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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROYCE A. LEVIEN, ROBERT W. LORD, and
MARK A. MALAMUD

Appeal 2011-004106
Application 11/404,381¹
Technology Center 2600

Before THU A. DANG, JAMES R. HUGHES, and
GREGORY J. GONSALVES, *Administrative Patent Judges*.

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's Final rejection of claims 1-44 and 46-49. Claim 45 was cancelled during prosecution. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Application filed April 14, 2006 claiming benefit of continuation application 11/143,970 filed June 2, 2005. The real party in interest is Intellectual Property Ventures LLC. (Br. 5.)

Invention

Appellants' invention relates generally to a data storage usage protocol. (Spec. 1.)²

Representative Claim

Independent claim 1, reproduced below with the key disputed limitations emphasized, further illustrates the invention:

1. A data storage protocol technique comprising:
 - providing a separate storage facility that receives selected captured data via a communication link from at least one transmitting capture device, which capture device includes local memory capacity;
 - maintaining some or all of the selected captured data at the separate storage facility as an inventory data version that is stored in accordance with a safekeeping arrangement;*
 - providing different status categories to identify the inventory data version of the selected captured data;
 - establishing future accessibility guidelines in accordance with the safekeeping arrangement to control back and forth data transferability between the separate storage facility and an external unit; and
 - implementing the future accessibility guidelines based on an applicable attribute associated with the external unit.

Rejections on Appeal

1. The Examiner rejects claims 1-12, 14, 16-25, 27, 28, 31-44, and 46-49 under 35 U.S.C. § 102(e) as being anticipated by Steinberg (US Patent No. 6,750,902 B1 issued June 15, 2004).

² We refer to Appellants' Specification ("Spec.") and Appeal Brief ("Br.") filed Aug. 27, 2010. We also refer to the Examiner's Answer ("Ans.") mailed Oct. 7, 2010.

2. The Examiner rejects claims 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Steinberg and Huberman (US Pat. Pub. 2006/0087559 A1 published Apr. 27, 2006 (filed Oct. 21, 2004)).

3. The Examiner rejects claims 13 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Steinberg and Nonaka (US Pat. Pub. 2005/0093980 A1 published May 5, 2005).

4. The Examiner rejects claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Steinberg and Sato (US Patent No. 7,219,365 B2 issued May 15, 2007 (filed Dec. 6, 2002)).

Grouping of Claims

Based on Appellants' arguments in the Brief, we will decide the appeal on the basis of representative claims 1, 13, 26, and 29. *See* 37 C.F.R. § 41.37(c)(1)(iv).

ISSUES

1. Under § 102, did the Examiner err in finding that Steinberg discloses: “*maintaining some or all of the selected captured data at the separate storage facility as an inventory data version that is stored in accordance with a safekeeping arrangement*” (emphasis added), within the meaning of independent claim 1, and the commensurate language of claims 38 and 45?

2. Under 103, did the Examiner err in finding that the cited combination of Steinberg and Huberman would have taught or suggested “*providing restricted availability to the inventory data versions based on a fee schedule*” (emphasis added), as recited in dependent claim 29?

3. Under 103, did the Examiner err in finding that the cited combination of Steinberg and Nonaka collectively, would have taught or suggested “*transferring selected captured data from an external unit to the separate storage facility based on a failure to obtain confirmation of an authorized user at the external unit*” (emphasis added), as recited in dependent claim 13?

4. Under 103, did the Examiner err in finding that the cited combination of Steinberg and Sato collectively would have taught or suggested “*changing a status category of inventory data versions based on a lack of usage over a period of time*” (emphasis added), within the meaning of dependent claim 26?

ANALYSIS

Anticipation Rejection

Appellants contend, *inter alia*, Steinberg does not describe “maintaining some or all of the selected captured data at the separate storage facility as an inventory data version that is stored in accordance with a safekeeping arrangement” as recited in independent claim 1. (Br. 39.) More specifically, Appellants contend that the Office Action does not set forth a *prima facie* case of anticipation and, in particular, does not point to any element of Steinberg corresponding to the limitation at issue. (Br. 40.)

We agree with and adopt the Examiner’s findings with respect to representative claim 1. (Ans. 3-5, 27-28.) More specifically, we agree with the Examiner that Steinberg teaches *inter alia*:

[S]torage 10 has a security engine 76 per Fig. 3 and that storage 10 receives image data from the camera and secures the data according to a required protocol as stated in col. 4, lines 53-55

where data can be inventoried according to a safekeeping based on camera ID or Unique number to secure the image as stated in col.5, lines 55-63. Additionally, Safekeeping arrangement is achieved by password protecting data, encrypting data, watermarking data, image authenticating data, and other identifiers as stated in col. 8, lines 35-67.

(Ans. 28.)

We observe that Appellants' arguments consists of reiterating the Examiner's rejection and cited portions of Steinberg (Br. 37-38, 45-46), a statement that Steinberg does not describe the limitation at issue (Br. 39, 46), further reiterations of Steinberg (Br. 39-40), and a conclusion that the Examiner did not point to any element of Steinberg that corresponds to the limitation at issue. (Br. 40, 47.) We find this form of argument unavailing. This form of argument does not amount to a separate patentability argument and is unpersuasive of error in the Examiner's rejection. *See Ex parte Belinne*, No. 2009-004693, 2009 WL 2477843 at *3-4 (BPAI Aug. 10, 2009) (informative); *see also* 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."). Appellants' argument "do[es] not . . . explain why the Examiner's explicit fact finding is in error." *Belinne*, 2009 WL 2477843 at *4. Mere attorney arguments and conclusory statements that are unsupported by factual evidence are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984). This reasoning is applicable in the present case.

To the extent Appellants argue that Steinberg does not explicitly set forth the exact language cited in claim 1 (Br. 40, 46) we note that anticipation "is not an 'ipsissimis verbis' test." *In re Bond*, 910 F.2d 831,

832-33 (Fed. Cir. 1990) (citing *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479 n.11 (Fed. Cir. 1986)). “An anticipatory reference . . . need not duplicate word for word what is in the claims.” *Standard Havens Prods. v. Gencor Indus.*, 953 F.2d 1360, 1369 (Fed. Cir. 1991).

As noted above, the Examiner sets forth a detailed explanation of the anticipation rejection (Ans. 3-5, 27-28), which complies with the notice function of the “prima facie case.” *In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011).³ Accordingly, we find that the Examiner set forth a prima facie case for anticipation of independent claims 1 and 38, and did not rely on Official Notice. Further, Appellants’ assertion regarding impermissible hindsight (Br. 43), is not relevant to a rejection under § 102.

Moreover, we observe that Appellants did not respond to the Examiner’s *specific findings* as discussed in the Answer, (Ans. 3-5, 27-28.) and Appellants did not file a Reply Brief. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). *Cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991)

Appellants also contend:

USPTO has not engaged in the broadest reasonable interpretation framework regarding Claims [b], and accordingly has inadvertently ignored at least the “maintaining some or all of the selected captured data at the separate storage

³ “[T]he prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.” *Jung*, 637 F.3d at 1362 (quoting *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007)). “[T]he PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies 35 U.S.C. § 132, in ‘notify[ing] the applicant . . .’” *Jung*, 637 F.3d at 1362 (quoting 35 U.S.C. § 132).

facility as an inventory data version that is stored in accordance with a safekeeping arrangement” recitations of Clause [b].

(Br. 45.) We agree with and adopt the Examiner’s construction of claim 1. Appellants have not shown where the Examiner’s claim construction was not broad and reasonable in light of Appellants’ Specification. *See In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (internal citations omitted).

Regarding independent claim 44, Appellants contend that Steinberg fails to disclose “Clause [c]” of claim 44. (Br. 82.) We observe that independent claim 44 is an apparatus (system) claim consisting of a computer, data storage, and instructions. We construe “clause [c]” of claim 44 to recite numerous types of parameters, i.e., data, but this data is not positively recited as being accessed in claim 44. Rather, the “instructions” are “configured to enable future back and forth transferability,” and implement an algorithm that facilitates *future accessibility* to status categories *based on* the parameters.

We find that the limitation at issue consists of a statement of intended use and data (non-functional descriptive material) and is not to be given patentable weight. “An[]intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.” *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003). Although “[s]uch statements often . . . appear in the claim’s preamble,” *In re Stencel*, 828 F.2d 751, 754 (Fed.Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.* The accessibility at some point in the future to various status categories based on various data (listed parameters) also does not further limit the claim either functionally or

structurally. *See Ex parte Nehls*, 88 USPQ2d 1883, 1889 (BPAI 2008) (precedential).⁴

This reasoning is applicable in the present case. We agree with and adopt the Examiner's with respect to claim 44. (Ans. 22.)

Based on this record, we conclude that the Examiner did not err in concluding that Steinberg would have disclosed or described the limitation at issue. Appellants did not argue for the patentability of claims 2-12, 16-25, 27, 28, and 31-43 and 46-49 with particularity. (Br. 48.) Accordingly, we affirm the Examiner's rejection of representative claim 1 and claims 2-12, 14, 16-25, 27, 28, 31-44, and 46-49.

⁴ The data on which the accessibility may be based constitutes non-functional descriptive material, which merely recites what the information or data represents (the name or label for the data). The acts of identifying, matching, and/or storing based on the data (none of which are actually recited in the claim or argued by Appellants), as well as the structure and functionality of the processor are the same regardless of what the data constitutes, how the data may be named, or the relationship among the data and do not further limit the claimed invention either functionally or structurally. The informational content of the data thus represents non-functional descriptive material, which "does not lend patentability to an otherwise unpatentable computer-implemented product or process." *Ex parte Nehls*, 88 USPQ2d 1883, 1889 (BPAI 2008) (precedential). *See Ex parte Curry*, 84 USPQ2d 1272, 1274 (BPAI 2005) (informative) (Fed. Cir. Appeal No. 2006-1003), *aff'd*, (Rule 36) (June 12, 2006) ("wellness-related" data in databases and communicated on distributed network did not functionally change either the data storage system or the communication system used in the claimed method). *See also In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *Nehls*, 88 USPQ2d at 1887-90 (discussing non-functional descriptive material).

Obviousness Rejections

Claims 29-30

Appellants initially contend that claims 29 and 30 are patentable because Huberman fails to cure the deficiencies of Steinberg that were argued with respect independent claim 1. (Br. 49.) We disagree for the reasons discussed above.

Appellants also contend that the cited combination of references do not teach or suggest *providing restricted availability to the inventory data versions based on a fee schedule*, as recited in dependent claim 29. (Br. 49.)

More specifically, Appellants contend:

[T]he USPTO has mapped, a "service contract", onto "providing restricted availability to the inventory data versions based on a fee schedule" which, as one skilled in the art would appreciate, is not appropriate because "providing restricted availability to the inventory data versions based on a fee schedule" is different from the service contract of Huberman. Consequently, according on its face, Huberman does not show the text of at least Clause [a] of Dependent Claim 29.

(Br. 50.)

The Examiner relied on paragraphs [0034, 0029, and 0024] of Huberman. (Ans. 30.) We agree with and adopt the Examiner's findings with respect to claim 29. More specifically, we agree with the Examiner that Huberman teaches a pre-defined clustering criteria (restricted availability) based on a service agreement (fee schedule). (Huberman, ¶ [0029].) Based on this record, we agree with the Examiner that the cited combination of references, *collectively*, would have taught or suggested the limitations recited in claim 29.

Regarding claim 30, Appellants merely repeat the arguments submitted for claim 29 from which claim 30 depends, while substituting the

language of claim 30 with the language of claim 30. (Br. 53-56.) Regarding claim 30, the Examiner found that the “fee” is *inherently* paid to the service provider. (Ans. 25.) We agree with and adopt the Examiner’s findings. (*Id.*) We observe that Appellants do not address the Examiner’s *specific* findings other than to say that the findings are conclusory.⁵ As discussed above, we find this type of argument unavailing.

Regarding both claims 29 and 30, Appellants contend that the Examiner did not provide a mapping between the teachings of Steinberg and Huberman to the express language of claims 29 (Br. 51) and 30 (Br. 55). We disagree. As noted above, the Examiner provided adequate evidence in support of the § 103 rejections of claims 29 and 30. Again, Appellants did not dispute the Examiner’s specific findings.

Further, Appellants argue that the Examiners’ rejections of claims 29 and 30 are based on impermissible hindsight. (Ans. 51, 55.) We disagree. Here, it is our view that an artisan possessing common sense and creativity at the time of the invention would have been familiar with a variety of methods for data and image storage, such as those methods taught or suggested by the collective teachings of Steinberg and Huberman. While we are fully aware that hindsight bias often plagues determinations of obviousness, *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966), we are also mindful that the Supreme Court has clearly stated that the “combination of

⁵ “[A]fter the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to appellant to ‘prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.’” *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986) (quoting *In re Swinehart*, 439 F.2d 210, 212-13 (CCPA 1971)).

familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int'l Co. v. Teleflex Inc.* 127 S. Ct. 1727, 1739 (2007).

This reasoning is applicable here. Thus, we find unavailing Appellants’ contention that the Examiner has relied on impermissible hindsight reconstruction. Given the breadth of Appellants’ claims, we are not persuaded that combining the respective familiar elements of the cited references in the manner proffered by the Examiner was “uniquely challenging or difficult for one of ordinary skill in the art” (*see Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418)). Therefore, we find the Examiner’s proffered combination of familiar prior art elements according to their established functions would have conveyed a reasonable expectation of success to a person of ordinary skill having common sense at the time of the invention.

Based on this record, we conclude that the Examiner did not err in finding that the cited combination of Steinberg and Huberman would have been obvious at the time of Appellants’ invention. Accordingly, we affirm the Examiner’s rejection of claims 29 and 30.

Claims 13 and 15

As noted above, the Examiner rejects claims 13 and 15 under § 103. Appellants initially argue that Nonaka fails to cure the deficiencies of Steinberg with respect to claim 1, from which claim 13 depends. (Br. 57.) We disagree for the reasons discussed above with respect to independent claim 1. In addition, Appellants argue that the cited combination of references fail to teach or suggest “transferring selected captured data from an external unit to the separate storage facility based on a failure to obtain

confirmation of an authorized user at the external unit.” (Br. 57, emphasis omitted.)

The Examiner found that Nonaka supplies the teaching lacking in Steinberg, specifically – “Nonaka teaches an external unit which transfers data to a storage facility when an unauthorized user (inherently fails to confirm as an authorized user) captures images in a restricted area.” (Ans. 26.) We agree with and adopt the Examiner’s findings.

After repeating the cited portions of Nonaka, (Br. 57-58) Appellants then conclude that the Examiner’s mapping of Nonaka to the claim language is inappropriate because the claimed language “is different from the restricted photography of Nonaka. Consequently, on its face, Nonaka does not show the text of at least Clause [a] of Dependent Claim 13.” (Br. 58.) We observe that Appellants’ arguments do not discuss the differences between the cited reference and the claim language. (*Id.*)

Appellants have not persuasively rebutted the Examiner’s specific findings with respect to claim 13. Similar to the discussion *supra*, we find this type of argument unavailing. With regard to claim 15, Appellants merely repeat the arguments presented for the patentability of claim 13, while substituting the language of claim 15 where applicable. (Br. 61-64.) We are not persuaded by these arguments for the reasons discussed *supra*.

Based on this record, we conclude that the Examiner did not err in rejecting claims 13 and 15. Accordingly, we affirm the Examiner’s rejection of claims 13 and 15.

Claim 26

As noted above, the Examiner rejects claim 26 under § 103. Appellants initially argue that Sato fails to cure the deficiencies of Steinberg with respect to claim 1, from which claim 26 depends. (Br. 65.) We disagree for the reasons discussed above with respect to independent claim 1.

Appellants further contend that the cited references fail to teach or suggest “changing a status category of inventory data versions based on a lack of usage over a period of time”, as recited in claim 26. More specifically, Appellants assert that the Examiner’s mapping of Sato to the language of claim 26 is not appropriate because “a status category for data that does not exist is illogical, and therefore would defeat the principle of operation of any logical reference.” (Br. 66.) We disagree for the reasons discussed *infra*.

The test for obviousness is not whether the features of a reference may be bodily incorporated into the structure of another reference but what the combined teachings of those references would have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (citations omitted). This reasoning is applicable in the present case.

The Examiner relied on Sato to teach or suggest, changing the status category of inventory data versions based on a lack of usage over time. (Ans. 27.) The cited portion of Sato teaches deleting the data over a period of time. (Sato, col. 8, ll. 58-63.) Therefore, we agree with the Examiner finding that the cited combination *collectively*, would have taught or suggested the limitation of claim 26 because the *status* of the data does change from existent to non-existent based on a lack of usage over time.

Steinberg was relied upon by the Examiner to disclose providing status categories. (Ans. 4.) The cited portions of Sato were relied upon to show that changing the status of the data, was well-known at the time of Appellants' invention. Thus, we agree with the Examiner that the combination of Steinberg and Sato collectively would have taught or suggested the limitations of claim 26.

As to Appellants' arguments regarding impermissible hindsight (Br. 67.) we do not find this argument persuasive for the same reason discussed *supra*. Initially, we observe that the Examiner did provide a rationale to combine Steinberg and Sato. (Ans. 28.) The proffered motivation was not disputed by Appellants. (*See* Br. 68.) Given the breadth of Appellants' claims, we are not persuaded that combining the respective familiar elements of the cited references in the manner proffered by the Examiner was "uniquely challenging or difficult for one of ordinary skill in the art" (*see Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (*citing* *KSR*, 550 U.S. at 418)). Therefore, we find the Examiner's proffered combination of familiar prior art elements according to their established functions would have conveyed a reasonable expectation of success to a person of ordinary skill having common sense at the time of the invention.

CONCLUSIONS OF LAW

Appellants have not shown that the Examiner erred in rejecting claims 1-12, 14, 16-25, 27, 28, 31-44, and 46-49 under 35 U.S.C. § 102(e).

Appellants have not shown that the Examiner erred in rejecting claims 13, 15, 26, 29, and 30 under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner's rejection of claims 1-12, 14, 16-25, 27, 28, 31-44, and 46-49 under 35 U.S.C. § 102(e).

We affirm the Examiner's rejections of claims 13, 15, 26, 29, and 30 under 35 U.S.C. § 103(a).

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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