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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHEW JOSEPH LOSCALZO, KAREN LYNN CLARK,
JEFFREY BERTRUM DILLEHUNT, RAYMOND LAWRENCE
STROWBRIDGE, DANIEL PAUAHI SMITH, and
REDMOND HOCHOY RINEHART

Appeal 2017-008677
Application 13/117,733¹
Technology Center 3600

Before CAROLYN D. THOMAS, NABEEL U. KHAN, and
MICHAEL M. BARRY, *Administrative Patent Judges*.

KHAN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1–23. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify City of Hope as the real party in interest. App. Br. 1.

BACKGROUND

THE INVENTION

According to Appellants, the invention relates generally to “systems, apparatuses and methods for identifying, analyzing, recording and taking actions through a patient screening system.” Spec. ¶ 3. “Patients can be provided with a personal interactive device for surveying patient information . . . which is analyzed and transmitted in real-time to make patient care decisions.” Spec. ¶ 3.

Exemplary independent claim 1 is reproduced below.

1. An individual screening and triage system comprising:
a patient interactive device;
an administrative server;

a data network operatively connected to at least the patient interactive device and the administrative server, wherein issues, prompts, and possible user selectable responses are directed from the administrative server over the data network to the patient interactive device and user selected responses are received at the administrative server from the patient interactive device; and

a triage module;

wherein the patient interactive device presents the issues, related possible prompts, and selectable responses to a user of the patient interactive device and transmits the user’s one or more selected responses over the data network;

wherein the transmitted user responses consist of the user’s one or more user selected responses;

wherein the administrative server receives the transmitted data and information for storage into a patient record; and

wherein the triage module is configured to compare a user’s response data and information with a set of triage rules and, if the response triggers a triage message, automatically

generate and transmit a patient triage alert to a communication device of a particular member of the user's care team.

REFERENCES AND REJECTIONS

1. Claims 1–23 stand rejected under 35 U.S.C. § 101. Final Act. 9–11.
2. Claims 1–4, 6, 9, 10, 12, 15, 16, 20,² and 23 stand rejected under 35 U.S.C. § 102(b) as anticipated by Hunkeler (US 2005/0283385 A1; published Dec. 22, 2005). Final Act. 11–23.
3. Claims 5, 11, and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hunkeler and Pristine (US 2004/0138924 A1; published July 15, 2004). Final Act. 23–24.
4. Claims 7, 13, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hunkeler and Kaplin (US 2011/0231208 A1; published Sept. 22, 2011). Final Act. 24–26.
5. Claims 8, 14, and 19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hunkeler and Cervi (US 2007/0185736 A1; published Aug. 9, 2007). Final Act. 26–30.
6. Claim 21 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Hunkeler and Machin (US 6,877,034 B1; published Apr. 5, 2005). Final Act. 30–31.

² We note that claim 20 is not listed in the header of the rejection of claims under 35 U.S.C. § 102, but the Examiner nonetheless addresses claim 20 under this section and in the Response to Arguments. Final Act. 7–8 and 17. Thus, we treat claim 20 as rejected as anticipated by Hunkeler.

7. Claim 22 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Hunkeler and Huyn (US 2002/0035486 A1; published Mar. 21, 2002). Final Act. 31–32.

DISCUSSION

REJECTION UNDER 35 U.S.C. § 101

Relevant Law

To determine whether claims are patent eligible under § 101, we apply the Supreme Court’s two-step framework articulated in *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208 (2014). First, we determine whether the claims are directed to a patent-ineligible concept: laws of nature, natural phenomena, and abstract ideas. *Id.* at 216–18. If so, we then proceed to the second step to consider the elements of the claims “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.” *Id.* at 217. In other words, the second step is to “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.’” *Id.* at 217–18.

The PTO has recently synthesized, for purposes of clarity, predictability, and consistency, key concepts identified by the courts as abstract ideas to explain that the “abstract idea” exception includes the following three groupings:

- (a) Mathematical concepts—mathematical relationships, mathematical formulas or equations, mathematical calculations;[]
- (b) Certain methods of organizing human activity—fundamental economic principles or practices (including

hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions);[] and

(c) Mental processes— concepts performed in the human mind[] (including an observation, evaluation, judgment, opinion).

See 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50, 52 (Jan. 7, 2019) (“USPTO § 101 Memorandum”). According to the USPTO § 101 Memorandum, “[c]laims that do not recite [subject] matter that falls within these enumerated groupings of abstract ideas should not be treated as reciting abstract ideas,” except in rare circumstances. *Id.* at 53. Even if the claims recite any one of these three groupings of abstract ideas, these claims are still not “directed to” a judicial exception (abstract idea) and, thus, are “patent-eligible” if “the claim as a whole integrates the recited judicial exception into a practical application of that exception.” *Id.* “[I]ntegration into a practical application” requires an additional element or a combination of additional elements in the claim to apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the exception. *Id.* at 54–55.

For example, limitations that are indicative of “integration into a practical application” include:

- (1) Improvements to the functioning of a computer, or to any other technology or technical field – *see* MPEP § 2106.05(a);
- (2) Applying the judicial exception with, or by use of, a particular machine – *see* MPEP § 2106.05(b);

- (3) Effecting a transformation or reduction of a particular article to a different state or thing – *see* MPEP § 2106.05(c); and
- (4) Applying or using the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception – *see* MPEP § 2106.05(e).

In contrast, limitations that are not indicative of “integration into a practical application” include:

- (1) Adding the words “apply it” (or an equivalent) with the judicial exception, or mere instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea – *see* MPEP § 2106.05(f);
- (2) Adding insignificant extra-solution activity to the judicial exception – *see* MPEP § 2106.05(g); and
- (3) Generally linking the use of the judicial exception to a particular technological environment or field of use – *see* MPEP § 2106.05(h).

See USPTO § 101 Memorandum, 84 Fed. Reg. at 54–55 (“Prong Two”).

When a claim recites a judicial exception and does not integrate that exception into a practical application, we then look to whether the claim:

Adds a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field, which is indicative that an inventive concept may be present; or simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception, which is indicative that an inventive concept may not be present.

USPTO § 101 Memorandum, 84 Fed. Reg. at 56.

USPTO Memorandum Step 2A

In rejecting claims 1–23, the Examiner finds the claims are “directed to providing questions to a patient and determining whether to notify a

caregiver of the results, which constitutes a basic method of organizing human activity and thus an abstract idea.” Final Act. 9. Analyzing the claims, the Examiner notes that they involve the steps of “storing a set of questions and possible responses for different issues, sending at least one question and possible response to a patient, receiving a selection of a response from the patient, and notifying a caregiver if the response satisfies a rule.” Final Act. 10; *see also* Ans. 25–26. As such, the Examiner analogizes the claims to those in *SmartGene, Inc. v. Advanced Biological Labs.*, 555 F. App’x 950 (Fed. Cir. 2014) and finds that they involve “the concept of comparing new and stored information and using rules to identify options.” Ans. 27. Similarly, the Examiner finds the claims involve “collecting information, analyzing it, and displaying certain results of the collection and analysis” and thus would be deemed patent ineligible under *Electric Power Group, LLC, v. Alstom*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). Ans. 27–28.

Appellants argue that “not a single one of the pending claims recite any of these four elements; so it can hardly be concluded that claims 1–23 are directed to an abstract idea based on these four elements. This misstatement of the claim language is clear error and is sufficient to reverse the rejection under § 101 on this basis alone.” App. Br. 8. Thus, Appellants argue the Examiner has mischaracterized the claims with an incorrectly asserted abstract idea. App. Br. 8–9; *see also* Reply Br. 2–3.

Appellants also take issue with the Examiner’s reliance on *SmartGene* and *Electric Power Group*. For example, Appellants argue “that the detailed, interrelated elements of the pending claims bear absolutely no resemblance to the claims of the *SmartGene* patents, and that the

conclusions of that case correspondingly are unrelated to the patent eligibility of the pending claims herein.” Reply Br. 5. Similarly, Appellants argue the claims in *Electric Power Group* are directed to “abstract ideas of a mental process and mathematical processes” whereas the present claims “include specific devices, a network, specific related prompts and responses, and triage rules -- all directed within an individual screening and triage system and method for addressing a particular problem identified in the specification.” Reply Br. 5

Instead, Appellants analogize the pending claims to those in *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299, 1313 (Fed. Cir. 2016), which, according to Appellants involved “the use of rules, rather than artists” to improve the claimed invention over the prior art. Similarly, Appellants argue the pending claims “recite comparing a user’s response information with a set of triage rules and, in response, triggering a specific action.” Further, Appellants allege

[b]y expressly guiding the patient through the screening process and automatically comparing the patient responses to a set of triage rules for determining an alert or action, the disclosed and claimed systems and methods provide for the very same, specific improvement in computer functionality that was found patent eligible in both *McRO* . . . and *Enfish*

Reply Br. 6.

We agree with the Examiner that claim 1 recites a judicial exception in the form of certain methods of organizing human activity, and specifically, here, the claims recite limitations for “managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions)” as set out in the USPTO § 101 Memorandum at 52. In particular, the claimed invention

manages interactions between a patient and the patient's care team by providing questions and possible responses sent on behalf of the care team to the patient and then prescribing a set of rules to follow when the responses are received. For example, claim 1 recites a patient device and a server where the server transmits to the patient device certain questions and possible responses. The patient enters a selection from the possible responses into the patient device which then transmits the responses back to the server for storage and analysis. A set of triage rules determines whether the patient's responses require an alert to be sent to the patient's care team.

We find that the claims do not integrate the judicial exception into a practical application at least because the claims do not recite (i) any additional elements of the claims reflects an improvement in the functioning of a computer or to another technological field, (ii) an application of the judicial exception with, or by use of, a particular machine, (iii) a transformation or reduction of a particular article to a different state or thing (iv) or a use of the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment. Specifically, the claims do not improve the functioning of either the patient interactive device or the claimed server. Appellants' argument that the claimed triage rules, like the rules in *McRO*, improve the technological process or computer functionality, is not persuasive. The rules in *McRO* were "rendered in a specific way: as a relationship between sub-sequences of phonemes, timing, and the weight to which each phoneme is expressed visually at a particular timing" *McRO*, 837 F.3d at 1315. It was the "structure of the limited rules" that were "limited to a specific process for automatically animating characters

using particular information and techniques” that led the Federal Circuit to conclude that the claims were “directed to a patentable, technological improvement.” *McRO*, 837 F.3d at 1316. Here, claim 1 itself says very little about the triage rules other than to indicate that they are used to determine whether a message should be sent to a member of the patient’s health care team. The claim does not limit or even describe the triage rules in any detail and, thus, cannot be said to limit the rules in a way that improves technology. We, therefore, find Appellants’ argument unpersuasive.

USPTO Memorandum Step 2B

The Examiner finds “[t]he claims do not include additional elements that are sufficient to amount to more than the judicial exception because generically recited computer elements (e.g. databases, servers, processors, etc.) do not add a meaningful limitation since these would be routine in any computer implementation.” Final act. 10. The Examiner supports this finding by citing to paragraphs 37 and 38 of the Specification which describe the patient interactive device as an “Apple iPad or Panasonic Toughbook” or other touch screen device. Similarly, the description of the server and network indicates that these elements are used in their standard and well known ways. Spec. ¶ 38. Appellants “agree that generic computer and network components are disclosed in the specification and are included in the claims.” Reply Br. 6–7.

The Examiner’s findings satisfy step 2B of the USPTO § 101 Memorandum guidelines. Accordingly, we sustain the Examiner’s rejection of the claims under 35 U.S.C. § 101.

REJECTION UNDER 35 U.S.C. § 102

Claim 1

Appellants argue that the claimed system transmits “only the selected responses or indications or data representing only the patient’s selected responses. . . . Only the responses selected by the patient or indications or data representing only the patient’s selected responses are transmitted.” App. Br. 12–13. According to Appellants, Hunkeler “instead provides for a conventional open format for the patient to enter patient-drafted information to be sent to the individualized healthcare system of Hunkeler.” App. Br. 13. Appellants further argue that “Hunkeler disclose a system that transmits both selected responses and user drafted narrative.” App. Br. 13.

The Examiner finds Hunkeler discloses the claimed limitations by describing a system that transmits prompts and responses to a user and allows the user to enter predetermined selectable responses. Final Act. 11–12 (citing Hunkeler ¶¶ 38, 41, 44, 45, 50, 52, Figures 4–7). The fact that Hunkeler also describes that the user has the option of also entering patient drafted responses in addition to the predetermined responses, does not require the user to do so. Ans. 30. We agree with the Examiner. Hunkeler discloses a system that provides prompts and questions to the user along with predetermined responses. *See* Hunkeler, Fig. 4. In addition to questions with predetermined responses, Hunkeler may also transmit questions with open-ended responses. Hunkeler, Fig. 4 (illustrating text boxes where the patient can enter other symptoms not listed elsewhere). However, Hunkeler does not require the patient to enter additional symptoms, for example, if no other symptoms exist. Hunkeler ¶ 50 (“The patient *may* add other symptoms that are not listed in the predefined list of

symptoms to personalize his profile” (emphasis added)). Thus, even if the claim were to be construed as precluding open-ended user responses being transmitted to the server, Hunkeler still discloses that such would be the case.

Appellants also argue that Hunkeler’s Figure 5 indicates that a nurse reviews the patient’s answers which, according to Appellants, is contrary to the automated system of claim 1. We are not persuaded by Appellants’ arguments. Figure 5 of Hunkeler indicates that the patient’s responses will be available to a nurse and that the nurse can review the answers with the patient at their next contact. This does not contradict the Examiner’s finding that Hunkeler automatically sends triage alerts based on the patient’s answers. Ans. 31 (citing Hunkeler ¶¶ 38, 54, and 64).

Accordingly, we sustain the Examiner’s rejection of claim 1 under 35 U.S.C. § 102, and for the same reasons, we sustain the rejections of independent claims 4, 10, and 16, for which Appellants make the same arguments.

Claim 2

Claim 2 depends from claim 1 and recites “wherein the user can comprise a patient, a family member of a patient, a member of a patient’s health care team, or a member of a patient’s caregiving team.” Appellants argue that Hunkeler

merely describe[s] who can participate in Hunkeler’s eCare and care system. However, none of the cited paragraphs disclose any of the ‘user’ persons recited in claim 2 making selected responses on a patient interactive device based on presented issues, related possible prompts, and selectable responses, as recited in claim 1, from which claim 2 depends.

App. Br. 23.

We disagree for the reasons stated in our analysis of claim 1. The Examiner finds Hunkeler discloses a patient making selected responses based on presented issues, prompts, and selected responses. Final Act. 11–13 (citing Hunkeler ¶¶ 38, 41, 44, 45, 50, 52, Figures 4–7).

Accordingly, we sustain the Examiner’s rejection of claim 2.

Claim 3

Claim 3 depends from claim 1 and recites “wherein a message is automatically generated and transmitted to at least one member of the user’s caregiving team if an action was not completely performed.” The Examiner finds Hunkeler discloses this limitation by “reminding a patient to refill a medication and sending a message to the provider if the patient does not refill the medication.” Final Act. 14 (citing Hunkeler ¶ 54) (emphasis omitted). Appellants argue that “failure to receive a confirmation from the patient is not the same feature as a recommended action not being completely performed.” App. Br. 24.

We are unpersuaded by Appellants’ argument. Instead, we agree with the Examiner that a patient not confirming that a prescription has been refilled discloses a recommended action not being completely performed. Further, Appellants do not provide persuasive evidence or reasoning that failure to receive confirmation from a patient about refilling a prescription does not disclose a recommended action not being completely performed.

Accordingly, we sustain the Examiner’s rejection of claim 3 and claims 9, 15, and 20, which were argued together with claim 3.

Claim 6

Claim 6 depends from claim 4 and recites “wherein the patient interactive device comprises a touch screen computer.” The Examiner finds Hunkeler discloses this limitation by describing that the patient devices include PDAs and tablets. Final Act. 17 (citing Hunkeler ¶ 46). Appellants argue “the cited portion of Hunkeler is silent regarding a touch screen computer.” App. Br. 24. We are unpersuaded by Appellants’ argument. In considering the disclosure of a reference for anticipation, it is proper to take into account not only specific teachings of the reference but also the inferences that one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826 (CCPA 1968). We agree with the Examiner’s finding that Hunkeler’s disclosure of a patient interactive device in the form of a tablet or PDA would disclose to the ordinary artisan a touch screen computer.

Claim 23

Claim 16 recites “triaging, wherein triaging comprises . . . performing at least one of the following: (1) electronically generating and transmitting a triage message . . . to a communication device of a member of the patient’s professional health care team . . . and (2) electronically generating and transmitting a triage message to a communication device of a specific member of the patient’s professional health care team” Claim 23 depends from claim 16 and recites “the specific member of the patient’s professional health care team is determined based on the patient’s responses.”

The Examiner interprets claim 16 as requiring only one of the above two actions, i.e. either (1) transmitting a triage message to a member of the

patient's health care team *or* (2) transmitting a triage message to a *specific* member of the patient's health care team. Because dependent claim 23 recites limitations that further limit only the second of the two actions of claim 16, and the Examiner's interpretation of claim 16 does not require the second action to be performed if the first action is performed, the Examiner ultimately finds that the limitations of claim 23 also are not required to be performed. Final Act. 22. The Examiner, thus, does not provide any findings regarding claim 23.

Appellants take issue with the Examiner's interpretation and argue that the reference must actually disclose claim 23's limitation in order to anticipate claim 23.

We are unpersuaded by Appellants' arguments. We agree with the Examiner's interpretation of claim 16 requiring only one of the two actions being performed. In this case, the Examiner finds Hunkeler discloses the first of the two actions. Final Act. 21. The Examiner has, therefore, provided a *prima facie* case of obviousness of claim 16 without having to address the second action. Claim 23 depends from claim 16 and limits only the second action of claim 16. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." 35 U.S.C. § 112(d). Because claim 23 limits only the second action of claim 16, and incorporates all the limitations of claim 16, the Examiner's rejection of claim 16 necessarily also addresses claim 23. In other words, if claim 23 were written in independent form, the Examiner's findings regarding the first action would suffice in providing a *prima facie* case of anticipation of the claim.

Accordingly, we sustain the Examiner's rejection of claim 23.

REJECTION UNDER 35 U.S.C. § 103

Claim 5

Claim 5 depends from claim 4 and recites “wherein the triage module is further configured to generate and transmit a summary report of the patient’s response record to one or more of the communication device and a printer.”

Appellants argue “the cited portion of Pristine merely discloses that the patient’s summary report is printed in the selected treatment room. Both Hunkeler and Pristine are silent regarding the claimed feature of transmitting the report to one or more communication devices.” App. Br. 26. Appellants also argue that because Hunkeler discloses allowing for the patient to print a copy of his or her action plan, but does not explicitly disclose printing of the patient summary report, the Examiner “has articulated no reason why that skilled artisan would add report print capabilities over and above those already provided within the Hunkeler system.” App. Br. 28.

We are unpersuaded by Appellants’ arguments. Pristine discloses that “an operator . . . of server 58 can . . . cause report 414 to be output at the printer 82 corresponding to that selected treatment room.” Pristine ¶ 58. One of ordinary skill would have understood that in order for the report to be printed in a selected treatment room, it must be transmitted to the printer in that room. Thus, we find no error in the Examiner’s finding that Pristine’s aforementioned teaching combined with Hunkeler’s teaching of transmitting the report to a communication device of a member of the patient’s health care team, teaches the limitations of claim 5.

We also find unpersuasive Appellants’ argument that Hunkeler and Pristine cannot be properly combined. The fact that Hunkeler teaches

printing an action plan does not preclude combining Hunkeler with a reference that teaches printing the patient report as well. Indeed, as the Examiner finds, Hunkeler's printing of the action plan bolsters the Examiner's combination by suggesting to one of ordinary skill that the patient summary report could also be printed. Ans. 35.

Accordingly, we sustain the Examiner's rejection of claim 5 and of claims 11 and 17, which were argued together with claim 5.

Claim 7

Claim 7 depends from claim 4 and recites "wherein an issue can further comprise a triage threshold and identify a triage alert professional, wherein the triage message is transmitted to a communication device of the identified triage alert professional when a patient response to an issue matches or exceeds the triage threshold associated with the issue."

Appellants argue "[w]hile the cited portion of Kapl[i]n discloses a mechanism to automatically notify care providers if the patient response triggers a threshold value, the reference fails to disclose how any such a notification takes place." App. Br. 29. Based on this allegation, Appellants argue Kaplin fails to enable one of ordinary skill in the art to make the invention. Appellants also take issue with the Examiner's reason to combine Hunkeler with Kaplin, arguing that Hunkeler already discloses sending an alert to a provider for reasons other and thus, "the person of ordinary skill in possession of the Hunkeler reference knew about transmitting messages to care providers and would have no reason to add any communication features recited in claims 7, 13, and 18 from the Kaplin reference." App. Br. 30.

We disagree with Appellants' arguments. The Examiner finds Kaplin teaches the alert notification is sent by email, thus, Kaplin does teach how

the notification is sent to the health care professional. We also disagree with Appellants' argument regarding the Examiner's reason to combine and instead agree with the Examiner that "the fact that an element was known at the time of a particular reference but not disclosed as part of that reference does not support a conclusion that there could be no motivation to add that element." Ans. 36.

Accordingly, we sustain the Examiner's rejection of claim 7 and of claims 13, and 18, which were argued together with claim 7.

Claim 8

Claim 8 depends from claim 4 and recites "wherein an issue further comprises information identifying an educational item, and the administrative server is further configured to retrieve the identified educational item from an educational item store and to transmit the educational item to a printer"

Appellants argue "Cervi merely discloses educational material identified by a physician and given to the patient, which is ne[i]ther the features recited in claims 8, 14, and 19" App. Br. 32. Appellants further argue "neither reference discloses the claimed element of retrieving and transmitting the identified educational item to a printer or location selected by the patient in response to information representing the patient's desire for additional information." App. Br. 32.

Similar to arguments made previously, Appellants also argue that there is no reason to combine Hunkeler with Cervi because Hunkeler already "provides . . . for delivering health information and educational programs on specific topics and making online education available to patients that is tailored to the specific needs of the patient." App. Br. 32–33.

We disagree. Cervi teaches that educational handouts can be printed by sending an order to a nurse station computer which then prints the educational handout. Cervi ¶ 63. Thus, we find no error in the Examiner’s finding that Cervi teaches transmitting the educational item for printing. Final Act. 27. Finally, for reasons similar to the ones stated with respect to claims 5 and 7, we do not find Appellants’ argument regarding the Examiner’s reason to combine Hunkeler and Cervi persuasive.

Accordingly, we sustain the Examiner’s rejection of claim 8 and of claims 14 and 19, which were argued together with claim 8.

Claim 21

Claim 21 depends from claim 4 and recites “the patient interactive device displays the next issue or prompt only after receiving the indication of the patient’s selection of one or more responses.” Appellants argue “requiring a user to answer every question is not equivalent to the feature recited in claim 21 of displaying the next issue or prompt only after receiving the indication of the patient’s selection of one or more responses.” App. Br. 34. Appellants also argue that there is no reason to combine Hunkeler and Machin. According to Appellants, “Machin is . . . hardly directed to the same subject matter as the individual screening and medical triaging system of the present claims.” *Id.* at 35.

We disagree with Appellants. Instead, we agree with the Examiner that Machin’s disclosure of a linear questionnaire where the user is not allowed to skip questions teaches the limitations of claim 21. Ans. 38; *see also* Machin 5:24–46. We also agree with the Examiner that “Machin is analogous prior art because it is concerned with the problem of collecting information from an individual through questionnaires and/or prompts

presented to the user.” Ans. 38–39. Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011). Machin relates to an online questionnaire, similar to the questionnaire of the claimed invention. Machin 1:9–14. Although Machin’s questionnaire deals with corporate performance evaluation, rather than patient health, the problem of collecting information through prompts and responses and making sure users answer each question before moving on to the next is the same as, or at least reasonably pertinent to the problem addressed by claim 21.

Accordingly, we sustain the Examiner’s rejection of claim 21.

Claim 22

Claim 22 depends from claim 4 and recites “wherein the patient interactive device displays the next issue, prompt, or patient selectable responses based on the patient’s selection of one or more responses.”

Appellants do not dispute that the combination of Hunkeler and Huyn teach or suggest the limitations of claim 22. *See App. Br.* 36–37. Instead, they take issue with the Examiner’s reason to combine the two references. *Id.* For example, Appellants argue “Hunkeler is silent regarding any need to dynamically modify its presentation of questions to the patient regarding their health.” *App. Br.* 37. However, the Examiner finds that Huyn provides a reason to combine the two references by “provid[ing] questions to the user dynamically based on the user’s actual responses rather than in a rigid and preset manner.” *Final Act.* 32. “As long as some motivation or

suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor.” *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992). We find the Examiner has articulated a reason with rational underpinning for combining the two references and Appellants’ argument focusing on Hunkeler’s silence is not persuasive of Examiner error.

Accordingly, we sustain the Examiner’s rejection of claim 22.

DECISION

The Examiner’s rejection of claims 1–23 under 35 U.S.C. § 101 is affirmed.

The Examiner’s rejection of claims 1–4, 6, 9, 10, 12, 15, 16, 20, and 23 under 35 U.S.C. § 102 is affirmed.

The Examiner’s rejection of claims 5, 7, 8, 11, 13, 14, 17–19, 21 and 22 under 35 U.S.C. § 103 is affirmed

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

AFFIRMED