

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALLSCRIPTS HEALTHCARE SOLUTIONS, INC.,
Petitioner,

v.

MYMEDICALRECORDS, INC.,
Patent Owner.

Case CBM2015-00022
Patent 8,301,466 B2

Before FRED E. McKELVEY, JAMES T. MOORE, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 328(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. *Background*

Allscripts Healthcare Solutions, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting a covered business method patent review of claims 8–12 (“challenged claims”) of U.S. Patent No. 8,301,466 B2 (Exhibit 1001, “the ’466 Patent”). Petitioner challenged the patentability of claims 8–12 of the ’466 patent under 35 U.S.C. §§ 101, 102, and 103. Pet. 14–15.

Petitioner also indicated that the '466 Patent was asserted against Petitioner in the following district court case: *MyMedicalRecords, Inc. v. Jardogs, LLC*, No. 2:13-cv-03560 (C.D. Cal.) (“the District Court Case”). Pet. 2–3.

On May 5, 2015, we instituted trial for all challenged claims 8–12 of the '466 Patent, on the grounds that the challenged claims are unpatentable under 35 U.S.C. §§ 101, 102, and 103. Paper 10 (“Decision to Institute” or “Inst. Dec.”). The Scheduling Order set a due date of August 5, 2015, for MyMedicalRecords, Inc. (“Patent Owner”) to file a Patent Owner Response to the Petition. Paper 11. Rather than filing a Response regarding the merits, Patent Owner filed an Updated Mandatory Notice (Paper 14) and now contends that this proceeding should be terminated because of activity that occurred in the District Court Case (Paper 16). That activity and the parties’ contentions regarding the appropriate course of action in light of that activity are summarized below.

B. The District Court Case and Related Parties’ Contentions

Prior to institution of trial, Patent Owner advised us that on December 23, 2014, the District Court determined that each of the challenged claims of the '466 Patent is directed towards patent-ineligible subject matter under 35 U.S.C. § 101 (Paper 9, 4 (citing Ex. 2002)) and that the District Court Decision was on appeal to the United States Court of Appeals for the Federal Circuit (*id.* at 4–5 (citing Ex. 2003)). On July 30, 2015, after institution of trial, Patent Owner filed an Updated Mandatory Notice informing us that the Federal Circuit issued a Mandate, based on a voluntary motion by Patent Owner, dismissing all the appeals. Paper 14 (citing Ex. 2006).

In response to an Order to Show Cause (Paper 15), Patent Owner contends that “[t]he appropriate action is for the Board to terminate this

matter under 37 C.F.R. § 42.72, rather than enter a judgment.” Paper 16, 2–3 (citing *Plaut v. Spendthrift Farm, Inc.*, 514 U.S. 211, 219 (1995); *Fresenius USA, Inc. v. Baxter International, Inc.*, 721 F.3d 1330 (Fed. Cir. 2013)). Patent Owner’s basis for its contention is that “the current CBM proceeding is moot” and “[t]here is nothing left for the Board to decide.” *Id.* at 2.¹

Petitioner disagrees and contends that “terminating this matter under § 42.72 without a final written decision would be *inappropriate*.” Paper 18, 2 (emphasis in original). Petitioner further contends that “[t]his CBM is not in a preliminary stage, and the Board has already issued a decision to institute review.” *Id.*

C. Discussion

In its Petition, Petitioner seeks relief beyond what was requested from the District Court. In particular, Petitioner requests a judgment against the challenged claims as unpatentable. Pet. 1. A final written decision in the context of a covered business method patent review carries with it, *inter alia*, the effects provided in 35 U.S.C. § 328(b) (“If . . . the time for appeal

¹ Patent Owner filed a request to amend its response to not include a portion of a footnote that indicates Petitioner’s counsel has not been responsive. Paper 19. We remind the parties that “[g]enerally, a motion will not be entered without prior Board authorization” and “a party should institute a conference call to obtain such authorization.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,762–63 (Aug. 14, 2012). Because we do not rely on Patent Owner’s or Petitioner’s contentions regarding Petitioner’s responsiveness and this proceeding is in a final stage, we deny Patent Owner’s request to make the change. Nonetheless, although Patent Owner did not seek authorization prior to filing (Paper 19), we do not expunge Patent Owner’s request under 37 C.F.R. § 42.7.

has expired or any appeal has terminated, the Director shall issue and publish a certificate cancelling any claim of the patent finally determined to be unpatentable.”)

We are not persuaded by Patent Owner that nothing is left for us to decide. The covered business method patent review that we instituted for claims 8–12 of the ’466 Patent (Inst. Dec. 31–32) is distinct and independent from the appeal of the District Court’s determination that each of the challenged claims of the ’466 Patent is directed towards patent-ineligible subject matter under 35 U.S.C. § 101. *Cf. In re Etter*, 756 F.2d 852, 857 (Fed. Cir. 1985) (“[R]eexamination proceedings and court actions involving challenges to validity [are] distinct and independent.”)

Additionally, Patent Owner’s cited authority involves, for example, “retroactively commanding the federal courts to reopen final judgments.” *Plaut*, 514 US at 219. In contrast, in the present covered business method patent review, prior to dismissal of the appeal, we instituted covered business method patent review of all challenged claims. Inst. Dec. 32. No proceeding needs to be reopened because trial commenced on the entry date of the Decision to Institute and is still ongoing. *Id.*

Section 42.72 provides that “[t]he Board may terminate a trial without rendering a final written decision *where appropriate . . .*” 37 C.F.R. § 42.72 (emphasis added). The instant proceeding is not in a preliminary stage. We already issued a decision authorizing covered business method patent review because we determined that the information presented in the Petition demonstrates that it is more likely than not that each of the challenged claims is unpatentable. Inst. Dec. 31–32. Under the

circumstances presented here, we determine that termination under § 42.72 is not appropriate.

Patent Owner has not filed a response to the petition after we authorized the covered business method patent review and has not submitted any factual evidence or expert opinions. We have jurisdiction under 35 U.S.C. § 6(c) and we issue a Final Written Decision pursuant to 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73. For the reasons set forth below, we determine that Petitioner has shown by a preponderance of the evidence that claims 8–12 of the '466 Patent are unpatentable, under 35 U.S.C. § 101. Because we determine that all challenged claims are unpatentable, under 35 U.S.C. § 101, we need not reach the grounds of anticipation or obviousness.

D. The '466 Patent

The '466 Patent explains, “[I]aws such as the Health Insurance Portability and Accountability Act (HIPAA)² provide a patient with the right to access [] their own medical records.” Ex. 1001, 1:21–26. The '466 Patent relates to providing a method for consumers to request their medical records from health care providers and store their medical records for online access. *Id.* at 1:15–20 (footnote added).

E. Illustrative Claim

Claim 8 is the independent claim challenged by Petitioner. Each of claims 9–12 depends, directly or indirectly, from claim 8. Claim 8 is illustrative and is reproduced below:

² Pub. L. No. 104-191 (1996).

8. A method for providing a user with the ability to access and collect personal health records associated with the user in a secure and private manner, the method comprising:

associating access information with the user for the user to use to access a server storing files comprising personal health records associated with the user in a computer readable storage medium;

providing the user with a user interface on a computing device to remotely access the personal health records stored on the server;

receiving at the server the files comprising the personal health records associated with the user from a health care provider associated with the user;

receiving at the server a request from the user made through the user interface of the computing device for access to the files, wherein the access information is associated with the request;

sending the user a file containing the personal health records associated with user from the server to the computing device in response to the request;

wherein the files are maintained on the server independently from any files maintained by the health care provider and wherein the files are managed privately by the user independently from the health care provider.

II. ANALYSIS

A. *Claim Construction*

As a step in our analysis in the Decision to InSTITUTE, we determined the meaning of the claims. The constructions are summarized in the table below.

Claim Term	Construction
“health care provider”	“[A] provider of health care services.” Inst. Dec. 6.
“maintained on the server independently”	“[S]tored on the server separately and not under the control or authority of the health care provider.” <i>Id.</i> at 8.

Claim Term	Construction
“managed privately by the user”	We determined that “managed” includes “controlled.” We determined that the remainder of the phrase needs no express construction. <i>Id.</i> at 9.

We discern no reason, based on the complete record now before us, to change our determinations thereof.

B. Non-Statutory Subject Matter

Petitioner asserts that each of the challenged claims is unpatentable under 35 U.S.C. § 101 for being directed to non-patentable subject matter. Pet. 19. In support of this ground, Petitioner presents a Declaration by Dr. Wallace G. Bysinger (Ex. 1008). The statute states that a new and useful “process, machine, manufacture, or composition of matter” is eligible for patent protection. 35 U.S.C. § 101. Each of the challenged claims is directed to a process.

Supreme Court precedent provides three specific exceptions to the broad categories of § 101: laws of nature, physical phenomena, and abstract ideas. *Bilski v. Kappos*, 561 U. S. 593, 601 (2010). “The ‘abstract ideas’ category embodies the longstanding rule that ‘[a]n idea of itself is not patentable.’” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014) (citing *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (quotations omitted)).

In *Alice*, the Supreme Court referred to the framework set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible

applications of those concepts.” *Alice*, 134 S. Ct. at 2355. In the first step, “we determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* “If so, we then ask, ‘[w]hat else is there in the claims before us?’” *Id.* (quoting *Mayo*, 132 S. Ct. at 1297). In the second step, 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.* Step two of the analysis may be described 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.* (citing *Mayo*, 132 S. Ct. at 1294).

1. Abstract Idea

Petitioner asserts that claims 8–12 of the ’466 Patent are unpatentable under 35 U.S.C. § 101, because they are directed to the abstract concept of allowing individuals to manage and access their health records and other medical or legal files privately. Pet. 19. We agree with Petitioner that the claimed invention is directed to an abstract idea: privately managing files by the user. The preamble and all claim limitations of the challenged claims support this view of the claims, and the ’466 Patent consistently describes the invention as allowing an individual to control access to their medical records. *See, e.g.*, Ex. 1001, 5:21–23. Management or control by the user or patient rather than by the health care provider is a method of organizing a human activity. On this record, the concept is an abstract idea, just like the

basic hedging concept at issue in *Bilski* and the abstract idea of intermediated settlement in *Alice*.³

2. *Inventive Concept*

Turning to the second step of the analysis, we consider the elements of the challenged claims both individually and as an ordered combination to determine whether the additional elements transform the nature of the claim into a patent-eligible application. *Alice*, 134 S. Ct. at 2355. Step two of the analysis involves determining whether an element or combination of elements is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself. *Id.* (citing *Mayo*, 132 S. Ct. at 1294).

First, we consider the elements of the challenged claims separately. Independent claim 8 includes recitations relating to sending a personal health record from a health care provider to a server, such as a web server (Ex. 1001, 9:36–37), and then to the user’s computing device. *Id.* at 17:1–21. These recitations include associating access information with the user, such as a password, providing a user interface, receiving a request, and sending a file in response to the request. *Id.*

³ We further note that our determination is consistent with Patent Office guidance on subject matter eligibility. See 2014 Interim Guidance on Patent Subject Matter Eligibility, 79 Fed. Reg. 74,618, 74,622 (Dec. 16, 2014) (“Abstract ideas . . . by way of example, includ[e] . . . certain methods of organizing activities.”); see also July 2015 Update: Subject Matter Eligibility, <http://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf> (last visited August 20, 2015) (“The phrase ‘certain methods of organizing human activity’ is used to describe concepts relating to interpersonal and intrapersonal activities, such as managing . . . transactions between people.”).

We conclude that receiving and sending data is a routine and conventional computer function. As explained in *Alice*, “use of a computer to obtain data . . . and issue automated instructions . . . are ‘well-understood, routine, conventional activit[ies]’ previously known to the industry.” *Alice*, 134 S. Ct. 2359; *see also 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.”).

Restricting access by password also is routine and conventional. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 712–13, 717 (Fed. Cir. 2014) (determining that representative claim 1 is patent ineligible although it recites “a fourth step of restricting general public access.”). Similarly, providing a user interface is an insignificant activity. *See Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1342–43 (Fed. Cir. 2013) (determining that claim 1 is patent ineligible although it recites a “claim folder,” which “manages claim information . . . by providing a structured and easy to use interface.”).

Claim 8 includes additional recitations relating to how data is stored and managed on the server. We determine that these limitations recite generic functions performed by a generic server and computing device. Storing files is a basic computer function. *See Alice*, 134 S. Ct. at 2359 (“Using a computer to create and maintain ‘shadow’ accounts amounts to electronic recordkeeping—one of the most basic functions of a computer.”). Additionally, regarding the recitation in challenged claim 8 of “wherein the files are *maintained* on the server *independently* from any files maintained by the health care provider” (Ex. 1001, 17:18–19 (emphasis added)), we

note the representative claim in *Alice* had a similar recitation. *See Alice*, 134 S. Ct. at 2352.

In particular, in *Alice*, the representative claim included the following: “creating a shadow credit record and a shadow debit record for each stakeholder party *to be held independently* by a supervisory institution from the exchange institutions” (emphasis added). *Id.* Nonetheless, in *Alice*, the Supreme Court concluded that the claim reciting this independent-maintenance limitation was ineligible for patent protection. *Id.* at 2360. Given that the recitation of independent maintenance of electronic records was found in *Alice* to be merely the recitation of generic computer functions, the similar recitation here leads us to the same conclusion.

Second, we consider the challenged claims as an ordered combination. *Id.* at 2359. On this record, when viewed as a whole, the challenged claims 8–12 simply recite the concept of user management performed by a generic computer. The challenged claims, for example, do not purport to improve the functioning of the computer itself. Nor do they improve another technology or technical field.

Petitioner additionally relies on the Declaration of Dr. Bysinger (Pet. 20–28), who testifies that the recited elements including “server,” “storing files . . . in a computer readable storage medium,” and “user interface on a computing device” were well-known conventional concepts in 2005. Ex. 1008 ¶¶ 30–32. Dr. Bysinger additionally states “the abstract idea of privately accessing and managing patient medical records . . . [has] existed since at least the promulgation of HIPAA.” *Id.* ¶ 33. We credit Dr. Bysinger’s statements because they are consistent with the challenged claims.

Challenged dependent claims 9–12 add nothing that alters the above analysis under § 101. Claims 9, 10, 11, and 12 recite additional limitations, such as wherein the access information comprises a password, receiving files from a second provider, wherein the files comprise image format files including wills and powers of attorney, respectively. Based on the present record, these comprise either generic limitations, such as using a password for access or sending a file in a known image format, or they relate to organizing human activities, such as user management of legal and financial documents, in addition to health records.

Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that claims 8–12 of the '466 Patent are unpatentable under 35 U.S.C. § 101, because they are directed to non-statutory subject matter.

III. CONCLUSION

We conclude that Petitioner has shown by a preponderance of the evidence that each of claims 8–12 of the '466 Patent is unpatentable under 35 U.S.C. § 101, as being directed to non-statutory subject matter. This is a Final Written Decision of the Board under 35 U.S.C. § 328(a).

IV. ORDER

For the foregoing reasons, it is
ORDERED that, pursuant to 35 U.S.C. § 328, claims 8–12 of U.S. Patent No. 8,301,466 are determined to be *unpatentable*; and
FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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