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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM PAN

Appeal 2017-000500
Application 12/285,839¹
Technology Center 3600

Before BRUCE T. WIEDER, AMEE A. SHAH, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner’s rejection of claims 1, 4, 7, 10, and 15. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Appellant’s claimed “invention relates to a method and a system for configuring a variety of medical information, and in particular to a method and a system for converting a variety of medical information into a

¹ According to Appellant, the real party in interest is EBM Technologies, Incorporated. (Appeal Br. 1.)

searchable format document by a configuration profile.” (Spec. 1, ll. 11–14.)

Claims 1 and 10 are the independent claims on appeal. Claim 1 is illustrative. It recites:

1. A method for configuring a variety of medical information, comprising:

identifying a plurality of file formats in each of a plurality of medical information documents, which is selected from a rich-text file, a spreadsheet/chart file, and a graphics file, or in combination in a document input unit, wherein the medical information documents are retrieved from a database;

retrieving data from the medical information documents having a correspondence with a predetermined configuration rule via a data retrieving unit, each of which corresponds to at least one of the file formats specified in the medical information documents;

extracting the medical information associated with the retrieved data having an identification of a patient, a textual diagnosis of the patient, and graphical information of the patient from the medical information documents based on the configuration rule applied to the data in a context extracting unit; and obtaining at least an index file, a text file and an image file for the extracted medical information, wherein the at least three files are separately stored in at least three different spaces;

assembling via a processor the index file, the text file and the image file, and the at least three separate files are each associated with the data extracted from medical information by the index file which points to the each space for the corresponding file; the index file including extracted text based patient identification data, the text file including text based medical data and text extracted from non-text based medical data, and the image file including images of the text based patient identification data, text based medical data and both the text and images from the non-text based medical data; and

separately storing the at least three files in the at least three different spaces; wherein the assembly of the at least three files are provided for a physician to review a single merged document

of the extracted medical data corresponding to the configuration rule using single software application, in order to obtain common textual medical data irrespective of the file format of the documents from which the data was retrieved.

REJECTIONS²

Claims 1, 4, 7, 10, and 15 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1, 4, and 10 are rejected under 35 U.S.C. § 103(a) as unpatentable in view of Cullen (US 6,397,213 B1, iss. May 28, 2002), Johnson (US 5,664,109, iss. Sept. 2, 1997), and Ingle (US 6,938,206 B2, iss. Aug. 30, 2005).

Claims 7 and 15 are rejected under 35 U.S.C. § 103(a) as unpatentable in view of Cullen, Johnson, Ingle, and Davis (US 2008/0228522 A1, pub. Sept. 18, 2008).

ANALYSIS

The § 101 rejection

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. Section 101, however, “contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v.*

² The rejection of claims 1, 4, 7, 10, and 15 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement, was withdrawn. (Answer 2–3.)

CLS Bank Int'l, 134 S. Ct. 2347, 2354 (2014) (quoting *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

Alice applies a two-step framework, earlier set out in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355.

Under the two-step framework, it must first be determined if “the claims at issue are directed to a patent-ineligible concept.” *Id.* If the claims are determined to be directed to a patent-ineligible concept, then the second step of the framework is applied to determine if “the elements of the claim . . . contain[] an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Id.* at 2357 (citing *Mayo*, 566 U.S. at 72–73, 79).

Under step one of the *Alice* framework, we “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) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)).

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 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).

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

Although usually done in a single step, one first determines to what the claims are directed, and then whether to what they are directed is an abstract idea.

Here, the Examiner determines that the claims are directed to “combining common format data into a single data file.” (Non-Final Action 2.)

Appellant disagrees and argues that “[t]he medical information which is input into the system in different formats is transformed into separate files each file containing respectively formatted data, which are further accessed to form an output aggregated document which may be formed irrespective of the formats of the inputted medical information documents.” (Appeal Br. 16.)

Claim 1 recites “[a] method for configuring a variety of . . . information, comprising: identifying a plurality of files formats in each of a plurality of . . . documents,” “retrieving data from the . . . documents,” “extracting the . . . information associated with the retrieved data,” “and obtaining at least an index file, a text file and an image file for the extracted . . . information,” “assembling . . . the index file, the text file and the image file,” “and separately storing the at least three files.” Although claim 1 also recites “wherein the assembly of the at least three files are [sic] provided for a physician to review a single merged document,” this is merely an intended use for the three files. In short, claim 1 does not combine common format data into a single file.

The Examiner's subsequent analyses of whether the claims are directed to an abstract idea, and the patent-eligibility question itself, proceed from this flawed determination of to what the claims are directed.

In view of the above, we find that the Examiner does not sufficiently establish that the claims are directed to an abstract idea as required under step one of the *Alice* framework. *See Alice*, 134 S. Ct. at 2355. Therefore, we will reverse the rejection of claim 1 under § 101. Independent claim 10 contains similar language, and for similar reasons we will reverse the rejection of claim 10 and dependent claims 4, 7, and 15 under § 101.

The § 103(a) rejection of claims 1, 4, and 10

Appellant argues that

the summary document produced in the cited art is not identical to the initial (original) content, i.e., the initial content of the original documents in the prior art is changed during the process. In contrast to the cited prior references, in the present invention the original (source) files are not modified

(Appeal Br. 42.)

We agree with the Examiner that “[t]here is no language in the claims that restricts the modification of the original files during the medical information processing [or] that the summary document must be identical to the original content.” (Answer 6.) Nor does Appellant point to such claim language. (*See* Appeal Br. 42.) Therefore, we do not find this argument persuasive of error.

Appellant also argues that “the claimed concept including the formation of the separate files (each in a respective format) stored at different memory spaces for being subsequently aggregated, using a single

software, into a document displayed for the physician's review - is not provided in the cited Prior Art references, solely or in combination." (*Id.*, emphasis omitted.)

The Examiner finds that Cullen teaches creating the image of a document where the "image contains data contained within the document and is saved into [a] database (Fig. 3, col. 6, lines 56-61)." (Answer 7.) The Examiner also finds that Johnson teaches

extracting textual data items from medical records where a document's type and source are identified . . . (col. 9, lines 16-35). Johnson also teaches . . . receiving text data files and extracting information from each file type (col. 6, lines 44-62). Information from the text data files are [sic] extracted and saved in a database. . . . Johnson further teaches . . . assembling the extracted textual medical information and patient identification information into separate documents (col. 10, lines 21-29)

(*Id.* at 7–8.) The Examiner also finds Ingle discloses "generating a merged report containing the extracted medical data using a text based software application (abstract, col. 4, lines 34-42.);" (Answer 8.) Further, the Examiner determines that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to combine the aforementioned features in Ingle with Cullen and Johnson based on the motivation of generating a medical summary document from source files that have been reviewed, edited, and attested to minimize to [sic] amount of human intervention required (Ingle – col. 4, lines 12-15.);" (*Id.* at 8–9.) Appellant does not persuasively argue why the Examiner's findings and determination are in error. Therefore, we do not find this argument persuasive of error.

Appellant also argues that, unlike the prior art, “[t]he medical-related three separate files in [the claimed] arrangement are not allowed to be accessed separately prior to their assembly.” (Appeal Br. 42.)

We agree with the Examiner that “[t]here is no language in the claims that restricts access to the individual data files prior to aggregation.”

(Answer 9.) Nor does Appellant point to such claim language. (*See* Appeal Br. 42–43.) Therefore, we do not find this argument persuasive of error.

Appellant also argues “that the cited prior art systems produce the final reports in a format of a number of individual documents such as separate Word, Excel, PDF, and/or Image file in different formats.” (Appeal Br. 44.) The invention, Appellant argues, “in contrast to a number of individual files, combines the index, text and image files into a single aggregated (or merged) document which is reviewed by a ‘single software’.” (*Id.*)

The Examiner answers that

Ingle teaches . . . generating a merged report containing the extracted medical data using a text based software application (abstract, col. 4, lines 34-42). . . . Therefore, the combination of Cullen, Johnson, and Ingle teach . . . “a physician to review a single merged document of the extracted medical data using only one of a single [software] application

(Answer 10.) Appellant does not persuasively argue why the Examiner’s findings and determination are in error. Therefore, we do not find this argument persuasive of error.

Appellant also argues that “Ingle requires the physician to make signature that appears to change the [original] content, which is different from the claimed invention which does not modify the original content.” (Appeal Br. 45.)

As discussed above, we see no language in the claims that restricts the modification of the original files. Nor does Appellant point to such claim language. (*See* Appeal Br. 44–45.) Therefore, we do not find this argument persuasive of error.

In view of the above, we are not persuaded that the Examiner erred in rejecting claim 1 under § 103(a). Claim 4 depends from claim 1 and Appellant relies on the arguments presented with regard to claim 1. (*See id.* at 45.) Independent claim 10 contain language similar to that of claim 1 and Appellant relies on the arguments presented with regard to claim 1. (*See id.* at 46.) For the reasons discussed above, we are not persuaded that the Examiner erred in rejecting claims 4 and 10 under § 103(a).

The § 103(a) rejection of claims 7 and 15

Claim 7 recites: “The method of claim 1, wherein the extracted medical information includes an Id [sic], and a patient’s first name, last name and Gender.”

Appellant argues that Davis was cited “for teaching providing data mining results to a user via a user interface, and classifying the data mining results to a specific patient including the patient’s first and last name, ID number, and gender – these features missing from Cullen in view of Johnson and in view of Ingle.” (Appeal Br. 47.) Appellant further argues that Davis does not cure the asserted deficiencies in Cullen, Johnson, and Ingle. (*Id.*) Rather, Appellant argues, “Davis merely teaches data mining by accessing a plurality of data sources to retrieve data related to the patient . . . [and] Davis does not address the assemblage of at least three separate files.” (*Id.*)

The Examiner finds, and we agree, that Davis discloses “providing data mining results to a user via a user interface (para. 49). Davis further teaches . . . classifying the data mining results to a specific patient including the patient’s first and last name, ID number, and gender (Fig. 3, 305)(para. 49).” (Non-Final Action 9.) Additionally, we note that the Examiner does not rely on Davis for teaching assembling the index, text, and image files. Rather, the Examiner relies on Cullen and Johnson for this teaching. (*See id.* at 6.)

In view of the above, we are not persuaded that the Examiner erred in rejecting claim 7 under § 103(a). Claim 15, which depends from claim 10, contains language similar to that of claim 7, and Appellant does not present additional arguments. (*See id.* at 48.) Therefore, for the reasons discussed above, we are not persuaded that the Examiner erred in rejecting claim 15 under § 103(a).

DECISION

The Examiner’s rejection of claims 1, 4, 7, 10, and 15 under 35 U.S.C. § 101 is reversed.

The Examiner’s rejections of claims 1, 4, 7, 10, and 15 under 35 U.S.C. § 103(a) 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