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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VARUN A. VORA and SWAPNIL R. DAVE

Appeal 2018-006434
Application 14/450,726
Technology Center 2600

Before ERIC B. CHEN, NORMAN H. BEAMER, and JOYCE CRAIG,
Administrative Patent Judges.

CRAIG, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–30.² *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Apple Inc. Appeal Br. 1.

² The Examiner objected to claims 31–36 as dependent upon a rejected base claim, but indicated claims 31–36 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Final Act. 10.

CLAIMED SUBJECT MATTER

The claims are directed to auto-activating smart responses based on activities from remote devices. Claim 1, reproduced below, is illustrative of the claimed subject matter (disputed limitation italicized):

1. A method of causing a digital assistant to automatically respond to incoming communications, the method comprising:
 - at one or more electronic devices each having one or more processors and memory:
 - obtaining a speech input from a user;
 - in response to obtaining the speech input, *determining whether the speech input includes instructions for performing a specified action in response to receipt of a subsequent incoming communication from one or more specified senders*;
 - storing the instructions;
 - after storing the instructions, obtaining an incoming communication from a respective sender;
 - determining whether the respective sender is one of the one or more specified senders; and
 - upon determining that the respective sender is one of the one or more specified senders, performing the specified action in accordance with the instructions and thereafter automatically deleting the instructions.

REJECTIONS

Claims 1–6, 8–18, 20–26, and 28–30 stand rejected under 35 U.S.C. § 103 as unpatentable over the combination of Wohlert (US 2010/0098231 A1, published Apr. 22, 2010) and Kuhlke et al. (US 2011/0045841 A1, published Feb. 24, 2011) (“Kuhlke”). Final Act. 3.

Claims 7, 19, and 27 stand rejected under 35 U.S.C. § 103 as unpatentable over the combination of Wohlert, Kuhlke, and Shin (US 2009/0313014 A1, published Dec. 17, 2009). Final Act. 9.

ANALYSIS

Appellant contends the cited portions of Wohlert and Kuhlke do not teach or suggest “determining whether the speech input includes instructions for performing a specified action in response to receipt of a subsequent incoming communication from one or more specified senders,” as recited in claim 1. Appeal Br. 10–13. Appellant argues that, although Wohlert teaches receiving voice input, Wohlert does not actively determine whether the speech input includes instructions, as claim 1 requires. *Id.*

The Examiner found that Wohlert does not limit the type of interface that may be used to input the instructions/rules, as evidenced by the fact that different alternatives are taught. Ans. 10 (citing Wohlert ¶ 92). The Examiner also found that Wohlert teaches using an interactive voice response (IVR) system to explicitly or inherently cause a personalized communication processing system (PCPS) to obtain a speech input from a user, and in response to obtaining the speech input, determine whether the speech input includes instructions for performing a specified action in response to receipt of a subsequent incoming communication from one or more specified senders. *Id.* at 10–11 (citing Wohlert Fig. 9, ¶¶ 35, 36, 60, 91, and 92).

We agree with Appellant that the Examiner erred. The Examiner did not clearly identify where Wohlert teaches or suggests determining whether the speech input includes instructions. We agree with Appellant that Wohlert teaches invoking a method for defining the rules using speech input (*id.* at 11; *see* Spec. ¶ 92), but is silent with regard to determining the contents of the speech input.

Moreover, to the extent the Examiner's findings are based on inherency, the Examiner has not provided sufficient reasoning to support the findings. Wohler teaches that a method 900 can be *invoked* by a user via an IVR interface, but Wohler is silent regarding whether rules may be provided or managed using an IVR interface. Even if rules may be provided or managed through the IVR interface in Wohler, however, there is no teaching that the contents of the speech input are analyzed in any way. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic." *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (rejection reversed because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art).

For these reasons, we are persuaded that the Examiner erred in finding that Wohlert teaches or suggests the disputed limitation, as recited in claim 1. Independent claims 15 and 21 recite limitations similar to the disputed limitation. The Examiner did not find that either Kuhlke or Shin teaches or suggests the disputed limitation missing in Wohlert.

Accordingly, we reverse the Examiner's § 103 rejection of independent claim 1, as well as the Examiner's § 103 rejection of independent claims 15 and 21, and the Examiner's § 103 rejection of dependent claims 2–14, 16–20, and 22–30, which stand with the independent claims from which they depend.

Because it is dispositive that the Examiner has not shown by a preponderance of evidence that the cited prior art teaches or reasonably suggests the disputed limitation, we do not address other issues raised by Appellant's arguments related to these claims. *See Beloit Corp. v. Valmet*

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Oy, 742 F.2d 1421, 1423 (Fed. Cir. 1984) (finding an administrative agency is at liberty to reach a decision based on “a single dispositive issue”).

DECISION

We reverse the decision of the Examiner rejecting claims 1–30.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–6, 8–18, 20–26, 28–30	103	Wohlert, Kuhlke		1–6, 8–18, 20–26, 28–30
7, 19, 27	103	Wohlert, Kuhlke, Shin		7, 19, 27
Overall Outcome:				1–30

REVERSED