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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT SCOTT ACKERSON, BRIAN ROBERT CARTER, and
CLAY PATTERSON

Appeal 2017-011761
Application 13/112,636
Technology Center 3600

Before JEAN R. HOMERE, RAMA S. ELLURU, and
HUNG H. BUI, *Administrative Patent Judges*.

Per Curiam.

Concurring-in-part Opinion re: 35 U.S.C. § 101 filed by *Administrative Patent Judges*, BUI and ELLURU.

Dissenting-in-part Opinion re: 35 U.S.C. § 101 filed by *Administrative Patent Judge*, HOMERE.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–5, 7, 8, 10–12, 14, 15, and 17–19, which constitute all claims pending in this application.¹ App. Br. 4. Claims 6, 9, 13, 16, and 20 have been canceled. Claims App. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify the real party in interest as Cerner Innovation, Inc. App. Br. 1.

Introduction

According to Appellants, the claimed subject matter relates to a method of downloading and updating a local copy of a user's medical record at an authenticated terminal within a medical computing environment including clinical laboratories, hospitals, providers' offices, home healthcare environments (103–106) connected to a central server (101) via a network (107). Spec. ¶¶ 4, 22–24, Fig. 1. In particular, upon receiving identification information from an activated user identification card, the authenticated terminal (103–106) is allowed to quickly connect with a central data store (102) via the network (107) to download to a local database updated health-related events pertaining to the user. *Id.* ¶¶ 27–28.

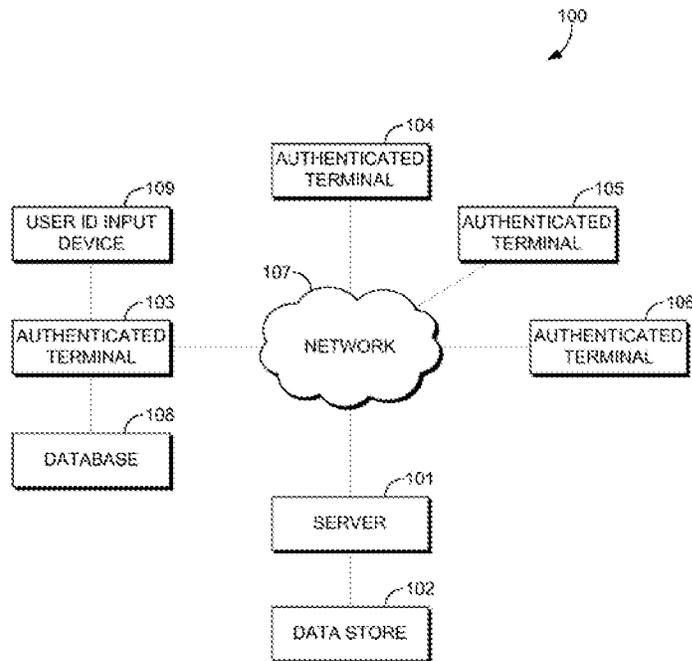


FIG. 1

Figure 1 depicts a schematic of a system for maintaining a user health record:

Representative Claim

Claims 1, 7 and 14 are independent. Independent claim 1 is representative, and is reproduced below with a disputed limitation italicized:

1. Non-transitory computer storage media having computer-executable instructions stored thereon that, when executed by a computing device, cause the computing device to perform a method of updating a user's health record, the method comprising:

receiving identification information from a user identification card at an authenticated terminal during a first encounter;

determining whether a connection with a user health record for the user at a central data store is established for the authenticated terminal; and

if the connection is not established for the authenticated terminal,

establishing the connection for the authenticated terminal with the user health record at the central data store;

determining that the user health record was not previously stored on a database associated with the authenticated terminal;

using the identification information to determine a portion of the user health record to select for storing as a local copy of the user health record on the database associated with the authenticated terminal;

requesting, from the central data store, the portion of the user health record to download and store as the local copy of the user health record on the database associated with the authenticated terminal;

storing the local copy of the user health record on the database associated with the authenticated terminal;

receiving identification information from the user identification card at the authenticated terminal during a second encounter; and

requesting updates to the local copy of the user health record in response to the receiving identification

information from the user identification card at the authenticated terminal during the second encounter.

References Relied Upon

Gray	US 6,268,788 B1	July 31, 2001
Joao	US 2002/0032583 A1	Mar. 14, 2002
McLaughlin et al. (hereinafter “McLaughlin”).	US 2009/0024416 A1	Jan. 22, 2009

Rejections on Appeal

Claims 1–5, 7, 8, 10–12, 14, 15, and 17–19 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 3.

Claims 1–5, 7, 8, 10–12, 14, 15, and 17–19 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of McLaughlin, Joao, and Gray. Final Act. 4–10.

ANALYSIS²

§ 103 Rejection

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (“*KSR*”). The question of obviousness is resolved on the basis of underlying factual

² We refer to Appellants’ arguments and the Examiner’s findings and conclusions set forth in the Final Office Action (mailed July 14, 2016) (“Final Act.”), the Appeal Brief (filed March 6, 2017) (“App. Br.”), the Answer (mailed July 24, 2017) (“Ans.”), and the Reply Brief (filed September 21, 2017) (“Reply Br.”) for the respective details.

determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Appellants argue that the Examiner erred in rejecting claim 1 over the combination of McLaughlin, Joao, and Gray because none of the cited references teaches or suggests “using the identification information to determine a portion of the user health record to select for storing as a local copy of the user health record on the database associated with the first authenticated terminal.” App. Br. 21–22. In particular, Appellants argue that McLaughlin discloses accessing a patient’s medical records, storing them as encrypted data on a smartcard, and the patient providing biometric data (e.g., fingerprint) to decrypt the stored data for subsequent use or transfer to another medium. *Id.* at 22. Appellants argue that the cited disclosure of McLaughlin’s fails to teach determining a portion of the patient’s health record to select for storing based on the entered biometric data. *Id.* Further, Appellants argue that Joao’s disclosure of continuously updating various databases with latest updates to maintain consistency there between does not cure the noted deficiencies of McLaughlin. *Id.* at 23. According to Appellants, Joao indiscriminately updates data based on various sources, as opposed to identifying particular information to update based on entered identification data. *Id.* at 24. Additionally, Appellants argue that Gray’s disclosure of controlling access to a computing system by verifying data entered through a scanner with data stored on a token while isolating data entered from a computer is similarly deficient. *Id.* These arguments are not persuasive.

Overview of McLaughlin

Figures 1 and 2 of McLaughlin are reproduced below:

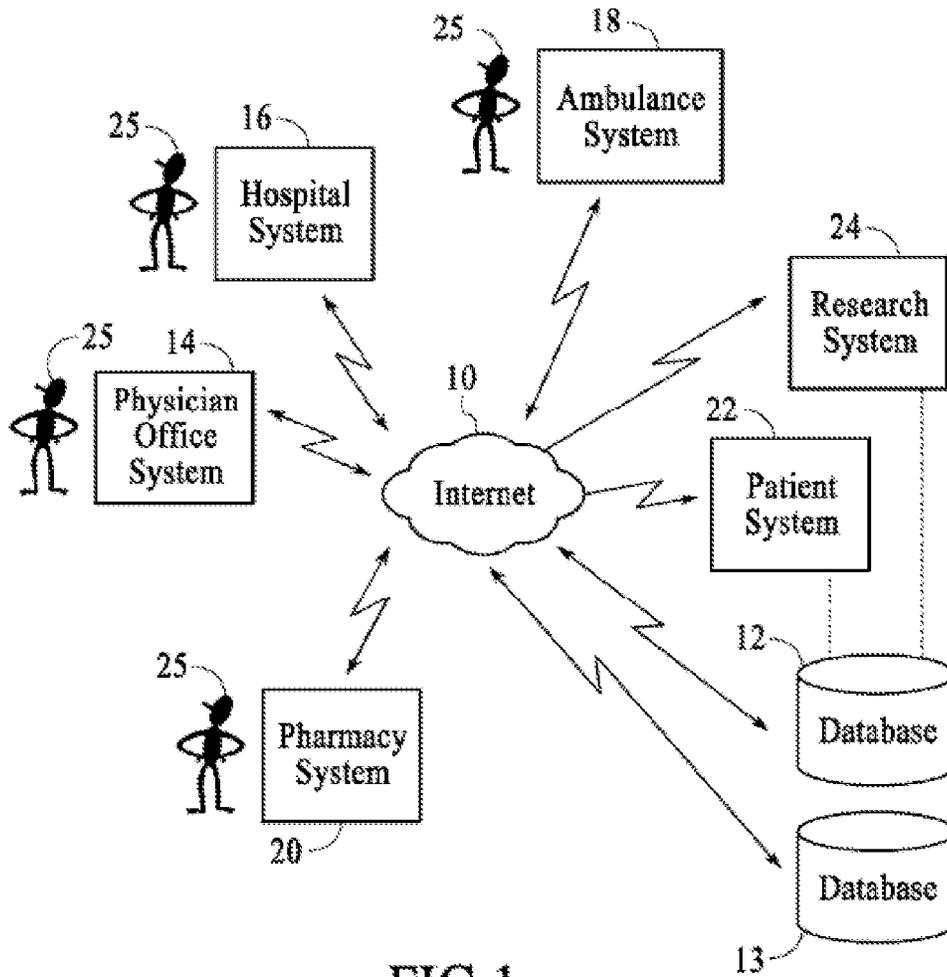


FIG. 1

Figure 1 shows a medical information management system having a database of patient medical information for access by authorized patients from a base unit at various healthcare facilities.

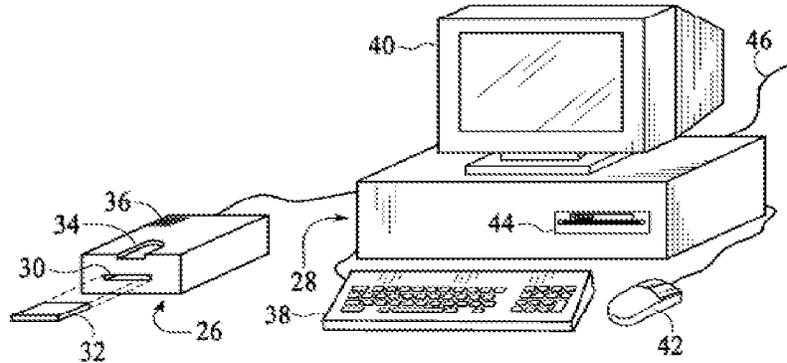


FIG. 2

Figure 2 depicts a base unit with a biometric/smartcard reader at a healthcare facility.

As depicted in Figure 1, McLaughlin discloses a healthcare medical management system for allowing an authorized user (25) at a healthcare facility (14, 16, 18, and 20) to access healthcare records of a patient locally or from a remote location (12, 13, 22, and 24) via the Internet (10).

McLaughlin Abstract, ¶ 27. As shown in Figure 2, the healthcare facility (25) is equipped with a healthcare workstation (28) coupled to a database system (44) and an authentication system (26) including a smartcard (32) and a fingerprint reader (28) for authenticating the user (25). *Id.* ¶¶ 31, 34. In particular, upon verifying the patient's biometric information, the system (12) permits patients to retrieve and review their own medical information including biographical data, health record, and medical insurance. *Id.* ¶ 31. Further, the system (12) allows the patient to transfer the medical information to the healthcare workstation. *Id.* ¶ 47.

As correctly noted by the Examiner, Appellants' arguments are tantamount to an individual attack against the references. Ans. 20. One cannot show non-obviousness by attacking the references individually where the rejections are based on combinations of references. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *see also In re Keller*, 642 F.2d 413, 425 (CCPA 1981). In this case, the Examiner relies upon McLaughlin for its teaching of a patient, using biometric identification at an authenticated terminal, to access a remote database (12) patient information, which is transferred via the Internet to a database associated with the authenticated terminal. Ans. 21 (citing McLaughlin ¶¶ 8, 24, 45, and 47. Further, the Examiner relies upon Joao's disclosure of a system for synchronizing healthcare information between a central database connected to a plurality of local databases in a network environment. *Id.* at 6, 22 (citing Joao ¶¶ 28, 38, and 54–56). Additionally, the Examiner relies upon Gray's disclosure of receiving identification information at the authenticated terminal during a second encounter. *Id.* at 7, 22 (citing Gray Abstract, 4:28–60).

We agree with the Examiner that the proposed combination of the cited references would predictably result in a healthcare medical management system wherein a remote database, upon authenticating a patient's entered credentials, allows the patient to download to the authenticated terminal a local copy of the user's health record, or updated portions thereof. *Id.* We find the Examiner's proposed combination of the cited teachings of McLaughlin, Joao, and Gray is no more than a simple arrangement of old elements with each performing the same function it had been known to perform, yielding no more than one would expect from such an arrangement. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). The ordinarily skilled artisan, being "a person of ordinary creativity, not an

automaton,” would be able to fit the teachings of the cited references together like pieces of a puzzle to predictably result in a healthcare medical management system wherein a remote database, upon authenticating a patient’s entered credentials, allows the patient to download to the authenticated terminal a local copy of the user’s health record, or updated portions thereof. *Id.* at 420–21. Because Appellants have not demonstrated that the Examiner’s proffered combination would have been “uniquely challenging or difficult for one of ordinary skill in the art,” we agree with the Examiner that the proposed modification would have been within the purview of the ordinarily skilled artisan. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418). Consequently, we are satisfied that, on the record before us, the Examiner has established by a preponderance of the evidence that the combination of McLaughlin, Joao, and Gray renders claim 1 unpatentable. Accordingly, we are not persuaded of error in the Examiner’s obviousness rejection of claim 1.

Regarding the rejection of claims 2–5, 7, 8, 10–12, 14, 15, and 17–19, Appellants have not presented separate patentability arguments or reiterated substantially the same arguments as those previously discussed for patentability of claim 1. As such, those claims fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Patent Eligible Subject Matter

To determine whether claims are patent eligible under 35 U.S.C. § 101, we apply the Supreme Court’s two-step framework articulated in *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208 (2014). First, we determine whether the claims are directed to a patent-ineligible concept: laws of nature, natural phenomena, and abstract ideas. *Id.* at 216–17. If so, we then proceed to the second step to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* at 217. In other words, the second step is to “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).

The Federal Circuit has described the *Alice* step-one inquiry as looking at the “focus” of the claims, their “character as a whole,” and the *Alice* step-two inquiry as looking more precisely at what the claim elements add—whether they identify an “inventive concept” in the application of the ineligible matter to which the claim is directed. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

Because there is no single definition of an “abstract idea” under *Alice* step 1, the Federal Circuit (1) has adopted the common law, analogy-driven approach (a.k.a. “analogous claim” test) to determine whether a claim is directed to an abstract idea, and (2) has instructed us “to examine earlier cases in which a similar or parallel descriptive nature can be seen—what

prior cases were about, and which way they were decided.” *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (citing *Elec. Power Grp.*, 830 F.3d at 1353–54; accord USPTO Memorandum, July 2015 Update: Subject Matter Eligibility, 3 (July 30, 2015), <https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf> (instructing examiners that “a claimed concept is not identified as an abstract idea unless it is similar to at least one concept that the courts have identified as an abstract idea”).

The PTO has acknowledged that the Federal Circuit’s common law, analogy-driven approach (a.k.a. “analogous claim” test) was effective soon after *Alice*, but recently concluded that approach has since become impractical as the growing body of Federal Circuit precedent has become increasing more difficult for the Office and Examiners to apply in a predictable manner. In particular, the PTO has issued a new § 101 Memorandum that governs all patent-eligibility analysis under *Alice* and § 101 effective as of January 7, 2019. See 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50, 52, Jan. 7, 2019 (“PTO § 101 Memorandum”). In this § 101 Memorandum, the PTO has synthesized, for purposes of clarity, predictability, and consistency, key concepts identified by the courts as abstract ideas to explain that the “abstract idea” exception includes the following three groupings:

- (1) Mathematical concepts—mathematical relationships, mathematical formulas or equations, mathematical calculations;
- (2) Mental processes—concepts performed in the human mind (including an observation, evaluation, judgment, opinion); and
- (3) Certain methods of organizing human activity—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).

PTO § 101 Memorandum, 84 Fed. Reg. at 52. According to the PTO § 101 Memorandum, “[c]laims that do not recite [subject] matter that falls within these enumerated groupings of abstract ideas should not be treated as reciting abstract ideas,” except in rare circumstances. Even if the claims recite any one of these three groupings of abstract ideas, these claims are still not “directed to” a judicial exception (abstract idea), and thus are patent-eligible, if “the claim as a whole integrates the recited judicial exception into a practical application of that [judicial] exception.” *See* PTO § 101 Memorandum, 84 Fed. Reg. at 53. “[I]ntegration into a practical application” requires an additional element or a combination of additional elements in the claim to apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the exception. *See* PTO § 101 Memorandum, 84 Fed. Reg. at 53–55.

For example, limitations that are indicative of “integration into a practical application” include:

- 1) Improvements to the functioning of a computer, or to any other technology or technical field – *see* MPEP § 2106.05(a);
- 2) Applying the judicial exception with, or by use of, a particular machine – *see* MPEP § 2106.05(b);
- 3) Effecting a transformation or reduction of a particular article to a different state or thing – *see* MPEP § 2106.05(c); and
- 4) Applying or using the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that

the claim as a whole is more than a drafting effort designed to monopolize the exception – *see* MPEP § 2106.05(e).

See PTO § 101 Memorandum, 84 Fed. Reg. at 53–55.

In contrast, limitations that are not indicative of “integration into a practical application” include:

- 1) Adding the words “apply it” (or an equivalent) with the judicial exception, or mere instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea – *see* MPEP § 2106.05(f);
- 2) Adding insignificant extra-solution activity to the judicial exception – *see* MPEP § 2106.05(g); and
- 3) Generally linking the use of the judicial exception to a particular technological environment or field of use – *see* MPEP § 2106.05(h).

See PTO § 101 Memorandum, 84 Fed. Reg. at 54–55 (“Prong Two”).

Examiner’s Determination of Patent-Ineligibility

In rejecting claims 1–5, 7, 8, 10–12, 14, 15, and 17–19 under 35 U.S.C. § 101, the Examiner determines these claims are generally directed to an abstract idea of updating a user health record between a central data store and a local data store upon authenticating the user. Ans. 13. The Examiner also determines that the claims include limitations that are considered “mental processes” and analogous or similar to concepts of (1) “comparing new and stored information and using rules to identify options” as discussed in *SmartGene (SmartGene, Inc. v. Advanced Biological Labs., SA*, 852 F. Supp. 2d 42 (D.D.C. 2012), *aff’d* 555 F. App’x 950 (Fed. Cir. 2014)); (2) “collecting and comparing known information” as discussed in *Classen; (Classen Immunotherapies Inc. v. Biogen IDEC*, 659 F.3d 1057 (Fed. Cir. 2011)); and (3) “obtaining and comparing intangible

data” as discussed in *CyberSource (CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011)). *Id.*

The Examiner further determines that the claims fail to amount to “significantly more than the judicial exception” or contain an “inventive concept” because (1) “the additional elements when considered both individually or as an ordered combination do not amount to significantly more than the abstract idea”; (2) the additional elements beyond the abstract ideas are generic computer components, such as a computing device, an authenticated terminal, a user ID card, a central data store, a user health record, and a database (i.e., local data store), implemented to perform generic functions that “are well-understood, routine and conventional activities to one of ordinary skill in the art”; and (3) “[t]here is no indication that the combination of elements improves the functioning of a computer or improves any other technology.” Ans. 14; Final Act. 3.

Appellants’ Contentions of Patent-Eligibility & Analysis

At the outset, Appellants contend the Examiner has not established a prima facie case of patent ineligibility under 35 U.S.C. § 101 because the Examiner (1) “has failed to identify an abstract idea in the claims, as required by Federal Circuit precedent”; (2) overlooked the “directed to” inquiry which requires an analysis of the claims, considered in light of the specification, based on whether their character as a whole is directed to an abstract idea; and (2) failed to explain why a precedential case is reasonably tied to an abstract idea. App. Br. 5–7; Reply Br. 2–3.

These arguments are not persuasive. First, we recognize that the Examiner “failed to identify an abstract idea in the claim” in the Final Action, but has since identified such an abstract idea in the Examiner’s Answer. In particular, we agree with the Examiner that the claims are

generally directed to an abstract idea of updating a user health record between a central data store and a local data store upon authenticating the user. Ans. 13. See *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012) (holding that patent eligibility is a question of law that is reviewable de novo).

Second, the Federal Circuit has repeatedly noted that “the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). The court has held that 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.” *In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011). Thus, all that is required of the Office is that it 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. *Id.*; see also *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (Section 132 “is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”). Appellants do not contend that the Examiner’s rejection under 35 U.S.C. § 101 cannot be understood or that the Examiner’s rejection, otherwise, fails to satisfy the notice requirements of 35 U.S.C. § 132. Indeed, Appellants’ understanding of the rejection is clearly manifested by their response as set forth in the briefs.

Lastly, the Examiner was required to review all claims at some level of generalization and determine whether those claims are directed to an

abstract idea under *Alice* step 1. Because there was no single definition of an abstract idea at the time, the Examiner was required “to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.” *Amdocs*, 841 F.3d at 1294 (citing *Elec. Power Grp.*, 830 F.3d at 1353–54; accord USPTO Memorandum, JULY 2015 UPDATE: SUBJECT MATTER ELIGIBILITY, 3 (July 30, 2015). In this case, the Examiner did just what he was required to do under the USPTO Memorandum i.e., analyzed the claims under *Alice* step 1 consistent with the guidance set forth in the USPTO’s “2014 Interim Guidance on Patent Subject Matter Eligibility,” 79 Fed. Reg. 74618 (Dec. 16, 2014), in effect at the time the rejection was made, i.e., on Mar. 18, 2016.

With respect to Appellants’ argument regarding the “directed to” inquiry under *Alice* step 1, we address that argument separately in the context of *Alice* step 1 inquiry and the newly published PTO § 101 Memorandum, 84 Fed. Reg. at 53, herein below.

Alice/Mayo—Step 1 (Abstract Idea)

Turning to the first step of the *Alice* inquiry, Appellants contend the Examiner erred in determining that the claims are directed to an abstract idea of “comparing new and stored information and using rules to identify options” under *SmartGene*. App. Br. 6, 8. In particular, Appellants argue the Examiner’s reliance on *SmartGene* is misplaced because (i) “*SmartGene* is a nonprecedential decision,” (ii) the Examiner’s reliance is in conflict with USPTO Guidance³ instructing examiners to “avoid relying upon or citing

³ Robert W. Bahr, *Recent Subject Matter Eligibility Decisions*, USPTO Memorandum (Nov. 2, 2016), available at

non-precedential decisions [(e.g., *SmartGene*)] unless the facts of the application under examination uniquely match the facts at issue in the non-precedential decision,” and (iii) the facts of the case on appeal do not match with those of *SmartGene*. App. Br. 8–10. According to Appellants, “the claims are not analogous to *SmartGene*” and the steps recited in the claims cannot be performed mentally because (i) claims 1 and 7 recite a computer storage media including several hardware elements that cannot be performed mentally, and (ii) claim 14 recites a system comprising “a user identification card,” “an authenticated terminal,” and “a datastore” and, as such, does not recite “method steps that may be performed mentally.” App. Br. 10–11.

Appellants further argue “the claims are directed to patent eligible subject matter because they describe a technological solution to a technological problem similar to the patent eligible claims in *McRO*” (*McRO, Inc. v. Bandai Namco Games America, Inc.*, 837 F.3d 1299 (Fed. Cir. 2016)). App. Br. 11 (emphasis omitted). In particular, Appellants argue the claims address “the problem of maintaining, updating, and consolidating electronic health records between a central datastore and local databases”—“a specific problem related to the conventional industry technology of electronic medical records,” and provides a “seamless integration of a user’s electronic health record with a plurality of facilities having authenticated terminals” for “the updating and maintenance of the user’s electronic health record.” *Id.* at 13. According to Appellants, “[b]ecause the claims present specific computer implemented methods that establish a technological solution to the technological problem of maintaining local copies of user

health records, they are similar to the claims in *McRO*, and thus, are directed to patent eligible subject matter.” *Id.*

Appellants’ arguments are not persuasive. At the outset, we note Appellants’ system claim 14 is no different from method claims 1 and 7 and, as such, are treated the same way under *Alice*. *Alice*, 573 U.S. at 226. In particular, the Supreme Court has long “warn[ed] us against” interpreting § 101 “in ways that make patent eligibility ‘depend simply on the draftsman’s art.’” *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 72 (2012) (quoting *Parker v. Flook*, 437 U.S. 584, 593 (1978) (“[t]he concept of patentable subject matter under § 101 is not ‘like a nose of wax, which may be turned and twisted in any direction.’”)). To hold otherwise would have exalted “form over substance.” *Flook*, 437 U.S. at 590. Like the claims in *Alice*, Appellants’ system claim 14 reciting hardware components configured to perform the same functions recited in method claims 1 and 7 add nothing of substance to the underlying abstract idea—these claims are also patent-ineligible under § 101. Likewise, the Federal Circuit’s decision in *SmartGene*, while non-precedential, remains instructive and provides a basis for the common law, claim analogy-driven approach to determine whether a patent claim is directed to an “abstract idea” under the first step of the *Alice* inquiry before the PTO § 101 Memorandum.

However, the newly published PTO § 101 Memorandum is now governing all patent-eligibility analysis under *Alice* and § 101 effective as of January 7, 2019. In particular, the PTO has synthesized, for purposes of clarity, predictability, and consistency, the “abstract idea” exception to limit to three categories of abstract ideas as outlined PTO § 101 Memorandum, 84 Fed. Reg. at 54–55.

Contrary to Appellants' arguments, Appellants' claims and Specification describe, "updating a patient's health record" between a central data store and a local data store upon authenticating the user, via a user identification card. Spec. ¶ 4; *see also* Abstract, and Figures 4–6. As correctly recognized by the Examiner (Ans. 13), maintaining consistency of "a patient's health record" between a central data store and a database (local data store) is an abstract idea. The steps recited in Appellants' claims 1, 7, and 14, such as (1) "determining that the user health record was not previously stored on a database"; (2) "using the identification information to determine a portion of the user health record to select for storing as a local copy of the user health record on the database"; (3) "requesting . . . the portion of the user health record to download and store as the local copy of the user health record on the database"; (4) "storing the local copy of the user health record on the database"; and (5) "requesting updates to the local copy of the user health record in response to . . . identification information from the user identification card" are nothing more than "mental processes" that could be performed by a human using a pen and paper (via reconciling differences between two copies of a patient's health record, regardless whether these copies are in paper form or in electronic form)—a subject matter that falls within the abstract ideas identified by the PTO § 101 Memorandum. *See CyberSource*, 654 F.3d at 1372–73 ("[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under [§] 101."); *see also In re Comiskey*, 554 F.3d 967, 979 (Fed. Cir. 2009) ("[M]ental processes—or processes of human thinking—standing alone are not patentable even if they have practical application."); *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) ("Phenomena of nature, . . . *mental processes*, and abstract intellectual concepts are not

patentable, as they are the basic tools of scientific and technological work.” (Emphasis added)). Additionally, mental processes remain unpatentable even when automated to reduce the burden on the user of what once could have been done with pen and paper. *CyberSource*, 654 F.3d at 1375 (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*.”).

For example, steps of “determining that the user health record was not previously stored”; “select[ing] [a portion of the user health record] for storing as a local copy of the user health record”; “requesting . . . the portion of the user health record to download and store as the local copy of the user health record on the database”; and “storing the local copy of the user health record” as recited in Appellants’ method claim 1, can be performed by a healthcare employee who simply reviews a patient’s health record and records the same. Similarly, step of “requesting updates to the local copy of the user health record in response to . . . identification information from the user identification card” can also be performed by the same healthcare employee who reviews and asks for an update in order to generate a training plan on paper. The remaining steps of “receiving identification information from a user identification card at an authenticated terminal” and “determining whether a connection with a user health record for the user at a central data store is established” are required when performed by generic computer components. *See CyberSource*, 654 F.3d at 1375.

In essence, Appellants’ claims seek to automate “pen and paper methodologies” to conserve human resources and minimize errors. This is a quintessential “do it on a computer” patent: it acknowledges data from one data store (e.g., first book) that was previously collected is compared with

data in another data store (e.g., local book), and simply proposes copying the same in another data store (e.g., local book) and doing so with a computer. *See University of Florida Research Foundation v. General Electric* (Fed. Cir. 20180-1284, February 26, 2019). The Federal Circuit has held such claims are directed to abstract ideas. *See, e.g., Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017) (holding abstract claims “directed to . . . collecting, displaying, and manipulating data”); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016) (holding abstract claims directed to “collecting information, analyzing it, and displaying certain results of the collection and analysis”). That the automation of updating a “patient’s health record” between a central data store and a local data store can be advantageously beneficial and even laudable to users (subscribers), but it does not render it any less abstract.

We also discern no additional element (or combination of elements) recited in Appellants’ claims 1–5, 7, 8, 10–12, 14, 15, and 17–19 that integrates the judicial exception into a practical application. *See* PTO § 101 Memorandum, 84 Fed. Reg. at 54–55 (“Prong Two”). For example, Appellants’ claim 1’s additional elements (e.g., “computing device,” “authenticated terminal,” “central data store” and “database”) do not (1) improve the functioning of a computer or other technology, (2) are not applied with any particular machine (except for a generic computer), (3) do not effect a transformation of a particular article to a different state, and (4) are not applied in any meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception. *See* MPEP §§ 2106.05(a)–(c), (e)–(h).

Appellants' reliance on *McRO* is misplaced. For example, *McRO*'s '576 patent (U.S. Patent No. 6,307,576) describes computer software for matching audio to a 3D animated mouth movement to provide lip-synced animation. *McRO*'s claims contain (i) specific limitations regarding a set of rules that “define[] a morph weight set stream as a function of phoneme sequence and times associated with said phoneme sequence” to enable computers to produce “accurate and realistic lip synchronization and facial expressions in animated characters” (*McRO*, 837 F.3d at 1313) and, when viewed as a whole, are directed to (ii) a “technological improvement over the existing, manual 3–D animation techniques” that uses “limited rules in a process specifically designed to achieve an improved technological result in conventional industry practice.” *McRO*, 837 F.3d at 1316.

In contrast to *McRO*, “updating a patient’s health record” between a central data store and a local data store upon authenticating the user, via a user identification card (Spec. ¶ 4; Abstract, and Figures 4–6) does not improve the computer functionality or provide any “technological solution to the technological problem of maintaining local copies of user health records,” as Appellants argue. App. Br. 13.

For these reasons, we agree with the Examiner’s determination that Appellants’ claims 1–5, 7, 8, 10–12, 14, 15, and 17–19 are directed to an abstract idea that is not integrated into a practical application.

Alice/Mayo—Step 2 (Inventive Concept)

In the second step of the *Alice* inquiry, Appellants argue (1) the Examiner failed to evaluate whether the claims contain an “inventive concept”; and (2) like the claims in (i) *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014), (ii) *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016); and (iii)

Amdocs (Isr.) Ltd. v. Openet Telecom, Inc., 841 F.3d 1288 (Fed. Cir. 2016), their claims provide a technical solution to a technological problem, and recite “specific, unconventional technological solution to a technological problem” in the field of medical record technology. App. Br. 18.

Appellant’s arguments are not persuasive. Instead, we discern no additional element or combination of elements recited in Appellants’ independent claims 1, 7, and 14 that contains any “inventive concept” or adds anything “significantly more” to transform the abstract concept into a patent-eligible application. *Alice*, 573 U.S. at 221. For example, Appellants’ abstract idea of “updating a patient’s health record” between a central data store and a local data store upon authenticating the user, via a user identification card (Spec. ¶ 4; Abstract, and Figures 4–6) is not rooted in computer technology. Nor does it (1) provide any technical solution to a technical problem as required by *DDR Holdings*; (2) provide any particular practical application as required by *BASCOM*; or (3) entail an unconventional technological solution to a technological problem as required by *Amdocs*. Instead, Appellants’ invention simply uses generic computer components (a computer receiving device, processing server, database device, transmitting device), shown, for example, in Figures 1, 2B, and 3B, to perform the abstract idea of “updating a patient’s health record.” Ans. 14.

As recognized by the Examiner, the use of generic computer components, such as a computing device, authenticated terminal, central data store and database) does not alone transform an otherwise abstract idea into patent-eligible subject matter. Ans. 14. As our reviewing court has observed, “after *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-

eligible.” *DDR*, 773 F.3d at 1256 (citing *Alice*, 573 U.S. at 223). Moreover, Appellants have not shown any specific limitation in claims 1, 7, and 14 beyond the judicial exception that is not “well-understood, routine, and conventional” in the field. *See* MPEP § 2106.05(d).

Because Appellants’ claims 1, 7, and 14 are directed to a patent-ineligible abstract concept and do not recite something “significantly more” under the second prong of the *Alice* analysis, we sustain the Examiner’s rejection of claims 1–5, 7, 8, 10–12, 14, 15, and 17–19 under 35 U.S.C. § 101.

DECISION

For the above reasons, the Examiner’s obviousness rejection and patent ineligibility rejection of claims 1–5, 7, 8, 10–12, 14, 15, and 17–19 are 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

Appeal 2017-011761
Application 13/112,636

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT SCOTT ACKERSON, BRIAN ROBERT CARTER, and
CLAY PATTERSON

Appeal 2017-011761
Application 13/112,636
Technology Center 3600

Before JEAN R. HOMERE, RAMA S. ELLURU, and HUNG H. BUI,
Administrative Patent Judges.

HOMERE, *Administrative Patent Judge*, dissenting-in-part.

I write separately to voice my disagreement with the concurring decision (“concurring dec.”) affirming the Examiner’s patent-ineligibility rejection. In particular, the concurring decision asserts agreement with the Examiner that the claims are directed to the abstract idea of “updating a user health record between a central data store and a local store upon authenticating the user.” Concurring Dec. 19–21 (citing Ans. 13). According to the concurring decision, the claims are therefore directed to the abstract idea of maintaining consistency between the databases, a method that can be performed by human thought alone, otherwise known as a mental process. *Id.* (citing *CyberSource*, *Comiskey*, *Gottschalk*.) From that conclusion, I respectfully dissent. At the outset, it is noted that the concurring decision mischaracterizes the abstract idea alleged by the

Examiner. Although the cited portion of the Examiner’s Answer refers to the language identified in the concurring decision, the Examiner explicitly identifies the alleged abstract idea as “the concept of comparing new and stored information and using rules to identify options.” Ans. 13. Further, it is noted that the concurring decision’s statement of the abstract idea merely summarizes the claimed language as opposed to identifying specific language in the claim that is directed to the alleged mental process as required by the PTO § 101 Memorandum set forth in the concurring decision. Instead, I agree with Appellants that the Examiner erred in concluding that the claims are directed to the abstract idea of “comparing new and stored information and using rules to identify options.” App. Br. 6. I agree with Appellants that the Examiner’s conclusion is devoid of any meaningful analysis supported by a precedential authority as to how any of the recited steps of receiving, determining, establishing, using, requesting, and storing is directed to the alleged abstract idea. *Id.* at 6–9. I also note that the Examiner’s conclusion suffers the same deficiencies as the concurring decision in failing to identify particularly the claim language associated with the alleged abstract idea. As persuasively argued by Appellants, the claimed subject matter is directed to using a user identification card at an authenticated terminal to connect with a central data store from which identified user health data is downloaded to a local store associated with the authenticated user terminal. App. Br. 12–13. Therefore, I agree with Appellants that the claims presently on appeal are directed to a specific computing environment for maintaining consistency between a local copy of a user’s health record at an authenticated computing device and another copy at central store by updating, consolidating, and reconciling differences therebetween. *Id.* As correctly noted by Appellants, because the

claims provide a seamless integration of a user's electronic health record at health facilities using an authenticated device to facilitate connection with a central data store from which updated data is downloaded, the claim is directed to performing self-improvement of the computing environment. *Id.* at 13. As such, I agree with Appellants that the claimed recitations are not directed to a method of organizing human activities, or mental steps.

Furthermore, even if the claimed functions were directed to the cited abstract idea alleged in the concurring decision, the claim integrates the noted judicial exception into a practical application because it recites an additional element reflecting an improvement in the functioning of a computer, or an improvement to other technology or technical field. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1258–59 (Fed. Cir. 2014). In particular, the claim recitation “requesting, from the central data store, the portion of the user health record to download and store as the local copy of the user health record on the database associated with the authenticated terminal” implements the recited functions with a particular machine or manufacture that is integral to the claim to thereby improve the integrity and functionality of databases in the distributed database environment.

Accordingly, I agree with Appellants that the claims are directed to patent eligible subject matter.

For the foregoing reasons, I would not sustain the Examiner's patent ineligibility rejection of claims 1–5, 7, 8, 10–12, 14, 15, and 17–19, which recite similar limitations.