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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROGER PINSONNEAULT and BRIAN BERTHA

Appeal 2016-008201¹
Application 12/650,759
Technology Center 3600

Before MURRIEL E. CRAWFORD, MICHAEL W. KIM, and
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1–8, 14–19, 21, and 22. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6.

¹ The Appellants identify “real party in interest is McKesson Financial Holdings.” Appeal Br. 3.

The invention relates generally to “providing adherence-based messages and benefits based upon evaluations of healthcare transactions.”

Spec. ¶ 1.

Claim 1 is illustrative:

1. A computer-implemented method, comprising:

receiving, by a service provider computer associated with a service provider from a healthcare provider computer, a first healthcare transaction comprising a product identifier that identifies a product to be dispensed, and at least one patient identifier that identifies a patient receiving the product, the first healthcare transaction associated with a first date, wherein the first date is a next refill date calculated based at least in part on the date of service for the first healthcare transaction and based upon at least one of a days' supply or a dispensed quantity identified by the first healthcare transaction;

comparing, by the service provider computer, the product identifier from the first healthcare transaction to a list of one or more identifiers associated with a product monitored under an adherence monitoring program;

determining, by the service provider computer and based upon the comparison, that the product is associated with the adherence monitoring program, the adherence monitoring program indicating patient specifications for patient utilization of the product;

storing, by the service provider computer and based at least in part upon a determination that the patient is associated with an adherence monitoring program, an association between the patient, the product to be dispensed, and the first date associated with the first healthcare transaction;

receiving, by the service provider computer from a healthcare provider computer, a second healthcare transaction that identifies the product to be dispensed, and the patient for receiving the product, the second healthcare transaction received subsequent to receiving the first healthcare transaction, the second healthcare transaction associated with a second date; and

generating, by the service provider computer immediately following and in response to receipt of the second healthcare

transaction, an adherence message indicating a level of adherence to the patient specifications of the adherence monitoring program comprising the steps of:

determining, by the service provider computer, the level of adherence to the patient specifications of the adherence monitoring program by comparing at least the second date associated with the second healthcare transaction to the first date associated with the first healthcare transaction, wherein comparing at least the second date to the first date includes determining whether the second date is greater than or less than the next refill date, wherein pursuant to a determination that the second date is greater than the next refill date, the level of adherence is determined to not be adherent; and

delivering or directing a delivery, by the service provider computer, of the adherence message that indicates the determined level of adherence to the patient specifications of the adherence monitoring program.

The Examiner rejected claims 1–8, 14–19, 21, and 22 under 35 U.S.C. § 101 as patent-ineligible subject matter in the form of an abstract idea.

We AFFIRM.

ANALYSIS

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In determining whether a claim falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-

step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. *See Alice*, 134 S. Ct. at 2356 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (“Analyzing respondents’ claims according to the above statements from our cases, we think that a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter.”); *Parker v. Flook*, 437 U.S. 584, 594–595 (1978) (“Respondent’s application simply provides a new and presumably better method for calculating alarm limit values.”); *Gottschalk v. Benson*, 409 U.S. 63, 64 (1972) (“They claimed a method for converting binary-coded decimal (BCD) numerals into pure binary numerals.”).

The following method is then used to determine whether what the claim is “directed to” is an abstract idea:

[T]he decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided. *See, e.g., Elec. Power Grp.*, 830 F.3d at 1353–54. That is the classic common law methodology for creating law when a single governing definitional context is not available. *See generally* Karl N. Llewellyn, *The Common Law Tradition: Deciding Appeals* (1960). This more flexible approach is also the approach employed by the Supreme Court. *See Alice*, 134 S. Ct. at 2355–57. We shall follow that approach here.

Amdocs (Israel) Limited v. Openet Telecom, Inc., 841 F.3d 1288, 1294 (Fed. Cir. 2016).

The patent-ineligible end of the spectrum includes fundamental economic practices, *Alice*, 134 S. Ct. at 2357; *Bilski*, 561 U.S. at 611; mathematical formulas, *Flook*, 437 U.S. at 594–95; and basic tools of scientific and technological work, *Benson*, 409 U.S. at 69. On the patent-eligible side of the spectrum are physical and chemical processes, such as curing rubber, *Diamond*, 450 U.S. at 184 n.7, “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores,” and a process for manufacturing flour, *Gottschalk*, 409 U.S. at 67.

If the claim is “directed to” a patent-ineligible abstract idea, we then consider the elements of the claim—both individually and as an ordered combination—to assess whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2355. This is a search for an “inventive concept”—an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.*

We are not persuaded by the Appellants’ arguments that the Examiner erred by rejecting the claims as abstract by only relying on “a conclusory statement without any factual support.” Appeal Br. 15. The Appellants, thus, essentially argue that because there is no evidentiary support of record for the Examiner’s determination, the Examiner has failed to establish a *prima facie* case of patent-ineligibility. Appeal Br. 15–16; *see also id.* 23–24, Reply Br. 2–8. The Appellants’ arguments are unpersuasive.

The Federal Circuit has repeatedly observed that “the *prima facie* case is merely a procedural device that enables an appropriate shift of the burden

of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). The court has, thus, held that the USPTO 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). Thus, 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) (Section 132 “is violated when the rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

Here, in rejecting the pending claims under 35 U.S.C. § 101, the Examiner notified the Appellants that the “claims are directed to a series of steps or an apparatus related to communicating a determined level of a patient’s adherence to a . . . monitoring program for a particular product by receiving data related to the program and healthcare transactions,” i.e., to an abstract idea (Answer 4); and that the additional elements or combination of elements, other than the abstract idea, do not provide meaningful limitations to transform the abstract idea into a patent-eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself (Answer 4–5). The Appellants do not contend that the Examiner’s rejection under § 101 was not understood or that the Examiner’s rejection, otherwise, fails to satisfy the notice requirements of § 132. Instead, the

Appellants' understanding of the rejection is clearly manifested by the Appellants' response as set forth in the briefs.

The Appellants' next assert, with a citation to *Ex parte Renald Poisson*, Appeal 2012-011084 (PTAB Feb. 27, 2015), that an examiner must provide evidence in order to support a rejection under 35 U.S.C. § 101 that what the claims are "directed to" is an abstract idea. Appeal Br. 15–16, 23, Reply Br. 2, 5. While, at times, evidence may be helpful in a patent eligibility analysis, e.g., where facts are in dispute, that is a far-cry from stating affirmatively that evidence is always needed. See *Mortgage Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325–26 (Fed. Cir. 2016) ("[I]t is also possible, as numerous cases have recognized, that a § 101 analysis may sometimes be undertaken without resolving fact issues."). In any case, we are not persuaded that it is needed here, where the Examiner has set forth the expressly authorized alternative to evidence, i.e., citations to analogous case law.² See *Amdocs (Israel) Limited v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) ("Instead of a definition [for what an 'abstract idea' encompasses], then, the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive

² See, e.g., para. IV "July 2015 Update: Subject Matter Eligibility," to 2014 Interim Guidance on Subject Matter Eligibility, 79 Fed. Reg. 74618 (Dec. 16, 2014) ("The courts consider the determination of whether a claim is eligible (which involves identifying whether an exception such as an abstract idea is being claimed) to be a question of law. Accordingly, courts do not rely on evidence that a claimed concept is a judicial exception, and in most cases resolve the ultimate legal conclusion on eligibility without making any factual findings."). The July 2015 Update is available at <https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf>.

nature can be seen—what prior cases were about, and which way they were decided.”).

The Appellants next argue that the “claims include additional features that do not preempt every application of any alleged abstract idea.” Appeal Br. 16; *see also id.* 23. “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362-63 (Fed. Cir. 2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the ecommerce setting do not make them any less abstract.”). And, “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, [as they are in this case,] preemption concerns are fully addressed and made moot.” *Ariosa*, 788 F.3d at 1379.

We are unpersuaded by the Appellants’ arguments that they “utilize a service provider computer and/or at least one memory and processor to address the issue of identifying medications monitored under an adherence monitoring program,” and because “the electronic healthcare transactions are received by the service provider computer from a healthcare provider computer,” the claims are not merely directed to organizing data, but a solution to a problem necessarily rooted in computer technology, as in *DDR Holdings LLC v. Hotels.com LP.*, 775 F.3d 1245 (Fed. Cir. 2014). Appeal Br. 17–18. In contrast, the Examiner finds “[t]here is nothing in the claims that could not be performed manually utilizing paper records accessed by human beings. The present system merely ‘applies’ computer technology to make a manual process perform quicker.” Answer 13. Setting aside

momentarily the recited service provider computer that receives data from a healthcare computer, and the execution of each step in the method by the service provider computer, we agree with the Examiner that the steps of receiving, comparing, and storing data, making determinations, and generating messages, can be done mentally by a human with the use of pen and paper. A dispensing pharmacist, for example, would receive and have access to the information that would permit them to perform the method to determine patient adherence to the medication program.

The Federal Circuit has held that if a method can be performed by human thought alone, or by a human using pen and paper, it is merely an abstract idea and is not patent-eligible under § 101. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) (“[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.”). Additionally, mental processes, e.g., computing a score, as recited in claim 1, remain unpatentable even when automated to reduce the burden on the user of what once could have been done with pen and paper. *Id.* at 1375 (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*, [409 U.S. 63 (1972)].”).

The Examiner also finds the claims correspond to:

comparing new and stored information (healthcare transaction data and stored monitoring information) and using rules to identify options (rules governing patient’s level of adherence based on comparisons) as discussed in *SmartGene*; and/or using categories to organize, store and transmit information (data labeled in various categories to handle and process data) as discussed in *CyberFone*.

Answer 8. The Appellants' response is that "simply naming the case does not provide the necessary specificity outlined by the Patent Office to make out a *prima facie* case that the claims are directed to an abstract concept." Reply Br. 4. However, the Examiner has done more than simply name the cases to which the present claims are similar, such as linking the claimed healthcare transaction data to new and stored information, and linking the determination of whether the medicine adherence program is being followed to using rules to identify options, citing *SmartGene, Inc. v. Advanced Biological Laboratories, SA*, 555 Fed. Appx. 950 (Fed. Cir. 2014).

We, therefore, are unpersuaded that the Examiner erred in determining that the claims are directed to abstract ideas.

Turning to step two of the *Mayo/Alice* analysis, the Examiner determined, and we agree, that the claims do not recite an "inventive concept" that transforms the claims from being directed to an abstract idea. *See Answer 4–5.*

We are unpersuaded by the Appellants' argument that the claims recite "substantially more" than abstract ideas, because there is no pending anticipation or obviousness rejection over the claims. Appeal Br. 24.

A finding of novelty or non-obviousness does not automatically lead to the conclusion that the claimed subject matter is patent-eligible. Although the second step in the *Mayo/Alice* framework is termed a search for an "inventive concept," the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for "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., 134 S. Ct. at 2355. “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n. for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90; *see also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (“The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.”).

The Appellants next argue the claims “are meaningful limitations beyond generally linking the alleged abstract concepts of comparing new and stored information and using rules to identify options and/or using categories to organize, store, and transmit information.” Appeal Br. 27. But Appellants offer no persuasive argument or technical reasoning to support that position. Instead, Appellants merely reproduce the language of claim 1, and summarily assert “the claims amount to significantly more than the alleged abstract idea and applies any alleged abstract concept to a new and useful end.” *Id.*

We are unpersuaded by the Appellants’ argument that “the pending claims are improving the technological process of electronic healthcare transaction processing.” Appeal Br. 28. Specifically, we are unpersuaded that the Appellants’ assertions, alone, establish that the claims recite steps that actually improve “electronic healthcare transaction processing.” For example, the steps in claim 1 involve receiving, comparing, and making determinations from received transaction information, which are generic computational steps performed on generic computer components. *See, e.g.*,

Spec. ¶ 23 (“The healthcare provider computer 102, the service provider computer 104, and the claims processor computer 108 may each be one or more processor-driven devices, such as, but not limited to, a server computer, a personal computer, a laptop computer, a handheld computer, and the like.”). We are unclear how anything about them causes any changes to the electronic healthcare transaction processing, which continues unchanged, outside the scope of the invention.

Therefore, the Appellants have not persuaded us that the claimed invention includes an “inventive step” that transforms the abstract ideas into eligible subject matter. For this reason, we sustain the Examiner’s rejection of claim 1 under 35 U.S.C. § 101. We also sustain the rejection of claims 2–8, 14–19, 21, and 22 that were argued only by reference to, and repeating of, the arguments advanced for claim 1. Appeal Br. 28–29.

DECISION

We AFFIRM the rejection of claims 1–8, 14–19, 21, and 22 under 35 U.S.C. § 101.

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