



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
13/946,976 07/19/2013 Louis Christopher Tripoli 25136-0003002 6670

20985 7590 02/22/2018
FISH & RICHARDSON P.C. (SD)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

Table with 1 column: EXAMINER

NAJARIAN, LENA

Table with 2 columns: ART UNIT, PAPER NUMBER

3686

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

02/22/2018

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):

PATDOCTC@fr.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LOUIS CHRISTOPHER TRIPOLI

Appeal 2016-003854
Application 13/946,976
Technology Center 3600

Before CARL W. WHITEHEAD JR., JON M. JURGOVAN and
ADAM J. PYONIN, *Administrative Patent Judges*.

WHITEHEAD JR., *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant is appealing the final rejection of claims 38–49 under 35 U.S.C. § 134(a). Appeal Brief 2. We have jurisdiction under 35 U.S.C. § 6(b) (2012).

We affirm.

Introduction

The invention is directed to “systems, methods, and techniques for presenting a medication list to a patient and for maintaining updates to the medication list.” Specification, paragraph 6.

Illustrative Claim

38. A system comprising:
one or more hardware processors; and
non-transitory computer-readable medium encoding instructions that, when executed by the one or more hardware processors, cause the system to perform operations comprising:
presenting, in a graphical user-interface, a medication list comprising graphical representations of medication containers, the graphical representations of medication containers including a first container for a first drug and a second container for a second drug, with medication data on the containers corresponding to a prescription for the respective container;
determining a problem between the first drug and the second drug on the medication list;
presenting, in the graphical user-interface in response to the determining of the problem, a user selectable depiction of the first drug container and the second drug container in physical conflict until a resolution of the problem is received;
transmitting, in response to user input in the form of a selection of the depiction of the first drug container and the second drug container in physical conflict, the determined problem on the medication list to a health care professional for resolution;
receiving the resolution of the problem from the health care professional; and
presenting, in the graphical user-interface responsive to the received resolution, a health care professional graphical depiction resolving the physical conflict.

Rejection on Appeal

Claims 38–49 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to nonstatutory subject matter. Final Action 3.

ANALYSIS

Rather than reiterate the arguments of Appellant and the Examiner, we refer to the Appeal Brief (filed August 17, 2015), the Final Action

Appeal 2016-003854

Application 13/946,976

(mailed December 15, 2014) and the Answer (mailed December 18, 2015)
for the respective details.

35 U.S.C. § 101 rejection

Patent eligibility is a question of law that is reviewable *de novo*. *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012). Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). “The ‘abstract ideas’ category embodies the longstanding rule that ‘[a]n idea of itself is not patentable.’” *Id.* at 2355 (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (quotations omitted)).

The Supreme Court in *Alice* reiterated the two-step framework, set forth previously in *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1300 (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. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* (citing *Mayo*, 132 S. Ct. at 1296–97) (emphasis added). If so, the second step is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether the additional elements “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1297–98). In other words, the second step is to “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.* (alteration in original) (quoting *Mayo*, 132 S. Ct. at 1294). Thus, we first analyze the claims to determine whether the claims embody an abstract idea. If they do, then we proceed to determine whether the claims are meaningfully limited to a patent-eligible application of an abstract idea or cover nothing more than the abstract idea itself.

Turning to the first step of our analysis, we must determine whether the claims at issue are directed to a patent-ineligible concept, such as an abstract idea. *See Alice*, 134 S. Ct. at 2355. In order to determine whether claims at issue are directed to an abstract idea, we must first determine what the claims are directed to. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016).

The Examiner finds the claims “are directed to the abstract idea of human activities - manipulating an interactive [medication] list” because “the abstract idea of comparing new and stored information and using rules to identify options” wherein:

[t]he steps of presenting a medication list, determining a problem on the medication list, presenting in response to the determining a user selectable depiction of the containers, transmitting the determined problem in response to user selection, and receiving/presenting the resolution of the problem describe the concept of comparing new and stored information and using rules to identify options.

Final Action 3; Answer 4. Appellant argues the Examiner “failed to articulate what precisely is considered to be the abstract idea” because the Examiner’s analysis, including three different statements alleging what the

Appeal 2016-003854
Application 13/946,976

abstract idea is, “doesn’t provide any evidence for its conclusion that ‘the concept of lists’ is ‘a fundamental economic practice long prevalent in our system of commerce’ and that the ‘use of lists’ is ‘a building block of the modern economy.’” Appeal Brief 2–3 (citing Final Action 3–4).

The Office carries its procedural burden of establishing a *prima facie* case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011). Put simply, all that is required of the Office is that it set forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. *Id.*; *see also Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (noting that section 132 “is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection”). Accordingly, we agree with the Examiner’s findings that the claims are directed to an abstract idea. When “the focus of the asserted claims” is “on collecting information, analyzing it, and displaying certain results of the collection and analysis,” the claims are directed to an abstract idea. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016).

Appellant further argues “In the present case, there is no issue of preemption since the independent claim is directed to particular types of user interface depictions that improve the effectiveness of an interactive medication list, and so, the independent claim does not preempt essentially all uses of the alleged abstract idea.” Appeal Brief 4. We do not find Appellant’s argument persuasive. Although it is true that the Supreme Court

Appeal 2016-003854
Application 13/946,976

has characterized pre-emption as a driving concern for patent eligibility (*see Alice*, 134 S. Ct. at 2354), characterizing pre-emption as a driving concern for patent eligibility is not the same as characterizing pre-emption as the sole test for patent eligibility. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice Corp.*, 134 S. Ct. at 2354). However, “[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa*, 788 F.3d at 1379. *Cf. OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 701, 193 (2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”).

Appellant contends, “Independent claim 38 includes features that amount to an inventive concept for resolving a computer-based health care system’s problem of enabling any user (e.g., a user with very little computer experience) to manage many different prescribed medications with a computer-based system” and therefore the claim recite significantly more than an abstract idea. Appeal Brief 4.

We are not persuaded by Appellant’s contentions that the claims represent *significantly more* than the abstract idea exception. We agree with the Examiner’s findings that the additional elements or combination of elements in the claims “do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the computer as recited is a generic computer component (see paragraph 113 of

Appeal 2016-003854
Application 13/946,976

Applicant's Specification) that performs functions (*i.e.*, presenting information, analyzing information, transmitting information, and receiving information)." Answer 4. Appellant does not direct us to, nor do we discern, any indication in the record that any specialized computer hardware or other *inventive* computer components are required. *See* Appeal Brief 4–5. Rather than reciting additional elements that amount to *significantly more* than the abstract idea, the pending claims, at best, add only a "processor," "non-transitory computer readable medium" and a "graphical user interface" *i.e.*, generic components, which do not satisfy the inventive concept. *See, e.g., 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. The bare fact that a computer exists in the physical rather than purely conceptual realm 'is beside the point.'" (citation omitted)). For the foregoing reasons, we sustain the Examiner's nonstatutory subject matter rejection of claims 38–49.

DECISION

The Examiner's nonstatutory subject matter rejection of claims 38–49 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED