

OTH-A



NOVAK DRUCE CONNOLLY
BOVE + QUIGG LLP

MACROSOLVE V. GEICO

Reexamination

Jay Guiliano

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Post Grant Review

FIRM	2005	2006	2007	2008	2009	2010	2011	2012*	Total*
Novak Druce Connolly Bove & Quigg**	6	16	24	41	42	39	31	24	223
Finnegan, Henderson	5	18	17	13	7	10	59	29	158
Fish & Richardson	12	6	11	33	26	14	16	32	150
Morrison & Foerster	11	23	20	16	27	4	10	9	120
Stern Kessler	6	10	8	4	20	19	32	21	120

**2012 data is as of January 4, 2013. ** Novak Druce + Quigg LLP and Connolly Bove Lodge & Hutz LLP merged firms on January 1, 2013.
(Source Data <http://portal.uspto.gov/external/portal/pair>)*



`816 Patent - Notice of Allowance

- Transmit tokens to a remote computing device
- Terminate first connection
- After termination, execute tokens
- Establish second connection
- Transmit response from user

Notice of Allowance (9/7/10) at 2-3



Overview of Reexamination Request

- Reexamination directed to all 14 claims
- Ready to file
- 380 pages
- 6 separate SNQs

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reexamination of:

Inventors: Payne, J. David

Patent No.: 7,822,816

Filed: August 19, 2003

For: SYSTEM AND METHOD FOR
DATA MANAGEMENT

REQUEST FOR REEXAMINATION UNDER
35 U.S.C. §§ 302-307 AND 37 C.F.R. §
1.510

Mail Stop *Ex Parte* Reexamination
ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR *EX PARTE* REEXAMINATION OF U.S. PATENT 7,822,816




Prior Art Dates

- Publication dated June 18, 1997
- Patent filed on August 10, 2000
- Patent issued on August 15, 1995
- Patent issued on November 23, 1999
- **PCT published on July 8, 1999**
- Patent issued on December 30, 1997
- Patent filed on March 19, 1999
- Patent filed May 1, 2000



PCT Publication

- Published July 8, 1999
- 102(b) prior art
- Related U.S. Patent issued May 8, 2001

PCT		WORLD INTELLECTUAL PROPERTY ORGANIZATION International Bureau			
INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)					
(51) International Patent Classification ⁶ :		A2		(11) International Publication Number: WO 99/33390	
A61B				(43) International Publication Date: 8 July 1999 (08.07.99)	
(21) International Application Number: PCT/US98/27458		(81) Designated States: AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, CA, CH, CN, CU, CZ, DE, DK, EE, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MD, MG, MK, MN, MW, MX, NO, NZ, PL, PT, RO, RU, SD, SE, SG, SI, SK, SL, TJ, TM, TR, TT, UA, UG, US, UZ, VN, YU, ZW, ARIPO patent (GH, GM, KE, LS, MW, SD, SZ, UG, ZW), Eurasian patent (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European patent (AT, BE, CH, CY, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE), OAPI patent (BF, BJ, CF, CG, CI, CM, GA, GN, GW, ML, MR, NE, SN, TD, TG).			
(22) International Filing Date: 23 December 1998 (23.12.98)		Published <i>Without international search report and to be republished upon receipt of that report.</i>			
(30) Priority Data: 60/068,825 24 December 1997 (24.12.97) US 60/091,552 2 July 1998 (02.07.98) US 09/139,423 25 August 1998 (25.08.98) US					
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(74) Agents: KIRSCH, Gregory, J. et al.; Needle & Rosenberg, P.C., 127 Peachtree Street, N.E., Atlanta, GA 30303 (US).					
(54) Title: HEALTH CARE DATA MANIPULATION AND ANALYSIS SYSTEM					
(57) Abstract					

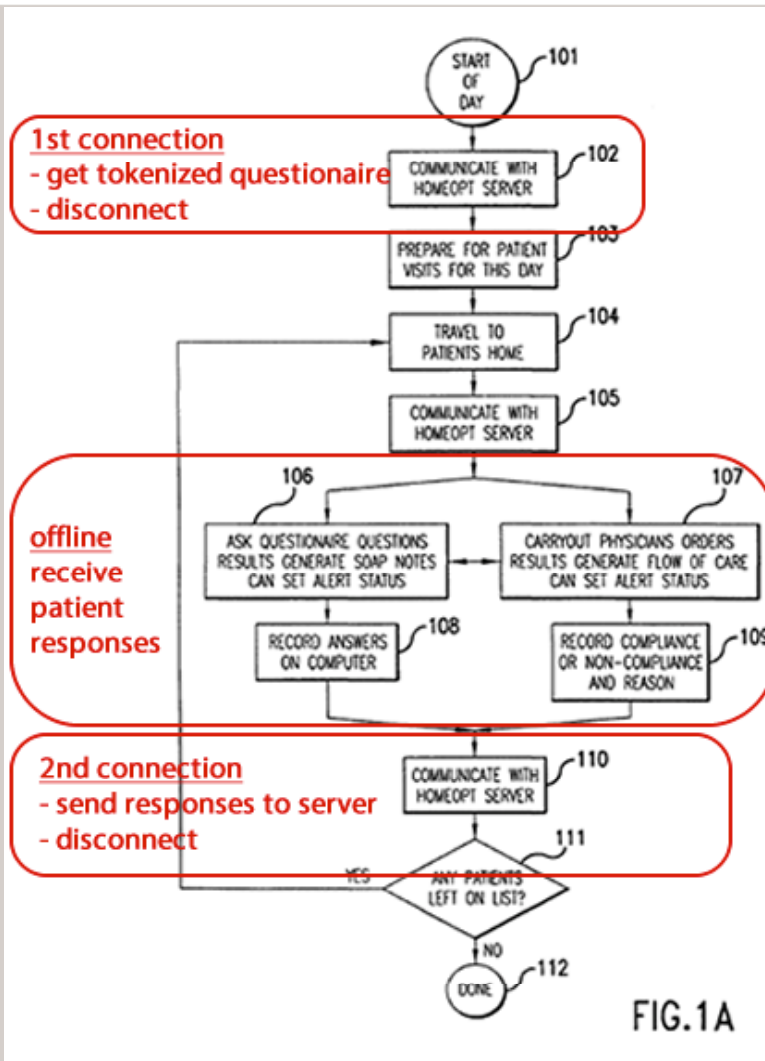


PCT Addresses Reasons for Allowance

- Patient care questionnaire used by nurse
- Questions are “tokenized representations” between server and nurse/doctor devices
- Nurse periodically queries server
- Nurse collects responses offline
- Nurse periodically synchronizes with server



PCT Overview





Claim 1: “A method for managing data ...”

- “A self-analyzing system for suggesting deviation from a current clinical pathway and entry into an alternative clinical pathway based upon historical information about the results of actions. Systems for tracking clinical pathway outcomes based on data collected post-treatment. A questionnaire computer language and subsystem are used in various stages of the systems of the invention.”

Abstract



“(a) creating a questionnaire ...”

- “Entire **questionnaires are versioned**, and may be easily modified, or recalled from earlier versions. **Questions once entered may be reused in many questionnaires.**”

12:17-31



“(b) tokenizing said questionnaire ...”

- “clinical pathway database models a decision tree comprising various decision nodes. These nodes are stored as either text or **tokenized representations of the Questionnaire Language ("QL") statements** (*see infra*).... Question ID is the identifier of the question itself.”

19:10-24



“(c) establishing a first wireless ... connection” (1 of 4)

- “In step 121, the processes commences. In step 122, the modem on the client computer 401 dials into the server 402. Again, this assumes that the computer 401 and server 402 are to be connected via modem and standard telephone lines. ... may be accomplished in a variety of ways, including over telephone lines, **via a wireless connection (cellular or otherwise), via the Internet, etc.”**

47:6-13



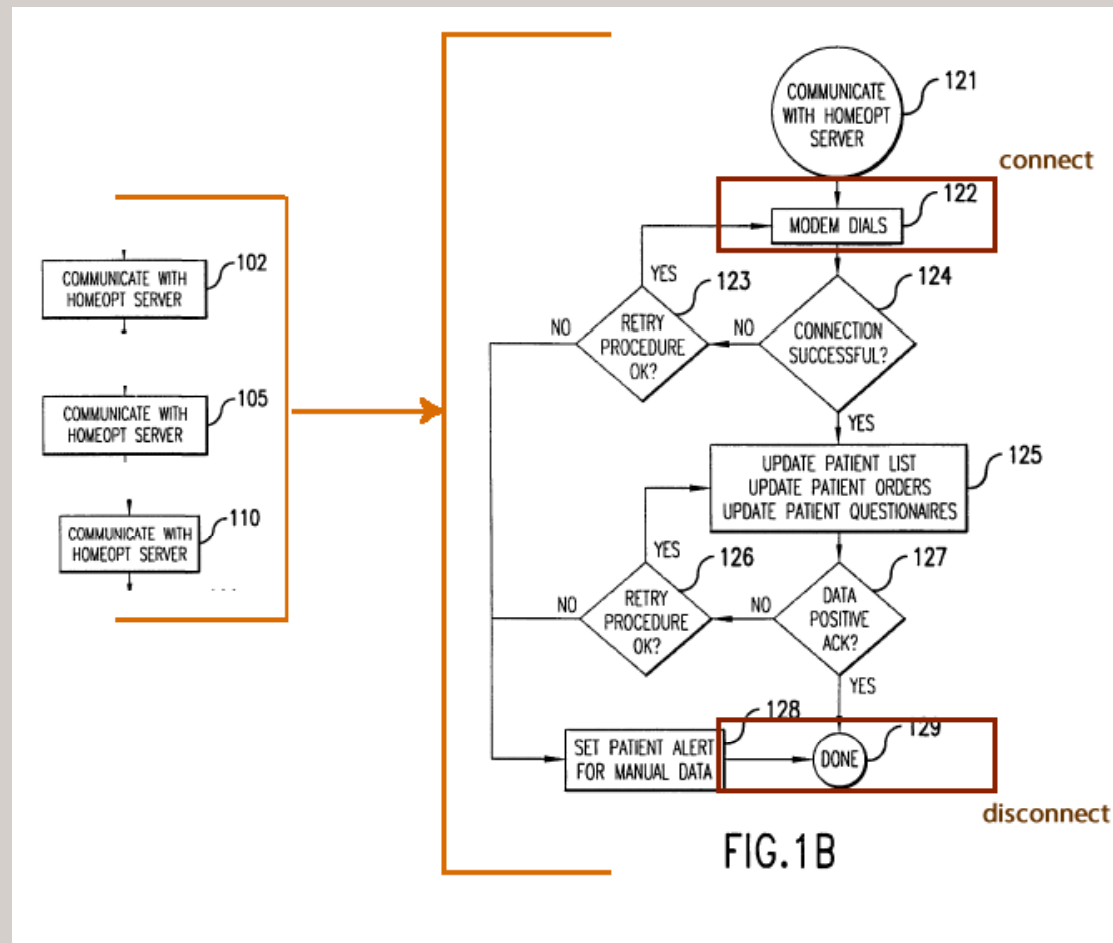
“(c) establishing a first wireless ... connection” (2 of 4)

- “Steps 102, 105 and 110, wherein the client computer 401 communicates with the server 402, are each described in further detail in steps 121-129, depicted in Figure 1B.”

47:6-8

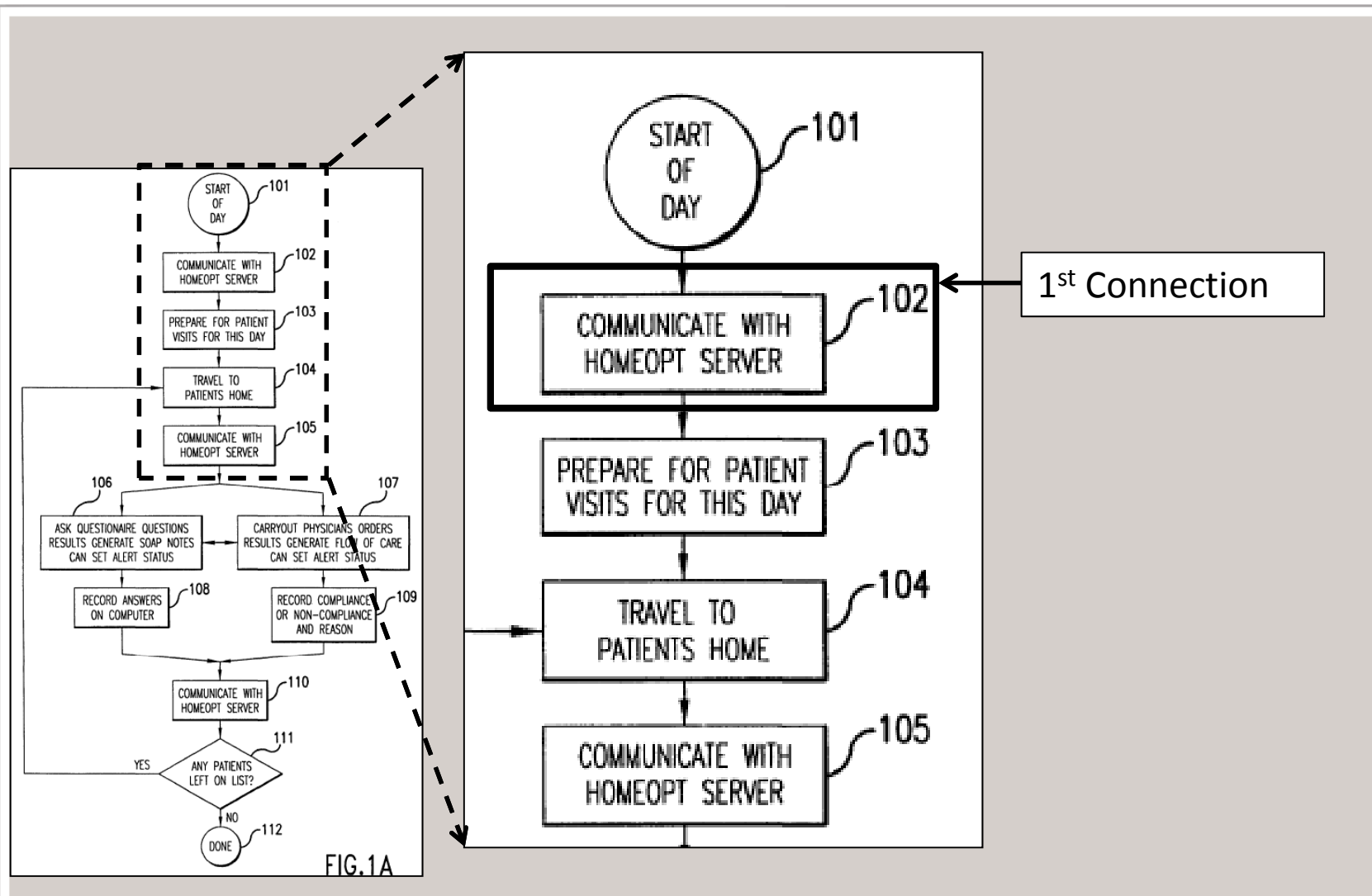


“(c) establishing a first wireless...connection” (3 of 4)





“(c) establishing a first wireless...connection” (4 of 4)





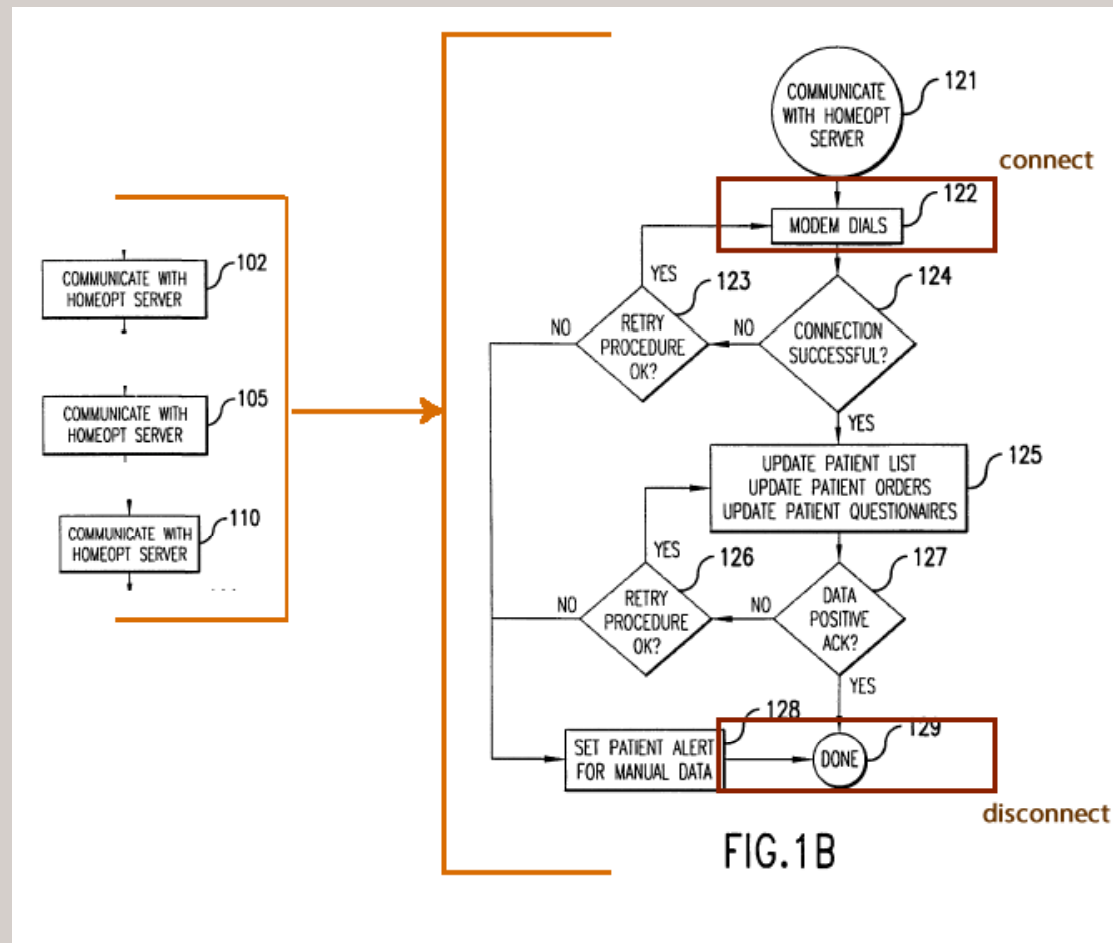
“(d) transmitting said plurality of tokens...”

- “In step 102, the nurse, using the client computer 401 (Figure 4) **communicates with the server 402**, in order **to obtain updated pathway instructions, etc., regarding what steps to perform during visit(s)** for one or more patient(s).”

46:4-7

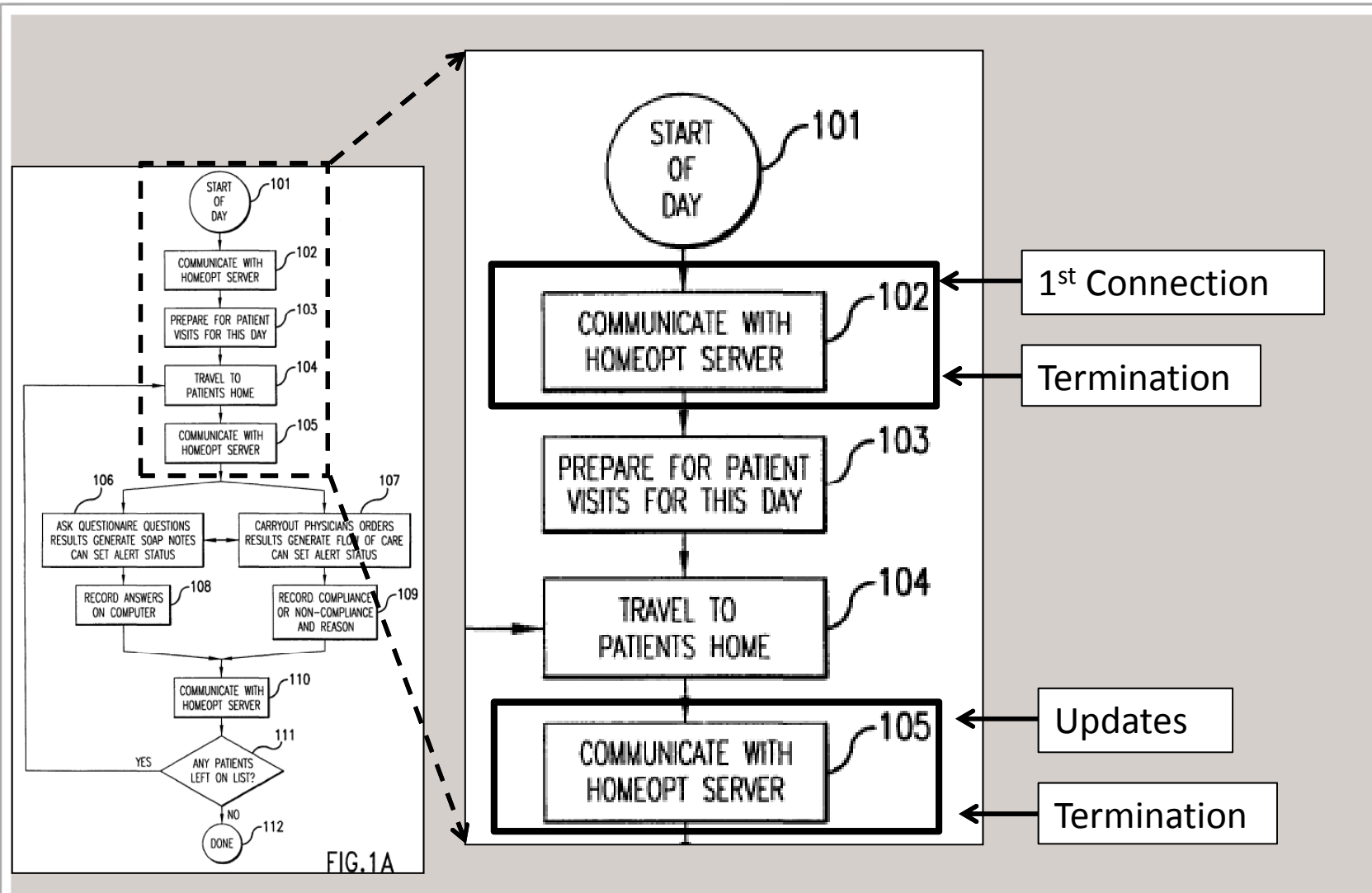


“(e) terminating first wireless...connection...” (1 of 2)





“(e) terminating first wireless...connection...” (2 of 2)





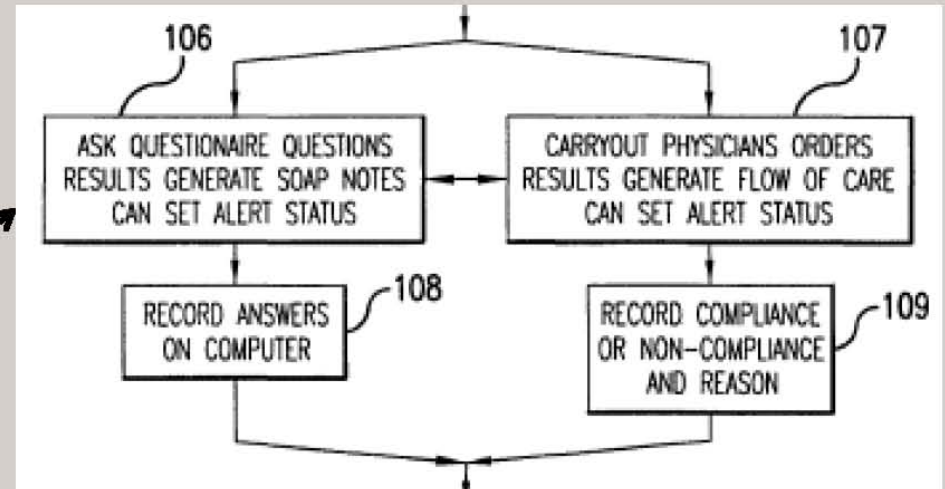
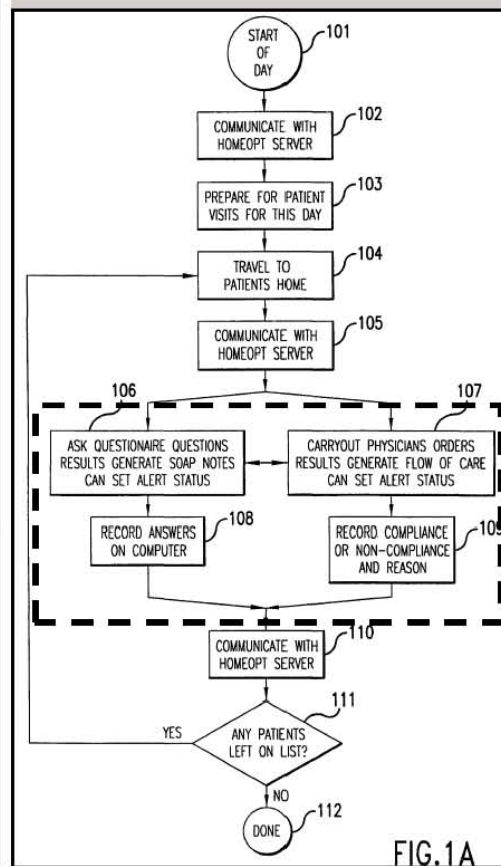
“(f) ... executing a portion of said plurality of tokens” (1 of 2)

- “In **step 106 and 108, the client computer 401, via the questionnaire language previously described**, or through any other data collection mechanism, **may obtain data from the nurse or other source corresponding to the clinical pathway to be followed**, as dictated by the physician. ... for ultimate retransmission to the server 402.”

46:16-20



“(f) ... executing a portion of said plurality of tokens” (2 of 2)





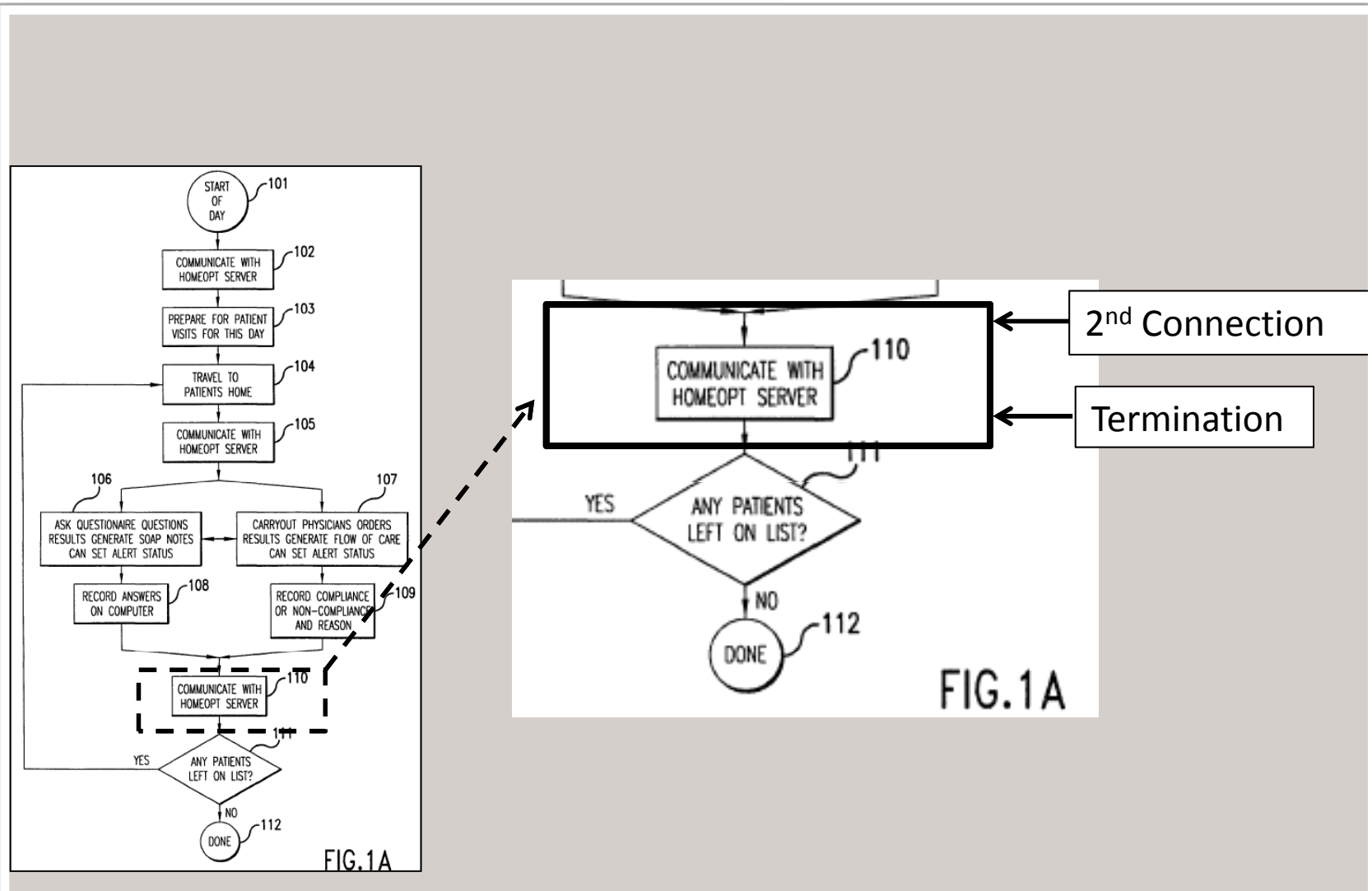
“(g) establishing a second wireless ... connection...” (1 of 2)

- “In step 110, the client computer 401 communicates with the server 402, in order to update both the computer 401 and server 402 as in steps 102 and 105.”

46:30-31



“(g) establishing a second wireless ... connection...” (2 of 2)





“(h) after second [connection]... transmitting... response”

- “In step 109, **the nurse records in the client computer 401 compliance or non-compliance with the orders.** If noncompliance, the reasons are also stored. Again, **all such stored data may later be transmitted back to the server 402.**”

46:16-28

- “In step 110, the client computer 401 communicates with the server 402, **in order to update both the computer 401 and server 402 as in steps 102 and 105.**”

46:30-31



“(i) storing said transmitted response at said server”

- “The **questionnaire and its answers are all stored.**”

23:10

- “Again, all such stored data may later be **transmitted back to the server 402.**”

46:27-28



Further Support for Unpatentability

- Another patent (issued 1999) discloses:

“A method and apparatus are disclosed for synchronizing transactions in a **disconnectable network** ... Transaction **synchronization**, which occurs after the computers are **reconnected**, transfers information from each computer to the other computer and applies updates to both replicas as appropriate.”

Abstract

“Suitable network connections include “packet-based, ... internet-compatible, local area, ... and **wireless network transmission** systems and methods.”

13:62-65



Ex Parte Reexaminations

- Grant of Reexamination Historically High

5. Decisions on requests.....	11737
a. No. granted.....	10755..... 92%
(1) By examiner	10633
(2) By Director (on petition)	122

- All claims cancelled 12%, claim changes 65%

b. Certificates – 3 rd PARTY REQUESTER	5823	
(1) All claims confirmed	1322	23%
(2) All claims canceled	724	12%
(3) Claim changes	3777	65%



Reexamination Considerations

- Based on newly discovered prior art
- Ex parte reexamination likely to be granted
- Ex parte request encourages follow-on IPR requests
- GEICO has already paid for reexamination request
- GEICO not subject to any estoppel in litigation