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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAJIV R. SHAH

Appeal 2016-005106[1]
Application 14/058,788[2]
Technology Center 3600

Before NINA L. MEDLOCK, MATTHEW S. MEYERS, and ROBERT J. SILVERMAN, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 18–24, 26–31, 36, and 37.[3] We have jurisdiction under 35 U.S.C. § 6(b).

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[1] Our decision references Appellant's Appeal Brief ("Appeal Br.," filed June 29, 2015), Reply Brief ("Reply Br.," filed April 8, 2016), the Examiner's Answer ("Ans.," mailed February 8, 2016), and Final Office Action ("Final Act.," mailed January 29, 2015).

[2] Appellant identifies MyMeds, Inc. as the real party in interest (Appeal Br. 1).

[3] The Examiner indicates that claims 32–35 are presently withdrawn (*see* Final Act. 2; Ans. 7, stating "Examiner submits that these claims have been withdrawn from consideration as being directed towards an impermissible

We AFFIRM.

CLAIMED INVENTION

Appellant's claimed invention relates generally "to systems and methods for increasing pharmaceutical competency of patients, by providing users/patients with a location to track, manage, learn about, and improve their understanding of the one or more medications they may be taking" (Spec. ¶ 21).

Claims 18 and 36 are the independent claims on appeal. Claim 18, reproduced below with added bracketed notations, is illustrative of the subject matter on appeal:

> 18. A computer-based method for managing one or more medications taken by a user, the method comprising:
>
> [a] receiving as computer readable storage media medication data from a source, wherein the medication data is related to the user's prescribed, dispensed, and claimed medicines;
>
> [b] storing the medication data in a database as non-transitory computer readable media;

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shift in invention that was not elected by original presentation."); *see also* Non-Final Office Action, mailed November 3, 2014, at page 3). In contrast, Appellant indicates that claims 32–35 "remain pending" (Appeal Br. 11; *see also* Applicant Arguments, filed January 22, 2015, at pages 6–7), and as such, asserts that claims 18–24 and 26–37 are presently rejected (*see* Appeal Br. 7; *see also* Reply Br. 5). The propriety of a restriction requirement is reviewable by petition to the Technology Center Director. *See* 37 C.F.R. § 1.144; MPEP §§ 818.03(c), 1002.02(c)(2), and 1201. Petitionable issues are not subject to review by the Board. *See In re Berger*, 279 F.3d 975, 984–85 (Fed. Cir. 2002). Accordingly, we provide no opinion concerning the propriety of the restriction requirement. Thus, claims 32–35 are not before us on appeal.

> [c] associating a unique identification for each user with the stored medication data for the user using computer executable instructions;
>
> [d] providing a computer-based user interface, whereby the stored medication data for the user is accessible to the user only after the user has provided an authentication; and
>
> [e] receiving an authentication provided by the user in computer readable form, the authentication associated with the user's unique identification;
>
> [f] providing a computer-implemented tutorial that the user may access from the user interface, wherein, using computer executable instructions, the tutorial interactively teaches the user to associate the name of a medication the user is taking with the clinical condition for which the medication was prescribed in order to increase the likelihood of the user taking the medication as prescribed; [and]
>
> [g] alerting the user via the user interface if two or more of the medications prescribed, dispensed, or claimed by the user are contra-indicated.

REJECTIONS

Claims 18–24, 26–31, 36, and 37 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter (*see* Final Act. 6–10).

Claims 18–24 and 26–31 are rejected under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement (*see* Final Act. 4–5).

ANALYSIS

Statutory Subject Matter

Independent claims 18 and 36, and dependent claims 19-24, 26–31, and 37

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (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 Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014). The first step in that analysis is to "determine whether the claims at issue are directed to one of those patent-ineligible concepts." *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered "individually and 'as an ordered combination'" to determine whether there are additional elements that "'transform the nature of the claim' into a patent-eligible application." *Id.* (quoting *Mayo*, 566 U.S. at 79, 78).

The Court acknowledged in *Mayo*, that "all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas." *Mayo*, 566 U.S. at 71. Therefore, the Federal Circuit has instructed that claims are to be considered in their entirety to determine "whether their character as a whole is directed to excluded subject matter." *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

Here, in rejecting claims 18–24, 26–31, 36, and 37 under 35 U.S.C. § 101, the Examiner determined that the claims, considered as a whole, are directed to an abstract idea of "managing medications taken by a person" without additional elements that transform it into a patent-eligible application of that idea (Final Act. 6). According to the Examiner, independent claim 18 is

> similar to certain methods of organizing human activities because the claimed steps, for example, mirror a mental process that a neurologist should follow when testing a patient for

> nervous system malfunctions. In this claim, the mental process involves interactively teaching the user about the medicine to increase the user's likelihood of taking the medication, and determining which medications are contra-indicated and determining if an alert should be generated for the user.

(Ans. 6).

In response, Appellant argues that the Examiner errs in rejecting the claims, because "[t]he Examiner did not cite any rule or precedent discussing what qualifies as 'organizing human activities'" (Appeal Br. 8; *see also* Reply Br. 8–15). More particularly, Appellant argues that the present claims cannot be directed to "organizing human activities" because they cannot be performed without the use of a machine (Appeal Br. 9). We cannot agree.

Under step one of the framework set forth in *Alice*, we agree with the Examiner that the invention is directed broadly to the concept of "managing medications taken by a person" (Final Act. 6), and similar to certain methods of organizing human activities that our reviewing courts have found patent ineligible, such as "unpatentable mental processes" including "steps [that] can be performed in the human mind, or by a human using a pen and paper" in *CyberSource Corp. v. Retail Decisions, Inc.* 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) and the concept of collecting information, analyzing it, and displaying certain results of the collection and analysis in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016).

In making this determination, we note that the present invention "is directed to systems and methods for increasing the pharmaceutical competency of patients, by providing users/patients with a location to track, manage, learn about, and improve their understanding of the one or more medications they may be taking" (Spec. ¶ 21). The Specification discloses

that one problem with our current healthcare system relates to "a patient seeing two or more doctors or specialists that do not always communicate with one another" (*id.* ¶ 3) which makes "it is difficult for many people to feel as though they have a handle on their health care" (*id.*). The Specification further discloses that "current methods of obtaining information about and/or tracking and/or managing one's prescription drug use may be too complicated, too time consuming, or too expensive" (*id.*), and thus, identifies "a need for a user-friendly, easy, informative way to manage one's prescription drug use" (*id.*).

We also note that independent claim 18 is directed generally to "[a] computer-based method for managing one or more medications taken by a user," including steps for "receiving . . . medication data," "storing the medication data," "associating a unique identification for each user with the stored medication data for the user," "providing a . . . user interface" for users to access stored medication data "only after the user has provided an authentication," "receiving an authentication provided by the user . . . , the authentication associated with the user's unique identification," "providing a . . . tutorial that the user may access from the user interface," and "alerting the user via the user interface if two or more of the medications prescribed, dispensed, or claimed by the user are contra-indicated." Here, independent claim 18 involves nothing more than receiving and storing data, associating the data with an identifier, providing a user interface to access the data, providing additional data, i.e., "tutorial," and alerting a user, without any particular inventive technology – an abstract idea. *See Elec. Power Grp.*, 830 F.3d at 1354.

Appellant further argues that independent claim 18 is not directed to an abstract idea because "[a]ccuracy is critical when determining contra-indicated medications, and the method of [c]laim 18 eliminates the possibility of human error" (Appeal Br. 10; *see also* Reply Br. 13–14). However, Appellant's argument is not persuasive at least because Appellant does not provide adequate evidence or technical reasoning as to how or why any efficiencies provided by the claimed invention are necessarily rooted in computer technology. The fact that "[c]laim 18 allows a user to securely and privately view all of his or her 'prescribed, dispensed, and claimed medicines' in one computer-based location, and provides important contra-indication warnings" (Appeal Br. 10) does not make the claimed invention any less abstract. "[R]elying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible." *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015).

Step two 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.'" *Alice*, 134 S. Ct. at 2355 (alteration in original) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012)).

And, similar to the situation in *Electric Power*, we find nothing sufficient to remove the claims from the class of subject matter ineligible for patenting. As the court explained in *Electric Power*, "merely selecting information, by content or source, for collection, analysis, and display does nothing significant to differentiate a process from ordinary mental processes,

whose implicit exclusion from § 101 undergirds the information-based category of abstract ideas." *Elec. Power Grp.*, 830 F.3d at 1355.

Here, Appellant argues that independent claim 18 recites limitations that amount to significantly more than "the purported abstract idea of organizing human activities" because the claim provides limitations which enable "a user to securely and privately access and manage his or her medication data for all 'prescribed, dispensed, and claimed medicines'" (Appeal Br. 16; *see also* Reply Br. 14–15). However, we agree with the Examiner that "when viewed as a whole and/or an ordered combination, [the claims do] not amount to significantly more than the abstract concept because the computer-implemented steps have been recited with a high level of generality" (Ans. 7–8). As the Examiner points out, "the claim does not provide 'specific ways' of using medication data. Instead, the claim makes use of generic computer technology to implement an abstract concept to manage medication contraindication" (*id.* at 8; *see also, e.g.*, Spec. ¶ 51 "a system or any portion thereof may be a personal computer (e.g., desktop or laptop), tablet computer, mobile device (e.g., personal digital assistant (PDA) or smart phone), server"; ¶ 31 "[w]hile passwords are described, other authentication and security methods are also contemplated and within the spirit of the present disclosure."). Thus, the individual steps of "receiving," "storing," "associating," "providing," "receiving," "providing," and "alerting" as recited by independent claim 18 do not supply an inventive concept because they merely require the application of conventional, well-known analytical steps. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014) ("[T]he claimed sequence of steps comprises only 'conventional steps, specified at a high level of generality,' which is

insufficient to supply an 'inventive concept.'") (citing *Alice*, 134 S. Ct. at 2357). There is no indication in the record that any specialized computer hardware or other non-generic computer components are required.

And, considered as an ordered combination, the computer components of Appellant's independent claims 18 and 36 add nothing that is not already present when the limitations are considered separately. Viewed as a whole, Appellant's claims simply recite to the concept of "managing medications taken by a person" (Final Act. 6) as performed by a general purpose computer (*see* Spec. ¶ 51). The claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of "managing medications taken by a person" (Final Act. 6), i.e., receiving and storing data, associating the data with an identifier, providing a user interface to access the data, providing a "tutorial," and alerting a user, which under our precedents, is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2360.

Appellant further argues that "[t]he allowance of Claim 18 would not 'pre-empt' any field or 'effectively grant a monopoly' over organizing human activities" (Appeal Br. 18 (citing *Alice Corp.*, 134 S. Ct. at 2354)). However,

> [t]he Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability. *Alice*, 134 S. Ct. at 2354 ("We have described the concern that drives this exclusionary principle as one of pre-emption[.]"). For 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). Preemption concerns are, thus, fully addressed and rendered moot where a claim is determined to disclose patent ineligible subject matter under the two-part framework described in *Mayo* and *Alice*. Although "preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility" (*id.*).

In view of the foregoing, we sustain the Examiner's rejection under 35 U.S.C. § 101 of independent claim 18, and dependent claims 19–24 and 26–31, which are not separately argued.

Appellant argues independent claim 36 under a separate heading, but relies on the arguments for independent claim 18 (*see* Appeal Br. 20–21; *see also* Reply Br. 15). We find no meaningful distinction between independent method claim 18 and independent system claim 36. The claims all are directed to the same underlying invention. Therefore, we also sustain the rejection of independent claim 36 and claim 37, dependent therefrom, under § 101 for the same reasons. As the Federal Circuit has made clear, "the basic character of a process claim drawn to an abstract idea is not changed by claiming only its performance by computers, or by claiming the process embodied in program instructions on a computer readable medium." *See CyberSource*, 654 F.3d at 1375–76 (citing *In re Abele*, 684 F.2d 902 (CCPA 1982)).

Software Per Se

As discussed above, we agree with the Examiner's determination that claims 18–24, 26–31, 36, and 37 are directed to subject matter that is not patent-eligible under 35 U.S.C. § 101. Accordingly, the Examiner's

alternative rejection of claims 36 and 37 under 35 U.S.C. § 101 is cumulative and therefore not addressed.

Written Description

In rejecting claims 18–24 and 26–31 under 35 U.S.C. § 112(a) (AIA), the Examiner finds that the Specification fails to support the "alerting" limitation wherein "drugs are *prescribed* and/or *dispensed* 'by the user,'" (Final Act. 5; *see also* Ans. 3–4) because "the *user* is not both a pharmacist and a physician. In fact, she is neither. The user is understood to be the patient . . . who can only 'claim' certain medications" (Final Act. 5). Additionally, the Examiner finds that "there is a single *source* of [medication] data. The source could be the user's employer" (*id.*) for providing information about medications that were prescribed and dispensed and the user for providing information about the "claimed" medications (Final Act. 5; *see also* Ans. 4–5). However, the Examiner finds that the Specification discloses at least these two sources of data and not a single source of data (*see* Ans. 5). Therefore, the Examiner finds Appellant has "not yet described a communication process, which allows for the scope of the added alerts" (*see* Final Act. 5).

In response, Appellant argues that the Examiner's rejection is improper, because "[t]he Examiner's assertion that Claim 18 requires that a user prescribe, dispense, and claim his or her medications is narrow, unreasonable, and inconsistent with the Applicant's [S]pecification. The [S]pecification makes continued reference to a doctor prescribing medications, and to a pharmacy dispensing medication" (Reply Br. 6–7 (citing Spec. ¶¶ 3, 25, 29, 41, 42)). Appellant also argues that "the recitation

of 'a source' in Claim 18 is not restrictive and does not limit the Claim to including only one source. However, the Specification does make clear that an employer, for example, may be the source for prescribed, dispensed, and claimed medication data" (Reply Br. 7 (citing Spec. ¶ 32)).

Whether a Specification complies with the written description requirement of 35 U.S.C. § 112(a) (AIA), is a question of fact and is assessed on a case-by-case basis. *See, e.g.*, *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991)). The disclosure, as originally filed, need not literally describe the claimed subject matter (i.e., using the same terms or *in haec verba*) in order to satisfy the written description requirement. But the Specification must convey with reasonable clarity to those skilled in the art that, as of the filing date, Appellant was in possession of the claimed invention. *See id.*

At the outset, we agree with Appellant that the Examiner's claim construction is inconsistent with the Specification. The Specification indicates that patients "may have more than one doctor prescribing drugs for them" (Spec. ¶ 3). The patient's employer may provide a batch file containing prescription history for all employees to the Portal Provider System (PPS), and the specific data provided may include the prescribing physician information and pharmacy name (*see* Spec. ¶ 25). Furthermore, "[i]f a new pharmacy is used, the [PPS] may be updated to reflect this" (Spec. ¶ 32). Thus, we agree with Appellant's claim construction that the "[claim] calls for alerting the user via the interface if two or more medications prescribed to the user, dispensed to the user, or claimed 'by the user' are contra-indicated" (Appeal Br. 6). Thus, we find that a person of

ordinary skill in the art would reasonably understand from the Specification (including the drawings), as originally filed, that the Specification provides written description support for the alerting limitations, as presently claimed (*see, e.g.*, Spec. ¶¶ 3, 25, 29, 32, 41, 42).

As to "a source," we agree with Appellant that the claim term "a source" does not limit the claim to "only one source" (Reply Br. 7). *See, e.g., Tate Access Floors, Inc. v. Interface Architectural Res., Inc.*, 279 F.3d 1357, 1370 (Fed. Cir. 2002) ("It is well settled that the term 'a' or 'an' ordinarily means 'one or more.'"); *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000). Furthermore, we find that a person of ordinary skill in the art would reasonably understand from the Specification (including the drawings), as originally filed, that the Specification provides written description support for "a source," to be for example, an employer (Reply Br. 7 citing (Spec. ¶ 32) or a user (Spec. ¶ 32) as presently claimed.

Therefore, we do not sustain the Examiner's rejection of claims 18–24 and 26–31, under 35 U.S.C. § 112(a) (AIA).

DECISION

The Examiner's rejection of claims 18–24, 26–31, 36, and 37 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejection of claims 18–24 and 26–31 under 35 U.S.C. § 112(a) or 35 U.S.C. § 112(a) (AIA), is reversed.

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)(iv).

AFFIRMED