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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 KOEHL, SUDHEENDRA V. GALGALI,
WENDY A. NEU, and WILLIAM J. WYNNE
_____

Appeal 2018-004935
Application 14/149,646
Technology Center 3600
_____

Before PHILIP J. HOFFMANN, BRUCE T. WIEDER, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

HOFFMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the
Examiner's rejection of claims 2–7 and 9–11. We have jurisdiction under
35 U.S.C. § 6(b).

We AFFIRM.

Appellant's disclosure "involves the transfer of data in electronic
messages with no loss of semantic data and/or other metadata or other

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[1] We use the word "Appellant" to refer to "applicant" as defined in
37 C.F.R. § 1.42. Appellant identifies the real party in interest as Quest
Diagnostics Investments Incorporated. Appeal Br. 1.

meaning associated with the data, with application to the transfer of medical data." Spec. ¶ 4. Below, we reproduce independent claim 2 as illustrative of the appealed claims.

> 2.   A method of duplicating data, comprising:
> receiving an electronic message that comprises at least one reference that uniquely specifies one or more electronic records that represent a set of data;
> presenting the electronic message to a recipient at a first computer system;
> in response to input to the first computer system, using the at least one reference to automatically retrieve one or more of the electronic records;
> based on the retrieved records, presenting at the first computer system some or all of the data comprised by the set of data, the recipient lacking access privileges to read or copy the electronic records but for the existence of the electronic message and further lacking access privileges to read or copy the electronic records except through one or more of the references; and
> in response to further input to the first computer system, creating a persistent copy of some or all of the electronic records.

REJECTIONS AND PRIOR ART

The Examiner rejects the claims as follows:[2]

I.   Claims 2–7 and 9–11 under 35 U.S.C. § 101 as reciting only patent-ineligible subject matter; and

II.   Claims 2–7 and 9–11 under 35 U.S.C. § 103(a) as unpatentable based on Weidner[3] and Heere.[4]

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[2] Although the Non-final Office Action includes an indefiniteness rejection, the Examiner withdraws this rejection in the Answer. Non-final Action 6–7; Answer 3.
[3] Weidner et al., US 2005/0108058 A1, published May 19, 2005.
[4] Heere et al., US 2005/0148849 A1, published July 7, 2005.

PRINCIPLES OF LAW CONCERNING 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 has long interpreted 35 U.S.C. § 101 to include implicit exceptions, however: "[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) (citation omitted).

In determining whether a claim falls within an excluded category, the Supreme Court's two-step framework, described in *Mayo* and *Alice*, guides us. *See 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." *Id.* 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 that the courts 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 that the courts 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*, although the claim at issue recited a mathematical formula, 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."). Nonetheless, 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.*

2019 Revised Patent Subject Matter Eligibility Guidance

In early 2019, the U.S. Patent and Trademark Office published revised guidance on the application of § 101. *See 2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) ("Guidance"). Under that 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 activity such as i) a fundamental economic practice, or ii) managing personal behavior or relationships or interactions between people, or mental processes); 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, Jan. 2018)).

A practical application "appl[ies], rel[ies] on, or use[s] 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." Guidance, 84 Fed. Reg. at 54.

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 either:

> (3) adds a specific limitation beyond the judicial exception which is not "well-understood, routine, [or] conventional" in the field (*see* MPEP § 2106.05(d)); or

> (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 generally Guidance.

ANALYSIS

Rejection I—Eligibility rejection of claims 2–7 and 9–11

Initially, we note that Appellant argues against the Examiner's § 101 rejection of the claims as a group. Appeal Br. 5–11. We choose independent claim 2 for our analysis, and the remaining claims stand or fall with claim 2. *See* 37 C.F.R. § 41.37 (c)(1)(iv). For the following reasons, based on our review of the record, we sustain the Examiner's rejection of the claims as patent-ineligible.

We determine that in accordance with point (1) of the Guidance referenced above, independent claim 2 recites at least one judicial exception, including an abstract idea. More specifically, as described in further detail, the abstract idea includes certain methods of organizing human activity, in particular managing personal behavior or relationships or interactions between people.

As set forth in Appellant's Specification, the "invention relates to the use of electronic messages to transfer data. "Many forms of electronic messaging are well known, *e.g.*, electronic mail (or email) and instant messaging. For example, depending on the system, email may comprise a system for sending asynchronous messages to one or more users." Spec. ¶ 6. A person may use a computer to send an electronic message to another person, who reviews the message on a computer. *E.g., id.* ¶ *15*. Thus, Appellant's Specification describes the abstract idea of managing the behavior of a person accessing records, as well as interactions between a person creating a record and a person accessing the record, through the sending and receiving of electronic messages. *Id.* ¶¶ 7–8.

This abstract idea of managing personal behavior or relationships or interactions between people is set forth in independent claim 2. Claim 2 recites a "method of duplicating data" (Appeal Br., Claims App. (Claim 2)) comprising: (1) providing a reference to a specific record (i.e., "receiving an electronic message that comprises at least one reference that uniquely specifies one or more electronic records that represent a set of data") (*id.*); (2) presenting that reference to a person who, as set forth below, otherwise lacks permission to access the specific record (i.e., "presenting the electronic message to a recipient at a first computer system") (*id.*); (3) having that person use the reference to retrieve the specific record (i.e., "in response to input to the first computer system, using the at least one reference to automatically retrieve one or more of the electronic records") (*id.*); (4) permitting the person to read or copy data in the specific record only because the person has the reference (i.e., "based on the retrieved records, presenting at the first computer system some or all of the data comprised by the set of data, the recipient lacking access privileges to read or copy the electronic records but for the existence of the electronic message and further lacking access privileges to read or copy the electronic records except through one or more of the references") (*id.*); and allowing the person to copy some data in the record (i.e., "in response to further input to the first computer system, creating a persistent copy of some or all of the electronic records") (*id.*).

Accordingly, claim 2 describes a method of organizing human activity, by managing the behavior of a person accessing records, and managing interactions between a person accessing a record and the person

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who created or sent the record, which is an abstract idea. *See* MPEP § 2106.04(a)(2)(II)(A) and the supporting case law cited therein.

In accordance with point (2) of the Guidance referenced above, claim 2 does not recite any additional element that integrates the judicial exception into a practical application—i.e., something that "appl[ies], rel[ies] on, or use[s] 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." Guidance at 54; *see also Alice*, 573 U.S. at 223–24. Aside from the abstract idea described above, the claim only generically recites the use of certain physical hardware—a first computer system—and, thus, this hardware does not meaningfully limit the claim. Further, in the Specification, Appellant does not describe the first computer system in such a way as to indicate that the hardware is anything other than generic. Instead, Appellant describes the computer system as including generic, well-known components. For example, Appellant's Specification describes that the computer system "may support interaction with the user interface by well-known means for interacting with computer systems, which may comprise accepting user input via a pointing device such as a mouse and a keyboard and displaying output on a computer monitor." Spec. ¶ 72.

Thus, claim 2 does not integrate the non-abstract portion of the claim into a practical application, and does not affect an improvement in any technology or technical field.

Therefore, for the above reasons, independent claim 2 is directed to the above-discussed abstract idea, and does not integrate the judicial exception into a practical application.

In accordance with points (3) and (4) of the Guidance referenced above, claim 2 fails to recite a specific limitation beyond the judicial exception which is not well understood, routine, and conventional in the field, but instead simply appends well-understood, routine, and conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. Taking the claim elements separately, the claimed hardware and the functions performed by the claimed hardware are purely conventional. Specifically, claim 2 does not recite anything other than using known, conventional components to perform their known, basic functions. Although, arguably, the actual information differs, the claim recites the hardware only at a high level of generality. Restated, here the claim recites only well-understood, routine, and conventional functions. *See In re Katz*, 639 F.3d 1303, 1316 (Fed. Cir. 2011) ("Absent a possible narrower construction of the terms 'processing,' 'receiving,' and 'storing,' . . . those functions can be achieved by any general purpose computer without special programming.").

Further, when considered as an ordered combination, claim 2's limitations do not add anything that is not already present when we consider the steps separately. The hardware and its technological configuration remain the same before, during, and after duplicating data. Thus, the claim amounts to nothing significantly more than instructions to apply the abstract idea with conventional hardware, and does not require an improved version or arrangement of the recited hardware. Accordingly, the claim recitations are insufficient to transform the abstract idea into a patent-eligible invention. *See Alice*, 573 U.S. at 225–26.

We have considered all of Appellant's arguments in the Briefs, but Appellant does not persuade us that the claim recites patent-eligible subject matter. *See* Appeal Br. 5–11; *see* Reply Br. 2–6. To the extent that the above discussion does not address particular arguments made by Appellant in the Briefs, we now address certain arguments below.

Appellant's arguments with reference to *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), are not persuasive of error. See Appeal Br. 8–10. In *BASCOM*, the Federal Circuit did indicate that it is sometimes possible for "an inventive concept" to reside in "the non-conventional and non-generic arrangement of known, conventional pieces," such as "a set of generic computer components." *BASCOM*, 827 F.3d at 1350. However, as explained above, there is nothing in Appellant's Specification or claim to indicate that the computer component recited in Appellant's claim 2—a first computer system— is arranged in anything other than a conventional and generic manner.

Appellant's arguments with respect to *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016) also are unpersuasive. Appeal Br. 6, 8–9. Unlike Appellant's claims, the claims in *Enfish* recited a "specific improvement to the way computers operate"—i.e., an improved database configuration that permitted faster and more efficient searching. *Id.* at 1330–33, 1336. The Federal Circuit later explained that the claims in *Enfish* "did more than allow computers to perform familiar tasks with greater speed and efficiency" but "actually permitted users to launch and construct databases in a new way." *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1305 (Fed. Cir. 2018). The Federal Circuit also explained that the claims in *Enfish* "focused on an improvement to computer functionality

itself, not on economic or other tasks for which a computer is used in its ordinary capacity." *Secured Mail Sols. LLC v. Universal Wilde, Inc.*, 873 F.3d 905, 910 (Fed. Cir. 2017). In contrast, Appellant's claim 2 may improve the abstract idea of duplicating data, but Appellant's claim does not recite an improvement in the way the non-abstract hardware performs such a task.

Rejection II—Obviousness rejection of claims 2–7 and 9–11

With respect to independent claim 2, Appellant argues that the Examiner's rejection is in error for the following reasons:

> Specifically, no reference teaches or suggests, as [independent] claim 2 recites, receiving an electronic message that comprises at least one reference that uniquely specifies one or more electronic records that represent a set of data. Nor does any reference teach or suggest, as claim 2 further recites:

> the recipient lacking access privileges to read or copy the electronic records but for the existence of the electronic message and further lacking access privileges to read or copy the electronic records except through one or more of the references.

Appeal Br. 13; *see also id.* 13–15; *see also* Reply Br. 2–5. Based on our review of the record, however, Appellant does not persuade us that the Examiner errs.

Specifically, Appellant does not persuade us that Weidner's paragraph 48 fails to disclose the above claim recitations. *See, e.g.*, Answer 12. This portion of Weidner states, in relevant part,

> With a contact selected, a user can compose an email and include an attachment . . . . By including an attachment, the recipient will be allowed to review the patient record which is attached. The actual patient record need not be physically

attached to the email.   Rather, the attachment of the email
provides access/authorization to the particular patient record.
That is, the attachment can be an authorization
code/password/ID to access other dentist's records.   The
authorization can be a code/password/ID or metadata attached
to the particular patient record that recognizes that the recipient
can access that particular patient record.

Weidner ¶ 48.   Accordingly, we sustain the Examiner's obviousness rejection
of claims 2–7 and 9–11.

CONCLUSION

We AFFIRM the Examiner's § 101 rejection of claims 2–7 and 9–11.

We AFFIRM the Examiner's § 103(a) rejection of claims 2–7
and 9–11.

In summary:

Claims Rejected	35 U.S.C. §	Basis/Reference(s)	Affirmed	Reversed
2–7, 9–11	101	Eligibility	2–7, 9–11	
2–7, 9–11	103(a)	Weidner, Heere	2–7, 9–11	
Overall Outcome:			2–7, 9–11	

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.
§ 41.50(f).

AFFIRMED