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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* MARIA CONSOLACION JASKELA, WILLIAM LEE  
WEBSTER, THOMAS WILLIAM UTECH, and  
TIMOTHY W. VANDERVEEN

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Appeal 2017-001346  
Application 13/901,504  
Technology Center 3600

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Before MICHAEL J. STRAUSS, JOSEPH P. LENTIVECH, and  
DAVID J. CUTITTA II, *Administrative Patent Judges*.

LENTIVECH, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellants<sup>1</sup> appeal from the Examiner's decision to reject claims 1–27, the only claims pending in the application on appeal. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> According to Appellants, the real party in interest is the Applicant, CareFusion 303, Inc. App. Br. 3.

STATEMENT OF THE CASE

*Appellants' Invention*

Appellants' invention generally relates to “managing preparation and delivery of a medication in a healthcare facility.” Spec. ¶ 2<sup>2</sup>. Claim 1, which is illustrative, reads as follows:

1. A system for managing preparation of a medication for a patient, the system comprising:

a memory comprising instructions; and

one or more processors configured to execute the instructions to:

receive information indicative of an order for medication for a patient from an electronic data feed;

determine whether the order for medication for the patient can be filled with a returned medication;

when the determination indicates the order can be filled with a returned medication, provide a notification to fill the order with the returned medication; and

when the determination indicates a returned medication is not available to fill the order, provide a notification to fill the order by preparing the medication.

(App. Br., Claims Appendix, 19.)

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<sup>2</sup> We refer to the Specification, filed May 23, 2013 (“Spec.”); [2<sup>nd</sup>] Non-Final Office Action, mailed Dec. 7, 2015 (“Non-Final Act.”); Appeal Brief, filed Jul. 11, 2016 (“App. Br.”); Examiner’s Answer, mailed Sept. 13, 2016 (“Ans.”); and the Reply Brief, filed Nov. 1, 2016 (“Reply Br.”).

*Rejection*

Claims 1–27 stand rejected under 35 U.S.C. § 101 as being directed to judicially excepted subject matter under 35 U.S.C. § 101. Non-Final Act. 2–4.

ANALYSIS

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. v. CLS Bank Int’l*, 134 S.Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). 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, 82–84 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of these 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,” such as an abstract idea. The inquiry often is whether the claims are directed to “a specific means or method” for improving technology or whether they are simply directed to an abstract end-result. *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1311, 1314 (Fed. Circ. 2016). If the claims are not directed to a patent-ineligible concept, 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 the additional elements

‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79–80, 1297). We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invokes generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

Appellants contend the claims are not directed to an abstract idea. App. Br. 15; Reply Br. 2–6. According to Appellants, the claims are directed to “a method for ‘managing preparation of a medication for a patient’ and produces results including ‘preventing a compound medication from being made that is no longer needed . . . thereby preventing waste’ and ‘decreasing the inefficient use of labor.’” Reply Br. 5 (citing Spec. ¶ 24). Appellants argue the claims would not patent “‘the result or effect produced’” and, therefore, are not directed to an abstract idea. *Id.* at 4 (citing *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312, 1314 (Fed. Cir. 2016)).

Appellants further argue “the identification of ‘collecting . . . and comparing known information . . . , which was found to be an abstract idea by the courts (Classen) in the Examiner’s Answer does not meet the requirements of identifying a similar abstract idea that has been held patent ineligible” because the Examiner has not relied on the knowledge generally available to those in the art, on the case law precedent, on Appellants’ own disclosure, or on evidence. Reply Br. 4 (citing “May 19, 2016, Memo Re Subject Matter Eligibility...May 2016 Update: Memorandum – Formulating a Subject Matter Eligibility Rejection and Evaluating the Applicant’s

Response to a Subject Matter Eligibility Rejection...July 2015 Update on Subject Matter Eligibility,” 80 Fed. Reg. 45,429 (July 30, 2015)).

Appellants further argue:

Claim 1 relates to a genus for “managing preparation of a medication for a patient” and the incorporation of at least the limitation of “determin[ing] whether the order for medication for the patient can be filled with a returned medication” improves the existing process for “managing preparation of a medication for a patient” and does not preempt all techniques for “managing preparation of a medication for a patient” that use different techniques. The specific limitations of exemplary independent Claim 1 would prevent broad preemption of all methods for “managing preparation of a medication for a patient”, and there has been no showing by the Examiner that any process for “managing preparation of a medication for a patient” must “determine whether the order for medication for the patient can be filled with a returned medication”.

Reply Br. 6.

We are not persuaded. We find the claims are directed to receiving and analyzing data and outputting a result of the analysis. For example, claim 1 recites: “[ (1) ] receiv[ing] information indicative of an order for medication for a patient from an electronic data feed; [ (2) ] determin[ing] whether the order for medication for the patient can be filled with a returned medication; [ (3) ] when the determination indicates the order can be filled with a returned medication, provid[ing] a notification to fill the order with the returned medication; and [ (4) ] when the determination indicates a returned medication is not available to fill the order, provid[ing] a notification to fill the order by preparing the medication.” Independent claims 13 and 25–27 recite similar limitations directed to receiving and analyzing data and outputting a result of the analysis. Information as such is intangible. *See, e.g., Microsoft Corp. v. AT&T Corp.*, 127 S. Ct. 1746, 1756

n.12 (2007); *Bayer AG v. Housey Pharm., Inc.*, 340 F.3d 1367, 1372 (Fed. Cir. 2003). Information collection and analysis, and outputting a result based thereon, including when limited to particular content, is also within the realm of abstract ideas. *See, e.g., Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1349 (Fed. Cir. 2015); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011).

We also are not persuaded by Appellants' argument that the pending claims are not directed to an abstract idea because the features of the claims would not preempt "all methods for "managing preparation of a medication for a patient." Reply Br. 6. Although the Supreme Court has described "the concern that drives this exclusionary principle [i.e., the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption," *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*, 134 S. Ct. at 2354). Although "preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility." *Id.*

Turning to the second step of the analysis, Appellants assert that, even if the claims are directed to an abstract idea, the claims are nonetheless directed to patent-eligible subject matter because the claims include

elements that amount to “significantly more than the [] exception”. App. Br 15–16; Reply Br. 2–3. We disagree.

We find unpersuasive Appellants’ argument that the limitations “when the determination indicates the order can be filled with a returned medication, provide a notification to fill the order with the returned medication” and “when the determination indicates a returned medication is not available to fill the order, provide a notification to fill the order by preparing the medication,” as recited in claim 1, are “not well-understood, routine, and conventional in the field.” App. Br. 15. The steps of “when the determination indicates the order can be filled with a returned medication, provid[ing] a notification to fill the order with the returned medication” and “when the determination indicates a returned medication is not available to fill the order, provid[ing] a notification to fill the order by preparing the medication” are all steps that can be performed by a human with pen and paper or by a general purpose computer using well-understood, routine, and conventional functions. And Appellants do not provide adequate evidence to the contrary. *See Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1347–49 (Fed. Cir. 2014) (“The concept of data collection, recognition, and storage is undisputedly well-known.”). The Specification supports this view in discussing general purpose computer(s) for performing the steps of the method. *See* Spec. ¶¶ 69–78. There is no further specification of particular technology for performing the steps. Instead, the Specification provides “aspects of the present disclosure are not limited to any specific combination of hardware circuitry and software.” Spec. ¶ 75. *See Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1263 (Fed. Cir. 2016); *see also Enfish*, 822

F.3d. at 1336 (focusing on whether the claim is “an improvement to the computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity.”); *DDR*, 773 F.3d at 1256 (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”) (citing *Alice*, 134 S. Ct. at 2358)).

We also find unpersuasive Appellants’ argument that the claims are significantly more because the recited limitations “improve[] the existing process for ‘managing preparation of a medication for a patient’” (Reply Br. 6) and “produces results including ‘preventing a compound medication from being made that is no longer needed . . . thereby preventing waste’ and ‘decreasing inefficient use of labor’” (Reply Br. 5). Managing preparation of a medication for a patient by using fewer resources and thereby preventing waste, as described in paragraphs 55–68 of the Specification, is not a technological improvement, but a business one. Further, it does not improve the technology of the computer itself; rather, it makes the process of managing preparation of medications more efficient. “[O]ur precedent is clear that merely adding computer functionality to increase the speed or efficiency of the process does not confer patent eligibility on an otherwise abstract idea.” *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (“[R]elying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.”).

Based on the foregoing reasons, we find the claims do not recite significantly more than the abstract idea.

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Thus, we are not persuaded that the Examiner erred in rejecting claims 1–27 under 35 U.S.C. § 101.

#### DECISION

We affirm the Examiner’s rejection of claims 1–27 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