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EXAMINER	
NAJARIAN, LENA	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte IAN KITCHING, RENE STERENTAL, ERIC KUO, LOU SHUMAN and MAIA SINGER

Appeal 2013-001912
Application 11/760,701
Technology Center 3600

Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER, and SCOTT C. MOORE, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant(s) seek our review under 35 U.S.C. § 134 of the Examiner's Final decision rejecting claims 1–14 and 25–31. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

Claim 1 is illustrative:

1. A method of managing delivery of an orthodontic treatment plan, comprising:

generating, using a computing device, a case difficulty assessment based on information received about a dental condition of a patient and one or more treatment goals;

generating, using a computing device, a treatment plan for a patient, the plan comprising a plurality of successive tooth arrangements for moving teeth along a treatment path from an initial arrangement toward a selected final arrangement, the plan further comprising a series of one or more treatment phases to move teeth along the treatment path, at least one phase comprising an individual set of appliances;

providing a customized set of treatment guidelines corresponding to a phase of the treatment plan, the guidelines comprising one or more appointment planning recommendations, the guidelines embodied in a tangible medium;

tracking progression of the patient's teeth along the treatment path, the tracking comprising comparing a digital representation of an actual arrangement of the patient's teeth following administration of a set of appliances to a planned arrangement to determine if the actual arrangement of the teeth substantially matches the planned tooth arrangement.

Appellants appeal the following rejections:

1. Claims 1–14 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.
2. Claims 1–6 and 9–14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Sachdeva (US 6,315,553 B1, issued Nov. 13, 2001) in view of Bair (US 6,067,523, issued May 23, 2000).
3. Claims 7, 8 and 25–31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sachdeva and Bair in view of Kenneth (US 2006/0004609 A1, pub. Jan. 5, 2006).

ISSUE

Did the Examiner err in rejecting claims 1–14 under 35 U.S.C. § 101 because the rejection did not include sufficient analysis of the claim language to establish a prima facie case?

Did the Examiner err in rejecting claim 1 under 35 U.S.C. § 103(a) because the Examiner has not established a reason to combine the teachings of Sachdeva and Bair so as to arrive at the claimed invention?

ANALYSIS

Rejection under 35 U.S.C. § 101

With regards to the rejection of claims 1–14, the rejection of record in the Examiner's Answer was mailed September 14, 2012, and applied only the machine or transformation test to these claims (Ans. 3-4). However, prior to the mailing of this rejection, the Supreme Court modified the analysis of non-statutory subject matter. The Supreme Court made clear in *Bilski v. Kappos*, 130 S. Ct. 3218, 3227 (2010), that a patent claim's failure to satisfy the machine-or-transformation test is not dispositive of the § 101 inquiry. Moreover, though the Answer discusses the machine-or-transformation test, the Examiner fails to apply even this test to the claims. The only analysis of the claims made by the Examiner is the statement on page 4 that it is unclear whether a human or a machine is performing the significant steps such as the step of tracking progression. There is no discussion of whether the claims recite an abstract idea. While the Examiner may be correct in asserting that the claims do not recite statutory subject matter, there is insufficient analysis of the claim language in the Examiner's

statement of the rejection to establish a prima facie case of unpatentability under § 101. As such, the rejection of claims 1–14 under 35 U.S.C. § 101 is not sustained.

Rejection under 35 U.S.C. § 103(a)

In rejecting claims 1–14 and 25–31 as being unpatentable over Sachdeva in view of Bair, the Examiner recognizes that Sachdeva does not disclose a case difficulty assessment based on information received about a dental condition of a patient, and relies on Bair for disclosing a case difficulty assessment.

We find that Sachdeva is directed to a method and apparatus for treatment of an orthodontic patient (Abst.). Bair is directed to a system and method for reporting behavioral health care data (col. 1, ll. 1–2). Bair discloses that a therapist rates the severity of the problem of the patient (col. 5, ll. 47–48). The Examiner concludes:

> At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned feature of Bair within Sachdeva. The motivation for doing so would have been to rate the severity of the problem (col. 5, lines 44–53 of Bair).

(Ans. Page 6).

Establishing a prima facie case of obviousness of an invention comprising a combination of known elements requires "an apparent reason to combine the known elements in the fashion claimed . . . ." *KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). The Examiner has not established that the applied prior art would have provided one of ordinary skill in the art with an apparent reason to include rating of the severity of the

problem in the Sachdeva method. In this regard, we agree with the Appellants that the Examiner has failed to establish how or why a person of ordinary skill in the art at the time of the invention would make a case difficulty assessment in the Sachdeva method. As such, the Examiner has not provided an apparent reason to modify Sachdeva to arrive at the claimed invention. Instead, the rejection appears to be based upon impermissible hindsight in view of the Appellants' disclosure. *See In re Warner,* 379 F.2d 1011, 1017 (CCPA 1967).

In view of the foregoing, we will not sustain the Examiner's rejection under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner is reversed.

REVERSED

rvb