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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LINGXIONG SHAO

Appeal 2017-008941
Application 13/991,264
Technology Center 2600

Before JOHN A. JEFFERY, BRUCE R. WINSOR, and
JUSTIN BUSCH, *Administrative Patent Judges*.

BUSCH, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–20, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

CLAIMED SUBJECT MATTER

Claims 1, 10, and 19 are independent claims. The claims generally relate to combining imaging data with user-generated information relating to

¹ Appellant identifies the real party of interest as Koninklijke Philips Electronics N.V. App. Br. 4.

the imaging data. Spec., Abstract. According to the Specification, a “user may add a marker to a portion or portions of the imaging data as being a region of interest.” *Id.* at 9. “Then the user may insert a marker link in the user-generated information . . . to that region of interest.” *Id.* Upon a subsequent reviewer clicking on the marker in the user-generated information, the corresponding region of interest of the imaging data is shown. *Id.*

Claim 1 is representative and reproduced below:

1. A method for combining imaging data with user-generated information relating to the imaging data, the method comprising:
 - generating a user interface on a display of an imaging system comprising an image processor, wherein generating the user interface comprises:
 - generating a first window comprising an image display tool; and
 - generating a second window comprising a user record tool;
 - wherein the first window and the second window are displayed separately and concurrently;
 - providing the imaging data in an image display portion of the image display tool;
 - recording user-generated information concerning the imaging data in a record portion of the user record tool entered by a first user via a user input operatively connected to the imaging system, wherein the user-generated information comprises a first marker link to another record of user-generated information concerning the imaging data entered by a second user; and
 - storing a record of the user-generated information, and associating the record with the imaging data so that the imaging data and the user-generated information record are stored and transferred together.

REJECTIONS²

Claims 1, 4, 7, 10, 13, 16, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang (US 2009/0092953 A1; Apr. 9, 2009) and Timothy Catlin et al., *InterNote: Extending a Hypermedia Framework to Support Annotative Collaboration*, HYPERTEXT '89 PROCEEDINGS, at 365–78 (Nov. 1989) (“Catlin”). Final Act. 8–18.

Claims 2, 3, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang, Catlin, and Ranjan (US 2009/0292559 A1; Nov. 26, 2009). Final Act. 18–20.

Claims 5, 6, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang, Catlin, and Kreeger (US 2011/0109650 A1; May 12, 2011). Final Act. 21–24.

Claims 6 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang, Catlin, Kreeger, and Evans (US 6,347,329 B1; Feb. 12, 2002). Final Act. 24–27.

Claims 8 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang, Catlin, and Vesper (US 2011/0153351 A1; June 23, 2011). Final Act. 27–28.

Claims 9 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang, Catlin, Evans, and Prince (US 7,545,967 B1; June 9, 2009). Final Act. 28–30.

² The rejections are under the provisions of 35 U.S.C. in effect before the effective date of the Leahy-Smith America Invents Act of 2011 (“pre-AIA”). See, e.g., Final Act 2.

THE OBVIOUSNESS REJECTION OVER YANG AND CATLIN

Claims 1, 7, 10, 16, and 19

The Examiner finds that Yang and Catlin collectively teach or suggest all recited elements of claim 1. Final Act. 8–12; Ans. 2–6. Among other things, the Examiner finds Yang (1) generates a user interface that displays a first and second window concurrently, (2) provides image data in the first window, and (3) records user-generated information concerning the imaging data entered by a first user in the second window. Final Act. 9–10; Ans. 3–4. The Examiner cites Catlin for teaching, among other things, user-generated information comprising a first marker link to another record of user-generated information entered by a second user. Final Act. 11–12; Ans. 5–6. In view of these collective teachings, the Examiner concludes that claim 1 would have been obvious. Final Act. 12; Ans. 6.

Appellant first contends Catlin is not an enabling disclosure because one skilled in the art cannot overcome Catlin’s failure to describe the necessary (1) details of how InterNote works, or (2) adaptation to other environments that do not share Intermedia’s framework to arrive at the claimed invention. *See* App. Br. 16–17 (quoting *Impax Labs. Inc. v. Aventis Pharm. Inc.*, 468 F.3d 1366, 1383 (Fed. Cir. 2006); MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) §§ 2121.01, 2145 (9th ed. Rev. 07.2015, Nov. 2015)); Reply Br. 3–4. Appellant’s non-enablement contention is unpersuasive. The Court of Appeals for the Federal Circuit addressed the issue of whether enablement is a requirement for a reference cited in an obviousness rejection and determined the following:

While a reference must enable someone to practice the invention in order to anticipate under § 102(b), a non-enabling reference

may qualify as prior art for the purpose of determining obviousness under § 103. *Reading & Bates Constr. Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 652, 223 USPQ 1168, 1173 (Fed. Cir. 1984) (reference that lacks enabling disclosure is not anticipating, but “itself may qualify as a prior art *reference* under § 103, but only for what is disclosed in it” (emphasis in original)); see *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989) (“[e]ven if a reference discloses an inoperative device, it is prior art for all that it teaches”).

Symbol Techs., Inc. v. Opticon, Inc., 935 F.2d 1569, 1578 (Fed. Cir. 1991); see *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1357 (Fed. Cir. 2003). Thus, we need not reach the question of whether Catlin is enabling as it qualifies as prior art for all that it teaches. *Symbol Techs.*, 935 F.2d at 1578.

Appellant also contends Catlin is non-analogous art because Catlin is not in the same field of endeavor as the claimed invention, and skilled artisans would not have looked to Catlin’s InterNote as reasonably pertinent to the problems of the medical imaging field. See App. Br. 15–18; Rely Br. 4–5. “The identification of analogous prior art is a factual question.” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (citing *In re GPAC*, 57 F.3d 1573, 1577 (Fed. Cir. 1995)). In an obviousness analysis,

[t]wo 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) (quoting *Bigio*, 381 F.3d at 1325).

The field of the claimed subject matter is directed to managing imaging data. Spec. 1. According to the Specification, “imaging data is stored in combination with user-generated information relating to the imaging data.” *Id.* Catlin is directed to InterNote—“a fundamental extension to Intermedia’s navigational linking paradigm.” Catlin 365. Catlin discloses that an entire medical textbook was once imported to allow a group to revise the medical textbook’s text and illustrations using Intermedia. *Id.* Intermedia also established annotation linkages between “[t]ext documents, structured graphic figures, timelines, and scanned images.” *Id.* Catlin’s InterNote transfers data across Intermedia’s annotation linkages using “warm linking” and “Notes.” *Id.* at 365, 369–71. Based on this similarity, and contrary to Appellant’s argument (App. Br. 17; Reply Br. 4–5), we find Catlin and the claimed subject matter are within the same field of endeavor.

We also find unpersuasive Appellant’s additional contention that the claimed invention is unexpected in view of Catlin’s description of the need for an extension of Intermedia’s integrated environment, which Appellant alleges would have required one of ordinary skill in the art to create a whole new architecture to support linking and storing records in any environment such that “the imaging data and the user-generated information record are stored and transferred together,” as recited in claim 1. App. Br. 19 (citing Catlin 365–66, 368, 370, 372–73); Reply Br. 5. Contrary to Appellant’s contention, App. Br. 19; Reply Br. 5, the Examiner relies on Yang, not Catlin, for disclosing storing a record of user-generated information, and associating the record with imaging data so that the imaging data and the

user-generated information record are stored and transferred together. *See* Final Act. 10 (citing Yang ¶¶ 17, 20, 30, 40–42, 52–53, 55, 58, 61; Figs. 1, 5–10). The Examiner relies on Catlin for teaching or suggesting a marker link and displaying two windows separately and concurrently. *Id.* at 11–12 (citing Catlin 365, 369–72, Fig. 3). Thus, Appellant’s contention that one of ordinary skill in the art would not have expected the claimed invention does not identify error in the Examiner’s rejection.

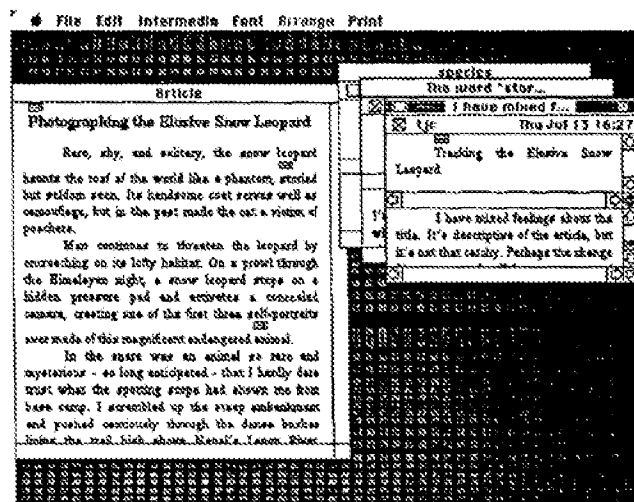
The Examiner’s obviousness rejection relies principally on Yang for teaching many of the recited elements of claim 1, and cites Catlin for very limited purposes. *See* Final Act. 8–11. Although the Examiner finds that Yang displays two generated windows concurrently—(1) a first window comprising an image display tool including imaging data, and (2) a second window comprising a user record tool including recorded user-generated information concerning the imaging data—the Examiner cites Catlin to show that displaying Yang’s two generated windows concurrently *and separately* would have been obvious in light of Catlin’s functionality.³ *See* Final Act. 9–11; Ans. 3–6. Therefore, Appellant’s arguments regarding Catlin’s alleged shortcomings with respect to the recited limitations pertaining to one

³ In the Answer, as an alternative to the Examiner’s finding that Yang teaches providing imaging data, *see* Final Act. 9, the “Examiner further notes that [Catlin’s] document image, although consisting only of text, is still a computer graphic image.” Ans. 38. Although we acknowledge Appellant’s arguments concerning claims 1, 10, and 19 that are responsive to the Examiner’s note, *see* Reply Br. 6–10, we need not address the arguments because we agree with and rely on the Examiner’s finding that Yang teaches imaging data, and we do not rely on the Examiner’s alternative basis that Catlin’s displayed document is “imaging data,” as recited in claim 1.

window with imaging data and another window with user-generated information, App. Br. 20, are unavailing where, as here, the rejection is not based solely on Catlin, but on the cited references' collective teachings. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Appellant's contention that the Examiner erred in finding that Catlin's "warm linking" feature of InterNote discloses the first marker link limitation is unavailing. *See* App. Br. 21; Reply Br. 8. Appellant's argument ignores the Examiner's reliance on Catlin's Notes that creates annotations in Intermedia's InterWord documents to teach or suggest the first marker link limitation. Final Act. 11 (citing Catlin 371–72; Figs. 2, 3); Ans. 41. We agree with the Examiner's findings and adopt them as our own.

Catlin "describe[s] . . . how warm linking is used both to create the content of annotations and to allow authors to incorporate annotations. . . . Annotations to Intermedia documents are made using *Notes*." Catlin 370. Catlin's Figure 3 is reproduced below.



Catlin's Figure 3 "depicts a sample session with InterNote where the author is viewing three Notes to determine whether or not to incorporate them into the draft of an InterWord document." Catlin 371.

Catlin discloses that when an annotator selects a portion of the InterWord document and selects a “Create Annotation” command, (1) a new Note window is opened and (2) a link is established between the annotator’s selection in the InterWord document and the new Note window. Catlin 371–72; Figs. 2–3. Catlin further discloses the annotator enters data into the new Note window. *Id.* Thus, we find Catlin’s Notes teaches or suggests an InterWord document (the claimed “user-generated information”) comprising a first marker link to a new Note window (the claimed “another record of user-generated information”) entered by a second user concerning the InterWord document.

As discussed above, the Examiner finds Yang displays a second window including recorded user-generated information concerning imaging data entered by a first user. Final Act. 9; Ans. 36–37. Yang further teaches a second user may later retrieve the first user’s recorded user-generated information. Yang ¶¶ 42, 47. The Examiner explains that Yang’s user-generated information concerning imaging data could comprise a first marker link to another record of user-generated information concerning imaging data entered by a second user, which would have been an obvious modification in light of Catlin’s Notes functionality. Final Act. 11–12; Ans. 38–41. Thus, Appellant’s arguments that even the combined teachings of Yang and Catlin do not teach or suggest the claimed invention, App. Br. 20–21, is unavailing in light of the collective teachings discussed above. *See Merck*, 800 F.2d at 1097; *In re Keller*, 642 F.2d 413, 425–26 (CCPA 1981).

Therefore, we are not persuaded that the Examiner erred in rejecting claim 1, or claims 7, 10, 16, and 19, not argued separately with particularity.

Claims 4, 13, and 20

The Examiner rejects claim 4, which recites that “the user-generated information further comprises a second marker link to a region of interest within the imaging data,” as obvious in view of Yang and Catlin. Final Act. 12–14; Ans. 6–8. The Examiner finds a user’s selection in a document in Catlin to create an annotation teaches a region of interest within the imaging data and the annotation teaches the recited user-generated information. Final Act. 12–13 (citing Catlin 369).

Appellant argues Catlin does not disclose a second marker link to *a region of interest within the imaging data*. App. Br. 23. We agree. As noted previously with respect to claim 1, the Examiner finds Yang teaches displaying two windows concurrently—(1) a first window comprising an image display tool including imaging data, and (2) a second window comprising a user record tool including recorded user-generated information concerning the imaging data. *See* Final Act. 9–11.

On this record, the Examiner has not shown how Catlin’s second annotation (the claimed “second marker link”), included in a second window’s user-generated information, teaches or suggests being a link to a region of interest within imaging data. Rather, Catlin discloses a window including user-generated information (the InterWord document), another window with additional user-generated information (i.e., an annotation identified as a “Note”), and markers in each window that creates a link between a Note and the “text, graphics or timeline objects” in the InterWord

document. *See* Catlin 371; Fig. 3. Catlin, however, does not teach or suggest a marker of the InterWord document to a region of interest within a separate first window's imaging data. Accordingly, we are persuaded the Examiner erred in rejecting claim 4, and claims 13 and 20, which recite commensurate limitations.

Because this issue is dispositive regarding the Examiner's error in rejecting these claims, we need not address Appellant's other arguments.

THE OBVIOUSNESS REJECTION OVER
YANG, CATLIN, AND KREEGER

Claims 5 and 14

The Examiner rejects claim 5, which recites, in pertinent part, manipulating user-generated information records displayed in a record portion of a user record tool using a second menu portion, as obvious over Yang, Catlin, and Kreeger. Final Act. 21–22; Ans. 15–16.

Appellant's contention regarding Kreeger's alleged shortcomings pertaining to a second window that includes user-generated information records is unavailing. App. Br. 26; Reply Br. 12. Notably, the Examiner's rejection is not based on Kreeger alone, but rather the collective teachings of Yang, Catlin, and Kreeger. Final Act. 21–22; Ans. 15–16. The Examiner relies on Kreeger for teaching the adjustment of a display screen's contrast using a window's tool bar. Ans. 47–50 (citing Kreeger ¶¶ 51, 68). In short, Appellant does not persuasively rebut the Examiner's finding that manipulating all contents of a display screen using a contrast button, such as that in Kreeger, in combination with Yang and Catlin's user-generated information records displayed in a record portion of a user record tool would have been at least an obvious variation. Therefore, Appellant's arguments

regarding Kreeger's individual shortcomings in this regard do not show nonobviousness where, as here, the rejection is based on the cited references' collective teachings. *See Merck*, 800 F.2d at 1097.

Therefore, we sustain the Examiner's rejection of claim 5, and claim 14, not argued separately with particularity.

Claims 6 and 15

Because our decision is dispositive regarding patentability of all appealed claims based on the Examiner's decision to also reject claims 6 and 15 under 35 U.S.C. § 103(a) as obvious over Yang, Catlin, Kreeger, and Evans discussed below, we need not reach the merits of the Examiner's decision to also reject claims 6 and 15 under 35 U.S.C. § 103(a) as obvious over Yang, Catlin, and Kreeger. *See* Final Act. 22–24; Ans. 16–18. *See Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984) (approving ITC's determination based on a single dispositive issue, and not reaching other issues not decided by the lower tribunal).

THE OBVIOUSNESS REJECTION OVER
YANG, CATLIN, KREEGER, AND EVANS

The Examiner rejects claim 6, which recites inserting a marker link into a user-generated information record by selecting a marker tab included in a second menu portion, as obvious over Yang, Catlin, Kreeger, and Evans. Final Act. 24–27.

Despite Appellant's argument to the contrary, App. Br. 29; Reply Br. 14–15, Appellant does not persuasively rebut the Examiner's finding that Evans' folder window 155 contains a list of selectable items, each selectable item newly created when a user creates a new form. Ans. 57–58 (citing Evans 6:60–7:15). We agree with and adopt the Examiner's findings and

conclusions, which are reasonable and supported on this record. Evans discloses generating new data (i.e., a table row, which Evans refers to as a “new form”) as the top entry in folder window 155 in response to selecting a form from a list of available forms in new forms box 157 and filling out a form, for example pediatric problem form 162. Evans 6:60–7:10; *see also id.* at 6:42–59 (describing Figure 5 in more detail).

Evans also discloses a user may select an entry in folder window 155 to annotate by clicking on the entry then clicking on annotate button 159. *Id.* 7:11–15. In that sense, then, Evans at least suggests inserting a selectable item (the claimed “a marker link”) into a folder window 155 (the claimed “user-generated information record”) by selecting a new forms box 157 (the claimed “marker tab”) included in a patient chart window 150 (the claimed “second menu portion”).

Accordingly, we sustain the Examiner’s rejection of claim 6, and claim 15, not argued separately with particularity. *See* App. Br. 29–30; Reply Br. 14.

THE OTHER OBVIOUSNESS REJECTIONS

We also sustain the Examiner’s obviousness rejections of claims 2, 3, 8, 9, 11, 12, 17, and 18. Final Act. 18–20, 27–30. Because these rejections were not argued separately with particularity, we are not persuaded of error in those rejections for the reasons previously discussed.

CONCLUSION

Under § 103, the Examiner did not err in rejecting claims 1–3, 5–12, and 14–19, but erred in rejecting claims 4, 13, and 20. We do not reach the

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Examiner's alternative rejection of claims 6 and 15 under § 103 over Yang, Catlin, and Kreeger.

DECISION

The Examiner's decision to reject claims 1–3, 5–12, and 14–19 is affirmed.

The Examiner's decision to reject claims 4, 13, and 20 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED-IN-PART