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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM SEAN HARRISON and PAUL J. SMITH

Appeal 2014-008855¹
Application 12/574,338²
Technology Center 3600

Before ANTON W. FETTING, NINA L. MEDLOCK, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 7–15, 18–23, 26, and 29–32. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Our decision references Appellants' Appeal Brief ("App. Br.," filed February 17, 2014) and Reply Brief ("Reply Br.," filed August 6, 2014), and the Examiner's Answer ("Ans.," mailed June 6, 2014) and Non-Final Office Action ("Non-Final Act.," mailed September 16, 2013).

² Appellants identify Provisio, Inc. (d/b/a iTrials) as the real party in interest. App. Br. 2.

CLAIMED INVENTION

Appellants' claimed invention "pertains generally to computer systems and accompanying software for adapting the function of such computer systems, and more particularly . . . to substantially automated systems and methods for developing studies such as clinical trials that involve recruiting suitable patients" (Spec. 1, ll. 22–28).

Claims 7, 20, and 29 are the independent claims on appeal. Claim 7, reproduced below, is illustrative:

7. A method for selecting an eligible investigator for a clinical trial, the method comprising:

accessing, with a computer including one or more processors, a physician database, the physician database including a physician record for each of a plurality of physicians, each physician record including a plurality of physician characteristics;

identifying, using the one or more processors, a ranked list of eligible investigators, the identifying including:

using a user-specified criterion of the clinical trial associated with at least one of the plurality of physician characteristics to select a first plurality of physicians as a group of potential investigators;

determining, for each physician in the group of potential investigators, a number of eligible patients for the clinical trial; and

selecting physicians from the group of potential investigators, for inclusion in a second plurality of physicians, w[h]ere the selected physician's number of eligible patients exceeds a user-defined threshold; and

scoring, using the one or more processors, eligible investigators from the second plurality of physicians against a plurality of user-defined criteria to generate a ranked list of eligible investigators; and

presenting information regarding the ranked list of eligible investigators to a user.

REJECTIONS

Claims 7–12 and 15–19 are rejected under 35 U.S.C. § 102(b) as anticipated by Rawlings (US 2007/0174252 A1, pub. July 26, 2007).

Claims 13, 14, 20–23, 26, and 29–32 are rejected under 35 U.S.C. § 103(a) as unpatentable over Rawlings and Reiner (US 2008/0312963 A1, pub. Dec. 18, 2008).³

ANALYSIS

Anticipation

Independent Claim 7 and Dependent Claims 8–12 and 15–19

We are persuaded by Appellants’ argument that the Examiner erred in rejecting independent claim 7 under 35 U.S.C. § 102(b), *inter alia*, because Rawlings does not disclose “determining, for each physician in the group of potential investigators, a number of eligible patients for the clinical trial,” as recited in claim 7 (App. Br. 13–14). The Examiner cites paragraphs 21 and 116, of Rawlings as disclosing the argued feature (Non-Final Act. 3). However, we agree with Appellants that there is nothing in either of these paragraphs that discloses “determining, for each physician in the group of potential investigators, a number of eligible patients for the clinical trial,” as called for in claim 7.

Rawlings discloses a computerized method for identifying potential subjects for a clinical trial, and describes that one or more exclusion or

³ We note that the Examiner omits any reference to claim 20 in the Non-Final Office Action, beyond identifying claim 20 as a pending claim (*see* Non-Final Act. 2). However, Appellants indicate that claim 20 is rejected under 35 U.S.C. § 103(a) as unpatentable over Rawlings and Reiner (App. Br. 12).

inclusion criteria are defined for the clinical trial (Rawlings ¶ 19). Specialized searching tables are pre-generated using healthcare claims data and the exclusion or inclusion criteria, and these tables are searched to identify subjects who match the exclusion or inclusion criteria (*id.*). Rawlings discloses that the method may include identifying potential clinical investigators for the clinical trial by searching the searching tables and generating a customized report (*id.*), and further discloses, in paragraph 21, on which the Examiner relies, that in one embodiment a hypergeometric statistic may be calculated and used to identify potential subjects for a clinical trial. Rawlings discloses an example in cited paragraph 116 in which an exclusion or inclusion criteria seeks physicians who have treated 200 patients having a particular diagnosis. Yet it is clear from a fair reading of Rawlings that the exclusion or inclusion criteria is intended to target physicians, i.e., to identify physicians to be included or excluded from the clinical trial based on the number of patients that the physician has treated with a particular disease. We find nothing in paragraph 116 or, for that matter, in paragraph 21 that discloses determining the number of the physician's patients eligible for a clinical trial.

In view of the foregoing, we do not sustain the rejection of claim 7 under 35 U.S.C. § 102(b). For the same reasons, we also do not sustain the rejection of claims 8–12 and 15–19, which depend therefrom.

Obviousness

Dependent Claims 13 and 14

Claims 13 and 14 depend from independent claim 7. The rejection of these dependent claims based on Reiner, in combination with Rawlings, does not cure the deficiency in the Examiner's rejection of claim 7.

Therefore, we do not sustain the Examiner's rejection of claims 13 and 14 under 35 U.S.C. § 103(a) for substantially the same reasons set forth above with respect to claim 7.

Independent Claims 20 and 29 Dependent Claims 21–23, 26, and 30–32

Independent claims 20 and 29 include language substantially similar to the language of claim 7. The Examiner does not rely on Reiner as disclosing “determining, for each physician . . . a number of eligible patients for the clinical trial.” Therefore, we do not sustain the Examiner's rejection under 35 U.S.C. § 103(a) of independent claims 20 and 29, and claims 21–23, 26, and 30–32, which depend therefrom, for substantially the same reasons set forth above with respect to claim 7.

DECISION

The Examiner's rejection of claims 7–12 and 15–19 under 35 U.S.C. § 102(b) is reversed.

The Examiner's rejection of claims 13, 14, 20–23, 26, and 29–32 under 35 U.S.C. § 103(a) is reversed.

REVERSED