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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARC DEVINCENT

Appeal 2017-000612
Application 12/780,762¹
Technology Center 3600

Before MICHAEL C. ASTORINO, CYNTHIA L. MURPHY, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 4–9, 11, 13, 16, 17, and 20–24. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

¹ The Appellant identifies Marc DeVincent as the real party in interest. Appeal Br. 3.

ILLUSTRATIVE CLAIM

4. A method of manufacturing a book encompassing a customized life story comprising the steps of:

presenting to a subject specific pre-determined interview questions;

electronically recording on a recording device the oral responses of the subject to said specific interview questions;

a computer converting said electronically recorded oral responses of the subject into a transcription;

the computer capturing one or more physical items into one or more electronic images;

automatically organizing, using a computer, said transcription and said electronic images into a draft manuscript;

providing the draft manuscript to the subject for review by the subject;

receiving editorial changes to said draft manuscript from the subject for use in creating a final manuscript;

choosing one of said electronic images for use on a cover or dust jacket; and

printing at least one physical copy of the final manuscript as a physical book.

CITED REFERENCES

The Examiner relies upon the following references:

Schlutius	US 2002/0136601 A1	Sept. 26, 2002
Campagna et al. (hereinafter "Campagna")	US 2009/0254802 A1	Oct. 8, 2009
Geldner et al. (hereinafter "Geldner")	WO 2003/071775 A2	Aug. 28, 2003

REJECTIONS²

I. Claims 4–9, 11, and 20–24 are rejected under 35 U.S.C. § 112 (pre-AIA), second paragraph, for failing to particularly point out and distinctly claim the subject matter regarded as the invention.³

II. Claims 4–9, 11, 13, 16, 17, and 20–24 are rejected under 35 U.S.C. § 101 as ineligible subject matter.

III. Claims 4, 5, 7–9, 11, 13, 16, 17 and 20–22, and 24 are rejected under 35 U.S.C. § 103(a) as unpatentable over Geldner and Campagna.

IV. Claims 6 and 23 are rejected under 35 U.S.C. § 103(a) as unpatentable over Geldner, Campagna, and Schlutius.

FINDINGS OF FACT

The findings of fact relied upon, which are supported by a preponderance of the evidence, appear in the following Analysis.

² In addition to the enumerated rejections, the Final Office Action (page 6) also rejects independent claims 9, 13, and 17 under 35 U.S.C. § 112 (pre-AIA), first paragraph, for failing to comply with the written description requirement. This rejection is withdrawn. *See* Answer 2–3. The pre-AIA version of 35 U.S.C. § 112 applies to this Appeal, because the filing date of the associated application predates the effective date of Section 4(c) of the Leahy-Smith America Invents Act (AIA) (September 16, 2012) (re-designating 35 U.S.C. § 112, ¶ 2, as 35 U.S.C. § 112(b)).

³ In regard to the rejection under 35 U.S.C. § 112 (pre-AIA), second paragraph, the Final Office Action (page 7) refers to only claims 4, 9, and 21. Because claims 4, 9, and 21 are independent claims, the rejection also applies to their associated dependent claims 5–8, 11, 20, and 22–24. *See* Answer 2.

ANALYSIS

Indefiniteness

The Appeal Brief does not address the rejection under 35 U.S.C. § 112 (pre-AIA), second paragraph. *See* Final Action 7; *see also* Answer 2. Accordingly, we summarily sustain the rejection of claims 4–9, 11, and 20–24 under 35 U.S.C. § 112 (pre-AIA), second paragraph, for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

Subject-Matter Eligibility

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. Yet, subject matter belonging to any of the statutory categories may, nevertheless, be ineligible for patenting. The Supreme Court has interpreted § 101 to exclude laws of nature, natural phenomena, and abstract ideas, because they are regarded as the basic tools of scientific and technological work, such that including them within the domain of patent protection would risk inhibiting future innovation premised upon them. *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013).

Of course, “[a]t some level, ‘all inventions . . . embody, use, reflect, rest upon, or apply’” these basic tools of scientific and technological work. *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (internal citation omitted). Accordingly, evaluating ineligible subject matter, under this judicial exclusion, involves a two-step framework for “distinguish[ing] between patents that claim the buildin[g] block[s] of human ingenuity and those that integrate the building blocks into something more, thereby

transform[ing] them into a patent-eligible invention.” *Id.* (internal quotation marks and citation omitted). The first step determines whether the claim is directed to judicially excluded subject matter (such as a so-called “abstract idea”); the second step determines whether there are any “additional elements” recited in the claim that (either individually or as an “ordered combination”) amount to “significantly more” than the identified judicially excepted subject matter itself. *Id.* at 2355.

As to the first step of the *Alice* framework, the Examiner states, in the Final Office Action:

The claim(s) is/are directed to recording/storing, organizing, receiving and retrieving information . . . printing and providing the information (book) . . ., which is a set of methods for collecting, comparing and storing information, then transmitting and generally communicating and providing the information (via printing or delivering). Examiner asserts that the particular steps involved . . . recording/storing, organizing, receiving and retrieving information . . . printing and providing the information (book) for a customized life story are based on a series of data collections (accumulation of inputs — audio and electronic) organizing and transmitting/providing/printing the retrieved (book) information obtained from the database are drawn to an abstract idea.

Final Action 7–8. The Examiner provides a revised description, in the Answer, stating that the claims in the Appeal “are directed to an abstract idea” — specifically, “[t]he claims are directed to a method of manufacturing a book encompassing a customized life story.” Answer 4.

As the Appellant argues (*see* Appeal Br. 13–14; *see also* Reply Br. 3), the Examiner has not identified a concept, to which any of the claims (considered as a whole) is directed, that has the character of a basic tool of scientific or technological work, or that is otherwise within the various types

of fundamental concepts that courts have categorized as abstract ideas. Indeed, “[t]he ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)). Although the Examiner states, for example, that “[t]he claims are directed to a method of manufacturing a book encompassing a customized life story” (Answer 4), the Examiner does not articulate why this might describe a patent-ineligible abstract idea. In the first step of the *Alice* analysis, “[i]t is not enough, however, to merely trace the invention to some real-world analogy.” *Data Engine Techs. LLC v. Google LLC*, 906 F.3d 999, 1011 (Fed. Cir. 2018).

In view of the foregoing, we are persuaded that the Examiner has not adequately shown that the claims are directed to judicially excluded subject matter, under the first step of the *Alice* framework. Accordingly, we do not address the second *Alice* step. See *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016). We do not sustain the rejection of claims 4–9, 11, 13, 16, 17, and 20–24 under 35 U.S.C. § 101

Obviousness

The Appellant contends, among other arguments, that the Examiner erred in rejecting independent claim 4 as obvious, because the cited prior art fails to teach or suggest the claim limitation of “a computer converting said electronically recorded oral responses of the subject into a transcription.” See Appeal Br. 22–23. With regard to the Geldner reference, the Appellant argues:

Nowhere does the reference actually teach that audio is transcribed (i.e., converted into textual information), and in fact since the reference is primarily directed at producing a multi-media presentation, the final result would remain as audio in order to support the desired final product, which is not textual. Nowhere does the reference suggest transcribing any of the recorded audio.

Id. at 23 (emphasis added).

In response, the Examiner states that such “convert[ing] into textual information,” as indicated by the Appellant, is not claimed and that the recited “converting . . . into a transcription” is met by Geldner’s disclosure of “asking the interviewee the interview questions, and recording of the (audio) interview on a first storage medium and transferring to a computer workstation for production.” Answer 11 (citing Geldner, page 2, last paragraph). *See also* Final Action 16 (citing Geldner Abstract and page 2, first paragraph).

The Appellant’s argument turns on the construction of the claim term “transcription” — in particular, whether the claimed “transcription” is a text version (in this instance, of the “electronically recorded oral responses”). *See* Appeal Br. 23; *see also* Reply Br. 5.

“During examination, ‘claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read 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) (quoting *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)). As the Federal Circuit has explained:

The correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification is not whether the specification proscribes or precludes some broad

reading of the claim term adopted by the examiner. And it is not simply an interpretation that is not inconsistent with the specification. It is an interpretation that corresponds with what and how the inventor describes his invention in the specification, *i.e.*, an interpretation that is “consistent with the specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (citation and internal quotation marks omitted); *see also In re Suitco Surface*, 603 F.3d 1255, 1259–60 (Fed. Cir. 2010).

In re Smith Int’l, Inc., 871 F.3d 1375, 1382–83 (Fed. Cir. 2017).

Sources for claim construction may include intrinsic sources (such as the claims, the Specification, and the cited references), as well as extrinsic sources (such as technical treatises and dictionaries). *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582–84 & n.6 (Fed. Cir. 1996). Yet, “there is no magic formula or catechism for conducting claim construction,” nor is there any requirement to “consider[] any particular sources” or to “analyze sources in any specific sequence, as long as those sources are not used to contradict claim meaning that is unambiguous in light of the intrinsic evidence.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1324 (Fed. Cir. 2005) (*en banc*). Prior art references considered by the Examiner, during the prosecution of a patent application, constitute intrinsic evidence that is available to aid in the construction of claim terms. *See V-Formation, Inc. v. Benetton Grp. SpA*, 401 F.3d 1307, 1311–12 (Fed. Cir. 2005) (construing claim language, in view of a prior art reference that was of record in the prosecution of the patent-in-suit and that employs the term at issue).

Here, the Specification sheds significant light on the claim construction issue. Paragraph 8 refers to “transcribing the interview (manually or automatically)” and, ultimately, “printing a final manuscript

and video end product,” which suggests textual/printable content. Spec. ¶ 8.

Further, paragraph 19 states:

After the interview, the preparer transcribes the interview. The transcription can be manual (by interviewer), by another person (outsourced), or by means of digital voice software recognition systems. The transcription is edited, arranged into chronological or other order, and separated into sections/chapters.

Id. ¶ 19. The reference to “digital voice software recognition systems,” above, suggests converting the vocal record to text. Indeed, paragraphs 21 and 24 refer to a “text based and video based” product and a “final printed version.” Further, the flow chart of Figure 1 includes the step of “Audio” becoming “Text.” *Id.* Fig. 1.

The Specification’s sense of “transcription” — meaning a textual version — is reinforced by other intrinsic evidence found in the prior art of record. In particular, Liaguno⁴ discusses speech-recognition technology and “transcription”:

As speech analysis technology improves to the point where speech recognition-to-text conversion operator produces no gaps, and enjoys an accuracy compatible with that produced by a human transcriber, the transcription text will become superfluous, and any portion of the video can be located by a free text search of the converted voice-text file.

Liaguno, col. 13, ll. 2–8. Liaguno refers to the conversion of voiced speech into a textual “transcription.”

⁴ Liaguno et al. (US 5,729,741, iss. Mar. 17, 1998) (“Liaguno”) was cited on an Information Disclosure Statement received by the Office on April 11, 2011.

In view of the evidence in the above-identified sources, we conclude that “transcription,” recited in claim 4, refers to a text version of the “electronically recorded oral responses.”

The cited portions of the Geldner reference, identified above, do not teach or suggest “converting said electronically recorded oral responses” into a text version thereof, as claim 4 requires, under our construction. Accordingly, we are persuaded of error in the rejection of independent claim 4, as well as the other independent claims involved in the present Appeal (claims 9, 13, 17, and 21), each of which contains a similar “transcription” limitation.

In view of the foregoing, we do not sustain the rejection of claims 4–9, 11, 13, 16, 17, and 20–24 under 35 U.S.C. § 103(a).

DECISION

We summarily AFFIRM the Examiner’s decision rejecting claims the rejection of claims 4–9, 11, and 20–24 under 35 U.S.C. § 112 (pre-AIA), second paragraph.

We REVERSE the Examiner’s decision rejecting claims 4–9, 11, 13, 16, 17, and 20–24 under 35 U.S.C. § 101.

We REVERSE the Examiner’s decision rejecting claims 4–9, 11, 13, 16, 17, and 20–24 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).

AFFIRMED-IN-PART