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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT H. LORSCH¹

Appeal 2018-002302
Application 13/858,665
Technology Center 3600

Before BIBHU R. MOHANTY, KENNETH G. SCHOPFER, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1, 5, 8–11, 14, and 16–18 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

¹ Appellant identifies the real party in interest as MyMedicalRecords, Inc. App. Br. 4.

THE INVENTION

The Appellant's claimed invention is directed to a method for users to integrate health records and genomic testing (Spec., page 1, lines 16–18).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method comprising:
 - receiving genomics data of an individual from a laboratory genomics testing facility into a genomics folders of a personal health record stored on a server, the personal health record associated with a password protected user account of the individual;
 - storing the genomics data in the genomics folders at the server;
 - providing a user interface associated with the password protected user account to the individual, the user interface allowing the individual to access the genomics data of the individual through the user interface associated with the password protected user account, wherein the user interface comprises a plurality of screens configured to allow the user to collect, organize, and store health records of the user including emergency information, laboratory test data including the genomics data, vaccinations and prescription data;
 - analyzing, via an analysis system, the genomics data stored in the genomics folder at the server with disease and health condition data stored on a predictive medical database relating to the genomics data to determine a susceptibility profile of the individual; and
 - generating the predictive medical report from the susceptibility profile of the individual; and
 - placing the predictive medical report in the password protected user account of the individual, wherein a second password may be associated with the genomics folder to access the predictive medical report and the genomics data when placed in the genomics folder.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 1, 5, 8–11, 14, and 16–18 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

2. Claims 1, 5, and 8–10 are rejected under 35 U.S.C. § 103(a) as unpatentable over Fey (US 2002/0052761 A1, published May 2, 2002 (“Fey”)) and Hirano (US 2005/0159984 A1, published July 21, 2005 (Hirano)).

3. Claims 11, 14, and 16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Fey and Gmelin (US 2005/0216311 A1, published September 29, 2005 (“Gmelin”)).

4. Claim 17 is rejected under 35 U.S.C. § 103(a) as unpatentable over Fey, Hirano, and Oesterheld (US 2013/0066649 A1, published March 14, 2013 (“Oesterheld”)).

5. Claim 18 is rejected under 35 U.S.C. § 103(a) as unpatentable over Fey, Gmelin, and Oesterheld.

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.²

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellant argues that the rejection of claim 1 is improper because the claim is not directed to an abstract idea and additionally provides “significantly more” than any alleged abstract idea (App. Br. 12–18; Reply Br. 11–19).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

In contrast, the Examiner has determined that the rejection of record is proper (Final Act. 3, 4; Ans. 4–6).

We agree with the Examiner. 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. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In judging whether claim 1 falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–78 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. If so, we then consider the elements of the claim both individually and as “an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application of the abstract idea. *Id.* This is a search for an “inventive concept” an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.* The Court also stated that “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Id.* at 2358.

Here, we determine that the claim is directed to the concept of storing health data for an individual and analyzing the data to make a medical report that can be accessed by the individual. This is a method of organizing human activities and a fundamental economic practice long prevalent in our

system of commerce and is an abstract idea beyond the scope of § 101. *See Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) where collecting information, analyzing it, and displaying results from certain results of the collection and analysis was held to be an abstract idea. *See also In re Meyer*, 688 F.2d 789, 795–96 (CCPA 1982), which held that “a mental process that a neurologist should follow” when testing a patient for nervous system malfunctions was not patentable.

We next consider whether additional elements of the claim, both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the abstract idea using generic computer components. We conclude that it does not. For example, the Specification at pages 8 and 9 describes using servers and a computing device in a conventional manner for their known functions.

Considering each of the claim elements in turn, the function performed by the computer system at each step of the process is purely conventional. Each step of the claimed method does no more than require a generic computer to perform a generic computer function.

For these above reasons the rejection of claim 1 is sustained. The Appellant has provided the same or similar arguments for the remaining claims, which are drawn to similar subject matter, and the rejection of these claims is sustained as well.

Rejection under 35 U.S.C. § 103(a)

The Appellant argues that the rejection of claim 1 is improper because the genomics data is not non-functional descriptive material; fails to identify a known method to combine Fey and Hirano to arrive at the claimed invention; that the cited combination would require changing the principle of operation of Fey; and that there is no reasonable expectation of success in the combination (App. Br. 21–28; Reply Br. 27–30).

In contrast, the Examiner has determined the rejection to be proper (Final Act. 4, 5; Ans. 6–8).

We agree with the Examiner and adopt the rationale for the rejection of record. Here, in claim 1 the term “genomics data” is non-functional descriptive material that does not change how the underlying substrate functions. Fey also does disclose “genetic health data management system” in the Abstract as used in the combination. We have reviewed the Appellant’s arguments that the cited combination is improperly made and would change the operation of the Fey reference but disagree and determine that the combination is properly made for the reasons set forth in the rejection of record, and accordingly the rejection of claim 1 is sustained.

The Appellant provides similar arguments for claim 11, but also further argues that Gmelin does not teach or suggest “sending a fax comprising the lab data from the personal health record system and the predictive medical report as specified by the user using the user interface of the personal health record system” (App. Br. 32–34).

In contrast, the Examiner has determined that this claim limitation is met in the combination Gmelin at para. 24 and known data transmission (Final Act. 7).

We agree with the Examiner's determination that Gmelin teaches the use of fax transmissions and that known data transmission techniques would have been obvious in the cited combination in the rejection of record. The Appellant's remaining arguments for claim 11 are similar to those made for claim 1 addressed above. Here, we have reviewed the Appellant's arguments for claim 11 but deem the rejection of record to be properly made and adopt the rationale set forth in the rejection. Accordingly, the rejection of record is sustained.

The Appellant has provided the same or similar arguments for the remaining rejected claims and the rejection of these claims is sustained for the same reasons given above.

CONCLUSIONS OF LAW

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 1, 5, 8–11, 14, and 16–18 under 35 U.S.C. § 101.

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 1, 5, 8–11, 14, and 16–18 under 35 U.S.C. § 103(a) as listed in the Rejections section above.

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DECISION

The Examiner's rejection of claims 1, 5, 8–11, 14, and 16–18 is sustained.

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

AFFIRMED