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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/031,645	02/22/2011	Douglas J. Short	006269-000005	5408

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EXAMINER	
PAULSON, SHEETAL R.	

ART UNIT	PAPER NUMBER
3686	

NOTIFICATION DATE	DELIVERY MODE
12/03/2015	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):

DocketDept@uspatent.com

Office Action Summary	Application No. 13/031,645	Applicant(s) SHORT, DOUGLAS J.	
	Examiner SHEETAL R. PAULSON	Art Unit 3686	AIA (First Inventor to File) Status No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _BPAI Decision 8/3/2015_.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

5)☒ Claim(s) _1-27_ is/are pending in the application.
5a) Of the above claim(s) _____ is/are withdrawn from consideration.
6)☐ Claim(s) _____ is/are allowed.
7)☒ Claim(s) _1-27_ is/are rejected.
8)☐ Claim(s) _____ is/are objected to.
9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10)☐ The specification is objected to by the Examiner.
11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a)☐ All b)☐ Some** c)☐ None of the:
1.☐ Certified copies of the priority documents have been received.
2.☐ Certified copies of the priority documents have been received in Application No. _____.
3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b) Paper No(s)/Mail Date _____.
3) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
4) ☐ Other: _____.

1. The present application is being examined under the pre-AIA first to invent provisions.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more. Claims 1-27 are directed to a process for determination of wellness categories and whether or not to provide a credit for deductible. Although the claim limitations are among the four statutory classes of invention, the claims are directed to an abstract idea. Specifically, **the abstract idea is defined as covering a person in a health plan with a deductible, determining which wellness categories the person falls into based on blood test results and other health parameters and determining if a patient qualifies for a credit to the deductible** which is directed towards an "idea of itself" and "fundamental economic practices," which is are examples identified by the courts to be abstract ideas. Covering a person under a health benefit plan with predetermined deductibles is similar to the concept in *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350 (Fed. Cir. 2014), wherein creating a contractual relationship (such as the contractual relationship between a person and an insurance company that provides the health benefit plans) was found to be an abstract idea by the courts.

Determining the wellness categories and whether or not to provide a credit is similar to the concept in *SmartGene, Inc. v. Advanced Biological Laboratories, SA,* 555 Fed. Appx. 950 (Fed. Cir. 2014), wherein comparing new (such as health information including blood test results and other health parameters of a person) and stored information (such as the criteria to be met for specific wellness categories that are pre-set based on blood test results and other pre-set health parameters and related credit offsets for wellness categories) and using rules to identify options (such as comparing a person's blood test result to the pre-set limits for the wellness categories and determining the associated predetermined deductible) was found to be an abstract idea by the courts.

The claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional elements or combination of elements in the claims, other than the abstract idea per se, amount to no more than functions that are well-understood, routine, and conventional activities previously known to the pertinent industry **(such as the drawing and testing of a blood sample from a person)**. Applicant's specification in paragraph 11 discloses the blood testing to be old and well known in the art, such as testing for cholesterol, glucose levels, genetic illness, mental illness, and heart disease, which are all well-understood, routine, and conventional activities in the healthcare industry.

A claim directed to a judicial exception (an abstract idea), must be analyzed to determine if the claim as a whole amounts to significantly more than the judicial exception itself. Limitations that may be enough to qualify as significantly more include: improvements to another technology or technical field; improvements to the functioning of the computer itself; applying the judicial exception with, or by use of, a particular machine; effecting a

transformation or reduction of a particular article to a different state or thing; adding a specific limitation other than what is well-understood, routine and conventional in the field, or adding unconventional steps that confine the claim to a particular useful application.

In this case, the claims do not include limitations that meet the criteria listed above. The claims do not include improvements to another technology or technical field; nor do they include improvements to the functioning of the computer itself. The claims merely amount to the application or instructions to apply the abstract idea on a general purpose computer, and require nothing more than a generic computer system to carry out the abstract idea itself. Further, the claims do not include specific limitations adding unconventional steps that confine the claim to a particular useful application. Nor do they include limitations beyond generally linking the use of the abstract idea to a particular technological environment. As such, the claims, when considered as a whole, are nothing more than the instruction to implement the abstract idea in a well-understood, routine and conventional technological environment. Further, the claims do not include a transformation or reduction of a particular article to a different state or thing.

The dependent claims further limit the abstract idea without adding significantly more. Accordingly, the Examiner concludes that there are no meaningful limitations in the claims that transform the judicial exception into a patent eligible application such that the claim amounts to significantly more than the judicial exception itself.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEETAL R. PAULSON whose telephone number is (571)270-1368. The examiner can normally be reached on 5/4/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elaine Gort can be reached on (571) 272-6181. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHEETAL R PAULSON/
Primary Examiner, Art Unit 3686

/GREG VIDOVICH/
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