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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/198,103	08/04/2011	Ezra Hanz	9797.001US1-SD	7118

39564 7590 10/01/2020

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EXAMINER	
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ART UNIT	PAPER NUMBER
3686	

NOTIFICATION DATE	DELIVERY MODE
10/01/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EZRA HANZ, JEFFREY ARTHUR STAHL,
and LEWIS ARNOLD STAHL

Appeal 2018-008212
Application 13/198,103
Technology Center 3600

Before MURRIEL E. CRAWFORD, TARA L. HUTCHINGS, and ROBERT J. SILVERMAN, *Administrative Patent Judges*.

HUTCHINGS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant[1] filed a Request for Rehearing ("Req. Reh'g"), pursuant to 37 C.F.R. § 41.52, on July 1, 2020, seeking reconsideration of our Decision on Appeal mailed March 20, 2020 ("Decision"), in which we affirmed the Examiner's rejection of claims 1 and 15 under 35 U.S.C. § 101 as directed to

[1] We use the term "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42.

a judicial exception without significantly more.[2] We have jurisdiction over the Request for Rehearing under 35 U.S.C. § 6(b).

DISCUSSION

Appellant argues that in affirming the Examiner's rejection under 35 U.S.C. § 101 in the framework of the Revised Guidance, the Board found that the claims were abstract because they related to mental steps and/or organizing human activity. Req. Reh'g 2. Appellant argues that the Examiner did not rely on the claims being drawn to mental steps or organized activity. *Id.* at 3. Rather, the Examiner determined that:

> Claims 1, 15 are directed to an abstract idea because an abstract idea is recited in the claims. The abstract idea is identified as: receiving the electronic prescription information including patient/prescriber's identities, parsing the prescription information to extract the patient/prescriber identity, accessing personal data about prescribing habits of the prescribe, automatically generating and transmitting a message for displaying information based on the past prescribing habits of the prescriber and medicine prescribed specific clinical information to the medicine being prescribed prior to the prescriber completing a prescription for the medication, while the clinical information is displayed on said display, the prescriber is unable to complete the prescription.
>
> And thus the claims are similar to other concepts that have been identified as an abstract idea in Electric Power Group in that it collects information (i.e., receiving and extracting prescription information including patient and prescriber information), analyzes the information (i.e., accessing and analyzing

[2] We also reversed the Examiner's rejection of claims 1 and 15 under 35 U.S.C. § 103(a). Appellant seeks reconsideration only of the affirmed rejection under § 101. *See* Req. Reh'g 2.

> prescriber's habit for previous drug), and displays the results (i.e. displaying prescriber habits and the medicine prescribed).

Id. (quoting Ans. 4). Appellant contends that the Board relies on a new basis for rejecting the claims, and that Appellant should be given an opportunity to respond. *Id.* at 4.

As set forth in the Decision, after Appellant's briefs were filed, the U.S. Patent and Trademark Office published 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50 (Jan. 7, 2019) ("Revised Guidance") that applies to all applications and patents resulting from applications filed before, on, or after January 7, 2019. The Office issued further guidance on October 17, 2019, clarifying the Revised Guidance. USPTO, October 2019 Update: Subject Matter Eligibility ("October 2019 Update"), https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf.

The October 2019 Update at page 7 explains that claims that recite mental processes include "a claim to 'collecting information, analyzing it, and displaying certain results of the collection and analysis,' where the data analysis steps are recited at a high level of generality such that they could practically be performed in the human mind, *Electric Power Group, LLC v. Alstom, S.A.*" Therefore, we understand the Examiner's characterization of the abstract idea, which analogized the claims to those at issue in *Electric Power*, to be a form of mental process, i.e., "concepts performed in the human mind (including an observation, evaluation, judgment, opinion)." Revised Guidance, 84 Fed. Reg. at 52 (footnote omitted). For example, the Examiner found that, like the claims at issue in *Electric Power*, Appellant's claims "collect[ ] information (i.e., receiving and extracting prescription information . . .), analyze[ ] the information (i.e., accessing and analyzing

prescriber's habit for previous drug), and display[ ] the results (i.e.[,] displaying prescriber habits and the medicine prescribed). Ans. 4 (emphasis omitted). Therefore, we do not agree that the thrust of our rejection changed from that set forth by the Examiner.

Appellant further argues that the claims are not directed to mental steps because a computer is needed. Req. Reh'g 4–5. Appellant contends that "[n]o one could . . . keep track of years of prescribing history for a drug and hundreds of different versions of information related to the drugs, and then display the right version of the information before the prescription is complete." *Id.* at 5. Appellant's argument is not persuasive, at least because it is not commensurate in scope with the claim language. Nothing in the claim language requires years of prescribing history or hundreds of different versions of information related to drugs. Moreover, mental processes remain unpatentable even when automated to reduce the burden on the user of what once could have been done with pen and paper. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011) ("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*.").

Appellant argues that the Board's further characterization of the claims as relating to a "commercial interaction," which is a certain method of organizing human activity and, thus, an abstract idea, "lacked analysis." Req. Reh'g 6. In this regard, Appellant contends:

> Applicant is not able to refute the Board's reasoning because the reasoning is nonexistent. How do the claims relate to advertising or marketing, and business relations? Why is a commercial interaction a method of organizing human activity? Why has the Board strayed from the guidelines of what constitutes organizing human activity according to MPEP 2106.04(a) Abstract Ideas

> [R-10.2019] -i.e., "fundamental economic principles or practices . . . commercial or legal interactions . . . managing personal behavior . . ."?

Id. (alterations in original).

We disagree that the Board strayed from the guidelines of what constitutes certain methods of organizing human activity. The Revised Guidance explains that this category includes "commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; [and] business relations)." Revised Guidance, 84 Fed. Reg. at 52.

Appellant's Specification describes that the information delivered to the prescriber includes "advertising or educational information" in the form of a message. Spec. ¶ 17. "For instance, when a prescriber has chosen to prescribe a specific drug, the system has the capability to offer an alternative drug (possibly comprising a paid-for advertisement by a pharmaceutical company)." *Id.* The message is "useful or beneficial to the patient and/or the prescriber in addition to being beneficial to the advertising entity (e.g., a pharmaceutical company)." *Id.* ¶ 19. Because messages include "advertising, the system also provides mechanisms for tracking the efficacy of such advertising and generating and delivering reports to the advertisers disclosing the efficacy of the advertising." *Id.* ¶ 20. Messages can include

> advertisements concerning alternative drugs to the one being considered by the prescriber for prescription, available generic alternatives to name-brand drugs, a suitable alternative medicine based on Formulary data, coupons for discounts on the medicine being prescribed or an alternative medicine, a recall notice, a health warning, or a recommend medication(s) based on current disease state.

Id. ¶ 25. Put simply, the Specification describes the claimed invention in the context of advertising, and marketing or sales activities or behaviors, i.e., a commercial interaction. *See also, e.g.*, *id.* ¶¶ 47–49 (describing querying a data collection module for information about the effectiveness of the advertising and other messaging, and allowing advertisers and other entities determining the efficacy of the advertising/messaging).

The Specification also describes the claimed invention in terms of compliance with legal obligations, i.e., a commercial interaction. For example, the "relevant laws and regulations of the pertinent countries, such as the HIPPAA medical privacy laws of the United States." Spec. ¶ 27. "Other data points an [sic] be used to comply with local laws and regulations . . . ." *Id.* "[W]ithin the Untied [sic] States, all advertising messages should comply with FDA guidelines, such as including any required regulatory statements." *Id.* In this regard, the Specification provides that the message may contain "an interface, such as a hyperlink to additional sources of information, such as regulatory web pages." *Id.* ¶ 24. Therefore, the Specification describes the claimed invention in the context of advertising, and marketing or sales activities or behaviors, i.e., a commercial interaction.

Nonetheless, on the facts of this case, we deem it reasonable to designate our affirmance of the rejection of claims 1 and 15 under 35 U.S.C. § 101 as a new ground of rejection.

CONCLUSION

Outcome of Decision on Rehearing:

Claims Rejected	35 U.S.C. §	Basis	Denied	Granted
1, 15	101	Eligibility		1, 15

Final Outcome of Appeal After Rehearing:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed	New Ground
1, 15	101	Eligibility	1, 15		1, 15

37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in MPEP § 1214.01.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

GRANTED; 37 C.F.R. § 41.50(b)