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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* DAVID D. HARVEY, CHIP ACH, MATHEW BLAKE,  
CHRISTOPHER BULKLEY, ANGELA CRAWFORD, DEIRDRE  
FENICK, MICHAEL MACHENRY, CAL PIEROG, LIBBY CURTIS  
WEBB, VAN B. WILLIS, ROBERT KEITH, and KURT SOPATA

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Appeal 2017-000246<sup>1</sup>  
Application 13/165,147<sup>2</sup>  
Technology Center 3600

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Before CYNTHIA L. MURPHY, KENNETH G. SCHOPFER, and  
BRADLEY B. BAYAT, *Administrative Patent Judges*.

BAYAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–3 and 5–39, which are all the pending claims in the application.<sup>3</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> Our Decision references Appellants’ Appeal Brief (“Br.,” filed Jan. 20, 2016), the Examiner’s Answer (“Ans.,” mailed June 30, 2016), and Final Office Action (“Final Act.,” mailed May 22, 2015).

<sup>2</sup> Appellants identify “athenahealth, Inc.” as the real party in interest. Br. 2.

<sup>3</sup> Claim 4 is canceled. *Id.* at 14, Claims App’x.

STATEMENT OF THE CASE

*Claimed Subject Matter*

Appellants' invention is titled Healthcare Information Communication System. Method claim 1, system claim 19, and computer readable medium claim 39 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the claimed subject matter and recites:

1. A method of facilitating communication between at least one patient and a healthcare provider using a practice management system that includes a communications management component, a billing management component, and a health information management component, the method comprising:

storing, by the communications management component, personal preferences information for each of a plurality of patients of a plurality of medical practices associated with the practice management system, wherein at least one of the plurality of medical practices is associated with a plurality of healthcare providers;

storing, by the health information management component, electronic health information for each of the plurality of patients;

receiving, by the practice management system, updated data for one or more of the plurality of patients;

generating, in response to receiving the updated data, at least one automated message, wherein the at least one automated message is generated based, at least in part, on the stored electronic health information for the first patient, and wherein the generating is performed by at least one computer processor of the practice management system;

determining based, at least in part, on the stored personal preferences information-for the first patient, a preferred mode of communication; and

transmitting, by the communications management component, the at least one automated message to the first patient using the determined preferred mode of communication.

*Rejections<sup>4</sup>*

Claims 1–3 and 5–39 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–3, 5–7, and 9–18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 19 and 28–31 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lawless (US 2007/0168228 A1, published July. 19, 2007) and Lipscher et al. (US 2006/0031097 A1, published Feb. 9, 2006 (hereinafter “Lipscher”).

Claims 1, 2, 7, 10, 12, 14–18, 29, 30, 31, and 39 are rejected under 35 U.S.C. § 103(a) as unpatentable over Grichnik et al. (US 2009/0062621 A1, published Mar. 5, 2009) (hereinafter “Grichnik”), Lawless, and Lipscher.<sup>5</sup>

Claim 3 is rejected under 35 U.S.C. § 103(a) as unpatentable over Grichnik, Lawless, and Forrest et al. (WO 2010/073208 A1, published July 1, 2010) .

Claims 5, 6, and 9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Grichnik, Lawless, Lipscher, and Bocionek et al. (US 2004/0243441 A1, published Dec. 2, 2004 (hereinafter “Bocionek”).

Claim 8 is rejected under 35 U.S.C. § 103(a) as unpatentable over Grichnik, Lawless, Lipscher, and Fox et al. (US 2011/0161097 A1, published June 30, 2011 (“hereinafter “Fox”).

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<sup>4</sup> We treat the Examiner’s inclusion of canceled claim 4 in the statements of rejection as harmless error.

<sup>5</sup> We note the Examiner’s inadvertent inclusion of claim 3 in the statement of rejection.

Claim 11 is rejected under 35 U.S.C. § 103(a) as unpatentable over Grichnik, Lawless, Lipscher, and Levine et al. (US 7,756, 722 B2, issued July 13, 2010).

Claim 13 is rejected under 35 U.S.C. § 103(a) as unpatentable over Grichnik, Lawless, Lipscher, and Kerr, II (US 2004/0030582 A1, published Feb. 12, 2004).

Claims 20–23 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lawless, Lipscher, and Bocionek.

Claims 24 and 25 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lawless, Lipscher, and Young et al. (US 2011/0270640 A1, published Nov. 3, 2011) (hereinafter “Young”).

Claims 26 and 27 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lawless, Lipscher, Young, and Fox et al. (US 2011/0161097 A1, published June 30, 2011).

Claims 32 and 33 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lawless, Lipscher, and Krishnan et al., (US 2005/0234740 A1, published Oct. 20, 2005).

Claims 34–38 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lawless, Lipscher, and Official Notice.

## ANALYSIS

### *Non-Statutory Subject Matter*

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: “[l]aws 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).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1300 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts.” *Alice*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” *id.*, e.g., to an abstract idea. If the claims are not directed to an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements [that] “‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1297).

Applying the framework in *Alice*, and as the first step of that analysis, the Examiner determined that the claims are “directed to billing and health information management and storing personal preference information for a plurality of patients in order to generate an automated message based, at least in part, on the stored personal preference information using a preferred mode of communication, which considered in its entirety, contains elements of a fundamental economic process and a method of organizing human activities or comparing new and stored information and using rules to identify options which the courts have found to be an abstract idea.” Final Act. 2. Proceeding to the second step, the Examiner found

The additional element(s) or combination of elements in the claim(s) other than the abstract idea per se amount(s) to no more than: (i) mere instructions to implement the idea on a computer, and (ii) recitation of generic computer structure that serves to perform generic computer functions that utilizes conventional methods of contact (i.e. phone calls or mail) that are well-understood, routine, and conventional activities previously known to the pertinent industry. Viewed as a whole, these additional claim element(s) do not provide meaningful limitation(s) to transform the abstract idea into a patent eligible application of the abstract idea such that the claim(s) amounts to significantly more than the abstract idea itself.

*Id.* at 2–3.

As an initial matter, Appellants argue that the § 101 rejection “should be reversed because the Final Office Action fails to clearly articulate an alleged abstract idea to which the claims are directed.” Br. 6. According to Appellants, the Final Office Action merely “recites various claim limitations and categories that the courts have identified as being abstract without identifying any particular alleged abstract idea on which the Office is relying to support the rejections under 35 U.S.C. § 101.” *Id.* We disagree.

35 U.S.C. § 132 sets forth a general notice requirement to ensure that an applicant is notified of the reasons for a rejection together with such information as may be useful in judging the propriety of continuing with prosecution of the application. *See, e.g., In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011). In this case, the Examiner provided adequate explanation to meet the notice requirement. The Examiner set forth the statutory basis of the rejection, applied *Alice*’s two-part framework, and sufficiently articulated reasoning relating to the *Alice* analysis in an informative manner, thus, meeting the notice requirement of 35 U.S.C. § 132. *See*

*Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (Section 132 “is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

Specifically, the Examiner followed the analysis used by the Supreme Court and the Federal Circuit by comparing the claimed concepts to prior decisions to identify an abstract idea. More specifically, the Examiner determined that the claims are “directed to billing and health information management and storing personal preference information for a plurality of patients in order to generate an automated message based, at least in part, on the stored personal preference information using a preferred mode of communication,” and indicated that the claims encompass a fundamental economic process, a method of organizing human activities, or comparing new and stored information and using rules to identify options, which courts have found to be abstract ideas. *See* Final Act. 2; *see also* Ans. 3–4. For example, the Examiner identified the recitation of “a billing management component” in the independent claims as “a fundamental economic practice in healthcare accounting.” Final Act. 24.

Therefore, Appellants have been provided with adequate notice to recognize and counter the Examiner’s rejection.

*Independent claims 1 and 39*

As to the first step in the *Alice* framework, Appellants present no arguments to dispute the Examiner’s characterization of the abstract idea. , In any event, we agree with the Examiner’s determination that the claims are directed to a patent-ineligible concept—an abstract idea. Here, the claims presented are similar to those found by the Board, and recently affirmed by

the Federal Circuit, to be directed to the “abstract idea of billing insurance companies and organizing patient health information,” which “describes little more than the automation of a ‘method of organizing human activity’ with respect to medical information.” *In re Salwan*, No. 2016–2079, 2017 WL 957239 \*3 (Fed. Cir. Mar. 13, 2017) (citing *Alice*, 134 S. Ct. at 2356). As the Federal Circuit recognized in *Salwan*, although the concepts recited in the claims may be “practical concepts,” they are nevertheless “fundamental economic and conventional business practices,” and thus, are abstract ideas. *Id.*

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.

In that regard, Appellants argue that the *receiving* and *generating* “elements of claims 1 and 39, considered either individually or in an ordered combination, amount to ‘significantly more’ than any of the alleged abstract ideas listed in the Final Office Action.” Br. 7 (“[T]hese limitations require that at least one automated message is generated based, at least in part, on electronic health information stored by a health information management component of a practice management system and that the at least one automated message is generated in response to receiving updated data for one or more patients associated with the practice management system.”). According to Appellants, the integration of a communications management component, a billing management component, and a health information management component “by the practice management system enables the

generation and transmission of automated messages not possible in systems that do not include such components.” *Id.*

However, we do not see, and Appellants do not help us see, how receiving updated data of patients and generating an automated message in response to receiving the updated data transforms the abstract idea into an inventive application. The steps of “receiving” data and manipulating existing data by “generating” additional data for automatic transmission are functions a generic computer conventionally performs. *See* Ans. 5–6 (citing Spec. ¶¶ 124–34). And “[t]aking the claim elements separately, the function performed by the computer at each step of the process is ‘[p]urely conventional.’” *Alice*, 134 S. Ct. at 2359 (citing *Mayo*, 132 S. Ct. at 1298). Considered as an ordered combination, the computer components<sup>6</sup> add nothing that is not already present when the steps are considered separately. *Id.* “[T]he focus of the claims is not on such an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016). As in *Salwan*, the recited steps fail to transform the nature of the claims as they are directed to generic computer structures (e.g., computer processor) for storing and transferring information. Considering the claim elements individually and as an ordered combination, the claims merely implement long-known practices related to healthcare management and patient health information on generic computers.

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<sup>6</sup> “Computer-executable instructions may be in many forms, such as program modules, executed by one or more computers or other devices. Generally, program modules include routines, programs, objects, components, data structures, etc. that perform particular tasks or implement particular abstract data types.” Spec. ¶ 134.

In view of the foregoing, we sustain the rejection of independent claims 1 and 39 under 35 U.S.C. § 101, including claims 2, 3, and 5–18, which are argued based on their dependency on claim 1. *See* Br. 7.

*Independent claim 19*

Appellants assert that claim 19 is distinct from claims 1 and 39 because it “does not include any limitations directed to storing personal preference information for a plurality of patients or generating an automated message based, at least in part, on stored personal preference information using a preferred mode of communication.” Br. 8. “Rather, claim 19 is directed to a computer system that includes multiple components including a health information datastore, a communications management component, a billing management component, and at least one processor programmed to provide a web-based user interface.” *Id.* Appellants argue that “[b]ecause claim 19 does not include any limitations directed to the above-quoted alleged abstract idea, claim 19 necessarily cannot be directed to this alleged abstract idea, and the rejection under 35 U.S.C. §101 is improper and should be reversed.” *Id.*

However, we do not see, and the Appellants do not help us see, why claim 19 is not directed to the abstract idea of “billing and health information management” regardless of not storing personal preference information patients or generating a message based on that information. As discussed above, the recitation of multiple components in the claim, as in claims 1 and 39, does not alter the analysis under *Alice* step one. *See* Ans. 6–7.

Thus, we sustain the rejection of independent claim 19 under § 101, including claims 20–38, which are argued based on their dependency on claim 19. *See* Br. 8.

*Indefiniteness*

We are persuaded by Appellants’ argument that the Examiner erred in rejecting claims 1–3, 5–7, and 9–18 under 35 U.S.C. § 112, second paragraph, as indefinite. Br. 8–9.

The Examiner determined that the limitation in claim 1 of “updated data of one or more of the plurality of patients” is indefinite because it is “unclear whether the said updated data is updating data on the personal preference information for each patient, electronic health information for each patient, or updating some other information.” Final Act. 3.

However, we agree with Appellants, and the Examiner does not explain in the Answer (*see* Ans. 7), why a person of ordinary skill in the art upon reviewing paragraphs 54, 65, and 75 of the Specification would not understand “that the updated data recited in claim 1 is any data stored by the practice management system for one or more patients, including personal preferences information and electronic health information, that may be updated and may trigger the generation of an automated message.” Br. 9. Even though the claimed *updated data* broadly encompasses any of the recited patient information in claim 1, “[b]readth is not indefiniteness.” *In re Gardner*, 427 F.2d 786, 788 (CCPA 1970).

Therefore, we do not sustain the rejection under 35 U.S.C. § 112, second paragraph.

*Obviousness*

*Independent claim 19*

In contesting the Examiner’s rejection of independent claim 19 as obvious over Lawless and Lipscher, Appellants argue that “neither Lawless nor Lipscher discloses or suggests a health information datastore configured to store electronic health information for patients of *a plurality of medical practices*, at least one of which is associated with a plurality of healthcare providers, as required by claim 19.” Br. 10–11 (citing Lipscher ¶ 31 as disclosing “management of *a single medical practice*”).

In response to Appellants’ argument, the Examiner asserts that Lipscher discloses that

records may be acquired from other systems, for example, from third-party payers, the patient’s previous healthcare providers or the patients themselves. (0038, 0051, 0053 and 0054). This reasonably conveys storing data for a plurality of patient[s] of a plurality of medical practices, wherein at least one of the plurality of medical practices is associated with a plurality of healthcare providers, as claimed.

Ans. 8.

Appellants do not dispute this finding, as such, we are not apprised of Examiner error. We note that paragraph 53 of Lipscher does disclose that healthcare providers, such as nurses and physicians, are provided with an interface to enter patient findings and medical history, wherein findings acquired from a patient and provided by healthcare providers are combined and stored in a database. Because Appellants have not shown error as to the Examiner’s findings, we sustain the rejection of claim 19 as obvious over Lawless and Lipscher, including claims 20–38, which are argued based on their dependency on claim 19. *See* Br. 11.

*Independent claims 1 and 39*

Appellants assert that “each of claims 1 and 39 recites, ‘storing, by the communications management component, personal preferences information for each of a plurality of patients of a plurality of medical practices associated with the practice management system, wherein at least one of the plurality of medical practices is associated with a plurality of healthcare providers.’” Br. 11. In contesting the Examiner’s rejection of independent claims 1 and 39 as obvious over Grichnik, Lawless and Lipscher, Appellants simply assert that none of these references “discloses or suggests a practice management system associated with a plurality of medical practices, at least one of which is associated with a plurality of healthcare providers, the purported combination of Grichnik, Lawless, and Lipscher necessarily also fails to disclose or suggest the above-quoted portion of claims 1 and 39.” *Id.*

In response to Appellants’ argument, the Examiner provides a detailed analysis as to how and why the above contested limitation is disclosed by the cited prior art. *See* Ans. 9–12.

Appellants may well disagree with how the Examiner interpreted and applied the references, but Appellants offer no substantive arguments to rebut these specific underlying factual findings made by the Examiner in support of the ultimate legal conclusion of obviousness. And we decline to examine the claims *sua sponte*, looking for distinctions over the prior art. *Cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art.”). In the absence of a more detailed explanation, we are not persuaded

of error on the part of the Examiner. *See Jung*, 637 F.3d. at 1365 (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections,” (citing *Ex Parte Frye*, 94 USPQ2d 1072 (BPAI 2010) (precedential) (“The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon.”))).

Accordingly, we sustain the rejection of independent claims 1 and 39 under 35 U.S.C. § 103(a), including claims 2, 3, and 5–18, which are argued based on their dependency on claim 1. Br. 11.

#### DECISION

The rejection under 35 U.S.C. § 101 is affirmed.

The rejection under 35 U.S.C. § 112, second paragraph, is reversed.

The rejections under 35 U.S.C. § 103 are affirmed.

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