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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RODERICK A. HYDE, MURIEL Y. ISHIKAWA,
ERIC C. LEUTHARDT, ROYCE A. LEVIEN, ROBERT W. LORD,
MARK A. MALAMUD, ELIZABETH A. SWEENEY,
LOWELL L. WOOD, JR., and VICTORIA Y.H. WOOD

Appeal 2012-011899
Application 12/290,227
Technology Center 2100

Before ROBERT E. NAPPI, JASON V. MORGAN, and
JAMES W. DEJMEK, *Administrative Patent Judges*.

DEJMEK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 1, 32–38, 40–41, 43–50, 53–59, 62–64, and 66–70. Claims 2–31, 39, 42, 51–52, 60–61, and 65 have been canceled. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We AFFIRM.

STATEMENT OF THE CASE

Introduction

Appellants' invention is directed to "methods and systems for combining a bioactive agent with an artificial sensory experience." Spec. 10. As set forth in the Specification, an artificial sensory experience may be a virtual experience, an on-line game, or an educational experience or tutorial. Spec. 49–50. In one embodiment, presenting an indication of a bioactive agent at least partly based on an indication of a user's compliance with the artificial sensory experience is disclosed. Spec. 10.

Representative claims 1, 64, and 67 are illustrative of the subject matter on appeal and are reproduced below with the disputed limitation emphasized in *italics*:

1. A computer-implemented method, comprising:
accepting an indication of an individual's compliance with an artificial sensory experience; and
presenting an indication of a bioactive agent at least partly based on the indication of the individual's compliance with the artificial sensory experience.

64. A computer program product comprising:
a non-transitory computer-readable medium bearing one or more instructions for accepting an indication of an

individual's compliance with an artificial sensory experience;
and

one or more instructions for presenting an indication of a bioactive agent at least partly based on the indication of the individual's compliance with the artificial sensory experience.

67. The computer program product of claim 64, wherein the computer-readable medium includes *a communications medium*.

References

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Brown	US 6,186,145 B1	Feb. 13, 2001
Glauser et al. (hereinafter "Glauser")	US 2009/0171697 A1	July 2, 2009 (PCT filed Nov. 1, 2006)

The Examiner's Rejections

1. Claim 67 stands rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. Ans. 6.
2. Claim 67 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Ans. 6–7.
3. Claims 1, 32–38, 40–41, 43–50, 53–59, 63, 64, and 66–70 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Brown. Ans. 7–15.
4. Claim 62 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown and Glauser. Ans. 15–16.

Issues on Appeal

1. Did the Examiner set forth a *prima facie* case of unpatentability under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a)?
2. Did the Examiner err in finding claim 67 is not directed to patentable subject matter and, further, is indefinite?

ANALYSIS¹

Rejections under 35 U.S.C. § 102(b)

Except for claim 62, all of the claims on appeal stand rejected under 35 U.S.C. §102(b) as anticipated by Brown. Ans. 7–15. Appellants contend the Examiner has not established a *prima facie* case of unpatentability for any of the rejected claims. App. Br. 31–47; Reply Br. 3–7. For the reasons set forth below, we are unpersuaded by Appellants’ argument.

As the Board has stated, “[t]he Examiner has the initial burden to set forth the basis for any rejection so as to put the patent applicant on notice of the reasons why the applicant is not entitled to a patent on the claim scope that he seeks — the so-called ‘*prima facie* case.’” *Ex Parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010)(precedential). Once the Examiner has set forth the *prima facie* case, the burden then shifts to the applicant to rebut the Examiner’s case. *Id.* See also *In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (“the PTO carries its procedural burden of establishing a *prima facie* case when its rejection satisfies 35 U.S.C. § 132”). Contrary to Appellants’ position, the threshold for establishing a *prima facie* case was not altered by

¹ Throughout this opinion we refer to the Appeal Brief (“App. Br.”) dated May 9, 2012, Reply Brief (“Reply Br.”) dated August 21, 2012, Supplemental Reply Brief (“Supp. Reply Br.”) dated August 21, 2012, and the Examiner’s Answer (“Ans.”) mailed on June 21, 2012.

the Federal Circuit in *Jung*. The Patent and Trademark Office (“PTO”) satisfies its initial burden of production by “adequately explain[ing] the shortcomings it perceives so that the applicant is properly notified and able to respond.” *Hyatt v. Dudas*, 492 F.3d 1365, 1370 (Fed. Cir. 2007).

In the Final Rejection, the Examiner identified portions of the Brown reference that disclose the disputed claim limitations. Final Rej. 4–12. Further, the Examiner provided a detailed explanation of how the identified sections of Brown disclose the claim limitations. Final Rej. 16–18. Despite the explanation provided by the Examiner, Appellants argue the Examiner failed to explain how the portions of Brown “map” to the disputed claim limitations. App. Br. 31–33. In response, the Examiner again provides a detailed explanation supporting the finding that Brown discloses each of the claim limitations. Ans. 20–22. We agree with the Examiner’s findings and conclusions and adopt them as our own without repeating them herein.

In their Appeal Brief, Appellants repeatedly state that Brown “fails to recite” or “does not recite” the text of the claim language. *See, e.g.*, App. Br. 31, 33–36. Appellants conclude the absence of identical claim language is antithetical to establishing a *prima facie* case of anticipation. *See* App. Br. 36–37. However, it is well established that for anticipation under 35 U.S.C. § 102, “the reference need not satisfy an *ipsissimis verbis* test.” *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009), citing *In re Bond*, 910 F.2d 831, 832–33 (Fed. Cir. 1990). *In re Schaumann*, 572 F.2d 312, 317 (CCPA 1978) (“[A]lthough appellants would have us hold that Hildebrandt fails as an anticipation because it does not contain a description of the subject matter of the appealed claims, *ipsissimis verbis*, we cannot countenance a result which so obviously exhorts [sic] form over substance.”). On this point we

conclude Appellants present no substantive arguments regarding the claims other than merely restating the limitations called for in the claims and asserting that the Examiner is wrong solely because the prior art does not discuss its invention in the same terms that are used in the claims. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2012) (“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) (“we hold that the Board reasonably interpreted 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.”).

Further, we are not persuaded by Appellants’ arguments regarding hindsight, personal knowledge, or the lack of official notice. *See* App. Br. 37–38. These issues are not germane to anticipation. Moreover, as discussed above, Appellants do not persuasively show that any recitations are missing in *Brown*, and thus, Appellants do not provide persuasive arguments or evidence showing that the Examiner improperly relied on personal knowledge or other extrinsic evidence in the context of making the rejection under 35 U.S.C. § 102(b).

In their Reply Brief, Appellants state “[s]ince the resolution of this question [whether the Examiner has established a *prima facie* case of unpatentability] controls whether or not Appellant must produce evidence in rebuttal of the *prima facie* case, Appellant asserts that it would be premature/improper for the Board to decide this appeal on the issue of the Patent Office fact finding.” Reply Br. 7–8. We disagree. It is well-settled that the Board is free to affirm an examiner’s rejection so long as “appellants have had a

fair opportunity to react to the thrust of the rejection.” *In re Kronig*, 539 F.2d 1300, 1302–03 (CCPA 1976). In the instant case, Appellants concede they have responded to the thrust of the Examiner’s rejection by “carr[ying] the burden of demonstrating that the claims are patentable over the technical material cited by the Examiner.” Supp. Reply Br. 4.

Accordingly, we affirm the Examiner’s 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Brown. Appellants do not provide arguments of separate patentability for independent claims 32, 63, 64, and 68 or claims 33–38, 40–41, 43–46, 48, 50, 53–59, 65–67, or 69–70, which depend directly or indirectly from claims 32, 63, 64 and 68. App. Br. 38. For similar reasons, discussed *supra*, we sustain the Examiner’s rejections of claims 32–38, 40–41, 43–46, 48, 50, 53–59, and 63–70.

Regarding claim 47, Appellants assert the identified disclosure of Brown “takes place in the context of *a user seeing a virtual reality demonstration, * not *means* for presenting an identification of a prescribed bioactive agent.” App. Br. 40. As identified by Appellants (App. Br. 10) and as set forth in the Specification, the “means for presenting an identification of a prescribed bioactive agent” are provided by block 4102 of Fig. 41. *See Spec. 76* (lines 6–7) (“Operation 4102 illustrates presenting an identification of a prescribed bioactive agent.”) and Fig. 41. Further, “prescription bioactive agent presenter module 3430” is set forth in Figure 35. “In some instances, prescription bioactive agent presenter module 3430 may include a computer processor.” *Spec. 76*. We agree with the Examiner’s finding that the computer unit of Brown serves as a means through which the prescribed bioactive agent is identified to the user. Ans. 24. Accordingly, we sustain the Examiner’s rejection of claim 47.

Appellants present a similar argument regarding claim 49 contending Brown does not disclose a means for indicating at least one side effect of the bioactive agent. App. Br. 42. Side effect indicator module 3434 may indicate at least one side effect of the bioactive agent and in some instances, may include a computer processor. Spec. 76–77. Again, we agree with the Examiner’s finding that Brown teaches a computer system in which side effects of medications are monitored and indicated and that such a system is a “means for indicating at least one side effect of the bioactive agent.” Ans. 25. Accordingly, we sustain the Examiner’s rejection of claim 49.

Rejection under 35 U.S.C. § 103(a)

Claim 62 stands rejected under 35 U.S.C. § 103(c) as being unpatentable over Brown and Glauser. Ans. 15–16. As with the § 102 rejections, Appellants make similar arguments that the references do not recite the claim language. App. Br. 43–47. For similar reasons as those discussed above, we do not find Appellants’ arguments persuasive of error in the Examiner’s findings.

Additionally, Appellants argue the identified disclosures of Brown and Glauser “take[] place in the context of *medication selection and dosing, * not *means for accepting* a self report by an individual of prescription compliance. App. Br. 46. In response, the Examiner points out that Brown is relied upon to teach a “means for accepting a self report by an individual of compliance with a prescription for a virtual world configured to reduce depression.” Ans. 27. The Examiner finds Brown teaches a computer system with a virtual reality simulation. *Id.* (citing Brown col. 21, ll. 47–49). The Examiner further finds Brown teaches a patient score based

on the individual's participation in the virtual reality scenario. Ans. 27 (citing Brown col. 21, ll. 45–58). The Examiner concludes Brown teaches “a clinician prescribing a virtual reality simulation configured to treat depression to a patient through a computer, and accepting through the computer a report in the form of input from the patient.” Ans. 27. We agree with and adopt the Examiner's findings and conclusions.

Accordingly, for the reasons discussed *supra*, we sustain the Examiner's rejection of claim 62 under 35 U.S.C. §103(a).

Rejection under 35 U.S.C. § 112, second paragraph

Claim 67 is further rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Ans. 7. In claim 67, the “non-transitory computer-readable medium” of claim 64 further includes a “communications medium.” Claim 67. Appellants argue the communications medium is defined in the Specification as including a fiber optic cable, a waveguide, a wired communications link and/or a wireless communication link. App. Br. 17 (citing Spec. 89). Appellants conclude, therefore, claim 67 is amendable to construction and is not drawn solely to a form of energy. App. Br. 17. The Examiner states “at least a ‘wireless communication link’ is drawn solely to a form of energy.” Ans. 19. The Examiner further notes the form of energy the claimed instructions are contained in is transitory in nature. *Id.* Therefore, the claim is directed to a “non-transitory” “transitory medium.” We agree with the Examiner and sustain the rejection of claim 67 under 35 U.S.C. § 112, second paragraph.

Rejection under 35 U.S.C. § 101

Claim 67 is further rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. Ans. 6. Appellants argue that due to its dependency on claim 64, claim 67 is similarly directed to statutory subject matter. App. Br. 15–16. In particular, Appellants contend claim 64 expressly recites that the “computer-readable medium” is “non-transitory” and that, as a dependent claim, claim 67 also includes this limitation. *Id.* However, as discussed *supra*, the communications media includes transitory signals in the form of energy. We agree with the Examiner that transitory signals are not patent eligible. Ans. 18. Accordingly, we sustain the rejection of claim 67 under 35 U.S.C. § 101.

DECISION

The rejections of claims 1, 32–38, 40–41, 43–50, 53–59, 62–64, and 66–70 are 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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

pgc