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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MICHAEL A. KERESMAN III, JEFFRY J. BOWMAN,  
FRANCIS M. SHERWIN, CHANDRA S. BALASUBRAMANIAN, and  
RAVISHANKAR S. BHAGAVATULA

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Appeal 2016-005760  
Application 13/338,586<sup>1</sup>  
Technology Center 3600

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Before JOHN A. EVANS, JOYCE CRAIG, and SCOTT E. BAIN,  
*Administrative Patent Judges.*

BAIN, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–10 and 12–20, which constitute all claims pending in the application. Claim 11 has been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> Appellants identify the real party in interest as Cardinal Commerce Corporation. App. Br. 1.

STATEMENT OF THE CASE

*The Claimed Invention*

The claimed invention relates to processing drug prescriptions via the Internet, by using a third party to authenticate the prescribing doctor and patient. Spec. ¶¶ 2–7. Claims 1, 9, and 16 are independent. Claim 1 is illustrative of the invention and the subject matter of the appeal, and reads as follows:

1. A computer-implemented method of processing drug prescriptions via the Internet, said method comprising:

receiving a first request over the Internet at a server of a pharmacy registered with an external agent, wherein the first request is received from a doctor registered with the external agent and specifies a prescription, wherein the prescription identifies a patient registered with the external agent;

redirecting the doctor to the external agent via the server and using the Internet, wherein the external agent authenticates the doctor and returns the doctor to the server using the Internet;

receiving a second request over the Internet at the server, wherein the second request is received from the patient registered with the external agent and specifies an order for the prescription;

redirecting the patient to the external agent via the server and using the Internet, wherein the external agent authenticates the patient and returns the patient to the server using the Internet;

receiving a patient-specific authorization level for the patient from the external agent at the server, the patient-specific authorization level including one or more limitations on authorized order requests from the patient; and,

the server rejecting the second request in response to the second request violating the patient-specific authorization level and allowing the second request otherwise;

wherein the method is performed by a pharmacy registered with an external agent.

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App. Br. 17–18 (Claims App.).

*The Rejection on Appeal*

Claims 1–10 and 12–20 are rejected under 35 U.S.C. § 101 as directed to ineligible subject matter. Final Act. 2–3.

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments presented in this appeal. Arguments which Appellants could have made but did not make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). On the record before us, we are not persuaded the Examiner erred. We adopt as our own the findings and reasons set forth in the rejection from which the appeal is taken and in the Examiner’s Answer, and provide the following for highlighting and emphasis.

The Examiner finds the claims are directed to the abstract idea of “processing [a] drug prescription,” and that any additional elements do not amount to significantly more than the abstract idea itself. Final Act. 2–3. Accordingly, the Examiner concludes the claims are directed to ineligible subject matter. *Id.* Appellants argue the Examiner erred because the invention “improves the technical functioning of a server of a pharmacy,” is directed to “an Internet-centric problem,” and the claims “do not unduly preempt the field.” App. Br. 11–15. In other words, Appellants do not dispute the Examiner’s findings under the first step of the *Alice* test, but rather, argue the claims satisfy the second step of *Alice*. *Id.* We are not persuaded.

Section 101 of the Patent Act provides “[w]hoever 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.” 35 U.S.C. § 101. The Supreme Court has long held that this provision contains an implicit exception: “[l]aws 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 (2013)). The Court has set forth a two-part inquiry to determine whether this exception applies. First, we must “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Alice*, 134 S. Ct. at 2355. Second, if the claim is directed to one of those patent-ineligible concepts, we 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.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1297 (2012)). Put differently, we must search the claims for an “inventive concept,” that is, “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 (quoting *Mayo*, 132 S. Ct. at 1294).

As noted above, Appellants do not dispute the Examiner’s finding, under the first step of *Alice*, that the claims are directed to the abstract idea of processing or filling a drug prescription, and we discern no error in that finding on this record.

Appellants focus their argument on the second step of *Alice*. In this second step,

we must examine the elements of the claim to determine whether it contains an “inventive concept” sufficient to “transform” the claimed abstract idea into a patent-eligible application. A claim that recites an abstract idea must include “additional features” to ensure “that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].”

*Alice Corp.*, 134 S. Ct. at 2357 (internal citations omitted). Appellants contend the invention “improves the technical functioning of a server of a pharmacy,” but Appellants’ only support for this argument consists of identifying general purpose servers, processors, and memory (as well as the Internet itself). App. Br. 11–12; Spec. Fig. 1, ¶¶ 5, 59. Such generic computing elements, however, “do not alone transform an otherwise abstract idea into patent-eligible subject matter.” *FairWarning IP, LLC, v. Iatric Sys., Inc.*, 839 F.3d 1089, 1096 (Fed. Cir. 2016) (citing *DDR Holdings, LLC, v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014)); Ans. 2.

Similarly, we discern no error in the Examiner’s finding that fulfilling prescription orders is not an “Internet-centric problem,” nor is it analogous to “example 21, claim 2” as cited in Appellants’ Brief. App. Br. 13 (citing example related to wireless backup for transmitting stock quotations when primary computer is offline). Rather, Appellants’ invention substitutes one generic server (the “external agent”) for another generic server (“server of a pharmacy”) to perform authentication. Ans. 3.

Finally, Appellants argue that the claims “confine[e] the abstract idea to a particular useful application,” and therefore do not “unduly preempt the field.” App. Br. 14. As the Examiner finds, however, the alleged absence of preemption does not transform abstract claims into eligible subject matter. *See, e.g., FairWarning IP*, 829 F.3d at 1098 (quoting *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015)); *see also OIP*

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*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.”).

Accordingly, we sustain the rejection of claims 1–10 and 12–20 as directed to ineligible subject matter.

#### DECISION

We affirm the Examiner’s decision rejecting claims 1–10 and 12–20.

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. § 41.50(f).

AFFIRMED