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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CARL A. BRAAM and DAVID M. OGLE

Appeal 2017-010073¹
Application 14/862,521²
Technology Center 2400

Before MICHAEL W. KIM, NINA L. MEDLOCK, and
SCOTT C. MOORE, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 21–40. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Our decision references Appellants’ Appeal Brief (“App. Br.,” filed March 17, 2017) and Reply Brief (“Reply Br.,” filed July 24, 2017), and the Examiner’s Answer (“Ans.,” mailed May 26, 2017) and Final Office Action (“Final Act.,” mailed October 17, 2016).

² Appellants identify IBM Corporation as the real party in interest. App. Br. 1.

CLAIMED INVENTION

Appellants' claimed invention "relate[s] to instant messaging systems and, more particularly, to monitoring the usage of instant messaging applications" (Spec. ¶ 1).

Claims 21, 28, and 35, reproduced below, are the independent claims on appeal, and representative of the claimed subject matter:

21. A computer-implemented method, comprising:
 - selecting a participant in an instant messaging session between a plurality of participants;
 - weighting an identified attribute of the instant messaging session;
 - weighting an identified attribute of the selected participant; and
 - determining, based upon the weighted attributes of the instant messaging session and the selected participant, an instant messaging usage metric for the selected participant.

28. A computer hardware system, comprising:
 - at least one hardware processor configured to initiate the following executable operations:
 - selecting a participant in an instant messaging session between a plurality of participants;
 - weighting an identified attribute of the instant messaging session;
 - weighting an identified attribute of the selected participant; and
 - determining, based upon the weighted attributes of the instant messaging session and the selected participant, an instant messaging usage metric for the selected participant.

35. A computer program product, comprising:
a computer storage device having stored therein computer usable program code, the computer usable program code, which when executed by a computer hardware system, causes the computer hardware system to perform:
selecting a participant in an instant messaging session between a plurality of participants;
weighting an identified attribute of the instant messaging session;
weighting an identified attribute of the selected participant; and
determining, based upon the weighted attributes of the instant messaging session and the selected participant, an instant messaging usage metric for the selected participant.

REJECTIONS³

Claim 28 is rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter that Appellants regard as the invention.

Claims 21, 28, and 35 are rejected under 35 U.S.C. § 112, second paragraph, as incomplete for omitting essential steps.

Claims 21–25, 27–32, and 34–39 are rejected under 35 U.S.C. § 103(a) as unpatentable over Morris et al (US 2002/0046243 A1, pub. Apr. 18, 2002) (“Morris”) and Kirkland et al. (US 2005/0149622 A1, pub. July 7, 2005) (“Kirkland”).

³ The Final Office Action includes a provisional rejection of claims 21–40 on the ground of non-statutory obviousness-type double patenting as unpatentable over claims 1, 2, 6–9 of U.S. Patent No. 9,177,295 in view of Morris and Kirkland (Final Act. 7–8), and indicates that a timely filed terminal disclaimer may be used to overcome the provisional rejection (*id.* at 7). Appellants filed a Terminal Disclaimer on March 24, 2017. We understand that this rejection is not the subject of the present appeal.

Claims 26, 33, and 40 are rejected under 35 U.S.C. § 103(a) as unpatentable over Morris, Kirkland, and Williams (US 2004/0228277 A1, pub. Nov. 18, 2004).

ANALYSIS

Section 112, Second Paragraph

Independent Claim 28

In rejecting claim 28 under 35 U.S.C. § 112, second paragraph, the Examiner takes the position that claim 28 is indefinite because (1) the claim comprises only one element, i.e., a processor, and, therefore, “lacks sufficient structures to perform the plurality of functions”; and (2) “one element claim cannot rely on 112 6th paragraph or 112(f) to incorporate the structure from the specification”; therefore, “the BRI of this claim element extends to all ways of processing, those known and unknown to the inventor, and amounts to pure functional claiming without boundaries” (Final Act. 3–4).

The difficulty with the Examiner’s analysis is that the Examiner seemingly confuses the indefiniteness requirement of 35 U.S.C. § 112, second paragraph, with the enablement requirement of § 112, first paragraph, which is a separate requirement. Therefore, we do not sustain the Examiner’s rejection of claim 28 under 35 U.S.C. § 112, second paragraph.⁴

⁴ In the event of further prosecution, the Examiner may wish to consider whether it is appropriate to enter a rejection of claim 28 under 35 U.S.C. § 112, first paragraph, as a single means claim, which is non-enabling for the scope of the claim. *See* Manual of Patent Examining Procedure (“MPEP”) § 2164.08(a). *See also In re Hyatt*, 708 F.2d 712, 714-15 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held non-enabling for the scope of the

Independent Claims 21, 28, and 35

In rejecting claims 21, 28, and 35 under 35 U.S.C. § 112, second paragraph, as indefinite, the Examiner takes the position that the claims are incomplete (Final Act. 6). More particularly, the Examiner asserts that the claims omit certain essential steps, namely, “determining/identifying a weighting for each participant in the instant messaging session relative to the selected participant’s position”; “determining/identifying a relative position of each participant in the context of the IM session”; and “determining the usage metric based on the weighting of each participant” (Final Act. 6 (citing Manual of Patent Examining Procedure (“MPEP”) § 2172.01)) — steps that the Examiner maintains are needed because “the IM usage metric [cannot] be adequately determined without knowing who each of the participants in the IM session is and their relative position” (*id.*).

MPEP § 2172.01 states that “essential matter may include missing elements . . . *described by applicant(s) as necessary to practice the invention . . . [and] a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected*” under 35 U.S.C. § 112, second paragraph, as indefinite. *Id.* (emphasis added). MPEP § 2172.01 also references MPEP § 2164.08(c), which states that “[b]road language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.”

The Examiner points to paragraphs 36 and 40 of Appellants’ Specification as indicating the essential features (Ans. 12). Yet, we find no clear disclosure in those paragraphs that describes or defines the “omitted”

claim because the specification disclosed at most only those means known to the inventor).

steps as essential to the claimed invention. It also is significant here that paragraph 5 of the Specification, as well as the Abstract, includes broad language that omits the allegedly critical steps. *See* MPEP § 2164.08(c) (“Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.”).

We are persuaded that the Examiner erred in rejecting claims 21, 28, and 35 under 35 U.S.C. § 112, second paragraph. Therefore, we do not sustain the Examiner’s rejection.

Obviousness

Independent Claim 21 and Dependent Claims 22–25, and 27

We are persuaded by Appellants’ argument that the Examiner erred in rejecting independent claim 21 under 35 U.S.C. § 103(a) because Kirkland, on which the Examiner relies, does not disclose or suggest “weighting an identified attribute of the instant messaging session,” as recited in claim 21 (App. Br. 14–17).

Kirkland is directed to a method, apparatus, and computer instructions for filtering and prioritizing instant messaging threaded conversations in an instant messaging system based on thread content, and discloses that the instant messaging client analyzes an incoming message to determine the thread subject (Kirkland Abstract). Based on the thread subject analysis, the client determines the priority level associated with the incoming message; the message is then delivered and displayed to the recipient according to the priority level (*id.*). Kirkland discloses, in paragraphs 49–53 cited by the Examiner, that the priority level may be manually set by the message sender or recipient (*id.* ¶ 49). For example, Kirkland describes that a typical user currently working on business project, who also is expecting a message (i.e.,

a draft patent application) from the legal department, may configure his IM client to unconditionally accept messages regarding the project (priority 1), accept messages from the legal department but place them in a secondary window (priority 2), and queue personal messages (priority 3) for later delivery (*id.* ¶¶ 50–52). The system, thus, filters the threaded conversations, and displays them to the user according to content priority (*id.* ¶ 53).

The Examiner takes the position that the priority scheme disclosed in Kirkland, including the ability to change a priority level based on the relative importance of a sender or message, amounts to “weighting” an attribute, as called for in claim 21, notwithstanding that Kirkland does not use that term explicitly (*see* Final Act. 3–4; *see also* Ans. 13–16). We, however, agree with Appellants that setting a priority level is not the same as weighting an attribute, which is generally understood to involve emphasizing the contribution of some aspects of a phenomenon (or of a set of data) to a final effect or result, by giving those aspects more weight in the analysis (App. Br. 15–16). Kirkland plainly discloses changing a priority level. But, Kirkland does not disclose or suggesting “weighting” the priority level, as that term is generally understood.

For example, in the hypothetical equation $X = (A * Y) + (B * Z)$, Y and Z represent the underlying attributes and A and B represent the weighting. If $A = 1.0$ and $B = 1.1$, then attribute Z is being weighted more heavily in the analysis. Kirkland, however, merely describes changing Z, the underlying attribute — not weighting the attribute, as claimed.

Id. at 16.

Moreover, even accepting the Examiner’s position that the priority scheme, as disclosed in Kirkland, amounts to “weighting an attribute of the instant messaging session,” as called for in claim 21, we fail to see, and the

Examiner does not adequately explain, why a person of ordinary skill in the art would have had an apparent reason to modify the Morris system to incorporate the Kirkland priority scheme, i.e., to determine an instant messaging usage metric for a selected participant, as disclosed in Morris, based on the *combination* of the weighted attributes of the instant messaging session *and* the selected participant, as called for in claim 21. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (holding that a prima facie case of obviousness requires showing that one of ordinary skill in the art would have had both an apparent reason to modify the prior art and predictability or a reasonable expectation of success in doing so).

In view of the foregoing, we do not sustain the Examiner's rejection of claim 21 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the rejection of dependent claims 22–25 and 27. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

Independent Claims 28 and 35 and Dependent Claims 29–32, 34, and 36–39

Independent claims 28 and 35 include language substantially similar to the language of claim 21, and stand rejected based on the same rationale applied with respect to claim 21 (Final Act. 10–11). Therefore, we do not sustain the Examiner's rejection under 35 U.S.C. § 103(a) of independent claims 28 and 35, and claims 29–32, 34, and 36–39, which depend therefrom, for the same reasons set forth with respect to claim 21.

Dependent Claims 26, 33, and 40

Claims 26, 33, and 40 depend from independent claims 21, 28, and 35, respectively. The Examiner's rejection of these dependent claims based on Williams, in combination with Morris and Kirkland, does not cure the

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deficiency in the Examiner's rejection of independent claims 21, 28, and 35. Therefore, we do not sustain the Examiner's rejection under 35 U.S.C. § 103(a) of dependent claims 26, 33, and 40 for the same reasons set forth above with respect to the independent claims.

DECISION

The Examiner's rejections of claims 21, 28, and 35 under 35 U.S.C. § 112, second paragraph, are reversed.

The Examiner's rejections of claims 21–40 under 35 U.S.C. § 103(a) are reversed.

REVERSED