



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
**United States Patent and Trademark Office**  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/188,000	06/21/2016	Angadbir Singh Salwan	SalwanP2P-CA02	5603
101173	7590	06/11/2018	EXAMINER	
Angadbir Singh Salwan 10701 Balantre Lane Potomac, MD 20854			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3649	
			MAIL DATE	DELIVERY MODE
			06/11/2018	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* ANGADBIR SINGH SALWAN<sup>1</sup>

---

Appeal 2018-002620  
Application 15/188,000  
Technology Center 3600

---

Before MICHAEL L. HOELTER, NATHAN A. ENGELS, and  
PAUL J. KORNICZKY, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>2</sup>

---

<sup>1</sup> Appellant identifies the real party in interest as himself. App. Br. 1.

<sup>2</sup> The present application is a continuation of Application No. 12/587,101 filed on October 2, 2009. This parent application was the subject of Patent Trial and Appeal Board Appeal No. 2015-007758, mailed April 29, 2016, which affirmed the Examiner's rejections. Ans. 5. This Board Decision was itself appealed to the US Court of Appeals for the Federal Circuit on May 13, 2016. Ans. 5. The Federal Circuit issued an opinion (*In re Salwan*, 681 Fed. Appx. 938 (Fed. Cir. 2017)) sustaining the Board's finding of patent-ineligible subject matter but elected not to address the Board's affirmances on §§ 103 and 112 grounds. *Salwan*, 681 Fed. Appx. at 940.

## STATEMENT OF THE CASE

This is a decision on appeal, under 35 U.S.C. § 134(a), from the Examiner's Final Rejection of claims 1–20. Final Act. 2 (Office Action Summary). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

## THE CLAIMED SUBJECT MATTER

The disclosed subject matter “relates, generally, to the field of applying Information Technology for the benefit of [the] healthcare (HC) industry.” Spec. ¶ 7.<sup>3</sup> System claims 1, 10, and 20 are independent. Claim 1 is illustrative of the claims on appeal and is reproduced below (emphasis omitted).

1. An EMR [electronic medical record] computing system for exchanging patient health information among healthcare user groups or the healthcare user group and patients over a network, the system comprising:

a central computer program embodied in a computer readable medium or embodied in a central server and a central database storing patient EMR data for access by authorized users, the central computer program configured to:

communicate through at least one computer program, which includes EMR and billing software, with at least one private database for a healthcare user group, the database comprising at least patient EMR and billing data, and accounting data confidential for the healthcare user group;

receive from the at least one private database EMR data including at least one of health problems, medications, diagnosis, prescriptions, notes written by a healthcare service provider, diagnostic test results or patient accounts data for storing in the central database,

---

<sup>3</sup> Reference is made to publication number US 2016/0300031 A1, dated October 13, 2016. *See also* App. Br. 2.

wherein the healthcare user group's confidential accounts data including one or more insurance companies accounts data, is not received;

selectively retrieve the stored EMR data, generate one or more healthcare reports including one or more of health problem list, medication list, diagnoses report, prescription, diagnostic test result report, patient billing report; and

transmit one or more healthcare reports to an authorized healthcare user group or the authorized patient for reviewing.

#### REFERENCES RELIED ON BY THE EXAMINER

Giannini	US 5,915,241	June 22, 1999
Schurenberg et al.	US 2002/0007284 A1	Jan. 17, 2002
Davis et al.	US 2003/0028399 A1	Feb. 6, 2003
Jay et al.	US 2003/0050802 A1	Mar. 13, 2003
White	US 2005/0057488 A1	Mar. 17, 2005
Malhotra et al.	US 2005/0251417 A1	Nov. 10, 2005
Hacker	US 6,988,075 B1	Jan. 17, 2006
Dugan	US 2006/0041450 A1	Feb. 23, 2006

#### THE REJECTIONS ON APPEAL

Claims 1–20 are rejected under 35 U.S.C. § 112(a) as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention.

Claims 1–20 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.<sup>4</sup>

---

<sup>4</sup> The heading on page 3 of the Final Office Action only lists claims 1 and 3–11 as subject to the § 101 rejection, but the body of the rejection addresses

Claims 1, 3–5, 10, and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hacker and Malhotra.

Claims 2, 6, and 16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hacker, Malhotra, and Davis.

Claims 7, 8, 12, 15, and 18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hacker, Malhotra, and Jay.

Claim 9 is rejected under 35 U.S.C. § 103(a) as unpatentable over Hacker, Malhotra, and Dugan.

Claim 11 is rejected under 35 U.S.C. § 103(a) as unpatentable over Hacker, Malhotra, and Giannini.

Claim 13 is rejected under 35 U.S.C. § 103(a) as unpatentable over Hacker, Malhotra, and Schurenberg.

Claim 14 is rejected under 35 U.S.C. § 103(a) as unpatentable over Hacker, Malhotra, Schurenberg, and Giannini.

Claim 17 is rejected under 35 U.S.C. § 103(a) as unpatentable over Hacker, Malhotra, and White.

Claim 19 is rejected under 35 U.S.C. § 103(a) as unpatentable over Hacker, Malhotra, Jay, and Schurenberg.

#### ANALYSIS

*The rejection of claims 1–20  
as failing to comply with the written description requirement*

The Examiner, with emphasis added, references the limitation, “wherein the healthcare user group’s confidential accounts data including

---

each of claims 1–20 and makes clear that the rejection applies to all the claims. *See* Final Act. 9; Ans. 10.

one or more insurance companies accounts data, *is not received*.”<sup>5, 6</sup> Final Act. 3; *see also* Ans. 7. The Examiner contends the “[s]pecification does not support the recited limitation. Same rationale applied to claims 2-20.” Final Act. 3; *see also* Ans. 6–7. Appellant disagrees stating, “Figures 1, 2, 3 and 4 clearly show, and paragraphs [0041, 0042, 0043, 0163, and 0168] precisely disclose” the limitation in question. App. Br. 7; *see also* Reply Br. 3.

There is ambiguity in these referenced figures and paragraphs as to whether they “precisely disclose” the limitation that certain confidential data “is not received” by the central computer. The referenced figures and paragraphs are silent as to any complete prohibition on any receiving (sharing) of a user group’s confidential accounts data, as recited. *See also* App. Br. 9. For example, Paragraph 163 of Appellant’s Specification addresses locally stored patient information stating, “[u]pon request, this information can be transferred to any authorized member within the network” and that “[o]ther confidential medical office data, such as patient billing data, cannot be shared with outside members.”<sup>7</sup> Thus, as understood, while some confidential data is expressly not shared, it is also the case that some confidential office data is shared. Consequently, these passages do not

---

<sup>5</sup> Appellant’s Specification defines “healthcare user group” as including physicians, hospitals and the like. Spec. 127. This would include a local medical office that a patient might visit. *See* Appellant’s Figures.

<sup>6</sup> Independent claims 1 and 20 both recite the limitation “is not received.” Independent claim 10, however, recites “is not transmitted.” Appellant does focus on their difference, but instead, argues claims 1, 10, and 20 together. App. Br. 6–11.

<sup>7</sup> Appellant’s usage of “outside members” is presumed to be those not part of the network. Claim 1 recites “**authorized** users,” which are understood to be authorized network users.

make clear there is a complete prohibition on receiving a local medical office's confidential accounts data by a central computer.

We note, however, that claim 1, as originally filed, includes this exact prohibition (i.e., “the healthcare user group’s **confidential** accounts data . . . is not received”). Finding this language in the originally filed claims is reminiscent of a similar situation discussed in *Mentor Graphics Corporation v. Eve-USA Inc.*, 851 F.3d 1275 (Fed. Cir. 2017). In that case, our reviewing court stated:

The very language of claim 1 which the court held was not supported by the specification was present in the originally-filed claims. Original claims are part of the original specification and in many cases will satisfy the written description requirement. *Ariad [Pharms., Inc. v. Eli Lilly & Co.]*, 598 F.3d 1336, 1349 (Fed. Cir. 2010); *see ScriptPro LLC v. Innovation Assocs., Inc.*, 833 F.3d 1336, 1341 (Fed. Cir. 2016); *Crown Packaging [Tech. v. Ball Metal Beverage]*, 635 F.3d 1373, 1381 (Fed. Cir. 2011)]. These claims raise none of the genus/species concerns that have caused us to question whether originally filed claims satisfy written description. *See, e.g., Ariad*, 598 F.3d at 1349–51. . . . Like *Crown Packaging*, the “original claims clearly show that the applicants recognized and were claiming [the disputed limitation]... These claims show, as *Ariad* recognized many original claims do, that the applicants had in mind the invention as claimed” and described it. 635 F.3d at 1381. Original claim 1 recites [the disputed limitation]. This is the precise language the district court found missing from the . . . specification. *See . . . ScriptPro*, 833 F.3d at 1341 (finding written description support when the original claims and the challenged claims recited the same limitation). We conclude that this original claim language clearly demonstrates that the inventor possessed an invention including [the disputed limitation] and described it.

*Mentor Graphics*, 851 F.3d at 1297.

Accordingly, and following the above holding by our reviewing court when confronted with a similar situation (i.e., the disputed limitation being

recited in the originally-filed claims), we do not sustain the Examiner’s rejection of claims 1–20 as failing to comply with the written description requirement.

*The rejection of claims 1–20  
as being directed to non-statutory subject matter*

Appellant argues this rejection of claims 1–20 together. App. Br. 11–13. We do the same. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner undertakes and explains, in much detail, both parts of the two-part test set forth in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012)). Final Act. 3–9; *see also* Ans. 7–10. The Examiner thereafter concludes that claims 1–20 are “directed to non-statutory subject matter.” Final Act. 9; Ans. 10. We need not repeat or rephrase that analysis here.

Appellant first contends that the Examiner only addressed “the **preamble** of the claim.” App. Br. 11. However, that is not the case since the Examiner clearly replicated and addressed the entirety of claim 1. *See* Final Act. 4. Appellant next contends that the Examiner wrongfully compared the “distorted preamble with the concept of **‘hedging’**” as set forth in *Bilski v. Kappos*, 561 U.S. 593, 602 (2010). App. Br. 11. However, the Examiner was merely correlating the similarity of Appellant’s claimed activity “to the concepts involving human activity relating to commercial practices,” such as those described in *Bilski*. Final Act. 4. We do not fault the Examiner for making such a correlation.

Appellant also contends, “[t]he examiner has further given only the **high level generic description** of the claim” while “completely ignoring the

**specifics** of the claim.” App. Br. 11; *see also* Reply Br. 4. However, as above, the Examiner considered all the limitations of claim 1, and, in considering such limitations, the Examiner concluded that they “do not make [claim 1] less abstract.” Final Act. 4; *see also* Ans. 7. We agree with the Examiner’s analysis because the additional “specifics” that Appellant addresses are, themselves, quite generic in nature (i.e., “a central server and a central database,” “authorized users,” billing software,” “private database,” “healthcare user group,” and the like). *See SAP Am. Inc. v. InvestPic LLC*, No. 2017-2801, slip op. at 8–9 (Fed Cir. May 15, 2018) (“As many [Federal Circuit] cases make clear, even if a process of collecting and analyzing information is ‘limited to a particular content’ or a particular ‘source,’ that limitation does not make the collection and analysis other than abstract.”) (quoting *Electric Power*, 830 F.3d at 1353, 1355 (citing cases)); *accord Bilski*, 561 U.S. at 612 (2010) (explaining that *Parker v. Flook*, 437 U.S. 584 (1978) “established that limiting an abstract idea to one field of use or adding token postsolution components did not make the concept patentable”).

Appellant also contends the Examiner “wrongfully equated his high level generic description to the concept of manipulating information using **mathematical relationships** of” *Gottschalk v. Benson*, 409 U.S. 63 (1972). App. Br. 12; *see also* Final Act. 4. However, Appellant does not explain how the Examiner erred in correlating Appellant’s claim language “to the basic concept of manipulating information using mathematical relationships” as expressed by the Examiner. Final Act. 4.

Appellant further contends (specific to page 5 of the Examiner’s Final Office Action), the Examiner argued “that claim 1 only performs basic

computer functions. The rest of [the Examiner’s] arguments on this page are completely irrelevant to claim 1.” App. Br. 12; *see also* Reply Br. 4.

However, the Examiner was explaining that the recited limitations of “*storing data, communicating data, receiving data, retrieving data, and transmitting data in the form of a healthcare report*” were simply a recitation of “generic computing elements [that] are known and conventional.” Final Act. 5; Ans. 7. We do not disagree with the Examiner’s assessment that “every off the shelf computer is configured to do” such function and that using a computer to perform these functions “does not constitute a meaningful limitation that would amount to significantly more than the judicial exception.” Final Act. 5; *see also* Ans. 7–8.

Appellant also acknowledges that the Examiner “further cited a number of court cases,” but Appellant contends, “[a]ll of these citations are completely irrelevant to the claimed subject matter. Therefore, the applicant does not feel the need to even discuss these citations.” App. Br. 12. As is typical when an Examiner references a court case, the reference was not cited because both the court case and the pending claims are indistinguishable. Instead, Examiners cite such court cases because the analyses and holdings expressed by the court could be analogized to the present situation, and, here, the cases were relied upon as guidance and authority regarding issues presented in the Appellant’s Application. Accordingly, we do not fault the Examiner for citing case law as authority to guide the Examiner’s analysis.

Appellant, thereafter, provides a dictionary definition of the word “abstract” which, per Appellant, includes such phrases as “**not practical to**

**be applied; has no practical application...**” App. Br. 12. Appellant thereafter argues that the claimed invention has innovation and practical application because it does not allow “the **confidential data** to be transferred from the **private database . . .** to the **central database.**” App. Br. 12; *see also id.* at 13. However, the question is not one of usefulness, but instead whether Appellant’s claim is proper subject matter so as to be patent-eligible, e.g., is not abstract. Appellant’s above comments are not persuasive on this point.

Accordingly, and based on the record presented, Appellant is not persuasive that the Examiner erred in concluding that claims 1–20 are directed to non-statutory subject matter. We sustain the Examiner’s rejection of these claims under 35 U.S.C. § 101.

*The rejections of claims 1–20  
as being obvious in view of the prior art*

Appellant (a) summarizes the Examiner’s reasons for the rejection of claims 1–20; (b) provides a discussion of both patent statutes and case law; and (c) discusses each of Hacker and Malhotra (which are employed in each 35 U.S.C. § 103(a) rejection). *See* App. Br. 13–18. Appellant’s arguments follow. We address claim 1 when Appellant’s arguments are not specific to any one claim, and we address the separate claims when they are argued separately. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Appellant initially contends the Examiner relied on “**impermissible hindsight**” for rejecting “all claims.” App. Br. 18. Appellant states that the Examiner “never described the individual elements/method steps, and **how to combine** them” based on Hacker and Malhotra, which “are so different from each other.” App. Br. 18; *see also id.* at 19. We disagree with

Appellant because the Examiner did, in fact, address the elements/steps recited and also correlated them to certain features disclosed in the references. *See* Final Act. 10–12 (even providing an alternative reason for the rejection of claim 1). Regarding the asserted difference between the two references (*see supra*), we likewise disagree with Appellant’s assessment because both Hacker and Malhotra pertain to a patient’s electronic medical records, including their storage and distribution among various components. *See* Abstract and Figure 1 of both references; *see also* Ans. 10–11.

Addressing Appellant’s assertion that the Examiner failed to explain “**how to combine**” the references (*see supra*), such an explanation regarding the actual mechanics by which the two are to be joined is not a pre-requisite for a finding of obviousness. Instead, for a rejection based on obviousness, the Supreme Court has provided instructions that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (*citing In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Hence, the Supreme Court requires “articulated reasoning with some rational underpinning” and not a detailed account explaining “how to combine” the references, as Appellant asserts. *See supra*. Furthermore, we are instructed, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418. In the matter before us, there is no evidence that the Examiner’s suggested combination of Hacker and Malhotra is beyond the ability of one skilled in the art.

Appellant also seems to not understand that the Examiner is combining the teachings of the two references and is not substituting a teaching of the one reference for the teaching of the other. *See* App. Br. 19–20. This is because Appellant contends that Hacker’s “**patient-controlled EMR**” would be inoperable if, instead, the “**physicians are given ‘control’**” of the records as in Malhotra. App. Br. 19. The Examiner is not replacing the one for the other.

Appellant further addresses the “**Examiner’s Erroneous/False Statements**” such as where the Examiner correlated a disclosure in Hacker “to the **accounts data** stored in the **private database** in my current invention.” App. Br. 21. However, Appellant does not explain how Hacker’s discussion regarding information found on Hacker’s “Insurance” page 436 (which lists such information as “names, addresses, phone numbers” and the like) is not part of the recited “accounts data” that is stored locally on the medical office’s computer. Hacker 9:54–59. Appellant also contends that, with respect to Hacker, “[t]here is no disclosure of any data transfer from a **private database** to the central server.” App. Br. 21. However, the Examiner relies on the combination of Hacker and Malhotra (and not just Hacker alone) for teaching communication with “at least one physician office computer (private data storage).” Final Act. 10. Further, the figures of both Hacker and Malhotra illustrate two-way communication between a physician’s office and a remote computer.

Appellant also states, “[m]y claimed invention has **both** the EMR and billing software on the **private computing system** that belongs to the physicians group.” App. Br. 22. However, claim 1 also recites that “**billing software**” is communicated with the “**central computer program.**” Thus,

claim 1 does not require the billing software to reside only locally, a distinction Appellant seeks to make. Appellant also contends, “Malhotra teachings are **contrary** (and **lead away** from the invention).” App. Br. 22. However, Appellant simply makes this assertion without clarifying how Malhotra actually criticizes, discredits, or otherwise discourages investigation into the claimed solution. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

Appellant thereafter contends the Examiner provided “**erroneous reasoning**” because “Malhotra is referring to reduction of labor by eliminating **double entry** of patient data” and that this is “**not applicable to Hacker**” which “has **only one** central computer program.” App. Br. 23. Appellant seems to disregard the various ancillary systems/devices in communication with Hacker’s main system (and illustrated in Fig. 1), and Appellant does not explain how the Examiner’s reason (“for the benefit of reducing the amount of labor required to enter data for billing purposes” (Final Act. 10)) is not applicable during the use of all these various components.

Appellant also contends that, as regarding Hacker and Malhotra, “each system has [a] **different objective/purpose**.” App. Br. 23. However, the test of obviousness is not what the references may or may not specifically disclose, but instead, the test is what the references would reasonably suggest to one skilled in the art. In other words, “[t]he use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699

F.2d 1331, 1333 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009 (CCPA 1968)).

Appellant further contends the Examiner relied on “**Impermissible Hindsight**” (App. Br. 24), but Appellant does not explain that which was only gleaned from Appellant’s disclosure. *See In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971); *see also* Ans. 11. Appellant also contends that the Examiner failed to provide a prima facie case of obviousness because “the examiner has never given any **explicit analysis** to support his conclusion of obviousness.” App. Br. 25. However, Appellant’s contention is not persuasive since we are instructed that the Examiner satisfies the initial procedural burden of establishing a prima facie rejection by adequately explaining the shortcomings it perceives so that the applicant is properly notified and able to respond. *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011). There is no indication the Examiner failed to indicate the perceived shortcomings or failed to properly notify Appellant of same. Appellant also fails to explain how the Examiner’s analysis was not made “explicit.”

When discussing independent claim 20, Appellant renders many of the same arguments previously presented and addressed. One distinction between claim 1 and claim 20 that Appellant notes is that claim 20 “does not claim any **central server, central computer program or central database.**” App. Br. 25. Instead, in claim 20, patient data is “transferred between a **first database . . . and a second database.**” However, identifying the various components via different terminology does not render the Examiner’s rejection inapt. In other words, Appellant does not explain

how the Examiner's underlying logic and rationale fails to be equally applicable to both the limitations of claim 1 and those of claim 20.

Appellant further contends (relying on case law that predates the Supreme Court's decision in *KSR*) that "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art." App. Br. 26. This is not a proper understanding of present case law which no longer requires the cited art itself to express the reason for the combination. *See KSR*, 55 U.S. at 419.

Accordingly, and based on the record presented, we are not persuaded the Examiner erred in combining the teachings of Hacker and Malhotra, or in concluding that their combination renders obvious the limitations recited in claims 1, 3–5, 10, and 20. Appellant does not present arguments regarding the Examiner's additional reliance on Davis, Jay, Dugan, Giannini, Schurenberg, and White. Accordingly, we are not persuaded the Examiner erred in additionally rejecting dependent claims 2, 6–9, and 11–19 whose rejections relied on these additional references.

#### DECISION

The Examiner's rejection of claims 1–20 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement is reversed.

The Examiner's rejection of claims 1–20 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter is affirmed.

The Examiner's art rejections of claims 1–20 under 35 U.S.C. § 103(a) are affirmed.

Appeal 2018-002620  
Application 15/188,000

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

AFFIRMED