UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

Ex parte JASON LAWRENCE O'MEARA

_____

Appeal 2018-008264
Application 13/949,616[1]
Technology Center 3600

_____

Before ANTON W. FETTING, PHILIP J. HOFFMANN, and
BRUCE T. WIEDER, *Administrative Patent Judges*.

FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE[2]

Jason Lawrence O'Meara (Appellant[3]) seeks review under

35 U.S.C. § 134(a) of a final rejection of claims 16–20, the only claims

pending in the application on appeal. We have jurisdiction over the appeal

pursuant to 35 U.S.C. § 6(b).

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[1] Oral arguments were presented March 2, 2020.

[2] Our Decision will make reference to the Appellant's Appeal Brief
("Appeal Br.," filed April 26, 2018) and Reply Brief ("Reply Br.," filed
August 8, 2018), and the Examiner's Answer ("Ans.," mailed June 8, 2018),
and Final Action ("Final Act.," mailed September 25, 2017).

[3] 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).

The Appellant invented a way of optimizing the collection of specimens. Specification para. 4.

An understanding of the invention can be derived from a reading of exemplary claim 16, which is reproduced below (bracketed matter and some paragraphing added).

> 16. A method of collecting one or more biological samples from a patient for a plurality of laboratory tests with the aid of a digital computer system, comprising:
>
> [1] providing the digital computer system with a database of collection requirements that includes at least, for each of the plurality of laboratory tests, one or more container types, one or more container amounts, and one or more collection volumes;
>
> [2] providing the digital computer system with a requisition that identifies the patient and the plurality of laboratory tests;
>
> [3] the digital computer system retrieving from the database the collection requirements respectively associated with the laboratory tests and calculating therefrom a total number of containers into which a plurality of samples are to be collected from the patient;
>
> [4] the digital computer system determining that the total number of containers exceeds a collection limit;
>
> [5] applying a rules engine within the digital computer system to apply one or more optimizations to reduce the total number of containers;
>
> [6] repeatedly applying the rules engine within the digital computer system to apply one or more additional optimizations to further reduce the total number of containers until the collection cannot be further optimized or the optimized number of containers no longer exceeds the collection limit;
>
> [7] receiving from the digital computer system collection instructions that reflect the one or more optimizations and the one or more additional optimizations; and
>
> [8] collecting the samples from the patient according to the collection instructions.

Claims 16–20 stand rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

ISSUES

The issues of eligible subject matter turn primarily on whether the claims recite more than abstract conceptual advice of results desired.

ANALYSIS

STEP 1[4]

Claim 16, as a method claim, nominally recites one of the enumerated categories of eligible subject matter in 35 U.S.C. § 101. The issue before us is whether it is directed to a judicial exception without significantly more.

STEP 2

The Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, . . . determine whether the claims at issue are directed to one of those patent-ineligible concepts. If so, we then ask, "[w]hat else is there in the claims before us? To answer that question, . . . consider 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. [The Court] described step two of this analysis as a search for an "'inventive concept'"—*i.e.*, 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."

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[4] For continuity of analysis, we adopt the steps nomenclature from 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) ("Revised Guidance").

Alice Corp. v. CLS Bank Int'l, 573 U.S. 208, 217–18 (2014) (citations omitted) (*citing Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 566 U.S. 66 (2012)). To perform this test, we must first determine what the claims are directed to. This begins by determining whether the claims recite one of the judicial exceptions (a law of nature, a natural phenomenon, or an abstract idea). Then, if the claims recite a judicial exception, determining whether the claims at issue are directed to the recited judicial exception, or whether the recited judicial exception is integrated into a practical application of that exception, i.e., that the claims "apply, rely on, or use 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." Revised Guidance, 84 Fed. Reg. at 54. If the claims are directed to a judicial exception, then finally determining whether the claims provide an inventive concept because the additional elements recited in the claims provide significantly more than the recited judicial exception.

STEP 2A Prong 1

At a high level, and for our preliminary analysis, we note that method claim 16 recites providing a database and requisition data, retrieving requirement data, determining container quantity data, apply optimization rules, receive instruction data, and advising one to follow the instructions to collect samples. Providing data is storing data. Determining optimizations is rudimentary computer analysis by mathematical optimization algorithms. Thus, claim 16 recites storing, receiving, and analyzing data. None of the limitations recite technological implementation details for any of these steps, but instead recite only results desired by any and all possible means.

From this we see that claim 16 does not recite the judicial exceptions of either natural phenomena or laws of nature.

Under Supreme Court precedent, claims directed purely to an abstract idea are patent in-eligible. As set forth in the Revised Guidance, which extracts and synthesizes key concepts identified by the courts, abstract ideas include (1) mathematical concepts[5], (2) certain methods of organizing human activity[6], and (3) mental processes[7]. Among those certain methods of organizing human activity listed in the Revised Guidance are managing personal behavior or relationships or interactions between people. Like those concepts, claim 16 recites the concept of managing medical information. Specifically, claim 16 recites operations that would ordinarily take place in advising one in generating instructions to collect patient samples that results in reducing the number of containers by optimization. The advice in generating instructions to collect patient samples that results in reducing the number of containers by optimization involves collecting one or more biological samples from a patient, which is a medical information act. For example, claim 16 recites "collecting one or more biological

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[5] *See, e.g.*, *Gottschalk v. Benson*, 409 U.S. 63, 71–72 (1972); *Bilski v. Kappos*, 561 U.S. 593, 611 (2010); *Mackay Radio & Telegraph Co. v. Radio Corp. of Am.*, 306 U.S. 86, 94 (1939); *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1163 (Fed. Cir. 2018).
[6] *See, e.g.*, *Bilski*, 561 U.S. at 628; *Alice*, 573 U.S. at 219–20; *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014); *Smart Sys. Innovations, LLC v. Chicago Transit Auth.*, 873 F.3d 1364, 1383 (Fed. Cir. 2017); *In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157, 1160–61 (Fed. Cir. 2018).
[7] *See, e.g.*, *Benson*, 409 U.S. at 67; *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1371–72 (Fed. Cir. 2011); *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1318 (Fed. Cir. 2016).

samples from a patient," which is an activity that would take place whenever one is gathering medical information from patient samples.

The Examiner determines the claims to be directed to an algorithm for computing an optimal number. Final Act. 3.

The preamble to claim 16 recites that it is a method of collecting one or more biological samples from a patient. The steps in claim 16 result in managing medical information by following instructions to collect patient samples into an optimized number of containers absent any technological mechanism other than a conventional computer for doing so. In particular, no technological steps or mechanisms are recited for the final limitation of following collection instructions.

As to the specific limitations, limitations 1–3 and 7 recite storing and receiving data. Limitations 4–6 recite generic and conventional analyzing of medical data, which advise one to apply generic functions to get to these results. Limitation 8 recites following instructions, which is conceptual advice. The limitations thus recite advice for following instructions to collect patient samples into an optimized number of containers. To advocate following instructions to collect patient samples into an optimized number of containers is conceptual advice for results desired and not technological operations.

The Specification at paragraph 4 describes the invention as relating to optimizing the collection of specimens. Thus, all this intrinsic evidence shows that claim 16 recites managing medical information. This is consistent with the Examiner's determination.

This in turn is an example of managing personal behavior or relationships or interactions between people as a certain method of

organizing human activity because managing medical information is a way of managing behavior among medical personnel and patient. The concept of managing medical information by following instructions to collect patient samples into an optimized number of containers is one idea for efficiently gathering such information. The steps recited in claim 16 are part of how this might conceptually be premised.

Our reviewing court has found claims to be directed to abstract ideas when they recited similar subject matter. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 84–86 (2012) ("[S]imply implementing a mathematical principle on a physical machine, namely a computer, was not a patentable application of that principle." Also "tell a treating doctor to measure metabolite levels and to consider the resulting measurements").

Alternately, this is an example of concepts performed in the human mind as mental processes because the steps of storing, receiving, and analyzing data mimic human thought processes of observation, evaluation, judgment, and opinion, perhaps with paper and pencil, where the data interpretation is perceptible only in the human mind. *See In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016). Claim 16, unlike the claims found non-abstract in prior cases, uses generic computer technology to perform data storage, reception, and analysis and does not recite an improvement to a particular computer technology. *See, e.g.*, *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314–15 (Fed. Cir. 2016) (finding claims not abstract because they "focused on a specific asserted improvement in computer animation").

As such, claim 16 recites storing, receiving, and analyzing data, and not a technological implementation or application of that idea.

Alternately, this is an example of a mathematical concept because the steps of optimizing resources perform a mathematical optimization algorithm. The remaining steps are mere data gathering and incidental post processing steps.

From this we conclude that at least to this degree, claim 16 recites managing medical information by following instructions to collect patient samples into an optimized number of containers, which is managing personal behavior or relationships or interactions between people, one of certain methods of organizing human activity identified in the Revised Guidance, and, thus, an abstract idea.

STEP 2A Prong 2

The next issue is whether claim 16 not only recites, but is more precisely directed to this concept itself or whether it is instead directed to some technological implementation or application of, or improvement to, this concept i.e. integrated into a practical application.[8]

> At the same time, we tread carefully in construing this exclusionary principle lest it swallow all of patent law. At some level, "all inventions ... embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas." Thus, an invention is not rendered ineligible for patent simply because it involves an abstract concept. "[A]pplication[s]" of such concepts " 'to a new and useful end,' " we have said, remain eligible for patent protection. Accordingly, in applying the § 101 exception, we must distinguish between patents that

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[8] *See, e.g.*, *Alice*, 573 U.S. at 223, discussing *Diamond v. Diehr*, 450 U.S. 175 (1981).

claim the " 'buildin[g] block[s]' " of human ingenuity and those
that integrate the building blocks into something more.

Alice, 573 U.S. at 217 (citations omitted).

Taking the claim elements separately, the operation performed by the
computer at each step of the process is expressed purely in terms of results,
devoid of implementation details. Steps 1–3 and 7 are pure data gathering
steps. Limitations describing the nature of the data do not alter this. Steps
4–6 recite generic computer processing expressed in terms of results desired
by any and all possible means and so present no more than conceptual
advice. Limitation 8 recites following instructions, which is conceptual
advice. The step of collecting per se is devoid of technological
implementation detail and is a conventional and generic practice. See
Specification para. 3. The claims do not recite any such details to how the
practice of collecting itself is implemented, but only recite an algorithm for
determining the number of containers to use when collecting. Inserting the
phrase "collecting the samples" without reciting how such collection is
performed only characterizes the instruction as that of performing a generic
and conventional activity; it is equivalent to reciting "and then do what is
usually done at that point." The invention is in calculating the number of
collection containers, not in the collection procedure itself. All purported
inventive aspects reside in how the data is interpreted and the results desired,
and not in how the process physically enforces such a data interpretation or
in how the processing technologically achieves those results.

Viewed as a whole, Appellant's claim 16 simply recites the concept of
managing medical information by following instructions to collect patient
samples into an optimized number of containers as performed by a generic

computer. This is no more than conceptual advice on the parameters for this concept and the generic computer processes necessary to process those parameters, and do not recite any particular implementation.

Claim 16 does not, for example, purport to improve the functioning of the computer itself. Nor does it effect an improvement in any other technology or technical field. The pages of Specification do not bulge with disclosure, but only spell out different generic equipment[9] and parameters that might be applied using this concept and the particular steps such conventional processing would entail based on the concept of managing medical information by following instructions to collect patient samples into an optimized number of containers under different scenarios. They do not describe any particular improvement in the manner a computer functions. Instead, claim 16 at issue amounts to nothing significantly more than an instruction to apply managing medical information by following instructions to collect patient samples into an optimized number of containers using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 573 U.S. at 225–26.

None of the limitations reflect an improvement in the functioning of a computer, or an improvement to other technology or technical field, applies or uses a judicial exception to effect a particular treatment or prophylaxis for a disease or medical condition, implements a judicial exception with, or uses a judicial exception in conjunction with, a particular machine or manufacture that is integral to the claim, effects a transformation or reduction of a

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[9] The Specification describes programmable digital computers. Spec. para. 16.

particular article to a different state or thing, or applies or uses 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.

We conclude that claim 16 is directed to achieving the result of

managing medical information by advising one in generating instructions to

collect patient samples that results in reducing the number of containers by

optimization, as distinguished from a technological improvement for

achieving or applying that result. This amounts to managing personal

behavior or relationships or interactions between people, which fall within

certain methods of organizing human activity that constitute abstract ideas.

The claim does not integrate the judicial exception into a practical

application.

STEP 2B

The next issue is whether claim 16 provides an inventive concept

because the additional elements recited in the claim provide significantly

more than the recited judicial exception.

The introduction of a computer into the claims does not generally alter

the analysis at *Mayo* step two.

> the mere recitation of a generic computer cannot transform a
> patent-ineligible abstract idea into a patent-eligible invention.
> Stating an abstract idea "while adding the words 'apply it'" is
> not enough for patent eligibility. Nor is limiting the use of an
> abstract idea "'to a particular technological environment.'"
> Stating an abstract idea while adding the words "apply it with a
> computer" simply combines those two steps, with the same
> deficient result. Thus, if a patent's recitation of a computer
> amounts to a mere instruction to "implemen[t]" an abstract idea

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"on … a computer," that addition cannot impart patent
eligibility. This conclusion accords with the pre-emption
concern that undergirds our § 101 jurisprudence. Given the
ubiquity of computers, wholly generic computer
implementation is not generally the sort of "additional
featur[e]" that provides any "practical assurance that the
process is more than a drafting effort designed to monopolize
the [abstract idea] itself."

Alice, 573 U.S. at 223–24 (citations omitted).

"[T]he relevant question is whether the claims here do more than
simply instruct the practitioner to implement the abstract idea [] on a generic
computer." *Alice*, 573 U.S. at 225. They do not.

Taking the claim elements separately, the function performed by the
computer at each step of the process is purely conventional. Using a
computer for storing, receiving, and analyzing data amounts to electronic
data query and retrieval—one of the most basic functions of a computer.
Limitation 8 recites following instruction, which is conceptual advice. All
of these computer functions are generic, routine, conventional computer
activities that are performed only for their conventional uses. *See Elec.
Power Grp. LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). *See
also In re Katz Interactive Call Processing Patent Litig.*, 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").
Limitation 8 recites following instructions, which is conceptual advice.
None of these activities is used in some unconventional manner nor does any
produce some unexpected result. Appellant does not contend it invented any
of these activities. In short, each step does no more than require a generic

computer to perform generic computer functions. As to the data operated upon, "even if a process of collecting and analyzing information is 'limited to particular content' or a particular 'source,' that limitation does not make the collection and analysis other than abstract." *SAP Am., Inc. v. InvestPic LLC*, 898 F.3d 1161, 1168 (Fed. Cir. 2018).

Considered as an ordered combination, the computer components of Appellant's claim 16 add nothing that is not already present when the steps are considered separately. The sequence of data storage-reception-analysis is equally generic and conventional. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (sequence of receiving, selecting, offering for exchange, display, allowing access, and receiving payment recited an abstraction), *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (sequence of data retrieval, analysis, modification, generation, display, and transmission), *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (sequence of processing, routing, controlling, and monitoring). The ordering of the steps is therefore ordinary and conventional.

We conclude that claim 16 does not provide an inventive concept because the additional elements recited in the claim do not provide significantly more than the recited judicial exception.

REMAINING CLAIMS

Claim 16 is representative. The remaining method claims merely describe process parameters. We conclude that the method claims at issue are directed to a patent-ineligible concept itself, and not to the practical application of that concept. There are no structural claims. As a corollary, the claims are not directed to any particular machine.

LEGAL CONCLUSION

From these determinations, we further determine that the claims do not recite an improvement to the functioning of the computer itself or to any other technology or technical field, a particular machine, a particular transformation, or other meaningful limitations. From this, we conclude the claims are directed to the judicial exception of the abstract idea of certain methods of organizing human activity as exemplified by the managing personal behavior or relationships or interactions between people of managing medical information by advising one in generating instructions to collect patient samples that results in reducing the number of containers by optimization, without significantly more.

APPELLANT'S ARGUMENTS

As to Appellant's Appeal Brief arguments, we adopt the Examiner's determinations and analysis from Final Action 2–4 and Answer 3–6 and reach similar legal conclusions. We now turn to the Reply Brief.

We are not persuaded by Appellant's argument that "the examiner, in so characterizing the claims, improperly failed to consider any claim as a whole. This characterization was therefore at an improperly high level of abstraction and disconnected from the language of the claims." Reply Br. 2 (citations omitted). As we determine *supra*, the claims are directed to the judicial exception of the abstract idea of certain methods of organizing human activity as exemplified by the managing personal behavior or relationships or interactions between people of managing medical information by advising one in generating instructions to collect patient samples that results in reducing the number of containers by optimization, without significantly more.

Appellant further argues that the asserted claims are akin to the claims found patent-eligible in *Diamond v. Diehr*, 450 U.S. 175 (1981). Reply Br. 3. But,

> we must read *Diehr* in light of *Alice*, which emphasized that *Diehr* does not stand for the general proposition that a claim implemented on a computer elevates an otherwise ineligible claim into a patent-eligible improvement. *Alice*. . . . Rather, *Diehr* involved "a 'well-known' mathematical equation . . . used . . . in a process designed to solve a technological problem in 'conventional industry practice.'"

OIP Techs., Inc. v. Amazon.com, Inc., 788 F.3d 1359, 1363 (Fed. Cir. 2015) (citations omitted). *Diehr* solved a technological problem in the conventional industry practice of molding tires. Here, Appellant argues only that the invention computes an optimal number of containers. Optimizing a number is not a conventional technological industry practice, but only a mathematical algorithm.

We are not persuaded by Appellant's argument that the claims are not abstract in view of *Thales Visionix Inc. v. United States*, 850 F.3d 1343 (Fed. Cir. 2017). Reply Br. 3.

> As the opinion in *SAP America* stated,

> Similarly, in *Thales Visionix Inc. v. United States* . . . the improvement was in a physical tracking system. The use of mathematics to achieve an improvement no more changed the conclusion that improved physical things and actions were the subject of the claimed advance than it did in *Diamond v. Diehr*. Here, in contrast, the focus of the claims is not a physical-realm improvement but an improvement in wholly abstract ideas—the selection and mathematical analysis of information, followed by reporting or display of the results.

SAP Am., 890 F.3d at 1022 (citations omitted). As with *SAP*, the instant claims select and analyze information, and then display results, this time in the form of instructions to be followed.

We are not persuaded by Appellant's argument that "data is collected, determinations are made algorithmically based on the data, and specimens are collected in amounts that depend on the determination. The result here therefore should be that the claimed method is not directed to an abstract idea." Reply Br. 5. The argument is a non-sequitur. The premise is that the claims are essentially conceptual advice to use mathematical optimization to instruct how to collect data. Such conceptual ideas are the epitome of abstract ideas.

We are not persuaded by Appellant's argument that "the claims are directed to improving the testing process by optimizing collection of specimens for laboratory analysis." Reply Br. 6. First, the claims do no more than generate instructions, which are conceptual advice to be followed. Second, the claims do not improve the testing process per se because they do not alter the testing steps. Instead, the claims only reduce the number of containers needed in the testing process, and that only by computing a number, not by physical process steps.

Appellant argues that the asserted claims are akin to the claims found patent-eligible in *Finjan, Inc. v. Blue Coat System, Inc.*, 879 F.3d 1299 (Fed. Cir. 2018). Reply Br. 8. In *Finjan*, the Court held that claims to a "behavior-based virus scan" were a specific improvement in computer functionality and hence not directed to an abstract idea. *Finjan*, 879 F.3d at 1304. The claimed technique of scanning enabled "more flexible and nuanced virus filtering" and detection of potentially dangerous code. *Id.*

This was done by "scanning a downloadable and attaching the results of that scan to the downloadable itself in the form of a 'security profile.'" *Id.* at 1303. The security profile included the information about potentially hostile operations produced by a "behavior-based" virus scan, as distinguished from traditional, "code-matching" virus scans that are limited to recognizing the presence of previously-identified viruses, typically by comparing the code in a downloadable to a database of known suspicious code. *Id*. at 1304. This behavior-based scan was a new type of file that when attached to a downloadable allowed the computer to do more to protect itself than in the past.

The instant claims present no such new type of processing to create a file that improves computer performance. Instead, the claims are conventional data processing of patient test data. They may improve information concerning a number of containers, but this is not an improvement to the computer.

> The claims here are unlike those found patent eligible in *Finjan, Inc. v. Blue Coat Sys., Inc*., 879 F.3d 1299 (Fed. Cir. 2018). In *Finjan*, the claimed invention employed "a new kind of file that enables a computer security system to do things it could not do before." *Id.* at 1305. We explained that the claims there, like those in *Enfish, LLC v. Microsoft Corp*., 822 F.3d 1327 (Fed. Cir. 2016), were directed to a "non-abstract improvement in computer functionality, rather than the abstract idea of computer security writ large." *Finjan*, 879 F.3d at 1305; *Enfish*, 822 F.3d at 1336. Unlike in *Finjan*, the claims here do not filter based on behavior, but based on the allowable form of information within a file, e.g., content other than I-frames in HTML or complex macros in Microsoft Word. Moreover, the claims do not create a new kind of file or improve the functioning of the computer itself. The "substitute" file merely duplicates the approved content from the original electronic

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file. It does not allow the computer to do something it could not previously do.

Glasswall Solutions Ltd v. Clearswift Ltd., 754 F. App'x. 996, 999 (Fed. Cir. 2018) (non-precedential).

Appellant also attempts to analogize the claims to those involved in *McRO,* 837 F.3d at 1299. Reply Br. 8. In *McRO*, the court held that, although the processes were previously performed by humans, "the traditional process and newly claimed method . . . produced . . . results in fundamentally different ways." *FairWarning*, 839 F.3d at 1094 (differentiating the claims at issue from those in *McRO*). In *McRO*, "it is the incorporation of the claimed rules, not the use of the computer, that improved the existing technology process," because the prior process performed by humans "was driven by subjective determinations rather than specific, limited mathematical rules." *McRO*, 837 F.3d at 1314 (internal quotation marks, citation, and alterations omitted). In contrast, the claims of the instant application merely implement an old practice of using decision criteria in making testing decisions in a new environment. Appellant has not argued that the claimed processes of selecting and collecting containers apply rules of selection in a manner technologically different from those which humans used, albeit with less efficiency, before the invention was claimed. Merely pigeon holing the objects of decision making in tiers to aid decision making is both old and itself abstract.

> The claims in *McRO* were not directed to an abstract idea, but instead were directed to "a specific asserted improvement in computer animation, i.e., the automatic use of rules of a particular type." We explained that "the claimed improvement [was] allowing computers to produce 'accurate and realistic lip synchronization and facial expressions in animated characters'

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that previously could only be produced by human animators."
The claimed rules in *McRO* transformed a traditionally
subjective process performed by human artists into a
mathematically automated process executed on computers.

FairWarning, 839 F.3d at 1094 (differentiating the claims at issue from
those in *McRO*) (citations omitted).

CONCLUSIONS OF LAW

The rejection of claims 16–20 under 35 U.S.C. § 101 as directed to a
judicial exception without significantly more is proper.

CONCLUSION

The rejection of claims 16–20 is affirmed.

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
16–20	101	Eligibility	16–20	

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) (2011).

AFFIRMED