



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
10/824,705 04/15/2004 Roy Schoenberg TZG0008 6791

93261 7590 10/25/2017
Bey & Cotropia PLLC (Trizetto Customer Number)
ATTN: Dawn-Marie Bey
213 Bayly Court
Richmond, VA 23229

EXAMINER

RAPILLO, KRISTINE K

ART UNIT PAPER NUMBER

3626

NOTIFICATION DATE DELIVERY MODE

10/25/2017

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dawnmarie@beycotropia.com
bey\_cotropia\_docketing@cardinal-ip.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* ROY SCHOENBERG

---

Appeal 2015-001467<sup>1</sup>  
Application 10/824,705<sup>2</sup>  
Technology Center 3600

---

Before BIBHU R. MOHANTY, MICHAEL W. KIM, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1, 2, 4–13, 42–44, 47–52, 54, and 55. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

---

<sup>1</sup> Our decision references Appellant’s Appeal Brief (“Appeal Br.,” filed May 21, 2014) and Reply Brief (“Reply Br.,” filed November 18, 2014), the Examiner’s Answer (“Ans.,” mailed September 18, 2014), and Final Office Action (“Final Act.,” mailed January 3, 2014).

<sup>2</sup> Appellant identifies TriZetto Corporation as the real party in interest (Appeal Br. 2).

## CLAIMED INVENTION

Appellant's claims "relate[ ] to automated data entry and, more particularly, to automated data entry within a medical records management system" (Spec. ¶ 2).

Claims 1, 42, and 49 are the independent claims on appeal. Claim 1, reproduced below, with minor formatting changes and added bracketed notations, is illustrative of the subject matter on appeal:

1. A data entry and access method executed using a record organization system including a key processing module, a key maintenance module and a record processing module comprising:

[a] in a computer-based medical record including a plurality of data fields, defining using the record processing module one or more data fields for which desired field data is to be acquired,

[b] receiving by the record organization system from a patient associated with the computer-based medical record a defined first access level for a first medical provider through patient selection, using a key maintenance module, of one or more data fields and associating each of the selected one or more data fields with the first access level for the first medical provider;

[c] generating, by the key maintenance module, a first individual access key for the first access level;

[d] receiving the first individual access key at the key processing module, associating the first individual access key with the first medical service provider and storing the first individual access key therein,

[e] automatically populating by the record processing module at least one of the one or more data fields with desired field data from a data source, said automatically populating comprising:

[f] receiving, by the record processing module that is stored to a computer-readable medium and executing on a processor-based computer, a schedule for contacting said

data source to prompt said data source for the desired field data for said at least one data field;

[g] triggering, by said record processing module, contacting said data source in possession of the desired field data in accordance with said schedule; and

[h] receiving, by said record processing module, the desired field data from the data source; and

[i] receiving by the record organization system from the first medical provider, the first access key and granting access to the first medical provider to the selected one or more data fields associated with the first access level.

### REJECTIONS

Claims 1, 2, 4–13, 42–44, 47–52, 54, and 55<sup>3</sup> are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.<sup>4</sup>

Claims 1, 2, and 4–13 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ross (US 7,076,436 B1, iss. July 11, 2006), Wheeler (US 2003/0097573 A1, pub. May 22, 2003), and Puchek (US 2003/0091158 A1, pub. May 15, 2003).

Claims 42–44, 47–52, 54, and 55 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hacker (US 6,988,075 B1, iss. Jan. 17, 2006) and Wheeler.

---

<sup>3</sup> The Examiner erroneously indicates that claims 1–13, 42–44, and 47–55 are presently rejected (*see* Ans. 2), however, as Appellant points out, claims 3 and 53 are cancelled (*see* Reply Br. 2). We treat this typographical error as harmless error.

<sup>4</sup> The Examiner entered the present ground in the Answer as a new ground of rejection (*see* Ans. 2).

## ANALYSIS

### *Non-statutory subject matter*

According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014).

The “directed to” inquiry [] cannot simply ask whether the claims *involve* a patent-ineligible concept, because essentially every routinely patent-eligible claim involving physical products and actions *involves* a law of nature and/or natural phenomenon—after all, they take place in the physical world. *See Mayo*, 132 S. Ct. at 1293 (“For all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.”) Rather, the “directed to” inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether “their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015); *see Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1375 [] (Fed. Cir. 2016) (inquiring into “the focus of the claimed advance over the prior art”).

*Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016).

“The ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *see also Enfish*, 822 F.3d at 1335).

In rejecting claims 1, 2, 4–13, 42–44, 47–52, 54, and 55 under 35 U.S.C. § 101, the Examiner finds that the claims, considered as a whole, are “directed to the abstract idea of organizing human activities by allowing a patient to determine different levels of access to medical providers of their

patient medical record” without additional elements that transform it into a patent-eligible application of that idea (*see* Ans. 2).

In response, Appellant argues that the Examiner’s rejection is improper because the Examiner “provides absolutely no support or citation for this determination” (Reply Br. 9 (emphasis omitted)), and further argues that “[t]he claims clearly go well beyond the Examiner’s over-simplification of ‘allowing a patient to determine different levels of access to medical providers of their patient medical record’” (*id.*). However, we agree with the Examiner that the claims are directed broadly to the abstract idea of “allowing a patient to determine different levels of access to medical providers of their patient medical record[s]” (*see* Ans. 2). And, to the extent Appellant argues that the Examiner erred in adequately supporting this determination by providing support or citation (*see* Reply Br. 7–9), Appellant’s argument is unpersuasive.

There is no requirement that the Examiner must provide evidentiary support in every case before a conclusion can be made that a claim is directed to an abstract idea. *See, e.g.*, para. IV “July 2015 Update: Subject Matter Eligibility” to 2014 Interim Guidance on Subject Matter Eligibility (2014 IEG), 79 Fed. Reg. 74618 (Dec. 16, 2014) (“The courts consider the determination of whether a claim is eligible (which involves identifying whether an exception such as an abstract idea is being claimed) to be a *question of law*. Accordingly, courts do not rely on evidence that a claimed concept is a judicial exception, and in most cases resolve the ultimate legal conclusion on eligibility without making any factual findings.”) (Emphasis added). We agree that evidence may be helpful in certain situations where, for instance, facts are in dispute. But it is not always necessary. Based on

the above analysis set forth by the Examiner, we are unpersuaded it is necessary in this case.

Instead, we need only look to other decisions where similar concepts were previously found abstract by the courts. *See Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (“Instead of a definition [for what an ‘abstract idea’ encompasses], then, the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.”)

To that end, as noted above, the Examiner finds the claims are directed to “allowing a patient to determine different levels of access to medical providers of their patient medical record[s]” (*see* Ans. 2). Broadly, we agree that the Examiner is correct in articulating that the claims are directed to an abstract idea.

According to Appellant’s Specification, the present “invention relates to automated data entry and, more particularly, to automated data entry within a medical records management system” (Spec. ¶ 2). And, taking independent claim 1 as representative, the claimed subject matter is generally directed to “[a] data entry and access method executed using a record organization system,” and includes steps for “defining . . . data fields . . . to be acquired,” “receiving . . . from a patient . . . a defined first access level for a first medical provider . . . and associating . . . data fields with the first access level for the first medical provider,” “generating . . . a first individual access key for the first access level,” “receiving the first individual access key . . . , associating the first individual access key with the first medical service provider[,] and storing the first individual access

key,” “automatically populating . . . data fields . . . from a data source,” by “receiving . . . a schedule for contacting said data source to prompt said data source for the . . . at least one data field,” “triggering . . . contacting said data source in possession of the desired field data in accordance with said schedule,” and “receiving . . . the desired field data from the data source,” and then “receiving . . . from the first medical provider, the first access key and granting access to the first medical provider to the selected . . . data fields associated with the first access level.”

In this regard, we find that the claims are more precisely directed to automated data entry system which allows a patient to determine different levels of access to medical providers of their patient medical records, although we do not discern that any gap between this finding and that of the Examiner is of any substantive significance. This concept amounts to a method of organizing human activity, which, like the concept of risk hedging in *Bilski*, falls squarely within the realm of abstract ideas. *See Alice*, 134 S. Ct. at 2356; *Bilski v. Kappos*, 561 U.S. 593, 611 (2010); *see also Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1339 (Fed. Cir. 2013) (claim to maintaining an “insurance transaction database containing information related to an insurance transaction decomposed into a plurality of levels” and “allowing an authorized user to edit . . . and to update the information related to the insurance transaction” held to be an abstract idea).

Step two is “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.’” *Alice*, 134 S. Ct. at 2355 (alteration in original) (citing

*Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012)).

Here, Appellant argues

[t]he claims clearly go well beyond the Examiner’s oversimplification of “allowing a patient to determine different levels of access to medical providers of their patient medical record.” Certain claims are directed to a system having discrete components - clearly not abstract. And the method involve a complex series of components and steps.

(Reply Br. 9). However, Appellant’s argument does not establish that the argued limitations add inventiveness, as opposed to the application of conventional, well-known analytical steps. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014) (“[T]he claimed sequence of steps comprises only ‘conventional steps, specified at a high level of generality,’ which is insufficient to supply an ‘inventive concept.’”) (Citing *Alice*, 134 S. Ct. at 2357) (internal citations omitted). Nor does Appellant provide evidence that the programming related to their modules entails anything atypical from conventional programming. In this regard, we note that Appellant’s Specification describes that “key maintenance module” allows a patient to generate access keys “that not only regulate who has access to their medical records, but also regulate the level of access (i.e., which portions of a patient’s medical record are viewable by the medical service provider to which the key is provided)” (Spec. ¶¶ 17–18). The Specification further describes that “key processing module” receives access keys generated and transmitted by patients and stores the keys in a centralized key repository (Spec. ¶ 20). The Specification also describes that “record processing module” allows medical service providers to access medical records which are stored on a medical records repository (Spec. ¶¶ 24, 26).

We also note there is no indication in the record that any specialized computer hardware or other “inventive” computer components are required. In this regard, we note that the Specification discloses that its “system 10 typically resides on and is executed by a computer 26 that is connected to network 28” (*see* Spec. ¶ 10), and “[c]omputer 26 may be a web server running a network operating system, such as Microsoft Window 2000 Server™, Novell Netware™, or Redhat Linux™” (*id.*). Thus, independent claim 1 merely employs generic computer components to perform generic data entry and data access functions which is not enough to transform an abstract idea into a patent-eligible invention. Also, considered as an ordered combination, we are unclear as to how these computer components/modules add anything that is not already present when the steps of the method are considered separately.

In view of the foregoing, we sustain the Examiner’s rejection under 35 U.S.C. § 101 of independent claim 1, and claims 2, 4–13, 42–44, 47–52, 54, and 55, which fall with independent claim 1.

#### *Obviousness*

##### *Independent claim 1 and dependent claims 2 and 4–13*

We are persuaded by Appellant’s argument that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 103(a) because the combination of Ross, Wheeler, and Puchek fails to disclose or suggest limitation [b] of independent claim 1 which recites

receiving by the record organization system from a patient associated with the computer-based medical record a defined first access level for a first medical provider through patient selection, using a key maintenance module, of one or more data

fields and associating each of the selected one or more data fields with the first access level for the first medical provider.

(Appeal Br. 5–7; *see also* Reply Br. 2–4).

The Examiner maintains that the rejection is proper, and cites Ross as disclosing the argued limitation (*see* Final Act. 3 (citing Ross, col. 3, ll. 35–45; col. 6, ll. 50–64; col. 12, ll. 59–62; claims 21 and 32; Fig. 2); *see also* Ans. 3–4 (citing Ross, col. 1, ll. 17–37; col. 3, ll. 35–45; col. 6, ll. 50–64; col. 12, ll. 46–58; claim 11; Wheeler ¶ 154)). However, we agree with Appellant that there is nothing in the cited portions that discloses or suggests the argued limitation.

Ross is directed to a system for “generat[ing] a comprehensive document; a full and complete medical record” (Ross, col. 1, ll. 45–46). Ross discloses that its “system has security measures which limits access to the system. Patients, family members, or others are prevented from looking into medical records or entering information” (*id.* at col. 3, ll. 35–38). Ross further discloses that “[p]ersonnel using the system must clearly demonstrate their identity using a variety of methods depending on the system configuration” (*id.* at col. 6, ll. 50–54). More particularly, Ross discloses

[t]he user’s identity establishes the individual “rights” to use various functions. For example, physicians may be the only users given rights to generate prescriptions, nurses could have rights to implement various medical procedures, ward clerks might need rights to order labs, but records clerks may be limited to changing demographic information.

(*Id.* at col. 6, ll. 54–60).

Wheeler is directed to “an improved communication system in which electronic communications regarding accounts are digitally signed” (Wheeler ¶ 2). Wheeler discloses that “[s]ession authentication and

transaction authentication are generally necessary before the account authority will grant the account holder with access to the account of the account holder or to another resource to which the account holder has rights” (*id.* ¶ 154).

After reviewing the cited portions of Ross, in view of Wheeler, we agree with Appellant that there is nothing in the relied upon portions of Ross or Wheeler that discloses or suggests the argued limitation (*see* Appeal Br. 5–10; *see also* Reply Br. 2–4). Although we agree with the Examiner that Ross discloses security measures which limit different users’ access rights (Ans. 3 (citing Ross, col. 3, ll. 35–45; col. 12, ll. 46–58)), the cited portions of Ross do not disclose who limits the access. Accordingly, we cannot agree with the Examiner that Ross discloses or suggests limiting access to one or more data fields selected by the patient, as limitation [b] requires. Thus, we agree with Appellant that Ross fails to disclose or suggest “the particularly claimed steps wherein a patient defines access levels to the patient’s medical record by selecting one or more data fields from the patient’s medical records that the patient wishes for individual medical provider(s) to be able to access,” as called for by limitation [b] of independent claim 1 (*see* Appeal Br. 7; Reply Br. 3). The Examiner does not rely on either of Wheeler or Puchek to cure this deficiency.

In view of the foregoing, we do not sustain the Examiner’s rejection of independent claim 1 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the Examiner’s rejection of claims 2 and 4–13, which depend therefrom.

*Independent claims 42 and 49, and dependent claims 43, 44, 47, 48, 50–52, 54, and 55*

We are not persuaded by Appellant’s argument that the Examiner erred in rejecting independent claims 42 and 49 under 35 U.S.C. § 103(a) because the combination of Hacker and Wheeler fails to disclose or suggest the subject matter of independent claims 42 and 49 (*see* Appeal Br. 10–15; *see also* Reply Br. 5–7). Instead, we agree with, and adopt the Examiner’s findings and rationale, as set forth at pages 9–11 of the Final Action, and the Examiner’s response to Appellant’s arguments, as set forth at pages 4–5 of the Answer. We add the following discussion for emphasis.

Hacker is directed “to a system and service for centrally storing patients medical records electronically on a database for patient-controlled remote access by both patients and medical providers” (Hacker, col. 1, ll. 5–8). Hacker’s system allows “[p]atients [to] control access to their record by providing a unique access identification means to a system server connected to the database” (*id.* at col. 7, ll. 25–27). Hacker discloses

[w]hen patients have allowed access, medical providers **140** can view appropriate portions of the patient[']s medical record, and add information to the patient’s medical record where appropriate. By limiting access to needed information, the patient's privacy can be increased. For example, pharmacists **140** would have access to prescription information but typically would not be given access to information concerning allergies, heart or liver conditions, age, weight, etc. since the checking/screening of this interaction information can be provided by software on the server **120**. When a medical provider **140** feels they need access to blocked portions, the medical provider **140** can ask the patient for a patient-selected passphrase, and the patient can decide whether or not to grant access.

(*Id.* at col. 8, ll. 4–17). Hacker also discloses

[p]atients can also get second opinions without the embarrassment of asking the first physician to forward their medical record to the second physician. In this scenario, the patient supplied identifier the[y] can be used by the second physician to allow access the patient’s medical record on the database without the involvement of the first physician.

(*Id.* at col. 11, ll. 14–18).

We also are not persuaded by Appellant’s argument that the Examiner erred because “Hacker provides no details or description regarding the underlying components which might enable the patient to supply the passphrase” (Appeal Br. 13; *see also* Reply Br. 5–7). More particularly, Appellant argues that the combination of Hacker and Wheeler cannot render obvious the subject matter of independent claims 42 and 49, because “Hacker is non-enabling both for its own disclosed concepts and most certainly for the components implementing the functions recited in the claims” (Appeal Br. 14). We cannot agree.

At the outset, we note that Hacker does not appear to be non-enabling on its face, and Appellant has failed to show with any argued specificity that it is. Furthermore, it is well settled that published subject matter is prior art for all that it teaches in *obviousness* determinations—even if the reference itself is not enabling. *See In re Antor Media Corp.*, 689 F.3d 1282, 1292 (Fed. Cir. 2012) (citing *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578 (Fed. Cir. 1991)). Although non-enabled references cannot *anticipate* a claimed invention, they nevertheless may be considered in *obviousness* determinations, as is the case here. *See Symbol Techs.*, 935 F.2d at 1578 (“While a reference must enable someone to practice the invention in order to anticipate under § 102(b), a non-enabling reference may qualify as prior art for the purpose of determining obviousness under § 103.”). Thus, we see

no error in the Examiner's reliance on Hacker as disclosing the argued subject matter of independent claims 42 and 49 under a broadest reasonable interpretation (*cf.* Spec. ¶¶ 17–18, 20, 24, 26).

In view of the foregoing, we sustain the Examiner's rejection of independent claims 42 and 49 under 35 U.S.C. § 103(a). For the same reasons, we also sustain the Examiner's rejection of claims 43, 44, 47, 48, 50–52, 54, and 55, which depend therefrom.

#### DECISION

The Examiner's rejection of claims 1, 2, 4–13, 42–44, 47–52, 54, and 55 under 35 U.S.C. § 101 is sustained.

The Examiner's rejection of claims 1, 2, and 4–13 under 35 U.S.C. § 103(a) is not sustained.

The Examiner's rejection of claims 42–44, 47–52, 54, and 55 under 35 U.S.C. § 103(a) is sustained.

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

AFFIRMED