

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BAXTER CORPORATION ENGLEWOOD

Petitioner or Appellant,

v.

PETITION FOR REVIEW

PATENT TRIAL & APPEAL BOARD

Respondent or Appellee.

Baxter Corporation Englewood

(name all parties* bringing the petition or appeal)

hereby petition/appeal the court for review of the Denial of Request for Rehearing in Appl.13/399,092 (describe the order or decision and include decision number) of the Patent Trial and Appeal Board

(name the agency, board, office or bureau) entered on Aug 21, 2017 (date).

The order or decision was received on Aug 21, 2017 (date).

Date: Oct 16, 2017

/s/ Matthew S. Dicke

(Signature of petitioner, appellant or attorney)

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*See Fed. R. App. P. 15 (a) (2) for permissible ways of identifying petitioners.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DENNIS TRIBBLE, JOEL A. OSBRONE,
ABDUL WAHID KHAN, MATTHEW VALENTINE, and
BHAVESH PADMANI

Appeal 2015-008278
Application 13/399,092
Technology Center 3600

Before NINA L. MEDLOCK, TARA L. HUTCHINGS, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

FINAMORE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Pursuant to 37 C.F.R. § 41.52, Appellants filed a Request for Rehearing on July 31, 2017 (“Req. Reh’g”) seeking reconsideration of our Decision on Appeal mailed June 13, 2017 (“Dec.”), in which we affirmed the Examiner’s decision to reject claims 1–18 and 32 under 35 U.S.C. § 101

as directed to non-statutory subject matter.¹ We have jurisdiction over the Request under 35 U.S.C. § 6(b).

ANALYSIS

A request for rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a). Arguments not raised and evidence not previously relied upon in the briefs on appeal are not permitted, except in the limited circumstances set forth in §§ 41.52(a)(2)–(4). In particular, § 41.52(a)(2) allows an appellant to present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

Pursuant to § 41.52(a)(2), Appellants argue that claims 1–18 and 32 are patent-eligible in view of the Federal Circuit’s decision in *BASCOM Global Internet Servs. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016). Req. Reh’g 2. More particularly, Appellants contend that *BASCOM* provides guidance in relation to the second step of the two-step framework for determining patent-eligibility. *Id.* We have considered Appellants’ arguments in light of *BASCOM*, and, for the reasons set forth below, we conclude *BASCOM* does not alter our determination that, pursuant to the second step of the patent-eligibility analysis, the claims do not include inventive concept—an element or combination of elements sufficient to ensure that the claim amounts to significantly more than the

¹ We also reversed the Examiner’s decision to reject claims 1–18 and 32 under 35 U.S.C. § 103(a). Appellants seek reconsideration of only the affirmed rejection under § 101. Req. Reh’g. 2.

abstract idea and to transform the nature of the claim into a patent-eligible concept.

Appellants argue that, in *BASCOM*, the Federal Circuit held a specific, discrete implementation of an abstract idea is patent-eligible even if the underlying process itself is an abstract idea not eligible for patent protection. Req. Reh’g 4. As such, Appellants assert that, like the claims in *BASCOM*, the present claims, as an ordered combination, recite an inventive concept under the second step of the patent-eligibility analysis because the claims represent a specific, discrete implementation of the abstract idea of “receiving & managing dose order preparation.” *Id.* at 4–8. According to Appellants, “[c]omparing the specificity of the present claims regarding the process of management of dose orders to the claims of *BASCOM* regarding filtering content, the present claims are at least as specific as those recited in *BASCOM*.” *Id.* at 5.

Contrary to Appellants’ arguments, the Federal Circuit did not find that the claims in *BASCOM* recited an inventive concept because the claims recited a specific implementation of the abstract idea of filtering content. Rather, in *BASCOM*, the Federal Circuit followed the Supreme Court’s guidance for determining whether the claims recite an inventive concept set forth in *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347, 2357–60 (2014).

In *Alice*, the Supreme Court explained that, under the second step of the patent-eligibility analysis, “the relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea of intermediated settlement on a generic computer.” 134 S. Ct. 2347, 2359 (2014). The Supreme Court also provided examples of claims that

represent more than instructions to implement an abstract idea on a generic computer, such as claims that purport to improve the functioning of the computer itself and claims that effect an improvement in any other technology or technical field. *Id.* at 2359–60.

Turning to *BASCOM*, the Federal Circuit held “[t]he inventive concept described and claimed in the ’606 patent is the installation of a filtering tool at a specific location, remote from end-users, with customizable filtering features specific to each end user.” 827 F.3d at 1350. In determining this feature to be an inventive concept, the Federal Circuit explained that the remote location of a filtering tool having customizable user-specific filtering features provides the filtering tool both the benefits of a filter on a local computer and the benefits of a filter on the ISP server and is a technical improvement over prior art ways of filtering content. *Id.* at 1350–51. Notably, the Federal Circuit specifically determined that “the claims may be read to ‘improve[] an existing technological process.’” *Id.* at 1351 (citing *Alice*, 134 S. Ct. at 2358).

Furthermore, in discussing recent case law regarding the second step of the patent-eligibility analysis, the Federal Circuit emphasized that the claims of the ’606 patent are a technical solution that improves computer technology. For example, in analogizing the claims of the ’606 patent to the patent-eligible claims in *DDR Holdings, LLC v. Hotels.com L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), the Federal Circuit explained:

[A]lthough the invention in the ’606 patent is engineered in the context of filtering content, the invention is not claiming the idea of filtering content simply applied to the Internet. The ’606 patent is instead claiming a technology-based solution (not an abstract-idea-based solution implemented with generic technical components in a conventional way) to filter content on

the Internet that overcomes existing problems with other Internet filtering systems. By taking a prior art filter solution (one-size-fits-all filter at the ISP server) and making it more dynamic and efficient (providing individualized filtering at the ISP server), the claimed invention represents a “software-based invention[] that improve[s] the performance of the computer system itself.”

Id. at 1351 (citations omitted). Similarly, in distinguishing the claims of the '606 patent from claims that lack an inventive concept, the Federal Circuit explained that, unlike the claims of the '606 patent, the claims lacking an inventive concept do not provide a specific technical solution apart from using generic computer concepts in a conventional way to carry out the abstract idea. *Id.* at 1351–52.

Accordingly, in *BASCOM*, the Federal Circuit premised its determination that the claims of the '606 patent include an inventive concept on the fact that the claims represent a technical improvement to filtering content on the Internet, not on the specificity of the claimed filtering scheme, as Appellants suggest. As such, the present claims having a similarly specificity to those claims in *BASCOM* does not apprise us of error in our determination that the present claims lack an inventive concept.

Appellants further rely on the specifics of the claimed method and argue that the management of dose orders by processing dose orders at a monitoring computer in a network and distributing the orders to workstations in the network according to a priority based on a comparison of a dose order record to an inventory record by the monitoring computer is not a conventional activity performed on a generic computer. Req. Reh'g 6–7. According to Appellants, the fact that there are no prior art rejections of the claims under 35 U.S.C. § 102 or § 103 supports Appellants' contention that

the claims, as an ordered combination, include non-conventional activities. *Id.* at 7. We disagree.

At the outset, we note that novelty is not the standard for an inventive concept. In considering whether the claims recite an inventive concept pursuant to the second step of the patent-eligibility analysis, the Federal Circuit has held: “a claim for a *new* abstract idea is still an abstract idea.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016).

Furthermore, as set forth in our Decision on Appeal and unrefuted by Appellants, the specific steps of the claims do not separate the claimed method from the abstract idea of “receiving & managing dose order preparation” under the first step of the patent-eligibility analysis. Dec. 5. Turning to the second step, in considering the claims individually and as an ordered combination, we fail to see how the specific steps recited in the claims improve the functioning of a computer or some other technology. Instead, the particulars of the claimed method improve the management of dose orders, which is untechnical. *Id.* at 10. Consequently, as set forth in the Decision on Appeal, the claims do not recite something apart from the generic computer implementation of the abstract idea of “receiving & managing dose order preparation,” which is not an inventive concept sufficient to confer patent-eligibility. *Id.* at 10–11.

Appellants also contend that the claims recite an inventive concept because they do not preempt all applications of the abstract idea of “receiving & managing dose order preparation.” Req. Reh’g 4–5. Although preemption may be the concern driving the exclusion of abstract ideas from patent-eligible subject matter, preemption is not the test for eligibility. “The

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Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice*, 134 S. Ct. at 2354).

In view of the foregoing, the Federal Circuit’s decision in *BASCOM* does not affect our determination that the claims do not recite an inventive concept pursuant to the second step of the patent-eligibility analysis. As such, Appellants do not apprise us of error in our determination that the claims are directed to non-statutory subject matter, and we, therefore, decline to modify our decision affirming the Examiner’s decision to reject claims 1–18 and 32 under 35 U.S.C. § 101.

DECISION

We have reconsidered our Decision on Appeal in light of Appellants’ Request for Rehearing, and we deny Appellants’ request to modify our original Decision.

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

DENIED