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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID JOSEPH MURPHY, BRENDA CASTRO,
TUOMAS VAITTINEN, TUULA KARKKAINEN, and
ARI ANTERO AARNIO

Appeal 2015-006449
Application 12/780,912¹
Technology Center 2600

Before LARRY J. HUME, JOHN P. PINKERTON, and JOYCE CRAIG,
Administrative Patent Judges.

HUME, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 1, 3–6, 8–11, 13–15, 18, and 20–26. Appellants have canceled claims 2, 7, 12, 16, 17, and 19. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to Appellants, the real party in interest is Nokia Corp. App. Br. 1.

STATEMENT OF THE CASE²

The Invention

Appellants' disclosed and claimed invention relates to methods and apparatus for presenting location-based content. Title.

Exemplary Claim

Claim 1, reproduced below, is representative of the subject matter on appeal (*emphases* added to contested limitations):

1. A method comprising:

retrieving content associated with one or more points of one or more objects of a location based service, the content having a prioritization in relation to other content;

determining one or more three-dimensional coordinates, the one or more three-dimensional coordinates are specific to a three-dimensional environment;

retrieving one or more models of the one or more objects;
and

causing, at least in part, rendering of the content associated with one or more surfaces of the one or more object models in a user interface of the location-based service, wherein the content is rendered in relation to at least one of the other content that overlaps with the content in the user interface based on the prioritization,

wherein said method further includes:

² Our decision relies upon Appellants' Appeal Brief ("App. Br.," filed Dec. 19, 2014); Reply Brief ("Reply Br.," filed June 22, 2015); Examiner's Answer ("Ans.," mailed Apr. 21, 2015); Final Office Action ("Final Act.," mailed July 21, 2014); and the original Specification ("Spec.," filed May 16, 2010).

receiving an input for selecting the one or more points via the user interface for determining a location for the content on the one or more surfaces of the one or more object models;

receiving an input of the content via the user interface;

associating the content with the one or more points by associating the selected one or more points with a three-dimensional model; and

causing, at least in part, storage of the association of the content and the one or more points.

Prior Art

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Ritter	US 2003/0151592 A1	Aug. 14, 2003
Dengler et al. ("Dengler")	US 2005/0001852 A1	Jan. 6, 2005
Snaveley et al. ("Snaveley")	US 2007/0110338 A1	May 17, 2007
Satoh	US 2009/0079587 A1	Mar. 26, 2009
Yu et al. ("Yu")	US 2010/0066750 A1	Mar. 18, 2010

Buchmann et al., "FingARtips — Gesture Based Direct Manipulation in Augmented Reality," GRAPHITE '04, Proceedings of the 2nd international conference on Computer graphics and techniques in Australasia and South East Asia, pp. 212–221, ACM, New York (hereinafter "Buchmann").

Rejections on Appeal

R1. Claims 1, 3, 4, 8, 9, 11, 13, 18, and 20–24 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Ritter, Yu, and Satoh. Final Act. 5.

R2. Claims 5, 6, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Ritter, Yu, Satoh, and Snavelly. Final Act. 11.

R3. Claim 10 stands rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Ritter, Yu, Satoh, and Dengler. Final Act. 14.

R4. Claims 25 and 26 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Ritter, Yu, Satoh, and Buchmann. Final Act. 15.

CLAIM GROUPING

Appellants proffer suggested claim groupings. App. Br. 6. However, we find the proposed groupings are not logically derived, particularly given the different grounds of rejection present in the various groups, and are not consistent with the Patent Rules for the grouping of claims. *See* 37 C.F.R. § 41.37(c)(1)(iv). We also find separate, substantive arguments are not presented in connection with each of Appellants' suggested groupings. *See* App. Br. 7 *et seq.*³

³ For each ground of rejection applying to two or more claims, the claims may be argued separately (claims are considered by appellant as separately patentable), as a group (all claims subject to the ground of rejection stand or fall together), or as a subgroup (a subset of the claims subject to the ground of rejection stand or fall together). When multiple claims subject to the same ground of rejection are argued as a group or subgroup by appellant, the Board may select a single claim from the group or subgroup and may decide the appeal as to the ground of rejection with respect to the group or subgroup on the basis of the selected claim alone. Notwithstanding any

Based on Appellants' actual arguments (App. Br. 7–16), we decide the appeal of obviousness Rejection R1 of claims 1, 3, 4, 8, 9, 11, 13, 18, and 20–24 on the basis of representative claim 1.

Remaining claims 5, 6, 10, 14, 15, 25, and 26 in rejections R2 through R4, not argued separately or substantively, stand or fall with the respective independent claim from which they depend.

ISSUE

Appellants argue (App. Br. 7–14; Reply Br. 2–4) the Examiner's Rejection R1 of claim 1 under 35 U.S.C. § 103(a) as being obvious over the combination of Ritter, Yu, and Satoh is in error. These contentions present us with the following issue:

Did the Examiner err in combining Ritter, Yu, and Satoh to render representative claim 1 unpatentable under § 103 because Ritter and Yu allegedly teach away from their combination?

ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellants. We do not consider arguments that

other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Under each heading identifying the ground of rejection being contested, any claim(s) argued separately or as a subgroup shall be argued under a separate subheading that identifies the claim(s) by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

37 C.F.R. § 41.37(c)(1)(iv) (emphasis added).

Appellants could have made but chose not to make in the Briefs, and we deem any such arguments waived. 37 C.F.R. § 41.37(c)(1)(iv).

We disagree with Appellants' arguments with respect to claims 1, 3–6, 8–11, 13–15, 18, and 20–26, and we incorporate herein and 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 Examiner's Answer in response to Appellants' arguments. We incorporate such findings, reasons, and rebuttals herein by reference unless otherwise noted. However, we highlight and address specific findings and arguments regarding claim 1 for emphasis as follows.

Appellants contend, "contrary to the Examiner's assertions (per page 3 of the Final Office Action dated July 21, 2014), the combination of Ritter and Yu would not have been obvious to one of ordinary skill in the art." App. Br. 9.

Appellants cite to and quote Ritter (¶¶ 31–32 and Fig. 5) and Yu (¶¶ 16 and 33) (App. Br. 9–10), and argue:

the above reproduced portions of Ritter and Yu are important in distinguishing the two references. Ritter clearly applies to fetching relevant known information (querying information about a targeted object) and including it on the object as seen in figure 5. Whereas, Yu clearly overlays virtual graffiti messages augments the targeted object with a virtual graffiti overlay. This is made clearer by the fact that Ritter is concerned with quick knowledge about newly navigated locations (see, e.g., Abstract) whereas Yu is concerned with relaying messages to other users through virtual graffiti overlay (see, e.g., Abstract, paragraph [0003], and Figure 2). Additionally, although Yu does provide examples of the virtual graffiti being related to the targeted location/object, the messaging method is what Yu is generally

concerned with (see, e.g., paragraph [0003]). From this, it is clear Ritter uses the display of content overlaid onto a scene for fast and easy querying, whereas Yu uses the display of content overlaid onto a scene for passing messages to other users.

App. Br. 11 (*italics omitted*). Appellants argue "the specifics of each instance result in the primary purpose of each reference being taken out of context." *Id.*

In support of their contention, Appellants quote Ritter paragraph 3, and allege:

Clearly, Ritter attempts to reduce the amount of information when visually searching an area and is using the queried information as points of interest when a destination is unknown.

As such, the references teach away their combination. Ritter is not interested in augmenting reality with the virtual by cluttering reality with more virtual additions. Rather, Ritter is attempting to access more real-world information about a targeted object, as such Ritter, in fact, teaches away from Yu. Yu teaches users to augment reality with their own creations and thus, it would not have been obvious to one of ordinary skill in the art to combine the systems as proposed by the Examiner. It is improper to combine references where the references teach away from their combination.

As such, the rationales presented in the Final Office Action dated July 21, 2014 appear to be nothing more than an agglomeration of bits and pieces of the claimed subject matter thrown together through the exercise of impermissible hindsight, without any of the "articulated reasoning with some rational underpinnings" required by the U.S. Supreme Court, *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007). In other words, the Office Action's stated motivation to combine, "advantages of allowing users to customize content are generally known in the art," in the Final Office Action, page 4, lacks substantive value.

App. Br. 12–13 (*internal citation omitted; some italics omitted*).

In the Answer, the Examiner summarizes the rejection by stating, "Ritter . . . discloses a 3D user interface for displaying content superimposed on 3D objects (e.g. Fig. 5 of Ritter), but does not disclose that a user can create the content and associate the content with 3D coordinates of the 3D objects," and further, "Yu . . . discloses a 3D user interface for displaying content superimposed on 3D objects (e.g. Figs. 2 & 3 of Yu), wherein a user can create the content and associate the content with 3D coordinates of the 3D objects (see especially para. 39 of Yu)." Ans. 2.

In response to Appellants' argument regarding the purported lack of obviousness and motivation for the suggested combination of Ritter and Yu, and that the references "teach away" from their combination (App. Br. 12), the Examiner finds:

Appellant is attempting to assign a singular, primary purpose to each reference, and show that these alleged primary purposes are different. This line of reasoning is unpersuasive. First, Ritter and Yu *are* in fact both directed to the same purpose of conveying location information to a user via 3D graphical representations of content overlaid onto a 3D scene.

Ans. 3.

Our reviewing Court guides it is irrelevant that the prior art and the present invention may have different purposes. *See Nat'l Steel Car, Ltd. v. Canadian Pac. Ry., Ltd.*, 357 F.3d 1319, 1339 (Fed. Cir. 2004) ("A finding that two inventions were designed to resolve different problems . . . is insufficient to demonstrate that one invention teaches away from another."). "Obviousness is not to be determined on the basis of purpose alone." *In re Graf*, 343 F.2d 774, 777 (CCPA 1965). It is sufficient that references suggest doing what an Appellant did, although the Appellant's particular

purpose was different from that of the references. *In re Heck*, 699 F.2d 1331, 1333 (Fed. Cir. 1983) (citing *In re Gershon*, 372 F.2d 535, 539 (CCPA 1967)).

Moreover, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Appellant. *See, e.g., In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006) (motivation question arises in the context of the general problem confronting the inventor rather than the specific problem solved by the invention); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323 (Fed. Cir. 2005) ("One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings."); *In re Linter*, 458 F.2d 1013 (CCPA 1972); *In re Dillon*, 919 F.2d 688, (Fed. Cir. 1990), *cert. denied*, 500 U.S. 904 (1991).

The Examiner makes additional factual findings and legal conclusions regarding the references and Rejection R1 of claim 1, which we adopt as our own, and incorporate herein by reference. Ans. 3–5.

In the Reply Brief, Appellants contend, *inter alia*,

[r]egarding the argument that the references do not have to have identical purposes to be combinable, Appellants continue to argue the purposes in this case are indicative of the references teaching away from their combination (Appeal Brief p.12). *They are also indicative of whether one of ordinary skill in the art would even consider such a combination.*

Reply Br. 3 (emphasis added).

We disagree with Appellants' arguments because Appellants do not point to any evidence of record that would demonstrate how a person with skill in the art would consider the references alone, or in combination.

Appellants' assertions amount to unsupported attorney argument, and therefore we give them little weight. *See In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re Huang*, 100 F.3d 135, 139–140 (Fed. Cir. 1996).

To support the conclusion that there was no motivation, Appellants argue:

[T]he Office Action's stated motivation to combine, “advantages of allowing users to customize content are generally known in the art,” in the Final Office Action, page 4, is clearly contrary to the original purpose of the navigating portions of Ritter which simply attempt to reduce clutter in order to more clearly navigate to a particular location.

Reply Br. 4. Appellants' analysis, however, is not the correct manner to determine motivation to combine. “Under the correct [obviousness] analysis, *any need or problem* known in the field of endeavor at the time of invention and addressed by the patent *can provide a reason for combining the elements in the manner claimed.*” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007) (italicized emphasis added).

Therefore, we do not find error in the Examiner's reliance on the combined teachings and suggestions of Ritter, Yu, and Satoh in rendering claim 1 obvious under § 103.

Accordingly, based upon the findings above, on this record, we are not persuaded of error in the Examiner's reliance on the combined teachings and suggestions of the cited prior art combination to teach or suggest the

disputed limitations of claim 1, nor do we find error in the Examiner's resulting legal conclusion of obviousness. Therefore, we sustain the Examiner's obviousness rejection of independent claim 1, and grouped claims 3, 4, 8, 9, 11, 13, 18, and 20–24 which fall therewith. *See* Claim Grouping, *supra*.

§ 103(a) Rejections R2–R4 of Claims 5, 6, 10, 14, 15, 25, and 26

In view of the lack of any separate, substantive arguments directed to obviousness Rejections R2 through R4 of claims 5, 6, 10, 14, 15, 25, and 26 under § 103 (*see* App. Br. 14–16), we sustain the Examiner's rejection of these claims. Arguments not made are waived.⁴

REPLY BRIEF

To the extent Appellants may advance new arguments in the Reply Brief (Reply Br. 2–4) not in response to a shift in the Examiner's position in the Answer, we note arguments raised in a Reply Brief that were not raised in the Appeal Brief or are not responsive to arguments raised in the

⁴ For example, with respect to Rejection R2, Appellants merely argue:

Snively fails to overcome the deficiencies set forth above with respect to *Ritter* in view of *Yu* and *Satoh* [in Rejection R1 of claim 1]. Therefore, dependent claims 5, 6, 14, and 15 also are patentable for at least the reasons independent claims 1 (Group I) and 11 (Group III) are patentable, from which the claims respectively depend, as well as for the additional features the claims recite.

App. Br. 14. Appellants make similar assertions with respect to Rejections R3 and R4. App. Br. 15. We find these types of arguments are not truly separate or substantive, and do not meet the requirements of 37 C.F.R. § 41.37(c)(1)(iv).

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Examiner's Answer will not be considered except for good cause (*see* 37 C.F.R. § 41.41(b)(2)), which Appellants have not shown.

CONCLUSION

The Examiner did not err with respect to obviousness Rejections R1 through R4 of claims 1, 3–6, 8–11, 13–15, 18, and 20–26 under 35 U.S.C. § 103(a) over the cited prior art combinations of record, and we sustain the rejections.

DECISION

We affirm the Examiner's decision rejecting claims 1, 3–6, 8–11, 13–15, 18, and 20–26.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED