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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* JEFFREY SAUL HARRIS

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Appeal 2012-006956  
Application 10/216,268<sup>1</sup>  
Technology Center 2100

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Before CAROLYN D. THOMAS, STANLEY M. WEINBERG, and  
JOHN A. EVANS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The real party in interest is Mr. Jeffrey Saul Harris.

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 11-15, 17-23, and 25-30, which are all the claims remaining in the application. Claims 1-10, 16, and 24 are cancelled. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

The present invention relates generally to the use of integrated structured methods, information systems, decision rules, and practice guidelines to improve outcomes related to the evaluation and management of health problems. *See* Spec. ¶ [0001].

Claims 20 and 29 are illustrative:

20. A method for managing health problems of medical patients through a computer executed program comprising:
  - receiving data about a medical patient needing healthcare;
  - storing the data in a medical record in a database;
  - matching the data against medical rules for indications of a medical condition;
  - matching patient's current functional abilities to guideline-based criteria;
  - establishing modified recovery work for reconditioning of the patient; and
  - generating a message to a care provider to establish a procedure related to the medical condition when the indications of the medical condition are present wherein the method is executed within a computer system.

29. A method for analyzing records in a data base comprising;

collecting predetermined data and searching a data base and creating or appending a record within the data base;

retrieving rules from a rules base, said retrieved rules selected to correspond to the data base record;

applying the selected rules or retrieved rules to the data base record;

reviewing results generated from applying the rules to the data;

generating at least one message establishing a procedure related to treatment of a medical patient in accordance with the rules;

storing results of rules application for comparative analysis;

wherein applying the selected rules further comprises matching a medical patient's physician imposed activity restrictions to guideline-based criteria and wherein the message further comprises suggesting a rethinking of the patient treatment if the medical patient's physician imposed activity restrictions do not match the criteria; and

wherein the method is executed within a computer system.

Appellant appeals the following rejections:

R1. Claims 11-15, 17-23, and 25-30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite; and

R2. Claims 11-15, 17-23, and 25-30 are rejected under 35 U.S.C. § 102(e) as being anticipated by Schaeffer (US 7,418,399 B2, Aug. 26, 2008).

### Claim Groupings

Based on Appellant's arguments in the Appeal Brief, we will decide the appeal on the basis of claims as set forth below. *See* 37 C.F.R. § 41.37(c)(1)(vii).

## ANALYSIS

### REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

#### *Claims 11-15, 17-23, and 25-30*

**Issue 1:** Did the Examiner err in finding that the claims are indefinite?

The Examiner found that “the metes and bounds of the claimed guideline-based criteria are still indistinct” (Ans. 5).

Appellant contends that “it is clear that the guidelines base criteria constitutes guidelines regarding recovery work for particular medical problems, as set forth in paragraph 0021 and Figure 2b” (App. Br. 10). Appellant further contends that “[t]he fact that guideline based criteria will necessarily be different for different medical diagnoses does not render the term indefinite” (*id.* at 9). We agree with Appellant.

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). While neither Appellant’s Appeal Brief nor Reply Brief have identified any specific definition for the term “guideline-based criteria,” Appellant’s Specification states that guideline-based criteria “is aimed at assisting or supporting functional recovery by providing modified work that does not aggravate the situation but does provide psychosocial support by returning the person to work or school” (Spec. ¶ [0021]). Thus given Appellant’s mere examples of guideline-based criteria, we find that the

specific term “guideline” carries an ordinary and customary definition and broadly includes any outline of a policy or conduct. WEBSTER’S NINTH NEW COLLEGIATE DICTIONARY 541 (9th ed. 1990). Furthermore, we note that it is not necessary that specifics of any such policies be spelled out. As such, we find that those skilled in the art would understand what is claimed when the claims are read in light of the Specification.

For these reasons, we reverse the Examiner’s § 112, second paragraph, rejection of claims 11-15, 17-23, and 25-30.

REJECTION UNDER 35 U.S.C. § 102(E)

*Claims 20-23 and 25-28*

**Issue 2:** Did the Examiner err in finding that Schaeffer discloses matching a patient’s current functional abilities to guideline-based criteria, as claimed in claim 20?

Appellant contends that “one skilled in the art would understand that ‘a patient’s current functional abilities’ is not the same thing as the patient’s medical condition or diagnosis, but is instead, the functional (physical) abilities/limitations of a patient with a particular medical condition/diagnosis” (App. Br. 15). Appellant further contends that “[n]owhere does Schaeffer discuss a ‘patient’s current functional abilities’” (*id.*).

The Examiner found that Schaeffer discloses “matching of a patient’s current functional abilities (e.g. per identifying a personal/demographic information in a medical data analyzing process at col. 10, lines 18-30) to guideline-based criteria” (Ans. 21).

Here, we find that the recitation in claim 20: “*matching patient’s current functional abilities to guideline-based criteria*” (emphasis added) merely amounts to non-functional descriptive material as we are merely matching a first type of data to a second type of data. In this case, the type of data (e.g., abilities and guideline-based criteria) that is being examined is irrelevant, as such data does not exhibit a functional interrelationship with the substrate. While the Examiner must consider all claim limitations, including descriptive material, when determining patentability of an invention over the prior art, *see In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983), the Examiner need not give patentable weight to descriptive material that does not have a new and obvious functional relationship with the substrate (nonfunctional descriptive material), *see id.* at 1386; *see also In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004).

Here, the non-functional descriptive material refers to data content that does not exhibit a functional interrelationship with the substrate and does not affect the way the computing processes are performed. Stated differently, elements that do not affect the claimed process are non-functional material, are merely descriptive, and are given no patentable weight. *See Ex parte Nehls*, 88 USPQ2d 1883, 1887-88 (BPAI 2008) (precedential).

Here, the Examiner properly found that Schaeffer matches a first data to a second data as Schaeffer at least discloses “that each bacterium is cross-matched with the antimicrobial used to treat it” (col. 10, ll. 13-14) and “matching characteristics between the undiagnosed patient and the previous persons” (col. 10, ll. 20-21). Therefore, we find that no patentable weight

needs to be given to the claimed “functional abilities,” as it is enough that Schaeffer discloses matching a first and second data item.

The Examiner further found that Schaeffer discloses means for “more accurately prescribing an effective course of treatment” (col. 5, ll. 34-35) and that “[t]hese knowledge discovery operations derive suggestions, e.g., treatment patterns or guidance procedures, that can be presented to the physician” (col. 5, ll. 42-44). We find that the claimed *establishing modified recovery work* reads on the above noted treatment features of Schaeffer.

Based on the record before us, we find no error in the Examiner’s anticipation rejection of representative claim 20 essentially for the reasons indicated by the Examiner. Claims 21-23 and 25-28, which were not separately argued, fall for similar reasons.

*Claims 11-15, 17-19, 29, and 30*

**Issue 3:** Did the Examiner err in finding that Schaeffer discloses rethinking of the patient treatment if the medical patient’s physician imposed activity restrictions do not match the criteria, as claimed in claim 29?

Appellant contends that “[t]here is no discussion in Schaeffer of a physician imposing activity restrictions for a patient, let alone matching those restrictions with guideline based criteria” (App. Br. 18). We agree with Appellant.

Here, the Examiner directs our attention to Schaeffer’s column 4 and column 15 to disclose the above-noted features (*see* Ans. 22). However, we find that while Schaeffer discloses that “information may be gathered about the individual, the disease and the treatment at each stage of the medical

process from before clinical diagnosis, through diagnosis and treatment, to after-treatment follow ups” (col. 4, ll. 18-22) and that “a computer is programmed to analyze the data and to recommend a course of action to the medical practitioner and/or patient. . . . A medical practitioner receives a report . . . ” (col. 15, ll. 16-26), the Examiner has not established, nor can we readily find, where Schaeffer discloses “activity restrictions” or a message being based on whether such restrictions do not match the criteria, as claimed. We are therefore constrained by the record before us to find that the Examiner erred in rejecting claim 29 and claims 11-15, 17-19, and 30 for similar reasons.

Since we agree with at least one of the arguments advanced by Appellant regarding these claims, we need not reach the merits of Appellant’s other arguments. It follows that Appellant has shown that the Examiner erred in finding that Schaeffer renders claims 11-15, 17-19, 29, and 30 unpatentable.

#### DECISION

We reverse the Examiner’s § 112, second paragraph, rejection and the § 102(e) rejection of claims 11-15, 17-19, 29, and 30.

We affirm the Examiner’s § 102(e) rejection of claims 20-23 and 25-28.

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-IN-PART**

Appeal 2012-006956  
Application 10/216,268

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