5–12, and 14–21 under 35 U.S.C. § 101.

DECISION

The Examiner’s rejection of claims 1–3, 5–12, and 14–21 is sustained.

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