

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IANNE MAE HOWARDS KORITZINSKY and JOHN AURTHUR REICH

Appeal No. 2004-2044
Application No. 09/476,708

ON BRIEF

Before SMITH, RUGGIERO, and MACDONALD, ***Administrative Patent Judges***.

MACDONALD, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 59-64 and 66-78. Claims 1-58 and 65 have been canceled.

Invention

Appellants' invention relates to a system and method for handling of imaging and diagnostic system protocols. The system may be integrated in a scanner interface which includes pages accessible through a browser-type or other graphical user

Appeal No. 2004-2044
Application No. 09/476,708

interface system. At least one of the pages may be devoted to a listing and description of protocols installed on or available for the particular scanner. The technique may also be employed on centralized management stations, such as a station linking several scanners in a radiology department of a medical institution. The system may also provide information on preferred or useful configuration parameters for carrying out the protocol. The interface may also permit the protocol to be loaded or requested for specific examinations by simply selecting the protocol from a menu. In a preferred arrangement, new or improved protocols may be made available through an interactive communications system which links the scanners to a centralized service facility. The service facility may transmit messages to the scanner to inform the operations personnel of the existence and availability of the new protocol. The protocol may then be downloaded or transmitted automatically or upon request by the institution. The technique allows protocols for a large variety of scanners, scanner types, modalities, and manufacturers to be easily distributed through the service center. The service center may also provide a library of available protocols which may be installed on memory media or transmitted via a network. Accounting for distribution of the protocols may also be

Appeal No. 2004-2044
Application No. 09/476,708

performed by the system, such as for transmitting protocols in accordance with subscriptions and so forth.

Claim 59 is representative of the claimed invention and is reproduced as follows:

59. A method for providing operational protocols to medical diagnostic systems, the method comprising the steps of:

storing a protocol on a machine readable medium, the protocol including at least one operation parameter for a medical diagnostic system;

displaying user viewable indicia descriptive of the protocol at a medical diagnostic location, wherein the user viewable indicia include an exemplary image obtainable via the protocol;

performing a protocol exchange transaction including selecting the protocol via a user interface and loading the protocol at the medical diagnostic location from the machine readable medium via a network connection to the medical diagnostic location; and

storing an accounting record of the transaction.

References

The references relied on by the Examiner are as follows:

Wyman	5,260,999	Nov. 9, 1999
Strauss et al. (Strauss)	5,790,173	Aug. 4, 1998
Reeder	5,852,812	Dec. 22, 1998
Pourjavid	5,883,985	Mar. 16, 1999
Wood et al. (Wood)	5,891,035	Apr. 6, 1999
Grate et al. (Grate)	5,956,483	Sep. 21, 1999
Clarke et al. (Clarke)	5,982,917	Nov. 9, 1999

Appeal No. 2004-2044
Application No. 09/476,708

Ross et al. (Ross)	6,026,417	Feb. 15, 2000
Wyatt	6,041,411	Mar. 21, 2000
Kuwabara	6,065,136	May 16, 2000
Miller et al. (Miller)	6,151,696	Nov. 21, 2000
Sekiguchi	6,288,799	Sep. 11, 2001

Evans, W.S., "Compression via Guided Parsing" (Abstract only), Proceedings [of the] DCC 1998 Data Compression Conference, page 544, edited by Storer, J.A., et al., published by the IEEE Comput. Soc., 1998.

Rejections At Issue

Claims 59, 60, 66, and 68 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Wood et al. and Reeder.

Claims 61 and 64 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Wood et al. and Reeder and Official Notice.

Claims 62 and 63 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Wood et al. and Reeder and Wyman.

Claim 67 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Wood et al. and Reeder and Clark et al.

Claims 69 and 71-73 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Wood et al. and Reeder and Official Notice.

Appeal No. 2004-2044
Application No. 09/476,708

Claim 70 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Wood et al. and Reeder and Official Notice and admitted prior art.

Claims 74-76 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Wood et al.

Claims 77-78 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Wood et al. and Official Notice.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 59-64 and 66-78 under 35 U.S.C. § 103.

Appellants have indicated that for purposes of this appeal, the claims stand or fall together in eleven groupings:²

¹ Appellants filed an appeal brief on September 12, 2003. Appellants filed a reply brief on December 29, 2003. The Examiner mailed out an Examiner's Answer on October 21, 2003.

² Appellants state that Groups II-VI, VIII, and X-XI, each "stand with [their] independent claim, or will fall separately." We interpret this statement of Appellants as "stand or fall separately."

Appeal No. 2004-2044
Application No. 09/476,708

Claims 59, 60, 66, and 68 as Group I;

Claims 61-64 and 67, as Groups II-VI;

Claims 69 and 71-73 as Group VII;

Claim 70 as Group VIII;

Claims 74-76 as Group IX; and

Claims 77-78 as Groups X-XI.

See pages 5-6 of the brief. Appellants have not explained why each group is believed to be separately patentable. Therefore, Appellants have failed to fully meet the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, **appellant explains why the claims of the group are believed to be separately patentable.** Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. (Emphasis added)

We will, thereby, consider Appellants' claims as standing or falling together in eight groups corresponding to the eight rejections at issue noted above, and we will treat:

Appeal No. 2004-2044
Application No. 09/476,708

Claim 59 as a representative claim of Group I;
Claim 61 as a representative claim of Group II;
Claim 62 as a representative claim of Group III;
Claim 67 as a representative claim of Group IV;
Claim 69 as a representative claim of Group V;
Claim 70 as a representative claim of Group VI;
Claim 74 as a representative claim of Group VII; and
Claim 77 as a representative claim of Group VIII.

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 59, 60, 66, and 68 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 59, 60, 66, and 68. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a ***prima facie*** case of

Appeal No. 2004-2044
Application No. 09/476,708

obviousness. ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). ***See also In re Piasecki***, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. ***In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. ***Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444. ***See also Piasecki***, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." ***Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." ***In re Lee***, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

A) *User viewable Indicia*

With respect to independent claim 59, Appellants argue at pages 7-9 of the brief, "[t]he Wood et al. and Reeder references do not disclose or suggest "displaying user-viewable indicia descriptive of the protocol at a medical diagnostics location, wherein the user-viewable indicia include an exemplary image obtainable via the protocol." The Examiner rebuts this at pages 16-20 of the answer by pointing out that the reference images of Wood et al. are "exemplary images" and also meet the claim limitation of being "obtainable via the protocol." Further, the Examiner points out that the references images are also "descriptive of the protocol." We agree with the Examiner on all these points. However, we still find the Appellants' argument persuasive. The Examiner has taken the exemplary image of Wood et al. which is found at the diagnostic end of the Wood et al. process and moved the exemplary image to the protocol selection process at the front of the Wood et al. process. The Examiner states various reasons at page 7 of the answer for making this modification to the Wood et al. process. We find that this represents improper hindsight absent some teaching that it is known to select a process to be performed using an image exemplary of the result of said process to be performed. Although not an analogous art, an example of this type of process

selection can be found in the font change process of Microsoft Word where the resulting font is shown as an example during the selection process.

B) Reeder is Non-Analogous Prior Art

With respect to independent claim 59, Appellants argue at pages 9-12 of the brief, "[t]he Reeder reference is clearly completely unrelated to problems with respect to medical systems or access to image protocols." We do not find Appellants' argument persuasive. Appellants have improperly limited the field of art to medical systems or access to image protocols. We find that the invention is clearly directed to a combined medical diagnostics and billing system. We find that the analogous art properly includes both the Wood et al. and Reeder patents.

C) Motivation or Suggestion to combine

With respect to independent claim 59, Appellants argue at pages 12-13 of the brief, "[t]he Examiner's statements . . . [fail] to articulate a convincing line of reasoning as to why one of ordinary skill in the art would combine the references." We do not find Appellants' argument persuasive. As pointed out by the Examiner at page 6 of the answer, Reeder teaches storing accounting records for transactions such as downloading a file. The system of Wood et al. clearly performs such transactions. We

Appeal No. 2004-2044
Application No. 09/476,708

find that more than sufficient motivation to combine exists within the four corners of the Wood et al. and Reeder patents.

Therefore, for the reason discussed at A) above, the Examiner has not met the initial burden of establishing a **prima facie** case of obviousness and we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

II. Whether the Rejection of Claims 61 and 64 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 61. Accordingly, we reverse.

With respect to dependent claim 61, we note that the Examiner has relied on Official Notice solely to teach "transmitting an authorization prompt" [answer, page 8]. Official Notice in combination with Wood et al. and Reeder fails to cure the deficiencies of Wood et al. and Reeder noted above with respect to claim 59. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

Appeal No. 2004-2044
Application No. 09/476,708

***III. Whether the Rejection of Claims 62-63 Under
35 U.S.C. § 103 is proper?***

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 62. Accordingly, we reverse.

With respect to dependent claim 62, we note that the Examiner has relied on Wyman solely to teach "service subscription" [answer, page 9]. The Wyman reference in combination with Wood et al. and Reeder fails to cure the deficiencies of Wood et al. and Reeder noted above with respect to claim 59. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

***IV. Whether the Rejection of Claim 67 Under 35 U.S.C. § 103
is proper?***

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 67. Accordingly, we reverse.

With respect to dependent claim 67, we note that the Examiner has relied on Clark et al. solely to teach "data for

filming . . ." [answer, page 9]. The Clark et al. reference in combination with Wood et al. and Reeder fails to cure the deficiencies of Wood et al. and Reeder noted above with respect to claim 59. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

V. Whether the Rejection of Claims 69 and 71-73 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 69 and 71-73. Accordingly, we reverse.

A) Features Missing from Proposed Combination

With respect to independent claim 69, we find Appellants' argument with respect to the use of "lists" to be unpersuasive, as it does not address the combination rejection made by the Examiner. However, Appellants also argue at pages 16-18 of the brief that the references do not disclose or suggest use of "an exemplary image obtainable via the protocol." We find this argument persuasive for the reason noted above with respect to claim 59.

B) Reeder is Non-Analogous Prior Art

With respect to independent claim 69, Appellants argue at page 19 of the brief, "[t]he Reeder reference is non-analogous art." We do not find Appellants' argument persuasive for the reason noted above with respect to claim 59.

C) Motivation or Suggestion to combine

With respect to independent claim 69, Appellants argue at page 19 of the brief that there is no motivation or suggestion to combine the references. We do not find Appellants' argument persuasive for the reason noted above with respect to claim 59.

Therefore, for the reason discussed at A) above, the Examiner has not met the initial burden of establishing a **prima facie** case of obviousness and we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

VI. Whether the Rejection of Claim 70 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 70. Accordingly, we reverse.

With respect to dependent claim 70, we note that the Examiner has relied on admitted prior art solely to teach "a

Appeal No. 2004-2044
Application No. 09/476,708

plurality of diagnostic system modalities" [answer, page 13].
The admitted prior art in combination with Wood et al. and Reeder and Official Notice fails to cure the deficiencies of Wood et al. and Reeder and Official Notice noted above with respect to claim 69. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

**VII. Whether the Rejection of Claims 74-76 Under
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 74-76. Accordingly, we reverse.

With respect to independent claim 69, Appellants also argue at page 21-22 of the brief that the references do not disclose or suggest use of "an exemplary image obtainable via the protocol." We find this argument persuasive for the reason noted above with respect to claim 59.

Therefore, the Examiner has not met the initial burden of establishing a **prima facie** case of obviousness and we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

Appeal No. 2004-2044
Application No. 09/476,708

**VIII. Whether the Rejection of Claims 76-78 Under
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 77-78. Accordingly, we reverse.

With respect to dependent claim 77, we note that the Examiner has relied on Official Notice solely to teach "a managing module within . . . the institution" [answer, page 14]. The Official Notice in combination with Wood et al. fails to cure the deficiencies of Wood et al. noted above with respect to claim 74. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

Other Issues

Should there be further prosecution of this application, we direct the Examiner's attention to:

- A) Column 3, line 55, through column 4, line 42, of Stark et al. U.S. Patent 6,371,123 which teach selection of a medical protocol based on image and text data; and
- B) Figures 29 and 30 of Hoium et al. U.S. Patent 5,951,484 which teach selection of medical protocol steps from a list.

Appeal No. 2004-2044
Application No. 09/476,708

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 59-64 and 66-78.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
ALLEN R. MACDONALD)	
Administrative Patent Judge)	

ARM/lbg

Appeal No. 2004-2044
Application No. 09/476,708

PATRICK S. YODER
7915 FM 1960 WEST
SUITE 330
HOUSTON, TX 77070