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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* JOHN L. BAEKE

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Appeal 2018-001695  
Application 13/736,057  
Technology Center 3600

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Before CARL L. SILVERMAN, JAMES W. DEJMEK, and  
JOYCE CRAIG, *Administrative Patent Judges*.

CRAIG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant<sup>1</sup> requests rehearing of the decision entered June 21, 2019 (“Decision”), affirming the rejection of claims 1, 2, 4–12, 14–22, and 26–28 under 35 U.S.C. § 101. We have reconsidered the Decision in light of Appellant’s comments in the Request. We are not persuaded that the Board’s affirmance is an undesignated new ground of rejection. Nor are we persuaded that the Board misapprehended or overlooked any points in affirming the Examiner. Thus, we deny the requested relief.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42 (2016). Appellant identifies the real party in interest as John L. Baeke. App. Br. 4.

## ANALYSIS

Requests for Rehearing are limited to matters overlooked or misapprehended by the Panel in rendering the original decision. *See* 37 C.F.R. § 41.52. Requests for Rehearing, however, may include arguments that the Board’s decision contained an undesignated new ground of rejection. 37 C.F.R. § 41.52(a)(4). Appellant’s arguments based on the Board’s Revised Guidance are timely, as the Revised Guidance went into effect on January 7, 2019, after Appellant’s Reply Brief was filed and before the Decision issued.<sup>2</sup>

Appellant refers to the Decision as “containing an undesignated new ground of rejection pursuant to 37 C.F.R. 41.52(4).” Reh’g Req. 2. Appellant, however, presents no persuasive argument in support. Thus, we are not persuaded that the Decision contains an undesignated new ground of rejection.

Appellant further argues that the Decision “may not have appreciated fully the meaningful limitations to the claims” in accordance with the 2019 Revised Patent Subject Matter Eligibility, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”). *Id.*

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<sup>2</sup> Appellant states that “[e]ach of the other rejections [(i.e., other than the rejection under 35 U.S.C. § 101)] addressed in Appellant’s Appeal Brief have been withdrawn by the Examiner.” Reh’g Req. 2. As noted in the Decision, only the rejections of claims 1, 2, 4–10, 19–22, and 26–28 under 35 U.S.C. § 103(a), and the rejection of claim 5 under 35 U.S.C. § 112, first paragraph, were withdrawn in the Answer. Decision 3 n.3 (citing Ans. 3). The Decision addressed the remaining rejections, affirming the Examiner’s rejection of claims 7, 17, and 19–22 under pre-AIA 35 U.S.C. § 103(a) and the Examiner’s rejection under pre-AIA 35 U.S.C. § 112, second paragraph, of claims 1, 2, 4–10, 19–22, and 26–28. Decision 13. Appellant does not identify any support that the Examiner has subsequently withdrawn these rejections.

We are not persuaded that the Decision overlooked meaningful limitations because Appellant argues in a conclusory manner that “[t]he scope of the insurance policy, in that it covers complications and side effects for at least one year past the completion date of the surgical procedure, should not be grouped into the limitations that make up the fundamental economic practice.” *Id.* at 3. Appellant has not argued persuasively why the scope or term of the policy is an “additional element,” separate from “underwriting an insurance policy to cover an adverse event,” which is recited in the same limitation of claim 1 and is part of the fundamental economic practice.

Even if (1) covering both complications and side effects; and (2) providing a policy for at least a year after the surgical procedure were considered “additional elements,” they would not integrate the judicial exception into a practical application. Appellant argues that covering both complications and side effects, and providing a policy for at least a year, applies or uses the judicial exception in some meaningful way beyond generally linking the use of the judicial exception to a particular environment, such that the claims as a whole is more than a drafting effort designed to monopolize the exception. Reh’g Req. 4; *see also* Guidance, 84 Fed. Reg. at 55.

We disagree. The basis of Appellant’s argument is that “[t]ypical insurance does not cover both complications and side effects, and do not extend to the claimed time period.” Reh’g Req. 4. The question in step 2A, prong 2, however, is not whether an additional feature (i.e., the scope and term of the insurance policy) is novel. *See Affinity Labs of Tex., LLC v. DirecTV, LLC*, 838 F.3d 1253, 1263 (Fed. Cir. 2016) (explaining that “[e]ven assuming” that a particular claimed feature was novel, the problem

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of abstractness was not avoided). Moreover, even assuming Appellant is correct that “[t]ypical insurance does not cover both complications and side effects, and do[es] not extend to the claimed time period” (Reh’g Req. 4), that does not mean no insurance policies have such features.

Appellant also argues that “the field of use, being linked to the underwriting, further provides evidence of a practical application of the judicial exception.” Reh’g Req. 5. Manual of Patent Examining Procedure section 2106.05(e), however, explicitly states that “[t]he claim should add meaningful limitations beyond generally linking the use of the judicial exception to a particular technological environment to transform the judicial exception into patent-eligible subject matter.” MPEP § 2106.05(e). Thus, we are not persuaded that limiting terms of the insurance coverage to a surgical environment would transform the judicial exception into patent-eligible subject matter.

Following the Guidance, we determined in the Decision that the claims do not integrate the judicial exception into a practical application so as to impose a meaningful limit on the judicial exception. The Request for Rehearing is denied.

## CONCLUSION

We have considered the arguments raised by Appellant in the Request. We have granted Appellant’s request to the extent that we have reconsidered our Decision, but we deny Appellant’s request to make any changes therein.

REHEARING DENIED