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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KULVIR SINGH BHOGAL, ROBERT ROSS PETERSON, and
LISA ANNE SEACAT¹

Appeal 2015-005333
Application 11/847,719
Technology Center 2100

Before ERIC S. FRAHM, JAMES W. DEJMEK, and
JOYCE CRAIG, *Administrative Patent Judges*.

DEJMEK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 30–58. Claims 1–29 have been canceled. *See* Appellants’ Amendment (filed October 16, 2012). We have jurisdiction over the remaining pending claims under 35 U.S.C. § 6(b).

We affirm-in-part.

¹ Appellants identify International Business Machines Inc. as the real party in interest. App. Br. 2.

STATEMENT OF THE CASE

Introduction

Appellants' claimed invention is directed to "presenting media to a group of users in an online environment." Spec. ¶ 1. In a disclosed embodiment, an electronic copy of a presentation is stored locally on a presenter's presentation device as well as stored locally on one of the participants' presentation device. Spec. ¶ 4. As the presenter advances slides in the presentation, the slides displayed on the participants' presentation devices are also advanced. Spec. ¶ 4. According to the Specification, the claimed invention requires only a small amount of information (compared to the information contained in each slide) to be sent over a computer network, thereby preserving bandwidth. Spec. ¶ 5.

Claims 30 and 58 are exemplary of the subject matter on appeal and are reproduced below with the disputed limitations emphasized in *italics*:

30. A computer-implemented method for synchronizing a media presentation, the method comprising:

storing electronic copies of the entire media presentation on presentation devices of two or more participants prior to beginning the media presentation, wherein each presentation device is operable to communicate with the other presentation devices through a communications network;

displaying the electronic copies of the media presentation on the participants' presentation devices;

using a menu on any of the presentation devices to select, by any of the participants, at least one participant among the participants to be a presenter of the media presentation;

in response to an activity performed by the selected at least one presenter on the at least one presenter's copy of the media presentation, transmitting data corresponding to the activity from the presenter's

presentation device, through the network, to the presentation devices of the participants who selected the at least one presenter; and

changing, in accordance with the transmitted data, the appearance of the electronic copies of the media presentation on the presentation devices of the participants who selected the at least one presenter.

58. A presentation device, comprising:

- a memory operable to receive and store an electronic copy of a media presentation prior to the beginning of the media presentation;

- a display unit operable to display the electronic copy of the media presentation on a user interface, wherein the user interface further includes a menu for selecting among *two or more participants having electronic copies of the media presentation*, a participant to be a presenter of the media presentation;

- a network interface operable to:

communicate with other presentation devices having electronic copies of the same media presentation through a communications network, and

receive data corresponding to an activity performed by the presenter on the presenter's copy of the media presentation; and

- a processor operable to, in response to the network interface receiving data corresponding to the activity performed by the presenter, change, in accordance with the transmitted data, the appearance of the electronic copy of the media presentation on the display unit.

The Examiner's Rejections²

1. Claims 30–33, 35, 36, 43–47, 49, 50, 57, and 58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Craig (US 6,654,785 B1; Nov. 25, 2003); Vernon et al. (US 2004/0252185 A1; Dec. 16, 2004)

² The Examiner has withdrawn the rejection of claims 44–57 under 35 U.S.C. § 101. *See* Adv. Act. 2 (mailed November 22, 2013).

(“Vernon”); and Watanabe (US 7,191,214 B2; Mar. 13, 2007). Final Act. 3–11.

2. Claims 34, 42, 48, and 56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Craig, Vernon, Watanabe, and Woolf et al. (US 7,373,590 B2; May 13, 2008) (“Woolf”). Final Act. 11–13.

3. Claims 37–40 and 51–54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Craig, Vernon, Watanabe, and Lentz (US 7,373,608 B2; May 13, 2008). Final Act. 13–17.

4. Claims 41 and 55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Craig, Vernon, Watanabe, and Lin (US 2004/0205477 A1; Oct. 14, 2004). Final Act. 17–19.

Issues on Appeal

1. Did the Examiner err in finding Watanabe teaches or suggests “storing electronic copies of the entire media presentation on presentation devices of two or more participants prior to beginning the media presentation, wherein each presentation device is operable to communicate with the other presentation devices through a communications network,” as recited in claim 30?³

2. Did the Examiner err in finding the combination of cited references teaches or suggests the disputed limitations recited in claim 58?

³ Because we find this issue dispositive, we do not address other issues raised by Appellants related to claims 30–57.

ANALYSIS⁴

Claims 30–57

In rejecting claim 30, the Examiner finds, *inter alia*, Watanabe teaches “storing electronic copies of the entire media presentation on presentation devices of two or more participants prior to beginning the media presentation, wherein each presentation device is operable to communicate with the other presentation devices through a communications network.” Final Act. 6 (citing Watanabe claims 2 and 5). However, in responding to prior arguments by Appellants, the Examiner explains Craig teaches “distributing copies of the presentation prior to the start of the presentation to individual remote locations” (citing Craig, col. 2, ll. 11–17) and Vernon teaches having a “document for the presentation stored on the local computer” (citing Vernon ¶ 50). Final Act. 19–20. The Examiner further explains neither Craig nor Vernon teaches storing the distributed presentation on each of the participants’ devices. Final Act. 20. The Examiner finds “Watanabe teaches storing a file corresponding to the conference and when the participant tries to access the file, the judging unit determines accessibility based on the user. The file and access to the file is [sic] determined prior to the start of the conference.” Final Act. 20 (citing Watanabe claims 2 and 5). The Examiner determines the combined teachings of Craig, Vernon, and Watanabe teaches “storing the distributed presentation on each participant’s device.” Final Act. 20.

⁴ Throughout this Decision, we have considered the Appeal Brief, filed January 7, 2014 (“App. Br.”); the Reply Brief, filed May 27, 2014 (“Reply Br.”); the Examiner’s Answer, mailed on April 1, 2014 (“Ans.”); and the Final Office Action (“Final Act.”), mailed on August 7, 2013, from which this Appeal is taken.

Appellants contend the Examiner erred because “Watanabe does not disclose that files ‘*corresponding to*’ the conference are electronic copies of the entire media presentation . . . [or] that these files are stored ‘*on the presentation devices of two or more participants.*’” App. Br. 14. Specifically, Appellants assert Watanabe teaches storing the files corresponding to the conference in memory of the host PC. App. Br. 14; Reply Br. 2⁵ (citing Watanabe, col. 7, ll. 18–30). Appellants argue the host PC of Watanabe is not equivalent to presentations devices of two or more participants, as required by claim 30. Reply Br. 2. Further, Appellants contend “Watanabe describes what happens when a user tries to access files *after* the conference is finished, not ‘*prior to beginning the media presentation,*’ which is recited in claim 30.” Reply Br. 2.

Additionally, Appellants argue the Examiner erred in finding Craig’s “individual remote locations” are the same as the claimed “presentation devices of two or more participants.” App. Br. 14. Appellants assert Craig’s use of individual remote locations implies a spatial dispersion only and does not relate to presentation devices of two or more participants. App. Br. 14. Further, Appellants contend the Examiner has not provided sufficient explanation as to how Craig’s distribution of copies of a presentation to individual remote locations, Vernon’s storage of a document on a user’s device, and Watanabe’s storage of a file corresponding to a conference could be combined to teach the disputed limitation. App. Br. 15.

We find Appellants’ arguments persuasive of Examiner error. In particular, the memory unit of Watanabe, as relied upon by the Examiner, is

⁵ The Reply Brief does not have page numbers. For reference purposes, we designate the title page of the Reply Brief as page 1.

part of a conference apparatus (*see* Watanabe claims 1, 2, and 5).

Watanabe teaches the memory unit stores files that were accessed during the conference, or that correspond to the conference. Watanabe, col. 7, ll. 18–20, claim 2. We agree with Appellants that Watanabe’s claimed conference apparatus relates to the conference host device, as opposed to the participants’ devices. Additionally, Watanabe teaches “if someone *subsequently* attempts to access those files [(i.e., files that were accessed during a conference)], a host PC **108** grants or refuses a permission to access the files depending on whether the person *was* a participant in the conference.” Watanabe, col. 7, ll. 20–23 (emphases added). Thus, we disagree with the Examiner that access to the files is determined prior to the conference. Further, we agree with Appellants that the Examiner has not provided sufficient reasoning to support the conclusion of obviousness based on the teachings of Craig, Vernon, and Watanabe with respect to this disputed limitation.

For the reasons discussed *supra* and based on the record before us, we are constrained to reverse the Examiner’s rejection of independent claim 30 and independent claim 44, which recites similar limitations. Further, we do not sustain the Examiner’s rejections of claims 31–43 and 45–57, which depend therefrom.

Claim 58

Independent claim 58 is directed to a presentation device comprising, *inter alia*, “memory operable to receive and store an electronic copy of a media presentation prior to the beginning of the media presentation.”

Emphasis added. Further, claim 58 recites a user interface that “includes a

menu for selecting among two or more participants having electronic copies of the media presentation.”

Appellants advance the same arguments against the Examiner’s rejection of claim 58 as were advanced for claim 30, discussed *supra*. See App. Br. 19.

We are unpersuaded by Appellants’ arguments, as directed to claim 58, because they are not commensurate with the scope of claim 58. See *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (limitations not appearing in the claims cannot be relied upon for patentability).

Claim 58 differs from independent claims 30 and 44 because, at least, claim 58 is directed to a “presentation device” comprising memory *operable to store* a copy of the media presentation. Claim 58 does not distinguish whether the claimed presentation device is the host’s (i.e., presenter’s) device or a participant’s device. Additionally, claim 58 recites only that the memory of the presentation device is *operable to store* a copy of the media presentation prior to the beginning of the media presentation. Watanabe teaches a conference apparatus (i.e., a presentation device) comprising, *inter alia*, memory operable to store a copy of the media presentation. See Watanabe, col. 7, ll. 18–20, claim 2. Appellants do not provide sufficient argument or evidence why the memory of Watanabe, which is operable to store the media presentation after the conference (as asserted by Appellants, see Reply Br. 2) would not be operable to store a copy of the media presentation prior to the conference.

For the reasons discussed *supra*, we are not persuaded by Appellants’ arguments of Examiner error. Accordingly, we sustain the Examiner’s rejection of claim 58.

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DECISION

We reverse the Examiner's decision to reject claims 30–57.

We affirm the Examiner's decision to reject claim 58.

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-IN-PART