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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANGADBIR SINGH SALWAN

Appeal 2015-007758
Application 12/587,101
Technology Center 3600

Before BIBHU R. MOHANTY, JAMES A. WORTH, and
TARA L. HUTCHINGS *Administrative Patent Judges.*

MOHANTY, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the Final rejection of claims 1, 7, 8, 10, 13, 18, 25, 28, 29, 32–34, 41, and 43–71 which are all the claims pending in the application.¹ We have jurisdiction under 35 U.S.C. § 6(b).

¹ The Final Rejection was mailed on Jan. 7, 2015 (hereinafter “Final”). The Appeal Brief was filed on Apr. 3, 2015 (hereinafter “App. Br.”). The Examiner’s Answer was mailed on June 24, 2015 (hereinafter “Ans.”). The Reply Brief was filed on Aug. 22, 2015 (hereinafter “Reply Br.”).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention is directed to the electronic communication and transfer of patient health information including clinical data (Spec. 12). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method for transferring patient health information among healthcare user groups or patients via a network, the method comprising:

providing at least one central data storage configured to receive and store patient health data from one or more private data storages of healthcare user groups, at least one central computer program embodied in at least one computer readable medium or embodied in at least one central server for processing and transferring patient health information stored in the one or more central data storages, and at least one device for providing user authorization to access patient data stored in the one or more central data storages, and configuring the central computer program or the central server for:

communicating through at least one computer program, which includes EMR and billing software, embodied in a computer readable medium with at least one private data storage storing electronic medical record (EMR) information originated, entered and controlled by at least one or more first healthcare service providers affiliated with the one or more healthcare user groups, including at least accounts information confidential for the first healthcare user groups, the confidential information includes at least accounts information of one or more insurance companies, which is at least used by the billing software to

calculate patient portion of the bill, and clinical data generated by one or more service providers;

receiving from the at least one private data storage the EMR information for storing, processing and transmission to at least one of the patients, or one or more second healthcare user groups, wherein the information confidential for the first healthcare user groups including at least the accounts information of one or more insurance companies is not received and stored at the central data storage;

storing the received EMR information generated by the one or more service providers including at least one of health problems, medications, diagnosis, prescriptions, notes written by the service Providers, diagnostic test results or patient accounts data in the at least one central data storage;

selectively retrieving the stored EMR information, generating one or more healthcare reports including one or more of health problem list, medication list, diagnoses report, prescription, diagnostic test result report, patient billing report; and

transmitting one or more healthcare reports to at least the second authorized healthcare user groups or the patient for reviewing.

(Claim 1 above was reproduced from the Appeal Brief filed Apr. 3, 2015 with the bolding and underlining removed, and stricken-through-text removed to conform with Appeal Practice).

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

| | | |
|-------------|--------------------|---------------|
| Giannini | US 5,915,241 | June 22, 1999 |
| Schurenberg | US 2002/0007284 A1 | Jan. 17, 2002 |
| Henley | US 2002/0065758 A1 | May 30, 2002 |
| Davis | US 2003/0028399 A1 | Feb. 6, 2003 |
| Jay | US 2003/0050802 A1 | Mar. 13, 2003 |

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|----------|--------------------|---------------|
| McNerney | US 2003/0088441 A1 | May 8, 2003 |
| Shelton | US 2005/0165624 A1 | July 28, 2005 |
| Malhotra | US 2005/0251417 A1 | Nov. 10, 2005 |
| Hacker | US 6,988,075 B1 | Jan. 17, 2006 |
| Dugan | US 2006/0041450 A1 | Feb. 23, 2006 |

The following rejections are before us for review:

1. Claims 1, 7, 8, 10, 13, 18, 25, 28, 29, 32–34, 41, and 43–71 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement for failure to show possession of the invention.

2. Claims 51, 52, 69, and 70 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

3. Claims 1, 7, 8, 10, 13, 18, 25, 28, 29, 32–34, 41, and 43–71 are rejected under 35 U.S.C. § 101 as beings directed to non-statutory subject matter.

4. Claims 1, 8, 10, 13, 28, 29, 34, 41, 50, 53, and 71 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hacker and Malhotra.

5. Claims 7, 28, 29, 34, 47–49, and 61 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hacker, Malhotra, and Davis.

6. Claims 18 and 58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hacker, Malhotra, and Giannini.

7. Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hacker, Malhotra, and McNerney.

8. Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hacker, Malhotra, and Shelton.

9. Claims 33 and 62 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hacker, Malhotra, and Schurenberg.

10. Claims 43, 44, 59, 63, and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hacker, Malhotra, and Jay.

11. Claims 45, 46, 51, 52, 54, 55, and 60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hacker, Malhotra and official notice.

12. Claims 56 and 57 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hacker, Malhotra, official notice, and Dugan.

13. Claims 65 and 67 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hacker, Malhotra, Giannini, and Jay.

14. Claims 69 and 70 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hacker, Malhotra, and Henley.

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.²

ANALYSIS

Rejection under 35 U.S.C. § 112, first paragraph

The Examiner has first rejected claim 1 under 35 U.S.C. § 112, first paragraph for failure to show possession of the claim limitation that “wherein the information confidential for the first healthcare user groups including at least the accounts information of one or more insurance companies is not received and stored at the central data storage” (Ans. 3).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

In contrast, the Appellant has argued that the cited claim limitation is shown in Figures 1, 2, 3, and 4; and paragraphs 41, 42, 43, 164, and 171 (Reply Brief 14–17).³

We agree with the Examiner. We have reviewed the Reply Brief’s presentation of the content of paragraphs 41, 42, 43, 164, and 171 cited in the Reply Brief, and these portions fail to specifically disclose that the cited account information is *not* received and stored at the central data storage. For example, at paragraph 164 it is stated that the health information specific to the medical practice is stored in the MIOS with the medical office, but this storing does not specifically prevent the health information from being stored in the central storage area as well. Also, paragraph 164 states that upon request, information can be transferred to an outside member, and the information could include at least some confidential information. A review of Figures 1, 2, 3, and 4 fails to disclose this as well.

The Examiner has also determined that the Specification fails to provide support for the claim limitation for “at least one **private data storage** storing electronic medical record (**EMR**) information originated, entered and controlled by at least one or more first healthcare service providers affiliated with the one or more healthcare user groups” (Ans. 3). In making this assertion the Examiner has cited to the Specification at page 10 as describing that a patient’s Personal Health records are “created and

³ The Appellant has presented arguments for the first time in the Reply Brief that were not made in the Appeal Brief, filed Apr. 3, 2015, but for the sake of efficiency we will consider them in this Decision. However, Arguments which Appellant could have made but chose not to make in these Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

controlled by the individual [patient] or family” but “accessible” to health care providers (*id.*).

In contrast, the Appellant has stated that support for this claim limitation is found in paragraph 164 and that the reference to page 10 made by the Examiner is in the “Prior Art” Section (Reply Br. 18).

We agree with the Examiner. Here, the citation by the Examiner to the Specification at page 10 is listed in the “Prior Art” section. However, the rejection has been maintained and the citation to page 10 in rejection was made only as an additional way to bolster it, not the basis for the fundamental rejection itself. The Appellant is still required to show specific support for the cited claim term in the Specification. Here, the citation by the Appellant to paragraph 164 does state that patient health care information is stored at the medical office but this does not specifically show that is controlled by the first health office. For this reason we agree with the Examiner.

As we agree with the Examiner, this rejection of claim 1 is sustained. The Appellant has not provided specific arguments with regard to claims 7, 8, 10, 13, 18, 25, 28, 29, 32, 34, 41, 43–68, and 71 and these rejections are sustained as well.

The Examiner has also determined that in claims 69 and 70 that the claim limitation for “computing the **quality of services** provided by the one or more first healthcare providers to the patients and provide feedback by monitoring the quality of services to the one or more healthcare user groups” is not supported (Ans. 4).

In contrast, the Appellant has stated that the Q-rating itself helps monitor and control the services (Reply Br. 20).

We agree with the Examiner. The cited claim limitation requires computing the quality of services by the healthcare providers and providing feedback by monitoring the quality of services. While the citation to paragraph 305 made in the Reply Brief at page 20 does show the use a Q-rating being calculated, it is not specifically disclosed that this information is used to provide feedback. For instance, the Q-rating could be an internal review measurement that is not provided to any groups as feedback. For this reason, this rejection of claims 69 and 70 is sustained.

Rejection under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 51 and 52 as being indefinite for failing to provide antecedent basis for the term “the patient appointment request” (Ans. 5). The Appellant argues that this rejection is improper and that the Specification supports such language (Reply Br. 21).

We agree with the Examiner. Here, the respective independent claims 1 and 41 each fail to provide a proper provide antecedent basis for the term “the patient appointment request” and it is unclear where such an appointment request is coming from (Ans. 5). For this reason, this rejection is sustained.

The Examiner has also rejected claims 69 and 70 as being indefinite for failing to specify how the feedback is provided (Ans. 5, 6). The Examiner states that it is unclear if the feedback is based on the private computing of the quality of services when the Specification states that the computation is based on feedback itself (Ans. 5, 6).

In contrast, the Appellant has determined that the rejection is improper and that the limitation is not indefinite (Reply Br. 20).

We agree with the Examiner. Here, it is unclear how the feedback is provided and which “feedback” is being referred to in the cited rejection. For this reason, this rejection of record is sustained.

Rejection under 35 U.S.C. § 101

The Examiner has rejected claim 1 under 35 U.S.C. 101 as being drawn to ineligible subject matter (Ans. 6, 7). The Examiner has determined that the claim is directed to the abstract idea of a fundamental economic practice of calculating a patient’s bill and that the additional elements do not add significantly more as they are drawn to the generic computer structures and conventional activities known in the industry (Ans. 6, 7).

In contrast the Appellant has argued that this rejection is improper (Reply Br. 22, 24).

We agree with the Examiner. Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “laws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347, 2354 (2014).

In judging whether claim 1 falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. If so, we then consider the elements of the claim both individually and as “an ordered

combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application of the abstract idea. *Id.* This is a search for an “inventive concept,” an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.* The Court also stated that “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Id.* at 2358.

Here, the claim is directed to the abstract idea of billing and also to a fundamental economic practice of calculating a patient’s bill. We next consider whether additional elements transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the abstract idea over the Internet, using generic computer components. We conclude that it does not. The recited method steps of claim 1 fail to transform the nature of the claim as they are directed to generic computer structures for storing and transferring information. For this reason, this rejection of claim 1 is sustained. The Appellant has provided the same arguments for the remaining claims, and the rejection of these claims is sustained as well.

Rejection under 35 U.S.C. § 103(a)

The Appellant argues that the rejection of claim 1 under 35 U.S.C. § 103(a) is improper (Reply Br. 24–36). The Appellant has provided arguments that: the combination is inoperable, differences exist between the combination and invention, that the Examiner has made false findings, that the combination lacks motivation, and that impermissible hindsight has been used (Reply Br. 29–37).

In contrast, the Examiner has determined that the rejection of claim 1 is proper (Ans. 7–10, 31, and 32).

We agree with the Examiner. We have reviewed the rejection of record in the Answer at pages 7–10, and agree with, and adopt, the facts and reasons articulated for the combination to be determined to have been obvious. The Appellant has argued in the Reply Brief at pages 29 and 30 that the combination would be inoperable, but we disagree. Here, it is not the entire teachings of Malhotra combined with Hacker, but only those used in the rejection of record. The Appellant also argues in the Reply Brief at pages 30–32 that the cited prior art has differences with the current invention but attacks the references individually rather than look at the combination of record used in the rejection. The Appellant’s arguments in this regard attack references individually, when the rejections are over a combination of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981) (“[O]ne cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references.”). The Appellant argues in the Reply Brief at pages 32 and 33 that the Examiner has made false statements. We have reviewed the findings of facts used in showing the required claimed prior art elements in the prior art and agree with and adopt these facts. The Appellant has argued in the Reply Brief at pages 34–36 that the rejection of record lacks motivation, uses impermissible hindsight, and fails to present a prima facie case. As stated above, we have reviewed the rejection of record in the Answer at pages 7–10 and agree with and adopt the reasons articulated for the combination to be determined to have been obvious. For these above reasons this rejection of claim 1 is sustained.

The Appellant has also argued in the Reply Brief at page 37 that the rejection of claim 71 is improper because the claim does not require a central server, program, or data storage and instead requires a first and second data storage (Reply Br. 37). Here, claim 71 does not exclude the use of a central server and the rejection accounts for private data storages (first and second data storage) in the rejection at page 7. We have reviewed the rejection of claim 71, and agree with and adopt the reasons articulated for the combination to be determined to have been obvious as well.

The Appellant has provided the same arguments for the remaining claims and the rejection of these claims is sustained as well.

CONCLUSIONS OF LAW

We conclude that Appellant has not shown that the Examiner erred in rejecting the claims as listed in the Rejections section above.

DECISION

The Examiner's rejection of claims 1, 7, 8, 10, 13, 18, 25, 28, 29, 32–34, 41 and 43–71 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