



# 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.
13/117,065	05/26/2011	Geetika T. Lakshmanan	YOR920100481US2 (014)	6816
70672	7590	06/01/2016	EXAMINER	
CRGO LAW 7900 Glades Road SUITE 520 BOCA RATON, FL 33434			DONABED, NINOS	
			ART UNIT	PAPER NUMBER
			2444	
			NOTIFICATION DATE	DELIVERY MODE
			06/01/2016	ELECTRONIC

**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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@crgolaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* GEETIKA T. LAKSHMANAN and MARTIN A. OBERHOFER

---

Appeal 2014-006715  
Application 13/117,065  
Technology Center 2400

---

Before ST. JOHN COURTENAY III, DAVID M. KOHUT, and  
KAMRAN JIVANI, *Administrative Patent Judges*.

COURTENAY, *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, mailed August 20, 2013, of claims 1–18. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

*Invention*

The claimed invention on appeal is directed to: “the field of e-meeting management and more particularly to social network integration with an e-meeting.” (Spec. ¶ 2.)

*Representative Claim*

1. A method for automated social networking for e-meetings, the method comprising:

monitoring content provided to an e-meeting managed by an e-meeting server executing in memory of a host computer;

detecting a name in the monitored content;

[L1] *comparing the detected name to names in a contact list for a social networking system executing externally to the e-meeting; and,*

triggering generation of a social networking introduction for the name to different participants to the e-meeting in response to matching the detected name to a name in the contact list.

(Emphasis added regarding the contested limitation, labeled as “L1”.)

*Rejections*

- A. Claims 13–18 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
- B. Claims 1, 3, 4, 7, 9, 10, 13, 15, and 16 are rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Appleman (US 7,979,802 B1; issued July 12, 2011) and Deeds (US 2006/0179114 A1; published August 10, 2006).
- C. Claims 2, 8, and 14 are rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Appleman, Deeds and Korneliussen (US 2007/0285505 A1; issued December 13, 2007).
- D. Claims 5, 6, 11, 12, 17, and 18 are rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and

suggestions of Appleman, Deeds and Uberti (WO 2004/061612 A2; published July 22, 2004).

### *Grouping of Claims*

Based on Appellants' arguments, we decide the appeal of all claims rejected under rejection B on the basis of representative claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv). We address rejection A of claims 13–18, rejection C of claims 2, 8, and 14, and rejection D of claims 5, 6, 11, 12, 17, and 18, separately, *infra*.

### ANALYSIS

We have considered Appellants' arguments and any evidence presented. We disagree with Appellants' arguments, and we adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons and rebuttals set forth in the Answer (2–7) in response to Appellants' arguments, to the extent consistent with the analysis below. However, we highlight and address specific findings and arguments for emphasis in our analysis below.

#### *Rejection A of Claims 13–18 under § 101*

**Issue:** Under § 101, did the Examiner err by concluding that claims 13–18 are directed to non-statutory subject matter?

Appellants attempt to distinguish claim 13 on appeal from the claims addressed in various Board decisions. (App. Br. 7). Appellants contend claim 13 is directed to statutory subject matter under 35 U.S.C. § 101:

[W]ith the opinions of Ex parte Mewherter, Ex parte Raverdy, Ex parte Hu, Ex parte Dureau and Ex parte Bash in mind, independent claim 15 recites a "a computer readable storage medium having computer readable program code embodied therewith", not just a "computer readable medium". Further, the specification distinguishes a "storage medium" from a mere "signal medium". Accordingly, those skilled in the art, as well as the Honorable Board in the decisions rendered within Ex parte Mewherter, Ex parte Raverdy, Ex parte Hu, Ex parte Dureau and Ex parte Bash, recognize there is a difference between a propagation medium (e.g., light, electricity, EMF, etc.) and a storage medium (e.g., memory, hard disk, CD-ROM, etc.).

(App. Br. 8):

The Examiner disagrees (Ans. 3):

There is no explicit definition that restricts "computer readable storage medium" to not include a signal.

[The] Examiner's broadest readable interpretation would therefore include non-statutory subject matter and specifically includes a signal. Since no definition is provided for the "computer readable storage medium", it could clearly include a signal per se . . . ."

We find Appellants' Specification does not exclude signals from the scope of the recited "computer readable storage medium" by a limiting

definition or express disclaimer.<sup>1,2</sup> Instead, Appellants' Specification broadly describes, in pertinent part (¶ 20): "aspects of the present invention may take the form of a *computer program product embodied in one or more computer readable medium(s)* having computer readable program code embodied thereon." *See also* Spec. (¶ 21): "A computer readable storage medium may be, for example, *but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, or device, or any suitable combination of the foregoing.*" *See also* Spec. (¶ 22): "A computer readable signal medium *may include a propagated data signal* with computer readable program code embodied therein, for

---

<sup>1</sup> We note the scope of the claims on appeal, at a minimum, at least covers the corresponding supporting embodiment(s) described in the Specification. We emphasize, however, that under a broad but reasonable interpretation (or the more narrow construction applied by the federal courts), and absent a limiting definition or express disclaimer, the scope of the claims is not limited to the preferred embodiments described in the Specification. Our reviewing court has repeatedly "cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification." *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346–47 (Fed. Cir. 2015) (*quoting Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1328 (Fed. Cir. 2002)).

<sup>2</sup> The Specification may show that "the patentee has disclaimed subject matter or has otherwise limited the scope of the claims." *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1343 (Fed. Cir. 2001); *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1344 (Fed. Cir. 2001) (relying on a disclaimer in the written description of subject matter that could have otherwise fallen within the scope of the claim language).

example, in *baseband or as part of a carrier wave.*” (Emphasis added).

Given the non-limiting, exemplary support described in the Specification (*id.*), we conclude the intended scope of the claim term “computer program product” broadly covers both statutory and non-statutory computer readable mediums, under a broad but reasonable interpretation. Our reviewing court guides:

The four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.

*In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007).

Notwithstanding Appellants’ arguments (App. Br. 4–8), we are bound by the holding of *Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013) (precedential). The expanded PTAB merits panel in *Mewherter* held the scope of a “computer readable storage medium” encompassed transitory media such as signals or carrier waves, where, as here, the Specification does not expressly disclaim transitory forms.<sup>3</sup> Therefore, we find the holding of *Mewherter* is directly on point and controlling regarding the “computer program product” that includes the “computer readable storage medium” recited in Appellants’ independent claim 13.

Accordingly, we apply the holding of *Mewherter* to Appellants’ recited “computer program product” that includes a “computer readable storage medium” (claim 13), and we sustain the Examiner’s rejection of claims 13–18 under § 101, as being directed to non-statutory subject matter.

---

<sup>3</sup> See n.2. *supra*.

*Rejection B of Claims 1, 3, 4, 7, 9, 10, 13, 15 and 16 under § 103*

*Contentions*

Appellants contend Deeds does not teach contested claim 1 limitation L1: “*comparing the detected name to names in a contact list for a social networking system executing externally to the e-meeting; . . .*” See App. Br. 12:

[C]laim 1 expressly recites "comparing the detected name to names in a contact list for a social networking system executing externally to the e-meeting" --not merely comparing the detected name to names in a contact list of a particular user of a social networking system. In other words, "a contact list for a social networking system" is not a contact list of one user. Rather "a contact list for a social networking system" includes all users of the social networking system. Additionally, it is plain that a contact list is not a "system"—it is a list, a set of names. A social networking system is plainly understood to mean a system in which users share social information with one another and develop individual networks of other users.

Appellants additionally refer to extrinsic U.S. Patent No. 8,601,596 B2, to Wu et al., for a definition of a “social networking system.” (App. Br. 12).

The Examiner disagrees, and refers to Deeds at paragraphs 47 and 69 (Ans. 6–7):

[The] Examiner points to paragraph[] [0047] of Deeds which teaches "After all communication identifiers within the received email message have been identified, the next step typically would be to compare each of these communication identifiers to the user's contact list to identify matches, as shown in block 104 of FIG. 3. A user would typically have a contact list stored in the memory of the user's communication terminal or **in a remote memory, such as in a server accessible by the terminal.** A contact list typically comprises

a number of individual contacts, with each individual contact typically comprising specific contact information for one person or other entity (e.g., corporate entity)."

Furthermore, paragraphs [0069] which teaches "For example, the received email may have contained a telephone number for a particular person. If that particular person is in the user's contact list, and that person's telephone number and email address are in the contact, then the contact will be displayed in the generated list. If that particular person is in the user's contact list, and that person's telephone number in the contact but that person's email address is not in the contact, then the contact will typically not be displayed in the generated list because the terminal will not be able to initiate a meeting request by email to that person. The generated list will typically also comprise any email address that were extracted from the received email message (either from a header or from the body of the message) but did not match any email addresses in any of the contacts. Even though such an email address does not match any of the contacts, the processor of the terminal can still initiate a meeting request by email to such an email address if selected by the user."

This section clearly teaches that a "contact list" is a social networking list because a contact list is a collection of screen names of people in a network with some relationship to one another which would be a social network system. Furthermore the claim limitation reads "comparing the detected name to names in a contact list **FOR** a social networking system" and clearly a contact list of Deeds is **FOR** an instant messaging social networking system.

**Issue:** Under § 103, did the Examiner err by finding the cited combination of Appleman and Deeds would have taught or suggested contested limitation L1: "*comparing the detected name to names in a contact list for a social networking system executing externally to the e-meeting,*" within the meaning of representative claim 1? (Emphasis added.)

This appeal turns on claim construction. Appellants urge “A social networking system is plainly understood to mean a system in which users share social information with one another and develop individual networks of other users.” (App. Br. 12). Appellants proffer as extrinsic evidence, U.S. Patent No. 8,601,596 B2, to Wu et al.

During examination, claims are to be given their broadest reasonable interpretation consistent with the specification, and the language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Amer. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted).

Here, Appellants support their claim interpretation by asking the panel to construe the claim 1 term “social networking system” in light of *another inventor’s patent*—Wu ‘596, rather than the instant Specification. We decline to consider such untimely extrinsic evidence, because it was not identified in the Evidence Appendix of the Appeal Brief (App. Br. 21), nor was the reference provided under the exceptions set forth under 37 C.F.R. § 41.33(d)(2).<sup>4</sup>

Turning to the intrinsic evidence, we look to Appellants’ Specification for *context* and find the term “social networking system” is not defined in

---

<sup>4</sup> See Evidence Appendix (App. Br. 21): “No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.”

claim 1 or in the Specification.<sup>5</sup> Moreover, Appellants fail to identify in the Briefs any limiting definition or express disclaimer in the originally-filed Specification. See n.2. *supra*.

The Examiner finds the contact list taught by Deeds (¶ 47, Fig. 3) teaches or suggests a “contact list for a social networking system,” because it relates to screen names in an Instant Messaging system. (Ans. 7).

Because Appellants have not provided a definition for “*social networking system*” in the claim or Specification, or rebuttal evidence properly entered and considered by the Examiner in the record, we are not persuaded the Examiner’s reading of the claim term “social networking system” is overly broad, unreasonable, or inconsistent with Appellants’ Specification.<sup>6</sup>

Therefore, by a preponderance of the evidence, and for the reasons discussed above, we are not persuaded the Examiner erred. Accordingly, we sustain Rejection B of representative claim 1, independent claims 7 and 13,

---

<sup>5</sup> Any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998); *see also Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1381 (Fed. Cir. 2008) (“A patentee may act as its own lexicographer and assign to a term a unique definition that is different from its ordinary and customary meaning; however, a patentee must clearly express that intent in the written description.”).

<sup>6</sup> Because “applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citation omitted).

and dependent claims 3, 4, 9, 10, 15, and 16, also rejected under rejection B, which fall with claim 1. *See* “Grouping of Claims,” *supra*.

*Rejection C of Claims 2, 8, and 14 under § 103*

Appellants advance no separate arguments for the noted claims, which are rejected under rejection C. Arguments not made are considered waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). Therefore, we sustain rejection C of dependent claims 2, 8, and 14.

*Rejection D of Claims 5, 6, 11, 12, 17, and 18 under § 103*

Appellants advance no separate arguments for the noted claims, which are rejected under rejection D. Arguments not made are considered waived. Therefore, we sustain rejection D of dependent claims 5, 6, 11, 12, 17, and 18.

*Conclusion*

For the reasons discussed above, and by a preponderance of the evidence, we are not persuaded the Examiner erred regarding rejection A under 35 U.S.C. § 101, and rejections B–D under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner’s rejection of claims 13–18 under § 101.

We affirm the Examiner’s rejections of claims 1–18 under § 103(a).

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 41.50(f).

AFFIRMED