



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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/078,855	11/13/2013	Satoshi KIRA	AC-723-3883	7650
27562	7590	10/31/2019	EXAMINER	
NIXON & VANDERHYE, P.C. 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			ABAZA, AYMAN A	
			ART UNIT	PAPER NUMBER
			2486	
			NOTIFICATION DATE	DELIVERY MODE
			10/31/2019	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):

PTOMAIL@nixonvan.com
pair_nixon@firsttofile.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SATOSHI KIRA, AKIHIRO UMEHARA
and TOSHIAKI SUZUKI

Appeal 2018-004613
Application 14/078,855
Technology Center 2400

Before: JENNIFER S. BISK, JUSTIN BUSCH, and
JASON J. CHUNG, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant¹ filed a paper under 37 C.F.R. § 41.52 requesting reconsideration of our July 23, 2019, Decision (“Dec.”) in which we entered a new ground of rejection for claims 1–10, 12–15, and 17–21 under 35 U.S.C. § 112(a) for lacking written description of the invention. Req. Reh’g 1–5. Appellant also requests reconsideration of our Decision affirming dependent claim 19. *Id.* at 6–7.

For the reasons stated below, however, we deny the request to modify our Decision.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. According to Appellant, Nintendo Co., Ltd. is the real party in interest. Appeal Br. 3.

APPLICABLE REQUEST FOR REHEARING RULES

Appellant “may file a single request for rehearing within two months of the date of the original decision of the Board.” 37 C.F.R. § 41.52(a)(1). “Arguments not raised, and Evidence not previously relied upon . . . are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) through (a)(4).” *Id.* Permitted new arguments are limited to: (a) new arguments based upon a recent relevant decision of either the Board or a Federal Court; (b) new arguments responding to a new ground of rejection designated pursuant to § 41.50(b); or (c) new arguments that the Board’s decision contains an undesignated new ground of rejection. *See* 37 C.F.R. § 41.52(a)(2)–(4).

I. Appellant’s Argument and Our Analysis Pertaining To the New Grounds of Rejection

Appellant argues a person having ordinary skill in the art at the time of the invention (“PHOSITA”) would have understood that to track something is “to observe or plot the moving path of (something, such as a spacecraft or missile) often instrumentally” which is what paragraph 56, Figure 6, and the remainder of the Specification support, and the Decision overlooks. Req. Reh’g 3–5 (citing <https://www.merriam-webster.com/dictionary/track>, retrieved Sept. 9, 2019). In addition, Appellant argues paragraph 56 shows a current point being moved and path point information is stored as a result of that movement and Figure 6 shows a path that goes from starting point Ps to end point Pg. Req. Reh’g 4–5. We disagree with Appellant.

As an initial matter, we note Appellant provides us a definition of “track.” For purposes of this rehearing Decision, we adopt Appellant’s definition of “track.” Moreover, claim 1 states:

track a target point that is moved, based on operation(s) performed by a user, over a map displayed on a display screen of the transmission-side apparatus, the target point being along a path from a first position of the map to a second position of the map.

Emphases added. Appellant refers to two sentences in paragraph 56 that state: “path point information on the current point (the starting point PS) at the time when the storage start instruction is performed is stored” and “[t]hen, path point information on a point that becomes a current point as a result of the current point (target point) being moved by a moving operation performed by the user, is stored.” Appellant also refers to Figure 6 to support track, which we reproduce below.

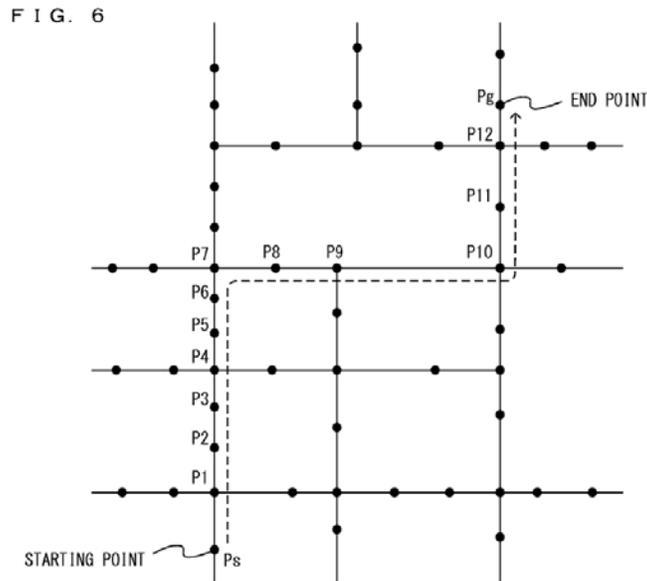


Figure 6 shows a path, denoted by the dotted line, between starting point Ps and end point Pg. While the two sentences in paragraph 56 and Figure 6 may support “track” in a vacuum, these sentences do not provide sufficient written description support to show possession of the limitation “track a target point that is moved . . . over a map displayed on a display screen . . . the target point being along a path from a first position of the map to a

second position of the map” recited in claim 1. In particular, Appellant’s Specification is broad and arguably suggests at least two possible interpretations: (A) generating a predetermined path; and (B) generating a path in a post hoc manner. Appellant argues the Specification also supports the recited limitation: (C) track a target point that is moved over a map displayed on a display screen, the target point being along a path from a first position of the map to a second position of the map. We discuss these interpretations in turn.

A. *Generating a Predetermined Path*

Paragraph 69 of the Specification states “the transmission-side apparatus 2 may select a starting point, points at intersections, and an end point on a path as *storage targets*” (emphasis added), which suggests generating a predetermined path—i.e., before any target point is moved—similar to the path drawn in Figure 6 between starting point Ps and end point Pg. Spec. ¶ 69. In addition, paragraph 56, Figure 6, and the remainder of the Specification are broad enough that a PHOSITA could read the Specification and reasonably ascertain that the path from starting point Ps to end point Pg is a predetermined path. A PHOSITA reading the Specification ascertaining this predetermined path (i.e., before any target point is moved) scenario would recognize this fails to support the limitation “track a target point that is moved . . . over a map displayed on a display screen . . . the target point *being along* a path from a first position of the map to a second position of the map” (emphases added) recited in claim 1. Moreover, drawing a predetermined path before a point is moved is inconsistent with a target point “being along a path” because the target point may not even be along the path yet.

B. Generating a path in a post hoc Manner

Another interpretation of paragraph 56, Figure 6, and the remainder of the Specification a PHOSITA could take is generating the path from starting point Ps to end point Pg in a post hoc manner—i.e., after a target point has completed its journey from starting point Ps to end point Pg. A PHOSITA reading the Specification ascertaining this post hoc path generation would recognize this fails to support the limitation “track a target point that is moved . . . over a map displayed on a display screen . . . the target point *being along* a path from a first position of the map to a second position of the map” (emphasis added) recited in claim 1. Drawing a post hoc path after a target point has completed its journey does not comport with “being along a path” because the target point may not even be along the path anymore since completing its journey.

C. Generating a path According to Appellant’s Interpretation

Although paragraph 56, Figure 6, and the remainder of the Specification do not exclude the ability to track a target point that is moved over a map displayed on a display screen, the target point being along a path from a first position of the map to a second position of the map, we disagree with Appellant that the Specification provides written description support for this embodiment. In other words, Appellant has not identified anything in the written description, nor do we see anything, demonstrating the inventors were in possession of tracking the target point *being along a path*. In particular, neither the figures nor the written description depict or describe displaying a map with a partially completed path along which a target point currently is positioned. As noted above, Figure 6 merely depicts a complete

path without identifying a location of a target point “being along [the] path.” Nor do we see a description of displaying such a partially completed path.

D. We Discern no Error in our Finding that Appellant’s Specification Lacks Written Description Support for the Tracking Step

Although the Specification is broad enough to arguably include various interpretations, without articulating them, as discussed *supra* in §§ I.A., I.B., and I.C., this demonstrates the written description may render obvious the limitation “track a target point that is moved . . . over a map displayed on a display screen . . . the target point being along a path from a first position of the map to a second position of the map” recited in claim 1. However, it is well settled that a description that merely renders the invention obvious does not satisfy the written description requirement. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (en banc). As such, we discern no error in our finding that Appellant lacked possession of the limitation “track a target point that is moved . . . over a map displayed on a display screen . . . the target point being along a path from a first position of the map to a second position of the map” recited in claim 1 at the time of filing the application. Dec. 16–17.

Accordingly, we are still of the view that claims 1–10, 12–15, and 17–21 lack written description under 35 U.S.C. § 112(a) for the reasons stated above and in our Decision.

II. Dependent Claim 19

A. We Disagree with Appellant’s First Argument

Appellant argues the Decision misapprehends that Appellant waived the argument “Zhu fails to teach transmitting line of sight direction in the generated path information that is transmitted” because Appellant included the last two paragraphs of claim 19 in the Appeal Brief and stated that Zhu

and Ohashi fail to teach claim 19. Req. Reh’g 6 (citing Appeal Br. 26). Appellant argued in the Appeal Brief only that Zhu’s camera position fails to teach “line of sight.” Appeal Br. 26. Appellant did not argue in the Appeal Brief that this information was not transmitted. *Id.*; Reply Br. 8 (arguing “there is no discussion of including that information in the transmitted path information as is set forth in claim 19” for the first time). We disagree.

We note that simply copying and pasting the last two paragraphs of claim 19 does not constitute argument sufficient to demonstrate error. In order to rebut a prima facie case of unpatentability, Appellant must point out the supposed Examiner errors distinctly and specifically, and the specific distinctions believed to render the claims patentable over the applied references. *See* 37 C.F.R. § 41.37(c)(vii) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”); *see also In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”); *cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art.”). In this case, although Appellant reproduced the last two paragraphs of claim 19, Appellant only distinctly and specifically developed the argument that Zhu’s “position of the camera” does not teach “line of sight direction” for that camera. Appeal Br. 26. Therefore, Appellant’s argument regarding the transmission aspect of the

limitation was raised belatedly because it was raised for the first time in the Reply Brief.

We further note that our Decision held that only Appellant’s argument regarding the transmission aspect, not the “line of sight” aspect, of claim 19 was waived. Dec. 15–16. Furthermore, we addressed the merits of all aspects of Appellant’s argument, including the waived transmission argument. *Id.*

B. We Disagree with Appellant’s Second Argument

Appellant argues the Decision overlooks a shift in the Examiner’s finding that prompted Appellant’s argument in the Reply Brief. Req. Reh’g 6–7 (citing Final Act. 15; Ans. 31). We disagree.

In particular, Appellant’s argument that the Examiner makes a new finding when the Examiner states Zhu’s position of the camera *and* geographic or map location teaches “line of sight direction” as Appellant alleges (Req. Reh’g 6–7(citing Final Act. 15; Ans. 31)) is unpersuasive because it takes the Examiner’s findings out of context.

Specifically, Appellant’s argument focuses only on the response to arguments in the Answer while ignoring the actual rejection of claim 19 in the Answer. *Compare* Final Act. 15 (citing Zhu 5:48–60; stating a position of the camera teaches the limitation “line of sight direction” recited in claim 19 and stating geographic or map location teaches “one of the multiple points” recited in claim 19) *with* Ans. 8–9 (citing Zhu 5:48–60; stating a position of the camera teaches the limitation “line of sight direction” recited in claim 19 and stating geographic or map location teaches “one of the multiple points” recited in claim 19).

Moreover, although the Examiner states “[g]iven location of the camera and the location of the image on the map, this information clearly present[s] the direction ‘line of sight’ from the camera to the image,” it is clear the Examiner is saying that Zhu’s position/location of the camera (i.e., “line of sight” recited in claim 19) is linked to Zhu’s location of the image (i.e., “one of the multiple points” recited in claim 19). This is even more apparent when reading claim 19, which states “a corresponding line of sight direction *is linked* to each one of the multiple points” (emphasis added). Therefore, reading page 31 of the Answer in combination with pages 8 and 9 of the Answer provides context that the Examiner did not make a new finding as Appellant alleges (Req. Reh’g 6–7).

Even if the Examiner made a new finding, which the Examiner did not, Appellant’s argument should focus on why Zhu’s position of the camera *and* geographic or map location fails to teach “line of sight direction.” Particularly, Appellant’s argument strays outside the metaphorical boundaries by arguing the limitation “transmitted” recited in claim 19. Thus, Appellant’s new argument regarding the transmitted aspect “is not responsive to an argument raised in the examiner’s answer” pursuant to 37 C.F.R. § 41.41(b)(2).

C. *We Disagree with Appellant’s Third Argument*

Appellant argues the Decision overlooks that position and direction are different and a PHOSITA would understand that a position at which an image is taken does not provide a teaching for “line of sight direction” into metadata. Req. Reh’g 7. We disagree.

Appellant states “[i]f the Decision’s affirmance for claim 19 rests on an interpretation that transmitting an image in combination with a position of

that image reads on the claimed line of sight direction features, then it should state as such to allow [Appellant] to propose further amendments to address such a claim interpretation.” Req. Reh’g 7, n.1. However, that is the interpretation we took in our Decision (Dec. 12–13, 15–16), which we discuss in the subsequent paragraph.

We respectfully note that Appellant overlooked our analysis on pages 12–13 and 15–16 of the Decision. As explained on pages 15–16 of the Decision, Zhu teaches line of sight direction and, as stated on pages 12–13 of this Decision, Zhu teaches “generating path information” and Ohashi teaches “transmitting.” Dec. 12–13, 15–16. Therefore, as stated on page 16 of the Decision “the combination of Zhu and Ohashi teach ‘transmitting the generated path information.’” *Id.*

Accordingly, we have considered Appellant’s arguments raised in the Request, but these arguments do not persuade us that the portion of the Decision affirming dependent claim 19 was in error.

CONCLUSION

Claims	35 U.S.C. §	Reference(s)/Basis	Denied	Granted
1–10, 12–15, 17–21	112(a)	Written Description	1–10, 12–15, 17–21	
19	103	Zhu, Ohashi	19	
Overall Outcome			1–10, 12–15, 17–21	

Final Outcome of Appeal after Rehearing:

Claims	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed	New Ground
1-5, 8-12, 14, 15, 21	103	JPREF, Ohashi	11	1-5, 8-10, 12, 14, 15, 21	
6, 7, 13, 17-20	103	JPREF, Ohashi, Lynch		6, 7, 13, 17-20	
12, 15, 19	103	Zhu, Ohashi	12, 15, 19		
1-10, 12-15, 17-21	112(a)	Written Description			1-10, 12-15, 17-21
11	112(a)	Written Description			11
11	112(b)	Indefiniteness			11
Overall Outcome			11, 12, 15, 19	1-10, 13, 14, 17, 18, 20, 21	1-15, 17-21

Accordingly, Appellants' Request for Rehearing is granted to the extent the Decision is reconsidered, but is denied with respect to modifying the Decision.

DENIED