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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JOHN CELONA, JEFFREY BARR, and  
SHELDON X. WANG

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Appeal 2018-005762  
Application 14/082,694  
Technology Center 3600

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Before JENNIFER S. BISK, LARRY J. HUME, and  
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a) Appellant,<sup>1</sup> eHealthInsurance Services, Inc., appeals from the Examiner's decision to reject claims 1–20, which are all claims pending in the application. Final Act. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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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(a). Appellant identifies the real party in interest as eHealthInsurance Services, Inc. Appeal Br. 3.

## BACKGROUND<sup>2</sup>

Appellant's disclosed embodiments and claimed invention relate to "communicating insurance information to a user via a networked-based system." Spec. ¶ 7. Claim 1, reproduced below, is illustrative of the subject matter on appeal:

1. A method of communicating insurance information to a user via a network-based system, the method comprising:
  - [(1)] receiving, via a network from a user device, demographic details of a user;
  - [(2)] processing the demographic details to identify a plurality of available insurance plans for the user, the processing including accessing a database identifying the plurality of available insurance plans;
  - [(3)] identifying, using at least one hardware processor, a group of insurance plans from the plurality of available insurance plans based on historical insurance plan data stored in the database, the historical insurance plan data comprising data concerning applications submitted by other users for each of the plurality of available insurance plans; and
  - [(4)] communicating, via the network, the group via the network-based system to the user device for presenting the group via a graphical user interface of the user device.

Appeal Br. 30 (Claims App'x) (limitation numbering added).

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<sup>2</sup> Throughout this Decision we have considered the Specification filed November 18, 2013 ("Spec."), the Final Rejection mailed April 21, 2017 ("Final Act."), the Appeal Brief filed October 19, 2017 ("Appeal Br."), the Examiner's Answer mailed March 14, 2018 ("Ans."), and the Reply Brief filed May 14, 2018 ("Reply Br.").

## REJECTIONS

Claims 1–20 stand rejected for the judicially-created doctrine of nonstatutory obviousness-type double patenting as being unpatentable over claims 1–24 of US Patent No. 8,589,189 B2, issued Nov. 19, 2013. Final Act. 13.

Claims 1–20 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 5–8.

## ANALYSIS

We review the appealed rejections for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). To the extent Appellant has not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. 37 C.F.R. § 41.37(c)(1)(iv).

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

### *Rejection of Claims 1–20 for Nonstatutory Obviousness-Type Double Patenting*

The Examiner rejects claims 1–20 on the ground of non-statutory obviousness-type double patenting. Final Act. 13.

Appellant does not address this ground on the merits, but “proposes to defer resolution of the double patenting rejection until the patentable subject matter is agreed upon.” Appeal Br. 10. The Examiner does not address this rejection in the Answer and has not officially withdrawn the rejection in any other communication of record.

We, therefore, *pro forma* affirm the Examiner’s rejection of claims 1–20 on the ground of non-statutory obviousness-type double patenting.

*Rejection of Claims 1–20 under 35 U.S.C. § 101*

Section 101 of the Patent Act provides that “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” is patent eligible. 35 U.S.C. § 101. But the Supreme Court has long recognized an implicit exception to this section: “Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). To determine whether a claim falls within one of these excluded categories, the Court has set out a two-part framework. The framework requires us first to consider whether the claim is “directed to one of those patent-ineligible concepts.” *Alice*, 573 U.S. at 217. If so, we then examine “the elements of each 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.” *Alice*, 573 U.S. at 217 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78, 79 (2012)). That is, we examine the claims for an “inventive concept,” “an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 573 U.S. at 217–18 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

The Patent Office recently issued guidance regarding this framework. *See USPTO, 2019 Revised Patent Subject Matter Eligibility Guidance*, 84

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Fed. Reg. 50 (Jan. 7, 2019) (“Revised Guidance”). Under the Revised Guidance, to decide whether a claim is “directed to” an abstract idea, we evaluate whether the claim (1) recites subject matter falling within an abstract idea grouping listed in the Revised Guidance and (2) fails to integrate the recited abstract idea into a practical application. *See* Revised Guidance, 84 Fed. Reg. at 51. If the claim is “directed to” an abstract idea, as noted above, we then determine whether the claim recites an inventive concept. The Revised Guidance explains that when making this determination, we should consider whether the additional claim elements add “a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field” or “simply append[] well-understood, routine, conventional activities previously known to the industry.” Revised Guidance, 84 Fed. Reg. at 56.

With these principles in mind, we turn to the Examiner’s § 101 rejection.

#### *The Judicial Exception—Abstract Idea*

The Examiner states “the claims are directed to an abstract idea of receiving and processing demographic details to identify and present insurance plan options.” Final Act. 6. The Examiner explains that “the concept is abstract for organizing a human activity.” Ans. 3. For the reasons explained below, we agree that the claims recite an abstract idea.

As quoted and enumerated above, claim 1 includes four main limitations. These limitations recite, in part, the following steps: *receiving* user information (limitation (1)), *identifying* a group of insurance plans from a plurality of available insurance plans for the user based on historical insurance plan data (limitations (2) and (3)), and *communicating* the

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identified group to the user device for presentation to the user. Appeal Br. 30 (Claims App'x).

According to the Specification, the invention overcomes problems related to presenting a vast amount of detail related to health insurance simultaneously. Spec. ¶ 3. “[A] user seeking a health insurance plan can often be subjected to information overload.” *Id.* ¶ 4. “What is needed then is a process for presenting health insurance information that, on the one hand, complies with all of the regulations governing the sale of health insurance, and on the other is easy to understand.” *Id.* ¶6. Presenting health insurance plan to a user seeking such a plan falls within “advertising, marketing, or sales activities.” Revised Guidance, 84 Fed. Reg. at 52.

Limitations (1)–(4) together recite a business or commercial practice that is not meaningfully different from business and commercial practices that courts have determined are abstract ideas. *See, e.g., In re Salwan*, 681 F. App'x 938, 941 (Fed. Cir. 2017) (billing insurance companies and organizing patient health information); *Audatex N. Am., Inc. v. Mitchell Int'l, Inc.*, 703 F. App'x 986, 989 (Fed. Cir. 2017) (providing an automobile insurance claim valuation through the collection and use of vehicle information); *Accenture*, 728 F.3d at 1344 (generating tasks to be performed in an insurance organization based on rules to be completed upon the occurrence of an event); *Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Canada (U.S.)*, 687 F.3d 1266, 1280 (Fed. Cir. 2012) (managing a stable value protected life insurance policy by performing calculations and manipulating the results).

Accordingly, we conclude claim 1 recites a certain method of organizing human activity identified in the Revised Guidance (i.e., a

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commercial interaction), and thus, an abstract idea.<sup>3</sup> Revised Guidance, 84 Fed. Reg. at 52, 53 (listing “[c]ertain methods of organizing human activity . . . commercial or legal interactions” as one of the “enumerated groupings of abstract ideas”).

*Integration of the Judicial Exception into a Practical Application*

If a claim recites a judicial exception, we determine whether the recited judicial exception is integrated into a practical application of that exception by: (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application. If the recited judicial exception is integrated into a practical application, the claim is not directed to the judicial exception.

Here, claim 1 recites the additional elements of “a network-based system,” “a user device,” “a database,” “at least one hardware processor,” and “a graphical user interface.” Appeal Br. 30 (Claims App’x).

Considering claim 1 as a whole, the additional elements do not apply or use

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<sup>3</sup> Our reviewing court recognizes that “[a]n abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). That need not and, in this case does not, “impact the patentability analysis.” *Id.* at 1241. Further, “[a]n abstract idea can generally be described at different levels of abstraction. . . . The Board’s slight revision of its abstract idea analysis does not impact the patentability analysis.” *Id.* Moreover, merely combining several abstract ideas does not render the combination any less abstract. *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“Adding one abstract idea (math) to another abstract idea . . . does not render the claim non-abstract.”); *see also FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (determining the pending claims were directed to a combination of abstract ideas).

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the abstract idea in a meaningful way such that the claim as a whole is more than a drafting effort designed to monopolize the exception. The Supreme Court guides that the “prohibition against patenting abstract ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or [by] adding ‘insignificant postsolution activity.’” *Bilski*, 561 U.S. at 610–11 (quoting *Diamond v. Diehr*, 450 U.S. 175, 191–92 (1981)).

The Specification describes each of these elements as generic components. For example, the Specification states that “server 12 communicates via one or more networks, such as the Internet 16, with a plurality of client devices 18,” which “may, for example, include a personal computer (PC), a Personal Digital Assistant (PDA), a cellular telephone, or any other client device including a display.” Spec. ¶ 36. The recited “database” is described in the Specification simply as “associated” with a server and including information about insurance plans. *Id.* ¶¶ 31, 37, 40. The Specification also describes “a processor 302 (e.g., a central processing unit (CPU) a graphics processing unit (GPU) or both).” *Id.* ¶ 57.

Appellant’s arguments have not persuaded us claim 1 is “directed to” a patent-eligible concept. For example, Appellant argues the Examiner failed to establish a prima facie case of patent ineligibility. Appeal Br. 11–12; Reply Br. 3–5. We disagree. The Federal Circuit has repeatedly noted that “the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). The Examiner satisfies the burden of establishing a prima facie case under 35 U.S.C. § 132 by setting forth a rejection in a sufficiently articulate and informative manner. *See In re Jung*, 637 F.3d 1356, 1363

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(Fed. Cir. 2011). If the Examiner “adequately explain[s] the shortcomings . . . the burden shifts to the applicant to rebut the prima facie case with evidence and/or argument.” *Hyatt*, 492 F.3d at 1370.

The Final Office Action adequately explains the § 101 rejection. *See* Final Act. 5–8. The Examiner’s statements satisfy § 132(a) because they apply the *Alice* analytical framework and apprise Appellant of the reasons for the § 101 rejection under that framework. Appellant has not responded by alleging a failure to understand the rejection, but argues that the Examiner’s abstract idea “is not adequately tied to the claim language.” Appeal Br. 11. To the contrary, Appellant clearly identifies the abstract idea identified by the Examiner. *See* Appeal Br. 11; Reply Br. 4. Our reviewing court recognizes that “[a]n abstract idea can generally be described at different levels of abstraction.” *Apple*, 842 F.3d at 1240. That need not and, in this case does not, “impact the patentability analysis.” *Id.* at 1241.

Appellant adds that the Examiner did not apply the required two-step patentability analysis to each of the dependent claims. Appeal Br. 12. There is no dispute that the Guidance directs examiners to examine each claim individually. But consideration of each claim individually does not require a separate written analysis for each individual claim. We decline to find error here in the Examiner’s decision to not address the patent-eligibility of each of claims 2–20, individually, where, as the Examiner observes (Ans. 6), the claims all recite similar steps as part of the same abstract idea, i.e., the steps include “receiving details, processing the details, identifying [] data based on the received and processed details and presenting the details on a generic graphical user interface of the device.” *See Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014) (explaining that when all claims are directed to the same

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abstract idea, “addressing each claim of the asserted patents [is] unnecessary”).

In the Reply, Appellant argues

the specific features of the user interface recited by claims 13, 16, and 17 are significantly more than any of the purported abstract ideas and, indeed, improve the operation of the recited computer system, for example, by arranging it for the unique challenges of the health insurance market described at the specification.

Reply Br. 5. We do not agree that the limitations added by claims 13, 16, and 17 (displaying an icon (claim 13), receiving selections of an icon and displaying information in response (claim 16), and selections comprising a pointer hover and a pointer click (claim 17)) improve the operation of the recited computer system. Instead, we agree with the Examiner that “[h]ere, the claims do not invoke any assertedly inventive programming,” but simply “require[e] the selection and manipulation of information” to make that information easier for a human to understand. Ans. 5. The claims improve a process of arranging and presenting data, which, aside from conventional use of generic computer equipment (e.g. selection using a pointer device), could equally apply to the presentation of data using pen and paper. *See* Spec. ¶¶ 4 (“Users desire a simple user interface that clarifies the benefits offered by various health insurance providers.”), 5 (“What is needed then is a process for presenting health insurance information that, on the one hand, complies with all of the regulations governing the sale of health insurance, and on the other is easy to understand.”).

Appellant also argues that, like *McRO*, “the specific way in which the operations are performed prevents broad preemption of the subject matter.” Appeal Br. 15 (citing *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837

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F.3d 1299 (Fed. Cir. 2016)). First, we do not agree with Appellant’s analogy to *McRO*. The claims in *McRO* “focused on a specific asserted improvement in computer animation, i.e., the automatic use of rules of a particular type.” *McRO*, 837 F.3d at 1314. The rules were “limited” and had “specific characteristics,” and the claims incorporated “the specific features of the rules as claim limitations.” *McRO*, 837 F.3d at 1313, 1316.

In contrast, claim 1 recites a series of broadly worded results without meaningfully describing how the results are achieved. And claim 1 generally concerns arranging data for efficient presentation to a user, not improving a technological process such as computer animation like the claims in *McRO*. Claim 1 is thus distinguishable from the patent-eligible claims in *McRO*. Second, preventing preemption of subject matter does not alter our § 101 analysis. Rather than preemption, the Federal Circuit instructs that the *Alice* two-step analysis is the test for whether claims are statutory. “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). “Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Id.*

Accordingly, even in combination with all the other recited elements, the addition of “a network-based system,” “a user device,” “a database,” “at least one hardware processor,” and “a graphical user interface” does not integrate the abstract idea into a practical application because it does not impose any meaningful limits on practicing the abstract idea. For these reasons, we determine that claim 1 does not integrate the recited abstract idea into a practical application.

*Inventive Concept*

Because we agree with the Examiner that claim 1 is “directed to” an abstract idea, we consider whether an additional element (or combination of elements) adds a limitation that is not well-understood, routine, conventional (“WURC”) activity in the field or whether the additional elements simply append WURC activities previously known to the industry, specified at a high level of generality, to the judicial exception. Revised Guidance, 84 Fed. Reg. at 23. The Examiner’s finding that an additional element (or combination of elements) is WURC activity must be supported with a factual determination. *Id.* (citing MPEP § 2106.05(d), as modified by the *Berkheimer* Memorandum<sup>4</sup>).

Whether the additional elements (“a network-based system,” “a user device,” “a database,” “at least one hardware processor,” and “a graphical user interface”) are WURC activity is a question of fact. *See Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018) (“Whether something is well-understood, routine, and conventional to a skilled artisan . . . is a factual determination.”).

On the record before us, Appellant has not shown that the claims on appeal add a specific limitation beyond the judicial exception that is not “well-understood, routine, and conventional” in the field (*see* MPEP § 2106.05(d)). Other than asserting that the entirety of the claimed subject matter is unconventional, Appellant does not point to any particular claimed element that does not qualify as WURC. Reply Br. 5.

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<sup>4</sup> Robert W. Bahr, *Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision* (*Berkheimer v. HP, Inc.*) (2018) (hereinafter “*Berkheimer* Memorandum”).

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In fact, as explained by the Examiner (Final Act. 7) Appellant's Specification demonstrates the WURC nature of "a network-based system," "a user device," "a database," "at least one hardware processor," and "a graphical user interface" because it indicates they may be implemented with generic devices. Spec. ¶¶ 36, 57.

For these reasons, we conclude that claim 1, considered as a whole, does not include an inventive concept.

Therefore, we sustain the Examiner's § 101 rejection of independent claim 1. For the reasons discussed above, we also sustain the Examiner's § 101 rejection of dependent claims 13, 16, and 17. We also sustain the Examiner's § 101 rejection of independent claims 18 and 20 and dependent claims 2–12, 14, 15, and 19, for which Appellant relies on the same arguments made with respect to claim 1. Appeal Br. 10–23; Reply Br. 2–7.

#### DECISION

We affirm the Examiner's nonstatutory obviousness-type double patenting rejection of claims 1–20 as being unpatentable over claims 1–24 of US Patent No. 8,589,189 B2, issued Nov. 19, 2013.

We affirm the Examiner's rejection of claims 1–20 under 35 U.S.C. § 101.

DECISION SUMMARY

<b>Claims Rejected</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1-20	Double Patenting	1-20	
1-20	§ 101	1-20	

FINALITY AND RESPONSE

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. § 1.136(a)(1)(iv).

AFFIRMED