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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* DANIEL WONG, DAVID HASKER, GLENN BRASSINGTON,  
STEFAN WEINERT, ABHISHEK S. SONI, ALAN GREENBURG,  
PAUL J. GALLEY, ULRICH PORSCHE, ROBERT E. REINKE, and  
MARCO DE POLO

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Appeal 2018-000414  
Application 12/818,930<sup>1</sup>  
Technology Center 3600

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Before ELENI MANTIS MERCADER, CATHERINE SHIANG, and  
LINZY T. McCARTNEY, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–26, 62, 63, and 79–80, which are all the claims pending and rejected in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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<sup>1</sup> Appellants identify Roche Diabetes Care, Inc. as the real party in interest. App. Br. 2.

## STATEMENT OF THE CASE

### *Introduction*

The present invention relates to “behavior modification methods and systems and particularly to self-administered, behavior modification facilitated through a structured tailoring method and system.” Spec. ¶ 2.

Claim 1 is exemplary:

1. A method of performing a self-administered, behavior modification program on a blood glucose meter which comprises facilitating a structured collection procedure for an individual which helps the individual change a current behavior to a target behavior and improves compliancy with the structured collection procedure, said method comprising:

providing the blood glucose meter loaded with the structured collection procedure and program instructions;

downloading the structured collection procedure from a server onto a client device, wherein software on the client computer serves as an interface between the server and the meter, wherein the server can only access information related to the installed version of the software and the server cannot access data in a database residing on the client device, wherein subsequent downloads of the particular structured collection procedure onto the client require access from an authorized client user;

measuring a biomarker comprising a blood glucose level with the blood glucose meter according to the structured collection procedure; and

executing the program instructions on the blood glucose meter causing a processor of the blood glucose meter to:

personalize the structured collection procedure by requesting goals from the individual to define for events to be accomplished in the structured collection procedure one or more adherence criteria that the processor uses to determine automatically whether each event was accomplished successfully and to define one or more exit criteria for ending the structured collection procedure,

and requesting intervention preferences from the individual;

initiate automatically a schedule of the events defined in the structured collection procedure upon one or more entry criteria being met;

provide intervention automatically according to the intervention preferences when the one or more adherence criteria for one of the events is not met;

end automatically the structured collection procedure upon the one or more exit criteria being met, wherein the processor continues automatically with the next one of the events in the structured collection procedure until the one or more exit criteria is met; and

assign a unique identifier to the events, when the one or more adherence criteria are met, which corresponds to the events in the structured collection procedure; and wherein the unique identifier is not assigned when the biomarker measurement is determined by the processor as not being close enough in time to a data event request based on a prescheduled time so as to facilitate the structured collection procedure and improve the compliancy with the structured collection procedure of a management system; and

providing a microprocessor, a memory, a power source, and an indicator, the indicator connected to the processor and which can operate under the control of the processor to emit audible, tactile, or visual alerts to the individual of daily times for the biomarker measurement; and

sending a message from the blood glucose meter to a physician when the individual fails to complete one of the one or more adherence criteria, wherein a communication link between a computer of the physician and the blood glucose meter can be established upon connection via the server.

*Rejection*<sup>2</sup>

Claims 1–26, 62, 63, and 79–80 stand rejected under 35 U.S.C. § 101 because the claims are directed to patent-ineligible subject matter. Final Act. 4–10.

ANALYSIS<sup>3</sup>

*35 U.S.C. § 101*

We have reviewed the Examiner’s rejection in light of Appellants’ contentions and the evidence of record. We concur with Appellants’ contention that the Examiner erred in this case.

Section 101 of the Patent Act provides “[w]hoever 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 therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (internal quotation marks and citation omitted).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo*

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<sup>2</sup> Throughout this opinion, we refer to the (1) Final Rejection dated Dec. 1, 2016 (“Final Act.”); (2) Appeal Brief dated Apr. 18, 2017 (“App. Br.”); (3) Examiner’s Answer dated Aug. 16, 2017 (“Ans.”); and (4) Reply Brief dated Oct. 12, 2017 (“Reply Br.”).

<sup>3</sup> Appellants raise additional arguments. Because the identified issue is dispositive of the appeal, we do not need to reach the additional arguments.

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

Concepts determined to be abstract ideas, and, thus, patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1853))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “a claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 187; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent

protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

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

The PTO recently published revised guidance on the application of § 101. USPTO’s 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Memorandum”). Under the guidance set forth in the Memorandum, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes) (Step 2A, Prong 1); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MANUAL OF PATENT EXAMINING

PROCEDURE (MPEP) § 2106.05(a)–(c), (e)–(h)) (9th Ed., Rev. 08.2017, 2018) (Step 2A, Prong 2).

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

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

(4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. (Step 2B).

*See* Memorandum at 54–56.

Turning to Step 2B of the Memorandum, “[t]he second step of the *Alice* test is satisfied when the claim limitations ‘involve more than performance of []well-understood, routine, [and] conventional activities previously known to the industry.’” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1367 (Fed. Cir. 2018) (quoting *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347–48 (Fed. Cir. 2014) and *Alice*, 573 U.S. at 225). “Whether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination.” *Berkheimer*, 881 F.3d at 1369.

In this case, Appellants argue with respect to the *Alice* step-two analysis,

the recited claim features discussed above are not well-understood, routine, and conventional in the industry, and are not characterized in Appellant’s specification as such. Further, the Examiner fails to provide any evidence for rebuttal to the contrary to support the rejection and thereby clarify the record for appeal.

App. Br. 19 (emphasis omitted).

Many features of claim 1. . . are simply not well-understood, routine, conventional functions, nor has any evidence been provided in the Final Office Action.

App. Br. 22.

the recited claim features discussed above are not well-understood, routine, and conventional in the industry, and are not characterized in Appellant's specification as such. Further, the Examiner fails to provide any evidence for rebuttal to the contrary to support the rejection and thereby clarify the record for appeal.

App. Br. 23 (emphasis omitted).

the recited features are simply not well-understood, routine, conventional functions. As discussed above, the Examiner has produced no evidence to substantiate Appellant's request for such proof.

App. Br. 24 (emphasis omitted).

The Examiner does not respond with the requisite evidence, as the Examiner merely provides conclusory and high-level general statements (Ans. 3, 7–9), which are insufficient for meeting the *Berkheimer* requirement. *See Berkheimer*, 881 F.3d at 1369. Therefore, the Examiner erred with respect to Step 2B of the Memorandum, and we are constrained by the record to reverse the Examiner's rejection of claims 1–26, 62, 63, and 79–80 on procedural grounds.

## DECISION

We reverse the Examiner's decision rejecting claims 1–26, 62, 63, and 79–80.

Appeal 2018-000414  
Application 12/818,930

REVERSED