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EXAMINER

SOREY, ROBERT A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SUMATHI PATURU

Appeal 2018-005576
Application 10/460,788
Technology Center 3600

Before ELENI MANTIS MERCADER, NORMAN H. BEAMER, and
ADAM J. PYONIN, *Administrative Patent Judges*.

PYONIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant¹ requests a rehearing of the Decision on Appeal mailed September 4, 2019 (the “Decision”), in which we affirmed the Examiner’s rejections of claims 13–20, 25, and 26 under 35 U.S.C. §§ 101 and 112, second paragraph. *See* Request for Rehearing filed October 28, 2019 (the “Request”). We have reconsidered the Decision in light of Appellant’s arguments; however, we are not persuaded of any error therein.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as the inventor, Sumathi Paturu. Appeal Br. 4

DISCUSSION

In the Decision, we affirmed the Examiner’s rejection of the claims as indefinite. *See* Decision 10–11. Additionally, we affirmed the Examiner’s rejection of the claims pursuant to the U.S. Patent Office’s recently published revised guidance on the application of 35 U.S.C. § 101. *See* Decision 6–10; *see also Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014) (Describing the two-step framework under 35 U.S.C. § 101, “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.”); USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Memorandum”).

Appellant requests rehearing of both parts of the decision. *See* Request 4. We discuss each of the statutory rejections, below.

A. Indefiniteness Rejection of Claims

Requests for Rehearing are limited to matters “believed to have been misapprehended or overlooked by the Board” in rendering the original decision. 37 C.F.R. § 41.52(a)(1). With respect to our decision regarding the Examiner’s indefiniteness rejection, the Request states that “[i]t is not clear why the Board had commented that the subject matter encompassed by claim 13 can not be reasonably understood without resort to speculation.” Request 30. Appellant additionally argues that “[t]he elaborate [claim 13] is all about scheduling and tracking.” *Id.*

The Examiner finds “[t]he plain language of claim 13 recites a ‘means of manually operable paper filings’, but then recites ‘means and methods,’” such that “is thus unclear whether the measures are a part of the means, an

article of manufacture, or whether the measures are the steps of a method.” Final Act. 5. The Examiner further finds “[c]laim 13 recites a ‘built in’ automated tracking system but it is not understood how of the claim works to schedule, screen, and track targeted patients,” as the meaning of “built in” is not clear. *Id.* at 6. The Examiner further identifies the claim terms “means of manually operable paper filings” and “similar means” as being unclear. *Id.* at 7.

We agree with the Examiner’s analysis. Appellant has not identified portions of the Specification that explain the meaning of the identified claim terms with sufficient clarity. *See* Ans. 6–7; *see also* Request 30–32. Accordingly, we are not persuaded we misapprehended or overlooked any points in determining “the subject matter encompassed by claim 13 cannot be reasonably understood without resort to speculation.” Decision 10; Final Act. 6.

Further, the Request states the following:

the Appellant redrafted the claims deleting the ‘objected terminology’ by the Board, as indeed they are not necessary for the invention to be effective and functional. They were introduced to draw the attention of the Board to some unique limitations of the invention that can be otherwise easily overlooked in the narrow confines of claim drafting. The amended claims are appended as Exhibit-1 for appraisal by the Board, not without the knowledge that the Primary Examiner is yet responsible for their entry and subsequent proceeds.

Request 5; *see also* “Exhibit-1” at Request 33–40. Appellant’s arguments refer to claim amendments that have not been entered, as acknowledged in the Request. *See* Request 5. Our review herein is limited to currently pending claims. *See* MPEP § 1206.

Appellant does not persuasively show we misapprehended or overlooked matters in rendering the original decision; thus, we are not persuaded the Examiner's indefiniteness rejection is in error. *See* Decision 10, 11.

B. Patent Ineligibility Rejection of Claims

1. Correction to Citation in the Decision

As a preliminary matter, the Request notes an incorrect quotation from Appellant's disclosure appearing in the Decision. *See* Request 11, 31; Decision 8. This quotation was used to support our determination that the claim "limitations replicate steps taken by a health care practitioner while interacting with a patient." Decision 7. Appellant is correct that the quote "was not contained in the specification of the Instant Invention." Request 11. Thus, we amend the citation on page 8 of the Decision to include the proper quote from the Specification. The correct citation should read: "*See, e.g.,* Fig. 1 (depicting a file); Spec. 13:14 ("After you fill in this data, make a photocopy and file in each section.>")."²

This correction does not alter our decision upholding the Examiner's rejection, which was based on the specific claim limitations pursuant to the USPTO guidance; the Specification was cited merely to support our determination that the claims recite a judicial exception. *See* Decision 7–8; Memorandum, 84 Fed. Reg. at 54.

² This citation is to the Specification as originally filed on June 13, 2003; we note that the file history contains numerous amendments to the Specification, and should there be further prosecution, the Examiner may wish to consider whether these amendments have introduced new matter into the disclosure of the application. *See* MPEP § 608.04.

2. Patent Ineligibility Arguments in the Request

Step 2A

Appellant argues the claims are eligible under Step 2A. *See* Request 8–29. Particularly, Appellant argues the claim limitations do not recite abstract concepts because they “are integrated into the filing as a ‘practical application.’” Request 9 (emphasis omitted). Appellant contends “[t]he JUDICIAL EXCEPTIONS of ‘data gathering and ‘data entry’ are not recited per se, and are ‘integrated’ into ‘additional elements’ of the ‘file and its components,’” making the claims “patent eligible under step 2A, prongs 1 and 2 of the 2019 Guidance.” Request 26, emphases omitted. Appellant contends that these “ADDITIONAL ELEMENTS apply or use the judicial exceptions” to “facilitate a ‘prophylaxis’ . . . for the breast, prostate[,] and colorectal cancers,” making the claims “eligible under Step 2 A, prong 2.” Request 26, emphasis omitted. *See also* Request 14–19.

Based on our review of the record, we are not persuaded of error in the Decision with respect to Step 2A, Prongs One and Two. In Prong One we “evaluate whether the claim recites a judicial exception, *i.e.*, an abstract idea, a law of nature, or a natural phenomenon.” Memorandum, 84 Fed. Reg. at 54. In the Decision, we identified particular limitations of claim 13 corresponding to “steps taken by a health care practitioner while diagnosing and treating a patient” as falling under the USPTO guidance as both “[c]ertain methods of organizing human activity” and “mental processes.” Decision 8.

Appellant argues that our Step 2A, Prong One analysis is incorrect because the preamble of claim 13 recites a “tracking system” and step (m) of claim 13 recites a “base substrate.” *See* Request 9–10. At best, these

limitations may be considered the use of a computer, which does not show we erred in determining the claim is directed to a judicial exception. *See* Decision 9 (“the limitations elaborate on the manner in which the abstract . . . [concepts] are to be performed,” and “even if any such [computer] technology was required, we determine the claim is ineligible pursuant to the Guidance.”); *see also* Final Act. 3; *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1335 (Fed. Cir. 2015) (“Courts have examined claims that required the use of a computer and still found that the underlying, patent-ineligible invention could be performed via pen and paper or in a person’s mind.”). Further, as we noted in the Decision, the preamble of claim 13 explicitly refers to “said method carried out by means of manually operable paper filings.” Decision 9. The use of a physical aid (pen and paper) to help perform a mental step does not negate the mental nature that is explicitly encompassed by the claim. *See* October 2019 Update: Subject Matter Eligibility at 9, noticed at 84 Fed. Reg. 55942 (Oct. 18, 2019).

Step 2B

Appellant argues the claims are eligible under Step 2B of the USPTO guidance. *See, e.g.*, Request 14, 15. Particularly, Appellant argues that “[t]he PROCESS STEPS of tracking” are “unlike any ‘file’ or ‘all files’” as there are “at least 25 . . . unconventional inventive concepts.” Request 26; *see also* Request 25. Appellant contends the “added elements of the Inventor devised ‘file compilation section’ and the added new combination of ‘process steps,’ amount to patentable inventive concepts.” Request 27 (emphasis omitted); *see also* Request 22 (regarding “the addition of the inventor devised elements of the ‘file compilation section’ and the resulted elements of new combination of process steps”). Appellant contends that

the “constitution of the papers / page numbers of the file” confine “the claim to a particular useful function” and fulfill “a long felt unresolved need.” Request 27 (emphasis omitted). Similarly, Appellant contends that “[r]elative to the prior art the file functions” confer a number of benefits, such as “greater than expected results.” Request 27 (emphasis omitted).

We are not persuaded of error in the Decision with respect to Step 2B. With respect to the currently pending claims, Appellant has failed to provide sufficient evidence or reasoning to persuade us we misapprehended or overlooked any points in determining the additional elements, individually and as an ordered combination, do not provide more than well-understood, routine, and conventional activities. *See* Decision 9, 10; Final Act. 9–11.

Additional Arguments

The Request includes arguments regarding case law and USPTO practice outside the context of a patent eligibility analysis under Section 101. *See* Request 13 (references to *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004) and MPEP § 2112.01), Request 23–24 (reference to MPEP § 716.02). Appellant contends such materials confer patent eligibility because of “fulfilling a long felt unresolved need” (Request 27, emphasis omitted), or other “inventive concepts” regarding “35 USC 102 and 103.” Request 27, emphasis omitted.

We are not persuaded of error in the Decision by these citations. Appellant’s arguments that the claims are patent eligible because they are otherwise novel and/or non-obvious are not persuasive. Although the second step in the *Alice* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness.

Alice, 573 U.S. at 217–18. A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent ineligible. *See Mayo*, 566 U.S. at 78–79. Further, “under the *Mayo/Alice* framework, a claim directed to a newly discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the novelty of that discovery for the inventive concept necessary for patent eligibility.” *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016).

Accordingly, we are not persuaded we overlooked or misapprehended any points in our Decision.

DECISION

We do not grant Appellant’s request because the outcome with respect to the claims is unchanged; however, we revise a citation appearing in our Decision as discussed above.

Outcome of Decision on Rehearing:

Claims	35 U.S.C. §	Reference(s)/Basis	Denied	Granted
13–20, 25, 26	101	Ineligible subject matter	13–20, 25, 26	
13–20, 25, 26	112(2)	Indefinite	13–20, 25, 26	
Overall Outcome			13–20, 25, 26	

Final Outcome of Appeal after Rehearing:

Claims	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
13–20, 25, 26	101	Ineligible subject matter	13–20, 25, 26	

Appeal 2018-005576
Application 10/460,788

13-20, 25, 26	112(2)	Indefinite	13-20, 25, 26	
Overall Outcome			13-20, 25, 26	

REHEARING DENIED