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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* SHAREN ANN GODWIN and FRANK PHILLIP SHEPPARD<sup>1</sup>

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Appeal 2017-007906  
Application 13/102,570  
Technology Center 3600

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Before CAROLYN D. THOMAS, JON M. JURGOVAN, and  
NABEEL U. KHAN, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of claims 1–52, all the pending claims in the present application. (*See Claims Appendix*). We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

The present invention relates generally to displaying a targeted message based on a prescription number (*see Spec., Abstract*).

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<sup>1</sup>Appellants name Ateb, Inc. as the real party in interest (App. Br. 1).

Claim 1 is illustrative:

1. A method of operating a pharmacy comprising:
  - accepting identification of a pharmaceutical prescription during a pharmacy transaction;
  - accepting a signature on a signature capture system at the pharmacy during the pharmacy transaction;
  - querying at least one database with a processor using predefined criteria based on the identification of a pharmaceutical prescription to identify a targeted message;
  - and
  - displaying the targeted message on the signature capture system at the pharmacy during the pharmacy transaction.

Appellants appeal the following rejections:

R1. Claims 1–52 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter (Final Act. 2–3); and

R2. Claims 1–52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dahlin (US 2004/0172295 A1, Sept. 2, 2004), Moura (US 2007/0124172 A1, May 31, 2007), and Uecker (US 6,240,394 B1, May 29, 2001) (Final Act. 4–13).

We review the appealed rejections for error based upon the issues identified by Appellants, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

## ANALYSIS

### *Rejection under § 101*

**Issue 1:** Did the Examiner err in finding that the claims are directed to non-statutory subject matter?

*Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014), identifies a two-step framework for determining whether claimed subject matter is judicially excepted from patent eligibility under § 101. According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355. If the claims are not directed to an abstract idea [or other patent-ineligible concept], the inquiry ends. If the claims are ‘directed to’ an abstract idea, then the inquiry proceeds to the second step of the Alice framework.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016). In analyzing whether a claims is directed to an abstract idea, we look to other decisions where similar concepts were previously found abstract by the courts. *See Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016).

In this regard, with respect to independent method claims 1 and 27, and similarly, non-transitory computer-readable medium claims 26 and 52 and system claims 25 and 51, the Examiner finds that the claims are directed to the abstract idea of “(i) comparing new and stored information and using rules to identify options, and (ii) using categories to organize, store, and transmit information” (Final Act. 3).

Appellants challenge said findings on the ground that “the Office Action appears to have generically re-categorized the specific recitations of

the claims at an unacceptable high level” (App. Br. 8) and “the pending claims are clearly directed to more than simply the abstract idea” (*id.* at 9).

It is evident that the Examiner considered all the limitations in the claims because the analysis is tethered to actual claim language (*see* Final Act. 3; Ans. 7). Further, the Examiner properly and reasonably found that representative claim 1 is at least directed to “comparing new and stored information and using rules to identify options” (Final Act. 3) which is an abstract idea that can be described at different levels of abstraction. *Cf. Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240–1241 (Fed. Cir. 2016) (“An abstract idea can generally be described at different levels of abstraction. As the Board has done, the claimed abstract idea could be described as generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location. It could be described in other ways, including, as indicated in the specification, taking orders from restaurant customers on a computer.”)

Here, the Examiner highlighted some known abstract concepts, i.e., comparing new and stored information and using rules to identify options; and using categories to organize, store and transmit information (*see* Ans. 7–8). We find that the Examiner’s cogent analysis relying on judicial examples (*id.*), albeit without specifically citing the particular cases, shows the Examiner provided adequate basis for making the rejection.

We note that claim 1 recites four steps: (1) accepting identification of a pharmaceutical prescription; (2) accepting a signature; (3) querying at least one database based on the pharmaceutical prescription; and (4) displaying the targeted message. These four steps present a scheme for operating a pharmacy.

Information collection and analysis, including when limited to particular content, is within the realm of abstract ideas. *See, e.g., 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”); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (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). Because the claims are directed to collecting information, analyzing it, and providing information based thereon to users, we agree with the Examiner that claim 1 is directed to a known abstract idea.

Appellants further contend that the claims “[do] not preempt the entire field of comparing new and stored information” (App. Br. 10), “[i]nstead the claims are directed to a practical application of technology . . . [and] has a real world use and benefit” (*id.*).

Although pre-emption “might tend to impede innovation more than it would tend to promote it, ‘thereby thwarting the primary object of the patent laws’” (*Alice*, 134 S. Ct. at 2354 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012))), “the absence of complete preemption does not demonstrate patent eligibility” (*Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015)). Moreover, because we find the claimed subject matter covers patent-ineligible subject matter, the pre-emption concern is necessarily addressed. “Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the

*Mayo* framework, [] preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics*, 788 F.3d at 1379.

We now turn to the second step of the *Alice* framework: “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) (quoting *Mayo*, 566 U.S. 66, 72–73 (2012)).

Appellants contend that “[t]he current claims improve an existing technological process because signature capture devices . . . are used to display a targeted message . . . which may facilitate improved communications with pharmacy customers and patients” (App. Br. 9). We find this argument unpersuasive.

For example, in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1259 (Fed. Cir. 2014), the subject claim was held patent-eligible because it encompassed “an inventive concept” for resolving a “particular Internet-centric problem.” In contrast, we find Appellants’ method performed by a processor (claim 1) does not provide a solution “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” *Id.* at 1257. Because we find all claims on appeal merely use a generic computer or processor as a tool which is used in the way a computer normally functions, we conclude that the claims fail to impart any discernible improvement upon the computer or processor; nor do Appellants’ claims solve “a challenge particular to the Internet” as considered by the court in *DDR*, 773 F.3d at 1256–57.

Appellants also contend that “[s]imply identifying that conventional computers can be used to implement the recitation does not render the claim

abstract” (App. Br. 11), and “because the claims are patentable over the cited art . . . and thus meet the requirements of novelty and non-obviousness of 35 U.S.C. 102/103, the claims **include unconventional limitations and unconventional steps**” (*id.*).

Appellants are reminded that “relying 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) (citing *Alice*, 134 S. Ct. at 2359 (“use of a computer to create electronic records, track multiple transactions, and issue simultaneous instructions” is not an inventive concept)). As recognized by the Supreme Court, “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 134 S. Ct. at 2358–59 (concluding claims “simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer” not patent eligible).

Also, although the second step in the *Alice/Mayo* 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*, 134 S. Ct. at 2355. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 1304. Our reviewing court guides that “[e]ligibility and novelty are separate inquiries.” *Two-Way Media Ltd. v. Comcast Cable Commc'ns., LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017); *see also Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1263 (Fed. Cir. 2016)



(holding that “[e]ven assuming” that a particular claimed feature was novel does not “avoid the problem of abstractness”).

For the foregoing reasons, Appellants’ contentions are unpersuasive as to error in the rejection under 35 U.S.C. § 101.

*Rejection under § 103(a)*

*Claims 1–20, 23–41, 43–46, and 49–52*

**Issue 2:** Did the Examiner err in finding that Dahlin, Moura, and Uecker collectively teach or suggest displaying a targeted message on a signature capture system at the pharmacy, as set forth in claim 1?

Appellants contend that “[a]lthough Dahlin provides messages on a message pad . . . Dahlin does not disclose or render obvious displaying targeted messages on a signature capture system at a pharmacy . . . [and] Dahlin does not disclose querying at least one database” (App. Br. 5). Appellants further contend that “Moura does not relate to prescription[s] . . . [t]herefore, Moura does not disclose or render obvious displaying targeted messages on a signature capture system at a pharmacy during a pharmacy transaction” (*id.* at 5–6). Appellants also contend that “the system [of] Uecker relies on data in a print stream and printed messages to the customer, and Uecker provides no apparent reason or motivation to use a signature capture system and does not describe or suggest how its data capture techniques could even be used in such a signature capture system” (App. Br. 6). We disagree with Appellants.

We refer to, rely on, and adopt the Examiner’s findings and conclusions set forth in the Answer. Our discussions here will be limited to the following points of emphasis.

In essence, as identified by the Examiner (*see* Ans. 5), Appellants are arguing the references individually. For instance, the Examiner finds that Dahlin teaches “accepting a signature on a signature capture system . . . [and] displaying the targeted message on the signature capture system during the pharmacy transaction” (Final Act. 4; Ans. 4); Moura teaches “querying at least one database . . . based on the identification of a pharmaceutical prescription” (Final Act. 4; Ans. 5); and Uecker teaches “at the pharmacy” (Final Act. 5; Ans. 5). Therefore, as noted by the Examiner “it is the combination of Dahlin et al., Moura et al., and Uecker et al. that renders obvious Appellants’ claimed invention” (Ans. 5).

Stated differently, Appellants’ arguments do not take into account what the collective teachings of the prior art would have suggested to one of ordinary skill in the art and is therefore ineffective to rebut the Examiner’s *prima facie* case of obviousness. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“The test for obviousness is not whether . . . the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”) (citations omitted). This reasoning is applicable here.

For example, Appellants’ argument against Dahlin separately from Moura and Uecker does not persuasively rebut the combination made by the Examiner. One cannot show non-obviousness by attacking references individually, where the rejections are based on combinations of references. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Accordingly, we sustain the Examiner’s rejection of claim 1. Appellants’ arguments regarding the Examiner’s rejection of independent

claims 25–27, 51, and 52 rely on the same arguments as for claim 1, and Appellants do not argue separate patentability for the dependent claims, except as noted below. We, therefore, also sustain the Examiner’s rejection of claims 2–20, 23–41, 43–46, and 49–52.

*Claims 21, 22, 42, 47, and 48*

**Issue 3:** Did the Examiner err in finding that Dahlin teaches or suggests a targeted message that solicits participation of the patient in a survey, as set forth in claim 21?

Appellants contend that they “cannot find any portion of Dahlin that proposes or suggests targeted messages that solicit participation of the patient in a survey” (App. Br. 7). Although the Examiner cites numerous paragraphs for allegedly teaching the aforementioned feature (*see* Final Act. 12), we agree with Appellants that it is not readily clear where this feature is taught/suggested in Dahlin. Furthermore, the Examiner fails to specifically address this argument in the Answer.

Therefore, we are constrained by the record before us to find that the Examiner erred in rejecting dependent claim 21, and dependent claims 22, 42, 47, and 48 for similar reasons.

DECISION

We affirm the Examiner’s § 101 rejection of claims 1–52 and the § 103(a) rejections of claims 1–20, 23–41, 43–46, and 49–52.

We reverse the Examiner’s § 103(a) rejection of claims 21, 22, 42, 47, and 48.

Because at least one rejection encompassing all claims on appeal is

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affirmed, the decision of the Examiner 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)(1)(iv).

AFFIRMED