



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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,099	04/07/2004	Sean Christopher Endler	7114-86605-US	8955
37123	7590	01/29/2013	EXAMINER	
FITCH EVEN TABIN & FLANNERY, LLP			BETIT, JACOB F	
120 SOUTH LASALLE STREET			ART UNIT	
SUITE 1600			PAPER NUMBER	
CHICAGO, IL 60603-3406			2158	
			MAIL DATE	
			DELIVERY MODE	
			01/29/2013	
			PAPER	

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SEAN CHRISTOPHER ENDLER,
JOSEPH STEVEN HERRES, and IPPEI TAMBATA

Appeal 2010-008101
Application 10/821,099
Technology Center 2100

Before KRISTEN L. DROESCH, JUSTIN BUSCH, and HUNG H. BUI,
Administrative Patent Judges.

BUSCH, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-14 and 20-29. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Introduction

According to Appellants, the invention relates to "capturing and storing content and, more particularly, to capturing and storing content related to an event." Spec. 1:7-8.

STATEMENT OF THE CASE

Exemplary Claim

Claims 1 and 14 are exemplary and reproduced below:

1. A method comprising:
 - detecting an event;
 - searching for an event profile corresponding to the event wherein the searching is done without using a time or date;
 - detecting content transmitted by a participant of the event and description information corresponding to the content; and
 - associating the content with the event based on the description information and the event profile.

14. A system comprising:
 - means for detecting an event;
 - means for searching for an event profile corresponding to the event wherein the means for searching is adapted to search without using a time or a date;
 - means for detecting content related to the event and transmitted by a participant of the event and description information corresponding to the content;

means for associating the content with the event based on the description information and the event profile; and means for storing the content and the event.

References

Chang	US 2003/0050982 A1	Mar. 13, 2003
Ohkubo	US 2003/0184653 A1	Oct. 2, 2003

Rejections

Claim 14 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 26-27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Chang.

Claims 1-14, 20-25, 28, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Chang and Ohkubo.

ISSUES

Appellants argue that claim 14 is directed to patentable subject matter because the disclosed structure for the recited “means for storing the content and the event” is the storage module, which is not software. App. Br. 14-15.¹ Appellants also argue that Chang does not disclose using an attribute other than a date/time for matching an event to content. App. Br. 15-17. Appellants further argue that the combination of Chang and Ohkubo does

¹ Throughout this opinion we refer to Appellants’ Appeal Brief dated January 11, 2010.

not teach searching for an event profile that matches the event **without** using a time or date. App. Br. 17-31.

Issue 1: Has the Examiner erred in determining that claim 14 is directed to non-statutory subject matter?

Issue 2: Has the Examiner erred in determining that Chang discloses using an attribute other than date or time for matching content to an event, as recited in independent claim 26?

Issue 3: Has the Examiner erred in determining that the combination of Chang and Ohkubo teaches “searching for an event profile corresponding to the event wherein the searching is done without using a time or date,” as recited in claim 1 and commensurately recited in independent claims 14, 20, and 25?

ANALYSIS

Issue 1

Appellants argue that claim 14 is directed to statutory subject matter because Appellants’ Specification provides structure that includes “a tangible physical storage location.” App. Br. 14-15. The Examiner finds that claim 14 is directed to non-statutory subject matter because, in at least one embodiment disclosed by Appellants, the invention would be comprised completely of software. Ans. 12. We agree with Appellants. We note the guidelines provided in the MPEP, which were published after the Briefs for this Appeal were filed:

Often the supporting disclosure for a computer-implemented invention discusses the implementation of the functionality of

the invention through hardware, software, or a combination of both. In this situation, a question can arise as to which mode of implementation supports the means-plus-function limitation. The language of 35 U.S.C. 112, sixth paragraph requires that the recited “means” for performing the specified function shall be construed to cover the corresponding “structure or material” described in the specification and equivalents thereof. Therefore, by choosing to use a means-plus-function limitation and invoke 35 U.S.C. 112, sixth paragraph, applicant limits that claim limitation to the disclosed structure, i.e., implementation by hardware or the combination of hardware and software, and equivalents thereof. **Therefore, the examiner should not construe the limitation as covering pure software implementation.**

However, **if there is no corresponding structure disclosed in the specification** (i.e., the limitation is only supported by software and does not correspond to an algorithm and the computer or microprocessor programmed with the algorithm), **the limitation should be deemed indefinite as discussed above, and the claim should be rejected under 35 U.S.C. 112, second paragraph.** It is important to remember that claims must be interpreted as a whole; so, a claim that includes a means-plus-function limitation that corresponds to software per se (and is thus indefinite for lacking structural support in the specification) is not necessarily directed as a whole to software per se unless the claim lacks other structural limitations.

MPEP § 2181 II.B. (emphases added). We therefore reverse the Examiner’s rejection of claim 14 under 35 U.S.C. § 101, but note that, in the event of further prosecution, the Examiner may wish to consider whether a rejection under 35 U.S.C. § 112, second paragraph is warranted.²

² In the event of further prosecution, the Examiner may also wish to review claims 1 and 26 (and their dependent claims) to determine whether the claims are directed to an abstract idea that covers a mental process.

Issue 2

Appellants argue that the user ID in Chang, which is sent to the calendar, “is not an attribute relating to the event,” but rather relates to the calendar and is used “to locate the user’s calendar.” App. Br. 16. Appellants then allege that “the only attribute of the event that is matched with the attribute of the content is the time stamp (See Chang, para. 0015).” *Id.* Appellants also argue that, even though the user attribute may be common between the content and the event, “the user attribute is not used to associate the content with the event as recited in Claim 26.” *Id.*

The Examiner explains that Chang discloses using both a user identifier and time stamp information of the content to match the content to an event. Ans. 13. The Examiner finds that the user’s calendar is located using the user identifier, then the event on the calendar is located using the time stamp information. *Id.* The Examiner also points out that a user identifier is “necessarily related to every event on their calendar,” and that the user identifier is related to the content, potentially as the author of that content. *Id.* Finally, the Examiner explains that, without using the user attribute to match the event to the content, the system would not be able to differentiate between two events occurring at the same time on calendars for two different users. *Id.*

In other words, the Examiner finds that one of the attributes used to match the event to the content is a user identifier, which is neither a date nor a time. Chang uses both the user identifier and a time stamp to associate events with content. The fact that Chang also uses a time stamp is not excluded by the claim language. Therefore, to the extent that Appellants are

arguing that Chang does not anticipate claim 26 because Chang uses a time stamp in addition to a user identifier, whereas the invention relates to using only an attribute that is not a date or time, we find that Appellants' arguments are not commensurate with the scope of the claims. We agree with the Examiner's findings and conclusions and therefore affirm the Examiner's anticipation rejection of claim 26 and dependent claim 27, not argued separately.

Issue 3

Appellants argue that the Examiner's construction of "wherein the searching is done without using a time or date" is in error and that the proper construction "requires searching without using either time or date, not without using time or without using date." App. Br. 18. Appellants then contend that, because Ohkubo discloses using at least a date for its searching, the combination of Chang and Ohkubo does not teach the recited limitations. App. Br. 19.

The Examiner concedes that the prior construction was incorrect. Ans. 15. However, the Examiner finds that Ohkubo still teaches the recited language because one embodiment of Ohkubo discloses obtaining calendar information "based on the photography location information." *Id.*

We agree with the Examiner's findings and conclusions and affirm the rejection of independent claim 1. Appellants assert the same arguments with respect to independent claims 14, 20, and 25. Appellants do not argue dependent claims 2-13, 21-24, 28, or 29 separately. For the same reason as

Appeal 2010-008101
Application 10/821,099

discussed above, we agree with the Examiner's findings and conclusions with respect to claims 2-14, 20-25, 28, and 29.

DECISION

The Examiner's rejection of claim 14 under 35 U.S.C. § 101 is reversed.

The Examiner's rejection of claims 26 and 27 under 35 U.S.C. § 102(b) is affirmed.

The Examiner's rejection of claims 1-14, 20-25, 28, and 29 under 35 U.S.C. § 103(a) 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)(iv) (2011).

AFFIRMED

tj