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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/011,055.

PATENT NO. 6188988.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

8/28/10 NK  
Loeb

383003-988X

File Petition

9/21/10

DOCKETED  
8/28/10 NK



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/011,055	06/21/2010	6188988	383003-988RX (106555)	1562

20792      7590      08/21/2010  
MYERS BIGEL SIBLEY & SAJOVEC  
PO BOX 37428  
RALEIGH, NC 27627

EXAMINER

ART UNIT      PAPER NUMBER

DATE MAILED: 08/21/2010

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

<b>Order Granting / Denying Request For Ex Parte Reexamination</b>	<b>Control No.</b>	<b>Patent Under Reexamination</b>	
	90/011,055	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 *ex parte* reexamination filed 21 June 2010 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)  PTO-892,      b)  PTO/SB/08,      c)  Other: \_\_\_\_\_

1.  The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2.  The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 ( c ) will be made to requester:

- a)  by Treasury check or,
- b)  by credit to Deposit Account No. \_\_\_\_\_, or
- c)  by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

/Deandra M Hughes/ Primary Examiner, Art Unit 3992		
cc:Requester ( if third party requester )		

### DENIAL OF REQUEST FOR *EX PARTE* REEXAMINATION

1. In this fourth request for reexamination of **USP 6,188,988** ("**'988 patent**") substantial new questions of patentability ("**SNQ**") affecting **claims 1-66** have been proposed by the third party requester ("**3PR**") in the *ex parte* reexamination request filed June 28, 2010 ("**Request**").

#### References

2. Bruce G. Buchanan and Edward H. Shortliffe. Rule-Based Expert Systems: The MYCIN Experiments of the Stanford Heuristic Programming Project. Addison-Wesley Publishing. 1984. ("**MYCIN**")
3. Edward H. Shortliffe. "MYCIN: A Rule-Based Computer Program for Advising Physicians Regarding Antimicrobial Therapy Selection." (Ph.D. Thesis. Stanford University. 1974. ("**Shortliffe**")
4. Ong Lea Suan. Computer-Aided Diagnosis and Treatment of Malaria: The IMEX System. Comp. Biol. Med. No. 5. Pp. 361-372. 1990. ("**Suan**")
5. Declaration of Edward H. Shortliffe dated July 7, 2009. ("**Shortliffe Declaration**")

#### Prosecution History

6. A brief summary of the prosecution history of the '**988 patent** is presented below.
  - On Sept. 11, 2000, claims 1-4, 6-27, 29-50, 52-69 (now numbered **claims 1-66**) in the application (09/523,532) which became the '**988 patent** were allowed.
  - On June 26, 2008, *ex parte* reexamination (90/009,213) of **claims 1-66** of the '**988 patent** was requested.
    - On Sept. 15, 2008, the reexamination filing date was vacated because third party requester ("**3PR**") failed to provide the requisite pertinency and manner of applying the cited prior art to every claim for which reexamination is requested.
    - The decision to vacate the filing date expressly stated, *inter alia*, that 3PR failed to provide a detailed explanation of how the rejections over **MYCIN** applied to every claim of the '**988 patent**.

- On Oct. 14, 2008, 3PR submitted a corrected reexamination request which received a filing date. Among the proposed SNQs of this request, 3PR proposed the following 10 SNQs over **MYCIN**:
  - (i) **MYCIN** alone
  - (ii) **MYCIN** in view of Pazzani
  - (iii) **MYCIN** in view of Miller
  - (iv) **MYCIN** in view of Kuperman
  - (v) **MYCIN** in view of Miller and Vlahavas
  - (vi) **MYCIN** in view of Kuperman and Vlahavas
  - (vii) **MYCIN** in view of Miller and Barrett
  - (viii) **MYCIN** in view of Kuperman and Barrett
  - (ix) **MYCIN** in view of Warner
  - (x) **MYCIN** in view of Zhao
- On Nov. 29, 2008, an order was issued in the *ex parte* proceeding (90/009,213) granting reexamination of claims 1-66 over, *inter alia*, the SNQs presented by the **MYCIN** reference.
- On Oct. 10, 2008, *inter partes* reexamination of claims 1-66 of the '988 patent was requested over, *inter alia*, 6 SNQ's over the Edward H. Shortliffe's thesis on the **MYCIN** system. These SNQs included:
  - (i) **Shortliffe** alone
  - (ii) **Shortliffe** in view of Perry
  - (iii) **Shortliffe** in view of Nienow
  - (iv) **Shortliffe** in view of Nienow and Shafer
  - (v) **Shortliffe** in view of Bartlett
  - (vi) **Shortliffe** in view of Pazanni

- On Jan. 7, 2009, an order was issued in the *inter partes* proceeding (95/001,088) granting reexamination of **claims 1-66** over, *inter alia*, the SNQs presented by the **Shortliffe** reference.
- On Mar. 19, 2009, the *ex parte* proceeding (90/009,213) and the *inter partes* (95/001,088) proceeding were merged.
- On June 11, 2009, **claims 1-66** were confirmed as patentable, *inter alia*, over the **MYCIN** reference (alone or in combination with another reference) and the **Shortliffe** reference (alone or in combination with another reference).
- On July 10, 2009, *ex parte* reexamination (90/010,599) of **claims 1-66** of the '988 patent was again requested, *inter alia*, over the **MYCIN** reference.
- On Oct. 9, 2009, an order was issued in the *ex parte* proceeding (90/010,599) granting reexamination of **claims 1-66** over, *inter alia*, the SNQs presented by the Lau reference. However, the SNQs as to the **MYCIN** reference were denied.
  - In the reasons for denying the SNQ over **MYCIN**, alone or in combination with another reference, the Examiner stated that both the **MYCIN** reference and the **Shortliffe** reference, which cover the same MYCIN system, were thoroughly addressed and distinguished in the merged 90/009,213 and 95/001,088 proceeding.
  - Further, 3PR's attempt to cast the **MYCIN** reference in a new light based on a Declaration of Edward H. Shortliffe filed with the request was unpersuasive because the **Shortliffe Declaration** addressed knowledge structures and not the claimed knowledge bases. As such, the proposed SNQs over the **MYCIN** reference cast in the light of the **Shortliffe Declaration** were denied.
  - The submitted **MYCIN** SNQs were as follows:
    - (i) **MYCIN** in view of Lau
    - (ii) **MYCIN** in view of Lau and Nienow
    - (iii) **MYCIN** in view of **Suan**
    - (iv) **MYCIN** in view of Van Heijst

(v) **MYCIN** in view of Van Heijst and Nienow

(vi) **MYCIN** in view of Windyga

- On Dec. 22, 2009, **claims 1-66** were confirmed as patentable over the Lau reference in the 90/010,599 proceeding.
- On Aug. 13, 2010, a notice to issue a reexamination certificate was mailed confirming **claims 1-66** in the merged 90/009,213 and 95/001,088 proceeding

7. The reasons for confirming the claims as patentable through the reexamination proceedings have consistently been that the prior art of record did not reach or make obvious:

- a first knowledge base comprising a plurality of different therapeutic treatment regimens for said disease or medical condition;
- a second knowledge base comprising a plurality of expert rules for evaluating and selecting a therapeutic treatment regimen for said disease or medical condition;
- a third knowledge base comprising advisory information useful for the treatment of a patient with different constituents of said different therapeutic treatment regimens.

Consequently, the Examiner considers a teaching as to these claimed three distinct knowledge bases to form the proper basis of an SNQ as to the **'988 patent**.

8. In the first request for reexamination (90/009,213), 3PR proposed ten SNQs based on the **MYCIN** system. In the second request for reexamination (95/001,088), 3PR proposed six SNQs based on the **MYCIN** system as discussed in the **Shortliffe** reference. In the third request for reexamination (90/010,599), proposed six more SNQs based on the **MYCIN** system. As such, 3PR has proposed 22 SNQs based on the **MYCIN** system over three reexamination proceedings.

Here in this 4<sup>th</sup> request for reexamination, 3PR again proposes **MYCIN** in view of **Suan** as an SNQ. However in this 4<sup>th</sup> request, 3PR proposes a materially different interpretation of the **Suan** reference than the interpretation of **Suan** taken in the 3<sup>rd</sup> request (90/010,599). In the 3<sup>rd</sup> request, 3PR stated that **Suan** does not disclose a distinct first knowledge base whereas in this 4<sup>th</sup> request, 3PR has removed this admission from the claim charts and now argues that **Suan** teaches the claimed first knowledge base. Please compare the following admission with the argument presented in the 4<sup>th</sup> Request on pages 15-17.

*“While **Suan** does not expressly disclose a distinct first knowledge base, it clearly utilizes knowledge of ‘therapeutic treatment regimens.’ See for example Fig. 4: ‘Find treatment regimen and dosage according to category, severity, diagnosis.’”  
(Request of 90/010,599 pg. 145, last ¶; emphasis added)*

As such, 3PR proposes the combination of **MYCIN** and **Suan** in a new light because in this 4<sup>th</sup> request, 3PR is taking an interpretation of **Suan** which is inapposite to the interpretation taken in the 3<sup>rd</sup> request. Even assuming that **Suan** does teach a first knowledge base, a reasonable examiner would not consider this important enough to raise an SNQ because the proposed combinations do not suggest a 1<sup>st</sup>, 2<sup>nd</sup>, and 3<sup>rd</sup> knowledge base, which would form the proper basis of an SNQ as discussed above.

Accordingly, the request for reexamination is DENIED.

#### **Conclusion**

9. **All** correspondence relating to this reexamination proceeding should be directed:

By Mail to: Mail Stop Ex Parte 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

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

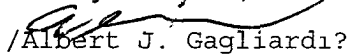
<https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

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.

11. 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:

Conferees:

/Deandra M. Hughes/  
Primary Examiner, CRU 3992  
  
/Albert J. Gagliardi?  
Primary Examiner, CRU 3992



Substitute for form 1449/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  <i>(Use as many sheets as necessary)</i>				<i>Complete if Known</i>		
				Control No.	<del>To be assigned</del>	90/011,055
				Reexam of Patent No.	6,188,988	
				First Named Inventor	D.W. BARRY	
				Group Art Unit	<del>To be assigned</del>	3992
				Examiner Name	<del>To be assigned</del>	D. Hughes
				Confirmation No.	To be assigned	
Sheet	1	of	1	Docket No.	383003-988RX (106555)	

OTHER DOCUMENTS - NON PATENT LITERATURE DOCUMENTS				
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	Translation <sup>2</sup>	
			Yes	No
/DMH/	C1	BUCHANAN <i>et al.</i> , 1984, "Rule-Based Expert Systems: The MYCIN Experiments of the Stanford Heuristic Programming Project," <i>Addison-Wesley Publishing</i>		
/DMH/	C2	SUAN, 1990, "Computer-Aided Diagnosis and Treatment of Malaria: The IMEX System," <i>Comp. Biol. Med.</i> 5:361-72		

Examiner Signature	/Deandra M. Hughes/	Date Considered	Aug. 8, 2010
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\*EXAMINER. Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Unique citation designation number <sup>2</sup> Applicant is to place a check mark here if English language Translation or translation of abstract is attached.