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7327 SW Barnes Road #521  
Portland, OR 97225

EXAMINER
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RASHID, HARUNUR

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docket.clerk@renaissanceiplaw.com  
PhillipsPatentLawyer@gmail.com

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* RICHARD R. REISMAN

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Appeal 2014-000548  
Application 12/893,246  
Technology Center 2400

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Before MAHSHID D. SAADAT, CATHERINE SHIANG, and  
NORMAN H. BEAMER, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant has requested rehearing of the decision entered June 27, 2016 (“Dec.”), which affirmed the Examiner’s decision to reject claims 13–15 under 35 U.S.C. § 103. We have considered Appellant’s arguments, and such arguments have not persuaded us that we misapprehended or overlooked any matters in our decision. Therefore, Appellant’s Request for Rehearing (“Req.”) is denied.

## DISCUSSION

A request for rehearing “must state with particularity the points [of law or fact] believed to have been misapprehended or overlooked by the Board,” and must comply with 37 C.F.R. § 41.52(a)(1) (2012).

### I

Appellant argues that “this Board Decision found that *Kaplan teaches that limitation* [“a user station not previously identified to the remote computer system”]. Specifically, the Board Decision cited to page 9 of the Examiner’s Answer.” Req. 9–10 (emphasis added) (citation omitted). In particular, Appellant argues: 1) “The Board Decision Misapprehended Kaplan, Which Does Not Teach or Suggest the ‘User Station Not Previously Identified’ Limitation”; 2) “Kaplan does not teach that the user has been previously identified”; and 3) “Kaplan does not teach that the user station (kiosk) has been previously identified” (Req. 10, 14 (boldface omitted)).<sup>1</sup> See Req. 10–15.

*First*, Appellant’s statements about our decision are incorrect.<sup>2</sup> To the contrary, our decision *explicitly states* that the disputed claim limitation “a user station not previously identified to the remote computer system” is taught or suggested by the combined teachings of Johnson and Kaplan—not merely the teachings of Kaplan. See Dec. 4–5.

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<sup>1</sup> It is unclear why Appellant argues “Kaplan does not teach that the user has been previously identified” (Req. 10); and “Kaplan does not teach that the user station (kiosk) has been previously identified” (Req. 14), as such arguments support our—not Appellant’s—position.

<sup>2</sup> Appellant’s statements also contradict the Reply Brief, which acknowledges that “[t]he Examiner relies on Kaplan as a secondary reference” for teaching the disputed claim limitation. Reply Br. 6.

Specifically, our decision explains that the Examiner finds—and Appellant does not dispute—Johnson teaches the claimed “user station” (mapped to Johnson’s user machine) and the claimed “remote system” (mapped to Johnson’s server system). Dec. 4.

Further, Kaplan discloses:

To use the invention, the subscriber takes any music selection in the store display and approaches the kiosk station 10. The subscriber is provided with an access card, similar to a credit card, which is used to activate the kiosk station 10. . . .

*Each customer can complete a brief membership application which asks for basis demographic information, general music listening preferences and buying habits and an access card will then be generated for that subscriber. Each subscriber will have a barcode on their access card which will immediately identify them when beginning a session on the kiosk station 10.*

Kaplan 5:22–36 (emphasis added).

Therefore, our decision explains that the Examiner correctly finds Kaplan teaches or suggests *before* the user (or customer) completes the membership application, he is “not previously identified to the . . . system.” Dec. 4. In fact, Appellant *admits* in Kaplan, it is a “fact that a customer without an access card might be considered to be ‘not previously identified.’” Req. 11.

Our decision further explains because Appellant does not challenge the propriety of combining the teachings of Johnson and Kaplan, the Examiner correctly finds the combination teaches or suggests “a user station [mapped to Johnson’s user machine] not previously identified to [taught or suggested by Kaplan’s teachings] the remote system [mapped to Johnson’s server system].” Dec. 4–5.

*Second*, Kaplan discusses different time periods: (1) *before* the user (customer) completes the membership application; and (2) *after* the user (customer) completes the membership application, and then an access card will be generated. *See* Kaplan 5:22–36. As discussed above, the Examiner cites Kaplan’s Time 1 (*before* completing the membership application) for teaching the claimed “not previously identified.” In contrast, Appellant’s following arguments are about Time 2 (*after* completing the membership application), and fail to show the Examiner’s finding based on Time 1 is incorrect:

Kaplan also envisions that users of the kiosk are already known. In particular Kaplan states, “*After scanning their user/subscriber card (free to the user, available at the store counter) across the UPC bar code reader[,]*” the user may operate the kiosk. (Kaplan 3:16–18.) That is, before using the kiosk, the user must obtain a user/subscriber card. Thus, the user is identified by the user/subscriber card before operations occur. Accordingly, Kaplan reinforces the notion of Johnson described above that users in Johnson are already identified.

App. Br. 16–17 (emphasis added).

In the Reply Brief (pages 6–7), Appellant again argues about Time 2 (*after* completing the brief membership application)—not Time 1 cited by the Examiner (*before* completing the brief membership application)—and fails to persuasively argue the Examiner’s finding based on Time 1 is incorrect:

The Examiner relies on Kaplan as a secondary reference. The Applicant pointed out in the Appeal Brief that Kaplan also assumes that a user has been previously identified [App. Br. 16–17] . . . . The Examiner responds by repeating the essence of the rejection and contending that the user must have been unknown to the kiosk computer *at the time when the user completed a membership application to obtain the*

*user/subscriber card* and thus concluding that “the examiner interprets registration as new user to the remote server or [sic] ‘the User Has Been Previously Identified to the Remote Computer System’.” (See Examiner’s Answer § 2.6 at 9.) In other words, the Examiner seems to contend that if one backs up far enough in time, at some point the user was not “previously identified.” Such reasoning is specious for several reasons. Under that logic, every user and user station – and everything at all – was not previously identified at some point in time. Under that logic, even a fully administered, closed enterprise network in which all of the computers are known a priori would at some point have not previously identified its users and user stations.

Reply Br. 6–7 (emphasis added) (original emphasis omitted).

Contrary to Appellant’s assertion, the Examiner did not “contend that if one backs up far enough in time, *at some point* the user was not ‘previously identified’” (Reply Br. 6–7 (emphasis added)). As discussed above, the Examiner cites Kaplan’s explicit teachings, and correctly finds *before* completing the brief membership application, the user (customer) is “not previously identified to the . . . system.” Ans. 9 (citing Kaplan 5:30–35). Appellant does not critique the specific Kaplan portion cited by the Examiner, and his general assertion that “[u]nder that logic, every user and user station – and everything at all – was not previously identified at some point in time . . . even a fully administered, closed enterprise network in which all of the computers are known *a priori* would at some point have not previously identified its users and user stations” (Reply Br. 7) does not show why the Examiner’s findings—based on Kaplan’s explicit teachings regarding *before* the user (customer) completes the brief membership application—are incorrect.

Further, Appellant’s citing a claim construction issue in *In re Suitco Surface Inc.*, 603 F.3d 1255 (Fed. Cir. 2010) (Reply Br. 7) is not on point. In *Suitco*, the court held “that the phrase ‘material for finishing the top surface of the floor’ refers to a clear, uniform layer on the top surface of a floor that is the *final* treatment or coating of a surface. It is not any intermediate, temporary, or transitional layer.” *Suitco*, 603 F.3d at 1260–61. Unlike the claim construction issue in *Suitco*, the claim construction is clear here: the Examiner correctly finds Kaplan teaches or suggests the claimed “not previously identified,” and Appellant *admits* it is a “fact that a customer without an access card might be considered to be ‘not previously identified’” (Req. 11).

Therefore, our decision explains that Appellant’s contentions are unpersuasive of Examiner error, because Appellant failed to persuasively address the Examiner’s specific findings and failed to critique the Kaplan portion cited by the Examiner. *See* Dec. 4.

*Finally*, because our decision and the Examiner’s findings rely on the combined teachings of Johnson and Kaplan to teach the disputed claim limitation, Appellant has not shown the inquiry of whether *Kaplan alone* teaches “the user station (kiosk) has been previously identified” (Req. 14)—regardless of the answer—is sufficient for showing error.

## II

Appellant argues: “The Board Decision Overlooked the Applicant’s Arguments That Kaplan Does Not Teach the ‘User Station Not Previously Identified’ Limitation.” Req. 15 (boldface omitted). In particular, Appellant contends: “The Board Decision overlooked the Applicant’s arguments at

pages 16–17 of the Appeal Brief”; and “The Board Decision improperly disregarded the Applicant’s arguments at pages 6–7 of the Reply Brief” (Req. 15–16 (boldface omitted)). Appellant argues the Board unlawfully disregarded Appellant’s arguments about Kaplan in the Reply Brief. *See* Req. 18–20.<sup>3</sup>

We disagree. As discussed above, our decision *explicitly states* that the disputed claim limitation “a user station not previously identified to the remote computer system” is taught or suggested by the combined teachings of Johnson and Kaplan—not merely the teachings of Kaplan. Dec. 4–5. Therefore, Appellant’s argument that *Kaplan alone* does not teach the disputed claim limitation is insufficient for showing error.

Further, as discussed above, this panel did not overlook or disregard Appellant’s arguments about Kaplan (on pages 16–17 of the Appeal Brief and pages 6–7 of the Reply Brief): we explicitly acknowledged those arguments, which are unpersuasive for showing error because Appellant failed to persuasively address the Examiner’s specific findings, and failed to critique the Kaplan portion cited by the Examiner. *See* Dec. 4. We want to make it abundantly clear that our footnote “[t]o the extent Appellant

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<sup>3</sup> Appellant represents “in Application No. 09/553,337, Appeal No. 2011-004918, in which the United States District Court for the Eastern District of Virginia remanded the matter to the Office for the Board to enter an order reversing the Board’s prior decision and remanding the case to the Examiner. *Intellectual Ventures I LLC v. Focarino*, No. 1:13-cv-534 (AJT/TCB) (E.D. Va. Filed Jan. 13, 2014) (remand order).” Req. 19 n.5. But the district court order merely states: “Pursuant to a settlement between the parties, it is hereby ORDERED that the instant civil action is REMANDED to the United States Patent & Trademark Office for further administrative proceedings.” Agreed Order of Remand dated January 13, 2014.

advances new arguments in the Reply Brief without showing good cause, Appellant has waived such arguments. *See* 37 C.F.R. § 41.41(b)(2)” (Dec. 4) is a general statement applicable to all new arguments in the Reply Brief, and Appellant’s arguments about Kaplan on pages 6–7 of the Reply Brief do not constitute such waived new arguments. While Appellant had the option to petition the Director to address the Examiner’s new findings in the Answer, Appellant chose to file a reply brief. As a result, we considered the merits of the arguments in our decision because Appellant had a full and fair opportunity to respond to the Examiner’s analysis on the merits.<sup>4</sup> *See In re Stepan Co.*, 660 F.3d 1341, 1343–44 (Fed. Cir. 2011).

### III

“Arguments not raised, and Evidence not previously relied upon . . . are not permitted in the request for rehearing except as permitted . . . .” 37 C.F.R. § 41.52(a)(1) (2012). Therefore, to the extent Appellant advances new arguments without showing good cause, Appellant has waived such new arguments.

For example, Appellant argues:

A customer who has not yet obtained an access card - the alleged not previously identified user – cannot use the kiosk and thus cannot perform step [1] of the patent claims. As a reminder, step [1] concerns computer actions. Specifically, step

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<sup>4</sup> We were aware of the Examiner’s new findings in the Answer, as we cited the Examiner’s Answer instead of the Final Action; and we stated “Appellant fails to squarely respond to the Examiner’s . . . findings [from page 9 of the Answer], and fails to critique the Kaplan portion cited by the Examiner” (Dec. 4), which does not indicate Appellant’s arguments in the Reply Brief were waived. Dec. 4.

[1] says that a “remote computer system” “receiv[es]” “from the user station” “over a communications network” “first information.” That is when the user station must be “not previously identified to the remote computer system.” . . . [T]he relevant time period for step [1] and its “user station not previously identified” limitation is when Kaplan’s kiosk 10 (the alleged “user station” in Kaplan) is sending information to a “remote computer system” (presumably the UNIX mini 70 or executive information system 90) – not before the customer has obtained an access card at the store counter.

Req. 11.

Appellant has waived the above new argument, as Appellant has not shown any good cause for the belated presentation, and raising the belated argument at such a late stage is unfair. We further note the belated argument is unpersuasive because it ignores the Examiner’s specific findings: the Examiner finds—and Appellant does not dispute—Johnson teaches “receiving at a remote computer system over a communications network first information.” *See* Final Act. 6. Therefore, the Examiner does not rely on Kaplan to teach that claim limitation separately. As noted in our decision (Dec. 4–5), in the Appeal Brief and Reply Brief, Appellant does not challenge the propriety of combining the teachings of Johnson and Kaplan for teaching the disputed claim limitation. In any event, the skilled artisan would “be able to fit the teachings of multiple patents together like pieces of a puzzle” since the skilled artisan is “a person of ordinary creativity, not an automaton.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 420–21 (2007). Appellant has not presented persuasive evidence that the resulting arrangements would have been “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior

art.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418–19).

In another example, Appellant argues:

Perhaps the Examiner and the Board implicitly adopted a strained interpretation of “not previously identified” to make Kaplan’s teachings relevant to the claims. However, such an interpretation would surely be unreasonable and not at all anchored to the actual language of step [1]. If a user could be “not previously identified” if he/she were unknown at any time in the past, no matter how far removed from the computer actions recited in step [1], then the phrase “not previously identified” would be meaningless. . . . A new, unknown user must provide demographic information on a membership application. Presumably someone enters that information in a behind-the-counter computer in a non-user, administrator mode to add the customer as a known, authorized user, at which point the customer gets an access card. This type of process, which was prevalent in closed-enterprise networks at the time of the invention, in no way makes the user “not previously identified” when placed in the context of near-by claim language, and, indeed, in no way resembles the claim language.

Perhaps the Examiner and the Board assumed that the membership application was a computerized application that the customer completes at the kiosk. Absolutely nothing in Kaplan says or suggest that. The Office would bear the burden to show that but has not done so – and cannot do so. *See In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002) (“During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. If the PTO fails to meet this burden, then the applicant is entitled to the patent.” (citations omitted)). The Examiner has not even attempted to present that strained interpretation of Kaplan. Such a reading of Kaplan would be contrary to the express text of Kaplan, which says that the kiosk will not work until the customer scans the barcode on his/her access card. *See Kaplan* 3:16–21, 5:24–26.

Indeed, there is absolutely no disclosure in Kaplan of the kiosk having any capability to dispense an access card, and the Office “may not resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *In re Warner*, 379 F.2d 1011, 1017 (C.C.P.A. 1967). Indeed, a machine dispensing barcode-bearing cards would have been far-fetched in 1992 when the Kaplan application was filed. The only reasonable assumption is that a customer fills out a paper application to obtain an access card and gives the paper application to a behind-the-counter store employee, who, perhaps after checking the paper application and entering its information, gives the customer an access card.

Req. 12–14.

Appellant has waived the above new argument, as Appellant has not shown any good cause for the belated presentation, and raising the belated argument at such a late stage is unfair. We further note the belated argument is unpersuasive because it includes assertions (such as how a membership was processed in 1992) that are speculative and unsubstantiated by evidence. In any event, Appellant has not persuasively explained how Appellant’s speculation about membership processing in 1992 renders the Examiner’s findings incorrect. As discussed above, and admitted by Appellant (Req. 11), before the user completes the membership application, Kaplan teaches a “not previously identified” user.

In a third example, Appellant argues:

[T]he claims in this application make clear that it is “the remote computer system” that has “not previously identified” the user station. The Examiner makes no attempt to identify what this “remote computer system” is in Kaplan. This is another clear shortcoming in the Examiner’s and the Board’s misplaced reliance on Kaplan.

Req. 15.

Appellant has waived the above new argument, as Appellant has not shown any good cause for the belated presentation, and raising the belated argument at such a late stage is unfair. We further note the belated argument is unpersuasive because, as discussed above, the Examiner finds—and Appellant does not dispute—Johnson teaches the claimed “remote computer system.” *See* Dec. 4. Therefore, Kaplan does not need to separately teach that claim element.

#### CONCLUSION

For the reasons stated above, Appellant has not persuaded us that we misapprehended or overlooked any issue of fact or law in our decision.

We have *granted* Appellant’s Request for Rehearing to the extent that we have reconsidered our decision dated June 27, 2016. Appellant has not shown that we misapprehended or overlooked any issue of law or fact in reaching that decision. Accordingly, we deny Appellant’s Request for Rehearing.

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).

DENIED