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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte DIBYENDU CHATTERJEE

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Appeal 2016-007002
Application 13/796,662
Technology Center 2400

—————

Before ST. JOHN COURTENAY III, CARL L. SILVERMAN, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of
claims 1–20, which are all the claims pending in this application. We have
jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm-in-part.

STATEMENT OF THE CASE

Introduction

Appellant's invention "relates to automated personal assistant
systems." (Spec. ¶ 1).

Exemplary Claim

1. A method, comprising:

determining, by a processor, one or more questions for presentation to a user, based at least on navigation information and a user profile of the user;

communicating, by the processor, the one or more questions to the user;

receiving, at the processor, one or more user responses to the one or more questions; and

[L] *determining, by the processor,* **a point of interest** *based at least on the one or more user responses to the one or more* **questions**, *the point of interest comprising a* **destination**.

(Emphasis added regarding contested limitation L).

Rejections

A. Claims 1–11, 16, 17, 19, and 20 are rejected under pre-AIA 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Prehofer (US 2010/0125406 A1, published May 20, 2010) and Ohler et al. (US 6,424,910 B1, issued July 23, 2002) (hereinafter "Ohler").

B. Claims 12 and 13 are rejected under pre-AIA 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Prehofer, Ohler, and Min et al. (US 2013/0144471 A1, published June 6, 2013) (hereinafter "Min").

C. Claim 14 is rejected under pre-AIA 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Prehofer, Ohler, and Melen et al. (US 2014/0006137 A1, published Jan. 2, 2014) (hereinafter "Melen").

D. Claims 15 and 18 are rejected under pre-AIA 35 U.S.C. § 103(a) as
being unpatentable over Prehofer, Ohler, and Aben et al. (US
2011/0131243 A1, published June 2, 2011) (hereinafter "Aben").

Issue on Appeal

Did the Examiner err in rejecting claims 1–20 as being obvious over
the cited combinations of references under pre-AIA 35 U.S.C. § 103(a)?

ANALYSIS

We have considered all of Appellant's arguments and any evidence
presented. To the extent Appellant has not advanced separate, substantive
arguments for particular claims, or other issues, such arguments are waived.
See 37 C.F.R. § 41.37(c)(1)(iv).

Claim 1 rejected under Rejection A

Issue: Under pre-AIA 35 U.S.C. § 103(a), did the Examiner err by
finding Prehofer and Ohler collectively teach or suggest contested limitation
L:

> [L] *determining, by the processor,* **a point of interest** *based at
> least on the one or more user responses to the one or more*
> **questions***, the point of interest comprising a* **destination**[,]

within the meaning of representative claim 1?[1] (Emphasis added).

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[1] We give the contested claim limitations the broadest reasonable
interpretation (BRI) consistent with the Specification. *See In re Morris*,
127 F.3d 1048, 1054 (Fed. Cir. 1997).

Appellant contests limitation L of claim 1, as follows:

the standing rejection does not explain how Prehofer could or
would be modified by Ohler such that the point of interest in
Prehofer comprises a destination while still being able to meet
the remaining claim limitations for which it was originally
cited. For example, **the use of questions in Prehofer** to
identify whether a point of interest (e.g., a landmark) is **visible
in order to navigate better to the destination requires that
point of interest to already be determined before asking the
question**, and to be something different from the destination.
Therefore, a modification of Prehofer to replace points of
interest with destinations would at best teach questions that
verify whether a destination is visible to the user. **However,
claim 1 requires determining the destination based on
responses to inquiries**.

App. Br. 13 (emphasis added).

The Examiner disagrees.

Prehofer teaches of presenting POI (point of interest) as a
navigation reference based upon the user information received
from the user (see, paragraph [0049]). Prehofer does not teach
the POI as a navigation destination. However the broadest
reasonable interpretation of appellant's argued "point of interest
comprising a destination" can be as an intermedia[te]
destination (equivalent to Prehofer's next POI)(the navigation
unit may request that the user click or otherwise select a
graphical icon representing a POI once the user has found the
POI and may then provide the user with additional directions
comprising a next POI along a route to the user's destination
location, see, paragraph [0052]).

(Ans. 11).

The Examiner additionally finds the cited secondary Ohler reference

teaches the POI as the destination as follows:

> The user provides the navigation services provider with data identifying the location of the first and second users and the type of point of interest (see, col. 4, lines 36-41 and step 164 in figure 2); and
>
> The navigation services provider provides data indicating a list of places (equivalent to appellant's POI as a destination) to the users based on the type specified by the user in step 164 (see, col. 5, lines 18-28 and step 178 and 180 in figure 2).

(Ans. 12).

Thus, the Examiner finds that the combination of "Prehofer and Ohler teaches all limitations of [independent] claims 1, 17, and 20." (*Id.*)

Turning to the evidence relied upon by the Examiner, Prehofer teaches that navigation unit 118 and/or POI management unit 126 obtain **usage data** by communicating queries or requests (i.e., "questions") to the user of the user device 102 about a **user's interaction** with **POI information**, such as "[v]**isibility data** [that] may be obtained by **querying a user** as to the **visibility** of a particular POI." Prehofer ¶ 52 (emphasis added).

However, even if we assume, arguendo, that the Examiner's proffered combination of Prehofer, as modified by Ohler, teaches or at least suggests the recited steps of "**determining** . . . one or more **questions** for presentation to a user, **based at least on navigation information and a user profile of the user**; [and] **communicating** . . . the one or more questions to the user; and **receiving**, at the processor, one or more **user responses** to the one or more questions"; we nevertheless find the plain language of the claim supports Appellant's principal contention that "claim 1 requires **determining the destination based on responses to inquiries**." (App. Br. 13) (emphasis added).

The second recited "determining" step of claim 1 requires:

[L] *determining, by the processor,* **a point of interest** *based at least on the one or more user responses to the one or more* **questions***, the point of interest comprising a* **destination***.*

(Claim 1).

We find a close examination of the evidence cited by the Examiner (Ans. 11–12; Final Act. 3–4) (in particular, ¶¶ 49 and 52 of Prehofer), reveals that the POI (Point of Interest) has **already been determined** when the user **selects it** by "**user click or otherwise select**[ing] **a graphical icon representing a POI**":

> the navigation unit **118 may query the user** about the visibility **level of the POI**. The navigation unit **118** may receive the user's response and provide the response to the POI management unit **126**. In one example embodiment, the navigation unit **118** may **request that the user click or otherwise select a graphical icon representing a POI** once the user has found the POI and may then provide the user with additional directions comprising a next POI along a route to the user's destination location.

(Prehofer ¶ 52) (emphasis added).

Nor has the Examiner cited to any portion of Ohler that overcomes the aforementioned deficiency of Prehofer. Therefore, on this record, we find a preponderance of the evidence supports Appellant's contention that **"the use of questions in Prehofer** to identify whether a point of interest (e.g., a landmark) is visible in order to navigate better to the destination requires that **point of interest to already be determined** before asking the question." (App. Br. 13) (emphasis added).

Therefore, we find the Examiner's proffered combination of Prehofer and Ohler does not teach or reasonably suggest the contested second-recited

(L) step of "**determining**." (Claim 1). We note independent method claim 20 recites contested limitation L using similar language having commensurate scope: "*determining, by the processor, one or more points of interest based at least on the one or more user responses to the one or more questions, the one or more points of interest comprising one or more destinations.*" (Claim 20).

Accordingly, we **reverse** the Examiner's rejection A of independent claims 1 and 20. For the same reasons, we reverse rejection A of dependent claims 2–11, and 16, which depend from independent claim 1.

Rejection B of Dependent Claims 12 and 13

Regarding rejection B of claims 12 and 13 (which depend from dependent claim 11, which in turn depends from claim 1), the Examiner has not shown how the additionally cited Min reference overcomes the aforementioned deficiencies of Prehofer and Ohler, as discussed above regarding rejection A of independent claim 1. *See* contested limitation L of claim 1. Accordingly, we **reverse** the Examiner's rejection B of dependent claims 12 and 13.

Rejection C of Dependent Claim 14

Regarding rejection C of claim 14 (which depends directly from claim 1), the Examiner has not shown how the additionally cited Melen reference overcomes the aforementioned deficiencies of Prehofer and Ohler, as discussed above regarding rejection A of independent claim 1. *See* contested limitation L of claim 1. Accordingly, we **reverse** the Examiner's rejection C of dependent claim 14.

Rejection D of Dependent Claim 15

Regarding rejection D of claim 15 (which depends directly from claim 1), the Examiner has not shown how the additionally cited Aben reference overcomes the aforementioned deficiencies of Prehofer and Ohler, as discussed above regarding rejection A of independent claim 1. *See* contested limitation L of claim 1. Accordingly, we **reverse** the Examiner's rejection D of dependent claim 15.

Rejection A of Independent System Claim 17 and Dependent Claim 19

Independent system claim 17 alternatively recites, in pertinent part: "a processor, communicatively coupled to the interface, configured to **determine one or more questions** *for presentation to the user, based at least on the navigation information and the user profile*." (emphasis added).

This is essentially the same language recited in the first recited "determining" step of claim 1: "**determining**, by a processor, **one or more questions** *for presentation to a user, based at least on navigation information and a user profile of the user*." (emphasis added).

In the Final Action (3), the Examiner rejects the first recited "determining" step of claim 1 over paragraph 52 of Prehofer.

In the statement of rejection for independent claim 17 (Final Act. 7), the Examiner finds: "Regarding claims 17 and 19, Prehofer in view of Ohler teaches all limitations as presented above in claim 1. Therefore they are rejected for similar reason as presented above in claim 1."

Appellant's arguments bridging pages 20 and 21 of the Appeal Brief merely recite the language of claim 17, and assert: "As discussed in Section A.3 [of the Appeal Brief], the rejection of claim 1 is improper. For at least

this reason, the rejection of claim 17 is also improper and should be reversed."

We find Appellant fails to substantively traverse the Examiner's finding that "*determin[ing] one or more questions for presentation to the user, based at least on the navigation information and the user profile*" (claim 17) is taught or suggested by paragraph 52 of Prehofer. (Final Action 3), as pertaining to the similar language recited in the first determining step of claim 1.

To the extent Appellant incorporates and applies arguments regarding the combinability of Prehofer and Ohler from the rejection of claim 1 to the rejection of claim 17, we find the Examiner (Final Act. 4) sets forth sufficient "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Moreover, Appellant provides no persuasive evidence that combining the teachings of an Prehofer in view of Ohler would have been "uniquely challenging or difficult for one of ordinary skill in the art" *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), or would have realized more than a predictable result. We note a point of interest (POI) can reasonably be a destination, and vice-versa.

Therefore, we **sustain** the Examiner's rejection A of broadest independent claim 17, and rejection A of claim 19 (not argued separately) which depends directly therefrom. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Rejection D of Dependent Claim 18

Claim 18 depends directly from independent claim 17. Regarding claim 18, Appellant argues: "as explained above in Sections A.3 and A.13 of

the Appeal Brief, the rejection of claims 1 and 17 is improper. Further, Aben does not cure the deficiencies of Prehofer and Ohler. Specifically, Aben does not teach **determining a destination based on answers to a series of questions**." (App. Br. 24) (emphasis added).

However, we note independent claim 17 and claim 18 (which depends directly from claim 17) are both **silent** regarding the argued limitation of "**determining a destination based on answers to a series of questions**" (App. Br. 24), which is applicable to independent claim 1 (and claim 15 also rejected under rejection D), but not to independent claim 17 and claim 18 which depends thereon. Therefore, for the same reasons discussed above regarding rejection A of independent claim 17, we **sustain** the Examiner's rejection D of dependent claim 18.

Reply Brief

As pertaining to affirmed rejection A of claims 17 and 19, and affirmed rejection D of claim 18, to the extent Appellant advances new arguments in the Reply Brief 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 Examiner's Answer will not be considered except for good cause. *See* 37 C.F.R. § 41.41(b)(2).

DECISION [2]

We reverse the Examiner's decision rejecting claims 1–16 and 20 under pre-AIA 35 U.S.C. § 103(a).

We affirm the Examiner's decision rejecting claims 17–19 under pre-AIA 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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED-IN-PART

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[2] In the event of further prosecution, we leave it to the Examiner to consider whether claims 1–20 should be rejected under 35 U.S.C. § 101, to the extent these claims could be performed as mental steps by a human, albeit with the aid of pen and paper. *See CyberSource Corp. v. Retail Decisions, Inc.,* 654 F.3d 1366, 1375 (Fed. Cir. 2011) ("That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*"). "[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101." *CyberSource,* 654 F.3d at 1373. Moreover, "the mere recitation of a generic computer cannot transform a patent ineligible abstract idea into a patent-eligible invention." *See Alice Corp. Pty. Ltd. v. CLS Bank Int'l,* 134 S.Ct. 2347, 2358 (2014). Although the Board is authorized to reject claims under 37 C.F.R. §41.50(b), no inference should be drawn when the Board elects not to do so. *See* Manual of Patent Examining Procedure (MPEP) §1213.02.