



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/071,270	03/24/2011	Erika Piia Paulina Reponen	P5013US01	3675
11764	7590	10/31/2016	EXAMINER	
Ditthavong & Steiner, P.C. 44 Canal Center Plaza Suite 322 Alexandria, VA 22314			GORTAYO, DANGELINO N	
			ART UNIT	PAPER NUMBER
			2168	
			NOTIFICATION DATE	DELIVERY MODE
			10/31/2016	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@dcpatent.com
Nokia.IPR@nokia.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ERIKA PIIA PAULINA REPONEN and
JAAKKO OLLI TAAVETTI KERANEN

Appeal 2015-008206
Application 13/071,270
Technology Center 2100

Before JOHN A. EVANS, SCOTT B. HOWARD, and SCOTT E. BAIN,
Administrative Patent Judges.

HOWARD, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1–20, which constitute all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify Nokia Corporation as the real party in interest. App. Br. 1.

THE INVENTION

The disclosed and claimed invention is directed to a method and apparatus for providing an active search user interface element “for presenting a global view of desired information at specific locations that correspond to the desired information with respect to a start position.”

Abstract.

Claim 1, reproduced below with the disputed claim limitation emphasized, is illustrative of the claimed subject matter:

1. A method comprising facilitating a processing of and/or processing (1) data and/or (2) information, the (1) data and/or (2) information based, at least in part, on the following:

one or more search parameters at an element of a user interface, the element presented at a position within the user interface;

a processing of the one or more search parameters to determine one or more search results;

at least one determination of one or more other positions within the user interface based,

at least in part, on the one or more search results; and

a presentation of the element at at least one of the one or more other positions,

wherein the user interface includes a transparency effect, and

wherein when the user interface is pointed towards a surface of the Earth, the presentation with the transparency effect of the element at the at least one of the one or more other positions is a view through the Earth to an opposite surface of the Earth.

REFERENCES

The prior art relied upon by the Examiner as evidence in rejecting the claims on appeal is:

Nasiri

US 7,907,838 B2

Mar. 15, 2011

LeBeau
Petrou

US 2011/0098917 A1 Apr. 28, 2011
US 2011/0131235 A1 June 2, 2011

REJECTIONS

Claims 1–4, 8–14, and 18–20 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over LeBeau in view of Nasiri. Final Act. 3–9.

Claims 5–7 and 15–17 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over LeBeau in view of Nasiri and Petrou. Final Act. 9–11.

ANALYSIS

We have reviewed the Examiner’s rejection in light of Appellants’ arguments that the Examiner erred. In reaching this decision, we have considered all evidence presented and all arguments made by Appellants. We are not persuaded by Appellants’ arguments regarding claims 1–20.

Appellants argue the Examiner erred in finding Nasari teaches “wherein when the user interface is pointed towards a surface of the Earth, the presentation with the transparency effect of the element at the at least one of the one or more other positions is a view through the Earth to an opposite surface of the Earth,” as recited in claims 1 and 11. App. Br. 5–9; Reply Br. 2–6. More specifically, Appellants argue Nasiri merely “describes that the displayed view for the map can be moved in accordance with motion of the device.” App. Br. 6–7. Appellants further argue that there is nothing improper with using functional language in a claim and that functional language must be considered, just like any other claim limitation. Reply Br. 5.

The Examiner concludes the disputed wherein limitation of claims 1 and 11 “is directed towards an *intended result*, the intended result being a view through the Earth to an opposite surface of the Earth when the user interface is pointed towards a surface of the Earth.” Ans. 3 (emphasis added). The Examiner further concludes “there are no limits recited in the claim on how the user interface would display a view to an opposite surface of the Earth, or how it would function to display a view to an opposite surface of the Earth.” Ans. 4–5.

During prosecution, claims must be given their broadest reasonable interpretation while reading claim language in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

With regard to claim 1, the disputed wherein limitation is a conditional limitation. That is, claim 1 only recites an intended use — displaying a specific transparency effect — when the user interface is pointed towards the surface of the earth. *See* App. Br. 11 (Claims App’x). On the other hand, the claim does not require any specific transparency effect when the user interface is not pointed towards the surface of the earth. *Id.* We conclude that the broadest reasonable construction of claim 1 covers two alternative methods, one method when the user interface is pointed towards the surface of the earth and another when it is not. *See Ex parte Schulhauser*, Appeal 2013-007847, slip op. 6–10 (PTAB April 28, 2016) (precedential) (discussing construction of conditional limitations in method claims). In light of the claim’s conditional language, the prior art need only teach one of the two alternatives, not both. *See id.* Appellants do not argue that the prior art does not teach or suggest all of the steps of the method

when the user interface is not pointed towards the surface of the earth. Therefore, we are not persuaded by Appellants' arguments that the Examiner erred. *Id.* (holding the claimed subject matter to be obvious when only one of two conditional methods is taught by the prior art).

Accordingly, we sustain the Examiner's rejection of independent claim 1, along with dependent claims 2–4 and 8–10, which are not separately argued. We also sustain the Examiner's rejection of claims 5–7, which are not argued separately and which Appellants agree stands and falls with the patentability of claim 1. *See* App. Br. 4.²

With regard to claim 11 — which is directed to an apparatus, not a method — we agree with and adopt the Examiner's conclusion that the disputed wherein clause is directed to an intended use of the claimed invention and does not limit the structure recited in the claim. *See* Ans. 3–5. “An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.” *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003); *see also In re Schreiber*, 128 F.3d 1473, 1477–78 (Fed. Cir. 1997) (claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function). Although “[s]uch statements often . . . appear in the claim's preamble . . .,” *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

² Even if the claim did not have conditional language, we would still sustain the Examiner's rejection of claims 1–10 for the same reasons discussed below regarding claim 11.

This reasoning is applicable to the disputed wherein limitation recited above, which, as a statement of intended use, does not further limit the structure of the claimed apparatus. Our reviewing court further guides the patentability of an apparatus claim “depends on the claimed structure, not on the use or purpose of that structure.” *Catalina Marketing Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002).

We have considered, but are not persuaded by, Appellants’ citation to the Manual of Patent Examining Procedure on the propriety of functional claims. *See* Reply Br. 5. The Examiner has not rejected the claims for claiming an intended use; instead, consistent with the Federal Circuit decisions discussed above, the Examiner has merely concluded that, under the broadest reasonable construction of the claim, the intended use of the apparatus does not limit the scope of the claim.

Moreover, to the extent the Manual of Patent Examining Procedure is relevant, the Examiner’s rejection is consistent with the Manual of Patent Examining Procedure’s guidance regarding wherein limitation³:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) “adapted to” or “adapted for” clauses;
- (B) “wherein” clauses; and
- (C) “whereby” clauses.

³ MPEP § 2111.04 is titled “‘Adapted to,’ ‘Adapted for,’ ‘Wherein,’ and ‘Whereby’ Clauses.”

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. See, e.g., *Griffin v. Bertina*, 283 F.3d 1029, 1034, 62 USPQ2d 1431 (Fed. Cir. 2002) (finding that a “wherein” clause limited a process claim where the clause gave “meaning and purpose to the manipulative steps”). In *In re Giannelli*, 739 F.3d 1375, 1378, 109 USPQ2d 1333, 1336 (Fed. Cir. 2014), the court found that an “adapted to” clause limited a machine claim where “the written description makes clear that ‘adapted to,’ as used in the [patent] application, has a narrower meaning, viz., that the claimed machine is designed or constructed to be used as a rowing machine whereby a pulling force is exerted on the handles.” In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “‘whereby’ clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.* However, the court noted that a “‘whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.’” *Id.* (quoting *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)).

MPEP § 2111.04. Appellants do not address this relevant section.

In this case, we conclude that the wherein clause is not necessary to give meaning and purpose to the structural limitations of the claims and merely describes an intended use. For example, there is no evidence on the record before us that shows the direction that the user interface is pointed has any relationship or bearing on the structure of the apparatus.

Accordingly, we sustain the Examiner’s rejection of claim 11, along with the rejections of dependent claims 12–14 and 18–20, which are not separately argued. We also sustain the Examiner’s rejection of claims 15–17, which are not argued separately. *See* App. Br. 4.

Appeal 2015-008206
Application 13/071,270

DECISION

For the above reasons, we affirm the Examiner's decisions rejecting claims 1–20.

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