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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ROBERT MATTHEW D'AMBROSIA

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Appeal 2010-008492  
Application 12/061,364  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and  
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Robert Matthew D'Ambrosia (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-4, 7-9, 11-16, 18-27, 29-34, 36-38 and 40-48. We have jurisdiction under 35 U.S.C. § 6(b) (2012).

## SUMMARY OF DECISION

We AFFIRM-IN-PART and enter a NEW GROUND of rejection pursuant to 37 C.F.R. 41.50(b).<sup>1</sup>

## THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A communication system, comprising:

a network;

a first communication device operated by a first medical unit by way of said network;

a first medical record server adapted to:

receive an identification number associated with a data object pertaining to a medical record of a subscriber from the first communication device; and

in response to receiving said identification number, send medical information from said data object to said first communication device by way of said network, wherein said first communication device is further adapted to receive said medical information from said first medical record server by way of said network, receive an annotation to said medical information from said first medical unit, and modify said medical information to include said annotation; and

a second medical record server, wherein said first communication device is adapted to send said annotated

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<sup>1</sup> Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed Dec. 7, 2009) and Reply Brief ("Reply Br.," filed Mar. 18, 2010), and the Examiner's Answer ("Answer," mailed Jan. 20, 2010).

medical information to said second medical record server, and said second medical record server is further adapted to:

receive a request for statistical information related to medical information pertaining to a plurality of medical records pertaining to respective subscribers from a second communication device by way of said network, wherein each of said medical records includes an annotation from a medical unit responding to a medical emergency associated with a corresponding subscriber, and wherein said request includes input parameters related to said statistical information;

perform an analysis on a basis of said input parameters to generate said statistical information; and

send said statistical information to said second communication device by way of said network.

#### THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Johnson	US 5,664,109	Sep. 2, 1997
Kolb	US 6,250,929 B1	Jun. 26, 2001
Dowling	US 6,574,239 B1	Jun. 3, 2003
Barmakian	US 7,213,016 B1	May 1, 2007

The following rejections are before us for review:

1. Claims 1-4, 7-9, 15, 19, 24-27, 32-34, 36-38, 41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson, Dowling, and Kolb.
2. Claims 11-14, 16, 18, 20-23, 29-31, 40 and 42-48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson, Dowling, Kolb, and Barmakian.

## ISSUE

Has the Examiner established a prima facie case of obviousness of the claimed subject matter over the prior art disclosures?

## ANALYSIS

### *Claims 7-9*

Claims 7-9 are subject to this appeal. However, they are dependent on cancelled claim 6. Accordingly, we enter a new ground of rejection of claims 7-9 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

*The rejection of claims 1-4, 7-9, 15, 19, 24-27, 32-34, 36-38, 41 under 35 U.S.C. §103(a) as being unpatentable over Johnson, Dowling, and Kolb.*

### *Claims 7-9*

Because claims 7-9 have been deemed indefinite, the prior art rejection of claims 7-9 is reversed pro forma. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962).

### *Claims 1-4, 15, 19, and 24-27*

Claims 1-4, 15, 19, and 24-27 are drawn to apparatuses comprising an element that functions to “receive a request for statistical information related to medical information pertaining to a plurality of medical records . . . wherein said request includes input parameters related to said statistical information.” In the case of independent claim 1, that element is a second

medical record server. In the case of independent claim 24, that element is a processor. The Examiner's position is that this element is not disclosed in Johnson (Answer 4) but that

Dowling teaches annotating the medical records accordingly (see for example Dowling column 1 lines 61-62 and column 15 lines 39-47 and Fig. 3). Kolb teaches statistically determining if the test population has made significant progress than the control population (see for example Kolb column 5 lines 60-67 and column 6 lines 1-3).

Answer 4.

Notwithstanding the Examiner's characterization of what Dowling and Kolb teach, we agree with the Appellant (App. Br. 14 and Reply Br. 13) that the Examiner has not explained how Dowling and Kolb address the limitation at issue. The Examiner does not explain how these disclosures to annotating the medical records (Dowling) and statistical determination (Kolb) provide for or lead one of ordinary skill in the art to an element that functions to "receive a request for statistical information related to medical information pertaining to a plurality of medical records ... wherein said request includes input parameters related to said statistical information" as claimed. Because this has not been done, a prima facie case of obviousness for the subject matter of these claims over the cited prior art combination has not been made out in the first instance. As a result, the rejection of claims 1-4, 15, 19, and 24-27 is not sustained.

*Claims 32-34, 36-38, and 41*

The Appellant has not challenged the rejection of claims 32-34, 36-38,

and 41. Accordingly, we summarily affirm the rejection of claims 32-34, 36-38, and 41 over the cited prior art combination.

*The rejection of claims 11-14, 16, 18, 20-23, 29-31, 40 and 42-48 under 35 U.S.C. §103(a) as being unpatentable over Johnson, Dowling, Kolb, and Barmakian.*

*Claims 11-14, 16, 18, and 20-23*

Claims 11-14, 16, 18 and 20-23 depend from claim 1, whose rejection was not sustained. See above. For the same reasons, we will not sustain the rejections of claims 11-14, 16, 18 and 20-23 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious . . .”).

*Claims 29-31*

Claims 29-31 depend from claim 24, whose rejection was not sustained. See above. For the same reasons, we will not sustain the rejections of claims 29-31 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious . . .”).

*Claims 40 and 42*

The rejection of claims 40 and 42, which depend from claim 32, will be sustained. As with claim 32 (see above), the rejection of claims 40 and 42 have not been challenged. Accordingly, we summarily affirm their

rejection over the cited prior art combination.

*Claims 43-48*

The rejection of claims 43-48 is reversed for similar reasons to those we gave above in reversing the rejection of claims based on independent claims 1 and 24 above. That is to say, independent claims 43, 44, 47 and 48 and claims 45 and 46, dependent on claim 44, all call for apparatuses comprising an element that functions (in the words of claim 47) to “send a request for statistical information related to medical information ... wherein said request includes input parameters related to said statistical information” which the Examiner has not shown to be disclosed in the cited prior art or explained how one of ordinary skill in the art would reach it given the combination of their disclosures.

Col. 7, ll. 7-15 and col. 8, ll. 13-19 of Barmakian is said to disclose the limitation at issue. Answer 9. The passages are reproduced below.

The database administration function 48 allows certain agents to control the database and to add, update, or remove records from the database. In particular, function 48 allows a database administrator to access and edit a table of agents. This agent table will be a list of individuals with passwords that allow them access to the database administration function. The agent table will include designations of the privileges that will be given to those individuals listed in the table.

Col. 7, ll. 7-15.

The agent service 44 also includes a work processing application 50 to enable creation of new documents or editing of existing forms that need to be sent to some person involved with the present system. Also included is a report generator 52 for providing statistics on records in various tables,

chronological or summary reports on transactions for all or some clients, etc.

Col. 8, ll. 13-19. We do not see and the Examiner does not explain how these passages provide for or would lead one of ordinary skill to an element that functions (in the words of claim 47) to “send a request for statistical information related to medical information ... wherein said request includes input parameters related to said statistical information.”

Because this has not been done, a prima facie case of obviousness for the subject matter of these claims over the cited prior art combination has not been made out in the first instance. As a result, the rejection of claims 43-48 is not sustained.

#### CONCLUSIONS

Claims 7-9 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claims 7-9 under 35 U.S.C. §103(a) as being unpatentable over Johnson, Dowling, and Kolb is reversed pro forma.

The rejection of claims 1-4, 15, 19, and 24-27 under 35 U.S.C. §103(a) as being unpatentable over Johnson, Dowling, and Kolb is reversed.

The rejection of claims 32-34, 36-38, 41 under 35 U.S.C. §103(a) as being unpatentable over Johnson, Dowling, and Kolb is affirmed.

The rejection of claims 11-14, 16, 18, 20-23, 29-31, and 43-48 under 35 U.S.C. §103(a) as being unpatentable over Johnson, Dowling, Kolb, and Barmakian is reversed.

The rejection of claims 40 and 42 under 35 U.S.C. §103(a) as being unpatentable over Johnson, Dowling, Kolb, and Barmakian is affirmed.

The rejection of claims 43-48 35 U.S.C. § 103(a) as being unpatentable over Johnson, Dowling, Kolb, and Barmakian is reversed.

### DECISION

The decision of the Examiner to reject claims 1-4, 7-9, 11-16, 18-27, 29-34, 36-38 and 40-48 is affirmed-in-part; that is, the rejection of claims 1-4, 7-9, 11-16, 18-27, 29-31, and 43-48 is reversed and the rejection of claims 32-34, 36-38, 40-42 is affirmed. Claims 7-9 are newly rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

37 C.F.R. § 41.52(a)(1) provides that “Appellant may file a single request for rehearing within two months from the date of the original decision of the Board.” 37 C.F.R. § 41.50(b) provides that “[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 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. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Patent Trial and Appeal Board for final action on the affirmed rejection, including any timely request for rehearing thereof.

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)