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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex Parte RONALD KEEN, THOMAS BISSONETTE, and STANLEY CRANE [1]

Appeal 2017–010694
Application 12/014,758
Technology Center 3600

Before ST. JOHN COURTENAY III, LARRY J. HUME, and JOYCE CRAIG, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 22, 24, 25, 27–29, 31, 32 and 36–40, which are all claims pending in the application. Appellants have canceled claims 23, 25, 26, 30, and 33–35. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE the rejection of claims 22, 24, 25, 27–29, 31, 32, and 36–40 and pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection for these claims.

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[1] According to Appellants, the real party in interest is Allscripts Healthcare Solutions, Inc. App. Br. 3.

STATEMENT OF THE CASE[2]

The Invention

Appellants' disclosed embodiments and claimed invention relate to "the field of electronic health records. In particular, the present invention is directed to a universal application integrator for automatically populating an electronic health record, and driving workflow automation to and from multiple clinical applications and devices that interface with the patient." Spec. ¶ 2.

Exemplary Claim

Claim 1, reproduced below, is representative of the subject matter on appeal (*emphasis* added to indicate hybrid nature of claim):

> 1. A networked electronic health record (EHR) *computer system* enabling electronic access to patient data of electronic health records (EHRs) by patient care devices (PCDs), services, and applications, the system comprising:
>
> (I) a plurality of PCDs each comprising one or more sensors for measuring one or more vital statistics of a patient, each PCD being configured to obtain patient diagnostic data in the form of one or more measurements for a patient captured utilizing its one or more sensors;
>
> (II) one or more computer readable media containing
>
> (a) an EHR database, which stores EHRs for a plurality of patients;
>
> (b) an EHR module, which,

[2] Our decision relies upon Appellants' Appeal Brief ("App. Br.," filed April 21, 2017); Reply Brief ("Reply Br.," filed Aug. 16, 2017); Examiner's Answer ("Ans.," mailed June 16, 2017); Final Office Action ("Final Act.," mailed Oct. 18, 2016); and the original Specification ("Spec.," filed Jan. 15, 2008).

(i) reads patient data from and writes patient data to EHRs in the EHR database, and

(ii) provides access to patient data of EHRs by client computers for accessing EHRs by users;

(c) a device interface module which is configured to

(i) receive, from the plurality of PCDs in different respective formats, patient diagnostic data, and

(ii) standardize the received patient diagnostic data to a format of the EHRs stored in the EHR database;

(d) a context manager, which provides context information to and receives context information from each of the plurality of PCDs, applications, and services, wherein the determination of context for a particular communication is based at least in part on the respective PCD, respective application, or respective service of the communication;

(e) a service module, which provides information to each of a plurality of services for supporting performance of the respective service, the information provided to a particular service being in a format usable by the service;

(f) an application module, which,

(i) electronically provides patient data from the EHRs to each of a plurality of applications, the patient data electronically provided to a particular application being in a format that usable by the application, and

(ii) receives patient data from each of the plurality of applications for saving in the EHRs of the EHR computer system; and

(g) a user interface module, which enables configuration of the networked EHR computer system by a user;

(III) wherein the system is configured for performance of a method comprising

(a) receiving, at a first PCD of the plurality of PCDs, a first instance of context information provided by the context manager, the first instance of context information comprising at least one of patient bibliographic data, procedure codes, and billing information for a particular patient;

(b) automatically configuring the first PCD utilizing the received first instance of context information;

(c) obtaining, by the configured first PCD, patient diagnostic data for the particular patient;

(d) receiving, at the device interface module, the obtained patient diagnostic data, and saving, in a respective EHR for the particular patient that is stored in the EHR database, by writing of the patient diagnostic data by the EHR module to the respective EHR for the particular patient; and

(e) setting a flag indicating that the EHR of the particular patient has been updated by patient data;

(IV) wherein the device interface module comprises an application driver layer or framework that enables a standardized method for integrating data from a plurality of PCDs into an EHR;

whereby the automatic saving of patient diagnostic data from PCDs and patient data from applications enables health care providers to access current information when making diagnoses and treatment decisions for patients, and whereby services are timely performed based on information provided by the service module.

Rejection on Appeal

Claims 22, 24, 25, 27–29, 31, 32, and 36–40 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 2.

ISSUE

Appellants argue (App. Br. 8–20; Reply Br. 2–4) the Examiner's rejection of claim 1 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter is in error. These contentions present us with the following issue:

Under our governing case law concerning 35 U.S.C. § 101, did the Examiner err in concluding claim 1 is directed to a judicial exception, i.e., an abstract idea, without significantly more, and thus is patent-ineligible under § 101?

ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellants. To the extent Appellants have not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. 37 C.F.R. § 41.37(c)(1)(iv).

Based upon our review of the record, we find a preponderance of the evidence supports particular arguments advanced by Appellants with respect to the rejected claims for the specific reasons discussed below. We highlight and address specific findings and arguments for emphasis as follows.

Alice Framework

Section 101 provides that anyone who "invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" may obtain a patent. 35 U.S.C. § 101. The Supreme Court has repeatedly emphasized that patent protection should not extend to claims that monopolize "the basic tools of scientific and

technological work." *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012); *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014). Accordingly, laws of nature, natural phenomena, and abstract ideas are not patent-eligible subject matter. *Alice Corp.*, 134 S. Ct. at 2354.

The Supreme Court's two-part *Alice* framework guides us in distinguishing between patent claims that impermissibly claim the "building blocks of human ingenuity" and those that "integrate the building blocks into something more." *Alice Corp.*, 134 S. Ct. at 2354 (internal quotation marks, citation, and bracket omitted). First, we "determine whether the claims at issue are directed to [a] patent-ineligible concept[]." *Id.* at 2355. If so, we "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." *Id.* at 2357 (quoting *Mayo*, 566 U.S. at 72, 79). Although the two steps of the *Alice* framework are related, the "Supreme Court's formulation makes clear that the first-stage filter is a meaningful one, sometimes ending the § 101 inquiry." *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). We note the Supreme Court "has not established a definitive rule to determine what constitutes an 'abstract idea'" for the purposes of step one. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016) (citing *Alice*, 134 S. Ct at 2357).

Regarding the first step of the *Alice* analysis the Examiner concludes the rejected claims are all directed to an abstract idea. Final Act. 2. The Examiner specifically concludes claim 22 is directed to an abstract idea because

> (1) it is analogous to the court-defined abstract idea in *SmartGene* in that it compares new (context information and patient diagnostic data) and stored (patient data in EHR) information and uses rules () to identify options setting flag for updated information.
> (2) it is analogous to the court-defined abstract idea in *Cyberfone* in that it uses categories (context information and patient diagnostic data) to organize, store, and transmit information.

Final Act. 3.

The Examiner further concludes the steps of claim 22 "correspond[] to concepts identified as abstract ideas by the courts, such as 'Fundamental economic practices, certain method of organizing human activates, an idea of itself and/or Mathematical relationships/formulas,' as referenced in *Alice Corp*." Ans. 4.

Even assuming the Examiner were correct in the conclusion that claim 22 is directed to an abstract idea, and if we were to agree that claim 22 involves nothing more than identifying, collecting, storing, comparing, and generating data, without any particular inventive technology — an abstract idea (*See Elec. Power Grp.*, 830 F.3d at 1354), we find Appellants raise a dispositive issue under our governing case law regarding step two of the *Alice* analysis.

Regarding the second step of the *Alice* analysis, the Examiner finds the claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception, because:

> When viewed as a whole, the claims do not include additional limitations that are sufficient to amount to significantly more than the judicial exception because the claims recite processes that are routine and well-understood in the art of healthcare

> communication systems and simply implement the process or processes on a computer(s), which is not enough to qualify as "significantly more" as described herein.

Final Act. 3–4

The Examiner also finds: "Therefore, the PCDs in combination with the other recited structure does not result in significantly more; and B) functions that are *well-understood, routine, and conventional* activities previously known to the pertinent industry (i.e., configuring, receiving, setting etc.)." Final Act. 5 (emphasis added).

Appellants argue:

> [T]he Examiner has offered no evidence that these features are indeed conventional. Applicant notes in this regard that although a judge or jury acting as trier of fact may be able to hold activities as routine and conventional without offering any evidence, there is a large difference between a judge or jury acting as a trier of fact, and a patent examiner who also acts as a party with a *burden of establishing a prima facie case of patent ineligibility*.

App. Br. 12.

Appellants further argue "The Examiner has not only offered no evidence that these additional features are conventional, but has in fact acknowledged that claim 22 is patentable over the known prior art." App. Br. 13.

According to the Federal Circuit, "[w]hether something is *well-understood, routine, and conventional* to a skilled artisan at the time of the patent is a factual determination." *See Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018) (emphasis added). Responsive to the *Berkheimer* decision, we reproduce below the mandatory changes to

examination practice, as set forth in the April 19, 2018 USPTO *Berkheimer* Memorandum (3–4):

> ***A. Formulating Rejections***: In a step 2B analysis, an additional element (or combination of elements) is not well-understood, routine or conventional unless the examiner finds, and expressly supports a rejection in writing with, one or more of the following:
>
> 1. A citation to an express statement in the specification or to a statement made by an applicant during prosecution that demonstrates the well-understood, routine, conventional nature of the additional element(s). A specification demonstrates the well-understood, routine, conventional nature of additional elements when it describes the additional elements as well-understood or routine or conventional (or an equivalent term), as a commercially available product, or in a manner that indicates that the additional elements are sufficiently well-known that the specification does not need to describe the particulars of such additional elements to satisfy 35 U.S.C. § 112(a). A finding that an element is well-understood, routine, or conventional cannot be based only on the fact that the specification is silent with respect to describing such element.
> 2. A citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s).
> 3. A citation to a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s). An appropriate publication could include a book, manual, review article, or other source that describes the state of the art and discusses what is well-known and in common use in the relevant industry. It does not include all items that might otherwise qualify as a "printed publication" as used in 35 U.S.C. § 102.[] Whether something is disclosed in a document that is considered a "printed publication" under 35 U.S.C. § 102

is a distinct inquiry from whether something is well-known, routine, conventional activity. A document may be a printed publication but still fail to establish that something it describes is well-understood, routine, conventional activity. *See Exergen Corp.*, 2018 WL 1193529, at *4 (the single copy of a thesis written in German and located in a German university library considered to be a "printed publication" in *Hall* "would not suffice to establish that something is 'well-understood, routine, and conventional activity previously engaged in by scientists who work in the field'"). The nature of the publication and the description of the additional elements in the publication would need to demonstrate that the additional elements are widely prevalent or in common use in the relevant field, comparable to the types of activity or elements that are so well-known that they do not need to be described in detail in a patent application to satisfy 35 U.S.C. § 112(a). For example, while U.S. patents and published applications are publications, merely finding the additional element in a single patent or published application would not be sufficient to demonstrate that the additional element is well-understood, routine, conventional, unless the patent or published application demonstrates that the additional element are widely prevalent or in common use in the relevant field.

4. A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s). This option should be used **only** when the examiner is certain, based upon his or her personal knowledge, that the additional element(s) represents well-understood, routine, conventional activity engaged in by those in the relevant art, in that the additional elements are widely prevalent or in common use in the relevant field, comparable to the types of activity or elements that are so well-known that they do not need to be described in detail in a patent application to satisfy 35 U.S.C. § 112(a). Procedures for taking

> official notice and addressing an applicant's challenge to official notice are discussed in MPEP § 2144.03.

Based upon our review of the record, and as guided by the mandatory changes to patent examination practice, as set forth in the April 19, 2018 USPTO *Berkheimer* Memorandum, we are persuaded by and agree with Appellants argument that the Examiner has not set forth a sufficient evidentiary basis to find the additional element (or combination of elements) of claim 22 is/are well-understood, routine, or conventional.

Accordingly, we are constrained on this record to reverse the Examiner's rejection of claims 22, 24, 25, 27–29, 31, 32 and 36–40 under 35 U.S.C. § 101, as being directed to patent-ineligible subject matter.

NEW GROUND OF REJECTION

Pursuant to our authority under 37 C.F .R. § 41.50(b), we enter a new ground of rejection of claims 22, 24, 25, 27–29, 31, 32 and 36–40 under 35 U.S.C. § 112(b), as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

We conclude the scope of claim 22 is indefinite because it is a hybrid claim, which recites both a computer system and steps performed by a user of the system. *See IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (a claim reciting both a system and a method for using that system held indefinite). "A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. § 112, second paragraph." Manual of Patent Examining Procedure (hereinafter "MPEP") § 2173.05(p)(II) (9th ed. 2018).

Consequently, we enter a new ground of rejection under 35 U.S.C. § 112(b) for indefiniteness for independent claim 22 and claims 24, 25, 27–29, 31, 32 and 36–40, which depend therefrom and inherit the same deficiencies as their base claim.

CONCLUSION

The Examiner erred with respect to patent-ineligible subject matter Rejection of claims 22, 24, 25, 27–29, 31, 32 and 36–40 under 35 U.S.C. § 101, and we reverse the rejection.

DECISION

We reverse the Examiner's decision rejecting claims 22, 24, 25, 27–29, 31, 32 and 36–40.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." Section 41.50(b) also provides:

> When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:
>
> (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the

claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the MPEP § 1214.01.

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).

REVERSED

37 C.F.R. § 41.50(b)