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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
13/466,574 05/08/2012 David Reyes P1098 2331

24739 7590 02/27/2019
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Table with 1 column: EXAMINER

LAM, ELIZA ANNE

Table with 2 columns: ART UNIT, PAPER NUMBER

3686

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

02/27/2019

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID REYES

Appeal 2018-000834¹
Application 13/466,574
Technology Center 3600

Before MURRIEL E. CRAWFORD, MICHAEL W. KIM, and
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1–3, 6–9, 21, 22, 24, 25, and 27–30. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6.

The invention relates generally to methods and apparatus for conducting communications with remote-located patients through a computer network. Spec. 1:15–17.

Independent claim 22 is illustrative:

22. A method comprising the steps:

(a) setting two or more on-location medical appointments
in memory of an Internet-connected server having at least one

¹ The Appellant identifies the inventor, Dr. David Reyes, as the real party in interest. Appeal Br. 2.

processor, at least one connected data repository, and a port enabling communication with computerized appliances also connected to the Internet;

(b) providing an interactive display on a display monitor with input/output (110) capability coupled to the server, the interactive display having a video conferencing window enabled to display to a physician attending the display monitor, images of a specific patient or of a medical assistant attending the specific patient at an appointment location;

(c) displaying a plurality of interactive indicia representing individual ones of the on-location medical appointments;

(d) selecting by the physician attending the display monitor of a specific one of the interactive indicia representing an appointment;

(e) establishing by the selection in step (d) a video conference between the physician attending the display monitor, using image and audio capability coupled to the server and proximal the display monitor and either the patient at the appointment location or the medical assistant at the appointment location using an Internet-connected communication device enabled for video conferencing, with video images displayed for the physician in the video conferencing window in the interactive display; and

(f) upon the video conference being established, selecting from the data repository data pertinent to the specific patient and displaying that data in a data window in the interactive display displaying the interactive indicia and the video window.

The Examiner rejected claims 1–3, 6–9, 21, 22, 24, 25, and 27–30 under 35 U.S.C. § 101 as directed to ineligible subject matter in the form of abstract ideas without significantly more.

The Examiner rejected claims 1–3, 6–9, 21, and 30² under 35 U.S.C. § 103(a) as unpatentable over Kaboff et al. (US 8,019,622 B2, iss. Sept. 13,

² In the Answer, the Examiner lists dependent claim 30 as rejected with independent claim 22. Ans. 3. Claim 30 depends ultimately, however, from independent claim 1. In the latest Office Action, the Examiner correctly

2011) (“Kaboff”), Wang et al., (US 2010/0268383 A1, pub. Oct. 21, 2010) (“Wang”), Walter et al. (US 2003/0154110 A1, pub. Aug. 14, 2003) (“Walter”), and Official Notice.

The Examiner rejected claims 22, 24, 25, and 27–29 under 35 U.S.C. § 103(a) as unpatentable Kaboff, Wang, and Walter.

We AFFIRM, but designate it as a NEW GROUND of rejection pursuant to 37 C.F.R. § 41.50(b).

ANALYSIS

Rejection 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. 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. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

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

included dependent claim 30 as rejected with in independent claim 1. *See* Non-Final Act. 5, 10, 13, mailed July 12, 2016, from which this appeal rises. Appeal Br. 7. We do the same.

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, 69 (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 184 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); 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 176; *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 (quotation marks 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. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”). Under the Guidance, 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 interactions such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

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.

See Guidance.

Independent claim 22 recites setting appointments, displaying information and indicia, initiating a videoconference upon the selection of the displayed indicia, and displaying additional information upon the selection of the displayed indicia. As claimed, these steps are directed to a method of organizing human activity, in that they are “managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions).” *See* Guidance, 84 Fed. Reg. at 52. Specifically, while some other functions are performed on a computer, the method steps themselves involve people performing those functions to facilitate an interaction. For example, the step of “setting two or more on-location medical appointments” involves people setting those appointments, while the steps of “selecting by the physician attending the display monitor of a specific one of the interactive indicia representing an appointment” and “establishing by the selection in step (d) a video conference between the physician . . . either the patient at the appointment location or the medical assistant at the appointment location” involves an initiation of an interaction between the doctor and the person associated with the selected appointment. As such, we preliminarily find that independent claim 22 is directed to one of certain methods of organizing human activity that are abstract ideas.

The other inquiries under the Guidance do not persuade us otherwise. The method does not concern an improvement to a technology, because while the method is executed on a computer, the purported improvement is

how doctor-patient communications can be improved utilizing that technology, which is not an improvement to the technology itself. *See* MPEP § 2106.05(a). In other words, the method merely implements a purported improvement to organizing human behavior on general purpose web server computers and network client computers. *See, for example*, Spec. 7:17–8–13, 12:17–13:25. This is indistinguishable from merely providing instructions to apply the method on a general purpose computer. *See* MPEP ¶ 2106.05(f). All the claim essentially does is tie the use of computers, all of which display information and conduct communications, to a particular medical environment and exchange. *See id.* § 2106.05(h). Because the steps involve general purpose computer operations, the method does not represent a “particular machine,” or transform a physical object. *See* MPEP § 2106.05(b)–(c). The claimed method thus does not “integrate the abstract idea into a practical application.”

Given that, we must now determine whether the claimed method includes a step that is *not* well-understood, routine, or conventional. *See* § 2106.05(d). The first recited step (a) of setting an appointment encompasses any form of making a record of an appointment, such as a scheduling book. *See* Spec. 18:3–6. Steps (b), (c), and (f) display selected information, including images. Displaying text and image information on a computer display is well-known, routine, and conventional. *See Mayo*, 566 U.S. at 79. Step (d) involves letting a user make a selection of to initiate an action, which is a normal behavior of a graphical user interface. *See Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1348 (Fed. Cir. 2015) (a web browser’s back and forward button functionality is “well-understood, routine, conventional”). Step (e) establishes a video conference. The

Specification indicates that “selection of an appointment such as appointment 206 will cause any live video feed sourced from the location of the patient and MA to be displayed in window 201.” Spec. 16, ll. 9–11. Because the initiation of a video conference is not limited, but broadly involves initiating any video feed, we infer this step, and the entire claim, merely relies on well-understood, routine, and conventional technology.³

We are unpersuaded by the Appellant’s argument that the claimed method provides “something more” in the way of “a new software mechanism” that a selection on a user interface to initiate a video conference, by having the selection of indicia control the computer. Appeal Br. 9–10. By using general purpose computers and standard computer functions, such as displaying images and video within a user interface that initiates actions upon selection of indicia, the Appellant has not introduced a new software mechanism, because user interfaces that provide these functions are already available.

We are not persuaded by the Appellant’s argument that the method provides a patentable transformation of data. Appeal Br. 10. This alleged “transformation” is, at best, merely a manipulation of data, which is not sufficient to meet the transformation prong under 35 U.S.C. § 101. *See Gottschalk*, 409 U.S. at 71–72 (holding that a computer based algorithm that merely transforms data from one form to another is not patent-eligible).

³ The Appellant’s Reply Brief appears to confirm this by arguing the invention solves the problem of forcing patients to travel to or leave where specialized computer equipment is located, to communicate with specialized computer equipment at a physician’s location. Reply Br. 9. The solution apparently involves the use of general purpose computers to resolve these problems.

Independent claim 22 thus does not provide additional limitations beyond the abstract idea to transform the abstract idea into eligible subject matter. Dependent claim 24 displays text, and dependent claim 25 uses color, text, or symbol to communicate. Dependent claim 27 lists common computers to use. Dependent claim 28 recites that the computer is “enabled” to connect to other devices. Dependent claim 29 indicates that a local area network is utilized. The dependent claims thus do not alter the analysis or outcome. In addition, claims 1–3, 6–9, and 30 merely implement the methods of claims 22, 24, 25, and 27–29 on a system. “[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible. The bare fact that a computer exists in the physical rather than purely conceptual realm is beside the point.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (internal citations and quotation marks omitted).

For these reasons, the Appellant has not persuaded us of error in the Examiner’s rejection. Therefore, we sustain the rejection of claims under 35 U.S.C. § 101 as directed to abstract ideas. However, because our rationale differs from that of the Examiner, we denominate our affirmance as a new ground of rejection.

Rejections under 35 U.S.C. § 103(a)

The Appellant argues together (1) both rejections and (2) both independent claims 1 and 22. We treat them in the same manner.

For independent claims 1 and 22, the Appellant argues that the cited “visit types” in *Kaboff* are not the claimed “interactive indicia,” that *Kaboff* does not initiate a video conference, and that *Wang* does not initiate, at

paragraph 77, where a doctor sends an invitation, a video conference in the same manner as claimed. Appeal Br. 12–13; *see also* Reply Br. 10–11.

We are not persuaded by the Appellant’s argument, because Wang discloses initiating a video conference through the selection of interactive indicia, in the form of the robot and connect button on a graphical user interface. Wang, Figs. 10, 11, ¶ 63.

We also are not persuaded by the Appellant’s argument that Walter fails to disclose interactive indicia that may be selected. Appeal Br. 13–15. Walter discloses that a doctor may “select individual patients[,] and open their patient health records from his provider schedule.” Walter ¶ 35 (cited at Non-Final Act. 8). Walter also discloses these selection are made using a “graphical user interface.” *Id.* ¶ 26. Graphical user interfaces permit selection of indicia to perform actions. Kaboff also discloses the use of graphical menus. Kaboff 9:59–65.

For dependent claim 3, the Appellant asserts that “color, text or symbol” of the interactive indicia is erroneously considered non-functional descriptive material, because “the interactive indicia are coded by color, text or symbol to indicate whether the appointment is ready to start.” App. Br. 15–16. We are unpersuaded the Examiner erred, because the claims do not provide any technical details as to how the “color, text or symbol” limits the functioning of the computer. Absent that, the association between the recited “color, text or symbol” and “appointment is ready to start” is broad enough to encompass that association made only in the human mind.

For these reasons, we sustain the rejection of all rejected claims as obvious under 35 U.S.C. § 103(a).

DECISION

We AFFIRM the rejection of claims 1–3, 6–9, 21, 22, 24, 25, and 27–30 under 35 U.S.C. § 101.

We AFFIRM the rejections of claims 1–3, 6–9, 21, 22, 24, 25, and 27–30 under 35 U.S.C. § 103(a).

This Decision contains a NEW GROUND of rejection pursuant to 37 C.F.R. § 41.50(b) (2008). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that 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. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED; 37 C.F.R. § 41.50(b)