

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY SAUL HARRIS

Appeal 2008-0728
Application 10/216,268¹
Technology Center 2100

Decided: September 23, 2008

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, C., *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1-9 mailed August 30, 2005, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Application filed August 12, 2002. The real party in interest is the inventor Jeffery Saul Harris.

A. INVENTION

Appellant invented a method for analyzing records in a database including retrieving rules and applying the rules to the data. (Spec., Abstract.)

B. ILLUSTRATIVE CLAIM

The appeal contains claims 1-9. Claims 1 and 6 are independent claims. Claim 1 is illustrative:

1. A method for analyzing records in a database comprising:
 - collecting predetermined data and searching a data base and creating or appending a record within the data base;
 - retrieving rules from a rules base, said retrieved rules selected to correspond to the data base record;
 - applying the selected rules or retrieved rules to the data base record;
 - reviewing results generated from applying the rules to the data;
 - generating at least one message establishing a procedure related to treatment of a medical patient in accordance with the rules;
 - wherein the method is implemented as program elements are executed within a computer system.

C. REFERENCE

The sole reference relied upon by the Examiner in rejecting the claims on appeal is as follows:

Falchuk US 6,256,613 B1 Jul. 3, 2001

D. REJECTION

The Examiner entered the following rejection which is before us for review:

Claims 1-9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Falchuk.

II. PROSECUTION HISTORY

Appellant appealed from the Final Rejection and filed an Amended Appeal Brief (App. Br.) on November 15, 2006. The Examiner mailed a Supplemental Examiner's Answer (Ans.) on May 11, 2000. No Reply Brief is shown in the record.

III. ISSUE

Whether Appellant has shown that the Examiner erred in finding that Falchuk teaches applying rules to database records.

IV. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Claim Construction

1. The Specification does not provide a lexicographic definition for the term “rules”.
2. The ordinary and usual meaning of “rules” is “a prescribed guide for conduct or action.” *Merriam-Webster's Collegiate Dictionary*, p.1023 (10th Edition 1997).

Falchuk

3. Falchuk discloses that there is “a need for better procedures for encouraging and documenting the continuing medical education which is gained when primary care physicians consult with specialists . . .” (col. 1, ll. 55-59).

4. Falchuk discloses “educating physicians and other medical staff so as to ensure standards and ‘best practice’ protocols” (col. 1, l. 65 to col. 2, l. 5).

5. Falchuk discloses that “[s]tandard information retrieval techniques may be employed to facilitate the retrieval of relevant information from the information database 40” (col. 4, ll. 4-6).

6. Falchuk discloses that the “text of the ‘question’ posed by the requesting physician and contained in the consultation request received at 32 may be used as a freeform retrieval request to find items of probable interest using conventional text content matching algorithms” (col. 4, ll. 6-10).

V. PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their

broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

VI. ANALYSIS

Grouping of Claims

In the Brief, Appellant argues claims 1-9 as a group (App. Br. 5-6). For claims 2-9, Appellant repeats the same argument made for claim 1. We will, therefore, treat claims 2-9 as standing or falling with claim 1.

See 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

The Board's Claim Construction

"Our analysis begins with construing the claim limitations at issue." *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (BPAI 2007).

Claims are given their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

To determine whether Falchuk anticipates representative claim 1, we must first determine the scope of the claims. Our reviewing court stated in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005), *cert. denied*, *sub nom. AWH Corp. v Phillips*, 126 S. Ct. 1332 (2006): "The claims, of course, do not stand alone. Rather, they are part of 'a fully integrated

written instrument,’ *Markman*, 52 F.3d at 978, consisting principally of a Specification that concludes with the claims. For that reason, claims ‘must be read in view of the specification, of which they are a part.’ *Id.* at 979. As we stated in *Vitronics*, the Specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’ 90 F.3d at 1582.”

We note that Appellant has not identified any specific definition for the term “rules” (FF 1), therefore, we give this term its ordinary and customary definition and find that “rules” include any guide for conduct or action (FF 2).

The Anticipation Rejection

We now consider the Examiner’s rejection of claims 1-9 under 35 U.S.C. § 102(e) as being anticipated by Falchuk.

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002).

Appellant contends that “there is simply no teaching of applying rules to the database record as required by claims 1 and 6” (App. Br. 6).

The Examiner found the Falchuk discloses “approved protocols and practices” (Ans. 7). We agree with the Examiner.

Specifically, Falchuk discloses a need for better procedures for documenting medical education (FF 3), and educating staff so as to ensure standards and best practice protocols (FF 4). As such, we find that Falchuk

takes into consideration procedures, standards, and best practice protocols when documenting medical data, which reads on following “rules.”

In addition, Falchuk discloses that standard retrieval techniques are being employed to facilitate the retrieval of relevant information from the database (FF 5) and that conventional text content matching algorithms are also being used to find desired database records (FF 6). Therefore, we find that one skill in the relevant art would recognize that such standard/conventional retrieval techniques would inherently include “applying rules” to the data base records in order to obtain results.

As to the other recited elements of claim 1, Appellant provides no argument to dispute that the Examiner has correctly shown where all these claimed elements appear in the prior art. Thus, we deem those arguments waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2006).

Therefore, we do *not* find that Appellant has shown error in the Examiner’s rejection of illustrative claim 1. Instead, we find the Examiner has set forth a sufficient initial showing of anticipation. Therefore, we affirm the rejection of independent claim 1 and of claims 2-9, which fall therewith.

VII. CONCLUSION

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 1-9.

Thus, claims 1-9 are not patentable.

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VIII. DECISION

In view of the foregoing discussion, we affirm the Examiner's rejection of claims 1-9.

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. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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