



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

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
13/957.627 08/02/2013 Damon HERBST CRNI.189886 6591

46169 7590 01/28/2019
SHOOK, HARDY & BACON L.L.P.
(Cerner Corporation)
Intellectual Property Department
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

EXAMINER

PAULS, JOHN A

ART UNIT PAPER NUMBER

3626

NOTIFICATION DATE DELIVERY MODE

01/28/2019

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):

IPDOCKET@SHB.COM
IPRCDKT@SHB.COM
BPARKERSON@SHB.COM

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* DAMON HERBST, CARLA LEIGHOW, and  
DAVID A. ROBASKA

---

Appeal 2018-000602  
Application 13/957,627  
Technology Center 3600

---

Before: MAHSHID D. SAADAT, BETH Z. SHAW, and  
NORMAN H. BEAMER, *Administrative Patent Judges*.

SHAW, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

The claims are directed to prepopulating clinical events with image based documentation. Claims App’x.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. One or more computer storage devices having computer-executable instructions embodied thereon, that when executed, perform a method of prepopulating clinical events with image based documentation, the method comprising:
  - receiving, by a medical information system, an image of a patient and metadata associated with the image, the image captured by an image capturing device communicatively coupled with the medical information system;
  - extracting the metadata, the metadata comprising an identification of the patient and clinical documentation associated with the image;
  - creating a tag describing a body part associated with the image, wherein the tag is selectable;
  - storing the image, the corresponding metadata, and the tag in an electronic medical record for the patient, wherein the electronic medical record for the patient is within the medical information system and is identified based on the identification of the patient;
  - embedding the tag, the image, and the corresponding metadata at a location on a silhouette of a human body corresponding to the body part described by the tag, wherein the silhouette of the human body is a graphical representation of the human body and is included in the electronic medical record for the patient;

providing, via the electronic medical record, the silhouette of the human body to a clinician device;  
receiving, on the clinician device, a selection of the tag;  
and  
displaying the image and the associated clinical documentation on the clinician device.

#### REJECTION

Claims 1–20 stand rejected under 35 U.S.C. § 101.

#### CONTENTIONS AND ANALYSIS

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[I]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 192 (1981)); “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores” (*id.* at 184 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 176; *see also id.* at 192 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (quotation marks omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance* (“Memorandum”). 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 interactions such as a fundamental economic practice, or mental processes); and
- (2) 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, do we then look 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 Memorandum.*

In this case, the claims do not recite any of the judicial exceptions. Specifically, taking claim 1 as representative, under its broadest reasonable interpretation, claim 1 does not cover performance in the mind but for the recitation of generic computer components. In particular, the step of: “embedding the tag, the image, and the corresponding metadata at a location on a silhouette of a human body corresponding to the body part described by the tag, wherein the silhouette of the human body is a graphical representation of the human body and is included in the electronic medical record for the patient,” requires action by a processor that cannot be practically performed in the mind. The same or similar limitations are found in independent claims 12 and 20. The claimed step of “embedding the tag, the image, and the corresponding metadata at a location on a silhouette of a human body corresponding to the body part described by the tag, wherein the silhouette of the human body is a graphical representation of the human body and is included in the electronic medical record for the patient,” is not practically performed in the human mind, at least because it requires a tag, an image, corresponding metadata, a graphical representation of the human body, and an electronic medical record for the patient.

Further, the claim does not recite any method of organizing human activity, such as a fundamental economic concept or managing interactions between people. Finally, the claim does not recite a mathematical relationship, formula, or calculation. Therefore, the claim is patent eligible

Appeal 2018-000602  
Application 13/957,627

because it is not directed to an abstract idea or any other judicial exception.  
For these reasons, we do not sustain the Examiner's rejection of claims 1–20  
under 35 U.S.C. § 101.

#### DECISION

For the above reasons, the Examiner's rejection of claims 1–20 is  
reversed.

REVERSED