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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEPHEN G. PRICE and SUZANNE L. PRICE

Appeal 2010-009823
Application 10/703,693
Technology Center 2400

Before JOSEPH F. RUGGIERO, BRUCE R. WINSOR, and
DANIEL N. FISHMAN, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 13 and 46-67, which constitute all the claims pending in this application. App. Br. 3, 6.¹ Claims 1-12 and 14-45 are cancelled. App. Br. 3. We have jurisdiction under 35 U.S.C. § 6(b)(1). We affirm.

¹ Throughout this opinion, we refer to: (1) the Appeal Brief ("App. Br.") filed July 15, 2009, as supplemented by Exhibits filed November 17, 2009; (2) the Examiner's Answer ("Ans.") mailed March 24, 2010; (3) the Reply Brief ("Reply Br.") filed May 20, 2010; (4) Rule § 1.131 Declaration of Stephen G. Price ("SGP Decl.;"") executed June 16, 2008; and (5) Rule § 1.131 Declaration of Suzanne L. Price ("SLP Decl.;"") executed June 19, 2008.

STATEMENT OF THE CASE

The Invention

Appellants' invention relates to communicating with computer system peripheral devices using Instant Messaging software embedded within a peripheral device. The peripheral device uses the embedded software to communicate with a computer system responsive to an event and/or to communicate with a user, application program, or other device, relating to events and print jobs. *See generally* Abstract.

Claim 13 is reproduced below and is illustrative of the claims at issue on this appeal:

13. A method for a peripheral device to communicate with a computer system, comprising:

providing a peripheral device having a processor means and instant messaging software embedded within;

placing the peripheral device in communication with a computer system comprising an instant messaging server; and

the peripheral device processor means using the embedded instant messaging software to communicate to a client through the instant messaging server responsive to detecting an event or to receiving an instant messaging message, comprising:

the peripheral device:

determining a type of the event; or

receiving the instant messaging message and parsing the received instant messaging message with the embedded instant messaging software to determine a type of the received parsed message;

the peripheral device using the embedded software to create a message responsive to the event type or to the received parsed message type; and

the peripheral device sending out the created message to the client instant messaging server.

The Examiner relies on the following as evidence of unpatentability:

Sagi	US 2003/0078979 A1	Apr. 24, 2003
Lee	US 2005/0015446 A1	Jan. 20, 2005

Schroath²

US 6,973,597 B2

Dec. 6, 2005

Appellants rely on the following as evidence of date of reduction to practice:

Suzanne L. Price	§ 1.131 Declaration	June 19, 2008
Stephen G. Price	§ 1.131 Declaration	June 16, 2008
Exhibit A	Amended Exhibit to Rule § 1.131 Declarations	Dec. 10, 2008
Exhibit B	Amended Exhibit to Rule § 1.131 Declarations	Dec. 10, 2008

The Rejections

Claims 13, 46-49, 53, 54, 57-59, 62, and 63 stand rejected under 35 U.S.C. § 102(e) as anticipated by Sagi. Ans. 3-6.

Claims 50, 55, 60, and 64 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sagi and Lee. Ans. 6-8.

Claims 51, 52, 56, 61 and 65-67 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sagi, Lee, and Schroath. Ans. 8-9.

ISSUE

The issue presented by Appellants' contentions is: Has the Examiner erred in finding the § 1.131 Declarations (SGP Decl., SLP Decl.) insufficient to remove Sagi and Lee as prior art under 35 U.S.C. §§ 102(e) and 103(a)?

² Schroath was not included in the Examiner's statement of evidence relied upon, Ans. 2-3, but was included in the statement of the grounds of rejections, Ans. 9. Based on a review of the record as a whole, we conclude this was a harmless typographical error.

ANALYSIS

REJECTION OF CLAIMS 13, 46-49, 53, 54, 57-59, 62, AND 63

The Examiner found that that Sagi discloses every limitation recited in claims 13, 46-49, 53, 54, 57-59, 62, and 63. Ans. 3-6. Appellants filed Declarations (SGP Decl. and SLP Decl. with supporting Exhibits A and B) under 37 C.F.R. § 1.131 to remove Sagi as a prior art reference.

Appellants' Appeal Brief does not substantively address the Examiner's reading of the rejected claims on the teachings of Sagi, Lee or Schroath as set forth in the rejections. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2010).

Actual Reduction to Practice Prior to Sagi

Appellants argue that the Declarations and supporting Exhibits (SGP Decl., SLP Decl., Exhibit A and Exhibit B) present (emphases added) “facts that are sufficient to show that they conceived *and reduced to practice* the invention taught and described in the specification and claims of the above application *on a date prior to the October 22, 2001 filing date of the referenced Sagi publication.*” App. Br. 7. In other words, Appellants assert *actual* reduction to practice prior to the effective date of Sagi. The Declaration under § 1.131 of inventor Stephen G. Price and that of inventor Suzanne L. Price both state (emphases added):

Of my own knowledge, prior to the date of October 22, 2001, the invention, being fully conceived and reduced to practice, was submitted for consideration for patentability as well as for use in IBM products or services, the submission itself requiring that the invention be fully operational and reduced to practice.

SGP Decl. 2; SLP Decl. 2.³ The inventors are therefore asserting *actual* reduction to practice prior to the effective date of Sagi (October 22, 2001) suggesting that Exhibits A and B, *per se*, constitute an *actual* reduction to practice. App. Br. 7. Appellants state: “[E]xhibits A and B on their face sufficiently describe the invention in detail such that one of ordinary skill in the art would be able to make and use the same, establishing both conception and the reduction to practice of the invention on April 5, 2001.” Reply Br. 2-3. We disagree.

We agree with the Examiner’s statement that (emphases added):

[P]roof of actual reduction to practice requires a showing that the apparatus existed and worked for its intended purpose. A written description does not constitute an *actual reduction to practice*. Furthermore only the filing of a US patent application which complies with the disclosure requirement of 35 USC 112 constitutes a constructive reduction to practice. [See MPEP §§ 715.07(III), 2138.05(I).] A written description, no matter how complete, which has not been made the subject of a US patent application does not qualify as reduction to practice. *Neither Exhibit A nor Exhibit B shows an existing apparatus or software that worked to implement the functionality of the claims.*

Therefore, evidence submitted is insufficient to provide proof of actual reduction to practice prior to the critical date.

Ans. 12. MPEP § 2138.05(II) points out that (emphases added; citations omitted):

³ We note that the Declaration of inventor Suzanne L. Price includes an identical statement with the word “*constructively*” inserted (handwritten) before the phrase “*reduced to practice*”. SLP Decl. 2. We disregard this handwritten note because the instant patent application was filed after the effective date of Sagi and, therefore, could not form a basis for constructive reduction to practice prior to Sagi.

The same evidence sufficient for a constructive reduction to practice may be insufficient to establish an *actual reduction to practice*, which requires a *showing of the invention in a physical or tangible form* that shows every element of the count. *For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose*, but it need not be in a commercially satisfactory stage of development.

The filed Declarations (SGP Decl. and SLP Decl. with associated Exhibits A and B) do not sufficiently evidence the existence of any physical or tangible form of the invention and do not sufficiently evidence any testing of the invention to demonstrate that it will work for its intended purpose.

Appellants further assert (emphases added):

Finally, the Examiner states that appellants have not provided any indications of repeated successful testing of the invention prior to the effective date of Sagi in order to establish a reduction to practice. However, the Examiner has not cited to authority that such testing is required. MPEP 2138.05(III) states that “*The nature of testing which is required to establish a reduction to practice depends on the particular facts of each case, especially the nature of the invention*’ *Gellert v. Wanberg*, 495 F.2d 779, 783, 181 USPQ 648, 652 (CCPA 1974).” *The Examiner has failed to establish that the nature of the claimed invention requires testing to establish a reduction to practice prior to the effective date of the referenced Sagi publication.*

App. Br. 11. The quoted portion of MPEP § 2138.05(III) above suggests that *some* testing is required but that the nature of the testing required may vary depending on the nature of the invention. *Some* testing or *some* facts evidencing that the invention exists and was demonstrated to work for its intended purpose is required under Rule § 1.131.

Appellants further argue that the invention is “such a simple device that the original and Replacement Exhibits A and B on their face sufficiently

describe the invention in detail such that one of ordinary skill in the art *would be able to make and use the same* establishing both conception and the reduction to practice of the invention on April 5, 2001.” App. Br. 10. Appellants cite *In Re Asahi/America, Inc.*, 68 F.3d 442 (Fed. Cir. 1995), in support of their assertion. App. Br. 10. In deciding *Asahi/America*, our reviewing court stated that (emphasis added) “some devices [are] so simple that a *mere construction* of them is all that is necessary to constitute reduction to practice” (*Asahi/America*, 68 F.3d. at 445 citing *Sachs v. Wadsworth*, 48 F.2d 928, 929 (CCPA 1931)). The *Asahi/America* court determined that Asahi had successfully reduced the invention to practice prior to the critical date stating that “Asahi presented evidence that the claimed coupling was manufactured by an outside vendor and described in two trade publications as part of commercial offerings” (*Asahi/America*, 68 F.3d. at 446). Here, Appellants do not present evidence similar to the evidence presented in *Asahi/America*. In the present case, Appellants have failed to present evidence of even a “*mere construction*” but rather provide a list of goals and desired features of the proposed invention in Exhibits A and B. Accordingly, we agree with the Examiner's conclusion that Appellants' evidence fails to sufficiently show *actual* reduction to practice prior to the effective date of Sagi. Ans. 12.

In view of the above discussion, we agree with the Examiner that the Rule § 1.131 Declarations and associated Exhibits A and B present insufficient facts evidencing existence of the invention in any physical or tangible form or evidencing any testing of the invention. Thus, the Rule § 1.131 Declarations present insufficient facts to evidence an *actual* reduction to practice.

For emphasis, we note that numbered paragraph 4 of both Exhibit A and Exhibit B (p. 3 of each Exhibit) provides the following prompt for the inventors: “If the invention is implemented in a product or prototype, include technical details, purpose, disclosure details to others and the date of that implementation.” Neither exhibit provides any such description of implementation as a product or prototype. Contrary to Appellants’ position, this omission suggests that the invention was *not* yet actually reduced to practice at the time of the invention disclosures (i.e., at the date and time of Exhibits A and B – both dated April 5, 2001).

Further, we note that the language of the exhibits is primarily phrased in the future tense suggesting how the invention *might* function or how it *could* be configured rather than how the invention *does* function or how it *is* configured. For example, Exhibit A includes numerous phrases such as (emphasis added):

- “Chat *could be used* interactively with the device.” Ex. A 2.
- “Chat command *could be implemented* to set some or all...” Ex. A 2.
- “The device *may* have facilities for holding...” Ex. A 2.
- “Chat commands *could* list these jobs...” Ex. A 2.
- “One *could implement* a feature that printed out...” Ex. A 3.
- “We *could also* print files using a chat protocol...” Ex. A 3.

Exhibit B contains similar recitations in the future tense but fails to describe any details of an actual implementation. Contrary to Appellants position, the phrasing of these recitations in Exhibits A and B suggests a set of future design goals rather providing evidence that the invention has been

actually reduced to practice at the time of the invention disclosures (at the time of Exhibits A and B – April 5, 2001).

For the foregoing reasons, Appellants have not persuaded us that the Declarations and supporting Exhibits (SGP Decl., SLP Decl., Exhibit A and Exhibit B) demonstrate that the inventions claimed in claims 13, 46-49, 53, 54, 57-59, 62, and 63 were actually reduced to practice prior to the October 22, 2001 filing date of Sagi.

Constructive Reduction to Practice After Sagi

In portions of their Appeal Brief and Reply Brief, Appellants discuss issues of conception, constructive reduction to practice and diligence. These issues are not relevant to the issue of support under Rule § 1.131 for *actual* reduction to practice *prior* to the effective date of a prior art reference. Appellants allege only *actual reduction to practice ante-dating Sagi (and Lee)*. Since conception and diligence are not at issue with respect to a claim of *actual* reduction to practice ante-dating a prior art reference under Rule § 1.131, we do not rule here as to the sufficiency of the Rule § 1.131 filings with respect to conception or diligence.

Summary

Based on the record before us, we find no error in the Examiner's finding that the Declarations and supporting Exhibits (SGP Decl., SLP Decl., Exhibit A and Exhibit B) are insufficient to remove Sagi as a reference under 35 U.S.C. § 102(e). We will, therefore sustain the rejection of claims 13, 46-49, 53, 54, 57-59, 62, and 63.

REJECTION OF CLAIMS 50-52, 55, 56, 60, 61, AND 64-67

Appellants argue that the Rule § 1.131 Declarations and associated Exhibits A and B serve to remove both Sagi and Lee as prior art references

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under 35 U.S.C. § 102(e) and § 103(a). App. Br. 12. The Examiner finds the § 1.131 Declarations and associated exhibits insufficient to remove Sagi and Lee as a prior art references. Ans. 14. We agree for the reasons expressed above. Based on the record before us, we find no error in the Examiner's rejection of claims 50-52, 55, 56, 60, 61, and 64-67.

CONCLUSION

The Rule § 1.131 Declarations are insufficient to remove Sagi and Lee as prior art references and therefore the Examiner did not err in rejecting claims 13 and 46-67.

DECISION

The Examiner's decision rejecting claims 13 and 46-67 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).

AFFIRMED

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