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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ERIC COHEN-SOLAL and MICHAEL CHUN-CHIEH LEE

Appeal 2018-002025
Application 13/981,998
Technology Center 3600

Before ST. JOHN COURTENAY III, MARC S. HOFF, and
ELENI MANTIS MERCADER, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–8, 11–13, 15, and 41–46, which constitute all the claims pending in this Application. Claims 9, 10, 14, and 16–40 are cancelled. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm-in-part.

¹ According to Appellants, the real party in interest is Koninklijke Philips N.V. App. Br. 2.

STATEMENT OF THE CASE

Embodiments of Appellants' claimed invention relate to:

identifying missing medical concepts for selecting an imaging protocol for an imaging procedure for a patient from medical concepts for imaging procedures for other patients and/or for identifying medical concepts from medical information for a patient in addition to an order prescribing an imaging procedure for the patient for selecting an imaging protocol for the imaging procedure.

Spec. 1.

Exemplary Claim

1. A method, comprising:

obtaining first electronically formatted medical information about a patient scheduled for an imaging procedure via an imaging system, wherein the electronically formatted medical information includes a first set of medical concepts corresponding to the imaging procedure;

obtaining second electronically formatted medical information with a second set of medical concepts for one or more imaging procedures for other patients previously scanned;

identifying cases of the other patients that correspond to the second electronically formatted medical information wherein the second set of medical concepts comprise the first set of medical concepts;

identifying a third set of medical concepts in the second set of medical concepts from identified cases of other patients that are missing from the first set of medical concepts in the first electronically formatted medical information of the patient as missing medical concepts; and

selecting an imaging protocol for the imaging procedure from imaging protocols recommended for the missing medical concepts, and *generating a signal indicative of the selected imaging protocol that configures an imaging scanner to scan the patient.*

App. Br. 14 (Claims Appendix) (emphasis added).

*Rejection*²

Claims 1–8, 11–13, 15, and 41–46 are rejected under 35 U.S.C. § 101, as being directed to a judicial exception, without significantly more. Final Act. 3.

Issue on Appeal

Did the Examiner err in rejecting claims 1–8, 11–13, 15, and 41–46 under 35 U.S.C. § 101, as being directed to a judicial exception, without significantly more?

ANALYSIS

We have considered all of Appellants’ arguments and any evidence presented. We highlight and address specific findings and arguments for emphasis in our analysis below.

Principles of Law — 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. *Mayo Collaborative Servs. v. Prometheus Labs.*,

² We herein refer to the Final Office Action, mailed May 10, 2017 (“Final Act.”); Appeal Brief, filed Sept. 28, 2017 (“App. Br.”); Examiner’s Answer, mailed Nov. 2, 2017 (“Ans.”); and the Reply Brief, filed Dec. 19, 2017 (“Reply Br.”).

Inc., 566 U.S. 66, 70 (2012) (brackets in original) (citing *Diamond v. Diehr*, 450 U.S. 175, 185 (1981)).

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*. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217–18 (2014) (citing *Mayo*, 566 U.S. at 75–77). 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, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding of rubber products” (*Diehr*, 450 U.S. at 191); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 183 n.7 (quoting *Corning v. Burden*, 56 U.S. (15 How.) 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 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 (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.*

Subject Matter Eligibility — 2019 Revised Guidance

The USPTO recently published revised guidance on the application of 35 U.S.C. § 101. *See* USPTO, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“2019 Revised

Guidance”). Under the 2019 Revised Guidance, we first look to whether the claim recites:

(1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, mental processes, or certain methods of organizing human activity such as a fundamental economic practice or managing personal behavior or relationships or interactions between people); 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)).³ *See* 2019 Revised Guidance, 84 Fed. Reg. at 51–52, 55.

A claim that integrates a judicial exception into a practical application applies, relies on, or uses 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 judicial exception. *See* 2019 Revised Guidance, 84 Fed. Reg. at 54. When the judicial exception is so integrated, then the claim is not directed to a judicial exception and is patent eligible under § 101. *Id.*

Only if a claim: (1) recites a judicial exception, and (2) does not integrate that exception into a practical application, do we then evaluate whether the claim provides an inventive concept. *See* 2019 Revised Guidance at 56; *Alice*, 573 U.S. at 217–18.

For example, we 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**

³ All references to the MPEP are to the 9th ed., Revision 08–2017 (rev. Jan. 2018).

(4) simply appends well-understood, routine, and conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. *See* 2019 Revised Guidance, 84 Fed. Reg. at 56.

Because there is no single definition of an “abstract idea” under *Alice* step 1, the PTO has recently 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).

According to the 2019 Revised Guidance, “claims 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 exception.” *See* 2019 Revised Guidance, 84 Fed. Reg. at 53.

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).

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 merely include instructions to implement an abstract idea on a computer, or merely using 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 2019 Revised Guidance, 84 Fed. Reg. at 54–55 (“Prong Two”).

We note Appellants’ Reply Brief was filed on December 19, 2017. Therefore, neither the Examiner nor the Appellants had the benefit of the 2019 Revised Guidance.

Rejection of Claims 1–8, 11–13, 15, and 41–46 under 35 U.S.C. § 101

The Examiner concludes that claims 1–8, 11–13, 15, and 41–46 recite the abstract idea of “*selecting* an imaging protocol for an imaging procedure based on a combination of medical concepts from electronically formatted medical information and *identified* missing medical concepts, and generating a signal indicative of the selected imaging protocol.” Final Act 4 (emphasis added).⁴

The Examiner finds the claims do not include additional elements that amount to significantly more than the judicial exception, because

the additional limitations of (1) generating/providing a signal indicative of the selected imaging protocol that configures an imaging scanner to scan the patient, (2) displaying/presenting recommended protocols, medical concepts, or lists of protocols, or (3) operating the imaging scanner to scan the patient according to the selected imaging protocol[,] merely represent insignificant, conventional extra-solution activities well-understood in the industry of healthcare communication systems or the application of the abstract idea (saying “apply it”).

Id. at 5.

The Examiner also finds “[a]n imaging scanner is claimed, which is not [a] generic computer structure.” *Id.* at 6. However, the Examiner finds:

the imaging scanner only serves as a device to which data is sent (extra-solution activity) and is only performing functions that an imaging scanner generically performs. The Specification does not provide a description of the imaging scanner other than the functions it performs. For example the Specification at Pg. 14, final paragraph describes an imaging

⁴ “Patent eligibility under § 101 presents an issue of law.” *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1340–41 (Fed. Cir. 2013).

scanner as a generic scanner which is used to perform generic patient medical imaging, which is/are functions that the imaging scanner generically performs. Therefore, the imaging scanner in combination with the other recited structure does not result in significantly more.

Final Act. 6⁵

For the aforementioned reasons, the Examiner concludes that claims 1–8, 11–13, 15, and 41–46 are not patent eligible under 35 U.S.C. § 101. We review this rejection *de novo* by applying the 2019 Revised Guidance.

The Judicial Exception

STEP 2A, PRONG ONE

Under the 2019 Revised Guidance (1), we identify the specific claim limitations which **recite** an abstract idea, including certain groupings of abstract ideas, in particular: (a) mathematical concepts, (b) mental steps, and (c) certain methods of organizing human activities.

We conclude that the first two “obtaining steps” of method claim 1 collect or gather information. However, courts have found such data gathering to be insignificant extra-solution activity. *See, e.g., In re Bilski*,

⁵ *See Spec.* 14–15:

The user of the system 102 can select a candidate relevant additional concept and employ and/or save the *resulting protocol for the patient*. The protocol can be conveyed from the computing system 102 to another system such as the *imaging scanner* that will . . . scan the patient using proprietary and/or standard approaches such as by encoding the protocol as a RIS Procedure ID and transmitting via the DICOM modality worklist. The protocol can be automatically loaded and loaded via user interaction. (emphasis added).

545 F.3d 943, 963 (Fed. Cir. 2008) (*en banc*), *aff'd sub nom Bilski v. Kappos*, 561 U.S. 593 (2010) (Characterizing data-gathering steps as insignificant extra-solution activity.).

In contrast, we agree with the Examiner that the two steps of “identifying” recite an abstract idea. Final Act. 4. Applying the 2019 Revised Guidance, we conclude such “identifying” falls within the category of mental processes, i.e., concepts performed in the human mind (including an observation, evaluation, judgment, or opinion).

Although the recited step of “selecting an imaging protocol for the imaging procedure from imaging protocols recommended for the missing medical concepts” could be performed as a mental step, courts have found that *selecting* a particular *data source* or *data type* to be manipulated is also insignificant extra-solution activity. *See, e.g., Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1328–29 (Fed. Cir. 2017) (Using XML tags to form an index is token extra-solution activity.); *see also* MPEP § 2106.05(g).

We particularly focus our analysis on the last “generating” step of independent method claim 1: “*generating a signal indicative of the selected imaging protocol that configures an imaging scanner to scan the patient*” (emphasis added). We conclude that this last step could not reasonably be performed as a mental step, because of the positively recited *signal* that *configures the imaging scanner*.

As noted above, we conclude that the two steps of “identifying” recite abstract ideas which could be performed as mental steps. *See* Claim 1. Thus, method claim 1 recites an abstract idea (mental steps). Similarly, we conclude the “identify” and “determine” functions of “computing system”

independent claim 15 could be performed as mental steps. Therefore, remaining independent claim 15 also recites an abstract idea.

To the extent Appellants advance arguments regarding *Mayo/Alice* step one, which also fall under the 2019 Revised Guidance (2) (covering MPEP §§ 2106.05(a)–(c) and (e)–(h)), we address these arguments *infra*.

Integration of the Judicial Exception into a Practical Application

STEP 2A, PRONG TWO

Independent Method Claim 1 and

Dependent Method Claims 2–8, 11–13, 43, 44, and 46

In applying the 2019 Revised Guidance (2), and for the reasons which follow, we conclude that Appellants’ method claims 1–8, 11–13, 43, 44, and 46 integrate the judicial exception into a practical application. In particular, for method claims 1–8, 11–13, 43, 44, and 46, an analysis under MPEP § 2106.05(b) (“Particular Machine”) provides a *useful and important clue*. See *Bilski*, 561 U.S. at 604. We emphasize that although the application of a judicial exception by or with a particular machine provides an important clue, it is not a stand-alone test for eligibility. *Id.*

Appellants contend:

The claims are directed to selecting an imaging protocol for the imaging procedure based on a combination of the medical concepts from the first electronically formatted medical information and the missing medical concepts, and *generating a signal indicative of the selected imaging protocol that configures an imaging scanner to scan the patient. The imaging protocol, imaging scanner and electronically formatted medical information are not abstract ideas. The claims are inherently tied to an electronic environment with electronically formatted*

medical information (processor and instructions explicit in independent claim 15) and to an imaging scanner (independent claim 1 and dependent claim 43, and claims 41 and 42 dependent from independent claim 15).

App. Br. 5 (emphasis added).

Appellants point to an alleged error by the Examiner: “The Office on page 11 appears to confine the abstract idea to a general-purpose computer. The imaging protocol selection viewed in light of the [S]pecification cannot be confined to a general-purpose computer. *The claims recite an imaging scanner, which is not a general-purpose computer.*” App. Br. 9 (emphasis added).

Appellants are correct that independent method claim 1, and claims 2–8, 11–13, 43, 44, and 46, which variously depend from claim 1, “*recite an imaging scanner, which is not a general-purpose computer.*” *Id.* (emphasis added). *See supra*, n.5, describing the claimed imaging scanner in the Specification 14–15. We note that dependent method claims 2–8, 11–13, 43, 44, and 46 include the “imaging scanner” limitation by virtue of their dependency from claim 1.⁶ This issue is not in dispute, because the Examiner expressly finds “[a]n imaging scanner is claimed, which is not [a] generic computer structure,” as indicated above. Final Act. 6.

As noted above, we conclude the last step of method claim 1 (“generating a signal indicative of the selected imaging protocol that configures an imaging scanner to scan the patient”) could not reasonably be performed as a mental step, because of the *signal* that is positively recited as

⁶ *See* Pre-AIA 35 U.S.C. § 112, fourth paragraph (“A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.”).

configuring the imaging scanner.

Significantly, we find the recited “*signal . . . that configures an imaging scanner*” (*id.*) ties *method* claims 1–8, 11–13, 43, 44, and 46 to a particular machine.⁷ To the extent the “imaging scanner” recited in method claim 1 might *arguendo* be construed as a generic “imaging scanner,” we find the “imaging scanner” becomes a *particular machine* when the generated signal *configures the imaging scanner* to scan the (particular) patient, within the scope of independent method claim 1, under a broad but reasonable interpretation.⁸

As emphasized above, the application of a judicial exception by a *particular machine* provides an important clue for *method* (process) claims; however, it is not a stand-alone test for eligibility, and is inapplicable to the remaining “computing system” claims 15, 41, 42, and 45, which we address separately, *infra*.

⁷ MPEP § 2106.05(b) provides further guidance regarding what constitutes a particular machine: “[A]s described in MPEP § 2106.05(f), additional elements that invoke computers or other machinery merely as a tool to perform an existing process will generally not amount to significantly more than a judicial exception. *See, e.g., Versata Development Group v. SAP America*, 793 F.3d 1306, 1335 . . . (Fed. Cir. 2015) (explaining that in order for a machine to add significantly more, it must ‘play a significant part in permitting the claimed method to be performed, rather than function solely as an obvious mechanism for permitting a solution to be achieved more quickly’).”

⁸ We give the contested claim limitations the broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

We additionally find that configuring the imaging scanner for a patient (having *individualized* medical needs) as a result of “generating a signal indicative of the selected imaging protocol” is a *meaningful limitation* that goes beyond merely linking the use of the judicial exception to a particular technological environment. *See* MPEP § 2106.05(e) (“Other Meaningful Limitations”). As noted in the Specification:

The selection of the *most adequate imaging protocol* for a given patient is *based upon the available information from the patient clinical record*. The record includes the current imaging order from a referring physician, which contains the “clinical indications” that caused the patient to be referred to imaging. Spec. 2 (emphasis added).

Thus, in accordance with *method* claim 1, the imaging scanner is *configured* specifically for a patient having *individualized* medical needs, as a result of “generating a signal indicative of the selected imaging protocol.”

Therefore, we agree with Appellants’ contention that at least *method* claims 1–8, 11–13, 43, 44, and 46 are “subject matter eligible as the claims are tied to ‘an imaging scanner to scan the patient,’” i.e., a particular machine. App. Br. 6. And the claimed “generating a signal” step of *method* claim 1 provides a meaningful limitation under MPEP § 2106.05(e).

Accordingly, we conclude that Appellants’ *method* claims 1–8, 11–13, 43, 44, and 46 **integrate the judicial exception into a practical application.**

For at least these reasons, we are constrained on this record to reverse the Examiner’s rejection under 35 U.S.C. § 101 of *method* claims 1–8, 11–13, 43, 44, and 46.

STEP 2A, PRONG TWO (CONTINUED)

*Independent “Computing System” Claim 15, and
Dependent “Computing System” Claims 41, 42, and 45*

For the reasons which follow, we conclude “computing system” claims 15, 41, 42, and 45 **do not** integrate the judicial exception into a practical application. *See* MPEP §§ 2106.05(a)–(c) and (e)–(h). Although we have considered all of Appellants’ arguments that may pertain to “computing system” claims 15, 41, 42, and 45, we find that none of Appellants’ arguments that may be applicable under MPEP §§ 2106.05(a)–(c) and (e) are persuasive or dispositive for at least the following reasons:

In contrast to independent *method* claim 1, independent “computing system” claim 15 is silent regarding any mention of “generating a *signal indicative of the selected imaging protocol that configures an imaging scanner to scan the patient.*” Claim 1 (emphasis added).

Instead, independent “computing system” claim 15 recites: “a display configured to *display the missing medical concept and the determined at least one scan protocol.*” (emphasis added). Merely displaying the “missing medical concept” and the “determined” scan protocol on a display, without more, is just the display of non-functional descriptive material (NFDM) *intended for human viewing.*

The MPEP provides applicable guidance: “where the claim as a whole is directed to conveying a message or meaning to a human reader independent of the intended computer system, and/or the computer-readable medium merely serves as a support for information or data, no functional relationship exists.” MPEP § 2111.05 (III.) (9th Ed., Rev. 08.2017, Last Revised Jan. 2018); *see also Ex parte Nehls*, 88 USPQ2d 1883, 1889 (BPAI

2008) (precedential) (“[T]he nature of the information being manipulated does not lend patentability to an otherwise unpatentable computer-implemented product or process.”).

Therefore, in applying the guidance of the aforementioned cited MPEP section, and the controlling guidance of *Nehls*, we broadly but reasonably construe the recited displayed “missing medical concept and the determined at least one scan protocol,” as non-functional descriptive material *merely intended for human perception*. Independent Claim 15.

In contrast to *method* claims 1–8, 11–13, 43, 44, and 46, as discussed above, we find none of Appellants’ arguments that may be applicable under MPEP §§ 2106.05(a)–(c) and (e) are persuasive regarding “computing system” claims 15, 41, 42, and 45.

In light of the foregoing, we conclude, under the 2019 Revised Guidance, that each of Appellants’ “computing system” claims 15, 41, 42, and 45, considered as a whole, is directed to a patent-ineligible abstract idea that is **not integrated** into a practical application.

STEP 2B—*The Inventive Concept*

“Computing System” Claims 15, 41, 42, and 45

The Examiner finds the claimed functions are “well-understood, routine, and conventional activities previously known to the pertinent industry (i.e., obtaining data, identifying data, selecting data, generating data, determining data, comparing data, discarding data, sorting data, displaying data, receiving data, providing data).” Final Act. 6 (emphasis omitted). The Examiner further finds “[t]here is no indication that the

combination of elements improves the functioning of a *computer* or improves any other technology.” *Id.* (emphasis added).

Appellants disagree: “The claims are not routine or conventional practice. As noted on page 1 of the [S]pecification, conventional practice is for a radiologist to review an order and assign an imaging protocol for the patient based on the specific clinical indications indicated in the order.”

App. Br. 6. Appellants then attempt to distinguish the claims over the previously cited Unger reference; however, there is no rejection over prior art before us on appeal. *Id.*

The Examiner responds: “the Appellant[s are] essentially making a novelty/nonobviousness argument by arguing that: because the claimed invention is not routinely performed (i.e., is novel/non-obvious), ‘significantly more’ must be present. This argument has been routinely held by the courts to be non-persuasive.” Ans. 7. The Examiner correctly cites to *Diehr*, 450 U.S. at 188–89 in support.⁹

Regarding *Step 2B*, the inventive concept, Appellants assert: “Said specific and definite claim limitation subject matter is not ‘well-understood,’ ‘routine’ or ‘conventional’ in the field of medical informatics used in selecting an imaging protocol for an imaging procedure.” Reply Br. 6.

⁹ “The ‘novelty’ of any element or steps in a process, or even of the process itself, is of *no relevance* in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diehr*, 450 U.S. at 188–89 (emphasis added). Our reviewing court further emphasizes that “[e]ligibility and novelty are separate inquiries.” *Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017); *see also Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1263 (Fed. Cir. 2016) (Holding that “even assuming” that a particular claimed feature was novel does not “avoid the problem of abstractness.”).

Berkheimer v. HP Inc., 881 F.3d 1360 (Fed. Cir. 2018)

Under the 2019 Revised Guidance, 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 adds a specific limitation beyond the judicial exception that is not “well-understood, routine, and conventional” in the field (*see* MPEP § 2106.05(d)); **or**, simply appends well-understood, routine, and conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

We note that *Berkheimer* was decided by the Federal Circuit on February 8, 2018. Appellants’ Reply Brief was filed almost two months earlier, on December 19, 2017. On April 19, 2018, the PTO issued the Memorandum titled: “Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*)” (hereinafter “*Berkheimer* Memorandum”).¹⁰

The *Berkheimer* Memorandum provided specific requirements for an Examiner to support with evidence any finding that *claim elements* (or a *combination of elements*) are well-understood, routine, and conventional. In reviewing the prosecution history, we recognize that Appellants have not yet had an opportunity to advance arguments based upon the change in the law effected by *Berkheimer*.

However, regarding the use of the recited generic “computing system” and “one or more processors” recited in independent claim 15, the Supreme

¹⁰ Robert W. Bahr, *Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (Berkheimer v. HP, Inc.)*, USPTO 1–5 (2018), <https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF>.

Court has held “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 573 U.S. 208, 223. Our reviewing court provides additional guidance, including in *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1096 (Fed. Cir. 2016) (“the use of generic computer elements like a microprocessor or user interface do not alone transform an otherwise abstract idea into patent-eligible subject matter”); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (claims reciting, *inter alia*, sending messages over a network, gathering statistics, using a computerized system to automatically determine an estimated outcome, and presenting offers to potential customers found to merely recite “well-understood, routine conventional activit[ies]” by either requiring conventional computer activities or routine data-gathering steps (alteration in original, internal citation omitted)).

Accordingly, on the record before us, Appellants have not shown that “computing system” claims 15, 41, 42, and 45 add a specific limitation, beyond the judicial exception, that is more than what was “well-understood, routine, and conventional” in the field (*see* MPEP § 2106.05(d)).

We emphasize the *Bilski* machine-or-transformation test discussed above (regarding method claim 1) is only applicable to process (method) claims, and thus is inapplicable to independent claim 15, which recites a system (apparatus): “A computer system, comprising” (Preamble, claim 15).

In light of the foregoing, we conclude, under the 2019 Revised Guidance, that each of Appellants’ “computing system” claims 15, 41, 42, and 45, considered as a whole, is directed to a patent-ineligible abstract idea

that is **not integrated** into a practical application, and **does not include an inventive concept**.

Accordingly, for the reasons discussed above, we sustain the Examiner’s rejection under 35 U.S.C. § 101 of independent “computing system” claim 15, and claims 41, 42, and 45, which variously depend therefrom.¹¹

CONCLUSIONS

The Examiner erred in rejecting *method* claims 1–8, 11–13, 43, 44, and 46 under 35 U.S.C. § 101, as being directed to a judicial exception, without significantly more.

The Examiner did not err in rejecting “*computing system*” claims 15, 41, 42, and 45 under 35 U.S.C. § 101, as being directed to a judicial exception, without significantly more.

¹¹ To the extent Appellants have not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

We reverse the Examiner's decision rejecting claims 1–8, 11–13, 43, 44, and 46 under 35 U.S.C. § 101.

We affirm the Examiner's decision rejecting claims 15, 41, 42, and 45 under 35 U.S.C. § 101.

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).

AFFIRMED-IN-PART