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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOERG SABCZYNSKI, SEBASTIAN PETER MICHAEL DRIES,
and PAVANKUMAR MURLI DADLANI MAHTANI

Appeal 2019-000999
Application 14/368,627
Technology Center 3700

Before MICHAEL L. HOELTER, MICHAEL J. FITZPATRICK, and
MICHELLE R. OSINSKI, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 1–5, 9–14, and 16–23. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Koninklijke Philips N.V. (“Appellant”) is the Applicant, as provided for under 37 C.F.R. § 1.46, and is also identified as the sole real party in interest. Appeal Br. 1.

STATEMENT OF THE CASE

The Specification

The Specification's disclosure "relates to generating information relating to a course of a procedure" for a patient. Spec. 1.

The Rejected Claims

Claims 1–5, 9–14, and 16–23 are rejected. Final Act. 1. No other claims are pending. Claim 1 is illustrative and reproduced below.

1. A system for generating information relating to a course of a procedure, comprising:

at least one processor programmed to:

determine a current position in a guideline, the current position corresponding to a status of a procedure in respect of a subject;

generate a pathway through the guideline, indicative of a course of the procedure, based on the current position;

generate a narrative describing at least part of the pathway in a natural language;

generate additional details for inclusion in the pathway and/or the narrative, based on a collection of additional details associated with the different positions in the pathway, wherein an additional detail of the collection of additional details is indicative of an effect of the condition or treatment on the patient that is not described in the guideline, and wherein an additional detail of the collection of additional details has associated therewith an indication of a probability of occurrence; and

control a graphics unit to display the generated pathway and the generated additional details.

Appeal Br. 24.

The Examiner's Rejections

The following rejections are before us for review:

1. claims 1–5, 9–14, and 16–23 under the judicial exception to 35 U.S.C. § 101 (Final Act. 3);
2. claims 1, 2, 5, 10, 12–14, 19, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Schmidt,² Alsafadi,³ and Moore⁴ (*id.* at 6);
3. claims 3, 4, 9, 16–18, and 23 under 35 U.S.C. § 103(a) as being unpatentable over Schmidt, Alsafadi, Moore, and Kanai⁵ (*id.* at 11); and
4. claims 11, 20, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Schmidt, Alsafadi, Moore, and Papageorge⁶ (*id.* at 13).

DISCUSSION

Rejection 1—Patent Eligibility

The Examiner rejected claims 1–5, 9–14, and 16–23 under the judicial exception to 35 U.S.C. § 101. Final Act. 3. Appellant argues all claims together. Appeal Br. 7–11. Accordingly, we select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Claim 1 is directed to a “system for generating information relating to a course of a procedure.” Appeal Br. 24. The only required physical component of the claimed system is a “processor.” *Id.* The remaining claim language is directed to how the processor is programmed. *Id.*

² WO 2007/054882 A2, published May 18, 2007 (“Schmidt”).

³ US 2008/0312961 A1, published Dec. 18, 2008 (“Alsafadi”).

⁴ US 2004/0044546 A1, published Mar. 4, 2004 (“Moore”).

⁵ US 6,807,531 B1, issued Oct. 19, 2004 (“Kanai”).

⁶ US 2002/0184050 A1, published Dec. 5, 2002 (“Papageorge”).

Section 101 provides that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. However, the Supreme Court has “long held that this provision contains an important implicit exception: [l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In analyzing patent-eligibility questions under the judicial exception to 35 U.S.C. § 101, we “first determine whether the claims at issue are directed to a patent-ineligible concept.” *Alice*, 573 U.S. at 218. If the claims are determined to be directed to an ineligible concept, then we “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.” *Id.* at 217 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 77 (2012)).

On January 7, 2019, the Director issued *2019 Revised Patent Subject Matter Eligibility Guidance* (“*Revised Guidance*”), which explains how the Director directs that patent-eligibility questions under the judicial exception to 35 U.S.C. § 101 be analyzed. 84 Fed. Reg. 50–57.

Per the *Revised Guidance*, the first step of *Alice* (i.e., Office Step 2A) consists of two prongs. In Prong One, we must determine whether the claim recites a judicial exception, i.e., an abstract idea, a law of nature, or a natural phenomenon. 84 Fed. Reg. at 54 (Section III.A.1.). If it does not, the claim is patent eligible. *Id.* With respect to the abstract idea category of judicial exceptions, an abstract idea must fall within one of the enumerated

groupings of abstract ideas in the *Revised Guidance* or be a “tentative abstract idea,” with the latter situation predicted to be rare. *Id.* at 51–52 (Section I, enumerating three groupings of abstract ideas), 54 (Section III.A.1., describing Step 2A Prong One), 56–57 (Section III.D., explaining the identification of claims directed to a tentative abstract idea).

If a claim does recite a judicial exception, we proceed to Step 2A Prong Two, in which we must determine if the “claim as a whole integrates the recited judicial exception into a practical application of the exception.” *Id.* at 54 (Section II.A.2.) If it does, the claim is patent eligible. *Id.*

If a claim recites a judicial exception and fails to integrate it into a practical application, we then proceed to the second step of *Alice* (i.e., Office Step 2B). In that step, we then evaluate the additional limitations of the claim, both individually and as an ordered combination, to determine whether they provide an inventive concept. *Id.* at 56 (Section III.B.). In particular, we look to whether the claim:

- Adds a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field, which is indicative that an inventive concept may be present; or
- simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception, which is indicative that an inventive concept may not be present.

Id.

Revised Guidance Step 2A Prong One

In Prong One of Step 2A, we determine whether claim 1 recites a judicial exception (i.e., a law of nature, natural phenomenon, or abstract idea).

The Examiner determined that claim 1 recites “the abstract idea of generating information relating to a course of a procedure by reciting steps of determining a current position in a guideline, generating a pathway through the guideline, generating a narrative, and generating additional details.” Final Act. 3. We agree that claim 1 recites an abstract idea in the mental processes category, as set forth in relevant case law and the *Revised Guidance*. See *Mayo*, 566 U.S. at 71 (“[M]ental processes[] and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.” (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972))); 84 Fed. Reg. at 52.

The Examiner cited *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 F. App’x 950 (Fed. Cir. 2014) as supporting the determination that claim 1 recites an abstract idea. Final Act. 3–4. That case indeed supports the Examiner’s rejection. In *SmartGene*, the Court found the following claim patent-ineligible for being directed to an abstract idea:

1. A method for guiding the selection of a therapeutic treatment regimen for a patient with a known disease or medical condition, said method comprising:

- (a) providing patient information to a computing device comprising:

- a first knowledge base comprising a plurality of different therapeutic treatment regimens for said disease or medical condition;

a second knowledge base comprising a plurality of expert rules for evaluating and selecting a therapeutic treatment regimen for said disease or medical condition;

a third knowledge base comprising advisory information useful for the treatment of a patient with different constituents of said different therapeutic treatment regimens; and

(b) generating in said computing device a ranked listing of available therapeutic treatment regimens for said patient; and

(c) generating in said computing device advisory information for one or more therapeutic treatment regimens in said ranked listing based on said patient information and said expert rules.

SmartGene, 555 F. App'x 951–52. In doing so, the Court held that “[w]hatever the boundaries of the ‘abstract ideas’ category, the claim [quoted above] involves a mental process excluded from section 101: the mental steps of comparing new and stored information and using rules to identify medical options.” *Id.* at 955. The same analysis is true of Appellant’s claim 1.

Appellant argues that *SmartGene* is not relevant because Appellant’s claim 1 is a system claim, whereas the claim in *SmartGene* was a method claim. Appeal Br. 7–8. This is a superficial argument that is not persuasive. Appellant has not cited any authority for the general proposition that case law regarding method claims is irrelevant to system claims.

Appellant asserts that “the present *method* claims call for convoluted, user interactive *series of steps* and *reactive steps* which it is submitted are not regularly performed in a person’s head” and “the operations recited in the claims are not readily amenable to being performed in a person’s head.” Appeal Br. 8 (emphasis added). This argument is also not persuasive. First, as Appellant has stressed elsewhere in the Appeal Brief, claim 1 is a system

claim, not a method claim. Claim 1 has one physical component, a processor. The processor is programmed to process data. Second, Appellant presents no evidence or explanation to support its assertion that “the claims are not readily amenable to being performed in a person’s head.” Appeal Br. 8. It is just an assertion. Moreover, the Specification suggests the opposite is true. *See* Spec. 1:26–29 (“Individualized information is accessible to the patient only by talking to the treating physician or specialist. . . . Unfortunately, the time of the physician or specialist is expensive.”).

In sum, we agree with the Examiner that claim 1 recites an abstract idea, namely a mental process. *See* 84 Fed. Reg. at 52.

Revised Guidance Step 2A Prong Two

In Prong Two of Step 2A, we determine whether claim 1 as a whole integrates the recited judicial exception (here, an abstract idea) into a practical application of the exception. We determine that claim 1 does not.

Claim 1 merely recites a generic computer component, a processor, which is programmed to carry out conventional processes typically performed by a processor. These processes—namely, to “determine” data, “generate” data, and “control a graphics unit to display” data—are insufficient to integrate the judicial exception into a practical application. *See* 84 Fed. Reg. at 55, nn.30, 31; MPEP § 2106.05(f), (g).⁷

⁷ In *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016), the Court held that data manipulation, as recited in the claims at issue, were directed to an abstract idea in the form of mental processes. *Id.* (Claims directed purely to “a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions . . . are . . . directed to an abstract idea.”).

Appellant argues that the abstract idea is integrated “into a practical application, namely into a system for generating information relating to the course of a procedure.” Reply Br. 3. This argument is not persuasive because it is not developed in any meaningful way. Appellant merely quotes the preamble of claim 1, without explaining how or why it is a practical application under governing case law.

The *Revised Guidance* aggregates exemplary considerations that courts have articulated for deciding whether an abstract idea has been integrated into a practical application. See 84 Fed. Reg. at 55. One consideration tending to show such integration is that an additional element of the claim (i.e., beyond the recitation of the abstract idea) “reflects an improvement in the functioning of a computer, or an improvement to other technology or technical field.” *Id.*; see also MPEP § 2106.05(a). Seeming to invoke this consideration, Appellant argues that claim 1 is “directed to a particular manner of summarizing and presenting information in an electronic device.” Appeal Br. 9 (citing *Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, 880 F.3d 1356 (Fed. Cir. 2018)). However, Appellant’s reliance on *Core Wireless* is misplaced. In *Core Wireless*, the patents at issue disclosed and claimed “*improved display interfaces.*” *Core Wireless*, 880 F.3d at 1359 (emphasis added). Appellant’s claim 1 is not “directed to a specific improvement in the capabilities of computing devices,” as required by the holding in *Core Wireless*. *Id.* at 1361. In fact, Appellant’s claim 1 does not even affirmatively recite “a graphics unit” as part of the claimed system. See Appeal Br. 24.

Further, no elements of claim 1 satisfy any of the other exemplary considerations set forth in the *Revised Guidance*. See 84 Fed. Reg. at 55; MPEP § 2106.05(b), (c), (e).

Accordingly, we determine that claim 1 does not integrate the recited judicial exception into a practical application of the exception.

Revised Guidance Step 2B

In Step 2B, we evaluate the additional limitations of claim 1, both individually and as an ordered combination, to determine whether they provide an inventive concept. 84 Fed. Reg. at 56 (Section III.B.). However, claim 1 does not include any limitations beyond the recitations of the abstract idea, insignificant extra-solution activity, and a conventional computer component (i.e., “processor”) for performing the extra-solution activity.

For the foregoing reasons, we affirm the rejection, under the judicial exception to 35 U.S.C. § 101, of claim 1, as well as claims 2–5, 9–14, and 16–23, which fall therewith. See 37 C.F.R. § 41.37(c)(1)(iv).

Rejection 2—Obviousness

Each of independent claims 1 and 14 recites “wherein an additional detail of the collection of additional details is indicative of an effect of the condition or treatment on the patient that is not described in the guideline.” Independent claim 21 similarly recites “the additional details including an indication of an effect of the condition or treatment on the patient that is not described in the guideline.”

The Examiner relies on Alsafadi as teaching these limitations. Final Act. 7–8 (regarding claims 1 and 14), 11 (regarding claim 21). However, the Examiner does not identify what feature or disclosure of Alsafadi allegedly

teaches these limitations. *Id.* Instead, the Examiner merely quotes the limitations and asserts that paragraphs 24 through 26 of Alsafadi teaches them. *Id.* For example, with respect to claims 1 and 14, the Examiner simply asserts “the Alsafadi reference provides a teaching of ‘wherein an additional detail of the collection of additional details is indicative of an effect of the condition or treatment on the patient that is not described in the guideline’ (see paragraph 24–26).” *Id.* at 7–8. “The Patent Office has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967); *see also In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988) (“The PTO has the burden under section 103 to establish a *prima facie* case of obviousness.”). It has not done so here.

In a “Response to Arguments” portion of the Final Action, the Examiner adds the following:

[T]he applicant has not explained how the Al[s]a[f]adi do not describe the additional detail of effect of condition or treatment that is not described in the guideline. The Examiner notes that the claim limitations do not provide any requirement on the breadth of the additional detail. As such, any detail would meet the limitation of “additional details is indicative of an effect of the condition or treatment on the patient that is not described in the guideline”.

Final Act. 16. In the first sentence quoted above, the Examiner erroneously puts the burden on Appellant to prove that Alsafadi does not teach the limitation that the Examiner asserts it teaches. This is erroneous because the Examiner “bears the initial burden of presenting a *prima facie* case of obviousness,” which the Examiner has not done. *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). “Only if that burden is met, does the burden of coming forward with evidence or argument shift to [Appellant].” *Id.*

In the second and third sentences, the Examiner broadly construes the word “detail” to mean “any detail” but nonetheless fails to identify a detail in Alsafadi “that is not described in the guideline,” as the independent claims recite.

For the foregoing reasons, the Final Action does not establish a prima facie case that independent claims 1, 14, and 21 would have been obvious over Schmidt, Alsafadi, and Moore. It, thus, likewise does not present a prima facie case that dependent claims 2, 5, 8, 10, 12, 13, and 19 would have been obvious over the same references. *See Fine*, 837 F.2d at 1076 (“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.”). Accordingly the rejection must be reversed. *Id.* (reversing for failure to establish a prima facie case of obviousness).

Rejections 3 and 4—Obviousness

In Rejections 3 and 4, the Examiner asserted an additional reference, either Kanai or Papageorge, to meet additional limitations recited in the rejected claims, all of which ultimately depend from claims 1, 14, or 21. Final Act. 11–14. The Examiner did not, however, rely on Kanai or Papageorge to cure the deficiency noted above in Rejection 2. *Id.* Accordingly, for similar reasons, we reverse Rejections 3 and 4.

SUMMARY

The Examiner's rejection of claims 1–5, 9–14, and 16–23 under the judicial exception to 35 U.S.C. § 101 is affirmed.

The Examiner's rejection of claims 1, 2, 5, 10, 12–14, 19, and 21 under 35 U.S.C. § 103(a), as being unpatentable over Schmidt, Alsafadi, and Moore, is reversed.

The Examiner's rejection of 3, 4, 9, 16–18, and 23 under 35 U.S.C. § 103(a), as being unpatentable over Schmidt, Alsafadi, Moore, and Kanai, is reversed.

The Examiner's rejection of claims 11, 20, and 22 under 35 U.S.C. § 103(a), as being unpatentable over Schmidt, Alsafadi, Moore, and Papageorge, is reversed.

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED