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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM S. BAILEY, JENNY YUEN, and VICTOR GONCALVES ELIAS[1]

Appeal 2018-006862
Application 14/082,937
Technology Center 2100

BEFORE CARL W. WHITEHEAD JR., IRVIN. E. BRANCH, and JON M. JURGOVAN, *Administrative Patent Judges*.

JURGOVAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks review under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1, 2, 4–6, 8–13, and 15–23. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.[2]

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[1] We use the word "Appellant" to refer to "applicant(s)" as defined in 37 C.F.R. § 1.42. According to Appellant, the real party in interest is Facebook, Inc. Appeal Br. 3.

[2] Our Decision refers to the Specification ("Spec.") filed November 18, 2013, the Final Office Action ("Final Act.") mailed April 18, 2017, the

CLAIMED SUBJECT MATTER

The claims are directed to transitioning a client computing device from a manual to automatic transition mode upon determining the device is no longer being held by a user. Spec. Abstract, ¶ 30. In the automatic transition mode, information is provided to listeners and a physics animation engine implements changes to elements of a user interface of an application. Spec. ¶¶ 50, 58.

Claims 1, 8, and 15 are independent. Claim 1, reproduced below, is representative of the claimed invention:

> 1. A method comprising:
>
> by a client computing device, determining that the client computing device is no longer held by a user;
>
> by the client computing device, based on the determining that the client computing device is no longer held by the user, transitioning from a first state of an application to a second state of the application, wherein:
>
> the first state of the application is associated with a manual transition mode, and
>
> the second state of the application is associated with an automatic transition mode;
>
> by the client computing device, in response to transitioning to the second state, determining one or more listeners associated with the application and registered to receive information associated with the second state of the application;
>
> by the client computing device, providing the information associated with the second state of the application to the one or more of the listeners; and
>
> by a physics animation engine executing on the client computing device, in response to receiving the information associated with the second state of the application, implementing

Appeal Brief ("Appeal Br.") filed February 6, 2018, the Examiner's Answer ("Ans.") mailed April 19, 2018, and the Reply Brief ("Reply Br.") filed June 19, 2018.

> one or more changes to one or more elements of a user interface of the application.

Appeal Br. 15 (Claims Appendix).

REJECTIONS[3]

I. Claim 22 stands rejected under 35 U.S.C. § 112(a) for failing to comply with the written description requirement. Final Act. 2–3.

II. Claims 1, 5, 6, 8, 12, 13, 15, 19–21, and 23 stand rejected under 35 U.S.C. § 103 based on Flynt (US 2007/0082707 A1, published Apr. 12, 2007), Hoffman ("5+ Cool Uses for Android's Daydream Mode," published Aug. 29, 2013) and Locker (US 2011/0029934 A1, published Feb. 3, 2011). Final Act. 4–21.

III. Claims 2, 9, and 16 stand rejected under 35 U.S.C. § 103 based on Flynt, Hoffman, Locker, and Calkins (US 2004/0222992 A1, published Nov. 11, 2004). Final Act. 21–29.

IV. Claims 4, 11, and 18 stand rejected under 35 U.S.C. § 103 based on Flynt, Hoffman, Locker, and Santoro (US 6,724,403 B1, issued Apr. 20, 2004) in view of Dann (US 2014/0040776 A1, published Feb. 6, 2014). Final Act. 29–36.

V. Claims 10 and 17 stand rejected under 35 U.S.C. § 103 based on Flynt, Hoffman, and Shaffer (US 2012/0306891 A1, published Dec. 6, 2012). Final Act. 36–38.

[3] The rejections for non-statutory double patenting and for indefiniteness under 35 U.S.C. § 112(b) were withdrawn by the Examiner. *See* Ans. 3.

VI. Claim 22 stand rejected under 35 U.S.C. § 103 based on Flynt, Hoffman, Locker, and Sharkey (US 8,230,246 B1, issued July 24, 2012). Final Act. 39.

OPINION

Section 112(a) Rejection

Section 112(a) provides that a patent application's specification shall contain a written description of the invention. The test for sufficiency of an application's written description is whether the application reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010).

Claim 22 recites that "the sensor of the client computing device includes a gyroscope of the client computing device." Appeal Br. 20 (Claims Appendix). Claim 21, from which claim 22 depends, recites that "the transitioning from the first state of the application to the second state of the application is [] based on the input from the sensor of the client computing device." *Id.* at 19–20. Claim 1, from which claim 21 depends, recites that "the first state of the application is associated with manual transition mode" and "the second state of the application is associated with an automatic transition mode" and the transitioning from the first state to the second state is "based on the determining that the client computing device is no longer held by the user." *Id.* at 15.

The Examiner interprets claim 22 to require that transitioning from manual to automatic transition mode is based on input from the gyroscope, which determines that the user is no longer holding the device. Final Act. 3.

The Examiner states that the Specification fails to provide support under § 112(a) for this claimed feature. Final Act. 3; Ans. 7.

Appellant argues that the Specification provides written description support for claim 22 by disclosing that the gyroscope detects that the user has flipped a mobile computing device to be screen side down on a surface (¶ 30), and that input from the device (e.g., any suitable information gathered from any of the device's sensors) may trigger a transition (¶ 49). Appeal Br. 12. In this regard, the Specification states:

> In particular embodiments, mobile computing device 10 may switch between manual and automatic transition mode upon detecting a change in the state of mobile computing device 10 (e.g.[,] from being in manual mode while held in the user's hand, device 10 then switches into automatic mode when it is set down onto a flat horizontal surface, placed on a stand, or plugged in for charging).

Spec. ¶ 30. The Specification thus distinguishes manual mode while the device is held in user's hand from automatic mode when the device is set down onto a surface, placed in a stand, or plugged in for charging.

As the Examiner observes (Ans. 7), the Specification mentions pausing automatic transitions upon detecting, using a gyroscope, that the user has dropped the device or flipped it to be screen side down on a surface (¶ 30). Thus, the Specification mentions the gyroscope's use in determining the device has been dropped or has been flipped screen side down on a surface (i.e., is no longer in the user's hand). In addition, this statement in the Specification establishes that the gyroscope is one of the sensors a device may have. Thus, when the Specification mentions any of the device sensors may trigger a transition (¶ 49), the gyroscope is one of the sensors covered by that statement.

The written description requirement does not require a claim to be worded identically to its support in the specification (i.e., it is not an "*in haec verba*" requirement). *See, e.g.*, *In re Lukach*, 442 F.2d 967, 969 (CCPA 1971); Manual of Patent Examining Procedure "MPEP" § 2163. When the mentioned parts of the Specification are considered together, we agree with Appellant that the written description support for claim 22 is adequate. Specifically, the Specification establishes that transition from the manual to automatic transmission mode when the user is no longer holding the device (¶ 30); that the gyroscope can be used to determine when the device is being held or not held (¶ 30); and that the gyroscope is one of the device's sensors that can trigger transition from manual to automatic transition mode (¶ 49). Thus, the Specification reasonably conveys to skilled artisans that the inventors had possession of the subject matter of claim 22 as of the filing date. Accordingly, we do not sustain the § 112(a) rejection.

Section 103 Rejection

A patent claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc*., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) where present, objective

evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

At the outset, we note that merely quoting or emphasizing claim language and asserting it is different from prior art references is insufficient to constitute an argument. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2013) ("The arguments shall explain *why* the examiner erred as to each ground of rejection contested by appellant." (Emphasis added.)). Furthermore, "[i]t is not the function of [the Board] to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art." *In re Baxter Travenol Labs*., 952 F.2d 388, 391 (Fed. Cir. 1991).

Accordingly, in the following analysis, we only address Appellant's contentions that are articulated with sufficient particularity and supported by sufficient explanation as to constitute cognizable allegations of specific reversible Examiner error and thereby amount to actual arguments. Arguments that Appellant did not make in the Briefs are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

I. Claims 1, 8, and 15

Appellant argues for patentability of independent claims 1, 8, and 15 together as one group. Appeal Br. 6–10. Accordingly, we select claim 1 as representative of the group and specifically address only this claim in our analysis. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner rejects claim 1 over the combination of Flynt, Hoffman, and Locker. Final Act. 4–8. The Examiner relies on Flynt to disclose most features of claim 1. *Id.* at 4–6. The Examiner relies on Hoffman to disclose that the device determines it is no longer being held by

a user, causing transition to the automatic mode (which Hoffman refers to as the "daydream" mode). *Id.* at 6–7. The Examiner relies on Locker to disclose a physics animation engine executing on a device. *Id.* at 7–8.

A. Docking and Charging Argument

Appellant argues that Hoffman discloses that "Android's Daydream feature is an ***'interactive screensaver mode' that can activate automatically when your device is docked or charging***, keeping your screen on and displaying information." Appeal Br. 7 (citing Hoffman pg. 1, ¶ 1); Reply Br. 2. Appellant argues "the trigger event for activating 'interactive screensaver mode' is detection that the device has been docked or is charging—not whether the device is still being held by a user." *Id.*

Claim terms must be given their broadest reasonable interpretation consistent with the specification in which they appear. (Emphasis added.) *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). As discussed with respect to the § 112(a) rejection, the Specification distinguishes between the manual mode when the device is held in the user's hand, and the automatic mode when it is set down onto a flat horizontal surface, placed on a stand, or plugged in for charging, and thus is no longer in the user's hand. Spec. ¶ 30. Appellant dismisses Hoffman's docking and charging as cases unrelated to whether the device is in a user's hand. Appellant's argument thus relies on an interpretation of claim 1 that we find inconsistent with the Specification.

B. Touch Sensor Argument

Appellant argues in Hoffman "there is no determination of whether . . . the user is still touching the device or not, let alone whether the client computing device is still being held by [the] user." Appeal Br. 7. Appellant's argument suggests that claim 1 requires that the device's sensor detects a user's touch. But, as discussed for the § 112(a) rejection of claim 22, non-touch sensors, such as a gyroscope, may be used to determine that the device is no longer held by a user. Spec. ¶ 30. Thus, it would be improper to restrict claim 1 to a touch sensor only when the Specification describes sensors more broadly to include non-touch sensors like a gyroscope capable of detecting a device is no longer in a user's hand.

C. Changing Principle of Operation Argument

Appellant argues "the Examiner's proposed combination of *Flynt* in view of *Hoffman* would change the principle of operation of *Flynt.*" Appeal Br. 8; Reply Br. 3 (citing *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959) ("If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."). Appellant contends Flynt precludes a user from navigating away from a tile space to an application. *Id.* (citing Flynt ¶ 51). Hoffman, according to Appellant, teaches that its device navigates to a Daydream application when docked or charging. *Id.* (citing Hoffman pg. 1, ¶ 3 ("the device's screen will stay on and display ***the Daydream app*** you choose.")). Thus, Appellant contends, combining Flynt with Hoffman would modify Flynt such that when the mobile phone is docked or charged, the device

navigates away from the tile space to an application, which contradicts Flynt's teaching to remain in the tile space. *Id.*

The Examiner explains that Hoffman's Flipboard (pg. 4) "is a feed/news application, and also possess[es] support for the "Daydream" mode." Ans. 5. The Examiner finds that combination of Flynt and Hoffman are compatible in view of Hoffman's Flipboard teaching that the same application can be in either the general or daydream mode. *Id.*

We agree with the Examiner that Appellant's argument fails to explain why Hoffman's Flipboard could not remain in Flynt's tile space in both the general and "daydream" mode, consistent with Flynt's teachings. Ans. 5–6. Accordingly, Appellant's argument is not persuasive to show Examiner error.

D. Two Applications Argument

Appellant next contends using the "***Daydream app*** you chose" from Hoffman and combining it with Flynt would result in using multiple applications, which teaches away from a single application transitioning between states, as claimed. Appeal Br. 8–9. Appellant's argument does not consider that Hoffman's "***Daydream app*** you chose" and Flynt's Flipboard may be the same application so that the combined references disclose one application, not two, transitioning between general and daydream states. In fact, the Examiner states that Hoffman teachings concerning its docking/charging display are being used in the rejection <u>to modify</u> Flynt's application and content tiles, not to combine two applications together. Final Act. 7. Accordingly, because Appellant's argument does not address

the Examiner's rejection as applied, we do not find Appellant's argument persuasive to show Examiner error. *See* 37 C.F.R. § 41.37(c)(1)(iv), *supra*.

E. Motivation to Combine Argument

The Examiner's stated motivation to combine Hoffman and Flynt is to display relevant content to a user without requiring user input. Final Act. 7. Appellant argues there is no motivation to combine Hoffman with Flynt because both teach to display relevant content to a user without requiring user input, so combining them would be redundant and unnecessary. Appeal Br. 9–10; Reply Br. 4.

Appellant's argument does not address, however, that the similarities between the references may provide a reason to combine them. *See Wyers v. Master Lock Co.*, 616 F.3d 1231 (Fed. Cir. 2010) (noting similarities of locks of prior art references and concluding person of ordinary skill in art would have had reason to combine the references); *see also KSR*, 550 U.S. at 420 ("in many cases a person of ordinary skill [in the art] will be able to fit the teachings of multiple patents together like pieces of a puzzle.").

In summary, we conclude that the Examiner has provided "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *See KSR*, 550 U.S. at 418. Accordingly, we sustain the rejection of claims 1, 8, and 15 as obvious under § 103.

Remaining Claims

Appellant presents no separate arguments for the remaining dependent claims. Appeal Br. 11–12. Thus, these claims fall for the reasons stated for their respective independent claims. *See* 37 C.F.R. § 41.37(c)(1)(iv).

CONCLUSION

We reverse the rejection of claim 22 as lacking written description under 35 U.S.C. § 112(a).

We affirm the Examiner's rejections of claims 1, 2, 4–6, 8–13 and 15–23 as obvious under 35 U.S.C. § 103.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
22	112(a)	Written Description		22
1, 5, 6, 8, 12, 13, 15, 19–21, 23	103	Flynt, Hoffman, Locker	1, 5, 6, 8, 12, 13, 15, 19–21, 23	
2, 9, 16	103	Flynt, Hoffman, Locker, Calkins	2, 9, 16	
4, 11, 18	103	Flynt, Hoffman, Locker, Santoro	4, 11, 18	
10, 17	103	Flynt, Hoffman, and Shaffer	10, 17	
22	103	Flynt, Hoffman, Locker, and Sharkey	22	

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
Overall Outcome			1, 2, 4–6, 8–13, 15–23	

TIME PERIOD FOR RESPONSE

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