

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 91

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHIGEYUKI IKEDA

Appeal No. 1999-0289
Application No. 08/336,690

HEARD: OCTOBER 9, 2001

Before HAIRSTON, KRASS, and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 21, 23-29 and 32-42, all of the pending claims.

The invention deals with recording and reproducing personal medical history of an individual patient on a digital audio tape (DAT).

Representative independent claim 21 is reproduced as follows:

21. In a medical information recording and reproducing apparatus having a processor connected to an input/output unit, a medical diagnostic imaging unit, a display unit and a digital audio tape (DAT) unit using a digital audiotape cassette including a DAT having a recording area for recording and reproducing digitized audio signals, a method of forming and using a personal medical information file, comprising the steps of:

(a) dividing said recording area of said DAT into a plurality of areas including an identification information (ID) area for storing said ID information of a single specified person, a personal medical history information area for storing case and therapeutic history information of said single specified person, a medicative history information area for storing medicative history information of said single specified person, an examination image history information area and an examination image information area for storing examination image information of said single specified person;

(b) processing medical information including ID information, case and therapeutic history information, medicative history information and examination image history information of said single specified person and examination image information of said specified person received from said input/output unit and said medical diagnostic imaging unit respectively to prepare said information for recording in said DAT;

(c) recording in said ID area of said DAT said ID information of said single specified person, and recording data of at least one of said case and therapeutic history information, said medicative history information, said examination image history information and said examination images information, related to a medical treatment said single specified person has received in one of said ID areas, said personal medical history information area, said medicative history information area, said examination image history information area and said examination image examination image history information area and said examination image information area corresponding to said data to

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be recorded thereby forming a personal medical information file;
and

(d) reproducing said personal information file of said single specified person from said DAT when said single specified person is being diagnosed.

The examiner relies on the following reference:

Ichikawa	4,737,912	Apr. 12, 1988
		(filed Sept. 3, 1985)

Claims 21, 23-29 and 32-42 stand rejected under 35 U.S.C. 103 as unpatentable over Ichikawa.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

This board has previously rendered a decision (Paper No. 37, April 5, 1993) on similar claims. The difference between those claims and the claims presently on appeal, as noted by the examiner, at page 2 of Paper No. 45, is that the latter claims recite that the recording area of the DAT is divided into a plurality of areas, designating the information which is to be recorded into these areas. The examiner's response to these additions was to cite column 4, line 4 et seq. of U.S. Patent No. 4,812,924 to show that it was conventional to provide 128 blocks

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of data per track on a DAT and to number these blocks sequentially. It is also the examiner's position that with regard to the actual content of the information recorded, i.e., name, medical history, etc., this is of "no patentable significance." The examiner also contended that it would have been obvious to "select the most common medical information, i.e., the medical history of the patient" [Paper No. 45, page 2] to be recorded, given that it would have been obvious to record medical information on a DAT.

In addition to providing two declarations by Koichi Koike under 37 CFR 1.132, appellant also makes the following arguments:

1. Ichikawa does not suggest the "single storage medium" of the claimed invention.

2. Ichikawa does not teach the recording of medical information pertaining to an "individual" patient (ID information, case history, medicative history, examination image history, and examination images) on a single storage medium.

3. The storage medium of Ichikawa is not divided into a plurality of recording areas, as is the DAT of the instant claimed invention.

4. It would not have been obvious to record medical information on a DAT at the time of the instant invention because

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DAT technology at that time related only to the storage of digitized audio signals in the form of music. There is no prior art to relate DAT technology to the storage of image information of any kind at the time of the instant invention. Thus, it would not have been obvious to store examination image history information and examination images on a DAT at the time of the instant invention.

We treat appellant's arguments in the order presented.

1. It is our view that Ichikawa certainly does suggest a "single storage medium" for storing medical information. Ichikawa's disclosed invention differs from the instant disclosed invention in that the former stores case histories and clinical histories and compares the two in order to aid in diagnosis of illness while the latter is concerned with storing an individual's medical history on a DAT which is updated each time the individual undergoes a medical exam.

However, Ichikawa does disclose, at column 5, lines 23-24, that clinical information (image and index) may be stored on a record medium which is separate from the case history information. Thus, the clinical information may be stored on a "single storage medium."

2. While it is true that Ichikawa is interested in storing

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clinical and case studies of a plurality of patients, it is also clear that only a single individual's medical information may be stored. As we pointed out in our earlier decision of April 5, 1993 [page 6], and as indicated by the examiner, even in Ichikawa, "when the first person's data is inputted there is only a single person's data on the medium." As we further indicated at that section of our decision, both image data and patient information relating to a single specific patient are retrieved in Ichikawa and it would have been manifest to artisans that the relevant information for each patient may be stored on either a separate recording medium for each individual patient or on a common, mass storage device wherein information on a plurality of patients is stored. We would also note that at page 12, lines 21 et seq. of the instant specification, appellant states that while Figure 1 is described as referring to a DAT which belongs to individual patients, "the invention is not limited thereto." Thus, even appellant does not limit the invention to loading a DAT with information regarding only a single individual patient.

3. Ichikawa indicates, at column 5, lines 15-21, that while an optical disk is disclosed, the medical information may be stored on "other recording medium such as floppy disc, magnetic tape, magnetic drum, etc." Clearly then, this is a suggestion

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that the particular storage medium is not important and that it would have been obvious to provide such medical information on storage media, such as DAT, which may have not yet been widely employed, at the time of Ichikawa.

Moreover, Ichikawa describes his floppy disk as being divided into a plurality of recording areas. While these areas may store clinical indexes having retrieval information pertaining to divided areas of the optical disk which stores clinical images, this would be, in our view, a clear suggestion to divide a recording medium into a plurality of recording areas, as claimed. When that storage medium is a DAT, clearly within the realm of recording media suggested by Ichikawa, the DAT would clearly have been divided into a plurality of recording areas.

4. While appellant appears to assert that DAT was used only for recording music at the time of appellant's invention, since appellant points to nothing in the instant disclosure alluding to a new kind of DAT, it would appear that appellant was employing a conventional DAT, at the time of the invention, to record the medical information. Thus, it is not clear what appellant relies on that would indicate that there was something new about appellant's DAT which allowed recording of medical images and information, rather than merely music. Accordingly, we fail to

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find anything unobvious about recording such information on the conventional DAT. As presented by appellant, it would appear, at best, that appellant has found a new, but obvious, use for an old storage medium.

Thus, none of appellant's arguments are persuasive to us of the nonobviousness of the instant claimed subject matter and they do not overcome what we perceive to be a prima facie case of obviousness established by the examiner.

We turn to the objective evidence, in the form of the Koike declarations, and view, anew, all of the evidence together with the claimed subject matter as a whole.

We do not agree with the examiner in giving little weight to the declarations "because declarant has only graduated from high school" [Paper No. 67]. We are convinced, from the statements at pages 1-3 of the supplemental declaration, that Mr. Koike, by reason of his education, vocation, technical background and status as a co-patentee on at least nine U.S. patents dealing with medical imaging, is at least one of ordinary skill in this art.

After a thorough review of the specification and the claims, together with the declarations, we find the substance of the declarations to be convincing of nonobviousness of the instant

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claimed subject matter.

Each of the claims on appeal requires at least that a DAT be used for recording and reproducing both medical information and examination image information. Some of the claims, such as independent claims 28, 34, 39 and 40 also require specific formatting of, and then converting, these individual types of information so as to be able to record the different information in a DAT cassette. While the examiner has set forth a prima facie case of obviousness in the use of a DAT for recording and reproducing medical information, by referring to column 5 of Ichikawa, relating to storage on "another recording medium," it is our view that such a prima facie case has been overcome by the evidence provided by the Koike declarations. In the primary declaration, Mr. Koike, an artisan involved with, and familiar with, the recording arts to which the subject application is directed, states, in paragraphs 18-21, that the state of the art at the time of the instant invention was such that there was no contemplation of using a DAT for storing medical information and images. In particular, at paragraph 19, Mr. Koike, an artisan whom we hold to be qualified to offer the opinion, affirmatively states that at the time of the instant invention, "the state-of-the-art was such that DAT technology was being used **only** to store

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digitized audio signals in the form of music" [emphasis ours].

Thus, we have the opinion of a qualified practitioner that DATs were clearly not used for recording and reproducing anything other than digitized audio signals in the form of music, together with a description in the instant specification as to specific formatting used to achieve recording and reproduction of medical information and images by adapting DAT unit 3 (e.g., pages 7-11). The examiner had the opportunity to rebut declarant's allegation by offering evidence showing the recording and/or reproducing of information and/or image data on a DAT but the examiner has failed to provide any such evidence.

Accordingly, in weighing the opinion of a qualified practitioner in the art against the silence of the examiner with regard to a specific showing of using a DAT for recording and/or reproducing anything other than music, we find that the evidence of record compels a finding for appellant. While we suspect that the earliest personal computers, dating from the 1970's, prior to the use of floppy discs, employed audio tape for storing digital information other than music, we have no evidence of this on record. Accordingly, while we find for appellant, that finding is based on the accuracy of declarant's statement that "the state-of-the-art was such that DAT technology was being used **only**

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to store digitized audio signals in the form of music" [emphasis
ours].

The examiner's decision rejecting claims 21, 23-29 and 32-42
under 35 U.S.C. 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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ERROL A. KRASS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

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