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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/954,333 11/24/2010 Jason A. Kiesel 27YE-162496 5200

30764 7590 11/15/2016
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EXAMINER

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ART UNIT PAPER NUMBER

2641

NOTIFICATION DATE DELIVERY MODE

11/15/2016

ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JASON A. KIESEL

Appeal 2015-006889
Application 12/954,333
Technology Center 2600

Before ALLEN R. MacDONALD, JOHN P. PINKERTON, and
GARTH D. BAER, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 7–25 and 27–41. Claims 1–6 and 26 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Exemplary Claim

Exemplary claim 7 under appeal reads as follows (emphasis added)¹:

7. A method for receiving civic incident reports from a user's mobile device, comprising:

providing a reporting application on the mobile device;

providing a menu of civic infrastructure problems and subsequent descriptors for selection by the user;

enabling an imaging mode of the mobile device determines if an image is appropriate for the selected civic infrastructure problem; and

transmitting the civic infrastructure problem and descriptors for selection by the user;

wherein the civic infrastructure problem is selected from the group consisting of: potholes, graffiti, obscured traffic signs, broken or burnt out lights, and animal control issues.

¹ The limitation “enabling an imaging mode of the mobile device ***determines*** if an image is appropriate for the selected civic infrastructure problem,” appears to include a typographical error. We treat the limitation as reciting “enabling an imaging mode of the mobile device [] if an image is appropriate for the selected civic infrastructure problem.”

Rejections on Appeal

1. The Examiner rejected claims 7–25, 27–32, and 39–41 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Smith (US 2006/0015254 A1; Jan. 19, 2016) and Lerg (US 6,288,643 B1; Sept. 11, 2001).²

2. The Examiner rejected claims 33–38 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Smith, Lerg, and Berger (US 2009/0117923 A1; May 7, 2009).³

Appellant's Contentions

1. Appellant contends that the Examiner erred in rejecting claim 7 under 35 U.S.C. § 103(a) because:

The Final Action admitted that Smith fails to teach a civic infrastructure problem that is “selected from the group consisting of: potholes, graffiti, obscured traffic signs, broken or burnt out lights, and animal control issues,” and attempts to cure the noted deficiency with Lerg. However, a close inspection of Lerg reveals that it does not disclose the missing limitation. ***In particular, Lerg does not teach or suggest reporting a civic infrastructure problem.***

To the above, Lerg appears to be directed to a method for detecting a graffiti-making act such as the spray of a spray paint can, the writing with a felt-marker pen on a surface, and the scratching with an abrasive instrument on a surface. The system of Lerg necessarily includes one or more sensors adapted to sense

² The patentability of claims 8–25, 27–32, and 39–41 is not separately argued from that of claim 7. *See* Appeal Br. 11–14. Except for our ultimate decision, claims 8–25, 27–32, and 39–41 are not discussed further herein.

³ The patentability of claims 34–38 is not separately argued from that of claim 7. *See* Appeal Br. 13–14. Except for our ultimate decision, claims 34–38 are not discussed further herein.

the graffiti-making act and transmit a signal representative of the graffiti. As such, Lerg is not directed toward allowing a “user” to report a civic infrastructure problem. Instead, Lerg is directed toward the use of sensors for detecting criminal acts such as a graffiti-making act. This is not the same as reporting a civic infrastructure problem. While a civic infrastructure problem might be the result of a criminal act, it is not tantamount to the act itself. By way of example, a criminal act such as spraying graffiti is of course, not the same as the resulting graffiti (i.e., the civic infrastructure problem). Accordingly, Lerg’s disclosure of a sensor used to detect the criminal act of spray-painting a public wall is not a criminal infrastructure problem.

Appeal Br. 11–12, Appellant’s emphasis and citations omitted, panel’s emphasis added.

2. Appellant also contends that the Examiner erred in rejecting claim 7 under 35 U.S.C. § 103(a) because:

[T]he Final Action asserted that Smith teaches “enabling an imaging mode of the mobile device determines if an image is appropriate for the selected civic infrastructure problem.” . . . Smith merely suggests “taking pictures... of the event when then mobile device enters the reporter mode” Accordingly, Smith simply allows a user to capture via pictures, video, or sound recording, an event. However, nowhere does Smith teach or even remotely contemplate making any sort of determination when enabling an image mode, let alone determining “if an image is appropriate for the selected civic infrastructure problem.”

Appeal Br. 12, Appellant’s emphasis and citations omitted, panel’s emphasis added.

3. Appellant also contends that the Examiner erred in rejecting claim 7 under 35 U.S.C. § 103(a) because:

[T]he Final Action already analogized the mobile device (such as a PDA or phone) of Smith to the claimed mobile device of independent claim 7. However, in relying on Lerg, the Final Action contradictorily asserted that Lerg's base unit 120 is now interpreted as reading on the claimed mobile device. ***This is improper as the Final Action has not set forth a clear/consistent ground of rejection.***

Additionally, there is no motivation to combine the teachings of Lerg and Smith and in fact, Lerg teaches away from Smith. That is, the base unit of Lerg is explicitly directed to a "stationary" or "fixed" unit meant to operate in conjunction with sensors for determining, e.g., when a wall (upon which the base unit is affixed or proximately located) is being tampered with such as when a vandal is spray painting the wall. ***Thus, while Smith is premised upon a person utilizing his/her mobile device to report, e.g., a natural disaster, Lerg is instead premised upon a fixed sensory device for detecting the actual occurrence of, e.g., graffiti. Again, there would be no motivation to combine the teachings of such disparate prior art references, and if the teachings were to be combined the operational principals of each of the prior art references would be vitiated.*** Thus, the cited prior art cannot be combined to teach or suggest a civic infrastructure problem that is "selected from the group consisting of: potholes, graffiti, obscured traffic signs, broken or burnt out lights, and animal control issues."

Appeal Br. 13, Appellant's citations omitted, panel's emphasis added.

4. In the Reply Brief, further as to above contention 1, Appellant also contends that the Examiner erred in rejecting claim 7 under 35 U.S.C. § 103(a) because:

Lerg's disclosure is replete with explicit statements which indicate that the system/method of Lerg is directed to catching the "act" rather than the end result. For example, Lerg describes using sensors to sense the body heat of a person, the sound of spray cans spraying paint, the scratching of a felt marker on a surface. Lerg further describes triggering an alarm if a

graffiti-making “act” has been detected, and in some embodiments relies on a video camera for “recording and/or monitoring the tagger ... a flash camera to capture a still image of the tagger” Moreover still, if a video camera or flash camera is focused on the presence/detecting the presence of a person committing the act, that video camera or flash camera would likely not be able to capture the graffiti on the wall itself due to the placement of the video camera or flash camera. . . .[T]he only way to capture video or photos of the tagger’s face would be to point the video camera or flash camera away from the wall and graffiti.

Again, it is clear that Lerg is concerned with capturing the person/the act, but certainly not the graffiti itself. Hence, and contrary to the position set forth in the Examiner’s Answer, recording the person committing an act is not “essentially the recording of the evidence of graffiti.” In fact, it would be well understood that the system/method of Lerg would have no way of knowing if in fact, an act of graffiti was actually committed as Lerg cannot capture evidence of the graffiti itself.

Reply Br. 3–4, Appellant’s emphasis and citations omitted, panel’s emphasis added.

5. In the Reply Brief, further as to above contention 2, Appellant also contends that the Examiner erred in rejecting claim 7 under 35 U.S.C. § 103(a) because:

[T]he Examiner’s Answer clearly lays out how a user decides to put a device into reporter or video mode, and subsequently takes a video/picture. *Accordingly, it is impossible for the system of Smith to determine if an image mode is appropriate because the user has already selected the mode to capture video/photo(s).*

Additionally, nowhere does Smith teach or suggest, nor does the Examiner’s Answer address the failing of Smith to teach or suggest that the image mode is appropriate for the selected civic infrastructure problem.

Reply Br. 4, Appellant’s citations omitted, panel’s emphasis added.

6. In the Reply Brief, further as to above contention 3, Appellant also contends that the Examiner erred in rejecting claim 7 under 35 U.S.C. § 103(a) because:

First, the Examiner's Answer fails to rebut or address Appellant's contention (set forth in the Appeal Brief) that the Final Action did not set forth a clear/consistent ground of rejection by confusingly/contradictorily relying on Lerg's base unit 102 to allegedly read on the claimed mobile device in one instance, and relying on Smith's mobile device to allegedly read on the claimed mobile device in another instance. Hence, Appellant maintains that the Final Action cannot stand.

Second, the Examiner's Answer merely paraphrases the reasoning set forth in the Final Action to again allege that Lerg/Smith are generally analogous prior art. However, in addition to the arguments already set forth in the Appeal Brief, *Appellant submits that as alluded to above, Lerg is explicitly directed to systems and methods for catching the perpetrator of some act.*

...

It should be abundantly clear that even if a user, according to Smith, were to take a picture of some act, it would do nothing to solve or aid in solving the problem identified by Lerg. Likewise, Lerg, because its explicitly stated concern is catching a tagger/the act specifically when no witness exists, its capturing of video would in no way provide the requisite motivation, nor could it be used to modify the system of Smith.

Reply Br. 5, Appellant's emphasis and citations omitted, panel's emphasis added.

7. Appellant contends that the Examiner erred in rejecting claim 33 under 35 U.S.C. § 103(a) for at least the reasons described with regard to claim 7. *See* Appeal Br. 13.

Issue on Appeal

Did the Examiner err in rejecting claims 7 and 33 as being obvious?

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellant's arguments that the Examiner has erred. We disagree with Appellant's conclusions. Except as noted herein, we adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which the appeal is taken (Final Act. 2–22); and (2) the reasons set forth by the Examiner in the Examiner's Answer (Ans. 2–5) in response to the Appellant's Appeal Brief. We concur with the conclusions reached by the Examiner. We highlight the following.

As to Appellant's above contentions 1 and 4, we are not persuaded the Examiner erred. Appellant's argument that Leng fails to teach reporting a civic infrastructure problem improperly attacks the cited references individually, where the rejection is based on a combination of cited references. In particular, Appellant attacks Leng for failing to teach claim limitations (i.e., "providing a menu of *civic infrastructure problems . . .* for selection by the user," and "*wherein the civic infrastructure problem is selected from the group consisting of: . . . graffiti*") when the Examiner did not rely solely on Leng to teach the aforementioned claim limitations. *See* Appeal Br. 11–12; Reply Br. 3–4. Rather, the Examiner relied upon Smith in combination with Leng to show the aforementioned claim limitations were obvious. In particular, the Examiner relied on Smith to teach a mobile device configured to provide a menu of civic infrastructure problems (e.g., a menu of categories of detected conditions) for selection by a user, and further relied on Leng to teach a device that records a graffiti-making act in

order to prevent graffiti. *See* Final Act. 4–5. It is well established that one cannot show non-obviousness by attacking references individually where the rejection is based upon the teachings of a combination of references. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *see also In re Keller* 642 F.2d 413, 425 (CCPA 1981). As Appellant’s argument does not address the actual reasoning of the Examiner’s rejection, we do not find it persuasive.

As to Appellant’s above contentions 2 and 5, we are also not persuaded the Examiner erred. Appellant’s argument is not commensurate with the scope of claim 7. More specifically, claim 7 fails to recite the feature that Appellant argues distinguishes the claim from Smith (i.e., a mobile device determining if an imaging mode is appropriate). *See* Appeal Br. 12; Reply Br. 4. Further, assuming *arguendo* that Appellant’s argument was commensurate with the scope of claim 7, we do not find it persuasive. Instead, we agree with the Examiner’s findings that Smith teaches the mobile device engaging an imaging mode (i.e., “reporter mode”) in response to a determination that an image is appropriate (e.g., a reception of an instruction by a user to enter a “reporter mode,” a determination that the user has taken a digital photograph or has recorded sound or digital video with the device, or a determination that the user has initiated event reporting software on the mobile device). *See* Final Act. 4; Ans. 3–4.

As to Appellant’s above contentions 3 and 6, we are also not persuaded the Examiner erred. We disagree with Appellant that the Final Office Action contradictorily asserted both Smith’s mobile device and Lerg’s base unit as teaching the claimed “mobile device.” *See* Appeal Br. 13; Reply Br. 5. Instead, as described above, the Examiner found Smith

teaches a mobile device configured to provide a menu of civic infrastructure problems (e.g., a menu of categories of road conditions), and further found Lerg teaches a device that reports graffiti via recording a graffiti-making act. *See* Final Act. 3–5. Regarding Appellant’s argument that there is no motivation to combine the teachings of Lerg and Smith because Lerg teaches a fixed base unit configured to detect graffiti where Smith teaches a mobile unit configured to detect a specified condition, we are not persuaded by this argument either. *See* Appeal Br. 13; Reply Br. 5. “[A] determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.” *In re Mouttet*, 686 F. 3d 1322, 1332 (Fed. Cir. 2012) (citations omitted). Nor is the test for obviousness whether a secondary reference’s features can be bodily incorporated into the structure of the primary reference. *In re Keller*, 642 F.2d 413, 425. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *Id.* Appellant has not provided sufficient evidence or technical reasoning to demonstrate that modifying Smith’s mobile device to report a detected incident of a graffiti-making act on a surface based on the teaching of Lerg would be beyond the skill of a person of ordinary skill in the relevant art.

Accordingly, we sustain the rejection of claim 7.

As to Appellant’s above contention 7, we are also not persuaded the Examiner erred for at least the reasons described above with respect to Appellant’s above contentions 1 and 4. Accordingly, we also sustain the rejection of claim 33.

CONCLUSIONS

(1) The Examiner has not erred in rejecting claims 7–25 and 27–41 as being unpatentable under 35 U.S.C. § 103(a).

(2) Claims 7–25 and 27–41 are not patentable.

DECISION

We affirm the Examiner’s rejections of claims 7–25 and 27–41 as being unpatentable under 35 U.S.C. § 103(a).

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