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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* MINALKUMAR PATEL, MOHAN P. CHARLES,  
MELISSA SAMPSON, and MICHAEL ESCUDER<sup>1</sup>

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Appeal 2017-008031  
Application 13/107,338  
Technology Center 3600

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Before CAROLYN D. THOMAS, ERIC B. CHEN, and  
SHARON FENICK, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1–14, 23–28, and 31–35. Claims 15–22, 29, and 30 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

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<sup>1</sup> Appellants state that the real party in interest is the assignee, Rx Specialty Hub LLC. (App. Br. 1.)

## STATEMENT OF THE CASE

Appellants' invention relates to an interactive, electronic, knowledge-based ordering process for specialty/biotech pharmaceuticals (i.e., medically coded drugs). (Abstract.)

Claim 1 is exemplary:

1. A method for authorizing and dispensing drugs, the method comprising:

providing a database of patient eligibility criteria for drugs, the patient eligibility criteria associated with a plurality of health plans, and the database including patient identifying information associated with said health plans;

interactively receiving an input from a user, the input including a prior authorization request including an identification of a particular patient and a selection of a drug, the input further including a choice of a specialty pharmacy;

determining automatically by a data processor, based on the prior authorization request, a health plan corresponding with said identified patient in said database, and evaluating, automatically by the data processor, said patient eligibility criteria for said selected drug to determine whether said identified patient is eligible for the drug according to the automatically determined corresponding health plan;

providing automatically, by the data processor, in response to the evaluating of said patient eligibility criteria for the corresponding health plan based on the prior authorization request, an authorization code to said user corresponding with said selected drug and said identified patient;

receiving automatically, by the data processor, a pharmacy dispensing report from said chosen specialty pharmacy, wherein said pharmacy dispensing report is associated with said authorization code and provides a pharmacy confirmation that said selected drug was dispensed to at least one of a healthcare provider and said identified patient;

receiving automatically, by the data processor, a medical claims report from said health plan, wherein said medical claims report is associated with said authorization code and provides a medical confirmation that said selected drug was administered to said identified patient at the approved dosage; and

updating automatically, by the data processor, said database with utilization data corresponding to said pharmacy dispensing report and said medical claims report.

Claims 1–14, 23–28, and 31–35 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.

Claims 1–14, 23–27, 31, 33, and 34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Greene (US 2008/0033751 A1, published Feb. 7, 2008), Seelinger (US 2002/0077857 A1, published June 20, 2002), and Scantland et al. (US 2012/0185270 A1, published July 19, 2012).

Claims 28, 32, and 35 stand rejected under 35 U.S.C. § 103(a) as unpatentable from Greene, Seelinger, Scantland, and Kane et al. (US 2008/0221932 A1, published Sept. 11, 2008).

## ANALYSIS

### *§ 101 Rejection*

We are persuaded by Appellants' arguments (Reply Br. 1–2) that the Examiner has not satisfied the proper burden for making a prima facie case for patent ineligibility under 35 U.S.C. § 101.

Under the patent eligibility guidelines at the time of the rejection, the Examiner determined that:

[c]laim(s) 1, 23 and 25 recite, in part, methods for performing the steps of “providing a database of patient eligibility criteria, receiving input from a user, determining a health plan based on user input, evaluating patient eligibility, receiving a pharmacy

dispensing report, receiving a medical claims report, updating the database” and “[t]hese steps corresponds to concepts identified as abstract ideas by the courts, such as ‘an idea of itself’ in *Alice*.” (Ans. 9.) Moreover, the Examiner determined that “[e]xamples of ‘an idea of itself’ are the concepts of ‘collecting information, analyzing it, and displaying certain results of the collection and analysis’ (*Electric Power Group*).<sup>12]</sup>” (*Id.*; *see also* Final Act. 2.) However, we agree with Appellants that the Examiner’s sweeping reliance upon *Electric Power Group* has not satisfied the proper burden for a *prima facie* case.

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g., Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“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.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4

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<sup>2</sup> *Elec. Power Grp. v. Alstom, S.A.*, 830 F.3d 1350 (Fed. Cir. 2016).

in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 192 (1981)); “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores” (*id.* at 184 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 176; *see also id.* at 192 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical

formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “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.” *Alice*, 573 U.S. at 221 (omitted). “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].’” *Id.* (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance* (“Memorandum”). Under that guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human interactions such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

- (3) adds a specific limitation beyond the judicial exception that are not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or
- (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

*See* Memorandum.

Although the Examiner generally states “[t]hese steps [recited in claims 1, 23, and 25] corresponds to concepts identified as abstract ideas by the courts, such as ‘an idea of itself’ with a citation to *Electric Power Group*” (Ans. 9), this statement, along with the Examiner’s other statements regarding the § 101 rejection in the Final Action and Answer, does not provide a clear determination as to whether and how the identified limitations fall within the subject matter groupings of abstract ideas of mathematical concepts, certain methods of organizing human interactions, or mental processes. *See* Memorandum 16. In particular, the Examiner does not adequately articulate why the claimed concepts are analogous to the facts of *Electric Power Group*, but merely overgeneralizes Appellants’ claimed invention. This overgeneralized abstract idea does not meet the Examiner’s requisite burden for analysis under the 2019 Revised Patent Matter Eligibility Guidance.

Accordingly, we are persuaded by Appellants’ arguments that the Examiner “aver[s] without explanation or justification that the claims recite generic computer components and their functions at ‘a high degree of generality’ and thus, constitute an abstract idea” and the Examiner improperly “asserts that the claims ‘are directed to an abstract idea related to

collecting information, analyzing it, and displaying of certain results of the collection and analysis.” (Reply Br. 1–2.)

Thus, we do not sustain the rejection of claims 1, 23, and 25 under 35 U.S.C. § 101. Claims 2–14, 24, 26–28, and 31–35 depend from independent claims 1, 23, and 25. We do not sustain the rejection of claims 2–14, 24, 26–28, and 31–35 under 35 U.S.C. § 101 for the same reasons discussed with respect to independent claims 1, 23, and 25.

### *§ 103 Rejections*

The Examiner rejected claims 1–14, 23–28, and 31–35 under 35 U.S.C. § 103(a) as unpatentable over various combinations of references, each including Scantland. In particular, the Examiner provided citations to the published application of Scantland (i.e., US 2012/0185270 A1) (Final Act. 5–6; *see also* Ans. 4), but relied upon the filing date of the provisional application (i.e., Application No. 61/306,272) (Final Act. 15). The Examiner further determined “that Provisional Application 61/306,272 supports fully Scantland et al. (See at least paragraphs [0031], [0047]-[0051], [0052]-[0056] of Provisional Application 61/306,272).” (Final Act. 15.) We do not agree with the Examiner’s conclusion that Scantland is available as prior art.

The present application, Application No. 13/107,338, was filed on May 13, 2011. Scantland, which is based upon Application No. 13/413,231 was filed on March 6, 2012, but claims priority to Provisional Application No. 61/306,272, filed on February 19, 2010. Thus, the present application was filed after the filing date of the Scantland U.S. provisional application, but before the non-provisional filing date of the Scantland U.S. application.

A U.S. patent or U.S. application publication is entitled to the benefit of the filing date of a provisional application to which priority is claimed under 35 U.S.C. § 119(e) as its pre-AIA 35 U.S.C. § 102(e) critical reference date *if the provisional application(s) properly supports the subject matter relied upon to make the rejection* in compliance with pre-AIA 35 U.S.C. § 112, first paragraph. MPEP § 2136.03(III). In addition, the pre-AIA 35 U.S.C. § 102(e) critical reference date of a U.S. patent may be the filing date of a relied upon provisional application only if at least one of the claims in the patent is supported by the written description of the provisional application in compliance with pre-AIA 35 U.S.C. § 112, first paragraph. *Id.* (citing *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015)).

The Examiner, on this record, has not provided the requisite finding that the provisional application's written description supports at least one of the claims in Scantland, in compliance with 35 U.S.C. § 112, first paragraph. *See Dynamic Drinkware*, 800 F.3d at 1381 (finding insufficient the combination of: (1) a comparison between the claims of the patent-in-suit and the disclosure of the prior art patent; and (2) a comparison between a claim of the patent-in-suit and the provisional application upon which the prior art patent's priority claim is based). We do not presume that the provisional application supports the paragraphs of Scantland cited in the Examiner's rejection, because we have no basis on this record for doing so. *See id.* at 1380 (“[B]ecause the PTO does not examine priority claims unless necessary, the Board has no basis to presume that a reference patent is necessarily entitled to the filing date of its provisional application.”). The

record is silent on a comparison between a claim of Scantland's patent application and the disclosure of the provisional application of Scantland.

Accordingly, we are persuaded by Appellants' arguments that:

the Scantland reference is based on Provisional Patent Application 61/306,272 filed February 19, 2010 (the Scantland Provisional). Therefore, pursuant to recent Federal Circuit case law, the provisional filing date of Scantland can be used as a prior art reference date against the present application, but only to the extent that the Scantland Provisional discloses the subject matter of the present claims.

(App. Br. 11.)

Thus, we do not sustain the rejection of claims 1–14, 23–28, and 31–35 under 35 U.S.C. § 103(a) as unpatentable over various combinations of Greene, Seelinger, Scantland, and Kane.

#### DECISION

The Examiners' decision to rejecting claims 1–14, 23–28, and 31–35 is reversed.

REVERSED