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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PETER CARL STUECKEMANN,
PANKAJ DUBEY,
RICHARD LANIER,
PRAKASH VENKATARAMANAN,
VAIBHAV JINDAL,
and SHANNON MARIE SWORD¹

Appeal 2016-006702
Application 14/107,154
Technology Center 3600

Before ANTON W. FETTING, BIBHU R. MOHANTY, and
NINA L. MEDLOCK, *Administrative Patent Judges*.

FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Appellants identify the Real Party in Interest as AbbVie Biotechnology Ltd. App. Br. 1.

STATEMENT OF THE CASE²

Peter Carl Stueckemann, Pankaj Dubey, Richard Lanier, Prakash Venkataramanan, Vaibhav Jindal, and Shannon Marie Sword (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1–3 and 5–31, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

The Appellants invented a way of facilitating, coordinating, or managing healthcare products and/or services, such as pharmaceutical products, drugs, medical devices, or other prescribed medical treatments. Specification para. 2.

An understanding of the invention can be derived from a reading of exemplary claim 25, which is reproduced below (bracketed matter and some paragraphing added).

25. A method for facilitating a medical order/prescription of a prescription product for a patient covered by a provider by providing an encrypted and compressed data message that includes a benefits summary and a populated form, comprising:

[1] providing at least one memory having stored therein a plurality of predefined forms for the prescription product, the plurality of predefined forms corresponding to a plurality of providers, the prescription product including a biologic product;

[2] receiving, from a healthcare provider (HCP) computing device, (i) patient intake information including provider

² Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed October 21, 2015) and Reply Brief (“Reply Br.,” filed June 23, 2016), and the Examiner’s Answer (“Ans.,” mailed April 26, 2016), and Final Action (“Final Act.,” mailed March 27, 2015).

information of the patient and (ii) prescription product information for the prescription product;

[3] generating, by a processor, a benefits verification request for the patient based on the patient intake information;

[4] obtaining a benefits summary based on the benefits verification request;

[5] selecting one of the predefined forms based on at least one of the patient provider information and the benefits summary;

[6] populating at least one field of the selected predefined form based on the patient intake information;

[7] generating a data message that includes the benefits summary and the populated form;

[8] encrypting the data message to protect patient privacy and to secure the data message for transmission to the HCP computing device, wherein the HCP computing device is a mobile device;

[9] compressing the data message to reduce data size and to facilitate transmission of the data message to the HCP computing device;

[10] transmitting the encrypted and compressed data message to the HCP computing device; and

[11] causing the benefits summary and the populated form to be displayed on the HCP computing device to enable review of the benefits summary by the HCP, and to enable review and signature of the populated form by the HCP.

Claims 1–3 and 5–31 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

ISSUES

The issues of eligible subject matter turn primarily on whether the claims recite more than abstract conceptual advice of what a computer is to provide without implementation details.

ANALYSIS

Method claim 25 recites storing forms in memory, receiving patient and prescription product data, generating a request and obtaining a summary based on the request, selecting and populating a form, and generating, encrypting, compressing, transmitting and displaying the form. Thus, claim 25 recites receiving, analyzing, modifying, transmitting, and displaying data. Encryption and compression have been so universally incorporated in data transmission since the break out of the Internet as to be subsumed into the very concept of data transmission. None of the limitations recites implementation details for any of these steps, but instead recite functional results to be achieved by any and all possible means. Data reception, analysis, modification, transmission, and display are all generic, conventional data processing operations to the point they are themselves concepts awaiting implementation details. The sequence of data reception-analysis-modification-transmission-display is equally generic and conventional. The ordering of the steps is, therefore, ordinary and conventional. The remaining claims merely describe process parameters, with no implementation details.

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, we 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. v. CLS Bank Int’l, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012)).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept. The Examiner determines the claims to be directed to facilitating a medical order/prescription of a prescription product. Final Act. 2.

Although the Court in *Alice* made a determination as to what the claims were directed to, we find that this case’s claims themselves and the Specification provide enough information to inform one as to what they are directed to.

The preamble to claim 25 recites that it is a method for facilitating a medical order/prescription of a prescription product for a patient covered by a provider by providing an encrypted and compressed data message that includes a benefits summary and a populated form. The steps in claim 25

result in generating, transmitting, and displaying a healthcare form absent any technological mechanism other than a conventional computer for doing so. The Specification at paragraph 2 recites that the invention relates to facilitating, coordinating, or managing healthcare products and/or services, such as pharmaceutical products, drugs, medical devices, or other prescribed medical treatments. Thus, all this evidence shows that claim 25 is directed to generating, transmitting, and displaying a healthcare form, i.e. presenting healthcare information. This is consistent with the Examiner's determination.

It follows from prior Supreme Court cases, and *Bilski* (*Bilski v. Kappos*, 561 U.S. 593 (2010)) in particular, that the claims at issue here are directed to an abstract idea. Like the risk hedging in *Bilski*, the concept of presenting healthcare information is a fundamental business practice long prevalent in our system of medicine. The use of presenting healthcare information is also a building block of ingenuity in medical diagnosis. Thus, presenting healthcare information, like hedging, is an "abstract idea" beyond the scope of § 101. *See Alice Corp. Pty.*, 134 S. Ct. at 2356.

As in *Alice*, we need not labor to delimit the precise contours of the "abstract ideas" category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of risk hedging in *Bilski* and the concept of presenting healthcare information at issue here. Both are squarely within the realm of "abstract ideas" as the Court has used that term. *See Alice Corp. Pty.*, 134 S. Ct. at 2357.

Further, claims involving data collection, analysis, and display are directed to an abstract idea. *Elec. Power Grp. LLC v. Alstom S.A.*, 830 F.3d

1350, 1353 (Fed. Cir. 2016) (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent-ineligible concept”); *see also In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016). Claim 25, unlike the claims found non-abstract in prior cases, uses generic computer technology to perform data reception, analysis, modification, transmission, and display and does not recite an improvement to a particular computer technology. *See, e.g., McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314–15 (Fed. Cir. 2016) (finding claims not abstract because they “focused on a specific asserted improvement in computer animation”). As such, claim 25 is directed to the abstract idea of receiving, analyzing, modifying, displaying, and transmitting data.

The remaining claims merely describe process parameters. We conclude that the claims at issue are directed to a patent-ineligible concept.

The introduction of a computer into the claims does not alter the analysis at *Mayo* 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 “implement[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 feature[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

Alice Corp. Pty., 134 S. Ct. at 2358 (citations omitted).

“[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea [] on a generic computer.” *Alice Corp. Pty.*, 134 S. Ct. at 2359. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer for receiving, analyzing, modifying, transmitting, and displaying data amounts to electronic data query and retrieval—one of the most basic functions of a computer. Encryption and compression have been so universally incorporated in data transmission since the break out of the Internet as to be subsumed into the very concept of data transmission.³ All of these computer functions are well-understood, routine, conventional activities previously known to the industry. *See Elec. Power Grp. v. Alstom S.A.*, *supra*. *See also In re Katz Interactive Call Processing Patent Litigation*, 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

³ *See e.g.*, Bidgoli (ed.), *Handbook of Information Security, Key Concepts, Infrastructure, Standards, and Protocols*, p, 416, (2006)
<https://books.google.com/books?id=bdxJhKW0e8wC&pg=PA416>.

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) (quoting *Elec. Power*, 830 F.3d at 1353). Referring to the data as a “data message,” as recited, adds nothing because no implementation details for such a message are recited, and any data transmission with a beginning and end is within the scope of a message.

Considered as an ordered combination, the computer components of Appellants’ method add nothing that is not already present when the steps are considered separately. The sequence of data reception-analysis-modification-transmission-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) (sequence of data retrieval, analysis, modification, generation, display, and transmission); *Two-Way Media Ltd. v. Comcast Cable Commc’ns., LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (sequence of processing, routing, controlling, and monitoring). The ordering of the steps is, therefore, ordinary and conventional.

Viewed as a whole, Appellants’ method claims simply recite the concept of presenting healthcare information as performed by a generic computer. To be sure, the claims recite doing so by advising one to select

and enter data in a form on one computer and send it along with a benefits summary to another computer for review. But this is no more than abstract conceptual advice on the parameters for such presenting healthcare information and the generic computer processes necessary to process those parameters, and does not recite any particular implementation.

The method 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. The Specification spells out different generic equipment⁴ and parameters that might be applied using this concept and the particular steps such conventional processing would entail based on the concept of presenting healthcare information under different scenarios. They do not describe any particular improvement in the manner a computer functions. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of presenting healthcare information using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp. Pty.*, 134 S. Ct. at 2360.

As to the structural claims, they

are no different from the method claims in substance. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea. This Court has long “warn[ed] ... against” interpreting § 101 “in

⁴ The Specification describes the client computers as computers including a web browser and does not describe server hardware, but only that servers may include various commonplace server software. Spec. para. 59.

ways that make patent eligibility ‘depend simply on the draftsman’s art.’”

Alice Corp. Pty., 134 S. Ct. at 2360 (quoting *Mayo*, 566 U.S. at 72).

As to Appellants’ Appeal Brief arguments, we adopt the Examiner’s determinations and analysis from Final Action 2 and Answer 3–8 and reach similar legal conclusions. We now turn to the Reply Brief.

We are not persuaded by Appellants’ argument that the Examiner provides no support for the allegation that the claims recite an abstract idea. Reply Br. 1. We determine *supra* the intrinsic evidence is sufficient to support this determination.

We are not persuaded by Appellants’ argument that the Examiner fails to present a *prima facie* case because he did not follow a USPTO memorandum. Reply Br. 2. The Examiner properly made findings as per *Alice*. Failure to follow Examiner Guidelines is beyond our jurisdiction and remedy is to be found by petition to the Director. *See* MPEP § 1201.

Appellants further argue that the asserted claims are akin to the claims found patent-eligible in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014). Reply Br. 3–4. In *DDR Holdings*, the court evaluated the eligibility of claims “address[ing] the problem of retaining website visitors that, if adhering to the routine, conventional functioning of Internet hyperlink protocol, would be instantly transported away from a host’s website after ‘clicking’ on an advertisement and activating a hyperlink.” *Id.* at 1257. There, the court found that the claims were patent eligible because they transformed the manner in which a hyperlink typically functions to resolve a problem that had no “pre-Internet analog.” *Id.* at 1258. The court cautioned,

however, “that not all claims purporting to address Internet-centric challenges are eligible for patent.” *Id.* For example, in *DDR Holdings* the court distinguished the patent-eligible claims at issue from claims found patent-ineligible in *Ultramercial*. *See id.* at 1258–59 (citing *Ultramercial*, 772 F.3d at 715–16). As noted there, the *Ultramercial* claims were ““directed to a specific method of advertising and content distribution that was previously unknown and never employed on the Internet before.”” *Id.* at 1258 (quoting *Ultramercial*, 772 F.3d at 715–16). Nevertheless, those claims were patent ineligible because they “merely recite[d] the abstract idea of ‘offering media content in exchange for viewing an advertisement,’ along with ‘routine additional steps such as updating an activity log, requiring a request from the consumer to view the ad, restrictions on public access, and use of the Internet.’” *Id.* (quoting *Ultramercial*, 772 F.3d at 715–16).

Appellants’ asserted claims are analogous to claims found ineligible in *Ultramercial* and distinct from claims found eligible in *DDR Holdings*. The ineligible claims in *Ultramercial* recited “providing [a] media product for sale at an Internet website”; “restricting general public access to said media product”; “receiving from the consumer a request to view [a] sponsor message”; and “if the sponsor message is an interactive message, presenting at least one query to the consumer and allowing said consumer access to said media product after receiving a response to said at least one query.” 772 F.3d at 712. Similarly, Appellants’ asserted claims recite receiving, analyzing, modifying, transmitting, and displaying data. This is precisely the type of Internet activity found ineligible in *Ultramercial*.

Appellants further argue that the asserted claims are akin to the claims found patent-eligible in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016). The claims differ from those found patent eligible in *Enfish*, where the claims were “specifically directed to a *self-referential* table for a computer database.” 822 F.3d at 1337. The claims thus were “directed to a specific improvement to the way computers operate” rather than an abstract idea implemented on a computer. *Id.* at 1336. Here, by contrast, the claims are not directed to an improvement in the way computers operate. Though the claims purport to accelerate the process of selecting and transmitting a form, our reviewing court has held that speed and accuracy increases stemming from the ordinary capabilities of a general purpose computer “do[] not materially alter the patent eligibility of the claimed subject matter.” *Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012). Instead, the claims are more analogous to those in *FairWarning*, wherein claims reciting “a few possible rules to analyze audit log data” were found directed to an abstract idea because they asked “the same questions (though perhaps phrased with different words) that humans in analogous situations detecting fraud have asked for decades.” 839 F.3d at 1094, 1095.

We are not persuaded by Appellants’ argument that the claims provide a technological advantage to protect privacy and reduce bandwidth by encrypting and compressing the data. Reply Br. 4–5. The claims recite no technological implementation for such encryption and compression, but only recite the concept of doing so. As such, the claims recite no more than abstract conceptual advice for doing so.

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The claims thus do not go beyond “stating [the relevant] functions in general terms, without limiting them to technical means for performing the functions that are arguably an advance over conventional computer and network technology.”

Affinity Labs of Texas, LLC v. Amazon.com Inc., 838 F.3d 1266, 1271 (Fed. Cir. 2016) (quoting *Elec. Power*, 830 F.3d at 1351).

CONCLUSIONS OF LAW

The rejection of claims 1–3 and 5–31 under 35 U.S.C. § 101 as directed to non-statutory subject matter is proper.

DECISION

The rejection of claims 1–3 and 5–31 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). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2011).

AFFIRMED