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GRACE J FISHEL
2200 WEST PORT PLAZA DRIVE
SUITE 202
ST. LOUIS, MO 63146

EXAMINER	
TOMASZEWSKI, MICHAEL	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NEIL C. LUALLEN

Appeal 2018-000293
Application 13/922,782
Technology Center 3600

Before MURRIEL E. CRAWFORD, PHILIP J. HOFFMANN, and CYNTHIA L. MURPHY, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant[1] appeals the Examiner's rejections of claims 5–11 and 13–20 under 35 U.S.C. §§ 101, 103, and 112. We sustain the Examiner's rejection under 35 U.S.C. § 101 (Rejection I); we sustain the Examiner's rejection under 35 U.S.C. § 103 (Rejection II); and we do not sustain the Examiner's rejection under 35 U.S.C. § 112. (Rejection III).[2]

Thus, we AFFIRM.

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[1] We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies Neil C. Luallen as the real party in interest. (Appeal Br. 1.)

[2] The Appellant appeals under 35 U.S.C. § 134; we have jurisdiction over this appeal under 35 U.S.C. § 6(b)

STATEMENT OF CASE

The Appellant's invention relates to a "method of marketing," and, specifically, "pharmaceutical marketing." (Spec. ¶¶ 1, 4.)

According to the Appellant, pharmaceutical companies "spend extensively" on educational services to "keep[] doctors updated on the latest changes in medical science, and potential benefits and safety precautions for their patients." (Spec. ¶ 3.) And, according to the Appellant, what "is not routinely done" is distributing educational marketing materials to a doctor (i.e., a medical-prescription-writing customer) that is "updated with drug alerts on a contemporaneous basis at the time the doctor is being educated about the drug." (Appeal Br. 7.)

With the Appellant's pharmaceutical marketing method, there is "'live' updating of the product information" sent to doctors "with drug alerts." (Appeal Br. 7.) This is accomplished by "[s]oftware" that is "utilized to scan for the most up to date drug and medical information," so that "drug warnings and safety recalls" can be sent as "alerts" to the doctors "in real time." (Spec. ¶ 51.)

Illustrative Claim

> 14. One or more computer storage media storing computer-usable instructions, that when used by one or more computing devices, cause the one or more computing devices to perform a method comprising the steps of:
>
> (a) targeting a medical prescription writing customer protected by a non-prescription writing gatekeeper for transmitting information;
>
> (b) motivating the gatekeeper to transmit the information to the medical prescription writing customer;

(c) providing educational information for a medical product or service updated with software operable to scan information sources for drug alerts relevant to the product or service;

(d) providing a marketing message;

(e) providing contact information;

(f) receiving feedback from the medical prescription writing customer;

(g) encouraging the medical prescription writing customer to participate in a contest;

(h) providing questions or puzzles with questions updated with software operable to scan information sources for drug alerts relevant to the product or service of step (c) for answering and participating in the contest;

(i) selecting a winner for the contest; and

(j) awarding a prize when the medical prescription writing customer achieves a predetermined goal in the contest.

Rejections

I. The Examiner rejects claims 5–11 and 13–20 under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more. (Final Action 3.)

II. The Examiner reject claims 5–11 and 13–20 under 35 U.S.C. § 103 as unpatentable over Bhan,[3] Hawks,[4] and Mayaud.[5]

III. The Examiner rejects claim 11 under 35 U.S.C. § 112, as indefinite. (Final Action 2.)

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[3] US 2001/0032125 A1, published October 18, 2001.

[4] US 2003/0216942 A1, published November 20, 2003.

[5] US 2005/0060197 A1, published March 17, 2005.

ANALYSIS

Claims 14 and 20 are the independent claims on appeal, with the rest of the claims on appeal (i.e., claims 5–13 and 15–19) depending directly or ultimately from independent claim 14. (*See* Appeal Br., Claims App.)

Independent claim 14 recites a customer-targeting step (a); a gatekeeper-motivating step (b); an educational-information-providing step (c); a marketing-message providing step (d); a contact-information-providing step (e); a feedback-receiving step (f); a contest-participation-encouraging step (g); a question/puzzle-providing step (h); a winner-selecting step (i); and a prize-awarding step (j). (*See* Appeal Br., Claims App.) Independent claim 20 recites a storage device comprising computer code for performing steps (a)–(j). (*See id.*)

Rejection I — 35 U.S.C. § 101

The Examiner determines that independent claim 14 is directed to an abstract idea involving "advertising" (e.g., marketing) and does "not include additional elements that are sufficient to amount to significantly more than the judicial exception." (Final Action 3.) More succinctly, the Examiner concludes that independent claim 14 fails the *Alice* test for patent eligibility.[6]

The 2019 Revised Patent Subject Matter Eligibility Guidance ("2019 Guidance, Federal Register Vol. 84, No. 4") provides us with specific steps

[6] In *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208 (2014), the Supreme Court provided a two-step test to guard against an attempt to patent purely an abstract idea. (*See Alice,* 573 U.S. at 217–18.) In the first step of the *Alice* Test, a determination is made as to whether the claim at issue is "directed to" an abstract idea. (*Id.* at 218.) In the second step of the *Alice* test, a determination is made as to whether additional elements transform the claim into something "significantly more" than the abstract idea. (*Id.* at 218–19.)

for discerning whether a claim passes the *Alice* test for patent eligibility. (*See* 2019 Guidance, Federal Register Vol. 84, No. 4, 50–57.) These steps are "[i]n accordance with judicial precedent" and consist of a two-pronged Step 2A and a Step 2B. (*Id.* at 52.)

In the first prong of Step 2A (Prong One), we evaluate whether the claim recites a judicial exception, such as an abstract idea. (2019 Guidance, Federal Register Vol. 84, No. 4, 54.) The 2019 Guidance "extracts and synthesizes key concepts identified by the courts as abstract ideas," these concepts include "[c]ertain methods of organizing human activity," particularly "fundamental economic principles or practices," and more particularly "advertising" and "marketing." (*Id.* at 52.)

The Appellant "concedes that the subject claims fall within the Abstract Ideas judicial exception." (Appeal Br. 6.) We agree with the Appellant that the claims recite an abstract idea. More specifically, steps (a)–(j) recite a pharmaceutical marketing method which is a fundamental economic practice, and thus an abstract idea.

Consequently, independent claim 14 recites an abstract idea under Prong One of step 2A.

Thus, we proceed to the second prong of Step 2A (Prong Two) of the 2019 Guidance. In Prong Two, we evaluate whether the claim contains additional elements that "integrate" the abstract idea "into a practical application." (2019 Guidance, Federal Register Vol. 84, No. 4, 54.) "Additional elements" are "claim features, limitations, and/or steps that are recited in the claim beyond the identified judicial exception." (*Id.* at 55, n. 24) As such, an "additional element" in independent claim 14 can only be a feature or step that is not part of a pharmaceutical marketing method.

Step (c) recites "providing educational information for a medical product or service updated with software operable to scan information sources for drug alerts." (Appeal Br., Claims App.) Step (h) recites "providing questions or puzzles with questions updated with software operable to scan information sources for drug alerts." (*Id*.) The Appellant argues the limitation "*updated with software operable to scan information for drug alerts*" is an additional element. (*Id.* at 6.)

Insofar as the Appellant is saying that a pharmaceutical company updating a doctor with product-related information is beyond the identified abstract idea, we disagree. The Specification states that it is "commonly known" that "[d]rug companies spend extensively to provide product information," and that "[t]he pharmaceutical salesperson helps provide this educational service by keeping doctors updated on the latest changes in medical science, and potential benefits and safety precautions for their patients." (Spec. ¶ 3.) Thus, keeping doctors updated on drug alerts is a common part of a pharmaceutical company's marketing method.

Insofar as the Appellant is saying that a pharmaceutical company looking to "sources" of information when updating its marketing materials is beyond the abstract idea, we disagree. The Specification states that "[t]hose skilled in the art" would recognize that there is "copious quantities of medical and drug information" that can be "quer[ied], gather[ed], analyze[d], and distribute[d]." (Spec. ¶ 65.) Thus, gathering information to accurately update marketing materials is another common part of a pharmaceutical company's marketing method.

Insofar as the Appellant is saying that the term "software" is recited in independent claim 14 and software can constitute an additional element

beyond the abstract idea, we agree.[7] Here, however, the recited software amounts to "instructions to implement an abstract idea" (i.e., a pharmaceutical company's marketing method) "on a computer." (2019 Guidance, Federal Register Vol. 84, No. 4, 55.) As explained above, scanning information sources and updating marketing materials are typical parts of a pharmaceutical company's marketing method, and the recited software does nothing more than implement these marketing tasks.

Consequently, independent claim 14's additional element ("software") does not integrate the abstract idea into a practical application under Prong Two of Step 2A of the 2019 Guidance.

Thus, we proceed to Step 2B of the 2019 Guidance. In Step 2B, we evaluate whether "additional elements recited in the claim[] provide[s] 'significantly more' than the recited judicial exception." (2019 Guidance, Federal Register Vol. 84, No. 4, 56.) More particularly, we evaluate whether these additional elements "[add] a specific limitation or combination of limitations that are not well-understood, routine, conventional activity," or whether they instead "simply append[] well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception." (*Id.*)

Here, the Specification states that one of ordinary skill in the art would "recognize that the copious quantities of medical and drug information may require software to query, gather, analyze, and distribute." (Spec. ¶ 9.) In other words, it is well-understood, routine, and/or

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[7] "[C]laims directed to software" are not "inherently abstract." (*Enfish, LLC* v. *Microsoft Corp.,* 822 F.3d 1327, 1335 (Fed. Cir. 2016).)

conventional to use software to scan and update drug information. And the Specification describes this software simply as "software" that may "be utilized to scan for the most up to date drug and medical information." (*Id.* ¶ 51.)[8]

Consequently, under Step 2B, independent claim 14's additional element ("software") does not provide significantly more than the recited abstract idea under Step 2B of the 2019 Guidance.

We agree, therefore, with the Examiner's conclusion that independent claim 14 fails the *Alice* test for patent eligibility.

The Appellant argues that independent claim 14 "provide[s] something more than the gathering and distribution of information," because "the contest puzzles and the correct answers are updated with drug alerts on a contemporaneous basis at the time the doctor is being educated about the drug." (Appeal Br. 7.) According to the Appellant, this is "unconventional" and "not routinely done in the field." (*Id.*) This establishes, at most, that the Appellant has come up with an improved marketing method in which a pharmaceutical company quickly relays drug alerts to a doctor in an entertaining way. But even a "brilliant" abstract idea "does not by itself satisfy the § 101 inquiry." (*Association for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013).)

The Appellant also argues that the claims "are confined to that particular useful application in the education of a prescription writing professional." (Appeal Br. 7.) This is just another way of saying that the

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[8] As for the hardware on which software instructions are executed, we agree with the Examiner that they "are all general purpose of generic-type computers." (Answer 4; *see also* Spec. ¶¶ 80–90.)

claimed marketing strategy is commercially tailored for a pharmaceutical company because "traditional sales techniques [were] not perfect." (Spec. ¶ 6.)

Thus, we sustain the Examiner's rejection of independent claim 14 under 35 U.S.C. § 101.

Claims 5–11 and 13–20 are argued as group for this rejection, and so they fall together. (*See* Appeal Br. 6–7.) Thus, we also sustain the Examiner's rejection of claims 5–11, 13, and 15–20 under 35 U.S.C. § 101. (*See* 37 CFR § 41.37(c) (1)(iv).)

Rejection II — 35 U.S.C. § 103

The Examiner determines that the pharmaceutical marketing method recited in independent claim 14 would have been obvious over the combined teachings of Bhan, Hawks, and Mayaud.

Step (a) of independent claim 14 recites "targeting a medical prescription writing customer." (Appeal Br., Claims App.) The Examiner finds that Bhan discloses a pharmaceutical marketing method in which a doctor (a medical prescription writing customer) is targeted and provided with educational information for medical product. (*See* Final Action 4.) In Bhan, the doctor is targeted based upon his/her specialty and provided with information about a drug relating to this specialty. (*See* Bhan ¶ 44.)[9]

Step (c) of independent claim 14 recites "providing educational information for a medical product or service updated with software operable

[9] For example, when the doctor "is a pediatrician, information about the juvenile diabetes drug would be sent," and when the doctor "is a geriatrics specialist, information about an osteoporosis drug would be sent." (Bhan ¶ 44.)

to scan information sources for drug alerts relevant to the product or service." (Appeal Br., Claims App.) The Examiner finds that Mayaud discloses providing doctors with drug alerts or advisories. (*See* Final Action 11.) Mayaud teaches "a computerized, prescription management system" that "provides a vehicle data collecting relevant data; parameters and a means for analysis of that data; and a means for disseminating alerts and advisories." (Mayaud ¶¶ 19, 193.) In this manner, the system can "communicate important messages, such as drug warnings and alerts, quickly and directly to physician users" and "manag[e] unanticipated problems arising with new drugs." (*Id.* ¶¶ 187, 193.)

The Examiner determines that it would have been obvious, in view of Mayaud, to modify Bhan's pharmaceutical marketing method to include drug alerts with the information/questions transmitted to the doctor "to more effectively manage any unanticipated problems or withdrawals associated with a particular drug." (Final Action 11.)

The Appellant argues that "[n]one of the references teach or suggest the elements of 'targeting' and 'providing information' updated with drug alerts." (Appeal Br. 8.) The Appellant asserts that, in Bhan, "there is no provision for a 'live' updating of the product information with drug alerts." (*Id*. at 7.) The Appellant asserts that, in Mayaud, information is provided "to a doctor who calls up a drug at the time a prescription is entered," and who "must have been pre-educated about it to call it up." (*Id*.)

This argument is not aligned with the Examiner's rejection which relies upon Mayaud, not Bhan, to teach the updating of product information with drug alerts; and relies upon Bhan, not Mayaud, to teach targeting a medical prescription writing customer. (*See* Final Action 11.)

The Appellant argues the references do not "motivate one skilled in the art to provide a drug alert to doctors who have not previously signified interest in the drug." (Appeal Br. 8.) However, the Appellant does not counter the Examiner's findings that "the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable." (Final Action 5.) And "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." (*KSR Intern. Co. v. Teleflex, Inc*. 550 U.S. 398, 416 (2007).)

Thus, we sustain the Examiner's rejection of independent claim 14 under 35 U.S.C. § 103.

Claims 5–11 and 13–20 are argued as group for this rejection and so they fall together. (*See* Appeal Br. 7–8.) Thus, we also sustain the Examiner's rejection of claims 5–11, 13, and 15–20 under 35 U.S.C. § 103. (*See* 37 CFR § 41.37(c)(1)(iv).)

Rejection III — 35 U.S.C. § 112

The Examiner determines that dependent claim 11 recites claim language is that indefinite and "one of ordinary skill in the art would not be apprised on the scope of the invention." (Final Action 2.)

Dependent claim 11 recites "technical questions designed to catch the attention of the medical prescription writing customer" and "trivial questions designed to catch the attention of the non-prescription writing gatekeeper." (Appeal Br., Claims App.) For example, the medical prescription writing customer (e.g. a doctor) would be provided with a question about the bone

mineral density of menopausal women; and the non-prescription writing gatekeeper (e.g., a secretary) would be provided with a question about a Bill Murray movie. (*See* Spec. Figs. 3A, 3B.)

The Appellant argues that one of ordinary skill in the art (e.g., a person skilled in pharmaceutical marketing methods) would be able ascertain the scope of independent claim 11. We are persuaded by this argument. When dependent claim 11 is read in the context of the Specification, one of ordinary skill in art would understand that a "technical" question provided to a doctor would require medical knowledge to answer, while a "trivial" question provided to a secretary would require only everyday knowledge to answer.

Thus, we do not sustain the Examiner's rejection of dependent claim 11 under 35 U.S.C. § 112.

CONCLUSION

Claim(s) Rejected	**Basis**	**Affirmed**	**Reversed**
5–11, 13–20	§§ 103, 101 Bhan, Hawks, and Mayaud	5–11, 13–20	
11	§ 112		11
Overall Outcome		5–11, 13–20	

DECISION

We affirm the Examiner's rejection of claims 5–11 and 13–20 under 35 U.S.C. § 101.

We affirm the Examiner's rejection of claims 5–11 and 13–20 under 35 U.S.C. § 103.

We reverse the Examiner's rejection of claim 11 under 35 U.S.C. § 112.

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