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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/799,367	04/23/2010	Edward K.Y. Jung	SE1-0589-US	7809
80118	7590	09/28/2015	EXAMINER	
Constellation Law Group, PLLC			TREHAN, AKSHAY	
P.O. Box 580			ART UNIT	
Tracyton, WA 98393			PAPER NUMBER	
			2663	
			MAIL DATE	
			DELIVERY MODE	
			09/28/2015	
			PAPER	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EDWARD K.Y. JUNG, ROYCE A. LEVIEN,
ROBERT W. LORD, MARK A. MALAMUD, and JOHN D. RINALDO

Appeal 2013-003143
Application 12/799,367
Technology Center 2600

Before CAROLYN D. THOMAS, BRUCE R. WINSOR, and
KEVIN C. TROCK, *Administrative Patent Judges*.

WINSOR, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1–4, 8, 13, 15, 17–24, 26–28, 31, 34, 39–41, 43–45, 53, 55, 57, 59, 60, 66, 67, 70, 83, 90, and 95–100, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b). Claims 5–7, 9–12, 14, 16, 25, 29, 30, 32, 33, 35–38, 42, 46–52, 54, 56, 58, 61–65, 68, 69, 71–82, 84–89, and 91–94 are cancelled. (*See* Br. 39–40, 42–47 (Claims App’x).)

We affirm.

¹ The real party in interest identified by Appellants is Searete, LLC, which is wholly owned by Intellectual Ventures Management LLC. (Br. 4.)

STATEMENT OF THE CASE

Appellants’ “application relates, in general, to sharing mechanisms that allows [sic] sharing images between multiple devices at least partially based on a regional proximity of the devices.” (Spec. 3:29–31.) Claim 1, which is illustrative, reads as follows:

1. A system comprising:
 - circuitry for obtaining at least one image representation from at least one image capture device;
 - circuitry for identifying one or more entities authorized to receive the at least one image representation obtained from the at least one image capture device based on at least one indication of at least one subset list of one or more individuals selected from at least one larger list; and
 - circuitry for transmitting at least one portion of the at least one image representation obtained from the at least one image capture device to at least some of the one or more entities identified as being authorized to receive the at least one image representation obtained from the at least one image capture device.

Claim 95 stands rejected under 35 U.S.C. § 101 because the claimed subject matter is nonfunctional descriptive material. (*See* Final Act. 2; Ans. 2–3.)

Claims 1–4, 8, 13, 15, 17–24, 26–28, 31, 34, 39–41, 43–45, 53, 55, 57, 59, 60, 66, 67, 70, 83, 90, and 95–100 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamaguchi (US 7,327,385 B2; issued Feb. 5, 2008), Steinberg et al. (US 6,750,902 B1; issued June 15, 2004; hereinafter “Steinberg”), and Weaver et al. (US 7,031,700 B1; issued Apr. 18, 2006; hereinafter “Weaver”). (*See* Final Act. 3–17; Ans. 4–20.)

Rather than repeat the arguments here, we refer to the Appeal Brief (“Br.” filed July 9, 2012) for the positions of Appellants and the Final Office Acton (“Final Act.” mailed May 9, 2012) and Answer (“Ans.” mailed Sept. 25, 2012) for the findings and conclusions of the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Appeal Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2012).

ISSUES

The issues presented by Appellants’ contentions are as follows:

Does the Examiner err in rejecting claim 95 under 35 U.S.C. § 101?

Does the Examiner err in finding the combination of Yamaguchi, Steinberg, and Weaver, particularly Weaver, teaches or suggests “circuitry for identifying one or more entities authorized to receive the at least one image representation obtained from the at least one image capture device based on at least one indication of at least one subset list of one or more individuals selected from at least one larger list,” as recited in claim 1?

Does the Examiner provide reasons to support the rejection of claim 96?

Does the Examiner err in finding the combination of Yamaguchi, Steinberg, and Weaver, particularly Weaver, teaches or suggests circuitry for identifying one or more entities positionally independent of the at least one image capture device and authorized to receive the textual content and the at least one image representation obtained from the at least one image capture device based on at least one indication of at least one

subset list of one or more individuals selected from at least one larger list,
as recited in claim 97?

Does the Examiner err in finding the combination of Yamaguchi, Steinberg, and Weaver, particularly Steinberg, teaches or suggests “circuitry for transmitting at least some of the feedback information received from the at least some of the one or more entities to the at least one image capture device,” as recited in claim 100?

ANALYSIS

We have reviewed Appellants’ arguments and contentions (Br. 12–35) in light of the Examiner’s findings and conclusions (Final Act. 2–17; Ans. 2–20) and explanations regarding Appellants’ arguments (Ans. 20–26). Appellants’ arguments and contentions do not persuade us of error in the Examiner’s findings, conclusions, and explanations; accordingly, we adopt the Examiner’s findings, conclusions, and explanations as our own. The following discussion, findings, and conclusions are for emphasis.

REJECTION UNDER 35 U.S.C. § 101

The Examiner concludes claim 95 encompasses non-functional descriptive matter because it recites instructions on non-transitory media without reciting that the non-transitory media is used or usable with a computer or machine. (Ans. 2–3.) The Examiner explains “the scope of the presently claimed non-transitory media can range from paper on which the program is written, to a program simply contemplated and memorized by a person.” (Ans. 23.)

Appellants contend the Examiner erred because the Examiner improperly applied the machine or transformation test to reject the claim under § 101. (Br. 12–14 (citing *Bilski v. Kappos*, 561 U.S. 593 (2010).))

We are unpersuaded of error because Appellants do not address the ground of rejection articulated by the Examiner. Claim 95 is not a claim to a process; rather it is a claim to media bearing instructions for a process. Although the Examiner did state that the claim “*raises a question as to whether* the claim is directed merely to an abstract idea” (Ans. 2 (emphases added)), the actual rejection articulated by the Examiner is based on a finding that the claim is directed to non-functional descriptive matter (*id.*), in accordance with what is sometimes known as the printed matter doctrine. In other words, the Examiner has found, and we agree, that claim 95 does not preclude embodiments that are merely printed instructions on paper, which is a non-transitory medium. *See In re Miller*, 418 F.2d 1392, 1396 (CCPA 1969) (“printed matter by itself is not patentable subject matter, because [it is] non-statutory . . .”). Here, unlike the claim at issue in *Miller*, claim 95 encompasses printed matter by itself, and not in a new and unobvious relationship with its substrate.

Appellants’ arguments do not persuade us of error in the rejection of claim 95 under § 101.

REJECTION UNDER 35 U.S.C. § 103(A)

Claim 1

Differences between the Claim and the Prior Art

Appellants contend as follows:

[T]hose portions of Weaver identified by the USPTO, and so far as Appellant[s] can discern, the pinpoint-cited portions of Weaver also do not recite at least “circuitry for **identifying one or more entities authorized to receive the at least one image representation obtained from the at least one image capture device based on at least one indication of at least one subset list of one or more individuals selected from at least one larger list**” as recited in Appellant[s’] Independent Claim 1.

(Br. 16.) Appellants reproduce, verbatim, certain, but not all, portions of Weaver relied on by the Examiner (*see* Br. 17 (reproducing Weaver, Fig. 4; col. 2, ll. 6–20; col. 4, ll. 11–15)) together with certain other passages of Weaver (*see* Br. 18 (reproducing Weaver, col. 2, ll. 57–59; col. 11, ll. 62–66; col. 12, ll. 1–19)). Certain portions of the reproduced passages of Weaver are enclosed in rectangles of emphasis. (*See* Br. 17–18.) Appellants then state that “Appellant[s] ha[ve] shown by direct quotations that Independent Claim 1 and the cited portions of Weaver are very different on their faces.” (App. Br. 19.) Appellants offer no other explanation of the significance Appellants urge us to attach to the emphasized portions of Weaver.

On appeal, Appellants may rebut the Examiner’s findings and reasoning with opposing evidence or argument. Failure to do so may constitute a waiver of potential arguments. *See Ex parte Frye*, 94 USPQ2d 1072, 1075–76 (BPAI 2010) (precedential); *see also Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir 2008) (arguments not made are considered waived). Furthermore, merely reciting the language of the claims and asserting that the cited prior art reference does not recite what the claim limitation recites is insufficient. *See* 37 C.F.R. § 41.37(c)(iv) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”); *see also In re Lovin*, 652

F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted [identical text in a previous version of] Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”); *cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art.”).

Furthermore, the test of obviousness is not the precise language recited by the reference; the test for obviousness is what the references, when considered together, “would have suggested to one of ordinary skill in the art,” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981), who is a person of ordinary creativity and not an automaton (*KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007)), and whose inferences and creative steps we may consider (*id.* at 418). *See also In re Bond*, 910 F.2d 831, 832–33 (Fed. Cir. 1990) (citing *Akzo N.V. v. U.S. Int’l Trade Comm’n*, 808 F.2d 1471, 1479 & n.11 (Fed. Cir. 1986)) (Interpretation of references “is not an ‘ipsissimis verbis’ test.”); *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369 (Fed. Cir. 1991). (“[A] . . . reference . . . need not duplicate word for word what is in the claims.”).

Appellants’ argument amount to little more than a recitation of the language of the disputed limitation of claim 1, a recitation of the language of Weaver reference, and a naked assertion that they are not the same. *See* 37 C.F.R. § 41.37(c)(iv); *see also Bond*, 910 F.2d at 832–33. The unexplained emphases added by Appellants amount to no more than an invitation for us to examine the claims and art in greater detail than argued

by Appellants. *See Baxter*, 952 F.2d at 391. Additionally, Appellants do not address the entirety of the Examiner’s articulated findings regarding the disputed limitation; for example, Appellants do not address the Examiner’s reliance (Final Act. 5; Ans. 6), *inter alia*, on Weaver’s teaching of “conferences carrying video or other media” (Weaver, col. 9, l. 5).

For the foregoing reasons, Appellants’ arguments are insufficient to persuade us of error in the Examiner’s reliance on Weaver, when combined with Yamaguchi and Steinberg, to teach or suggest the disputed limitation.

Combination of References

Appellants contend:

that if Yamaguchi were modified and/or combined to cure the aforementioned deficiencies to reach [sic] “circuitry for **identifying one or more entities authorized to receive the at least one image representation obtained from the at least one image capture device based on at least one indication of at least one subset list of one or more individuals selected from at least one larger list**”, such a modification and/or combination would change the principle operation [sic] of Yamaguchi.

(Br. 19 (citing MPEP § 2143.01; *In re Ratti*, 270 F.2d 810 (CCPA 1959).)

Appellants reproduce passages of Yamaguchi, enclosing portions in rectangles for emphasis. (Br. 20–21 (reproducing Yamaguchi, Fig. 4, col. 6, ll. 26–57).) Appellants conclude as follows:

[I]f Yamaguchi were to be modified to reach “circuitry for **identifying one or more entities authorized to receive the at least one image representation obtained from the at least one image capture device based on at least one indication of at least one subset list of one or more individuals selected from at least one larger list**” as recited in Independent Claim 1, Yamaguchi would no longer principally operate by “**When the users of cell phones 110 want to get a copy of the picture**

currently on the host display 120, they send a request command to the host display from their cell phones 110.”

Thus, under controlling Federal Circuit precedent, there can be no “teaching” to resolve the facial differences shown above between the Yamaguchi technical material and Independent Claim 1 as a matter of law.

(Br. 21–22 (quoting Yamaguchi, col. 6, ll. 47–50).)

Appellants’ conclusory statement, which Appellants characterize as “attorney argument” (Br. 21–22) is unpersuasive because it conflates Yamaguchi’s *principle* (“the laws or facts underlying the workings of an artificial device,” MERRIAM WEBSTER’S COLLEGIATE DICTIONARY 927 (10th ed. 1999) (definition 1c)) of operation with how Yamaguchi *principally* (“most important[ly], consequential[ly], or influential[ly] : CHIEF[LY],” *id.* at 926 (definition 1)) operates. Even if we were to accept, *arguendo*, that the combination of Weaver with Yamaguchi would change how Yamaguchi principally (i.e., most importantly) operates, Appellants’ contentions do not demonstrate that the combination changes Yamaguchi’s principle (i.e., underlying laws or facts) of operation. Furthermore,

[t]o justify combining reference teachings in support of a rejection it is not necessary that a device shown in one reference can be physically inserted into the device shown in the other. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

Keller, 642 F.2d at 425 (citations omitted).

Appellants further contend as follows

[I]f Yamaguchi were modified and/or combined to cure the aforementioned deficiencies to reach “circuitry for **identifying one or more entities authorized to receive the at least one image representation obtained from the at least one image capture device based on at least one indication of at least one subset list of one or more individuals selected from at least one larger list**”, such a modification and/or combination would render Yamaguchi unsatisfactory for one or more of its intended purposes.

(Br. 22 (citing MPEP § 2143.01; *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).) Appellants reproduce passages of Yamaguchi, enclosing portions in rectangles for emphasis. (Br. 23–24 (reproducing Yamaguchi, Fig. 4, col. 6, ll. 26–57).) Appellants conclude as follows:

[I]f Yamaguchi were to be modified to reach “circuitry for **identifying one or more entities authorized to receive the at least one image representation obtained from the at least one image capture device based on at least one indication of at least one subset list of one or more individuals selected from at least one larger list**” as recited in Independent Claim 1, Yamaguchi would no longer be satisfactory for the following intended purpose: “[**T**]those present may more easily share in the experience **create great amusement and fun at parties, weddings, homes, or conferences**”.

(Br. 25 (quoting Yamaguchi, col. 6, ll. 42–43, 56–57).)

Appellants’ conclusory statement, which Appellants characterize as “attorney argument” (Br. 25), is unpersuasive. We assume, *arguendo*, and without deciding, that allowing those present to “more easily share in [an] experience . . . [to] create ‘great amusement and fun’” in various contexts is an intended purpose of Yamaguchi’s system and method, and not merely a subsidiary advantages of meeting “a need for an enhanced system of image display for cellular phones and other such wireless devices having digital

camera capabilities, while ensuring adequate bandwidth and resolution for the advanced imaging capabilities anticipated, yet with minimal power consumption” (Yamaguchi, col. 1, ll. 32–37). Nevertheless, Appellants do not explain, nor is it apparent from the quoted passages or Appellants’ emphases, why “identifying one or more entities authorized to receive the at least one image representation obtained from the at least one image capture device based on at least one indication of at least one subset list of one or more individuals selected from at least one larger list” as recited in claim 1 and taught by Weaver (*see* Final Act. 5; Ans. 6) would prevent “those present [from] . . . more easily shar[ing] in the experience . . . [to] create great amusement and fun at parties, weddings, homes or conferences” (Yamaguchi, col. 6, ll. 42–43, 56–57).

For the forgoing reasons, Appellants’ arguments do not persuade us the Examiner erred in concluding it would have been obvious at the time of Appellants’ invention to combine the teachings Yamaguchi, Steinberg, and Weaver as articulated by the Examiner.

Claim 1 Summary

Appellants’ arguments do not persuade us of error in the rejection of claim 1 over the combination of Yamaguchi, Steinberg, and Weaver. Accordingly, we sustain the rejection of claim 1. Appellants argue the patentability of independent claims 40, 83, 90, and 95 over the cited art by relying on the arguments presented for claim 1. (Br. 32–35.) Appellants do not separately argue the patentability of claims 2–4, 8, 13, 15, 17–24, 26–28,

31, 34, and 39, which depend from claim 1,² (Br. 25) and claims 41, 43–45, 53, 55, 57, 59, 60, 66, 67, and 70, which depend from claim 40 (Br. 32). Therefore, we sustain the rejection of claims 2–4, 8, 13, 15, 17–24, 26–28, 31, 34, 39, 40, 41, 43–45, 53, 55, 57, 59, 60, 66, 67, 70, 83, 90, and 95 for the same reasons as for claim 1.

Claim 96

Appellants contend the Examiner “did not cite to any specific art with respect to Claim 96.” (Br. 26.) Appellants further assert there are “no specific reasons supporting a rejection of Claim 96.” (*Id.*) We are not persuaded of error. As pointed out by the Examiner (Ans. 23–24), and conceded by Appellants (Br. 26), in rejecting claim 96 the Examiner stated the claim was “rejected for similar reasons as to claim 17[](**See rejection set forth in claim 17**) [sic]” (Final Act. 9). In rejecting claim 17, the Examiner relied on the rejection of claim 1, from which claim 17, like claim 96, directly depends. (Final Act. 8.) The Examiner made additional findings regarding the limitations added by claim 17 to those of claim 1. (Final Act. 8–9 (citing Steinberg, Figs. 1, 7, and 8).) Therefore, we find the Examiner has presented specific reasons for the rejection of claim 96. Appellants do not point to any specific error or deficiency in the Examiner’s findings as they apply to either claim 17 or claim 96.

Accordingly, we sustain the rejection of claim 96 for the reasons set forth under this heading and those set forth *supra* regarding claim 1.

² Appellants identify claims 2–4, 8, 13, 15, 17–24, 26–28, 31, 34, 39, and 96–100, as depending from claim 42 (Br. 25); however claim 42 is cancelled (Br. 44 (Claims App’x)).

Claim 97

Appellants contend as follows:

[T]he pinpoint-cited portions of Weaver do not recite at least “circuitry for **identifying one or more entities positionally independent of the at least one image capture device** and authorized to receive the textual content and the at least one image representation obtained from the at least one image capture device based on at least one indication of at least one subset list of one or more individuals selected from at least one larger list” as recited in Appellant[s’] Dependent Claim 97.

(Br. 27.) As with claim 1, Appellants have reproduced verbatim the language of the claim and passages of Weaver with rectangles added for emphasis (Br. 27–28 (reproducing Weaver, col. 2, ll. 18–20; col. 4, ll. 15–19).) We note Appellants do not address all of the passages of Weaver relied on by the Examiner or any of the passages of Steinberg relied on by the Examiner. (*See* Final Act 15 (citing Weaver, col. 2, ll. 11–20; col. 3, ll. 1–20; col. 4, ll. 10–33; Steinberg, Figs. 7, 8).) The only argument offered is the conclusory statement that the recitations of the claim and the reproduced passages of Weaver are different. (*See* Br. 28.) Appellants’ argument is unpersuasive of error for the substantially the same reasons as set forth *supra* regarding claim 1.

Accordingly, we are unpersuaded of error in the rejection of claim 97 for the reasons set forth under this heading and the reasons set forth *supra* regarding claims 1 and 96, from which claim 97 depends. Claims 98 and 99 depend from claim 97. Appellants’ only argument for the separate patentability of claims 98 and 99 is the same as Appellants’ argument regarding claim 96. (*See* Br. 28–30.) Therefore, for the same reasons as for claims 1, 96, and 97, we sustain the rejection of claims 98 and 99.

Claim 100

Appellants contend “the pinpoint-cited portions of Steinberg do not recite at least ‘circuitry for transmitting at least some of the feedback information received **from the at least some of the one or more entities to the at least one image capture device**’ as recited in Appellant[s’] Dependent Claim 100.” (Br. 31.) Similarly to claim 1, Appellants reproduce a figure from Steinberg with rectangles added for emphasis (*id.* (reproducing Steinberg, Fig. 12).) The figure reproduced by Appellants was not relied on by the Examiner in the office action appealed from to teach the limitations of claim 100 (*see* Final Act. 17 (citing Steinberg, Figs. 7, 8, 11)). To the extent Appellants may have intended to reproduce Steinberg’s Figure 11, we note that Appellants contentions do not address the Examiner’s reliance on Figures 7 and 8. (*See also* Steinberg, Figs. 10, 13 (appearing on the same page as Steinberg, Figs. 11, 12).) Appellants’ arguments are not commensurate with the grounds of rejection, in that they do not address the passages of Steinberg relied on by the Examiner as read together by one of ordinary skill in the art. The only argument offered is the conclusory statement that the recitations of the claim and the recitations of the reproduced figure of Steinberg are different. (*See* Br. 32.) Appellants’ argument is unpersuasive of error for the substantially the same reasons as set forth *supra* regarding claim 1.

Accordingly, we are unpersuaded of error in the rejection of claim 100 for the reasons set forth under this heading and the reasons set forth *supra* regarding claims 1 and 96–99, from which claim 100 depends. Therefore, we sustain the rejection of claim 100.

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DECISION

The decision of the Examiner to reject claims 1–4, 8, 13, 15, 17–24, 26–28, 31, 34, 39–41, 43–45, 53, 55, 57, 59, 60, 66, 67, 70, 83, 90, and 95–100 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

ACP