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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte OWEN O'SULLIVAN and FERNANDO J. SALAZAR

Appeal 2018-002677
Application 14/036,139
Technology Center 2100

Before JOHN A. JEFFERY, CARL L. SILVERMAN, and SCOTT E. BAIN, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants[1] appeal under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 1–8. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellants' invention organizes synchronous communication sessions by determining a context responsive to detecting a trigger event, such as the user moving or picking up a peripheral device. The context specifies a foreground application. Candidate participants, determined from the

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

context, are invited to access the synchronous communication responsive to user input in a user interface displayed separate from the foreground application. *See generally* Abstract; Spec. ¶¶ 29–30, 68–80; Figs. 1, 5.

Claim 1 is illustrative:

> 1. A method, comprising:
> determining, using a processor of a data processing system, a context responsive to detecting a trigger event, wherein the context specifies a foreground application executing within the data processing system;
> determining candidate participants from the context;
> displaying a user interface separate from the foreground application, wherein the user interface lists the candidate participants; and
> responsive to a user input received within the user interface, sending an invite to the candidate participants, wherein the invite specifies access information for a synchronous communication session.

RELATED APPEAL

This appeal is related to an appeal filed in connection with U.S. Application No. 14/024,709 (Appeal No. 2018-002660), which is a parent to the present continuation application.

THE REJECTIONS[2]

The Examiner provisionally rejected claims 1–8 on the ground of non-statutory double patenting over claims 1–16 of copending Application 14/024,709. Final Act. 2.

The Examiner rejected claims 1–3, 5, and 7 under 35 U.S.C. § 103 as unpatentable over Wyatt (US 2013/0031185 A1; published Jan. 31, 2013)

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[2] Because the Examiner indicates the claims 1–8 are provisionally rejected on the ground of non-statutory double patenting despite not including that rejection in the "Grounds of Rejection to be Reviewed on Appeal" section in the Answer, we nonetheless presume that this provisional rejection is

and Braun (US 2009/0289779 A1; published Nov. 26, 2009). Final Act. 3–8.[3]

The Examiner rejected claim 4 under 35 U.S.C. § 103 as unpatentable over Wyatt, Braun, and Hwang (US 2015/0160817 Al; published June 11, 2015). Final Act. 8–9.

The Examiner rejected claims 6 and 8 under 35 U.S.C. § 103 as unpatentable over Wyatt, Braun, and Chavez (US 2012/0221952 Al; published Aug. 30, 2012). Final Act. 10–12.

THE PROVISIONAL DOUBLE PATENTING REJECTION

Because Appellants do not contest the Examiner's provisional double patenting rejection of claims 1–8 (*see* Final Act. 2), we summarily sustain this rejection. *See* MPEP § 1205.02.

THE OBVIOUSNESS REJECTION OVER WYATT AND BRAUN

Regarding independent claim 1, the Examiner finds that Wyatt discloses, among other things, (1) determining, using a processor, candidate participants from a "context" (email thread of an email application); (2) displaying a user interface separate from a foreground application, where the user interface lists candidate participants; and (3) sending an invite to those

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maintained, for there is no indication in the Answer that it was withdrawn. *Compare* Final Act. 2 *with* Ans. 3 (maintaining every ground of rejection in the Final Office Action except those listed under a "WITHDRAWN REJECTIONS" subheading (which there are none)).

[3] Throughout this opinion, we refer to (1) the Final Rejection mailed February 7, 2017 ("Final Act."); (2) the Appeal Brief filed July 10, 2017 ("App. Br."); (3) the Examiner's Answer mailed November 16, 2017 ("Ans."); and (4) the Reply Brief filed January 15, 2018 ("Reply Br.").

participants responsive to user input received within the interface. Final Act. 3–5; Ans. 4–5. Although the Examiner acknowledges that Wyatt's system does not *necessarily* determine a context responsive to detecting a trigger event, where the context specifies a foreground application, the Examiner nonetheless cites Braun for teaching this feature in concluding that the claim would have been obvious. Final Act. 7–9.

Appellants argue that not only is the Examiner unclear as to exactly which particular element in Wyatt constitutes the recited "context," the Examiner's reliance on Braun for teaching determining the recited context responsive to detecting a trigger event is said to be misplaced. *See* App. Br. 8–15; Reply Br. 2–6. According to Appellants, Braun's "context" refers to effects that are to be generated by a force feedback device, where this context is stored in association with a particular application. App. Br. 14–19; Reply Br. 4–6. As such, Appellants contend, Braun's "context" is already determined before the event that invokes the context and, therefore, is not determined responsive to a trigger event as claimed. *Id.*

Appellants add that Wyatt and Braun are unrelated and, therefore, the Examiner's proposed reason to combine the references lacks a rational underpinning. App. Br. 17–19; Reply Br. 7–13. According to Appellants, it is unnecessary to prioritize applications in Wyatt because the conditions that require prioritizing in Braun, namely that different applications can be associated with a particular event that causes an effect in a force feedback device, are not present in Wyatt. App. Br. 17–18; Reply Br. 7–13. Appellants argue other recited limitations summarized below.

ISSUES

I. Under § 103, has the Examiner erred by finding that Wyatt and Braun collectively would have taught or suggested:

(1) determining, using a processor of a data processing system, a context responsive to detecting a trigger event, where the context specifies a foreground application as recited in claim 1?

(2) analyzing a digital asset open within the foreground application as recited in claim 2?

II. Is the Examiner's proposed combination of the cited references supported by articulated reasoning with some rational underpinning to justify the Examiner's obviousness conclusion?

ANALYSIS

Claims 1, 3, 5, and 7

We begin by construing the key disputed limitation of claim 1 which recites, in pertinent part, a "context." The Specification does not define the term "context," unlike other terms whose concrete definitions leave no doubt as to their meaning. *See, e.g.,* Spec. ¶¶ 23, 27, 87–90 (defining various terms). Although claim 1 recites that (1) the "context" specifies a foreground application[4] executing within a data processing system, and (2) candidate participants are determined from this "context," the claim does not further detail the particulars of this "context," let alone clarify its meaning.

[4] According to paragraph 33 of the Specification, an application that is currently active or "in focus" may be referred to as a "foreground application."

Turning to the Specification, paragraph 32 notes that client 105 in Figure 1 determines (1) a context specifying information for application 145, and (2) determines candidate participants from this context. But here again, this paragraph is short on specifics as to exactly what this "context" is. Paragraph 35 explains that a context is presumed to be "instructive" of (1) a particular issue that user 105 attempts to resolve, and (2) the particular candidate participants who may be needed to resolve the issue.

The Specification's paragraph 36 adds that the context of client 105 includes, *for example,* the foreground application, and *can* include any digital asset open therein or currently displayed by the foreground application. Paragraph 74 also describes the functionality of a "context agent" in Figure 5 that determines a context including a foreground application. Notably, this paragraph indicates, quite broadly, that the context *may* further include not only a digital asset that is open within the foreground application, but also "additional information." Our emphasis on the permissive and exemplary language in these passages underscores that despite informing our understanding of the recited "context," the term is not limited to these descriptions.

Given this non-limiting description, we see no error in the Examiner's reliance on Wyatt for at least suggesting a "context" that is associated with an email thread of an email application, and that candidate participants are determined from such a "context." Final Act. 3; Ans. 4–5. As shown in Wyatt's Figure 4, the graphical user interface (GUI) 300 shows an email thread 302 and a button 306 that allows a client to establish a synchronous communication with other clients associated with the thread. Wyatt ¶¶ 14–15. Notably, the option to establish a synchronous communication via

button 306 can be provided automatically *after* a select number of related emails are present. *See* Wyatt ¶ 15.

After button 306 is selected, the potential clients, shown in GUI 310 in Wyatt's Figure 5, are invited to participate in the synchronous communication by selecting the "Create" button 322. Wyatt ¶¶ 16–20. As shown in Wyatt's Figure 6, clients participating in the synchronous communication can view emails that were exported from the thread. Wyatt ¶ 20.

Given this functionality, we see no error in the Examiner's finding that Wyatt at least suggests determining a "context" associated with an email thread of an email application, namely the ability to export addresses associated with an email thread via button 306 in Figure 4 responsive to the presence of a select number of related emails in the mailbox (i.e., a detected "trigger event"). *See* Ans. 4–5 (citing Wyatt ¶ 15). That is, the select number of related emails in the mailbox would effectively trigger this context determination—a context associated with the application's ability to export email addresses via button 306 in Figure 4. That Wyatt's paragraph 15 indicates that the option to establish a synchronous communication via button 306 can be provided *automatically after* a select number of related emails are present is telling in this regard.

Although Wyatt at least suggests determining a context responsive to detecting a trigger event, and is, therefore, technically cumulative to Braun in that regard, we nonetheless see no error in the Examiner's reliance on Braun for at least suggesting the recited context determination. Not only does Braun teach triggering events when a graphical object moves over a window's close box in paragraph 125, but also assigns priority to an active

or foreground application so that it receives event notifications in paragraph 128. Given these teachings in light of Wyatt's functionality, we see no error in the Examiner's finding that the proposed combination would allow a trigger to occur to first analyze *system* context, and if an email application was active and open based on this analysis, to then further analyze *email* context to initiate synchronous communication with other users as the Examiner indicates. Ans. 12–13.

To be sure, unlike Wyatt, Braun's "context" refers to effects that are generated by a force feedback device, where this context is stored in association with a particular application. *See* Braun ¶¶ 93–95; Fig. 4. In that sense, then, Braun's "context" is determined before the event that invokes the context and, therefore, is not determined responsive to a trigger event as Appellants indicate. App. Br. 8–14; Reply Br. 3–6. But as noted above, the Examiner relies on a *different* context in Braun, namely the *system* context that determines whether applications are active and open to prioritize those applications in paragraph 128. *See* Ans. 16–17. Given this teaching, we see no reason why such a system context determination could not be made in Wyatt's system, particularly given Wyatt's multiple applications in the client system in Figure 2, and associated GUIs shown in Figures 4 to 6 as the Examiner indicates. *See* Ans. 10.

To the extent that Appellants contend that the Examiner proposes to somehow incorporate Braun's force feedback device into Wyatt (*see* App. Br. 19), we disagree. Rather, as noted above, the Examiner's proposed combination is not based on such bodily incorporation, but rather the references' collective teachings and suggestions. It is well settled that "a determination of obviousness based on teachings from multiple references

does not require an actual, physical substitution of elements." *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012) (citations omitted). Nor is the test for obviousness whether a secondary reference's features can be bodily incorporated into the structure of the primary reference. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *Id.* And here, the Examiner's proposed combination predictably uses prior art elements according to their established functions to yield a predictable result. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007). Accordingly, the Examiner's proposed combination of the cited references is supported by articulated reasoning with some rational underpinning to justify the Examiner's obviousness conclusion.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 1, and claims 3, 5, and 7 not argued separately with particularity.

Claim 2

We also sustain the Examiner's rejection of claim 2 reciting that determining candidate participants from the context comprises analyzing a digital asset open within the foreground application. *See* Final Act. 7; Ans. 13.

Despite Appellants' arguments to the contrary (App. Br. 19–20; Reply Br. 13–14), Appellants do not persuasively rebut the Examiner's finding that upon detecting a trigger event, the Wyatt/Braun system would first analyze *system* context, and if an email application was active and open based on this analysis, then further analyze *email* context to initiate synchronous communication with other users. Ans. 13. Even assuming, without

deciding, that email applications need not be active to receive email as Appellants contend (Reply Br. 13–14), the Examiner's finding in this regard is not based solely on receiving email, but *analyzing* the email's associated context. *See* Ans. 13. Performing this analysis on an active and open email application as the Examiner proposes would have been at least an obvious variation. To the extent that Appellants contend otherwise, there is no persuasive evidence on this record to substantiate such a contention.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 2.

THE OTHER OBVIOUSNESS REJECTIONS

We also sustain the Examiner's obviousness rejections of claims 4, 6, and 8. Final Act. 8–12. Because these rejections are not argued separately with particularity, we are not persuaded of error in these rejections for the reasons previously discussed.

CONCLUSION

The Examiner did not err in rejecting claims 1–8 under § 103. Nor did the Examiner err in provisionally rejecting those claims on the ground of non-statutory double patenting.

DECISION

We affirm the Examiner's decision to reject claims 1–8.

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