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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VAL C. DEAN

Appeal 2017-000451
Application 14/269,316
Technology Center 3600

Before DENISE M. POTHIER, LARRY J. HUME, and
CATHERINE SHIANG, *Administrative Patent Judges*.

POTHIER, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellant^{1,2} appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–16. Appeal Br. 2. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ Throughout this opinion, we refer to the Final Action (Final Act.) mailed May 18, 2015, the Appeal Brief (Appeal Br.) filed May 4, 2016, the Examiner's Answer (Ans.) mailed August 15, 2016, and the Reply Brief (Reply Br.) filed October 7, 2016.

² The real party in interest is listed as TriZetto Corporation. Appeal Br. 2.

Invention

The present invention is directed to a system and method which allows a prospective insured to make an informed decision on healthcare insurance by using a current medical profile to assist in the selection of future medical insurance. Based on past medical care, as obtained from payor data, a number of different plans, each having different providers, different deductibles, different maximums, different reimbursement policies, etc., a person can make an informed decision.

Spec. ¶ 7. This illustrates “the power obtained when the medical history of a patient can be generated and continually monitored based upon an abstraction of data meant for another purpose, namely payment information.” Spec. ¶ 23.

Claim 1 is reproduced below:

1. An online method for assisting a user in selecting a medical reimbursement plan, said method comprising:

abstracting, by a processor, first medical information included with at least one medical reimbursement claim intended for a first payor from one or more medical providers before the at least one medical reimbursement claim reaches the first payor, said abstracted first medical information pertaining to a particular user, wherein the abstracting includes converting the first medical information by at least one adaptor from one or more formats to one or more second formats, removing first subsets of the converted first medical information pertinent to selection of a medical reimbursement plan and storing the first subsets of converted medical information in a patient profile database;

receiving, by the processor, second medical information from the particular patient responsive to questions administered to the particular user;

receiving, by the processor, first non-medical information from the particular user responsive to questions administered to the particular user;

abstracting, by the processor, second non-medical information from incoming external information intended for a first payor from one or more external sources before the incoming external information reaches the first payor, said abstracted second non-medical information pertaining to the particular user, wherein the abstracting includes converting the second non-medical information by at least one adaptor from one or more formats to one or more second formats, removing second subsets of the converted non-medical information pertinent to selection of a medical reimbursement plan and storing the second subsets of converted non-medical information in a patient profile database;

retrieving, by the processor from the patient profile database, the first and second subsets of converted medical and converted non-medical information;

obtaining, by the processor, medical reimbursement plan information for multiple individual medical reimbursement plans;

comparing, by the processor, the first and second subsets of converted medical and converted non-medical information, the second medical information, and the first non-medical information, with the medical reimbursement plan information for each individual medical reimbursement plan; and

providing to the particular user by the processor an evaluation of each of the individual medical reimbursement plans based on the comparison to assist the particular user with the selection of at least one of the individual medical reimbursement plans.

The Examiner relies on the following as evidence of unpatentability:

Barber	US 4,858,121	Aug. 15, 1989
Johnson	US 5,664,109	Sept. 2, 1997
Ullman	US 2002/0002495	Jan. 3, 2002
Schoenbaum	US 2002/0147617 A1	Oct. 10, 2002
Kalies	US 2004/0073457 A1	Apr. 15, 2004
Lash	US 2005/0010446 A1	Jan. 13, 2005

The Rejections

Claims 1–16 are rejected under 35 U.S.C. § 101. Final Act. 6.

Claims 1, 2, 9, and 10 are rejected under 35 U.S.C. § 103(a) as unpatentable over Schoenbaum, Barber, and Johnson. Final Act. 7–9.

Claims 3–5 and 11–13 are rejected under 35 U.S.C. § 103(a) as unpatentable over Schoenbaum, Barber, Johnson, and Lash. Final Act. 9–11.

Claims 6 and 14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Schoenbaum, Barber, Johnson, and Kalies. Final Act. 11–12.

Claims 7, 8, 15, and 16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Schoenbaum, Barber, Johnson, and Ullman. Final Act. 12–13.³

THE PATENT-INELIGIBLE SUBJECT MATTER REJECTION

The Examiner finds the claims are directed to an abstract idea of “extracting user information from medical claims and questionnaires and comparing that user information to medical insurance plans to help a user select the best medical insurance plan for them.” Final Act. 6; Ans. 3. The Examiner further finds the claims have additional elements but that these

³ The rejections based on 35 U.S.C. § 112, first and second paragraphs presented in the Final Acton (Final Act. 2–5) have been withdrawn (Ans. 2).

elements alone or in combination do not amount to significantly more than the abstract idea; rather, the additional elements are no more than (1) instructions to implement the abstract idea on a computer and (2) a generic computer serving to perform generic computer functions that are well-understood, routine, and conventional activities previously known in the industry. Final Act. 6.

Appellant asserts the Examiner has not presented a prima facie case under 35 U.S.C. § 101. Appeal Br. 9–10; Reply Br. 3–4. Specifically, Appellant argues the Examiner ignores claim elements, including the recited “abstracting . . . first medical information” step in claim 1. Appeal Br. 9–10; Reply Br. 4. Appellant further contends claim 1 recites (1) new physical components (i.e., “at least one adaptor”) and (2) processes other than those performed mentally (i.e., “abstracting and converting from one or more formats to one or more second formats”). Appeal Br. 10; Reply Br. 5–6. To the extent the claims are directed to an abstract idea, Appellant asserts “The claims are directed to a complex process, requiring interaction between multiple hardware components and the extraction and adaptation of data from various sources and formats” and do not pre-empt every application of the generic computer functions. Appeal Br. 11.

ISSUE

Under § 101, has the Examiner erred in rejecting claims 1–16 by concluding the claims are directed to patent-ineligible subject matter?

ANALYSIS

Claim 1

In *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 70 (2012) and *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014), the Court set forth a two-step analytical framework for evaluating patent-eligible subject matter. First, “determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355. If so, “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements” add enough to transform the “nature of the claim” into “significantly more” than a patent-ineligible concept. *Id.* at 2355, 2357 (quoting *Mayo*, 566 U.S. at 79); see *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

Mayo/Alice Step 1

Step one in the *Mayo/Alice* framework involves looking at the “focus” of the claims at issue and their “character as a whole.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). This “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.’” *Enfish*, 822 F.3d at 1335 (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

We agree with the Examiner that claim 1’s focus is directed to an abstract idea of “extracting user information from medical claims and questionnaires and comparing user information to medical insurance plans to help a user select the best medical insurance plan for them.” Final Act. 6;

Ans. 3. Such an abstract idea is an idea itself, a method of organizing human activities⁴, or both.⁵

To elaborate, claim 1 recites “receiving . . . second medical information from the particular patient responsive to questions administered to a particular user” and “receiving . . . first non-medical information from the particular user responsive to questions administered to the particular user” (e.g., extracting user information from medical claims and questionnaires). *See* Ans. 3–4. Claim 1 also recites a method “for assisting a user in selecting a medical reimbursement plan,” “obtaining . . . medical reimbursement plan information for multiple individual medical reimbursement plans,” “comparing . . . subsets of converted medical and converted non-medical information, the second medical information, and first non-medical information, with the medical reimbursement plan information for each individual medical reimbursement plan,” and “providing to the particular user . . . an evaluation of each of the individual medical reimbursement plans based on the comparison to assist the particular user with the selection of” a medical reimbursement plan (e.g., compare user information to medical insurance plans to help a user select the best medical insurance plan). *See also* Ans. 3–4.

Courts have found steps of gathering, analyzing, manipulating, and comparing information and displaying results are directed to abstract idea.

⁴ *See Elec. Power Grp.*, 830 F.3d 1350, *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343 (Fed. Cir. 2014), *Berkheimer v. HP Inc.*, F.3d (Fed. Cir. 2018), and *In re TLI Communications LLC Patent Litigation*, 823 F.3d 607 (Fed. Cir. 2016).

⁵ *See RecogniCorp, LLC v. Nintendo Co., Ltd*, 855 F.3d 1322 (Fed. Cir. 2017) (stating “Adding one abstract idea (math) to another abstract idea (encoding and decoding) does not render the claim non-abstract.”)

See Elec. Power Grp., 830 F.3d at 1354 (indicating the claims are directed to an abstract idea of gathering and analyzing information of a specified content and displaying results), *Content Extraction*, 776 F.3d at 1347 (indicating the claims are directed to the abstract idea of collecting data using a scanner, recognizing specific information within a collected dataset, and storing the recognized data in memory), *TLI Communications*, 823 F.3d at 613 (indicating the claims were directed to an abstract idea of classifying and storing digital images in an organized manner), and *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1366-67 (Fed. Cir. 2018) (stating the claims are directed to an abstract idea of parsing and comparing information akin to collecting and recognizing data and classifying data in an organized manner).

Similarly, the steps outlined above in claim 1 are those of gathering information (e.g., “receiving . . . second medical information” and “first non-medical information,” “retrieving . . . the first and second subsets of converted medical and converted non-medical information,” and “obtaining . . . medical reimbursement plan information”), analyzing or comparing information (e.g., “comparing . . . information with the medical reimbursement plan information”), and displaying results (e.g., “providing to the particular user . . . an evaluation of each of the individual medical reimbursement plans based on the comparison”). Moreover, even when such information is limited to particular content, it is well-settled that such steps, such as collecting certain information, is within the realm of abstract ideas. *Elec. Power Grp.*, 830 F.3d at 1353.

Regarding the specifically disputed “abstracting . . . first medical information” step in claim 1, this step involves three underlying processes of

“converting the first medical information . . . from one or more formats to one or more second formats, removing first subsets of the converted first medical information pertinent to selection of a medical reimbursement plan, and storing the first subsets of converted medical information in a patient profile database.” Appeal Br. 21 (Claims App.). As noted by the Examiner (Ans. 3–4), such steps of removing certain information and storing information are considered to be abstract ideas. *See Content Extraction*, 776 F.3d at 1347, *TLI Communications*, 823 F.3d at 613, and *Berkheimer*, 881 F.3d at 1366-67. Also, even presuming, without agreeing, the “abstracting” step in claim 1 involves classifying patients into categories (*see* Spec. ¶ 26), classifying data is considered to be directed to an abstract idea. *See TLI Communications*, 823 F.3d at 613 (stating the claims are directed to an abstract idea of classifying digital images).

As for the step of “converting” information from one format to another, this step is also directed to an abstract idea of organizing information, possibly through a mathematical correlation. *See RecogniCorp.*, 855 F.3d at 1327 (indicating the claims are directed to an abstract idea of starting with data, codes the data using a multiplication operation, and ends with a new form of data) and *Digitech Image Techs., LLC v. Electronics for Imaging, Inc.*, 758 F.3d 1344, 1350-51 (Fed. Cir. 2014). Although disclosing using an adaptor (e.g., 120) to convert information from one format to another (Spec. ¶ 19, Fig. 1), there is no discussion—nor does Appellant assert—that this step is sufficiently rooted in technology to solve a technological problem. Likewise, the second “abstracting” step in claim 1 (Appeal Br. 21 (Claims App.)) is directed to a similar abstract idea to that of the first “abstracting” step.

Appellant contends claim 1 differs from *SmartGene, Inc. v. Advanced Biological Laboratories, SA*, 555 F. App'x 950 (Fed. Cir. 2014). Appeal Br. 9–10; Reply Br. 4–5. Regardless of whether *SmartGene* is applicable to the facts in this record, the noted cases discussed above support that claim 1 is directed to at least one abstract idea. We further are unpersuaded by Appellant's mere assertion that “the facts of [*McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299, 1312 (2016)] are similar to the facts and claims . . . in this application.” Reply Br. 6. Unlike the claims of *McRO*, claim 1 does not involve and Appellant has not demonstrated any claim involves a specialized algorithm or “specific features of the rules as claim limitations” as asserted. Reply Br. 6.

Regarding Appellant's assertion that the Examiner's findings in the Answer amount to a new ground of rejection under 35 U.S.C. § 101 (Reply Br. 4, n.4), we agree such a matter is petitionable. Reply Br. 4 n.4; *see also* 37 C.F.R. § 41.40(a). For this reason, this issue is not within the jurisdiction of the Board and will not be addressed. *See* MPEP §§ 1002 and 1201 (9th ed., Rev. 08.2017 Jan. 2018); *see also In re Hengehold*, 440 F.2d 1395, 1403 (CCPA 1971) (stating that there are many kinds of decisions made by Examiners, “which have not been and are not now appealable to the board or to this court when they are not directly connected with the merits of issues involving rejections of claims, but traditionally have been settled by petition to the Commissioner.”).

As for Appellant's contention that the Examiner incorrectly asserts the process steps cannot be performed mentally (i.e., “abstracting and converting from one or more formats to one or more second formats”) (Appeal Br. 10), we are not persuaded. First, courts have treated “analyzing

information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Elec. Power*, 830 F.3d at 1354. Second, we recognize some of the steps in claim 1 involve using (1) “a processor” (e.g., both “abstracting” steps, both “receiving” steps, the “retrieving” step, the “obtaining” step, the “comparing” step, and the “providing” step), (2) “at least one adaptor” (e.g., both “abstracting” steps), and (3) “a patient profile database” (e.g., both “abstracting” steps). Appeal Br. 21–22 (Claims App.). Yet, but for the recitation of these generic computer components, we agree with the Examiner the above, recited steps or functions could be performed as mental steps, or with the aid of pen and paper. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011) (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*[, 409 U.S. 63 (1972)]”); *see also Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146-47 (Fed. Cir. 2016).

As for the pre-emption contention argued by Appellant (Appeal Br. 11 (discussing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014); Reply Br. 6 (discussing *McRO*, 837 F.3d 1299)), we note lack of preemption does not make the claims any less abstract. *See Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”); *see also* Ans. 6 (indicating the same). Claim 1 does not sufficiently include meaning limitations beyond generally linking the use of the abstract idea to a

particular technological environment (e.g., selecting a medical reimbursement plan).

Mayo/Alice Step 2

In this step, we consider the elements of claim 1 both individually and as combination to determine whether the additional elements add enough to transform the claim into significantly more than a patent-ineligible concept. Step two involves the search for an “inventive concept.” *Alice*, 134 S. Ct. at 2355; *Elec. Power Grp.*, 830 F.3d at 1353. An “inventive concept” requires more than “well-understood, routine, conventional activity already engaged in” by the relevant community. *Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1047 (Fed. Cir. 2016) (quoting *Mayo*, 566 U.S. at 79–80).

As noted above, the additional elements in claim 1 include recitations to “a processor,” “at least one adaptor,” and “a patient profile database” to perform the recited steps of functions of the claim. Appeal Br. 21–22 (Claims App.). See Ans. 4–5. The disclosure describes the processor and the database (12) in generalities. Spec. ¶¶ 17, 28, 30, 33, Fig. 1. Also, although Appellant characterizes the recited “at least one adaptor” in claim 1 as “new physical components” (Appeal Br. 10), and claim 1 has “multiple hardware components” (Appeal Br. 11), the disclosure describes the adaptor in general and shows adaptor 120 as an empty box. Spec. ¶¶ 19, 26, Fig. 1. Thus, like the Examiner (Final Act. 6; Ans. 4–5), we agree the additional elements in claim 1 are viewed as no more than recitations to generic computers that do not transform the above-discussed abstract idea into a patent-eligible invention. See *Alice*, 134 S. Ct. at 2358 (holding “the mere recitation of a generic computer cannot transform a patent-ineligible abstract

idea into a patent-eligible invention”); *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1341 (Fed. Cir. 2017) (“the claims recite both a generic computer element—a processor—and a series of generic computer ‘components’ that merely restate their individual functions That is to say, they merely describe the functions of the abstract idea itself, without particularity. This is simply not enough under step two.”).

For the above reasons, claim 1’s limitations, viewed “both individually and as an ordered combination,” do not amount to significantly more than the judicial exception and does not sufficiently transform the nature of the claims into patent-eligible subject matter. *See Alice*, 134 S. Ct. at 2355.

Based on the record before us, we are not persuaded of error in the Examiner’s rejection of claim 1.

Claims 2–16

Appellant contends claims 2–16 are not addressed in the rejection. Appeal Br. 12–14. This argument is unavailing. First, the rejection includes all the claims when discussing *Mayo/Alice* two steps. Final Act. 6 (stating “[t]he claims are directed to the abstract idea . . .” and “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 . . .”). Moreover, independent claim 9 includes similar limitations to claim 1. *Compare* Appeal Br. 21–22 with 23–24 (Claims App.), which have been addressed (Final Act. 6; Ans. 3–5). Even more, the Examiner states that using “the same rationale,” the additional limitations in claims 2 through 16 are directed to an abstract idea and “not significantly more.” Ans. 5. Appellant does not rebut these findings in the Reply Brief. *See generally* Reply Br.

For the foregoing reasons, Appellant has not persuaded us of error in the rejection of claims 2–16.

THE OBVIOUSNESS REJECTION OVER SCHOENBAUM,
BARBER, AND JOHNSON

Regarding independent claim 1, the Examiner finds Schoenbaum teaches many of its limitations. Final Act. 7–8. The Examiner turns to Barber to teach the recited “abstracting” steps and, more particularly, to teach known central processing systems that take information from a physician and reformat the information into a claim for an insurance carrier. Final Act. 8. The Examiner proposes “combining prior art elements according to known methods to yield predictable results” “with the motivation of improving processing of medical insurance claims information.” Final Act. 8 (citing Barber 1:8–9, 55, 3:43–54). The Examiner further turns to Johnson to teach the recitations of subsets of patient data and proposes combining this teaching with Schoenbaum and Barber. Final Act. 9.

Among other arguments, Appellant argues the Examiner improperly relies on impermissible hindsight in combining Schoenbaum and Barber. Appeal Br. 14–15. Appellant further fails to see how combining the references as proposed improves the processing of medical insurance claims information, which concerns Barber and not Schoenbaum. *See* Appeal Br. 15.

ISSUE

Is the Examiner’s articulated reason to combine Schoenbaum and Barber supported by some rational underpinning to justify the conclusion that “abstracting . . . first medical information included with at least one medical reimbursement claim, . . . the abstracting includes converting the first medical information by at least one adaptor from one or more formats to one or more second formats” would have been obvious?

ANALYSIS

Based on the record, we are persuaded by Appellant’s contentions. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) states “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. For example, “when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *Id.* at 417 (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)).

KSR further states “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (*KSR*, 550 U.S. at 418 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)), although the reason to combine need not be explicit and can “take account of inferences creative steps that a person of ordinary skill in the art would employ” (*Id.*). *See also* Final Act. 14 (stating “there is no requirement that the motivation to make the proposed modification must be expressly articulated within the references themselves”). When using the

reasoning of applying a known technique to a known method ready for improvement to yield predictable results, the Manual of Patent Examining and Procedure (MPEP) indicates the rational underpinning to support this obviousness conclusion is that the particular known technique “was recognized as part of the ordinary capabilities of one skilled in the art.” MPEP § 2143(I)(D) (9th ed., Rev. 08.2017 January 2018).

Turning to the rejection, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Schoenbaum with Barber with the motivation of improving processing of medical insurance claims information (Barber, column 1, lines 8-9, 55) and combining prior art elements according to known methods to yield predictable results.

Final Act. 8, *quoted in* Appeal Br. 15. The Examiner further addresses that “Barber discloses a central processing system taking information transmitted from a remote physician terminal and reformatting it into a claim for an insurance carrier.” Final Act. 8 (citing Barber 3:43–54). When taken collectively, the Examiner’s articulated reasoning appears to be that Barber’s known technique of reformatting claim information for an insurance carrier would have been recognized to be within an ordinary skilled artisan’s capabilities and thus, when combined with Schoenbaum, would yield the predictable result of the “abstracting” step and, more particularly, the “converting” step recited in claim 1. *See* Final Act. 8.

We find the rejection as proposed problematic. The reason provided to combine Barber’s teaching with Schoenbaum—to reformat *claim information for an insurance carrier*—has not been explained sufficiently to relate to Schoenbaum’s known process. That is, Schoenbaum teaches a method for assisting a user in selecting a health insurance plan, involving

obtaining medical and non-medical information related to a particular user. Schoenbaum ¶¶ 8, 39, 45, 136, 139–46, 174, Figs. 5, 17–18, claim 6, *cited in* Final Act. 7–8. Schoenbaum’s process includes obtaining medical condition information from a user in order to assist in choosing a medical plan. Schoenbaum ¶ 136, Fig. 5, *cited in* Final Act. 7. But the Examiner does not articulate Schoenbaum’s process of selecting a healthcare plan involves collecting claim information from insurance carriers, such that applying Barber’s teaching to reformat such information for an insurance carrier (Barber 3:43–54, *cited in* Final Act. 8) would have been obvious to one skilled in the art. Appellant similarly fails to see how combining the references as proposed improves the processing of medical insurance claims. *See* Appeal Br. 15. The Examiner does not elaborate on his reasoning or respond to Appellant’s contention in the Answer. Ans. 7–8 (addressing only how Barber is analogous art).

Also, the provided reason to include Barber’s teaching in Schoenbaum’s process “of improving processing of medical insurance claims information (Barber, column 1, lines 8-9, 55)” (Final Act. 8) is ambiguous. To the extent the Examiner is taking the position that applying Barber’s discussion provides a general teaching to reformat data,⁶ including Schoenbaum’s data, to “improv[e] processing of medical . . . information” (Final Act. 8), such an adequate explanation of this teaching has not been provided on the record or sufficiently tied to Schoenbaum’s Health Cost

⁶ *See* Barber 3:51–55 (discussing reformatting into the appropriate format), 7:66–8:1 (same). According to the Specification, medical claims may be submitted from various service providers in different formats. The system converts claim information from providers into an appropriate format to assist with “proper interfacing between systems.” Spec. ¶ 19, Fig. 1.

Calculator (HCC) process. Moreover, column 1, line 55 of Barber describe improving a “computerized financial transaction system” but there is insufficient discussion on how this financial transaction system relates to improving the processing medical information.

Given the above-noted gaps between the prior art and claim 1’s method, the record does not explain adequately why one skilled in the art would have recognized applying Barber’s teaching to Schoenbaum to predictably yield the recited “first medical information included with at least one medical reimbursement claim” that is abstracted, including “converting first medical information . . . from one or more formats to one or more second formats” as recited in claim 1.⁷

Lastly, we agree with Appellant that the rejection as proposed does not rely on Johnson to cure the above-noted deficiency. Appeal Br. 17; *see also* Final Act. 9.

For the foregoing reasons, Appellant has persuaded us of error in the rejection of (1) independent claim 1, (2) independent claim 9, which recites commensurate limitations, and (3) dependent claims 2 and 10 for similar reasons.

⁷ There are various passages in Schoenbaum discussing obtaining claim data on a reference population as part of the HCC, which assists in comparing alternative health insurance choices. Schoenbaum ¶¶ 44, 46–47, 137. Such findings along with a sufficiently, articulated reason to combine Barber’s teachings with Schoenbaum to arrive at the claim 1’s invention is not before us.

THE OBVIOUSNESS REJECTION OVER SCHOENBAUM,
BARBER, JOHNSON, AND LASH

Claims 3–5 and 11–13 are rejected under § 103 based on Schoenbaum, Barber, Johnson, and Lash. Final Act. 9–11. Claims 3–5 depends directly or indirectly from claim 1; claims 11–13 depend directly or indirectly from claim 9. Above, we determined the rejection did not adequately explained how Schoenbaum, Barber, and Johnson teach or suggest certain, disputed limitations. Lash is not relied upon to cure the above-noted deficiencies in the references. Final Act. 9–11. We therefore do not sustain the rejection of claims 3–5 and 11–13.

THE REMAINING OBVIOUSNESS REJECTIONS

Claims 6 and 14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Schoenbaum, Barber, Johnson, and Kalies. Final Act. 11–12. Claims 7, 8, 15, and 16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Schoenbaum, Barber, Johnson, and Ullman. Final Act. 12–13. Claims 6–8 depend from claim 1; claims 14–16 depend from claim 9.

As for these remaining rejections, the Examiner does not rely on Kalies or Ullman to teach the deficiencies in the previously discussed references. Final Act. 11–13. For the foregoing reasons, Appellant has persuaded us of error in the rejection of claims 6–8 and 14–16.

DECISION

We affirm the Examiner’s rejection of claims 1–16 under 35 U.S.C. § 101.

Appeal 2017-000451
Application 14/269,316

We reverse the Examiner's rejections of claims 1–16 under 35 U.S.C. § 103(a).

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is 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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED