

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES L. BURKS, ROBERT R. SCHICK
and SHEILA H. SCHWEITZER

Appeal No. 1999-2311
Application 08/777,805

HEARD: June 14, 2001

Before JERRY SMITH, BARRETT and BARRY, 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, 2, 4-14, 16-23, 28, 29, 32-37, 39-43, 46 and 51-54, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for communicating medical transactions between a

plurality of computer stations, some of which are located at healthcare providers and some of which are located at payors. The invention particularly relates to permitting transactions to take place between computers using different formats and communication protocols.

Representative claim 1 is reproduced as follows:

1. A medical transaction system for communicating data messages between a plurality of computer stations located at healthcare providers and payors, comprising:

a communication receiver for receiving data messages related to patient care activities performed by said healthcare providers, said messages received from said computer stations at said healthcare providers in a plurality of formats and protocols recognized by said communications receiver;

a compiler for compiling patient care information from said data messages received from said computer stations to form a plurality of patient care records having a single common format that is independent of at least one of said plurality of formats and protocols recognized by said communication receiver;

an extractor for extracting ones of said patient care records in accordance with a computer station identification code;

a formatter for formatting said extracted patient care records in a format corresponding to said computer station identification code; and

a communications transmitter for transmitting said formatted patient care records to said computer station

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identified by said identification code in a format and
protocol recognized by said identified computer station.

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The examiner relies on the following reference:

Barber et al. (Barber) 4,858,121 Aug. 15, 1989

Claims 1, 2, 4-14, 16-23, 28, 29, 32-37, 39-43, 46 and 51-54 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Barber taken alone.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief 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 obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the 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 evidence relied upon would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the appealed claims.

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Accordingly, we reverse.

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In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re

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Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to each of independent claims 1, 14, 20 and 39, the examiner finds that Barber teaches the essential aspects of the claimed invention. The examiner finds that any differences between the claimed invention and Barber would have been obvious to the artisan [answer, pages 4-5].

Appellants argue that Barber fails to show any capability for transmitting or receiving information in a

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plurality of formats and protocols as claimed. Appellants argue that Barber requires that all incoming messages from healthcare providers be in a single standard format.

Appellants also argue that there is no suggestion on this record that Barber should be modified to support different formats and protocols. In fact, appellants note that the prior art of record in this case suggests that such modification of Barber would be difficult or impossible [brief, pages 6-15].

The examiner responds that although Barber does not teach that the computer terminals generate messages in a plurality of different formats and protocols, it would have been obvious to do so in view of the well known methods of generating, transferring and receiving data in a plurality of formats and protocols at the time of appellants' invention. The examiner also responds that a plurality of computer stations each having a format would meet the claimed plurality of formats and protocols as claimed. The examiner observes that his proposed modification of Barber would improve the performance of Barber's system. Finally, the examiner takes "official notice" that many systems prior to the claimed

invention have been used to facilitate communications and conversions between dissimilar networks or protocols and many systems have been used for converting data from one format to another format [answer, pages 9-13].

We agree with appellants that the record in this case does not support the examiner's rejection. As noted above, the examiner has the burden of initially presenting a prima facie case of obviousness. The examiner cannot satisfy this burden by simply dismissing differences between the claimed invention and the teachings of the prior art as being obvious. In this case, the examiner must either present a cogent rationale why the artisan would have been motivated to modify the teachings of Barber to arrive at the claimed invention which is supported by the record, or the examiner must present us with an evidentiary record which independently supports the finding of obviousness. The examiner's only rationale for modifying Barber is that the proposed modification would enhance the overall system of Barber {answer, page 11}. The fact that a claimed invention enhances a prior art system is not evidence that the enhancement would have been obvious within the meaning of 35 U.S.C. § 103. It does not matter how

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strong the examiner's convictions are that the claimed invention would have been obvious, or whether we might have an intuitive belief that the claimed invention would have been obvious within the meaning of 35 U.S.C. § 103. Neither circumstance is a substitute for evidence lacking in the record. Whether there is prior art available which would render these appealed claims unpatentable we cannot say. Whether the examiner could have developed a reasonable basis for asserting the obviousness of the claimed invention based on the present record we will not speculate. We can say, however, that the record presently before us does not support the rejection as formulated by the examiner. Therefore, we do not sustain the examiner's rejection of independent claims 1, 14, 20 and 39 or of claims which depend therefrom based on Barber and the rationale provided by the examiner.

For the reasons discussed above, the decision of the examiner rejecting claims 1, 2, 4-14, 16-23, 28, 29, 32-37, 39-43, 46 and 51-54 is reversed.

REVERSED

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