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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALFRED C. TOM

Appeal 2015-007808
Application 12/712,130
Technology Center 2600

Before ALLEN R. MacDONALD, NABEEL U. KHAN, and
SHARON FENICK, *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 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claims

Exemplary claims 1, 7, 9, and 13 under appeal read as follows (emphasis added):

1. A voice-based menu navigation system comprising:
a speech engine operable to recite a list of choices to a user for the user to choose from; and
an input device that is operated by the user and is operable to increase or decrease the speed of the recitation of the list of choices in response to operation by the user, wherein ***the recitation of the list of choices becomes an abbreviated description*** for faster navigation.
3. The system according to claim 2 wherein the text-to-speech engine chooses which text to process and recite to the user based on the user's manipulation of the input device ***if there are two or more text descriptions for each choice in the list of choices.***
7. The system according to claim 1 further comprising a component that is operable to track the manipulation speed of the input device provided by the user and ***set a default rate of speed based on a user's tracking history.***
9. The system according to claim 1 wherein the speech engine determines the list of choices to be recited based on the content of a text file with markup tags where the markup tags describe which content applies to which speed of recitation of the list of choices.
13. The system according to claim 1 wherein the list of choices includes advertisements.

Rejections

1. The Examiner rejected claims 1–6, 8, and 15–18 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Nainpally et al. (US 2003/0105639 A1, published June 5, 2003), Kurzweil et al. (US 6,033,224, issued Mar. 7, 2000), and Raffa et al. (US 2010/0169075 A1, published July 1, 2010).¹

2. The Examiner rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Nainpally, Kurzweil, Raffa, and Ikehara et al. (US 2007/0168115 A1, published July 19, 2007).

3. The Examiner rejected claims 9–14, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Nainpally, Kurzweil, Raffa, and Reed et al. (US 2008/0141180 A1, published June 12, 2008).²

¹ Claims 1, 2, 4–6, 8, and 15–18 are grouped together. Although Appellant discusses claim 15 (App. Br. 10) we do not select it as representative of this group. Rather, we select claim 1 as representative. Further as to claim 15, the discussion thereof does not comply as separately argued as required by 37 C.F.R. § 41.37(c)(1)(iv) (“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.” (emphasis added)). However, we exercise our discretion and we treat claim 15 as separately argued. We treat claims 16–18 with claim 15. Claim 3 is grouped separately (App. Br. 10–11). Claims 2, 4–6, and 8, are not argued separately. Except for our ultimate decision, claims 2, 4–6, and 8 are not discussed further herein.

² Claims 9–14, 19, and 20 are grouped together. Although Appellant discusses claims 9 and 19 (App. Br. 13–15) we do not select either as representative of this group. Rather, we select claim 13 as representative.

Further as to claims 9 and 19, as with claim 15, the discussion thereof does not comply as separately argued as required by 37 C.F.R. § 41.37(c)(1)(iv). Although we take note of claims 9 and 19 (below), unlike claim

Appellant's Contentions

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

Appellant submitted the Second Declaration that includes additional materials. The Second Declaration includes an Exhibit C that describes the concept of a recitation of a list of choices that becomes *an abbreviated description*. Thus, Appellant submits that the claim language at issue was clearly conceived of before the effective date of Raffa. In particular, with respect to at least the Second Declaration, page 2 of Exhibit C states that prerecorded audio clips for reciting menu items may be used, where there are several versions on hand and where the version used depends on the speed of recitation desired, i.e., menu items (lists) are available in various versions where the faster versions *include abbreviated lists* for faster recitation. Page 2 of Exhibit C also states that tactile inputs for *going forward or backward can cut off the current item being spoken, which essentially abbreviates the portion of the list being spoken*.

App. Br. 8, emphasis added.

Appellant submits that at least Exhibit C of the Second 1.131 Declaration shows that the inventor was in possession of the claim language at issue because Exhibit C states, *inter alia*, that prerecorded audio clips for reciting menu items may be used, with several versions on hand depending on the speed of recitation desired.

App. Br. 9.

15, we exercise our discretion and decline to treat claims 9 and 19 as separately argued. We treat claims 9–12, 14, 19, and 20, with claim 13. Although not necessary for our decision, if we were to treat claims 9 and 19 as separately argued, we would adopt as our own the Examiner's reasoning (Ans. 6–7).

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

In the Final Office Action mailed December 12, 2014, the Examiner stated that, “Examiner takes the position that the original disclosure supports only abbreviation of each menu option individually but not a list of options”.

App. Br. 8–9.

2. Appellant contends that the Examiner erred in rejecting claim 15 under 35 U.S.C. § 103(a) because:

While paragraph [0029] of Raffa discloses transmitting audible items at a speed that matches traversal of input items, Appellant respectfully submits that nothing in paragraph [0029] of Raffa discloses setting a default rate of speed that is based on a user’s tracking history.

App. Br. 10.

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

Appellant submits that the Examiner has not shown that dependent claim 3 is obvious in view of Naimpally because a specific request from a user to download files (Naimpally) does not teach or suggest choosing which text to process and recite as claimed by Appellant in claim 3.

App. Br. 11.

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

Ikehara does not teach or suggest a component that, *inter alia*, tracks the manipulation speed of an input device provided by the user and ***that sets a default rate of speed*** based on a user’s tracking history.

App. Br. 12–13, emphasis added.

5. Appellant contends that the Examiner erred in rejecting claim 13 under 35 U.S.C. § 103(a) because:

With respect to Appellant's claim[13], Appellant submits that, for at least the reasons set forth supra with respect to Raffa being removed as a prior art reference, th[is] claim[is] not obvious in view of the cited prior art.

App. Br. 13.

Issues on Appeal

Did the Examiner err in rejecting claims 1, 3, 7, 13, and 15 as being obvious?

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellant's Appeal Brief arguments that the Examiner has erred.

As to Appellant's above contentions 2 and 4, covering claims 15 and 7 respectively, we agree.

As to Appellant's above contention 1A, covering claim 1, Appellant asserts "page 2 of Exhibit C states that prerecorded audio clips for reciting menu items may be used, where there are several versions on hand and where the version used depends on the speed of recitation desired, i.e., menu items (lists) are available in various versions where the faster versions include abbreviated lists for faster recitation." App. Br. 8. We disagree. Appellant is correct that the exhibit states "[t]he text-to-speech engine may use prerecorded audio dips for reciting menu items, and have several versions on hand depending on the speed recitation desired." Exhibit C, p. 2. However, we find no support in Exhibit C for the remainder of

Appellant's assertion (the "i.e." clause). Although Appellant also argues "[p]age 2 of Exhibit C also states that tactile inputs for going forward or backward can cut off the current item being spoken, *which essentially abbreviates* the portion of the list being spoken" (App. Br. 8), this does not align with Appellant's Specification which uses the terms "cut off" (Spec. 6 and 19) and "abbreviated description" (Spec. 19) as distinct descriptions of inventive features.

Further, as to contention 1B, covering claim 1, we are unpersuaded by this argument. Appellant bases the argument on Examiner's concluding sentence to the paragraph bridging pages 2–4 of the response section of the Final Action. That concluding sentence states "the original disclosure supports only abbreviation of *each menu option individually* but not *a list of options*." Final Act. 4, emphases added. Based on our reading of the entire response to argument paragraph, we conclude that an objective observer viewing the entire response would conclude that the concluding sentence referenced by Appellant contains a typographical error in that the clauses "each menu option individually" and "a list of options" are reversed. The body of the paragraph states:

By amendment of October 14, 2014, the Applicant identifies locations in the second declaration which support abbreviation concept. Specifically, the Applicant points to page 5 of Exhibit B (Second Declaration under 37 CFR 1.131, filed December 2, 2013) wherein according to the Applicant the options may be skipped. On page 7 of Remarks of the amendment of October 14, 2014, the Applicant concludes " . options may be skipped, i.e., abbreviated". Examiner respectfully disagrees since *skipping the options abbreviates the list of the options but not an option itself*.

Final Act. 3, emphasis added. Based on a proper reading, the concluding sentence would be understood to state “the original disclosure supports only abbreviation of [*a list of options*] but not [*each menu option individually*].”

As to Appellant’s above contention 3, covering claim 3, we disagree. In response to Appellant’s arguments, the Examiner provides additional analysis and points to “paragraph [0026] of Raffa et al. wherein the selection of the appropriate version of the abbreviation is made by a user based on comprehension.” Ans. 5. Appellant’s Reply Brief does not dispute this new analysis. Although not necessary for our decision, we note that claim 13 is not limited to abbreviations. Rather, it merely requires choosing text to process if there are two or more text descriptions. We find that such is taught at paragraph 41 of Naimpally as a language having been selected by the user by manipulation of the input device (Naimpally paragraph 38, “user to select from a list of different languages”).

As to Appellant’s above contention 5, covering claim 13, we disagree for the reasons discussed above regarding contention 1.

CONCLUSIONS

- (1) Appellant has established that the Examiner erred in rejecting claims 7 and 15–18 as being unpatentable under 35 U.S.C. § 103(a).
- (2) The Examiner has not erred in rejecting claims 1–6, 8–14, 19, and 20 as being unpatentable under 35 U.S.C. § 103(a).
- (3) Claims 7 and 15–18 have not been shown to be unpatentable.
- (4) Claims 1–6, 8–14, 19, and 20 are not patentable.

DECISION

The Examiner's rejections of claims 1–6, 8–14, 19, and 20 are affirmed.

The Examiner's rejections of claims 7 and 15–18 as being unpatentable under 35 U.S.C. § 103(a) are reversed.

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-IN-PART