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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/458,071	07/17/2006	Scott A. Miller	WHS-840	8204

52716 7590 11/02/2016

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ART UNIT	PAPER NUMBER
3626	

NOTIFICATION DATE	DELIVERY MODE
11/02/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SCOTT A. MILLER and CARL T. BERTRAM

Appeal 2014-009263
Application 11/458,071[1]
Technology Center 3600

Before HUBERT C. LORIN, BIBHU R. MOHANTY, and BRADLEY B. BAYAT, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Scott A. Miller and Carl T. Bertram (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–26. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and enter a NEW GROUND OF REJECTION.

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[1] The Appellants identify Walgreen Co. as the real party in interest. App. Br. 1.

THE INVENTION

Claim 17, reproduced below with bracketed matter added, is illustrative of the subject matter on appeal.

> 17. A computer-readable storage medium having computer-executable instructions stored in a memory to be executed on a processor for implementing a method of assessing health risks for a group of persons, the computer executable instructions comprising instructions for:
>
> [1] receiving patient parameter data relating to one or more patient risk factors for each of a plurality of persons;
>
> [2] receiving medical condition data relating to a medical condition for each of the plurality of persons;
>
> [3] receiving medication data relating to a medication for each of the plurality of persons for the medical condition, wherein the medication comprises at least part of an actual medical treatment received by the person to treat the medical condition;
>
> [4] creating a subset of persons from the plurality of persons based on the patient parameter data;
>
> [5] evaluating the medical condition data and the medication data to identify an adverse health outcome for each of the persons in the subset;
>
> [6] evaluating a likelihood of each identified adverse health outcome occurring based on the patient parameter data, the medical condition data and the medication data for each of the persons in the subset, and evaluating the level of risk of each identified adverse health outcome to determine an intervention severity index for each of the persons in the subset, wherein the intervention severity index is representative of the urgency involved in intervening in the medical treatment of the person;
>
> [7] providing a result from evaluating the likelihood of the identified adverse health outcome for each of the persons in the subset; and

[8] intervening in the medical treatment of the person in accordance with the intervention severity index, wherein an identified adverse health outcome having an intervention severity index greater than a predetermined threshold receives a different type of intervention than an identified adverse health outcome having an intervention severity index less than the predetermined threshold.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Martin	US 2003/0154109 A1	Aug. 14, 2003
Fitzgerald	US 2003/0191667 A1	Oct. 9, 2003
Teagarden	US 6,694,298 B1	Feb. 17, 2004
Burkeen	US 2005/0021368 A1	Jan. 27, 2005
Olson	US 2006/0190323 A1	Aug. 24, 2006

The following rejections are before us for review:

1. Claims 1–21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Teagarden, Martin, and Burkeen.
2. Claims 22–25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Teagarden, Martin, Fitzgerald, and Burkeen.
3. Claim 26 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Teagarden, Fitzgerald, and Olson.[2]

[2] Claim 26 depends from claim 22, so we assume the Examiner meant to find claim 26 unpatentable over Teagarden, Martin, Fitzgerald, Burkeen, and Olson.

ISSUES

Did the Examiner err in rejecting claims 1–21 under 35 U.S.C. § 103(a) as being unpatentable over Teagarden, Martin, and Burkeen?

Did the Examiner err in rejecting claims 22–25 under 35 U.S.C. § 103(a) as being unpatentable over Teagarden, Martin, Fitzgerald, and Burkeen?

Did the Examiner err in rejecting claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Teagarden, Fitzgerald, and Olson?

ANALYSIS

The independent claims are claims 1, 17, and 22. Independent claim 17 includes the limitation:

> intervening in the medical treatment of the person in accordance with the intervention severity index, wherein an identified adverse health outcome having an intervention severity index greater than a predetermined threshold receives a different type of intervention than an identified adverse health outcome having an intervention severity index less than the predetermined threshold

(App. Br. 33, Claims Appendix). Claims 1 and 22 contain similar limitations.

The Examiner takes the position, regarding limitation [8], that "the 'wherein clause' merely expresses the intended results; therefore it does not limit the claim and is not given patentable weight" (Final Act. 13) (emphasis omitted). In the Answer, for the first time, the Examiner finds that paragraphs 15, 29, 30, 33, and 34 of Burkeen describe the above limitation (Ans. 16–17).

The Appellants argue that the Examiner erred by failing to give patentable weight to the "wherein" clause because this clause gives "further meaning and purpose to the step of intervening, rather than expressing an intended result of the step of intervening" (App. Br. 9–13). The Appellants also contend that the cited portions of Burkeen do not disclose this limitation (App. Br. 17–21).

We agree with the Appellants that the Examiner erred by not giving patentable weight to the limitation in question because it requires a specific way of performing the intervening step (i.e., using a "predetermined threshold") rather than merely an intended outcome of the intervening step. We also agree with the Appellants that the cited passages of Burkeen do not disclose this limitation. Said passages describe configuring clinical safety checks that trigger clinical interventions, such as by using the user interface of Figures 10 and 11. Although each clinical intervention has a significance level 937 (*see* Figure 10), and each safety check is associated with specific interventions (*see* Figure 11), we see no evidence of comparing significance level 937 to a "predetermined threshold" of significance in order to determine "a different type of intervention" as required by the claim.

A prima facie case of obviousness has not been made out in the first instance by a preponderance of the evidence. Accordingly, the rejections are not sustained.

NEW GROUND OF REJECTION

Claims 1–26 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Alice Corp. Pty. Ltd. v. CLS Bank Int'l, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under §101.

According to *Alice* step one, "[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept," such as an abstract idea. *Id.* at 2355.

Taking claim 17 as representative of the claims on appeal, the claimed subject matter is directed to information gathering and then evaluating the gathered information. Information gathering and evaluation are fundamental building blocks of human ingenuity. As such it is an abstract idea.

Step two of *Alice* is "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.* at 2355.

We see nothing in the subject matter claimed that transforms the abstract idea of information gathering and evaluation into an inventive concept.

The computer-readable storage medium of claim 17 includes instructions for performing eight steps of gathering and evaluating particular information; that is, gathering particular data ("receiving patient parameter data . . . medical condition data . . . medication data"), identifying a first information ("subset of persons"), identifying a second information ("adverse health outcome"), evaluating the data ("likelihood . . . level of risk . . . intervention severity index"), providing resulting data ("result from evaluating"), and intervening in the medical treatment based on the resulting

data. Claim 1 is similar but omits steps [4] and [7]. Claim 22 is directed to "receiving a request" and "providing a medication therapy management service" that performs a service similar to the steps of claim 17.

The receiving, evaluating, and providing steps are known operations for obtaining a desired information and thus add little to patentably transform the information gathering abstract idea.

Furthermore, each of the receiving, evaluating, and providing steps are themselves abstract ideas. For example, "comparing new and stored information and using rules to identify medical options" is an abstract idea. *See SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 F. App'x 950, 955 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 58 (2014). *See also Blue Spike, LLC v. Google Inc.*, No. 14-CV-01650-YGR, 2015 WL 5260506 (N.D. Cal. Sept. 8, 2015), *aff'd sub nom., Blue Spike, LLC, v. Google Inc.*, No. 2016-1054, 2016 WL 5956746, *5 (Fed. Cir. Oct. 14, 2016) ("comparing one thing to another" is an abstract idea). Merely combining three abstract ideas does not render the combination any less abstract. *Cf. Shortridge v. Found. Constr. Payroll Serv., LLC*, No. 14-CV-04850-JCS, 2015 WL 1739256, *11 (N.D. Cal. Apr. 14, 2015), *aff'd*, No. 2015-1898, 2016 WL 3742816 (Fed. Cir. July 13, 2016).

As for the final step, "intervening in the medical treatment of the person" (claim 17), it simply expresses a mere post-solution activity. The claim does not specify any particular entity that performs the intervening step. The Specification discloses, for example, that the system "prompts a user, such as the patient's pharmacist or a pharmacist at a pharmaceutical care center 20, to intervene" via, e.g., "a daily print-out of interventions," or

"a prompt on a computer display" (Spec. para. 88), and that "interventions may be performed by a pharmacist" or "by a medical provider" (Spec., para. 105). *Cf. CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1371 (Fed. Cir. 2011) ("The Court [*Parker v. Flook*, 437 U.S. 584 (1978)] rejected the notion that the recitation of a practical application for the calculation could alone make the invention patentable"). Moreover, the intervening step is not linked to any device and thus could be practiced mentally (e.g., by a person such as a pharmacist). Adding a mental step cannot patentably transform an otherwise abstract idea into an inventive concept. *In re Comiskey*, 554 F.3d 967, 979 (Fed. Cir. 2009) ("mental processes—or processes of human thinking—standing alone are not patentable even if they have practical application").

Finally, we note that claim 17 calls for the recited instructions to be "computer-executable instructions stored in a memory to be executed on a processor." But any general-purpose computer available at the time the application was filed would have satisfied these limitations. The Specification supports that view. *See* paragraph 124 of the Specification ("routine(s) described herein may be implemented in a standard multi-purpose CPU"). "[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." *Alice* at 2358.

For the foregoing reasons, we find that claim 17 covers subject matter that is judicially-excepted from patent eligibility under § 101. The other independent claims – computer-readable storage medium claims 1 and 22

parallel claim 17 – similarly cover claimed subject matter that is judicially-excepted from patent eligibility under § 101. The dependent claims describe various information gathering schemes which do little to patentably transform the abstract idea.

Therefore, we enter a new ground of rejection of claims 1–26 under 35 U.S.C. § 101.

CONCLUSIONS

The rejection of claims 1–21 under 35 U.S.C. § 103(a) as being unpatentable over Teagarden, Martin, and Burkeen is reversed.

The rejection of claims 22–25 under 35 U.S.C. § 103(a) as being unpatentable over Teagarden, Martin, Fitzgerald, and Burkeen is reversed.

The rejection of claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Teagarden, Fitzgerald, and Olson is reversed.

Claims 1–26 are newly rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

DECISION

The decision of the Examiner to reject claims 1–26 is reversed.

Claims 1–26 are newly rejected.

NEW GROUND

This decision contains a new ground of rejection pursuant to 37 C.F.R.

§ 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that the Appellant(s), WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
>
> (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

REVERSED; 37 C.F.R. § 41.50(b)