



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

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/632,780 12/07/2009 Zhihua Fang ZFG-10202/29 4453

25006 7590 03/01/2018
DINSMORE & SHOHL LLP
900 Wilshire Drive
Suite 300
TROY, MI 48084

EXAMINER

FU, HAO

ART UNIT PAPER NUMBER

3693

NOTIFICATION DATE DELIVERY MODE

03/01/2018

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):

MichiganPatTM@dinsmore.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ZHIHUA FANG

Appeal 2016-008176¹
Application 12/632,780
Technology Center 3600

Before MURRIEL E. CRAWFORD, MICHAEL W. KIM, and
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 21–40. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6.

The invention relates generally to “recording, sharing, and storing data and materials for selective retrieval.” Spec. ¶ 2.

¹ The Appellant identifies the inventor, Zhihua Fang, as the real party in interest. Appeal Br. 1.

Claim 21 is illustrative:

21. A method of storing personal information and materials on a long-term basis for later retrieval and use, the method comprising the steps of:

providing a computer network in communication with a memory enabling individuals to contribute and store personal information in electronic form;

providing a storage facility enabling the individuals to contribute and store personal materials in non-electronic form;

establishing a financing plan in the form of an initial endowment and the resulting interest to ensure that the personal information and personal materials contributed by each individual will be stored on a permanent basis;

wherein the personal information at least includes documentary information and audio/visual information submitted in electronic form; and

wherein the personal materials includes physical artifacts chosen by an individual and one or more biological samples taken from the individual.

Claims 21–40 are rejected under 35 U.S.C. § 101 as reciting ineligible subject matter in the form of an abstract idea.

Claims 21–24, 26, 27, 30–34², 37, 39, and 40 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kane (US 2008/0086475 A1, pub. Apr. 10, 2008), Julie L. Williams, “Conditional Approval #479” to Scott Anderson from the Comptroller of the Currency, Administrator of National Banks, Washington, D.C., Sept. 2001 (hereinafter “Anderson”), Zylberberg et al. (US 2008/0274459 A1, pub. Nov. 6, 2008), and Slay et al. (US 2005/0228732 A1, pub. Oct. 13, 2005).

² We treat the Examiner’s inclusion of claim 35 in the rejection over Kant, Anderson, Zylberberg, and Slay, even though the claim is actually addressed in a rejection that relies additionally on Official Notice, as inadvertent error. *See* Final Act. 16.

Claims 25, 35, 36, and 38 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kane, Anderson, Zylberberg, Slay, and Official Notice.

Claims 28 and 29 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kane, Anderson, Zylberberg, Slay, and Toda (US 2010/0054566 A1, pub. Mar. 4, 2010).

We AFFIRM-IN-PART.

ANALYSIS

Rejection under 35 U.S.C. § 101

We are persuaded by the Appellant's argument that storing physical materials is not an abstract idea. Appeal Br. 2; *see also* Reply Br. 2 (“how can storing *physical artifacts* be *abstract*?”).

The Examiner argues that the “claims merely recite the action of providing a space for storing user's physical materials. The action of providing a space is intangible.” Answer 5.

However, in contrast with the Examiner's assertion, independent claim 21 recites “providing a storage facility enabling the individuals to contribute and store personal materials” where the materials include “physical artifacts chosen by an individual and one or more biological samples taken from the individual.” A storage facility that stores physical artifacts and biological samples which can be touched and generally perceived by the senses is a tangible object, and, thus, not an abstract idea. Even a storage facility that is merely space, as suggested by the Examiner, can be perceived, and is tangible also.

For this reason, we do not sustain the rejection of claim 21 as abstract under 35 U.S.C. § 101. We also do not sustain the rejection of claims 22–40 that depend from claim 21 and were rejected along with claim 21.

Rejection of Claims 21, 22, 26, 27, 30–32, 34, 39, and 40 under 35 U.S.C. § 103(a)

We are unpersuaded by the Appellant’s argument that the prior art, Kane, Anderson, Zylberberg and Slay, “are *unrelated*,” because they each do not concern problems disclosed in the other references. Appeal Br. 6; *see also* Reply Br. 4.

Whether a reference in the prior art is “analogous” is a fact question. *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992) (citing *Panduit Corp. v. Dennison Mfg.*, 810 F.2d 1561, 1568 n.9 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987)). Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *Id.* (citing *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979)). “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *In re Clay*, 966 F.2d at 659.

Kane is directed to “an internet website that can be used to store a user’s memories.” Kane ¶ 2. Kane, thus, is in the same field of endeavor as “providing a computer network in communication with a memory enabling

individuals to contribute and store personal information in electronic form,” as claimed.

Anderson is directed to storage of electronic materials, similar to Kane, and recognizes that banks have long stored tangible materials such as documents and other items in safe deposit boxes. Anderson 8, 10.

Anderson, thus, is in the same field of endeavor as “providing a storage facility enabling the individuals to contribute and store personal materials in non-electronic form,” as claimed.

Zylberberg is directed to “storing biological materials.” Zylberberg ¶ 2. Zylberberg, thus, is in the same field of endeavor as storing “biological samples taken from the individual,” as claimed.

Slay is directed to environmental projects to “locate suitable real property, develop it into a wildlife habitat, and maintain it for perpetuity” using an endowment.” Slay ¶ 16. Slay is, thus, directed to providing perpetual financing for real property projects, and, thus, is in the same field of endeavor as financing projects on a “permanent basis,” as claimed.

Therefore, each of the references is in the same field of endeavor as the corresponding aspect of the claimed invention. The four references are analogous art to the claimed invention.

The Appellant essentially argues that the combination of Kane, Anderson, and Zylberberg is in error, because if Kane’s web site were modified to store personal artifacts and biologic samples, the result would not be predictable. Appeal Br. 6.

We are not persuaded by the Appellant’s argument. The rejection does not depend on any modification to Kane’s web site, but instead merely combines Kane’s storage for electronic materials, with Anderson’s storage

for personal artifacts in safe deposit boxes, and Zylberberg's storage of biologic samples. Final Act. 11–12. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). A prima facie conclusion of obviousness may be supported by a showing that the claims are directed to a process, machine, manufacture, or composition of matter already known in the prior art that is altered by the mere substitution of one element for another known in the field, and such modification yields a predictable result. *Id.* (citing *United States v. Adams*, 383 U.S. 39, 40 (1966)).

Here, when combining three types of storage for three types of materials, each storage facility after combination would continue to store materials of the same type stored after combination as before, with predictable results, because none of the storage facilities would need to change for the type of storage they are used for. For example, Kane's web site would continue to store electronic data, Anderson's safe deposit box would continue to store artifacts, and Zylberberg's facility would continue to store biologic samples, each without the need for modification. This is consistent with the arrangement envisioned by the Appellant, where electronic storage, physical artifact storage, and biologic sample storage are addressed with separate types of facilities. *See Spec.* ¶ 26 (§§ 3.1.4–3.1.6).

The Appellant also essentially argues that the introduction of Slay to the combination of Kane, Anderson, and Zylberberg is not suggested by Kane, which has no financing plan, and there is no reason for the combination except one gained only from impermissible hindsight. Appeal Br. 7; *see also* Reply Br. 4–5.

We do not agree with the Appellant. In *KSR*, the Supreme Court further stated that “[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR* at 417. When considering obviousness of a combination of known elements, the operative question is thus “whether the improvement is more than the predictable use of prior-art elements according to their established functions.” *Id.*

We agree with the Examiner that it would have been within the skill of the ordinary artisan to substitute Slay’s financing method, using an initial endowment with generated interest (Final Act. 12 (citing Slay ¶¶ 13, 34)), for Kane’s monthly fee (*id.* citing Kane ¶ 41), where Slay’s financing method would work just as well, after substitution, for the combined storage facilities as for environmental remediation projects, before the substitution. We are persuaded that Slay’s method of funding a project would have been recognized by the ordinary artisan as being able to be predictably applied to many other types of projects, to provide long-term funding beyond a reliance on month-to-month subscriptions disclosed in Kane. “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR* at 421.

For these reasons, the Appellant has not demonstrated legal error by the Examiner in the rejection of claim 21 under 35 U.S.C. § 103(a), nor of dependent claims 22, 26, 27, 30–32, 34, 39, and 40 that were not argued separately. For this reason, we sustain the rejection of claims 21, 22, 26, 27, 30–32, 34, 39, and 40 under 35 U.S.C. § 103(a).

Rejection of Claim 23 under 35 U.S.C. § 103(a)

Dependent claim 23 recites “wherein the physical artifacts and biological samples are stored in secure, locked-down, fire-proof, and earthquake-resistant facilities.”

In rejecting claim 23, the Examiner cites to Anderson, page 10, and Zylberberg, paragraphs 4, 8, and 16. Final Act. 13.

We are not persuaded by the Appellant’s argument that “the Examiner has presented no factual evidence that a person of skill in the art ‘would know that nationals [sic] banks typically have vaults that are secure, locked-down, fire-proof, and earthquake resistant.’” Appeal Br. 7. The ordinary artisan would understand from Anderson’s national bank safe deposit box “safekeeping of physical items” (Anderson 10), and Zylberberg’s storage in “preserving environment[s]” (Zylberberg ¶ 4) that these environments would need to be resistant to perils such as theft, earthquake, and fire to keep items safe and preserved over time. The teaching in the prior reference need not be *ipsissimis verbis*. *Structural Rubber Products Co. v. Park Rubber Co.*, 749 F. 2d 707, 716 (Fed. Cir. 1984).

The Appellant has failed to establish error in the Examiner’s rejection, and for this reason we sustain the rejection of claim 23 under 35 U.S.C. § 103(a).

Rejection of Claim 24 under 35 U.S.C. § 103(a)

Dependent claim 24 recites

the step of segmenting the personal information or personal materials into a plurality of categories, including:

- 1) public sharing;
- 2) sharing only within circles of family, friends, or other community as specified by an individual; and

3) private, to be shared only by the individual who contributed the information or materials or executors authorized by an individual through legal agreement.

We are persuaded by the Appellant's arguments that the Examiner has not supported adequately that the claim language is disclosed in the cited references, because Kane does not disclose all the recited categories, and the passing references, on page 13 of the Final Action, to "Google Plus and Facebook" are inadequate. Appeal Br. 7–8.

In describing the categorization of data, the Specification describes a number of different arrangements between public, shared, and private categories. For example, Section 3.1.1 describes "1) Public, 2) Access Only for Families and Friends and Communities, and 3) Private." Spec. ¶ 26. Another section clarifies that "some Immordata data can be shared with the public; some may be shared only with families, friends, or authorized legal entities; but some will be private to the individuals only." *Id.* ¶ 28. Here "authorized legal entities" are considered to be part of the shared category but not the "private" category. Original claim 20 recites a third arrangement, providing:

a public category, which is open to any public viewing by a person who has a way to view said physical artifacts and biological data and materials, and a communal category, which is open to a person who has to obtain permission from a community to view or use said physical artifacts and biological data and materials, and a private category, which is to be accessed only by said customer and executors authorized by said customer.

Spec., Claims Appendix. Here, the shared category is controlled by permission from a "community," not the individual user, and the private category has a specific description of "executors authorized by said

customer,” which varies from “authorized legal entities” in the shared category in paragraph 28.

We can infer from these varying arrangements of access categories that the Appellant intended to clearly define the three claimed categories of access permission, not to broadly define “segmenting . . . by different categories of users” or “different security level[s],” as asserted by the Examiner. Answer 11.

Kane discloses public and private categories of access, but these do not correspond to the specific claimed categories, at least because there is no corresponding “shared” category between public and private, and no disclosure of where an “executor” falls. *See Kane* ¶¶ 18, 21 *cited at* Final Act. 13; Answer 11. The Examiner’s sweeping assertion (Final Act. 13; Answer 11) that “Google Plus and Facebook both provide this feature”³ is unsupported by the evidence of record.

For these reasons, the Examiner has failed to support adequately the conclusion of obviousness of claim 24. For this reason, we do not sustain the rejection of claim 24 under 35 U.S.C. § 103(a).

Rejection of Claim 33 under 35 U.S.C. § 103(a)

We are not persuaded by the Appellant’s argument that “Kane makes no mention of a ‘family tree.’” Appeal Br. 7.

The Examiner finds that Kane discloses a family tree at paragraph 37, which discloses “a family can start a family tree through its memory web page, uploading its memory assets each year, so that future generations of

³ In addition, we are of the understanding that Google+ came into public use approximately two years after the filing date of the instant application, which would mean this reference may not qualify as prior art.

that family can look back and see their long line of relatives and witness their experiences and interests.” Final Act. 15 (citing Kane ¶ 37).

Because Kane clearly meets the claim language, we sustain the rejection of claim 37 under 35 U.S.C. § 103(a).

Rejection of Claim 37 under 35 U.S.C. § 103(a)

Dependent claim 37 recites “the step of using the personal information from a plurality of individuals to establish a community or country.”

We are unpersuaded by the Appellant’s argument that “Kane does not teach or suggest the limitations of Appellant's claim 37, in [0036] or Figure 8.” Appeal Br. 8.

Where an Appellant’s remarks do not point to any specific language within the claims to distinguish over the prior art, those remarks amount to a general allegation that the claims define a patentable invention. Such allegations will not be considered an argument for separate patentability. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

In addition, the Examiner indicates that the Final Action “misquoted the paragraph number,” because instead paragraph 37 discloses using personal information to form communities. Answer 12. Kane discloses using stored information to form communities in the forms of “future generations of that family,” and a “group of high school friends” that shared common experiences. Kane ¶ 37. The Appellant does not refute this evidence in the Reply Brief.

For these reasons, we sustain the rejection of claim 37 under 35 U.S.C. § 103(a).

Rejection of Claims 25, 35, 36, and 38 under 35 U.S.C. § 103(a)

Each of claims 25, 35, 36, and 38 were rejected over Kane, Anderson, Zylberberg, and Slay, with the additional citation to separate findings of Official Notice for each claim. *See* Final Act. 16–17.

The Appellant articulates that “Appellant traverses all such reliance on the basis that the materials noticed by the Examiner in this case are not common or well-known in the instant, relevant art.” Appeal Br. 8. For each finding of Official Notice, the Appellant argues the Examiner “has provided no evidence.” *Id.* 8–9.

To adequately traverse the taking of Official Notice, which itself is a form of evidence, an applicant must come forth with information or argument that, on its face, casts reasonable doubt regarding the justification of the Official Notice. *See In re Boon*, 439 F.2d 724, 728 (CCPA 1971) (explaining that an applicant has the right to challenge the official notice and demand production of evidence in support thereof, provided such challenge is accompanied by adequate information or argument that, on its face, creates a reasonable doubt regarding the circumstances justifying the official notice); *see also* MPEP § 2144.03. Merely stating disagreement with the Examiner’s conclusions, as the Appellant did here, does not rise to the level of a traversal of Official Notice.

Because the Appellant has not adequately traversed the Examiner’s taking of Official Notice, the facts of which the Examiner took Official Notice are admitted prior art. *See In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970) (where an applicant for a patent has failed to challenge a fact officially noticed by the Examiner, and it is clear that the applicant has been

amply apprised of such finding so as to have the opportunity to make such challenge, the Examiner's finding shall be considered conclusive).

For this reason, we sustain the Examiner's rejection of claims 25, 35, 36, and 38 under 35 U.S.C. § 103(a).

Rejection of Claims 28 and 29 under 35 U.S.C. § 103(a)

Dependent claim 28 recites “wherein the documentary information or audio/visual information submitted by an individual in electronic form includes the medical records of that individual.” Dependent claim 29 recites “wherein the documentary information or audio/visual information submitted by an individual in electronic form includes medical imagery.”

Claims 28 and 29, thus, limit the nature or meaning of the electronic content that is stored.

The Appellant argues error because Toda, cited by the Examiner as disclosing medical records and imagery, is “unrelated” to the other cited references.

We are not persuaded by the Appellant's argument. Toda is directed to “a medical image management apparatus for storing and managing the medical image data.” Toda ¶ 1. We find that this is in the same field of endeavor as storing “medical records” and “medical imagery,” as claimed. Toda, therefore, is analogous art to the claimed invention.

For this reason, we sustain the rejection of claims 28 and 29 under 35 U.S.C. § 103(a).

DECISION

We reverse the rejection of claims 21–40 under 35 U.S.C. § 101.

We affirm the rejections of claims 21–23 and 25–40 under 35 U.S.C. § 103(a).

Appeal 2016-008176
Application 12/632,780

We reverse the rejection of claim 24 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-IN-PART