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EXAMINER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
*Inter Partes* Reexamination**

REEXAMINATION CONTROL NUMBER 95/001,088.

PATENT NUMBER 6,188,988.

TECHNOLOGY CENTER 3999.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

**All correspondence** relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

<b>ORDER GRANTING/DENYING REQUEST FOR INTER PARTES REEXAMINATION</b>	<b>Control No.</b>	<b>Patent Under Reexamination</b>	
	95/001,088	6188988	
	<b>Examiner</b>	<b>Art Unit</b>	
	Deandra M. Hughes	3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

The request for *inter partes* reexamination has been considered. Identification of the claims, the references relied on, and the rationale supporting the determination are attached.

Attachment(s):     PTO-892         PTO/SB/08         Other: \_\_\_\_\_

1.  The request for *inter partes* reexamination is GRANTED.
- An Office action is attached with this order.
- An Office action will follow in due course.

2.  The request for *inter partes* reexamination is DENIED.

This decision is not appealable. 35 U.S.C. 312(c). Requester may seek review of a denial by petition to the Director of the USPTO within ONE MONTH from the mailing date hereof. 37 CFR 1.927. EXTENSIONS OF TIME ONLY UNDER 37 CFR 1.183. In due course, a refund under 37 CFR 1.26(c) will be made to requester.

**All correspondence** relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Order.

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**ORDER GRANTING REQUEST FOR *INTER PARTES* REEXAMINATION**

1. A substantial new question of patentability ("SNQ") affecting claims 1-66 of USP 6,188,988 ("Barry") is raised by the *inter partes* reexamination request filed Jan. 10, 2008 ("Request").

***Extensions of Time***

2. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that *inter partes* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.937). Patent Owner extensions of time in *inter partes* reexamination proceedings are provided for in 37 CFR 1.956. Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner's response is set by statute. 35 U.S.C. 314(b)(3).

***Notification of Other Proceedings***

3. The patent owner is reminded of the continuing responsibility under 37 CFR 1.985(a) to apprise the Office of any litigation activity, or other concurrent proceeding, involving **USP 6,188,988** throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §2686 and 2686.04.

***References Cited in this Action***

4. Shortliffe, E.H., "*Mycin: A Rule-Based Computer Program for Advising Physicians Regarding Antimicrobial Therapy Selection*," (Ph.D. thesis, Stanford

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- University) (on file with Mathematical and Computer Sciences Library, Stanford University), Stanford Artificial Intelligence Laboratory Memo AIM-251, Computer Science Department Report No. STAN-CS-74-465, National Technical Information Service (NTIS) Technical Report No. AD-A001 373 (1974); **(hereafter "Shortliffe")**
5. Kulikowski, C.A. and Weiss, S.M., "Representation of Expert Knowledge for Consultation: The CASNET and EXPERT Projects," in *Artificial Intelligence in Medicine*, pp. 21-55 (Peter Szolovits ed., Westview Press, Boulder, CO) (1982) **(hereafter "Kulikowski")**
  6. Miller, P.L. and Black, H.R., "Medical Plan-Analysis by Computer: Critiquing Pharmacologic Management of Essential Hypertension," *Computers and Biomedical Research* 17:38-54 (1984) **(hereafter "Miller")**
  7. Siepman, J.P. and Bachman, J.W., "HTN-APT: Computer Aid in Hypertension Management," *Journal of Family Practice* 24:313-316(1987) **(hereafter "Siepman")**
  8. Evans, R.S., *et al.*, "Development of an Automated Antibiotic Consultant," *M.D. Computing: Computers in Medical Practice* 10:17-22 (1993) **(hereafter "Evans 1993")**
  9. Hickam, D.H., *et al.*, "The Treatment Advice of a Computer-Based Cancer Chemotherapy Protocol Advisor," *Annals of Internal Medicine* 103:928-936 (1985) **(hereafter "Hickam")**
  10. Langlotz, C.P., *et al.*, "A Therapy Planning Architecture That Combines Decision Theory and Artificial Intelligence Techniques," *Computers and Biomedical Research* 20:279-303 (1987) **(hereafter "Langlotz")**
  11. Evans, R.S., *et al.*, "A Decision Support Tool for Antibiotic Therapy," *1995 Proceedings of the Annual Symposium on Computer Applications in Medical Care*, pp. 651-655 (1995) **(hereafter "Evans 1995")**
  12. Degoulet, P., *et al.*, "Computer-assisted Techniques for Evaluation and Treatment of Hypertensive Patients," *American Journal of Hypertension* 3:156-163 (1990) **(hereafter "Degoulet")**
  13. Perry, C.A., "Knowledge bases in medicine: a review" *Bulletin of the Medical Library Association* 78:271-282 (1990) **(hereafter "Perry")**
  14. Nienow, J.R., Spach, D.H., Hooton, T.M, and Collier, A.C., "Antiretroviral Therapy," in *The HIV Manual: A Guide to Diagnosis and Treatment*, pp. 60-88 (David H. Spach and Thomas M. Hooton eds., Oxford University Press, New York) (1996) **(hereafter "Nienow")**

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15. Shafer, R.W. and Merigan, T.C., "Editorial: New Virologic Tools for the Design and Analysis of Clinical Trials," *Journal of Infectious Diseases*, 171:1325-1328 (1995) (**hereafter "Shafer"**)
16. Bartlett, J.G., *Medical Management of HIV Infection* (available as internet pages archived on June 1, 1997):

[http://web.archive.org/web/19970601005020/www.hopkins-aids.edu/jhas\\_htmlcode/jhas\\_book/jhas\\_book.html](http://web.archive.org/web/19970601005020/www.hopkins-aids.edu/jhas_htmlcode/jhas_book/jhas_book.html)

[http://web.archive.org/web/19970601005936/www.hopkins-aids.edu/jhas\\_htmlcode/jhas\\_book/D.MedMgt.Ch01.FM.html](http://web.archive.org/web/19970601005936/www.hopkins-aids.edu/jhas_htmlcode/jhas_book/D.MedMgt.Ch01.FM.html)

[http://web.archive.org/web/19970601005953/www.hopkins-aids.edu/jhas\\_htmlcode/jhas\\_book/D.MedMgt.Ch02.FM.html](http://web.archive.org/web/19970601005953/www.hopkins-aids.edu/jhas_htmlcode/jhas_book/D.MedMgt.Ch02.FM.html)

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[http://web.archive.org/web/19970601010035/www.hopkins-aids.edu/jhas\\_htmlcode/jhas\\_book/D.MedMgt.Ch05.FM.html](http://web.archive.org/web/19970601010035/www.hopkins-aids.edu/jhas_htmlcode/jhas_book/D.MedMgt.Ch05.FM.html)

[http://web.archive.org/web/19970601010059/www.hopkins-aids.edu/jhas\\_htmlcode/jhas\\_book/D.MedMgt.Ch06.FM.html](http://web.archive.org/web/19970601010059/www.hopkins-aids.edu/jhas_htmlcode/jhas_book/D.MedMgt.Ch06.FM.html)

[http://web.archive.org/web/19970601010115/www.hopkins-aids.edu/jhas\\_htmlcode/jhas\\_book/D.MedMgt.Ch07.FM.html](http://web.archive.org/web/19970601010115/www.hopkins-aids.edu/jhas_htmlcode/jhas_book/D.MedMgt.Ch07.FM.html)

Bartlett, J.G., *Medical Management of HIV Infection* (Port City Press, Baltimore) (1997) (**hereafter "Bartlett"**)

17. Pazzani, M., *et al.*, "CTSHIV: A Knowledge-Based System for the Management of HIV-Infected Patients," in *Intelligent Information Systems*, pp. 7-13 (Hojjat Adeli ed., IEEE Computer Society, Los Alamitos, CA) (1997) (**hereafter "Pazzani"**)

#### ***Prosecution History***

18. On July 7, 2000, a non-final rejection of claims 1-4, 6-27, 29-50, and 52-69 under the judicially created doctrine of obviousness-type double patenting was issued. Claims 5, 28, and 51 were cancelled in a preliminary amendment dated 03/10/2000.

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- (A) Claims 1-4 and 6-23 were rejected under the judicially created doctrine of obviousness-type double patenting and were considered unpatentable over claims 1-4 and 6-22 of USP 6,081,786.
- (B) Claims 24-27 and 29-46 were rejected under the judicially created doctrine of obviousness-type double patenting and were considered unpatentable over claims 23-27 and 29-44 of USP 6,081,786.
- (C) Claims 47-50 and 52-69 were rejected under the judicially created doctrine of obviousness-type double patenting and were considered unpatentable over claims 47-50 and 52-69 of USP 6,081,786.

Following the double-patenting rejection, the Examiner indicated claims 1-4, 6-27, 29-50, and 52-69 were allowable over the prior art of record. (pages 4-6). The Examiner stated as the reasons for allowance that a method, system, or computer program taken either individually or in combination with other prior art of record fails to teach or suggest a method, system, or computer program for:

- (A) guiding the selection of a therapeutic treatment regimen for a patient with a known disease or medical condition;
- (B) the method, system, or computer program comprising providing patient information to a computing device specifically comprising the three distinct knowledge bases wherein:
  - (i) the first knowledge base comprises a plurality of different therapeutic treatment regimens for said disease or medical condition;
  - (ii) the second knowledge base comprises a plurality of expert rules for evaluating and selecting a therapeutic regimen for said disease or medical condition;
  - (iii) the third knowledge base comprises advisory information useful for the treatment of a patient with different constituents of said different therapeutic treatment regimens; and
- (C) generating in a computing device a listing of available therapeutic treatment regimens based on the patient information and the first knowledge base; and

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- (D) generating advisory information for one or more therapeutic treatment regimens in the listing based on the patient information and expert rules.

Applicant filed a terminal disclaimer on August 7, 2000 obviating the double-patenting rejections. As a result, the Examiner issued a Notice of Allowance of claims 1-4, 6-27, 29-50, and 52-69.

19. The requester considers the following references to present Substantial New Questions of Patentability (**hereafter "SNQs"**)

- (A) Shortliffe presents an SNQ with respect to claims 1-3, 5-8, 12, 14, 17, 20-25, 27-30, 34, 36, 39, 42-47, 49-51, 55, 57, 60, and 63-66.
- (B) Kulikowski presents an SNQ with respect to claims 1, 5, 6, 8, 12, 21, 23, 27, 28, 30, 34, 43, 45, 49, 51, 55, 64, and 66.
- (C) Miller presents an SNQ with respect to claims 1-3, 5, 7, 12, 13, 20-25, 27, 29, 34, 35, 42-47, 50, 55, 56, and 63-66.
- (D) Siepman presents an SNQ with respect to claims 1, 5, 6, 8, 12-14, 20-23, 27, 28, 30, 34-36, 42-45, 49, 51, 55-57, and 63-66.
- (E) Evans 1993 presents an SNQ with respect to claims 1, 5-8, 12, 14, 17, 20-23, 27-30, 34, 36, 39, 42-45, 49-51, 55, 57, 60, and 63-66.
- (F) Hickam in combination with Langlotz presents an SNQ with respect to claims 1, 5-8, 16, 21, 23, 27-30, 38, 43, 45, 49-51, 59, 64, and 66.
- (G) Evans 1993 in combination with Evans 1995 presents an SNQ with respect to claims 1-3, 5, 7, 23-25, 27, 29, 45-47, 50, and 66 .
- (H) Siepman in combination with Degoulet presents an SNQ with respect to claims 1, 5-8, 13, 21, 23, 27-30, 35, 43, 45, 49-51, 56, 64, and 66.
- (I) Shortliffe in combination with Perry presents an SNQ with respect to claims 13-19, 22, 35-41, 44, 56-62, and 65.
- (J) Shortliffe in combination with Nienow presents an SNQ with respect to claims 4, 9-11, 19, 26, 31-33, 41, 48, 52-54, and 62.
- (K) Shortliffe in combination with Nienow and Shafer presents an SNQ with respect to claims 4, 26, and 48.



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- (L) Shortliffe in combination with Bartlett presents an SNQ with respect to claims 4, 9-11, 19, 26, 31-33, 41, 48, 52-54, and 62.
- (M) Shortliffe in combination with Pazzani presents an SNQ with respect to claims 1, 9, 12, 19, 20, 23, 31, 34, 41, 42, 45, 52, 55, 62, and 63.
- (N) Miller in combination with Nienow presents an SNQ with respect to claims 4, 9-11, 19, 26, 31-33, 41, 48, 52-54, and 62.

### ***Summary of the Decision***

20. The following is a summary of the decision on the SNQ's presented in the instant request for the *Inter Partes* reexamination:

- (A) It is not agreed that Shortliffe presents an SNQ with respect to claims 1-3, 5-8, 12, 14, 17, 20-25, 27-30, 34, 36, 39, 42-47, 49-51, 55, 57, 60, and 63-66.
- (B) It is not agreed that Kulikowski presents an SNQ with respect to claims 1, 5, 6, 8, 12, 21, 23, 27, 28, 30, 34, 43, 45, 49, 51, 55, 64, and 66.
- (C) It is not agreed that Miller presents an SNQ with respect to claims 1-3, 5, 7, 12, 13, 20-25, 27, 29, 34, 35, 42-47, 50, 55, 56, and 63-66.
- (D) It is not agreed that Siepman presents an SNQ with respect to claims 1, 5, 6, 8, 12-14, 20-23, 27, 28, 30, 34-36, 42-45, 49, 51, 55-57, and 63-66.
- (E) It is not agreed that Evans 1993 presents an SNQ with respect to claims 1, 5-8, 12, 14, 17, 20-23, 27-30, 34, 36, 39, 42-45, 49-51, 55, 57, 60, and 63-66.
- (F) It is not agreed Hickam in combination with Langlotz presents an SNQ with respect to claims 1, 5-8, 16, 21, 23, 27-30, 38, 43, 45, 49-51, 59, 64, and 66.
- (G) It is not agreed that Evans 1993 in combination with Evans 1995 presents an SNQ with respect to claims 1-3, 5, 7, 23-25, 27, 29, 45-47, 50, and 66 .
- (H) It is not agreed that Siepman in combination with Degoulet presents an SNQ with respect to claims 1, 5-8, 13, 21, 23, 27-30, 35, 43, 45, 49-51, 56, 64, and 66.
- (I) It is agreed that Shortliffe in combination with Perry presents an SNQ with respect to claims 13-19, 22, 35-41, 44, 56-62, and 65.

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- (J) It is not agreed that Shortliffe in combination with Nienow presents an SNQ with respect to claims 4, 9-11, 19, 26, 31-33, 41, 48, 52-54, and 62.
- (K) It is not agreed that Shortliffe in combination with Nienow and Shafer presents an SNQ with respect to claims 4, 26, and 48.
- (L) It is not agreed that Shortliffe in combination with Bartlett presents an SNQ with respect to claims 4, 9-11, 19, 26, 31-33, 41, 48, 52-54, and 62.
- (M) It is not agreed that Shortliffe in combination with Pazzani presents an SNQ with respect to claims 1, 9, 12, 19, 20, 23, 31, 34, 41, 42, 45, 52, 55, 62, and 63.
- (N) It is not agreed that Miller in combination with Nienow presents an SNQ with respect to claims 4, 9-11, 19, 26, 31-33, 41, 48, 52-54, and 62.

***Response to Third Party Requester's ("3PR's") Arguments***

21. 3PR argues the following:

- (A) "To the extent that the Examiner relied on the notion that the '988 claims require the three knowledge bases to be "distinct," he was in error as a matter of law. MPEP § 2111 provides that pending claims must be given their broadest reasonable interpretation consistent with the specification. The words of the claims "must be given their plain meaning unless the plain meaning is inconsistent with the specification." Because the '988 claims do not recite a requirement that the claimed knowledge bases be "distinct," and because the specification does not include any act of lexicography supporting such a limiting construction or that is in any way inconsistent with the plain meaning of the claims, the Examiner should not have read a requirement for "distinct" knowledge bases into the claims, contrary to their plain meaning." (1st paragraph, pg. 22)
- (B) "One amendment and argument requires mention. Applicants inserted the word "chronic" into the phrase "known disease or medical condition" in each independent claim. Applicants also stated that Pazzani, an HIV system, and Evans, a bacterial infection system, are not "concerned with selecting treatment regimens for a patient afflicted with a *chronic* disease or condition." But this argument is inconsistent with the proper interpretation of the '988 claims. The meaning of the term "chronic known disease or medical condition" is apparent by reading the dependent claims. In particular, claims 9 and 13-19 further limit claim 1 to particular known diseases including HIV infection, cancer, urinary tract infection, and hepatitis. Proper claim reading dictates that each of these particular known diseases is "chronic" as that term is used in the '988 patent because a dependent claim must be read to include all the limitations of

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the claim from which it depends, and cannot be internally inconsistent. In other words, the patentee cannot argue that the independent claims *exclude* certain diseases when the dependent claims *expressly include* the same diseases. Thus, for assessing the patentability of the '988 patent, HIV infection, cancer, urinary tract infection, hepatitis, etc., are all "chronic known diseases." And, in any event, there is nothing in the specification to suggest that the addition of the known element of suggesting therapies for chronic disease would be a non-obvious substitution to otherwise anticipated claims." (1<sup>st</sup> paragraph, pg. 21)

Argument (A) is unpersuasive because the words of independent claims 1, 23, and 45 are given their plain meaning in that the knowledge bases are identified as a 'first' knowledge base, a 'second' knowledge base, and a 'third' knowledge base. For example, a 'first' knowledge base is inherently distinct from a 'second' knowledge base because the alternative would be for the knowledge bases to be indistinct thereby rendering the terms 'first' and 'second' meaningless. Accordingly, it is unpersuasive that the Examiner erred as a matter of law when relying on the notion that the claims require the three knowledge bases to be 'distinct'.

Argument (B) is immaterial to this order because the Examiner did not rely on the term 'chronic' in his reasons for allowance. As a result, the issue of whether a disease is 'chronic' is immaterial for determining whether a reference presents a SNQ.

### ***Decision***

#### ***SNQ (A): Shortliffe***

22. It is not agreed that the consideration of Shortliffe raises a SNQ as to claims 1-3, 5-8, 12, 14, 17, 20-25, 27-30, 34, 36, 39, 42-47, 49-51, 55, 57, 60, and 63-66 of the Barry patent because Shortliffe does not disclose a first **knowledge base** which comprises a plurality of different therapeutic treatment regimens for said disease or medical condition. Inter alia, 3PR identifies a list of drugs and specific therapeutic

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regimens labeled PROP-THER comprising those clinical parameters which are attributes of therapies being considered for recommendation (see Request, pgs. 37-38).

However, Shortliffe specifically states that the "distinction between MYCIN'S knowledge-base and data-base should be understood because the terms are used in their specialized sense throughout this thesis." (pg. 43, 2<sup>nd</sup> paragraph). Further, Shortliffe specifically states that the corpus of decision rules outlined in the first paragraph of page 43 is "termed the 'knowledge-base' of the MYCIN system" and that "system knowledge must be contrasted with MYCIN's database." (pg. 43). Shortliffe specifically notes that "information about the patient under consideration is termed 'patient data'" and then subsequently emphasizes the importance in maintaining the distinction between MYCIN's knowledge-base and data-base (2<sup>nd</sup> paragraph, pg. 43).

Also, Patent Owner specifically states in column 7:55-58 that "an expert system typically contains a knowledge base containing accumulated experience and a set of rules for applying the knowledge base to each particular situation that is described to the program." Furthermore, Shortliffe does not disclose a **third knowledge base** comprising advisory information useful for the treatment of a patient with different constituents of said different therapeutic regimens. 3PR cites, inter alia, page 104 of Shortliffe wherein it states "This chapter specifically describes the Consultation System (Subprogram 1). As indicated in Figure 1-1, the subprogram uses both system knowledge from the corpus of rules, plus patient data entered by the physician, in order to generate advice from the user." (see Request, pg. 40). This can not be a *third* knowledge base because it is comprised of at least, the second knowledge base which

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is the corpus of 200 decision rules. For the reasons set forth above in the Response to 3PR's arguments, the claimed knowledge bases are distinct.

Accordingly, Shortliffe does not present an SNQ with respect to claims 1-3, 5-8, 12, 14, 17, 20-25, 27-30, 34, 36, 39, 42-47, 49-51, 55, 57, 60, and 63-66 because Shortliffe does not disclose a first **knowledge base** comprising different therapeutic regimens for said disease or condition.

***SNQ (B): Kulikowski***

23. It is not agreed that the consideration of Kulikowski raises a SNQ as to claims 1, 5-6, 8, 12, 21, 23, 27-28, 30, 34, 43, 45, 49, 51, 55, 64, and 66 of the Barry patent.

Kulikowski does not disclose a third knowledge base comprising **advisory information useful for the treatment of a patient with different constituents of said different therapeutic regimens**. 3PR cites page 26 of Kulikowski as disclosing the third knowledge base. (see Request, pg. 58). However, the cited disclosure does not disclose that the "additional feature of the system" comprises information useful for the **treatment of a patient with different constituents of said different therapeutic treatment regimens**.

Further, 3PR cites pages 33-34 of Kulikowski as disclosing the third knowledge base. However, the cited portion does not disclose that the knowledge base is a **third** knowledge base. Pages 33-34 merely reference the entire CASNET model, which comprises first knowledge base, i.e. the General Class of Therapies and the second knowledge base, i.e. the restriction rules R1-R3, but does not disclose a third, distinct,

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knowledge base. Accordingly, Kulikowski does not raise a SNQ as to claims 1, 5-6, 8, 12, 21, 23, 27-28, 30, 34, 43, 45, 49, 51, 55, 64, and 66.

***SNQ (C): Miller***

24. It is not agreed that the consideration of Miller raises a SNQ as to claims 1-3, 5, 7, 12-13, 20-25, 27, 29, 34-35, 42-47, 50, 55-56, and 63-66 of the Barry patent. Miller does not disclose a third knowledge base comprising advisory information useful for the treatment of a patient **with different constituents of said different therapeutic regimens**. 3PR cites pages 38 and 44-45 of Miller as disclosing the third knowledge base comprising new drugs and new treatment modalities wherein the third knowledge base mentions relevant topical issues all in the context of discussing an approach to a particular patient's care. (see Request, pg. 67). However, the cited portions do not disclose that the third knowledge base comprises advisory information useful for the treatment of a **patient with different constituents of said different therapeutic regimens**. Accordingly, Miller does not raise a SNQ as to claims 1-3, 5, 7, 12-13, 20-25, 27, 29, 34-35, 42-47, 50, 55-56, and 63-66.

***SNQ (D): Siepman***

25. It is not agreed that the consideration of Siepman raises a SNQ as to claims 1, 5-6, 8, 12-14, 20-23, 27-28, 30, 34-36, 42-45, 49, 51, 55-57, and 63-66 of the Barry patent. Siepman does not disclose three distinct knowledge bases. The knowledge databases cited by 3PR (see Request pgs. 79-80) are not disclosed as distinct databases. In addition, Siepman does not disclose a third knowledge base comprising advisory information useful for the treatment of a patient **with different constituents of**

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**said different therapeutic regimens.** 3PR cites page 315 of Siepman as disclosing the third knowledge base comprising “the suitability of [the recommended] treatment options for the patient” and “the information necessary to prescribe any of the drugs.” (see Request, pg. 80). However, the cited portions do not disclose that the third knowledge base comprises advisory information useful for the treatment of a **patient with different constituents of said different therapeutic regimens.** Accordingly, Siepman does not raise a SNQ as to claims 1, 5-6, 8, 12-14, 20-23, 27-28, 30, 34-36, 42-45, 49, 51, 55-57, and 63-66.

***SNQ (E): Evans 1993***

26. It is not agreed that the consideration of Evans 1993 raises a SNQ as to claims 1, 5-8, 12, 14, 17, 20-23, 27-30, 34, 36, 39, 42-45, 49-51, 55, 57, 60, and 63-66 of the Barry patent. Evans 1993 does not disclose three distinct knowledge bases. The knowledge bases cited by 3PR (see Request pgs. 88-89) are not disclosed as distinct databases. In addition, Evans 1993 specifically teaches that “because the information is coded, **a knowledge base** can analyze and monitor patient care.” (emphasis added; pg. 18) Accordingly, Evans 1993 does not raise a SNQ as to claims 1, 5-8, 12, 14, 17, 20-23, 27-30, 34, 36, 39, 42-45, 49-51, 55, 57, 60, and 63-66.

***SNQ (F): Hickman in Combination with Langlotz***

27. It is not agreed that the consideration of Hickman in combination with Langlotz raises a SNQ as to claims 1, 5-8, 16, 21, 23, 27-30, 38, 43, 45, 49-51, 59, 64, and 66 of the Barry patent. Hickman does not disclose three distinct knowledge bases. The knowledge databases cited by 3PR (see Request pgs. 101-103) are not disclosed as

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distinct databases. In addition, the portions of Langlotz cited in the Request (see pgs. 101-103) do not teach modifying a knowledge base such as that disclosed in Hickman to comprise three distinct knowledge bases. Further, neither Hickman nor Langlotz discloses a knowledge base comprising advisory information useful for the treatment of a patient **with different constituents of said different therapeutic regimens**

Accordingly, Hickman in combination with Langlotz does not raise a SNQ as to claims 1, 5-8, 16, 21, 23, 27-30, 38, 43, 45, 49-51, 59, 64, and 66.

***SNQ (G): Evans 1993 in Combination with Evans 1995***

28. It is not agreed that the consideration of Evans 1993 in combination with Evans 1995 raises a SNQ as to claims 1, 5-8, 12, 14, 17, 20-23, 27-30, 34, 36, 39, 42-45, 49-51, 55, 57, 60, and 63-66 of the Barry patent. Evans 1993 does not disclose three distinct knowledge bases for the reasons set forth above in the decision of **SNQ (E)**. In addition, Evans 1993 specifically teaches that "because the information is coded, **a knowledge base** can analyze and monitor patient care." (emphasis added; pg. 18). The cited portions of Evans 1995 (see Request, pg. 116) do not teach modifying a knowledge base such as that disclosed in Evans 1993 to comprise three distinct knowledge bases. Accordingly, Evans 1993 in view of Evans 1995 does not raise a SNQ as to claims 1, 5-8, 12, 14, 17, 20-23, 27-30, 34, 36, 39, 42-45, 49-51, 55, 57, 60, and 63-66. claims 1-3, 5, 7, 23-25, 27, 29, 45-47, 50, and 66

***SNQ (H): Siepman in Combination with Degoulet***

29. It is not agreed that the consideration of Siepman raises a SNQ as to claims 1, 5-8, 13, 21, 23, 27-30, 35, 43, 45, 49-51, 56, 64, and 66 of the Barry patent. Siepman



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does not disclose a third knowledge base comprising advisory information useful for the treatment of a patient **with different constituents of said different therapeutic regimens**. Further, Degoulet does not contain a teaching for modifying the invention of Siepman with a third knowledge base comprising advisory information useful for the treatment of a patient **with different constituents of said different therapeutic regimens**. Accordingly, Siepman in combination with Degoulet does not raise a SNQ as to claims 1, 5-8, 13, 21, 23, 27-30, 35, 43, 45, 49-51, 56, 64, and 66.

***SNQ (I): Shortliffe in Combination with Perry***

30. It is agreed that the consideration of Shortliffe in combination with Perry raises a SNQ as to claims 13-19, 22, 35-41, 44, 56-62, and 65. For the reasons set forth above in the determination of **SNQ (A)**, Shortliffe does not disclose first and third knowledge bases. However, Perry teaches updating Shortliffe's MYCIN with additional knowledge bases. (pg. 274, 2<sup>nd</sup> column). The teaching as to the adaptation of Shortliffe's MYCIN with additional knowledge bases was not present in the prosecution of the application which became the Barry patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 13-19, 22, 35-41, 44, 56-62, and 65 are patentable. Accordingly, Shortliffe in combination with Perry raises a SNQ as to claims 13-19, 22, 35-41, 44, 56-62, and 65, which question has not been decided in a previous examination of the Barry patent.

***SNQ (J): Shortliffe in Combination with Nienow***

14. It is not agreed that the consideration of Shortliffe in combination with Nienow raises a SNQ as to claims 4, 9-11, 19, 26, 31-33, 41, 48, 52-54, and 62 of the Barry

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patent for the reasons set forth above in the determination of **SNQ (A)**. Shortliffe does not disclose first and third knowledge bases. Further, Nienow does not contain a teaching for modifying the invention of Shortliffe with additional knowledge bases. Accordingly, Shortliffe in combination with Nienow does not raise a SNQ as to claims 4, 9-11, 19, 26, 31-33, 41, 48, 52-54, and 62.

***SNQ (K): Shortliffe in Combination with Nienow and Shafer***

15. It is not agreed that the consideration of Shortliffe in combination with Nienow and Shafer raises a SNQ as to claims 4, 26, and 48 of the Barry patent for the reasons set forth above in the determination of **SNQ (A)**. Shortliffe does not disclose first and third knowledge bases. Further, neither Nienow nor Shafer contain a teaching for modifying the invention of Shortliffe with additional knowledge bases. (see Request, pg. 152). Accordingly, Shortliffe in combination with Nienow and Shafer does not raise a SNQ as to claims 4, 26, and 48.

***SNQ (L): Shortliffe in Combination with Bartlett***

16. It is not agreed that the consideration of Shortliffe in combination with Bartlett raises a SNQ as to claims 4, 9-11, 19, 26, 31-33, 41, 48, 52-54, and 62 of the Barry patent for the reasons set forth above in the determination of **SNQ (A)**. Shortliffe does not disclose first and third knowledge bases. Further, Bartlett does not contain a teaching for modifying the invention of Shortliffe with additional knowledge bases. (see Request, pg. 160) Accordingly, Shortliffe in combination with Bartlett does not raise a SNQ as to claims 4, 9-11, 19, 26, 31-33, 41, 48, 52-54, and 62.

***SNQ (M): Shortliffe in Combination with Pazzani***

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17. It is not agreed that the consideration of Shortliffe in combination with Pazzani raises a SNQ as to claims 1, 9, 12, 19-20, 23, 31, 34, 41-42, 45, 52, 55, and 62-63 of the Barry patent for the reasons set forth above in the determination of **SNQ (A)**. Shortliffe does not disclose first and third knowledge bases. Further, Pazzani does not contain a teaching for modifying the invention of Shortliffe with additional knowledge bases. (see Request pg. 179). Accordingly, Shortliffe in combination with Pazzani does not raise a SNQ as to claims 1, 9, 12, 19-20, 23, 31, 34, 41-42, 45, 52, 55, and 62-63 .

***SNQ (N): Miller in Combination with Nienow***

18. It is not agreed that the consideration of Miller in combination with Nienow raises a SNQ as to claims 4, 9-11, 19, 26, 31-33, 41, 48, 52-54, and 62 of the Barry patent for the reasons set forth above in the determination of **SNQ (C)**. Further, Nienow does not contain a teaching for modifying the invention of Miller with additional knowledge bases. (see Request, pg. 187) Accordingly, Shortliffe in combination with Bartlett does not raise a SNQ as to claims 4, 9-11, 19, 26, 31-33, 41, 48, 52-54, and 62.

***Conclusion***

19. For the reasons above, claims 13-19, 22, 35-41, 44, 56-62, and 65 of the Barry patent will be reexamined.

20. **All** correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam  
Attn: Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

21. Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at:

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

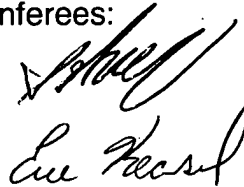
25. Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

/Deandra M. Hughes/

Deandra M. Hughes  
Primary Examiner  
Central Reexamination Unit 3992  
(571) 272-6982

Conferees:



The image shows two handwritten signatures in black ink. The top signature is a stylized cursive signature, and the bottom signature is also in cursive, appearing to read 'Eve K...'. Both signatures are written over the word 'Conferees:'.