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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* LANCE A. LIOTTA and TYSON LIOTTA

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Appeal 2019-003109  
Application 10/130,402  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and  
NINA L. MEDLOCK, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL  
STATEMENT OF THE CASE

Appellant<sup>1</sup> seeks our review under 35 U.S.C. § 134 of the Examiner's non-final rejection of claims 14–16, 27–29, 32, 37, 38, 40–43, 49, 52–62, and 64–73. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as INSTANTDX, LLC. (Appeal Br. 1).

## THE INVENTION

Appellant claims a system and method for real-time delivery of medical tests and related data from laboratories or similar sources to portable communication devices. (Spec. 1, ll. 6–9; Title).

Claim 14 is representative of the subject matter on appeal.

14. A method for physician use of a portable communications device to prepare and submit a prescription, said method comprising:

receiving medical test data having test results for a plurality of medical tests for a patient;

receiving a comparison of each test result with a data range which determines severity and the data range defines normal standard test data results;

displaying to a physician a list of the compared test results ranked in order of severity via an Internet browser of said portable communications device;

receiving a request to generate a prescription for the patient after displaying the list of the test results;

displaying to the physician a list of drugs in response to the request using said portable communications device;

receiving by said portable communications device input from said physician relating to a drug selected from said list of drugs;

displaying to said physician using said portable communications device at least one predefined default electronic prescription for said selected drug, the at least one predefined default electronic prescription including identification of a drug, an amount of the drug, and dosing information for a patient, the dosing information identifying the frequency with which the patient takes the drug;

receiving by said portable communications device input from said physician that one of: (i) accepts one of said at least one predefined default electronic prescriptions; (ii) modifies one of said at least one of said predefined default electronic prescription, or (iii) generates at least one electronic prescription that is not predefined;

sending one of said accepted, modified, or generated electronic prescriptions to a pharmacy using said portable communications device; and

periodically receiving a reminder message when the sent electronic prescription requires that the patient submit to additional lab testing.

#### THE REJECTIONS<sup>2</sup>

Claims 14–16, 27–29, 32, 37, 38, 40–43, 49, 52–62, and 64–73 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.<sup>3</sup>

Claim 72 is rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of the claim upon which it depends.

Claims 14, 15, 27–29, 32, 37, 38, 40–43, 60, 64, 67–70, and 73 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mayaud (US 5,845,255; December 1, 1998), Levine (US 4,852,570; August 1, 1989), Surwit (US 6,024,699; February 15, 2000), and Zarom (US 6,356,529 B1; March 12, 2002).

Claims 16 and 59 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mayaud, Levine, Surwit, Zarom, and Wong (US 6,115,690; September 5, 2000).

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<sup>2</sup> The Examiner has withdrawn the rejection of claims 27–29, 32, 40, 42, 43, 64, 69, and 70 under 35 U.S.C. § 112, first paragraph.

<sup>3</sup> Newly added claims 67–73 are not listed with the claims rejected under 35 U.S.C. § 101 in the Non-Final action. However, claim 73 is discussed in the Non-Final Action and the Answer (Non-Final Act. 44; Ans. 73) and claims 69, 71 and 73 are discussed in the Appeal Brief (Appeal Br. 17, 21). Therefore, we treat the absence of these claims in the listing of the claims rejected under 35 U.S.C. § 101 as inadvertent.

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Claims 49, 53, 54, 61, 62, 65, 66, 71, and 72 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mayaud, Zarom, and Wong.

Claims 52 and 56–58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mayaud and Zarom.

Claim 55 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Mayaud, Zarom, and Levine.

## ANALYSIS

### 35 U.S.C. § 101 REJECTION

We will sustain the rejection of claims 14–16, 27–29, 32, 37, 38, 40–43, 49, 52–62, and 64–73 under 35 U.S.C. § 101.

#### The Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, . . . determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . If so, . . . then ask, “[w]hat else is there in the claims before us?” . . . To answer that question, . . . consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. . . . [The Court] described step two of this analysis as 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.”

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*Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 217–18 (first and last alterations in original) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)) (citations omitted).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept. The Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the [S]pecification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). It asks whether the focus of the claims is on a specific improvement in relevant technology or on a process that itself qualifies as an “abstract idea” for which computers are invoked merely as a tool. *See id.* at 1335–36.

In so doing we apply a “directed to” two prong test: 1) evaluate whether the claim recites a judicial exception, and 2) if the claim recites a judicial exception, evaluate whether the judicial exception is integrated into a practical application. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”).

In the briefing, Appellant refers to prior USPTO guidance regarding § 101, including, for example: *Memorandum on Subject Matter Eligibility Decisions* dated November 2, 2016 (“the 2016 Memorandum”). (Appeal Br. 18). However, the 2016 Memorandum and other prior guidance, including: (1) *2014 Interim Guidance on Patent Subject Matter Eligibility*, 79 Fed. Reg. 74,618 (December 16, 2014); (2) *July 2015 Update on Subject Matter Eligibility*, 80 Fed. Reg. 45,429 (July 30, 2015) (“the 2015 Update”) and (3) *May 2016 Subject Matter Eligibility Update*, 81 Fed. Reg. 27,381 (May 6, 2016) have been superseded by the 2019 Revised Guidance. *See*

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2019 Revised Guidance, 84 Fed. Reg. at 52. As such, our analysis will not address the sufficiency of the Examiner's rejection against the cited prior guidance. Rather, our analysis will comport with the Guidance as discussed below.

The Examiner determines that claim 14 is directed to receiving medical test data having test results, a comparison of test results to severity data ranges, a comparison of test results to severity data ranges to list the compared test results in order of severity, and displaying a list of the compared test results. The Examiner determines that this correlates to collecting information (receiving medical test data having test results), analyzing it (comparison of test results to severity data ranges to list the compared test results), and displaying certain results of the collection and analysis (displaying a list of the compared test results). (Non-Final Act. 3). The Examiner determines that the claims are directed to a fundamental medical practice which correlates to an idea of itself and a mental process. (*Id.* at 4).

The Specification discloses that the present invention enables physicians to access test results remotely as soon as they become available by exchanging information with portable devices. (Spec. 1, ll. 11–12). The Specification also discloses that, with particular reference to mobile telephones, no prior systems are known to exist for receiving and transmitting medical information and/or transaction data. (*Id.* at 3, ll. 2–4). The Specification summarizes the invention as a method for delivery and use of medical test data which includes receiving medical test data related to at least one patient. The test data are stored on a medical server and the physician is notified that the test data are available and the test data are sent to the communications device of the physician. (*Id.* at 3, ll. 18–27). The

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physician uses the test results to develop a treatment regimen which may include prescription or pharmacological treatment. (*Id.* at 9, ll. 5–8). The physician develops an electronic prescription and sends the prescription electronically to a pharmacy. (*Id.* at 9, ll. 9–16). The Specification also discloses that a physician is presented with an overview of lab results from his/her patient in the form of a list which lists patients in order of lab result severity. (*Id.* at 13, ll. 25–33). As such, the disclosure in the Specification supports the Examiner’s determination regarding the recitations of claim 14.

The method of claim 14 manages the personal behavior, relationship or interactions between a physician and a patient which is one of certain methods of organizing human activity that are judicial exceptions as identified in the Guidance 84 Fed. Reg. at 53.

Alternately, this is an example of concepts performed in the human mind as mental processes because the steps of generating, receiving, analyzing, and displaying data mimic human thought processes of observation, evaluation, judgment, and opinion, perhaps with paper and pencil, where the data interpretation is perceptible only in the human mind. *See In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016).

We thus agree with the Examiner’s determination that claim 14 recites judicial exceptions.

Also, we determine that the steps of claim 14 constitute “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016); *see also buySAFE, Inc. v. Google, Inc.*, 765



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F.3d 1350, 1355 (Fed. Cir. 2014) (claims directed to certain arrangements involving contractual relations are directed to abstract ideas). Thus, we determine that claim 14 recites the judicial exception of methods of organizing human activity and in the alternative, a mental process.

Turning to the second prong of the “directed to” test, claim 14 requires a “portable communications device” which is disclosed as a web-enabled mobile telephone. (Spec. 3, l. 30). The recitation of a “portable communications device” does not impose “a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” Guidance 84 Fed. Reg. at 53. We find no indication in the Specification, nor does Appellant direct us to any indication, that the operations recited in independent claim 14 invoke any inventive programming, require any specialized computer hardware or other inventive computer components, i.e., a particular machine, or that the claimed invention is implemented using other than generic computer components to perform generic computer functions. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”).

We also find no indication in the Specification that the claimed invention effects a transformation or reduction of a particular article to a different state or thing. Nor do we find anything of record, short of attorney argument, that attributes any improvement in the portable communications device and/or functionality to the claimed invention or that otherwise indicates that the claimed invention integrates the abstract idea into a “practical application,” as that phrase is used in the Guidance. *See* Guidance, 84 Fed. Reg. at 55.

In this regard, the recitation does not effect an improvement in the functioning of the portable communications device or other technology, does not recite a particular machine or manufacture that is integral to the claims, and does not transform or reduce a particular article to a different state or thing. *Id.* Thus, claim 14 is directed to judicial exceptions that are not integrated into a practical application and thus claim 14 is directed to “abstract ideas.”

Turning to the second step of the *Alice* analysis, because we find that claim 14 is directed to abstract ideas, the claims must include an “inventive concept” in order to be patent eligible, i.e., there must be an element or combination of elements that is sufficient to ensure that the claim in practice amounts to significantly more than the abstract idea itself. *See Alice*, 573 U.S. at 217–18 (quoting *Mayo*, 566 U.S. at 72–73).

The introduction of a computer in the form of a portable communications device into the claims does not alter the analysis at *Alice* step two.

[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility. Nor is limiting the use of an abstract idea “to a particular technological environment.” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implemen[t]” an abstract idea “on . . . a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our § 101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional featur[e]” that provides any “practical assurance that the

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process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

*Alice*, 573 U.S. at 223 (alterations in original) (citations omitted).

Instead, “the relevant question is whether [claim 14] do[es] more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Id.* at 225. It does not.

Taking the claim elements separately, the function performed by the computer in the form of the portable communication device at each step of the process is purely conventional. Using a computer to retrieve, select, and apply decision criteria to data and modify the data as a result amounts to electronic data query and retrieval—one of the most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the trading industry. *See Elec. Power Grp.*, 830 F.3d at 1354; *see also In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1316 (Fed. Cir. 2011) (“Absent a possible narrower construction of the terms ‘processing,’ ‘receiving,’ and ‘storing,’ . . . those functions can be achieved by any general purpose computer without special programming”). In short, each step does no more than require a generic computer to perform generic computer functions. As to the data operated upon, “even if a process of collecting and analyzing information is ‘limited to particular content’ or a particular ‘source,’ that limitation does not make the collection and analysis other than abstract.” *SAP Am. Inc. v. InvestPic, LLC*, 890 F.3d 1016, 1022 (Fed. Cir. 2018).

Considered as an ordered combination, the computer component of Appellant’s claims add nothing that is not already present when the steps are considered separately. The sequence of data reception-analysis-access/display is equally generic and conventional or otherwise held to be

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abstract. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (sequence of receiving, selecting, offering for exchange, display, allowing access, and receiving payment recited an abstraction), *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (holding that sequence of data retrieval, analysis, modification, generation, display, and transmission was abstract), *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (holding sequence of processing, routing, controlling, and monitoring was abstract). The ordering of the steps is, therefore, ordinary and conventional.

Claim 14 does not, for example, purport to improve the functioning of the portable communications device itself. As we stated above, claim 14 does not effect an improvement in any other technology or technical field. The Specification spells out different generic equipment and parameters that might be applied using this concept and the particular steps such conventional processing would entail based on the concept of information access under different scenarios. (*See, e.g.*, Spec. 3, l. 30; 11 ll. 12–15). Thus, claim 14 amounts to nothing significantly more than instructions to apply the abstract ideas using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 573 U.S. at 226.

We have reviewed all the arguments (Appeal Br. 14–34; Reply Br. 2–16) Appellant has submitted concerning the patent eligibility of the claims before us that stand rejected under 35 U.S.C. § 101. We find that our analysis above substantially covers the substance of all the arguments, which have been made. But, for purposes of emphasis, we will address various arguments in order to make individual rebuttals of same.

We are not persuaded of error on the part of the Examiner by Appellant's argument that claim 14 recites a technical improvement because the present application results in lower electrical power burden on a portable communications device, improves the speed at which relevant data can be assessed, and reduces the amount of data needed to be processed in a computer network. In making this argument, Appellant argues that the instant claims are similar to the claims in *Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, 880 F.3d 1356 (Fed. Cir. 2018). (Appeal Br. 15).

We do not consider claim 14 to improve efficiency of a particular machine or in a particular technology as were the claims in *Core Wireless*. In *Core Wireless* the court held that claims which recited an interface were patent eligible as the claims recited specific limitations of the interface such as: an application summary that can be reached through a menu, the data being in a list and being selectable to launch an application, *and additional limitations directed to the actual user interface displayed and how it functions*. *Core Wireless*, 880 F.3d at 1363. The court found that the claims were directed to an improved user interface and not the abstract concept of an index as the claim "limitations disclose a specific manner of displaying a limited set of information to the user, rather than using conventional user interface methods to display a generic index on a computer." *Id.* Further, an improvement in efficiency alone does not render claim 14 patent eligible. "While the claimed system and method certainly purport to accelerate the process of analyzing audit log data, the speed increase comes from the capabilities of a general-purpose computer, rather than the patented method itself. *See Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) ("[T]he fact that the required calculations could be performed more efficiently via a computer does not

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materially alter the patent eligibility of the claimed subject matter.’).”

*FairWarning IP, LLC*, 839 F.3d at 1095.

In regard to Appellant’s argument that the claims reduce the electrical power load and amount of data needed to be processed, we note that we can find no basis for it in the claim or the Specification. Appellant has not directed us to a disclosure in the Specification about a problem of electrical power load that has been solved by following the recited steps of the claimed method on a generic computer. Therefore, this argument is not only not commensurate in scope with what is claimed but, because the record does not reflect it, amounts to mere attorney argument. Attorney argument, however, cannot take the place of record evidence. *See In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1581 (Fed. Cir. 1989).

We are not persuaded of error on the part of the Examiner by Appellant’s argument that the features of the claims were not previously known and improve medical computer networks and devices that provide real-time delivery of medical tests and related data. (Appeal Br. 18–19). In making this argument, Appellant relies on *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016).

We agree with the Examiner’s response to this argument and adopt same as our own. (Ans. 6–8). In addition, we are not persuaded that the claimed invention is analogous to the claimed invention in *McRO*. The claims in *McRO* were directed to a specific asserted improvement in computer animation, i.e., the automatic use of rules of a particular type. *McRO*, 837 F.3d at 1313. By contrast, claim 14 under appeal recite only receiving, processing, and analyzing information.

We are not persuaded of error on the part of the Examiner by

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Appellant's argument that the claims do not unduly preempt the field. (Appeal Br. 24–25). “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”). And, “[w]here a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa*, 788 F.3d at 1379.

In view of the foregoing, we will sustain this rejection as it is directed to claim 14 and claims 15, 16, 37, 38, 59, 60, 67–68 dependent therefrom. We will also sustain the rejection as it is directed to claims 27–29, 32, 40–43, 52–58, 61, 62, 64, and 65 because Appellant has not argued the separate eligibility of these claims.

In regard to claim 49, Appellant argues that the claim effects a particular treatment of prophylaxes for a disease or medical condition by “generating an electronic prescription” for a disease or medical condition. (Reply Br. 15). Appellant does not explain how claim 49 effects a particular treatment. The Guidance includes a ‘treatment/prophylaxis’ consideration, under which a claim can integrate a judicial exception into a practical application by applying or using the judicial exception to effect a particular treatment or prophylaxis for a disease or medical condition.”). Guidance, 84 Fed. Reg. at 55. Claim 49, however, does not recite applying a specific compound at specific doses to treat a particular medical condition for specific patients in a manner analogous to the eligible treatment method.

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*See Vanda Pharm. Inc. v. W.-Ward Pharm. Int'l Ltd.*, 887 F.3d 1117, 1136 (Fed. Cir. 2018) (“At bottom, the claims here are directed to a specific method of treatment for specific patients using a specific compound at specific doses to achieve a specific outcome.”). In contrast, claim 49, considered as a whole, is directed to creating an electronic prescription for some condition which includes steps directed to transmitting, analyzing, storing, and displaying information. As indicated in the preamble of claim 49, the method can be used to generate an electronic prescription, but claim 49 does not recite any steps related to treating any determined condition. Therefore, we will sustain the rejection as it is directed to claim 49.

In regard to claims 69 and 71, Appellant argues that the claims improve the technical functioning by reducing the electrical power burden on the portable communications device. This argument is not persuasive for the same reasons given above in response to this argument as it is directed to claim 14.

We are not persuaded of error on the part of the Examiner in rejecting claim 73 by Appellant’s argument that the features of claim 73 minimize memory usage of the portable communications device. This argument fails for the same reasons given in response to Appellant’s argument that claim 14 results in reduced power load and reduced data processed, i.e., we can find no basis for it in the claim or the Specification. Appellant has not directed us to a disclosure in the Specification about a problem of memory usage that has been solved by following the recited steps of claim 73 on a generic computer. The argument is not only not commensurate in scope with what is claimed but, because the record does not reflect it, amounts to mere attorney argument. As such, we will sustain the rejection as it is



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directed to claim 73.

### 35 U.S.C. §112, FOURTH PARAGRAPH REJECTION

The Examiner rejects claim 72, determining that because “it is possible to infringe on the electronic device [recited in claim 72] separately from the method claimed in the parent claim [(i.e., claim 49)], claim 72 fails to further limit the claim from which it depends as required by 35 U.S.C. § 112, fourth paragraph. (Final Act. 7; Ans. 18-19).

We will not sustain this rejection because in our view claim 72 is directed to an electronic device that is programmed in such a way as to perform the method of claim 49. The claim is to an electronic device programmed to perform a particular method. The phrase “method of claim 49” is used as shorthand to identify the method that the claimed electronic device is programmed to perform, and not to further limit independent claim 49. As such, claim 72 is an independent claim and as such the requirements of 35 U.S.C. §112, fourth paragraph are not applicable.

### 35 U.S.C. §103(a) REJECTIONS

Rejection of claims 14, 15, 27–29, 32, 37, 38, 40–43, 60, 64, 67–70, and 73.

We will not sustain this rejection because we agree with Appellant that the cited prior art does not disclose “periodically receiving a reminder message when the sent electronic prescription requires that the patient submit to additional lab testing.”

The Examiner relies on Mayaud for teaching this subject matter at column 28, lines 19–29 and 38–49; column 31, lines 33–49; column 44, lines 11–18, column 50, lines 18–23; and column 51, line 65 to column 52, line 26. (Non-Final Act. 9–10).

We find that the relied on portion of column 28 of Mayaud describes a notification of fulfillment of a prescription and an alert that the prescription has expired but does not describe a reminder message that the prescription requires that the patient submit to additional lab testing. We find that the relied on portion of column 31 of Mayaud describes an alert sent to the physician if they prescribe an offending agent, but does not describe a reminder message that the prescription requires that the patient submit to additional lab testing. We find that the relied on portion of column 44 describes a more complex embodiment of the invention that integrates applications for prescription management with equivalent applications for diagnostic tests, laboratory analysis, and radiological studies but does not describe a reminder message that the prescription requires that the patient submit to additional lab testing. We find that the relied on portion of column 50 does not describe a message, but rather states that it will be appreciated that the invention can be beneficially applied to the specification of other therapies and technical remedies. We find that relied on portions of columns 51 to 52 describe a method in which a patient's history can drive the selection and establishment of optimal diagnostic test matrix for identifying a patient condition or conditions with good specificity and confidence but does not describe a reminder message that the prescription requires that the patient submit to additional lab testing.

In view of the foregoing, we will not sustain this rejection as it is directed to claim 14 and claims 15, 37, 38, 60, 67–70, and 73 dependent therefrom.

In regard to claim 27, the Examiner relies on the same paragraphs of Mayaud for teaching the step of recommending one or more lab tests based at least in part upon the sent electronic prescriptions. As detailed above,

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these paragraphs describe various aspects of the Mayaud invention, however, we find that these portions of Mayaud do not describe the recommending steps of claim 27. Column 52 does recite suggesting further testing but it is not based on a prescription. Therefore, we will not sustain this rejection as it is directed to claim 27 and claims 28, 29, 32, 40–43, and 64 dependent therefrom.

#### Rejection of claims 16 and 59

Claims 16 and 59 depend from claim 14 and thus require a periodic reminder message. We will not sustain this rejection for the same reasons given in our discussion of the 35 U.S.C. §103(a) of claim 14 because each of these claims requires a reminder message that the prescription requires that the patient submit to additional lab testing and the Examiner relies on Maynaud for teaching this subject matter.

#### Rejection of claims 49, 53, 54, 61, 62, 65, 66, 71, and 72

Each of these claims requires the patient to submit to medical tests when the sent prescription requires additional lab testing and the Examiner relies on Mayaud for teaching this subject matter. Therefore, we will not sustain this rejection as it is directed to claims 49, 53, 54, 61, 62, 65, 66, 71, and 72 for the same reasons given in our discussion of the rejection of claim 14 under 35 U.S.C. §103(a) because each of these claims requires a reminder message that the prescription requires that the patient submit to additional lab testing and the Examiner relies on Maynaud for teaching this subject matter.

Rejection of claims 52, and 56–58

Claims 52, like claim 14 recites “receiving a reminder message” requiring the patient to submit to additional lab testing. The Examiner relies on Mayaud for describing this subject matter. Therefore, we will not sustain this rejection for the reasons given above in our discussion of the rejection of claim 14 under 35 U.S.C. §103(a).

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting the appealed claims under 35 U.S.C. § 101.

We conclude the Examiner did not err in rejecting claim 72 under 35 U.S.C. §112, fourth paragraph.

We conclude the Examiner did err in rejecting the appealed claims under 35 U.S.C. §103(a).

CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
14–16, 27–29, 32, 37, 38, 40–43, 49, 52–62, 64–66	101	Eligibility	14–16, 27–29, 32, 37, 38, 40–43, 49, 52–62, 64–73	
72	112, fourth paragraph			72
14, 15, 27–29, 32, 37, 38, 40–43, 60, 64, 67–	103(a)	Mayaud, Levine, Surwit, Zarom		14, 15, 27–29, 32, 37, 38, 40–43, 60, 64, 67–

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70, 73				70, 73
16, 59	103(a)	Mayaud, Levine, Surwit, Zarom, Wong		16, 59
49, 53, 54, 61, 62, 65, 66, 71, 72	103(a)	Mayaud, Zarom, Wong		49, 53, 54, 61, 62, 65, 66, 71, 72
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55	103(a)	Mayaud, Zarom, Levine		55
<b>Overall Outcome</b>			14–16, 27– 29, 32, 37, 38, 40–43, 49, 52–62, 64-73	

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).

AFFIRMED