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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANOUK CHARLOTTE O’PRINSEN and XI CHEN

Appeal 2019-002579
Application 13/501,311
Technology Center 3700

Before CHARLES N. GREENHUT, BRETT C. MARTIN, and
MICHELLE R. OSINSKI, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner’s decision to reject claims 1–14. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ 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 Koninklijke Philips N.V. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The claims are directed to the determination of a training plan, and particularly to the selection of exercises intended to be done by users. Spec. 1, ll. 4–5. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A non-transitory information medium storing a program which is loaded and executable by at least one data processing device to implement a method of selecting exercises from a plurality of exercises for a user, each of said plurality of exercises being associated with a set of characteristics, and each characteristic of said set of characteristics being associated with a set of categories for classifying said plurality of exercises, the method comprising:

obtaining first quantitative inputs reflecting answers to a first set of questions related to a first characteristic among said set of characteristics, wherein said answers to the first set of questions reflect information of said user;

selecting a first subset of categories from the set of categories based on a comparison of the first quantitative inputs to a first predefined criteria; and

determining a first set of exercises from the plurality of exercises based on said selected subset of categories.

REFERENCE

The prior art relied upon by the Examiner is:

Name	Reference	Date
Gordon	US 2004/0220017 A1	Nov. 4, 2004
Mummy	US 7,335,167 B1	Feb. 26, 2008

REJECTIONS

Claims 1–14 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Ans. 2.

Claims 1–14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mummy and Gordon. Ans. 4.

OPINION

Patent Eligibility

In issues involving subject matter eligibility, our inquiry focuses on whether the claims satisfy the two-step test set forth by the Supreme Court in *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208 (2014). The Supreme Court instructs us to “first determine whether the claims at issue are directed to a patent-ineligible concept,” *id.* at 216–18, and, in this case, the inquiry centers on whether the claims are directed to an abstract idea. If this initial condition is met, we then move to the second step, in which 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, 79, 78 (2012)). The Supreme Court describes the second step 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.’” *Id.* (quoting *Mayo*, 566 U.S. at 72–73).

The USPTO published revised guidance on the application of § 101. *2019 Revised Patent Subject Matter Eligibility Guidance* (“Guidance”), 84

Fed. Reg. 50 (Jan. 7, 2019).² Under that guidance, we first look to whether the claim recites:

- (1) 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, and mental processes) (“Step 2A, Prong One”); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h) (9th ed. Rev. 08.2017, Jan. 2018)) (“Step 2A, Prong Two”).

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

- (3) adds a specific limitation beyond the judicial exception that is 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 generally Guidance.

² In response to received public comments, the Office issued further guidance on October 17, 2019, clarifying the 2019 Revised Guidance. USPTO, *October 2019 Update: Subject Matter Eligibility*, https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf.

ANALYSIS

Claim Grouping

Appellant argues the independent claims as a group for the purpose of the rejection under a judicial exception to § 101. Appeal Br. 10–14. As to this rejection, we select claim 1 as representative of the group, and the remaining independent claims stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Examiner’s Findings and Conclusion

In the first step of the *Alice* inquiry, the Examiner rejects the claims, stating that the claims are drawn to the abstract idea of “data collection, analysis, and display.” Ans. 3. The Examiner further explains “that the determining step can be performed . . . purely mentally or by pen or pencil.” Ans. 9. In this regard, the claims amount to using a computer merely for improved/faster processing of data that could otherwise be done by a human without a computer. At *Alice* step 2, the Examiner additionally determines that the claims do not add a meaningful limitation to the abstract idea so as to amount to significantly more than the judicial exception because they implement the abstract idea on generic processors that perform generic computer functions. Ans. 2.

Analysis According to the Guidance

Step One: Does Claim 1 Fall within a Statutory Category of § 101?

We first examine whether the claim recites one of the enumerated statutory classes of subject matter, i.e., process, machine, manufacture, or composition of matter, eligible for patenting under 35 U.S.C. § 101.

Claim 1 is drawn to a non-transitory medium storing a program which can be executed to implement a method, which is one of the statutory classes (i.e., a manufacture) under 35 U.S.C. § 101.

Step 2A, Prong One: Does Claim 1 Recite a Judicial Exception?

We next look to whether the claim recites 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, and mental processes.

In this instance, claim 1 recites steps that amount to mental processes and/or certain methods of organizing human activity by managing personal behavior involved in determining a training plan. Specifically, the claim recites:

obtaining first quantitative inputs reflecting answers to a first set of questions related to a first characteristic among said set of characteristics, wherein said answers to the first set of questions reflect information of said user;

selecting a first subset of categories from the set of categories based on a comparison of the first quantitative inputs to a first predefined criteria; and

determining a first set of exercises from the plurality of exercises based on said selected subset of categories.

Although these steps are claimed as being on a non-transitory storage medium for storing a program to be run by a computer, the activities themselves are all capable of being performed by a human without a computer, and fall into the abstract idea of mental processes. *See, e.g., CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011) (“That purely mental processes can be unpatentable, even when

performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson.*”); *see id.* at 1372–73 (holding that constructing and using a map of credit card numbers recited a mental process performable in the human mind); *In re Villena*, 745 F. App’x 374, 375–76 (Fed. Cir. 2018) (holding that claims to generating a map-like display for a geographic region with icons of residential properties and their values recited an abstract idea).

We, therefore, determine that claim 1 recites at least the abstract idea of mental processes, which is a judicial exception to patent-eligible subject matter.

Step 2A, Prong Two: Does Claim 1 Recite Additional Elements that Integrate the Judicial Exception into a Practical Application?

Following our Office guidance, having found that claim 1 recites a judicial exception, we next determine whether the claim recites “additional elements that integrate the exception into a practical application” (*see* MPEP §§ 2106.05(a)–(c), (e)–(h)). *See* Guidance, 84 Fed. Reg. at 54. As noted above, each of the claimed steps is recited as being performed by a computer device specified at a high level of generality and, does not result in an improvement in the functioning of a computer or other technology or technological field. The recitations of the generic structures with which the recited steps are performed are merely instructions to use a generic computer system as a tool to perform the abstract idea. Thus, claim 1 does not apply, rely on, or use the abstract idea in a manner that imposes a meaningful limit on those steps. Rather, the claim is simply a drafting effort designed to monopolize the abstract idea steps of claim 1. *See* MPEP § 2106.05(f) (“Use of a computer or other machinery in its ordinary capacity for . . . tasks (*e.g.*, to receive, store, or transmit data) or simply adding a general purpose

computer or computer components after the fact to an abstract idea . . . does not provide significantly more.”).

In short, the additional elements discussed above: (1) do not result in an improvement to the functioning of a computer or other technology; (2) are not any particular machine; (3) do not effect a transformation of a particular article to a different state; and (4) are not applied in any meaningful way beyond generally linking the use of the judicial exception to a particular technological environment. *See* MPEP §§ 2106.05(a)–(c), (e)–(h); Guidance, 84 Fed. Reg. at 55. Consequently, the claimed invention does not integrate the abstract idea into a “practical application.”

For these reasons, the additional elements of claim 1 do not integrate the judicial exception into a practical application. Thus, claim 1 is directed to an abstract idea, which is a judicial exception to patent-eligible subject matter under 35 U.S.C. § 101.

Step 2B: Does Claim 1 Recite an Inventive Concept?

We next consider whether claim 1 recites any additional elements, individually or as an ordered combination, that transform the abstract idea into a patent-eligible application, e.g., provide an inventive concept. *Alice*, 573 U.S. at 217–18. Claim 1 consists wholly of steps that recite abstract ideas that are performed by a generic computer and thus does not recite any such additional elements.

According to Office guidance, under Step 2B, “examiners should . . . evaluate *the additional elements* individually and in combination . . . to determine whether they provide an inventive concept (i.e., whether the additional elements amount to significantly more than the exception itself).” *See* Guidance, 84 Fed. Reg. at 56 (emphasis added). Thus, the second step

of the inquiry (Step 2B) looks at the additional elements in combination. *See BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018) (“It has been clear since *Alice* that a claimed invention’s use of the ineligible concept to which it is directed cannot supply the inventive concept that renders the invention ‘significantly more’ than that ineligible concept.”).

As noted above, the computer is invoked as a conventional tool to run the program stored on the storage medium. Apart from being used to perform the abstract idea itself, the generic computer system components only serve to perform well-understood functions (e.g., obtaining, receiving, repositioning, transmitting, etc.). *See FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1096 (Fed. Cir. 2016) (“[T]he use of generic computer elements like a microprocessor or user interface do not alone transform an otherwise abstract idea into patent-eligible subject matter.”). In our view, claim 1 fails to add a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field, but instead “simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.” *See* Guidance, 84 Fed. Reg. at 56. That is, claim 1 is not directed to a specific application designed to achieve an improved technological result, as opposed to being directed to merely ordinary functionality of the above-recited additional elements to apply an abstract idea. For the reasons discussed above, we find no additional element, alone or in combination, recited in claim 1 that contains any “inventive concept” or adds anything “significantly more” to transform the abstract concept into a patent-eligible application. *See Alice*, 573 U.S. at 221.

Appellant's Contentions

Appellant first contends that the claims are “synonymous with the patentable implementation of the technical solution/improvements of the patentable claims . . . as set forth in *McRO, Inc. v. Bandai Namco Games America, Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016).” Reply Br. 15. The Examiner is correct, however, that the “collective functions merely provide conventional computer implementation” and that “the alleged benefit results from an increased speed due to computer processing and not the claimed invention.” Ans. 4, 9. As noted above, the claims merely recite a program for performing a series of steps that otherwise can be performed as mental processes. As such, there is no technological improvement involved in the claims.

Appellant also asserts that “determining a first set of exercises from the plurality of exercises based on said selected subset of categories . . . cannot be performed mentally or by a human using a pen and paper . . . because it is very time-consuming and hardly possible to be done manually.” Appeal Br. 10–11. As the Examiner explains, however, “the claimed limitations merely require [a] small set of data and classification, ex. two or three, which can be surely performed [] mentally or by pen or pencil.” Ans. 9. Even if the calculation were to involve more than two or three in the data set(s), Appellant has provided no evidence that the calculations could not be performed by a human. We do not doubt that the calculation could get more complicated, but this merely means that the calculation may take longer and the only improvement is the improved speed of performing the method on a computer. Accordingly, we are not persuaded that the claims are directed to statutory subject matter and sustain the Examiner’s rejection.

Obviousness

We first note, in arguing the Examiner’s obviousness rejection, Appellant mostly quotes claim language and asserts that either Mummy or Gordon fails to teach the claim language without any explanation as to why. *See, e.g.*, Appeal Br. 19–29. Merely reciting the language of the claims and asserting that the prior art reference or combination does not disclose or teach each claim limitation is insufficient. *See* 37 C.F.R. § 41.37(c)(vii) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”); *see also In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”). We also note that the Examiner is correct in response to many of Appellant’s arguments regarding Gordon that “Mummy teaches the claimed limitation so Gordon is not required to teach the claimed limitation.” *See, e.g.*, Ans. 19, 20, 21, 23.

In summary, the Examiner essentially finds that Mummy teaches all of the claimed limitations except that Mummy fails to teach collecting data based upon a patient’s answers to questions. *See* Ans. 4–6. The Examiner then finds that “Gordon discloses [a] method and system for generating an exercise program . . . comprising evaluations and measures compris[ing] answers to a first set of questions.” Ans. 6 (citing Gordon ¶ 16, Figs. 2, 5). The Examiner then finds that it would have been obvious to modify Mummy to obtain data via a questionnaire as taught in Gordon “to provide

customized exercise more efficiently with detailed input.” *Id.* (citing Gordon ¶ 7).

Appellant argues that Mummy fails to teach “selecting the iliac crest category over the PSIS-ASIS differential category and the scapulae evaluation category based on a second predefined criteria.” Appeal Br. 22. As the Examiner states, however, “Appellant[] appear[s] to confuse between categories and characteristics associated with the categories.” Ans. 14. The Examiner further explains, and we agree, “that the iliac crest, PSIS-ASIS and Scapulae Elevation are measurement methods (col. 7, ll. 20–26) and measured values are compared to select the subset categories but not the categories themselves as claimed.” *Id.* In other words, Appellant’s arguments are not directed to elements that are actually claimed. The Examiner correctly explains how each portion of Mummy aligns with the claim language and we see no error in the Examiner’s application of Mummy to the claims. Ans. 4–6.

As to the dependent claims, Appellant merely relies on the arguments with respect to claims 1 and 9 and does not present separate arguments for the remaining claims. *See, e.g.*, Reply Br. 29–34.

CONCLUSION

The Examiner’s rejections are **AFFIRMED**.

More specifically,

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-14	101	Eligibility	1-14	
1-14	103	Mummy, Gordon	1-14	
Overall Outcome			1-14	

TIME PERIOD FOR 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