



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/262,863	10/31/2008	Joseph Bernstein	B1245/20006	7023
3000	7590	10/01/2019	EXAMINER	
CAESAR RIVISE, PC 7 Penn Center, 12th Floor 1635 Market Street Philadelphia, PA 19103-2212			WILLIAMS, TERESA S	
			ART UNIT	PAPER NUMBER
			3686	
			NOTIFICATION DATE	DELIVERY MODE
			10/01/2019	ELECTRONIC

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

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@crbcp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOSEPH BERNSTEIN

Appeal 2018-009080
Application 12/262,863
Technology Center 3600

Before ELENI MANTIS MERCADER, NORMAN H. BEAMER, and
GARTH D. BAER, *Administrative Patent Judges*.

MANTIS MERCADER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 21, 22, 26, 28–30, 32, 36, 38, and 43–48, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellant identifies Joseph Bernstein as the real party in interest (App. Br. 2).

THE INVENTION

Appellant's claimed invention is directed to "[a]n authorization process for high intensity medical interventions" (Abstract).

Independent claims 21 and 47, reproduced below (with emphases added to independent claim 21), are representative of the subject matter on appeal:

21. A method for screening requests for authorization to administer diagnostic tests and therapeutic medical care procedures for patients, the method comprising the steps of:

providing a database in non-transient memory with a plurality of questions which correspond to each of said diagnostic test or therapeutic medical care procedures, respectively;

receiving from users a) information about patients, and b) said requests for authorization to administer diagnostic tests or therapeutic medical care procedures for patients, wherein each of said requests for authorization are stored in memory and received before the diagnostic tests or therapeutic medical care procedures for each of said users are authorized;

retrieving from said database in said non-transient memory under microprocessor control and based on:

a) said information and b) said requests, ones of said plurality of questions corresponding to said requests, respectively, and transmitting said ones of said plurality of questions to said user;

receiving, from said users, answers for said ones of said plurality of questions,

identifying, retrieving from said database, and transmitting at least one further question to one of said users, said further question is identified and retrieved from said database based on one of said answers received from said one of said users, wherein said identifying is prevented until said one of said answers is received from said one of said users;

preventing, under said microprocessor control, said users from receiving authorization until each of said ones of said plurality of questions and said one further question are answered by said users;

providing said users with authorization under said microprocessor control responsive to each of said ones of said plurality of questions and said one further question being answered;

generating visual feedback to the users responsive to said ones of said plurality of questions and said one further question answered by said users, the feedback instructing the users as to whether or not diagnostic tests or therapeutic medical care procedures are appropriate to request;

receiving from ones of the users whether they have withdrawn their respective requests;

compiling and storing in a further database, in memory, withdrawal data which indicates whether each of the users withdraws their respective requests for authorization for diagnostic testing or therapeutic medical care; and

retrieving said withdrawal data in a form for display.

47. A method for gaining third party payment authorization for a mode of diagnostic testing or therapeutic medical care procedures for patients, the method comprising the steps of:

providing a database in non-transient memory with a plurality of questions which correspond to each of said diagnostic testing or therapeutic medical care procedures, respectively;

receiving from users a) information about patients, and b) requests for authorization to administer said diagnostic testing or therapeutic medical care procedures for patients, wherein each of said requests for authorization are stored in non-transient

memory and received before the diagnostic testing or therapeutic medical care procedures for each of said users are authorized;
retrieving from said database in said non-transient memory under microprocessor control and based on:

a) said information and b) said requests, ones of said plurality of questions for said testing or procedures corresponding to each of said requests, respectively, and transmitting said questions to said users;

receiving, from said users, answers for ones of said plurality of questions,

identifying, retrieving from said database, and transmitting at least one further question to one of said users, said further question is identified and retrieved from said database based on one of said answers received from one of said users, wherein said identifying is prevented until said one of said answers is received from said one of said users;

preventing, under said microprocessor control, said users from receiving authorization until each of said ones of said plurality of questions and said one further question are answered by said users;

providing said users with authorization under said microprocessor control responsive to each of said retrieved questions being answered;

providing said authorization to at least one source of financial payments for said diagnostic tests and therapeutic medical care procedures after said ones of said plurality of questions and said one further question are answered.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is the following:

Smith

US 2003/0069759 A1

Apr. 10, 2003

THE REJECTIONS

The Examiner made the following rejections:

Claims 21, 22, 26, 28–30, 32, 36, 38, and 43–48 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more. Final Act. 3.

Claims 21, 22, 26, 28–30, 32, 36, 38, 43–46, and 48 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Final Act. 7.²

Claims 44, 46, and 47 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Lipscher. Final Act. 8.

Claims 21, 22, 26, 28–30, 32, 36, 38, 43, 45, and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lipscher and Smith. Final Act. 13.

ISSUES

The issues are whether the Examiner erred in finding that:

1. claims 21, 22, 26, 28–30, 32, 36, 38, and 43–48 are directed to ineligible subject matter;
2. claims 21, 22, 26, 28–30, 32, 36, 38, 43–46, and 48 fail to comply with the written description requirement;

² The heading of the rejection incorrectly lists claims 39, 40, and 42 as rejected, but these claims were previously canceled in an Amendment filed on Feb. 17, 2017. Further, the heading and body of the rejection refers to claim 47, whereas claim 48 contains the claim limitation that forms the basis of the rejection. We find the reference to claim 47 (instead of to claim 48) to be a harmless error.

3. Lipscher discloses the limitations of:

preventing, under said microprocessor control, said users from receiving authorization until each of said ones of said plurality of questions and said one further question are answered by said users;

[and]

providing said users with authorization under said microprocessor control responsive to each of said retrieved questions being answered,

as recited in independent claim 47; and

4. the combination of Lipscher and Smith teaches or suggests the limitation of “compiling and storing in a further database, in memory, withdrawal data which indicates whether each of the users withdraws their respective requests for authorization for diagnostic testing or therapeutic medical care,” as recited in independent claim 21.

ANALYSIS

We have reviewed the Examiner’s rejection in light of Appellant’s arguments. We have considered in this Decision only those arguments Appellant actually raised in the Briefs. Any other arguments Appellant could have made but chose not to make are deemed waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Patent Eligibility

The Examiner determines claim 21 is patent ineligible under 35 U.S.C. § 101, because “the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more.” Final Act. 3; *see also Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014) (describing the two-step framework “for distinguishing patents that claim laws of nature, natural phenomena, and

abstract ideas from those that claim patent-eligible applications of those concepts”).

After the docketing of this appeal, the USPTO published revised guidance on the application of § 101 (“Guidance”). *See* USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Memorandum”). Pursuant to the Guidance “Step 2A,” the office first looks to whether the claim recites:

- (1) Prong One: any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
- (2) Prong Two: additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, does the Office then (pursuant to the Guidance “Step 2B”) look to whether the claim:

- (3) adds a specific limitation beyond the judicial exception that are not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or
- (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See Memorandum.

Pursuant to Step 2A, Prong One of the Guidance, the Office first looks to “evaluate whether the claim recites a judicial exception, i.e., an abstract idea” (Memorandum at 54). Here, claim 21 recites “[a] method for screening requests for authorization to administer diagnostic tests and

therapeutic medical care procedures for patients.” Specifically, claim 21 recites the limitations italicized *supra*. In the italicized portions of claim 21, questions are presented to the user based on the user input of:

(1) “information about patients” and “requests for authorization to administer diagnostic tests or therapeutic medical care procedures for patients,” and

(2) answers provided by the user to previous questions, and authorization for payment for the diagnostic tests and therapeutic medical care procedures is only made after all questions are answered. The aim of the questioning is to “initiate[] a dialogue with a user (typically a physician) requesting a particular high intensity medical intervention in order to review the various indications for the intervention with the user” (Spec. 5:5–7).

These limitations are classified by the Guidance as

(1) managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions), and

(2) commercial or legal interactions (including agreements in the form of contracts),

and the Guidance provides such steps are examples of the abstract concept of “[c]ertain methods of organizing human activity” (Memorandum at 52).

These limitations are also classified by the Guidance as concepts performed in the human mind (including an observation, evaluation, judgment, opinion), and the Guidance provides such steps are examples of the abstract concept of “mental processes” (Memorandum at 52).

Accordingly, claim 21 “recites a judicial exception . . . [and] requires further analysis in Prong Two” of the Guidance. *See* Memorandum at 54.

Pursuant to Step 2A, Prong Two, we are not persuaded the Examiner has erred in finding that claim 21 is directed to an abstract idea. That is, we determine claim 21 does not integrate the recited judicial exception into a practical application. *See* Memorandum at 54.

Appellant argues that the

sequence of interactions with [non-transitory] computer memory enables applicant's invention to process data with improved processing speed and memory utilization over the prior art

(App. Br. 4) because

the identification of questions that will not be posed may be eliminated, resulting in faster identification of questions to pose, decreases searching of memory to obtain questions to be posed, and fewer memory access because fewer questions are initially retrieved

and “as initial questions are answered, additional questions may be retrieved from memory based on the answers to the initial questions” (App. Br. 5).

Appellant has not shown the claim includes additional elements that improve the underlying computer, or other technology. *See Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015) (“[M]erely adding computer functionality to increase the speed or efficiency of the process does not confer patent eligibility on an otherwise abstract idea.”). Moreover, Appellant’s purportedly improved abstract concept is still an abstract concept under the Guidance. *See Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (“a claim for a new abstract idea is still an abstract idea.”) (emphasis omitted). That is, the generation of questions, including the generation of a “further question” that is “based on one of said answers received from one of said users,” is part of the recited abstract idea as discussed above. As the argued elements

Appeal 2018-009080
Application 12/262,863

are part of the abstract idea, they are not additional elements that integrate the identified abstract idea into a practical application. *See* Memorandum, 84 Fed. Reg. 54–55 (“evaluate integration into a practical application by: (a) Identifying whether there are any additional elements recited in the claim beyond the judicial exception(s)”).

Accordingly, we determine the claim does not integrate the judicial exception into a practical application. *See* Memorandum, 84 Fed. Reg. at 54. We determine the “claim recites a judicial exception and fails to integrate the exception into a practical application,” therefore we proceed with “further analysis pursuant to the second step of the *Alice/Mayo* test (USPTO Step 2B).” Memorandum, 84 Fed. Reg. at 51.

Appellant argues the Examiner errs in determining the claims do not recite an inventive concept that amounts to significantly more than the judicial exception itself. *See* Reply Br. 2–4. Particularly, Appellant contends

patentability [of the claims is] based on the following steps that are not “well-understood, routine, and conventional to a skilled artisan in the relevant field”:

. . . receiving, from said users, answers for said ones of said plurality of questions,

identifying, retrieving from said database, and transmitting at least one further question to one of said users, said further question is identified and retrieved from said database based on one of said answers received from said one of said users . . .

compiling and storing in a further database, in memory, withdrawal data which indicates whether each of the users withdraws their respective requests . . .

. . . retrieving said withdrawal data in a form for display.

(Reply Br. 3).

We are not persuaded the Examiner’s rejection is in error. The steps argued by Appellant are part of the recited judicial exception itself, as discussed above. *See* Memorandum fn. 24 (“USPTO guidance uses the term ‘additional elements’ to refer to claim features, limitations, and/or steps that are recited in the claim beyond the identified judicial exception.”) (emphasis omitted).

Regarding the limitations beyond the identified judicial exception, we agree with the Examiner that “[t]he additional element[s] of a database, memory and microprocessor [are] generic because [the elements perform] the well-understood, routine, and conventional activity of using generic computer hardware” (Final Act. 5–6, citing Spec. pages 7–9). Appellant does not point to any portion of the disclosure as describing these additional elements, and these elements do not appear in the Specification or the Figures, although the disclosure refers to “a computer containing the algorithm” (Spec. 5:1, 7:27). *See also Alice*, 573 U.S. at 226 (“But what petitioner characterizes as specific hardware . . . is purely functional and generic. Nearly every computer will include a ‘communications controller’ and ‘data storage unit’ capable of performing the basic calculation, storage, and transmission functions required by the method claims.”); *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (Claims reciting, inter alia, sending messages over a network, gathering statistics, using a computerized system to automatically determine an estimated outcome, and presenting offers to potential customers found to merely recite “well-understood, routine conventional activit[ies].”).

Accordingly, we affirm the Examiner’s rejection of independent claim 21, and independent claim 47 and dependent claims 22, 26, 28–30, 32, 36, 38, 43–46, and 48 not separately argued. *See* App. Br. 7.

Written Description

Appellant argues that

[t]he specification describes the ability to determine “the rate of utilization for marginally indicated services” and “whether the user authorized and executes a service despite the fact that it was not recommended” This disclosure is obviously describing to what extent a medical provider proceeds with a procedure (or withdraws a procedure) for which authorization has been requested. At page 12, line 3 the specification describes the creation of a “report card.” The disclosure of a “report card” indicates that information is displayed (i.e. the whole concept beyond a “report card” is to display/provide feedback)

(App. Br. 7–8).

We are not persuaded. The Examiner finds, and we agree, that

[t]he specification does not describe to one of ordinary skill in the art to understand how the retrieval of withdrawal data is obtained from a “report card”. The example Applicant refers to, where on “the rate of utilization for marginally indicated services; that is, whether the user authorizes and executes a service despite the fact that it was not recommended” ([Spec. 11: 7–8]) is the opposite of *retrieving said withdraw data in a form for display*.

(Ans. 4).

We agree, because one skilled in the art would consider the “rate of utilization for marginally indicated services” as measuring a rate of services *actively executed* by the user (although the service was not recommended). One skilled in the art, finding no explicit definition of “withdraw” in the disclosure, would consider “withdraw data” to be related to services not executed by the user, that are (in some way) withdrawn.

Accordingly, we affirm the rejection of independent claim 21, and dependent claims 22, 26, 28–30, 32, 36, and 45 not separately argued. *See*

Appeal 2018-009080
Application 12/262,863

App. Br. 7–8. However, we reverse the rejection of dependent claims 38, 44, and 46, as these claims are dependent on independent claim 47, and do not contain the claim limitation at issue.

Anticipation

Appellant argues that

Applicant’s claim recites the feature of providing authorization to proceed after questions have been answered. This is completely different than Lipscher in which authorization to proceed depends upon **HOW** his questions are answered

(App. Br. 8–9), because

Lipscher at column 22, lines 32 – 48 describes a process where questions must be answered correctly for a provider to receive approval to dispense a certain medication. By contrast, Applicant’s claim describes a process where approval to proceed is granted after receiving answers to questions – and the claim is not directed to **HOW** the questions are answered.

(App. Br. 9).

We are not persuaded by Appellant’s argument. Appellant’s argument that claim 47 “recites the feature of providing authorization to proceed after questions have been answered” is not commensurate with the scope of the claim, which recites that “providing said users with authorization under said microprocessor control *responsive* to each of said retrieved questions being answered.” The broadest reasonable interpretation of “responsive” indicates that authorization may depend on the actual answer supplied, not just that an answer was supplied. This interpretation is supported by Appellant’s disclosure, which states that

it is also within the scope of the present invention to develop criteria for identifying particularly poorly indicated interventions, and flag them for denial (after human review).

Appeal 2018-009080
Application 12/262,863
(Spec. 11:25–27).

Further, the Examiner finds, and we agree, that

Lipscher’s prerequisite questioning is necessary as a prior condition for the healthcare provider being required to answer is taught in column 22, lines 32-48 *this set of questions may be specified as a prerequisite question as described above. For example, a similar methodology may be used by a DMA [disease management advisor] to specify a set of questions that the HCP should answer to get approval to perform a procedure or test.*

(Ans. 4, quoting 22:44–48).

The Examiner’s finding that the prerequisite questions are questions in which an approval is granted after receiving an answer, is supported in the cited section because approval is not conditioned on the answer, but that an answer is supplied merely because the questions “should” be answered “to get approval.” The Examiner’s finding is further confirmed by Lipscher’s teaching that in some situations “[t]he user can select ‘done,’ for example, if the treatment is automatically approved” (Lipscher 7:52–54).

Accordingly, we sustain the Examiner’s rejection of independent claim 47, and dependent claims 44 and 46, not separately argued.

Obviousness

In the Appeal, Appellant first argues that the “providing said users with authorization” limitation is “neither disclosed nor suggested by the art of record,” as “explained above with regard to claim 47” (App. Br. 9). We are not persuaded by this argument, under the reasoning provided in the affirmance of the anticipation rejection of claim 47.

Appellant then argues that “Lipscher includes no metrics” regarding the “compiling and storing” limitation of independent claim 21. App. Br. 10. However, the Examiner finds, and we agree, that “Lipscher is not relied

upon to teach” this limitation (*see* Ans. 4) but instead this limitation was found by the Examiner to be taught or suggested in the secondary reference Smith. *See* Final Act. 18.

We are not persuaded by Appellant’s argument. “[O]ne cannot show non-obviousness by attacking references individually where . . . the rejections are based on combinations of references.” *In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

Accordingly, we affirm the Examiner’s rejection of independent claim 21, and dependent claims 22, 26, 28-30, 32, 36, 43, and 45, not argued separately. *See* App. Br. 10. We also affirm the obviousness rejection of claim 48, as this claim is commensurate in scope with independent claim 21. However, we reverse the rejection of claim 38, as this claim is dependent on independent claim 47 and is not commensurate in scope with the subject matter of independent claim 21.³

CONCLUSION

The Examiner did not err in finding that:

1. claims 21, 22, 26, 28–30, 32, 36, 38, and 43–48 are directed to ineligible subject matter;
2. claims 21, 22, 26, 28–30, 32, 36, 38, 43–46, and 48 fail to comply with the written description requirement;
3. Lipscher discloses the limitations of:
 - preventing, under said microprocessor control, said users from receiving authorization until each of said ones of said plurality of questions and said one further question are answered by said users;

[and]

³ Should there be further prosecution, the Examiner may consider an anticipation rejection of claim 38.

providing said users with authorization under said microprocessor control responsive to each of said retrieved questions being answered,

as recited in independent claim 47; and

4. the combination of Lipscher and Smith teaches or suggests the limitation of “compiling and storing in a further database, in memory, withdrawal data which indicates whether each of the users withdraws their respective requests for authorization for diagnostic testing or therapeutic medical care,” as recited in independent claim 21.

DECISION

The Examiner’s decision rejecting claims 21, 22, 26, 28–30, 32, 36, 38, and 43–48 as directed to non-statutory subject matter is affirmed.

The Examiner’s decision rejecting claims 21, 22, 26, 28–30, 32, 36, 43, 45, and 48 as failing to comply with the written description requirement is affirmed.

The Examiner’s decision rejecting claims 38, 44, and 46 as failing to comply with the written description requirement is reversed.

The Examiner’s decision rejecting claims 44, 46, and 47 as anticipated is affirmed.

The Examiner’s decision rejecting claims 21, 22, 26, 28–30, 32, 36, 43, 45, and 48 as obvious is affirmed.

The Examiner’s decision rejecting claim 38 as obvious is reversed.

Appeal 2018-009080
Application 12/262,863

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