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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 REQUEST FOR REHEARING

Appellants filed a Request for Rehearing (“Request”) under 37 C.F.R. § 41.52(a)(1) for reconsideration of our Decision on Appeal, mailed June 1, 2016 (“Decision”). The Decision affirmed the Examiner’s rejection A of claims 13–18 under 35 U.S.C. § 101, as being directed to non-statutory subject matter. Our Decision also affirmed rejections B, C, and D under § 103(a) of claims 1–18. In the Request, Appellants further contest rejection A under § 101, and additionally contest § 103 rejection A of representative claim 1.

We have reconsidered our Decision, in light of Appellants’ arguments in the Request, and are not persuaded that we misapprehended or overlooked

any points in rendering our Decision. We decline to change or modify our prior Decision for the reasons discussed *infra*.

ANALYSIS

Rejection A under 35 U.S.C. § 101

Independent claim 13 is reproduced below (emphasis added):

13. *A computer program product* for automated social networking for e-meetings, *the computer program product comprising:*

a computer readable storage medium having computer readable program code embodied therewith, the computer readable program code comprising:

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

computer readable program code for detecting a name in the monitored content;

computer readable program code for comparing the detected name to names in a contact list for a social networking system executing externally to the e-meeting;

and,

computer readable program code for 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.

In our Decision (6), we found PTAB precedential opinion *Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013), directly on point, and controlling regarding the contested “computer readable storage medium”

recited in claim 13. Under *Mewherter*, the scope of a “computer readable storage medium” was held to encompass transitory media such as signals or carrier waves, *where the Specification does not expressly disclaim transitory forms*.

In the Request (3–4), Appellants urge we have misapprehended or overlooked the issue of whether the Specification expressly disclaims transitory forms of the “computer readable storage medium” recited in claim 13. Appellants refer to the Appeal Brief (5), and contend, *inter alia*:

In the Decision, however, the Board appears to have overlooked the argument of the Appeal Brief wherein it was noted that paragraph [0021] definitively excludes the "signal medium" from the "storage medium", the "storage medium" and not the "signal medium" having been claimed by Appellants in claim 13. Indeed, paragraph [0021] "expressly disclaim[s] transitory forms" as required by the jurisprudence of Ex parte Mewherter¹ as noted by the Board. Accordingly, in light of the "express disclaim[er]" of paragraph [0021] of the originally filed specification, Appellants seek rehearing on the matter of the rejections under 35 U.S.C. § 101.

(Request 3–4).

Issue: Under § 101, does the Specification expressly disclaim transitory forms of the “computer readable storage medium” recited in independent claim 13?

Under a broad but reasonable interpretation, the scope of the “computer program product” recited in the preamble of claim 13 covers (under the open-ended term “comprising”) at least one “computer readable

¹ See *Mewherter*, 107 USPQ2d at 1862.

storage medium having computer readable program code embodied
therewith”^{2, 3}

In the Request (3), Appellants urge the Specification (¶ 21) expressly disclaims transitory forms, because “paragraph [0021] definitively excludes the ‘signal medium’ from the ‘storage medium’, the ‘storage medium’ and not the ‘signal medium’ having been claimed by Appellants in claim 13.”

However, we find paragraph 21 of the Specification does not expressly and unambiguously disclaim transitory forms of storage mediums. Instead, paragraph 21 broadly describes a “computer readable storage medium” using exemplary, non-limiting language: “A computer readable

² See e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997) (“Comprising” is a term of art used in claim language which means that the named elements are *essential*, but other elements may be added and still form a construct within the scope of the claim.) (Emphasis added). [T]his court has repeatedly emphasized that an indefinite article “a” or “an” in patent parlance carries the meaning of “one or more” in open-ended claims containing the transitional phrase “comprising.” *SanDisk Corp. v. Kingston Technology Co., Inc.*, 695 F.3d 1348, 1360 (Fed. Cir. 2012) (citing *Baldwin Graphic Systems, Inc. v. Siebert*, 512 F.3d 1338, 1342 (Fed. Cir. 2008)).

³ See also Spec. ¶ 27 (“Finally, the terminology used herein is for the purpose of describing *particular embodiments only and is not intended to be limiting of the invention*. As used herein, the singular forms ‘a’, ‘an’ and ‘the’ are intended to include the plural forms as well, unless the context clearly indicates otherwise. It will be further understood that the terms “comprises” and/or “comprising,” when used in this specification, specify the presence of stated features, integers, steps, operations, elements, and/or components, but do not preclude the presence or addition of one or more other features, integers, steps, operations, elements, components, and/or groups thereof.” (Emphasis added).

[

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.”

(Emphasis added).

We find the exemplary language in the Specification (§ 21) (i.e., “*may be, for example, but not limited to*”) is open-ended, and therefore fails to provide the artisan with notice of a limiting definition, or an *express, unambiguous* disclaimer. We additionally find paragraph 21 of the Specification, as cited by Appellants (Request 3), is silent regarding any mention of “non-transitory,” as are claims 13–18 on appeal.

However, paragraph 22 of the Specification further describes: “A computer readable *signal* medium *may be* any computer readable medium *that is not a computer readable storage medium* and that can communicate, propagate, or transport a program for use by or in connection with an instruction execution system, apparatus, or device.” (Emphasis added).

Thus, paragraph 22 (and not paragraph 21) appears to be the basis for the purported disclaimer argued by Appellants in the Request (3). To the extent that paragraph 22 of the Specification excludes computer readable *signal mediums* from being a computer readable *storage medium*, Appellants conclude that *transitory* forms of storage mediums are expressly disclaimed in the Specification under *Mewherter*. (Request 3).

We give the claim limitations the broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). In considering whether the portions of the Specification cited by Appellants (§§ 21–22) expressly disclaim all transitory mediums from the scope of the “computer readable storage medium” recited in claim

13, we must also weigh the additional open-ended description in paragraph 28 that appears to contravene such disclaimer: “The description of the present invention has been presented for purposes of illustration and description, *but is not intended to be exhaustive or limited to the invention in the form disclosed.*” (Spec. ¶ 28). (Emphasis added).⁴ Additionally, we are unable to find in the entirety of Appellants’ Specification (including the claims and drawings) *any* mention of the term “non-transitory” that would be the basis for an express disclaimer *clearly and unambiguously* excluding *all transitory forms* of mediums from the scope of the claims.

Although Appellants ground their purported disclaimer on the description of the “computer readable *signal* medium” described in paragraph 22 of the Specification, we particularly note claim 13 is *silent* regarding any mention of a “computer readable *signal* medium.” (Emphasis added). Our reviewing court guides: “[i]t is the *claims* that measure the invention.” *See SRI Int’l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*) (citations omitted); *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998) (“[*T*]he name of the game is the claim.”). “We have cautioned against reading limitations into a claim from the preferred embodiment described in the specification, even if it is the only embodiment described, absent clear disclaimer in the specification.” *In re*

⁴ *Accord Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346–47 (Fed. Cir. 2015) (“This court has repeatedly ‘cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification.’”) (quoting *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1328 (Fed. Cir. 2002)).

Am. Acad. of Science Tech Ctr., 367 F.3d 1359, 1369 (Fed. Cir. 2004)
(emphasis added).

Here, we find no clear “non-transitory” disclaimer in the Specification or claims. Given the open-ended, non-limiting descriptions found in paragraphs 21 and 28 of the Specification, and because claim 13 is *silent* regarding any mention of a computer readable *signal* medium (Spec. ¶ 22), and particularly because claim 13 does not positively recite a *non-transitory* “computer readable storage medium,” on this record, we are not persuaded the Examiner erred.⁵ For at least these reasons, we find Appellants’ Specification, and Appellants claims 13–18, do not *expressly* and unambiguously disclaim all transitory forms of the recited “computer readable *storage* medium.” (Claim 13).

We find a preponderance of the evidence supports the Examiner’s finding that the cited portions of the Specification (¶¶ 21–22) do “not limit the ‘computer readable storage medium’ [recited in claim 13] to non-transitory entities.” (Final Act. 23). Thus, we agree with the Examiner’s

⁵ A simple amendment to claim 13 adding “non-transitory” before “computer readable storage medium” would appear to cure the § 101 problem, consistent with current USPTO policy. We refer Appellants to the February 23, 2010 “Subject Matter Eligibility of Computer Readable Media” policy statement by former PTO Director David J. Kappos, as published in the Official Gazette of the United States Patent and Trademark Office (USPTO), 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010), available at: <http://www.uspto.gov/web/offices/com/sol/og/2010/week08/TOC.htm#ref20> We leave this issue to the Appellants and the Examiner in the event of further prosecution.

broader reading that the scope of the claim also covers non-statutory transitory mediums: “[The] Examiner’s broadest reasonable interpretation of ‘computer readable storage medium’ would include a signal per se.”⁶ (*Id.*).

As indicated in our Decision (6), under *Mewherter*, the scope of a “computer readable storage medium” was held to encompass transitory media such as signals or carrier waves, where, as here, the Specification does not expressly disclaim transitory forms. Therefore, we reaffirm our holding that *Mewherter* is on point and controlling regarding claims 13–18, as rejected by the Examiner under § 101. *See* Decision (6).

This panel is bound under agency authority by the precedential holding of *Mewherter*, which was approved by the Director of the USPTO, and by a majority of the judges of the Board.⁷ Accordingly, on this record, and by a preponderance of the evidence, we are not persuaded we misapprehended or overlooked any points in rendering our Decision regarding the Examiner’s § 101 rejection A of claims 13–18.

⁶ 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).

⁷ We note the Director of the USPTO is also a member of the Board under 35 U.S.C. § 6(a) (“The Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Patent Trial and Appeal Board.”).

Rejection B of Claim 1 under § 103(a)

In the Request (6), Appellants assert the Board established a claim construction of a “social networking system” as a “contact list” for an “instant messaging system.” Appellants urge the Board’s claim construction is a new ground of rejection:

The findings of the Board, however, extend the arguments from the equating of a “contact list” to a social networking system executing externally to an e-meeting as claimed and argued by Appellants at pages 8 and 9 of the Reply Brief, to a contact list provided by an instant messaging system. The Board’s findings appear to be an “undesigned new ground of rejection” under 37 C.F.R. § 41.50(c). As such, Appellants respectfully request the Board to designate the findings of fact of page 10 of the Decision a “new grounds of rejection” in so far as to this point, the Examiner appears only to have compared a “contact list” to the claimed “social networking system executing externally to the e-meeting”.

(Request 6).

We disagree with Appellants’ contention that our claim interpretation rises to the level of a new ground of rejection, because claim interpretation is the first step in any meaningful analysis, consistent with our statutory responsibility as a Board to “review adverse decisions of [E]xaminers upon applications for patents pursuant to section 134(a)” 35 U.S.C. § 6 (b)(1).⁸

⁸ A determination that a claim is obvious involves two analytical steps (assuming the references have been properly combined under § 103). First, we must interpret the claim language, where necessary. Because the PTO is entitled to give claims their broadest reasonable interpretation, a court's review of the Board's claim construction is limited to determining whether it was reasonable. *In re Morris*, 127 F.3d 1048, 1055 (Fed. Cir. 1997). Secondly, the Board must compare the construed claim to one or more prior

Our review necessarily requires construing and reading the contested claim limitations on the corresponding features found by the Examiner in the prior art. The issue of proper claim interpretation under BRI is a preliminary consideration for review of each claim limitation contested by Appellants. To require claim construction by the Board to be designated a new ground of rejection would frustrate the purpose of the Administrative Procedure Act (APA), and any meaningful PTAB administrative review of the claim terms contested on appeal. Further, Appellants do not specifically explain how the Board's claim interpretation changed the thrust of the rejection based upon the prior art teachings cited by the Examiner.

Our reviewing court recognizes the Board need not recite and agree with the Examiner's rejection *in haec verba* to avoid issuing a new ground of rejection:

Under the Act [APA], an applicant for a patent who appeals a rejection to the Board is entitled to notice of the factual and legal bases upon which the rejection was based. 5 U.S.C. § 554(b)(3). The Board's rules are in accord and provide that when the Board relies upon a new ground of rejection not relied upon by the examiner, the applicant is entitled to reopen prosecution or to request a rehearing. *See* 37 C.F.R. § 41.50(b). The Board need not recite and agree with the examiner's rejection *in haec verba* to avoid issuing a new ground of rejection. "[T]he ultimate criterion of whether a rejection is considered 'new' in a decision by the [B]oard is whether [applicants] have had fair opportunity to react to the thrust of the rejection." *In re Kronig*, 539 F.2d 1300, 1302-03 (CCPA 1976) (holding no new ground of rejection when the Board relied on the same statutory basis and the same reasoning advanced by the examiner).

art references and make factual findings regarding the limitations contested by Appellants. *Cf. In re Crish*, 393 F.3d 1253, 1256 (Fed. Cir. 2004).

In re Leithem, 661 F.3d 1316, 1319 (Fed. Cir. 2011).

This reasoning is applicable here. Therefore, we find Appellants' arguments unpersuasive that our claim interpretation in the Decision rises to the level of a new ground of rejection.

Turning to the record (Final Act. 5), we note the Examiner finds Appleman teaches or suggest all of the limitations of claim 1, except: "Appleman does not explicitly teach comparing the detected name to names in a contact list for a social networking system executing externally to the e-meeting."

As stated in our Decision (10):

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.⁹

In the Response to Arguments (Ans. 4), the Examiner notes the lack of a definition: "Applicant's specification only discusses 'externally to an e-

⁹ 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).

meeting' in paragraphs [0006] and [0007]. No explicit definition of what external would include or not include is presented." Given the lack of a definition in the Specification, the Examiner broadly but reasonably interprets the claim 1 language "externally to the e-meeting" and finds:

Examiner points to paragraphs [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)."

(Ans. 4, emphasis added).

As reproduced above, the Examiner made a specific finding in bold type regarding the "social networking system executing externally to the e-meeting" (claim 1): "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.**" (Ans. 4). The Examiner additionally points to paragraph 69 of Deeds, and finds:

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 which would be a social network list/system. *Furthermore, the contact list can be local to the user terminal or on a remote server and therefore can be located external to the e-meeting. No matter whether the e-meeting is local or remote to the terminal, the "contact list" could be the opposite and therefore external to the e-meeting.* It is clear then that the prior art of record teaches "contact list for a social

networking system executing externally to the e-meeting" along with all other limitations of the claimed invention.

(Ans. 5, emphasis added).

In the Reply Brief (6), Appellants reproduce the record, but do not substantively traverse the Examiner's specific findings:

In the Examiner's Answer, Examiner responded to Appellants' specific basis of distinction by first arguing that the term "externally" is somehow ambiguous and difficult to understand and therefore requires a specific definition within the specification. Examiner further repeats the content of paragraph [0047] of Deeds notwithstanding Appellants observation that paragraph [0047] of Deeds refers only to a contact list locally or remotely stored in memory.

Regarding Appellants' underlying premise that the Board established a new claim construction for a "social networking system" (claim 1), by reading this term as encompassing a "contact list" for an "instant messaging system" (Request 6), we conclude our construction at least comports with Appellants' own proffered interpretation of a social networking *system*:

"Whereas, a *system* is something substantially more: a collection of components working together to achieve some goal." (Reply Br. 8, emphasis added).

We find a "contact list" and "instant messaging system" are a *collection of components that work together* to achieve a "social

networking” *goal*, and therefore at least *suggest* the “social networking system” recited in claim 1.¹⁰

Moreover, the Supreme Court guides the obviousness “analysis need not seek out precise teachings directed to the specific matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). The operative question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

Here, given the evidence relied upon by the Examiner (Ans. 2–7), we answer that question in the negative. On this record, we are not persuaded the Examiner’s proffered combination of Appleman and Deeds would have been 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, on this record, we are not persuaded of error regarding the Examiner’s underlying factual findings and ultimate legal conclusion of obviousness for all claims rejected under § 103.

CONCLUSION

We have considered all of the arguments raised by Appellants in the Request, but Appellants have not persuaded us that we misapprehended or overlooked any points in rendering our Decision.

¹⁰ “[T]he question under 35 U.S.C. § 103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made.” *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F. 2d 804, 807–808 (Fed. Cir. 1989).

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DECISION

We have granted Appellants' request to the extent that we have reconsidered our Decision, but we deny the Request with respect to making any changes therein.

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 also* 37 C.F.R. § 41.52(b).

REQUEST FOR REHEARING DENIED