

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No.16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JEFFREY S. HASTINGS

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Appeal No. 2001-1469  
Application 09/001,284

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ON BRIEF

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Before THOMAS, JERRY SMITH, BLANKENSHIP, Administrative Patent Judges.  
JERRY SMITH, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-11 and 13-18, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for storing medical images. A particular feature of the invention is that a storage device is automatically selected based on patient diagnostic information.

Representative claim 1 is reproduced as follows:

1. A system for storing a medical image comprising:  
a plurality of storage devices;

a clinical information system comprising patient diagnostic information associated with a medical image; and

a medical image management system, coupled with the plurality of storage devices and the clinical information system;

wherein the clinical information system is operative to send patient diagnostic information to the medical image management system and wherein the medical image management system is operative to automatically select a storage device in which to store the medical image by analyzing the patient diagnostic information and is further operative to store the medical image in the selected storage device.

The examiner relies on the following reference:

Orphanoudakis et al. (Orphanoudakis), "Development of an Integrated Image Management and Communication System on Crete," Medical Information Systems Laboratory Institute of Computer Science, FORTH, 1995, pp. 1-6.

Claims 1-11 and 13-18 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the disclosure of Orphanoudakis.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the

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examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Orphanoudakis does not fully meet the invention as set forth in claims 1-11 and 13-18. Accordingly, we reverse.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he reads the claimed invention on the disclosure of Orphanoudakis [answer, pages 3-7]. With respect to each of independent claims 1, 6 and 7, which stand or fall together as a single group [brief, page 6], appellant argues that Orphanoudakis does not disclose automatically selecting a storage device by analyzing patient diagnostic information as claimed. Appellant notes that the examiner has admitted this fact and the examiner, therefore, has improperly relied on a second reference which is cited in the Orphanoudakis article. Appellant argues that it was improper for the examiner to rely on the additional teachings of Huang to support a

rejection under 35 U.S.C. § 102(a) based on Orphanoudakis. Finally, appellant argues that even if it were proper to combine the teachings of Orphanoudakis and Huang, the combination still fails to teach automatically selecting a storage device in which to store the medical image by analyzing patient diagnostic information as claimed [brief, pages 9-15].

The examiner responds that the Huang reference was cited only to show an inherent characteristic of Orphanoudakis. The examiner notes that Orphanoudakis specifically refers to Huang and that Huang teaches storing files onto the fastest storage device. The examiner also argues that since Orphanoudakis teaches image retrieval rates based on the seriousness of the patient's illness, Orphanoudakis must have evaluated diagnostic information before selecting a storage device [answer, pages 7-8].

Appellant responds that the use of Huang to disclose an inherent property of Orphanoudakis is improper. Appellant notes that there are several interpretations of Huang and that the examiner's interpretation does not necessarily follow. Appellant also asserts that the selection of a storage device in Huang is not made by analyzing patient diagnostic information associated with the image as claimed [reply brief].

We do not sustain the examiner's rejection of claims 1-11 and 13-18 because all the features of independent claims 1, 6 and 7 are not fully met by the disclosure of Orphanoudakis for reasons argued by appellant. At the outset, we agree with appellant that the mere citation of a reference in a published article does not allow the cited

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reference to be combined with the published article in support of a rejection under 35 U.S.C. § 102. On the facts of this case, it is clear that the examiner is relying on Huang to provide teachings which are missing from Orphanoudakis and that do not necessarily follow from the disclosure of Orphanoudakis. In the final rejection, the examiner admitted that Orphanoudakis does not specifically disclose automatically selecting the storage device by analyzing patient diagnostic information, but the examiner found that Orphanoudakis discloses this operation anyway based on the cited reference to Huang. The examiner and appellant disagree on what is taught by Huang. The very fact that the examiner and appellant dispute what is disclosed by Huang is evidence that Huang is not being relied on merely to explain the meaning of a term or to show an inherent characteristic. Notwithstanding the examiner's assertion that Huang does simply provide an inherent characteristic of Orphanoudakis, we agree with appellant that Huang has been improperly used in this anticipation rejection.

When the rejection is considered using only the disclosure of Orphanoudakis, we also agree with appellant that the selection of a storage device in Orphanoudakis is not clearly determined using patient diagnostic information. Orphanoudakis appears to move data between storage devices based on previously obtained data from models which show how often data is typically accessed during hospital stays.

Since all the features of the claimed invention are not found entirely within the

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disclosure of Orphanoudakis, we do not sustain the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-11 and 13-18 is reversed.

Since we have reversed the anticipation rejection in this case as fundamentally flawed because it requires a consideration of two references, we also remand this application to the examiner for a consideration of whether prosecution of this application should be reopened to make an appropriate rejection based on the prior art of record or on any other prior art. We do this in part to ensure that the proper scope of the claimed invention has been considered and that the factual findings necessary to support any rejection are properly of record in this case.

Our first observation is that the independent claims on appeal do not recite that the plurality of storage devices (claim 1) or the storage device (claims 6 and 7) represent a hierarchical storage system. Each of the independent claims only requires that a storage device be selected by analyzing patient diagnostic information. Thus, the other critical factual question in this appeal is what is meant by the term "patient diagnostic information." Any additional rejection of these appealed claims should include a finding as to what is the broadest reasonable interpretation of this term and how the applied prior art is deemed to meet, teach or suggest this claimed term. The present record suggests that appellant and the examiner may have different views of what this term includes, but any such differences have not been fully explored because of the

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examiner's reliance on the Huang reference. In response to this remand, the examiner is free to take whatever action is deemed appropriate.

REVERSED AND REMANDED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	BOARD OF PATENT
JERRY SMITH	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	

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