



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO., EXAMINER, ART UNIT, PAPER NUMBER, NOTIFICATION DATE, DELIVERY MODE. Includes application details for Jerardo Mendoza and examiner Weisenfeld, Aryan E.

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@iplawusa.com
hclark@iplawusa.com

<b>Office Action Summary</b>	<b>Application No.</b> 11/757,185	<b>Applicant(s)</b> MENDOZA ET AL.	
	<b>Examiner</b> ARYAN WEISENFELD	<b>Art Unit</b> 3689	<b>AIA (First Inventor to File) Status</b> No

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

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 9/17/2013.  
 A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on \_\_\_\_\_.
- 2a)  This action is **FINAL**.                                      2b)  This action is non-final.
- 3)  An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims\***

- 5)  Claim(s) 1-3 and 7-23 is/are pending in the application.  
5a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 6)  Claim(s) \_\_\_\_\_ is/are allowed.
- 7)  Claim(s) 1-3 and 7-23 is/are rejected.
- 8)  Claim(s) \_\_\_\_\_ is/are objected to.
- 9)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

\* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see [http://www.uspto.gov/patents/init\\_events/pph/index.jsp](http://www.uspto.gov/patents/init_events/pph/index.jsp) or send an inquiry to [PPHfeedback@uspto.gov](mailto:PPHfeedback@uspto.gov).

**Application Papers**

- 10)  The specification is objected to by the Examiner.
- 11)  The drawing(s) filed on 6/1/2007 is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

**Certified copies:**

- a)  All    b)  Some\*\*    c)  None of the:
1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b) Paper No(s)/Mail Date \_\_\_\_\_.
- 3)  Interview Summary (PTO-413) Paper No(s)/Mail Date. \_\_\_\_\_.
- 4)  Other: \_\_\_\_\_.

**DETAILED ACTION**

***Reopening Prosecution***

1. In view of the appeal brief filed on 9/17/2013, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount of previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/JANICE MOONEYHAM/

Supervisory Patent Examiner, Art Unit 3689

---

***Response to Amendment***

2. 35 U.S.C. 102(b) Rejections have been withdrawn.
3. 35 U.S.C. 101 Rejections have been added.

*Notice to Applicant*

4. In the Appeal Brief dated 9/17/2013 the following has occurred: No claims have been amended; No claims have been canceled; No claims have been added.
5. Claims 1-3 and 7-23 are pending.
6. The present application is being examined under the pre-AIA first to invent provisions.

*Claim Rejections - 35 USC § 101*

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 13-16 is rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter. Claim 13 recites a computer-readable storage medium containing executable code for instructing a processor, however, as stated in MPEP 2106 (I): "machine readable media can encompass non-statutory transitory forms of signal transmission, such as, a propagating electrical or electromagnetic signal *per se*. See *In re Nuijten*, 500 F.3d 1346, 84 USPQ2d 1495 (Fed. Circ. 2007). When the broadest reasonable interpretation of machine readable media in light of the specification as it would be interpreted by one of ordinary skill in the art encompasses transitory forms of signal transmission, a rejection under 35 U.S.C. 101 as failing to claim statutory subject matter would be appropriate." Paragraph [0028] of the Specification defines computer-readable storage medium to be "may be a magnetic disk, compact disk, or any other volatile or non-volatile mass storage system readable by processor 38." As such, the Specification leaves open the possibility that the machine readable medium can include, for

example, signals, and thus, given its broadest reasonable interpretation, fails to meet the requirements of 35 U.S.C. 101.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-3 and 7-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Starkey et al. (US 2003/0036926), hereinafter "Starkey," in view of Trends in the Social Security and Supplemental Security Income Disability Programs, [http://www.ssa.gov/policy/docs/chartbooks/disability\\_trends/overview.html](http://www.ssa.gov/policy/docs/chartbooks/disability_trends/overview.html), Wayback Machine September 28, 2006, hereinafter, "Trends," in view of Supplemental Security Income: Supporting People with Disabilities and the Elderly Poor, Eileen P. Sweeney, <http://www.cbpp.org/cms/?fa=view&id=512>, Published August 17, 2005, hereinafter "SSI."**

10. **Regarding claim 1**, Starkey discloses a managing computing system for making an assistance program offered by a provider available to a client comprising:

Art Unit: 3689

a processor (Page 2, paragraph [0022] discloses that the system is run on a central system including a proxy server/firewall system, a web server, and a database server);

a computer-readable storage medium containing executable code for instructing said processor to perform operations comprising (As above, Page 2, paragraph [0022] discloses that the system is run in a computer environment where each of the plurality of servers are in communication with each other):

receiving client information (Page 2, paragraphs [0018] – [0021] disclose that an assistance coordinator obtains information necessary to determine whether it is likely that the patients qualify for benefits under an assistance program);

comparing said client information with eligibility requirements for said assistance program (As discussed above, Page 2, paragraphs [0018] – [0021] disclose receiving information to determine patient eligibility for an assistance program. Page 3, paragraphs [0030] – [0030] then disclose that this information, along with various probability models, are compared with eligibility requirements that are defined by an assistance program and determine whether a person is eligible to receive benefits under the assistance program, to determine whether the patient is, in fact eligible. Paragraph [0030] additionally teaches that an assistance program is typically a federal or state program that provides medical benefits. Paragraph [0018] discloses that such programs can include Medicaid. Paragraph [0033] then discloses that information is analyzed to determine whether the patient information indicates that the patient will not qualify for benefits under the assistance program. For example, if the patient's income and/or financial resources exceed a limit for the assistance program, then the determination is that the patient is unlikely to qualify for benefits for that program);

Art Unit: 3689

when said client information meets said eligibility requirements, notifying the user of an eligibility of said client to enroll in said assistance program (Pages 3 and 4, paragraphs [0040] – [0043] disclose that if a client meets said eligibility requirements, that an application is displayed for the patient to enroll in the assistance program).

facilitating enrollment of said client in said assistance program in response to said notifying operation (As disclosed above, paragraphs [0040] – [0043] disclose that if a client meets said eligibility requirements, that an application is displayed for the patient to enroll in the assistance program. Paragraph [0043] then proceeds to state that in addition, the representative of the assistance coordinator is provided with prompts to assist in the completion of the application).

In sum, Starkey discloses a system and method for determining if a patient is eligible for an assistance program by comparing information, such as income, that is received from the patient, to the eligibility requirements, such as maximum income, of the assistance program. The only difference between Starkey and the claimed invention is that Starkey does not teach that the client information received is pertaining to a social benefit program for which said client qualifies, that this information is being received from an organization that administers said social benefit program, and that the eligibility notification is presented to said organization.

Specifically, Starkey does not disclose (note that only italicized portions are what Starkey does not disclose, the rest is simply written for clarity):

receiving client information *from an organization that administers said social benefit program for which said client qualifies from an organization that administers said social benefit program*; and

when said client information meets said eligibility requirements, notifying *said organization* of an eligibility of said client to enroll in said assistance program.

The question, then, is would it have been obvious to a person of ordinary skill for an organization that administers a social benefit program to use the system of Starkey to input information to determine eligibility of a client for another assistance program.

To address this, Trends teaches a variety of programs offered by the U.S. Social Security Administration. One of these programs, as taught on the bottom of Page 2 and top of Page 3 is the Medicare program which covers persons aged 65 or older. Medicare is essentially hospital insurance, and is very similar to Medicaid, which is the program cited in paragraph [0018] of Starkey.

Additionally, Trends teaches another example of an assistance program, the Supplemental Security Income program, as discussed in the middle of Page 3, which is a program that is based on both age and income requirements (See <http://www.cbpp.org/cms/?fa=view&id=512> to show that the required age is 65 years old and for further elaboration on the SSI program including specific income requirements. A copy of this article has been included with the Office Action).

From this, it would have been obvious to modify the system of Starkey in several ways. First, it would have been obvious to replace the self-pay patient of Starkey with a person who already qualifies for the Social Security benefit of Medicare, because, as shown by Trends, the Social Security Administration has eligibility requirements for its programs, so it would be beneficial to implement a system like Starkey to easily compare information received with eligibility requirements for a first social benefit program. Next, it would have been obvious for



Art Unit: 3689

the Social Security information to input the information received from people applying for Medicare benefits into the system of Starkey while substituting the requirements for Medicare with those of the Supplemental Security Income program to further streamline the benefits process. That is, the Social Security Office is in charge of both Medicare and SSI. It would be beneficial to simply use the information received for people applying for Medicare (i.e. that their age is older than 65) and input it into the system of Starkey to determine eligibility for a second assistance program (SSI) because both of these programs have overlapping eligibility requirements (aged 65 or older), so it would make the process of determining eligibility more efficient because the Social Security Administration will not have to receive two sets of applications, one for Medicare and one for SSI.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the system of Starkey to have an organization, such as the Social Security Administration input information of people that are eligible for a first social benefit program, such as Medicare, into the system of Starkey to determine if those same people are eligible for a second assistance program (such as SSI) with overlapping eligibility requirements (such as age requirements), to make the process of determining eligibility more efficient and reducing the number of applications received.

It should be noted that SSI was introduced only to further clarify the requirements for SSI eligibility, for example, the person must be age 65 or over, and have an income no greater than \$579/month or 73% of the poverty line.

11. **Regarding claim 2**, the combination of Starkey, Trends, and SSI make obvious the system of claim 1. Starkey further teaches:

determining whether said client is currently enrolled in said assistance program (Page 2, paragraph [0018] teaches that the hospital identifies if the patient is part of an assistance program or is self-pay);

when said client is currently enrolled in said assistance program abstaining from performing said notifying and facilitating operations (Page 2, paragraph [0019] then teaches that only after it has been determined that the patient is not part of an assistance program is the patient referred to an assistance coordinator to determine eligibility for an assistance program).

However, none of the references teach that these steps are done by a computer.

However, referring to MPEP section 2144.04 (III), stating: "*In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.)"

Applying this to the claimed invention, it would then be obvious to automate the above-mentioned limitations because whether these steps are done by a human manually, or by an automated computer system, the results would be the same, and, as shown in *In re Venner*, providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. Stated differently, the determining step in claim 2 is nothing more than identifying. Whether this step is done by a

Art Unit: 3689

person at the hospital not using a computer, or some form of computer check-in system that can receive information pertaining to a patient's insurance or assistance programs and apply a mark, such as a check mark, next to those patients who are enrolled in an assistance program, the result of this step will be determining if a patient is or is not enrolled in an assistance program. There is no additional, novel, step the processor is performing besides an identification of whether a patient is enrolled in an assistance program.

12. **Regarding claim 3**, the combination of Starkey, Trends, and SSI make obvious the system of claim 1. Starkey further teaches:

determining that said client information fails to meet said eligibility requirements for said assistance program (Page 4, paragraph [0033] teaches that the information is analyzed to determine whether the patient information indicates that the patient will not qualify for benefits under the assistance program);

abstaining from performing said notifying and facilitating operations in response to said determining operation (Page 4, paragraph [0040] teaches that if the patient information indicates that the eligibility criteria are not met, for example if income is too high, the method ends there, before the application displaying and assisting steps taught in paragraph [0043]).

13. **Regarding claim 7**, the combination of Starkey, Trends, and SSI make obvious the system of claim 1. The combination further teaches wherein said provider provides a product that has an associated cost, said cost is specified in a record, and said executable code instructs said processor to perform operations comprising:

providing said record to said organization (Page 2, paragraph [0019] of Starkey teaches that the assistance program pays the hospital for the expenses. It should be appreciated by one of

Art Unit: 3689

ordinary skill in the art that an obvious form of payment display is to provide the organization with a bill); and

allowing said organization to guarantee payment of at least a portion of said cost presented in said record (Page 2, paragraph [0019] of Starkey teaches that the assistance program pays the hospital for the expenses. Additionally, one of the assistance programs taught by Trends is Medicare, which is effectively health insurance provided by the Social Security Administration).

14. **Regarding claim 8**, the combination of Starkey, Trends, and SSI make obvious the system of claim 7. Starkey further teaches enrolling said client in said assistance program when said portion of said cost is guaranteed by said organization (As discussed above, Page 2, paragraph [0019] of Starkey teaches that the assistance program pays the hospital for the expenses. This means that the assistance program always guarantees at least partial payment of expenses for patients who enroll).

15. **Regarding claim 9**, the combination of Starkey, Trends, and SSI make obvious the system of claim 1. Trends and SSI further teach wherein said assistance program is a low-income discount program for a product provided by said provider, and said client information received at said managing computing system includes verified income information for said client (As discussed earlier, the assistance program under the umbrella of the Social Security Administration is the SSI program, which, as shown in the right-hand column of SSI has certain income based requirements. It should be appreciated by one of ordinary skill that the US Government verifies income amounts when applying for government programs).

Art Unit: 3689

16. **Regarding claim 10**, the combination of Starkey, Trends, and SSI make obvious the system of claim 9. Starkey further teaches wherein said eligibility requirements include an income threshold and said executable code instructions instructs said processor to compare said verified income information for said client to said income threshold to determine said eligibility of said client to enroll in said assistance program (Page 4, paragraph [0040] teaches comparing a patient's income to a threshold income established by the assistance program to determine eligibility).

17. **Regarding claim 11**, the combination of Starkey, Trends, and SSI make obvious the system of claim 1. The combination of references further teaches wherein said client information includes information commonly required by both said social benefit program and said assistance program (Page 2 and top of Page 3 of Trends shows the Medicare program which covers persons aged 65 or older, and the right-hand column of Page 1 of SSI shows that a requirement for the SSI program is also being at least 65 years old. Additionally, both Medicare and SSI require income information).

18. **Regarding claim 12**, the combination of Starkey, Trends, and SSI make obvious the system of claim 1. Starkey further teaches providing an eligibility statement to said organization, said eligibility statement indicating said eligibility of said client to enroll in said assistance program (Paragraphs [0040] – [0043] teach determining that a patient is eligible and providing an affirmation of said eligibility by providing an application form to apply for said assistance program).

19. **Regarding claims 13 and 17**, Starkey discloses a first computing system including a processor (Page 2, paragraph [0022] discloses that the system is run on a central system

Art Unit: 3689

including a proxy server/firewall system, a web server, and a database server), a second computing system operable by an organization that administers a social benefit program for which a client qualifies, said second computing system being in selective communication with said first computing system for communicating client information pertaining to said social benefit program for which said client qualifies, said client information including verified income information (Page 2, paragraph [0022] discloses that the system is run on a central system including a proxy server/firewall system, a web server, and a database server. It should be noted that the fact that the second system is operable by an organization affords no patentable weight because it does not change the structure of the system, and the data sent between the computer systems also affords no patentable weight because it does not change the structure of the system) computer-readable storage medium containing executable code for instructing a processor to perform the following operations:

receiving client information (Page 2, paragraphs [0018] – [0021] disclose that an assistance coordinator obtains information necessary to determine whether it is likely that the patients qualify for benefits under an assistance program);

comparing said client information with eligibility requirements for said low-income discount program (As discussed above, Page 2, paragraphs [0018] – [0021] disclose receiving information to determine patient eligibility for an assistance program. Page 3, paragraphs [0030] – [0030] then disclose that this information, along with various probability models, are compared with eligibility requirements that are defined by an assistance program and determine whether a person is eligible to receive benefits under the assistance program, to determine whether the patient is, in fact eligible. Paragraph [0030] additionally teaches that an assistance program is

Art Unit: 3689

typically a federal or state program that provides medical benefits. Paragraph [0018] discloses that such programs can include Medicaid. Paragraph [0033] then discloses that information is analyzed to determine whether the patient information indicates that the patient will not qualify for benefits under the assistance program. For example, if the patient's income and/or financial resources exceed a limit for the assistance program, then the determination is that the patient is unlikely to qualify for benefits for that program;

when said client information meets said eligibility requirements, notifying the user of an eligibility of said client to enroll in said low-income discount program (Pages 3 and 4, paragraphs [0040] – [0043] disclose that if a client meets said eligibility requirements, that an application is displayed for the patient to enroll in the assistance program).

facilitating enrollment of said client in said low-income discount program in response to said notifying operation (As disclosed above, paragraphs [0040] – [0043] disclose that if a client meets said eligibility requirements, that an application is displayed for the patient to enroll in the assistance program. Paragraph [0043] then proceeds to state that in addition, the representative of the assistance coordinator is provided with prompts to assist in the completion of the application).

In sum, Starkey discloses a system and method for determining if a patient is eligible for an assistance program by comparing information, such as income, that is received from the patient, to the eligibility requirements, such as maximum income, of the assistance program. The only difference between Starkey and the claimed invention is that Starkey does not teach that the client information received is pertaining to a social benefit program for which said client qualifies, that this information is being received from an organization that administers said social

Art Unit: 3689

benefit program, that the eligibility notification is presented to said organization, and that the social benefit program includes verified income information for said client that is commonly required by both social benefit program and said low-income discount program.

Specifically, Starkey does not disclose (note that only italicized portions are what Starkey does not disclose, the rest is simply written for clarity):

*receiving client information from an organization that administers said social benefit program for which said client qualifies from an organization that administers said social benefit program, said client information including verified income information that is commonly required by both said social benefit program and said low-income discount program;*

*when said client information meets said eligibility requirements, notifying said organization of an eligibility of said client to enroll in said assistance program; and*

*wherein said client information includes verified income information commonly required by both said social benefit program and said low-income discount program.*

The question, then, is would it have been obvious to a person of ordinary skill for an organization that administers a social benefit program to use the system of Starkey to input information to determine eligibility of a client for another assistance program.

To address this, Trends teaches a variety of programs offered by the U.S. Social Security Administration. One of these programs, as taught on the bottom of Page 2 and top of Page 3 is the Medicare program which covers persons aged 65 or older. Medicare is essentially hospital insurance, and is very similar to Medicaid, which is the program cited in paragraph [0018] of Starkey.



Additionally, Trends teaches another example of an assistance program, the Supplemental Security Income program, as discussed in the middle of Page 3, which is a program that is based on both age and income requirements (See <http://www.cbpp.org/cms/?fa=view&id=512> to show that the required age is 65 years old and for further elaboration on the SSI program including specific income requirements. A copy of this article has been included with the Office Action).

Lastly, Trends teaches wherein said client information includes verified income information commonly required by both said social benefit program and said assistance program (Page 2 and top of Page 3 of Trends shows the Medicare program which covers persons aged 65 or older, and the right-hand column of Page 1 of SSI shows that a requirement for the SSI program is also being at least 65 years old. Additionally, both Medicare and SSI require income information. It should be appreciated by one of ordinary skill that the US Government verifies income amounts when applying for government programs).

From this, it would have been obvious to modify the system of Starkey in several ways. First, it would have been obvious to replace the self-pay patient of Starkey with a person who already qualifies for the Social Security benefit of Medicare, because, as shown by Trends, the Social Security Administration has eligibility requirements for its programs, so it would be beneficial to implement a system like Starkey to easily compare information received with eligibility requirements for a first social benefit program. Next, it would have been obvious for the Social Security information to input the information received from people applying for Medicare benefits into the system of Starkey while substituting the requirements for Medicare with those of the Supplemental Security Income program to further streamline the benefits

Art Unit: 3689

process. That is, the Social Security Office is in charge of both Medicare and SSI. It would be beneficial to simply use the information received for people applying for Medicare (i.e. that their age is older than 65) and input it into the system of Starkey to determine eligibility for a second assistance program (SSI) because both of these programs have overlapping eligibility requirements (aged 65 or older), so it would make the process of determining eligibility more efficient because the Social Security Administration will not have to receive two sets of applications, one for Medicare and one for SSI.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the system of Starkey to have an organization, such as the Social Security Administration input information of people that are eligible for a first social benefit program, such as Medicare, into the system of Starkey to determine if those same people are eligible for a second assistance program (such as SSI) with overlapping eligibility requirements (such as age requirements), to make the process of determining eligibility more efficient and reducing the number of applications received.

It should be noted that SSI was introduced only to further clarify the requirements for SSI eligibility, for example, the person must be age 65 or over, and have an income no greater than \$579/month or 73% of the poverty line.

**To recap: the low-income discount program is the SSI, the social benefit program is Medicare, and they both share the eligibility requirement of income. Starkey discloses a system that receives information, compares information to eligibility requirements, notifies a user of eligibility, and facilitates in enrollment. The rationale above teaches why it would**

Art Unit: 3689

**be obvious to apply the system of Starkey to the Social Security Administration, and specifically for clients that qualify for Medicare and then SSI.**

20. **Regarding claim 14**, the combination of Starkey, Trends, and SSI make obvious the computer readable storage medium of claim 13. Starkey further teaches:

determining whether said client is currently enrolled in said low-income discount program (Page 2, paragraph [0018] teaches that the hospital identifies if the patient is part of an assistance program or is self-pay);

when said client is currently enrolled in said low-income discount program abstaining from performing said notifying and facilitating operations (Page 2, paragraph [0019] then teaches that only after it has been determined that the patient is not part of an assistance program is the patient referred to an assistance coordinator to determine eligibility for an assistance program).

However, none of the references teach that these steps are done by a computer.

However, referring to MPEP section 2144.04 (III), stating: "*In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.)"

Applying this to the claimed invention, it would then be obvious to automate the above-mentioned limitations because whether these steps are done by a human manually, or by an automated computer system, the results would be the same, and, as shown in *In re Venner*, providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. Stated differently, the determining step in claim 14 is nothing more than identifying. Whether this step is done by a person at the hospital not using a computer, or some form of computer check-in system that can receive information pertaining to a patient's insurance or assistance programs and apply a mark, such as a check mark, next to those patients who are enrolled in an assistance program, the result of this step will be determining if a patient is or is not enrolled in an assistance program. There is no additional, novel, step the processor is performing besides an identification of whether a patient is enrolled in an assistance program.

21. **Regarding claim 15**, the combination of Starkey, Trends, and SSI make obvious the storage medium of claim 13. Starkey further teaches:

determining that said client information fails to meet said eligibility requirements for said assistance program (Page 4, paragraph [0033] teaches that the information is analyzed to determine whether the patient information indicates that the patient will not qualify for benefits under the assistance program);

abstaining from performing said notifying and facilitating operations in response to said determining operation (Page 4, paragraph [0040] teaches that if the patient information indicates that the eligibility criteria are not met, for example if income is too high, the method ends there, before the application displaying and assisting steps taught in paragraph [0043]).

Art Unit: 3689

22. **Regarding claim 16**, the combination of Starkey, Trends, and SSI make obvious the storage medium of claim 13. Starkey further teaches wherein said eligibility requirements include an income threshold and said executable code instructions instructs said processor to compare said verified income information for said client to said income threshold to determine said eligibility of said client to enroll in said assistance program (Page 4, paragraph [0040] teaches comparing a patient's income to a threshold income established by the assistance program to determine eligibility).

23. **Regarding claim 18**, the combination of Starkey, Trends, and SSI make obvious the system of claim 17. Starkey further teaches:

receiving application information for said low-income discount program on behalf of said client from said organization via said second computing system (As discussed above, Page 2, paragraphs [0018] – [0021] disclose that an assistance coordinator obtains information necessary to determine whether it is likely that the patients qualify for benefits under an assistance program. Then paragraph [0043] teaches completing an application);

enrolling said client in said low-income discount program (Paragraph [0043] teaches completing an application for enrollment, and signing the application. Upon signing the application the application is submitted and the method ends. Paragraph [0019] teaches that a patient is enrolled after this process is completed and upon enrollment, the program pays the hospital expenses).

24. **Regarding claim 19**, the combination of Starkey, Trends, and SSI make obvious the system of claim 17. The combination further teaches wherein said provider provides a product

Art Unit: 3689

that has an associated cost, said cost is specified in a record, and said executable code instructs said processor to perform operations comprising:

providing said record to said organization (Page 2, paragraph [0019] of Starkey teaches that the assistance program pays the hospital for the expenses. It should be appreciated by one of ordinary skill in the art that an obvious form of payment display is to provide the organization with a bill);

allowing said organization to guarantee payment of at least a portion of said cost presented in said record (Page 2, paragraph [0019] of Starkey teaches that the assistance program pays the hospital for the expenses. Additionally, one of the assistance programs taught by Trends is Medicare, which is effectively health insurance provided by the Social Security Administration); and

concurrently enrolling said client in said low-income discount program when said portion of said cost is guaranteed by said organization (As discussed above, Page 2, paragraph [0019] of Starkey teaches that the assistance program pays the hospital for the expenses. This means that the assistance program always guarantees at least partial payment of expenses for patients who enroll. Because a portion of the fees are always guaranteed, any enrollment occurs concurrently with this guarantee).

25. **Regarding claim 20**, the combination of Starkey, Trends, and SSI make obvious the system of claim 17. The combination of references further teaches wherein said client information includes information commonly required by both said social benefit program and said assistance program (Page 2 and top of Page 3 of Trends shows the Medicare program which covers persons aged 65 or older, and the right-hand column of Page 1 of SSI shows that a

Art Unit: 3689

requirement for the SSI program is also being at least 65 years old. Additionally, both Medicare and SSI require income information).

26. **Regarding claim 21**, the combination of Starkey, Trends, and SSI make obvious the system of claim 17. Starkey further teaches wherein said second computing system generates an application for said low-income discount program on behalf of the client in response to said notifying operation (Paragraph [0043] teaches creating an application based on the determination that a patient is eligible for the assistance program. Claim 17 already discusses why it would be obvious to notify an organization).

27. **Regarding claims 22 and 23**, the combination of Starkey, Trends, and SSI make obvious the system of claim 17. Starkey further teaches wherein said second computing system applies for said low-income discount program on behalf of said client in response to said notifying operation (As disclosed above, paragraphs [0040] – [0043] disclose that if a client meets said eligibility requirements, that an application is displayed for the patient to enroll in the assistance program. Paragraph [0043] then proceeds to state that in addition, the representative of the assistance coordinator is provided with prompts to assist in the completion of the application. Additionally, as discussed in claims 2 and 14 above, MPEP section 2144.04 (III), stating: "*In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined “old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed.” The court held that broadly providing an automatic

or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.)”

Applying this to the claimed invention, it would then be obvious to automate the above-mentioned limitations because whether these steps are done by a human manually, or by an automated computer system, the results would be the same, and, as shown in *In re Venner*, providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.

### *Response to Arguments*

#### **35 U.S.C. 102(b):**

Applicants’ arguments presented on Pages 8-14 which assert that Starkey does not disclose a client who qualifies for a social benefit program administered by an organization are deemed persuasive and addressed by the newly added references Trends and SSI.

Applicants’ arguments that Starkey fails to render claim obvious are moot because the previous Examiner did not assert obviousness for claim 1. The current Examiner has introduced new references to address limitations not disclosed by Starkey and has provided lengthy rationales for obviousness.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ARYAN WEISENFELD whose telephone number is (571)272-6602. The examiner can normally be reached on Monday-Friday 8 AM - 5 PM EST.



Art Unit: 3689

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. W./

Examiner, Art Unit 3689

/GERARDO ARAQUE JR/

Primary Examiner, Art Unit 3689