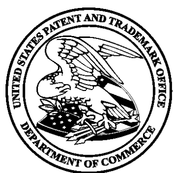

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CORVILLE O. ALLEN, JOHANNA M. COOK, and ANDREW R. FREED

Appeal 2020-001922
Application 14/524,536
Technology Center 3600

Before ROBERT E. NAPPI, CATHERINE SHIANG, and JAMES W. DEJMEK, *Administrative Patent Judges*.

DEJMEK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant[1] appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 9–20. Appellant has canceled claims 1–8. *See* Appeal Br. 9. We have jurisdiction over the remaining pending claims under 35 U.S.C. § 6(b).

We affirm.

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[1] Throughout this Decision, we use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42 (2018). Appellant identifies International Business Machines Corporation as the real party in interest. Appeal Br. 1.

STATEMENT OF THE CASE

Introduction

Appellant's disclosed and claimed invention generally relates to "conditionally overriding strict criteria for a prospective medical treatment." Spec. ¶¶ 1, 6. According to the Specification, a strict criterion relates to an explicit treatment rule or principle. Spec. ¶ 39. In a disclosed embodiment, "a determination is made during evaluation of a patient's medical condition whether their condition should be treated as a strict evaluation or as a conditional evaluation." Spec. ¶ 40. A strict evaluation evaluates the patient's medical condition according to strict criteria, whereas a conditional evaluation evaluates the patient's medical condition by overriding certain strict criteria with conditional criteria. Spec. ¶ 40. As an example, the Specification describes a strict criterion may be a patient's age (e.g., less than 60 years old). Spec. ¶¶ 39, 45. However, if it is determined that the patient meets other criteria (e.g., is active and can perform some light exercise), the strict criterion of being less than 60 years old may be overridden and a treatment regimen that would otherwise have been restricted to the patient is conditionally available. Spec. ¶¶ 45–47.

Claim 9 is representative of the subject matter on appeal and is reproduced below:

9. A system comprising:

a processor;

a data bus coupled to the processor; and

a computer-usable medium embodying computer program code, the computer-usable medium being coupled to the data bus, the computer program code used for answering questions based upon conditional criteria via a question/answer (QA) system executing on a hardware processor, the QA system having an

associated criteria conditional override system and comprising instructions executable by the processor and configured for:

performing an evaluation of a medical condition of a person, the evaluation comprising accessing patient medical record data, the patient medical record data being stored within a patient medical record data repository;

receiving an input corpus to the QA system via a network, the input corpus comprising a question having an associated first condition, the input corpus being stored within a medical corpus data repository, the QA system comprising a knowledge manager and a knowledge base, the QA system using natural language processing to analyze the input corpus and extract question topic information contained in the question, the question being related to the medical condition associated with the person;

determining whether the medical condition should be evaluated using one of a strict evaluation and a conditional evaluation, the strict evaluation and the conditional evaluation being obtained from associated strict and conditional treatment data, the strict and conditional treatment data being stored within a strict and conditional treatment data repository, the strict treatment data being used to retrieve associated strict criteria, the strict evaluation evaluating the medical condition of the person according to the strict criteria, the conditional evaluation evaluating the medical condition of the person according to associated conditions that result in the strict criteria being overridden by conditional criteria corresponding to the associated conditions, the strict criteria being overridden based upon supporting evidence not found within the strict criteria;

receiving criteria for answering the question, the criteria being associated with the associated first condition and received by the QA system configured to answer questions;

> identifying a second condition affecting the first condition via the criteria conditional override system; and
>
> answering the question with a modification of the first condition via the criteria conditional override system, the answering performed in response to determining that the second condition exceeds a threshold.

The Examiner's Rejection[2]

Claims 9–20 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

ANALYSIS[3]

The Supreme Court's two-step framework guides our analysis of patent eligibility under 35 U.S.C. § 101. *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 217 (2014). In addition, the Office has published revised guidance for evaluating subject matter eligibility under 35 U.S.C. § 101, specifically with respect to applying the *Alice* framework. USPTO, 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) ("Office Guidance"). If a claim falls within one of the statutory categories of patent eligibility (i.e., a process, machine, manufacture, or composition of matter) then the first inquiry is whether the claim is directed to one of the judicially

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[2] The Examiner had also rejected claims 9–20 under 35 U.S.C. § 103. Final Act. 5–13. The Examiner subsequently withdrew this rejection. *See* Ans. 3.

[3] Throughout this Decision, we have considered the (corrected) Appeal Brief, filed August 8, 2019 ("Appeal Br."); the Examiner's Answer, mailed November 7, 2019 ("Ans."); and the Final Office Action, mailed April 4, 2019 ("Final Act."), from which this Appeal is taken. Appellant did not file a Reply Brief. To the extent Appellant has not advanced separate, substantive arguments for particular claims or issues, such arguments are considered waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

recognized exceptions (i.e., a law of nature, a natural phenomenon, or an abstract idea). *Alice*, 573 U.S. at 217. As part of this inquiry, we must "look at the 'focus of the claimed advance over the prior art' to determine if the claim's 'character as a whole' is directed to excluded subject matter." *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257–58 (Fed. Cir. 2016). Per the Office Guidance, this first inquiry has two prongs of analysis: (i) does the claim recite a judicial exception (e.g., an abstract idea), and (ii) if so, is the judicial exception integrated into a practical application. Office Guidance, 84 Fed. Reg. at 54. Under the Office Guidance, if the judicial exception is integrated into a practical application, *see infra*, the claim passes muster under § 101. Office Guidance, 84 Fed. Reg. at 54–55. If the claim is directed to a judicial exception (i.e., recites a judicial exception and does not integrate the exception into a practical application), the next step is to determine whether any element, or combination of elements, amounts to significantly more than the judicial exception. *Alice*, 573 U.S. at 217; Office Guidance, 84 Fed. Reg. at 56.

As an initial matter, we note that the Examiner has applied and followed the Office Guidance in formulating the rejection of claims 9–20 under 35 U.S.C. § 101. *See* Final Act. 2–4; Ans. 4–7. The Examiner determines the claims are directed to "receiving questions/answers associated with a medical condition in order to produce results for a prospective treatment." Ans. 4. In particular, the Examiner determines the claims recite, *inter alia*, accessing patient data, receiving data, and evaluating/identifying data. Final Act. 3; *see also* Ans. 4–5. The Examiner determines these steps could be performed in the mind or with pen and paper, but for the additional recitation of generic computer components.

Final Act. 3. As such, consistent with the Office Guidance, the Examiner concludes the claims fall within the category of mental processes. Final Act. 3; Ans. 5. The Examiner further determines the additional limitations fail to integrate the judicial exception into a practical application, but rather amount to instructions to apply the judicial exception using a generic computing component. Final Act. 4; Ans. 5–6. The Examiner explains the claims do not improve the functioning of a computer or any other technology, but link the judicial exception to a particular technological environment of field of use. Ans. 6. As such, the Examiner concludes the claims are directed to an abstract idea. Final Act. 4. Further, the Examiner determines the claims to not recite additional limitations, individually, or when considered as an ordered combination, that amount to significantly more than the judicial exception. Final Act. 4. Instead, the Examiner finds the claims merely recite generic computer components performing generic computing functions to apply the judicial exception. Final Act. 4; Ans. 5–6.

Appellant disputes the Examiner's conclusion that the pending claims are directed to patent-ineligible subject matter. Appeal Br. 4. In particular, Appellant asserts "the claims do not per se recite mathematical concepts, methods of organizing human activity or mental processes." Appeal Br. 4. In addition, Appellant argues the claims are directed to "the practical application of answering questions based upon conditional criteria via a question/answer system executing on a hardware processor." Appeal Br. 4.

Appellant's conclusory statements do not apprise us of Examiner error. Rather, we adopt the Examiner's findings and legal conclusions.

As a point of emphasis, if a claim, under its broadest reasonable interpretation, covers performance in the mind but for the recitation of

generic computer components, then it is still in the mental processes category unless the claim cannot practically be performed in the mind. *See Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1318 (Fed. Cir. 2016) ("[W]ith the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper."); *see also CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) (holding that the incidental use of a "computer" or "computer readable medium" does not make a claim otherwise directed to a process that "can be performed in the human mind, or by a human using a pen and paper" patent eligible); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012) (explaining mental processes are not patentable); Office Guidance, 84 Fed. Reg. at 52–53 nn.14–15.

Contrary to Appellant's conclusory assertion, we agree with the Examiner that the claims covers performance in the mind (e.g., evaluating the medical condition of a person) but for the recitation of generic computer components—i.e., a mental process (i.e., an observation, evaluation, judgment, or opinion). *See* Final Act. 3; Ans. 4–5; *see also* Office Guidance, 84 Fed. Reg. at 52. As set forth in Appellant's Specification, the evaluation of strict criteria to determine whether it can be overridden is "akin to how medical practitioners and technicians evaluate criteria." Spec. ¶ 53.

In addition, we note that the instant claims are similar to those at issue in *SmartGene, Inc. v. Advanced Biological Labs.*, SA, 555 F. App'x 950 (Fed. Cir. 2014) (unpublished). In *SmartGene*, the court determined the claims define a "method for guiding the selection of a therapeutic treatment

regimen for a patient with a known disease or medical condition." *SmartGene*, 555 F. App'x at 954 (internal quotation omitted). The court further explained that, but for the use of a computing device, comparing stored and input data and rules are what doctors do routinely. *SmartGene*, 555 F. App'x at 954. The court concluded the mental steps of comparing new and stored information and using rules to identify medical options fell within the category of mental processes excluded by § 101. *SmartGene*, 555 F. App'x at 955.

Because the claim recites a judicial exception, we next determine whether the claim integrates the judicial exception into a practical application. Office Guidance, 84 Fed. Reg. at 54. To determine whether the judicial exception is integrated into a practical application, we identify whether there are "*any additional elements recited in the claim beyond the judicial exception(s)*" and evaluate those elements to determine whether they integrate the judicial exception into a recognized practical application. Office Guidance, 84 Fed. Reg. at 54–55 (emphasis added); *see also* MPEP § 2106.05(a)–(c), (e)–(h).

Again, contrary to Appellant's conclusory statement (*see* Appeal Br. 4), we agree with the Examiner's determination (*see, e.g.*, Final Act. 3–4; Ans. 6) that the additional elements fail to integrate the judicial exception into a practical application. More particularly, the claims do not recite (i) an improvement to the functionality of a computer or other technology or technical field (*see* MPEP § 2106.05(a)); (ii) a "particular machine" to apply or use the judicial exception (*see* MPEP § 2106.05(b)); (iii) a particular transformation of an article to a different thing or state (*see* MPEP

§ 2106.05(c)); or (iv) any other meaningful limitation (*see* MPEP § 2106.05(e)). *See* Office Guidance, 84 Fed. Reg. at 55.

Answering questions based upon conditional criteria via a question/answer system executing on a hardware processor (as asserted by Appellant, *see* Appeal Br. 4) is merely applying the judicial exception using a generic computing component. *See Mayo*, 566 U.S. at 72 (explaining that "to transform an unpatentable [judicial exception] into a patent-eligible application of [the judicial exception], one must do more than simply state the [judicial exception] while adding the words 'apply it'"); *see also Alice*, 573 U.S. at 221.

Because we determine the claims are directed to an abstract idea or combination of abstract ideas, we analyze the claims under step two of *Alice* to determine if there are additional limitations that individually, or as an ordered combination, ensure the claims amount to "significantly more" than the abstract idea. *Alice*, 573 U.S. at 217–18 (citing *Mayo*, 566 U.S. at 77–79). As stated in the Office Guidance, many of the considerations to determine whether the claims amount to "significantly more" under step two of the *Alice* framework are already considered as part of determining whether the judicial exception has been integrated into a practical application. Office Guidance, 84 Fed. Reg. at 56. Thus, at this point of our analysis, we determine if the claims add a specific limitation, or combination of limitations, that is not well-understood, routine, conventional activity in the field, or simply append well-understood, routine, conventional activities at a high level of generality. Office Guidance, 84 Fed. Reg. at 56.

Here, Appellant's claims do not recite specific limitations (alone or when considered as an ordered combination) that are not well-understood,

routine, and conventional. Rather, the Specification describes the computer (i.e., information processing) system at a high level of generality. *See* Spec. ¶¶ 33–38. In addition, the Specification describes that devices that use the QA (question/answer) system may be such well-known devices as personal digital assistants, personal entertainment devices, tablets, and laptop computers. Spec. ¶ 32. *See also Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324–25 (Fed. Cir. 2016) (generic computer components, such as an "interface," "network," and "database," fail to satisfy the inventive concept requirement); *Alice*, 573 U.S. at 226 ("Nearly every computer will include a 'communications controller' and [a] 'data storage unit' capable of performing the basic calculation, storage, and transmission functions required by the method claims."); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) ("That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive.").

For the reasons discussed *supra*, we are unpersuaded of Examiner error. Accordingly, we sustain the Examiner's rejection of claims 9–20 under 35 U.S.C. § 101. *See also* 37 C.F.R. § 41.37(c)(1)(iv).

CONCLUSION

We affirm the Examiner's decision rejecting claims 9–20 under 35 U.S.C. § 101.

DECISION SUMMARY

Claims Rejected	**35 U.S.C. §**	**Reference(s)/Basis**	**Affirmed**	**Reversed**
9–20	101	Eligibility	9–20	

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. § 41.50(f).

AFFIRMED