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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte REID M. RUBSAMEN

Appeal 2022–000391
Application 15/014,783
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner’s final rejection of claims 28–30. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellant claims a method for acquiring and analyzing a list of a patient's prescription medications. (Spec. ¶ 1, Title).

Claim 28 is representative of the subject matter on appeal.

28. In a computer system which implements a data receptor form on a screen which is accessible to a community of users, a method of analyzing data on a patient's prescribed pharmaceuticals, the method comprising the computer implemented steps of:

(a) providing a community of users with access to the computer system using word wide web access;

(b) generating a screen for user patient access wherein the screen prompts the user patient to manually enter data relating to the drugs being taken by the user patient;

(c) obtaining data manually entered by the user patient as prompted wherein the data comprises a list of drugs currently taken by the user patient;

(d) analyzing the manually entered list of drugs against a databank of potential healthcare providers in order to determine one or more healthcare providers which provide the highest benefits on the drugs listed by the user patient; and

(e) producing a result based on the analysis; and

(f) sending the result to the user patient

wherein the results of the analysis describe recent changes in benefits provided by benefits providers; and

further wherein the results comprise current information on government funding policies relating to prescription drug reimbursement.

THE REJECTION

Claims 28–30 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

ANALYSIS

35 U.S.C. § 101 REJECTION

We will sustain the rejection of the claims under 35 U.S.C. § 101.

The Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, . . . determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . If so, . . . then ask, “[w]hat else is there in the claims before us?” . . . To answer that question, . . . 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. . . . [The Court] described step two of this analysis 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.”

Alice Corp. Pty. Ltd. v. CLS Bank Int’l, 573 U.S. 208, 217–218 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)) (citations omitted).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept. The Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the [S]pecification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). It asks whether the focus of the claims is on a specific improvement in relevant technology or on a process that itself qualifies as an “abstract idea” for

which computers are invoked merely as a tool. *See id.* at 1335–36.

In so doing we apply a “directed to” two prong test: 1) evaluate whether the claim recites a judicial exception, and 2) if the claim recites a judicial exception, evaluate whether the judicial exception is integrated into a practical application. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 FR 50, pp 50–57 (Jan. 7, 2019) (“*Guidance*”).¹

Appellant argues all claims in the Appeal together, as a group. (Appeal Br. 11–21). We select independent claim 28 for analysis herein. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner determines that the claims are directed to a method of analyzing a patient’s prescribed pharmaceuticals. (Final Act. 2). The Examiner determines that the method falls in the category of a certain methods of organizing human activity and a mental process. The Examiner finds that judicial exceptions are not integrated into a practical application because the remaining elements amount to no more than general purpose computer components programmed to perform the abstract ideas. The Examiner finds the claims do not include additional elements that are sufficient to amount to significantly more than the judicial exceptions because they are recited at a high level of generality using generic computer components. (*Id.* at 5).

The Specification discloses that review of a patient’s medication regimen seldom occurs for a variety of reasons such as lack of motivation by the patient and the physician. If patients or their physicians could be motivated to periodically review their medications, a safer and/or more efficacious therapy could result.

¹ The MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) incorporates the revised guidance and subsequent updates at Section 2106 (9th ed. Rev. 10.2019, rev. June 2020).

(Spec. 2). In addition, the Specification discloses that a method for acquiring information from patients and analyzing it in a way so as to facilitate targeted marketing of specific pharmaceuticals to those patients. (Spec. ¶ 6). As such, the Specification discloses that the method of the invention seeks to motivate patients and physicians to review medications and use the information received for targeted advertisements.

Consistent with this disclosure, claim 28 recites “generating a screen for user patient access wherein the screen prompts the user patient to manually enter data,” “obtaining data manually entered,” “analyzing the manually entered list of drugs,” “producing a result based on the analysis,” and “sending the result to the user patient.”

We thus agree with the Examiner’s findings that the claims are directed to organizing the activities of humans (motivating patients to have drugs analyzed), which is a certain method of organizing human activity. Also, we agree with the Examiner that the steps of “obtaining data manually entered by the user patient . . . wherein the data comprises a list of drugs,” “analyzing the manually entered list of drugs,” and “producing a result,” constitute “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016); *see also buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (claims directed to certain arrangements involving contractual relations are directed to abstract ideas). Thus, we find that claim 28 recites the abstract idea of a certain method of organizing human activity and in the alternative, a mental process.

Turning to the second prong of the “directed to test”, claim 28 requires a “computer system,” and a “screen.” These recitations do not impose “a

meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *Guidance*, Fed. Reg. at 53. We find no indication in the Specification, nor does Appellant direct us to any indication, that the operations recited in independent claim 28 invoke any assertedly inventive programming, require any specialized computer hardware or other inventive computer components, i.e., a particular machine, or that the claimed invention is implemented using other than generic computer components to perform generic computer functions. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”).

We also find no indication in the Specification that the claimed invention effects a transformation or reduction of a particular article to a different state or thing. Nor do we find anything of record, short of attorney argument, that attributes any improvement in computer technology and/or functionality to the claimed invention or that otherwise indicates that the claimed invention integrates the abstract idea into a “practical application,” as that phrase is used in the revised *Guidance*. *See Guidance*, 84 Fed. Reg. at 55.

In this regard, these recitations do not affect an improvement in the functioning of the computer system or screen or other technology, do not recite a particular machine or manufacture that is integral to the claims, and does not transform or reduce a particular article to a different state or thing. *Id.* Thus, claim 28 is directed to a judicial exception that is not integrated into a practical application and thus claim 28 is directed to an abstract idea.

Turning to the second step of the *Alice* analysis, because we find that claim 28 is directed to abstract ideas, the claim must include an “inventive concept” in

order to be patent-eligible, i.e., there must be an element or combination of elements that is sufficient to ensure that the claim in practice amounts to significantly more than the abstract idea itself. *See Alice*, 573 U.S. at 217–18 (alteration in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)).

The introduction of a computer elements into the claim does not alter the analysis at *Alice* step two.

[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility. Nor is limiting the use of an abstract idea “to a particular technological environment.” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implemen[t]” an abstract idea “on . . . a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our § 101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional featur[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

Alice, 573 U.S. at 223 (alterations in original) (citations omitted).

Instead, “the relevant question is whether the claim [28] here does more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Id.* at 225. It does not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to retrieve, select, and apply decision criteria to data and modify the data as a result amounts to electronic data query and retrieval—one of the most basic functions of a computer. All of these computer functions are well-understood, routine,

conventional activities previously known to the trading industry. *See Elec. Power Grp.*, 830 F.3d at 1354; *see also In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1316 (Fed. Cir. 2011) (“Absent a possible narrower construction of the terms ‘processing,’ ‘receiving,’ and ‘storing,’ . . . those functions can be achieved by any general purpose computer without special programming”). In short, each step does no more than require a generic computer to perform generic computer functions. As to the data operated upon, “even if a process of collecting and analyzing information is ‘limited to particular content’ or a particular ‘source,’ that limitation does not make the collection and analysis other than abstract.” *SAP Am. Inc. v. InvestPic, LLC*, 890 F.3d 1016, 1022 (Fed. Cir. 2018).

Considered as an ordered combination, the computer components of Appellant’s claim 28 adds nothing that is not already present when the steps are considered separately. The sequence of data reception-analysis-access/display is equally generic and conventional or otherwise held to be abstract. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (sequence of receiving, selecting, offering for exchange, display, allowing access, and receiving payment recited an abstraction), *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (holding that sequence of data retrieval, analysis, modification, generation, display, and transmission was abstract), *Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (holding sequence of processing, routing, controlling, and monitoring was abstract). The ordering of the steps is, therefore, ordinary and conventional.

Claim 28 does not, for example, purport to improve the functioning of the computer system or screen. As we stated above, claim 28 does not effect an improvement in any other technology or technical field. The Specification spells

out different generic equipment and parameters that might be applied using this concept and the particular steps such conventional processing would entail based on the concept of information access under different scenarios. (*See, e.g.*, Spec. ¶¶ 54, 57, 58). Thus, claim 28 at issue amounts to nothing significantly more than instructions to apply the abstract idea of analyzing a patient's prescribed pharmaceuticals using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 573 U.S. at 226.

We have reviewed all the arguments (Appeal Br. 11–21) Appellant has submitted concerning the patent eligibility of the claims before us that stand rejected under 35 U.S.C. § 101. We find that our analysis above substantially covers the substance of all the arguments, which have been made. But, for purposes of completeness, we will address various arguments in order to make individual rebuttals of same.

We are not persuaded of error on the part of the Examiner by Appellant's argument that this case should be remanded because identical claims in an earlier version of this case were found patentable in 2015. (Appeal Br. 12). We agree with the Examiner's response to this argument found on page 4 of the Answer. In this regard, the opinion relied on was issued before the decision in *Alice*.

Appellant argues that in a similar manner to the claims in *Amdocs*, the claimed system provides unconventional results. This argument is not persuasive because Appellant does not explain *how* the instant claims provide unconventional results and how any results produced affect the eligibility of the claims. We agree with the Examiner's response to this argument found on page 4 of the Answer and adopt same as our own.

Appellant argues that the steps of the claim cannot be performed in the human mind. Specifically, Appellant argues that the human mind cannot gather the information necessary to perform the analysis claimed but does not explain why the human could not do so. We also note that the Examiner also determined that the claims fall under the category of a certain method organizing human activity and therefore even if the claims could not be performed in the human mind claim 28 would be abstract on that basis.

Appellant compares the claim 28 to the claim in Example 42 of the guidance and states that claim 28 is eligible for the same reason as Example 42. But once again, Appellant does not explain why this is so. Other than listing the limitations of the claim 28 in italics, Appellant does not explain the comparison. In this regard, we note that Example 42 was found to be eligible because non-standard format is converted to standard format and Appellant does not explain how claim 28 provides similar functions.

In view of the foregoing, we will sustain the Examiner's rejection.

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 28–30 under 35 U.S.C. § 101.

DECISION

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
28–30	101	Eligibility	28–30	

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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. § 1.136(a)(1)(iv).

AFFIRMED