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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD TORGERSRUD and
JOHN SATORI YAMASAKI

Appeal 2018-008067
Application 13/843,623¹
Technology Center 2400

Before ST. JOHN COURTENAY III, LARRY J. HUME, and
JOYCE CRAIG, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* CRAIG.

Dissenting Opinion filed by *Administrative Patent Judge* COURTENAY.

CRAIG, *Administrative Patent Judge*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's non-final rejection of claims 1, 3–8, 10–15, and 17–20, which constitute all of the claims pending in this application. Claims 2, 9, and 16 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ According to Appellants, the real party in interest is Intelmate LLC. App. Br. 4.

INVENTION

Appellants' application relates to a method for "reviewing an inmate's communications." Spec. ¶ 3. Claim 1 is illustrative of the appealed subject matter and reads as follows (disputed limitations emphasized):

1. A method for reviewing communications of an inmate comprising:
 - receiving a two-party message comprising a media item, wherein a first party of the two-party message is the inmate, and wherein the two-party message targets a recipient;
 - determining that a first portion of the media item is viewable prior to completion of a pending review of the media item;*
 - placing the first portion of the media item in a conditionally viewable repository for the inmate;
 - making the first portion of the media item accessible to the recipient based on the first portion being placed in the conditionally viewable repository for the inmate;
 - determining that a second portion of the media item is not viewable pending review;
 - placing the second portion of the media item in a conditionally held repository for the inmate;
 - making the second portion of the media item inaccessible to the recipient based on the second portion being placed in the conditionally held repository for the inmate;
 - receiving review results of a review process performed on the media item, wherein the review results indicate that the media item is rejected;
 - moving the media item to a rejected repository based on the review results; and
 - making the two-party message inaccessible to the recipient based on the media item being placed in the rejected repository for the inmate,
 - wherein the first portion of the media item is accessible to the recipient prior to receiving the review results and inaccessible to the recipient subsequent to receiving the review results.*

REJECTION

Claims 1, 3–8, 10–15, and 17–20 stand rejected under 35 U.S.C. § 103(a) as obvious over the combination of Shapiro et al. (US 2013/0179949 A1; published July 11, 2013) (“Shapiro”), Harper, (US 7,742,582 B2; issued June 22, 2010), Edd et al., (US 8,086,952 B2; issued Dec. 27, 2011) (“Edd”), and Ayers et al. (US 2012/0276513 A1; published Nov. 1, 2012) (“Ayers”). Non-Final Act. 2.

ANALYSIS

Appellants argue claims 1, 3–8, 10–15, and 17–20 as a group and select claim 1 as representative of the group. App. Br. 7. We also choose claim 1 as representative of the group. *See* 37 C.F.R. §41.37(c)(1)(iv).

Appellants contend the Examiner erred because Ayers does not teach or suggest the limitation “determining that a first portion of the media item is viewable prior to completion of a pending review of the media item,” as recited in claim 1. App. Br. 13. Appellants argue “it is completely unclear how and where Ayers teaches ‘determining that a first portion of the media item is viewable prior to completion of a pending review of the media item,’ because the cited paragraphs appear to be entirely unrelated to the claim limitation.” App. Br. 13–14.

The Examiner found that paragraphs 11, 75, and 77 of Ayers teach or suggest the disputed “determining” limitation. *See* Non-Final Act. 5–6; Ans. 6. We do not find that the cited portions of Ayers, or even Shapiro, Harper, or Edd, or any other portions of the references, teach or suggest “determining that a first portion of the media item is viewable prior to completion of a pending review of the media item” as particularly recited and specifically described in each of the independent claims 1, 8, and 15.

For example, the Examiner found that paragraph 11 of Ayers teaches that participants can be inmates. *See* Ans. 6; Ayers ¶ 11. The Examiner found paragraph 75 of Ayers teaches that video files are stored in a remote server, cataloged and readily reviewable by participants. *See* Ans. 6; Ayers ¶ 75. The Examiner also found paragraph 75 of Ayers teaches “the analysis stage that is performed by the system can provide valuable information about the relationship between the participants (*i.e. content is viewable prior to the completion of the pending review*).” *See* Ans. 6 (emphasis added); Ayers ¶ 75. Finally, the Examiner found that paragraph 75 of Ayers teaches that face-to-face interactions are stored, cataloged, and searchable for the convenience of the participants and/or reviewer. *See* Ans. 6; Ayers ¶ 77.

While Ayers teaches in paragraph 75 that a “video file may be shared with others with permission from one or more of the participants,” and “[t]he video file may be shared with others when only all of the participants provide permission for sharing,” we find these teachings insufficient to teach or suggest the disputed limitation, which requires “determining” for a given media item that “content is viewable *prior to the completion of the pending review*.” *See* Ayers ¶ 75 (emphasis added). Thus, we agree with Appellants that, on the record before us, these portions of Ayers are insufficient to teach or suggest the “determining” limitation of claim 1.

In addition, the Examiner found Edd teaches or suggests that “the first portion of the media item is accessible to the recipient prior to receiving the review results and inaccessible to the recipient subsequent to receiving the review results,” as recited in claim 1. Non-Final Act 5 (citing Edd col. 3:26–29). The cited portion of Edd teaches “prior to the automatically initiated review the second country version is accessible to end users of a

web site that uses the content-controlled database.” Edd col. 3:26–29. The Examiner found “[t]his is functionally equivalent to the claimed language because, the portion of media (i.e. content) is accessible to the recipient (i.e. accessible to the end users) prior to the receiving the review results (i.e. prior to the automatically initiated review).” Ans. 6.

We agree with Appellants that the Examiner erred. The invention as claimed recites a single media item that has at least two portions. In contrast, Edd teaches multiple, separate versions of the same content, but not multiple portions of content. *See* Reply Br. 3. On the record before us, it is unclear how the teachings of Edd fit with the teachings of Shapiro, Harper, and Ayers to teach or suggest “the first portion of the media item is accessible to the recipient prior to receiving the review results and inaccessible to the recipient subsequent to receiving the review results,” as claim 1 requires.

For these reasons, we are persuaded that the Examiner erred in finding that the combined teachings of Shapiro, Harper, Edd, and Ayers teach or suggest the disputed limitations of claim 1. The Examiner’s findings do not provide sufficient evidence or explanation to support the rejection. *See* Ans. 6.

Accordingly, on the record before us, we reverse the Examiner’s 35 U.S.C. § 103(a) rejection of independent claim 1 and grouped claims 3–8, 10–15 and 17–20.

Appeal 2018-008067
Application 13/843,623

DECISION

We reverse the Examiner's decision rejecting claims 1, 3–8, 10–15, and 17–20.²

REVERSED

² In the event of further prosecution, we leave it to the Examiner to determine whether the claims are patent eligible under 35 U.S.C. § 101 in view of the Director's revised guidance on subject matter eligibility. *See 2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (<https://www.govinfo.gov/content/pkg/FR-2019-01-07/pdf/2018-28282.pdf>).

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Before ST. JOHN COURTENAY III, LARRY J. HUME, and
JOYCE CRAIG, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*, Dissenting Opinion.

I write separately because I respectfully disagree with the Majority's reversal of the Examiner's rejection. For at least the reasons detailed below, and based upon a preponderance of the evidence, I find the following claim limitations are *taught or suggested* by the Examiner's proffered combination of Shapiro, Harper, Edd, and Ayers, and are therefore *obvious*:

“determining that a first portion of the media item is viewable prior to completion of a pending review of the media item,” as recited in independent Claims 1, 8, and,

“determine that a first portion of the media item is viewable prior to completion of a pending review of the media item,” as recited in independent Claim 15 (emphasis added), and,

“wherein the first portion of the media item is accessible to the recipient prior to receiving the review results and inaccessible to the recipient subsequent to receiving the review results.”

Claims 1, 8, and 15 (emphasis added).

Claim Construction

I begin my analysis with claim construction, and turn to the Specification for *context*:

Pertinent portions of paragraphs 3 and 78 of the Specification are descriptive of the invention:

In general, in one aspect, the invention relates to a method for reviewing an inmate's communications. The method includes receiving a two-party message including *a media item*, where *a first party* of the two-party message is the *inmate*, and where the two-party message targets a *recipient*, and determining whether *the media item is viewable pending review*.

Spec. ¶ 3 (emphasis added).

The Specification (¶ 78) describes exemplary types of media items:

In one or more embodiments of the invention, the message server (732) is a process or group of processes with functionality to receive messages that include *media items* (e.g., *digital text, digital photos, digital videos, digital audio, etc.*) and deliver those messages to a recipient based on a target address. Specifically, the message server (732) may receive messages

addressed to, or sent from, an inmate residing within a controlled facility. The message server (732) may send and receive messages to and from an inmate application (not shown), an inmate kiosk (not shown), a visitor kiosk (not shown), and/or an outsider application (not shown).

Spec. ¶ 78 (emphasis added).

Given this *context*, I conclude, as an initial matter of claim construction, that the scope of the claimed “media item” **at least** covers “digital text, digital photos, digital videos, digital audio, etc.” Spec. ¶ 78.³

Secondly, I note the *two-party messages* include messages that are “*addressed to, or sent from*, an inmate residing within a controlled facility.” *Id.* (emphasis added). Thus, according to the Specification (¶ 78), the communication may flow in *both directions* between the two parties: i.e., from the “inmate” to the “recipient” or vice versa, via the message server.

However, as claimed, the inmate is the first party, and the “two party message” that “targets a recipient” *implies* that the “recipient” is the second party. Claims 1, 8, and 15. However, independent claims 1, 8, and 15 are *silent* regarding any literal mention of a “second party.” But dependent

³ I accord the contested claim limitations the broadest reasonable interpretation (“BRI”) consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). The scope of the claims on appeal, at a minimum, at least covers the corresponding supporting embodiment(s) described in the Specification. However, the scope of the claims is not limited to the preferred embodiments described in the Specification: “[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments [C]laims may embrace ‘different subject matter than is illustrated in the specific embodiments in the specification.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc) (internal citations omitted).

claims 6 and 13 further limit independent claims 1 and 8, respectively, by specifying “wherein a **second party** of the two-party message is *external to a controlled facility housing the inmate*.” (emphasis added).⁴

As further explained in the Background of the Specification, in detention environments such as jails and prisons, “detained individuals, such as prisoners, offenders, convicts, military personnel, patients, government cleared personnel, or other detainees, frequently desire to communicate with individuals **outside** the detention environment such as *friends or family members*.” Spec. ¶ 2 (emphasis added). Thus, according to one embodiment, the “recipient” as recited in the claims may be *a friend or family members. Id.*

However, inmates are subject to various communications restrictions that may be, for example, exercised under a state’s police power. The Specification provides several non-limiting examples: “Inmate target restrictions may be **specific outsiders or visitors** with whom the inmate is not allowed to communicate (e.g., the victim of a crime perpetrated by the inmate, etc.)” Spec. ¶ 24 (emphasis added). Further, such “[i]nmate target restrictions may also include types of people with whom the inmate is not

⁴ Under the doctrine of claim differentiation, “dependent claims are presumed to be of narrower scope than the independent claims from which they depend.” *Howmedica Osteonics Corp. v. Zimmer, Inc.*, 822 F.3d 1312, 1323 (Fed. Cir. 2016); *see also Phillips*, 415 F.3d at 1314–15 (Fed. Cir. 2005) (en banc) (“Differences among claims can also be a useful guide in understanding the meaning of particular claim terms. For example, the presence of a dependent claim that adds a particular limitation gives rise to a presumption that *the limitation in question is not present in the independent claim.*”) (citations omitted) (emphasis added).

allowed contact (*e.g.*, outsiders who are ex-cons, minors under the age of 18, etc.).” *Id.*

I emphasize, as an initial matter of claim construction, that method claim 1 does not specify who or what performs the disputed step or act of “determining.”

The Evidence

Turning to the references relied upon by the Examiner as evidence in support of the rejection:

(1) **Shapiro** describes an invention that “includes delivering and monitoring digital content distributed to correctional facility inmates, giving supervisory authorities the ability to screen the incoming digital content.” Abstract. Shapiro further describes: “[d]igital content can include email, and stored and steamed video content, and can be scanned for keywords by supervisory authorities before delivery to an inmate.” *Id.*

(2) **Harper** describes: “A correctional facility communication system for sending an external message to an offender of a correctional facility.” Abstract.

(3) **Edd** describes managing content “in a content-controlled database by detecting a modification made to a first country version of a content item in the content-controlled database, and automatically initiating a review of a second country version of the content item in the content-controlled database in response to detecting the modification of the first country version.” Abstract.

(4) **Ayers** describes a learning tool used “in reviewing an audio-video recording of a face-to-face interaction with one or more persons, whereby

one or more of the participants use the learning tool to privately describe their separate viewpoints of the interaction.” Abstract.

Two-Party Messages Sent or Received by an Inmate

According to one described embodiment of Appellants’ invention: “a message with a single recipient is referred to as a two-party message, in which one party is an inmate (who is either the sender or receiver) and one party is an outsider or visitor (who is either the sender or receiver).” Spec. ¶ 79. Thus, a “two-party message may be sent or received by the inmate,” in accordance with the Specification, unless further limited by specific claim language. *Id.*

Regarding the contested limitation: “*determining that a first portion of the media item is viewable prior to completion of a pending review of the media item*” (Claim 1), the Examiner relies on Shapiro’s claim 12 for teaching or suggesting at least the “determining that a first portion of the media item is viewable” part of the limitation:

-determining that a first portion of the media item is viewable pending review (claim 12 limitation “delay distribution...to an intended recipient”)

Non-Final Act. 3; *see also* Ans. 3–4.

Shapiro’s claim 12 (page 20), as specifically relied upon by the Examiner (*id.*), describes in pertinent part:

obtain digital video content from inmates or non-inmates, *delay* distribution of at least *a portion* of the digital video content until a staff person of the correctional facility approves transmission of the at least *a portion* of digital video content to an intended recipient, and distribute the digital video content to the intended recipient if approved.

(emphasis added).

Thus, I find Shapiro's claim 12 at least *suggests* providing *some* of the inmate-provided, non-delayed video content to a non-inmate *recipient*, with the delayed "at least a portion" of the video content not being immediately available for viewing by the *recipient*, until *after* review and approval by a staff person of the correctional facility.

Regarding the second part of the limitation: "viewable *prior to completion of a pending review of the media item*" (claim 1, (emphasis added)), the Examiner finds: "Shapiro and Harper do[] not *explicitly* teach wherein the first portion of the media item is accessible to the recipient prior to receiving the review results." Non-Final Act. 5 (emphasis added).

However, the Examiner finds:

Edd teaches wherein the first portion of the media item is accessible to the recipient prior to receiving the review results (column 3 lines 26-29). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Edd's teaching in Shapiro and Harper's teaching to . . . allow access[] to the content to the recipient prior to receiving the review results. The motivation for doing so would be to allow temporary access to the content so if the content were later disapproved on the review, the recipient user can explain the reason on why he should be allowed access.

Although, Edd teaches wherein the first portion of the media item is accessible/viewable to the recipient prior to receiving the review results (i.e. which can be functionally equivalent to prior to completion of the pending review of the media item)(column 3 lines 26-29), [(paragraph break inserted)] Ayers teaches determining that a first portion of the media item is viewable prior to completion of a pending review of the media item (Paragraph[s] 11, 75 77). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Ayers's teaching in Shapiro, Edd and

Harper's teaching to come up with determining first portion of the media item prior to completion of pending review of the media item. The motivation [for] doing so would be to preview the media/video therefore, the length of the media can set or preset (Paragraph 77).

Non-Final Act. 5–6.

The Edd Reference

Column three of Edd provides some background description:

In various embodiments consistent with the invention, content is managed in a content-controlled database by detecting a modification made to a first country version of a *content item* in the content-controlled database, and *automatically initiating a review of a second country version* of the content item in the content-controlled database in response to detecting the modification of the first country version.

Edd, col. 3, ll. 6–12 (emphasis added).

Lines 26–29 of column 3, as cited by the Examiner (Non-Final Act. 6) expressly teach: “**prior to the automatically initiated review the second country version is accessible** to end users of a web site that uses the content-controlled database.” (emphasis added).

As noted above, the claimed *media items* can include “digital text, digital photos, digital videos, digital audio, etc.” (Spec. ¶ 78). Edd describes maintaining “content from a content-controlled database (e.g., web pages or other files maintained in a web site).” (Edd, Col. 2, 60–62).

Thus, I find Edd, in combination with the other cited references, teaches or suggests at least the following part of the “determining” limitation: “viewable *prior to completion of a pending review of the media item,*” as recited in independent claims 1 and 8, and as similarly recited in independent claim 15 (emphasis added).

In particular, I find Edd teaches or suggests that *a first portion of the media item* (i.e., the modified first country version of the content item) is viewable (i.e., accessible) “*prior to completion of a pending review*” of the second country version of the same media item. Claims 1, 8, and 15 (emphasis added).

As noted above, the Examiner also relies on Shapiro’s claim 12 for teaching or suggesting at least the “determining that a first portion of the media item is viewable” part of the limitation:

-determining that a first portion of the media item is viewable pending review (claim 12 limitation “delay distribution...to an intended recipient”)

Non-Final Act. 3; *see also* Ans. 3–4.

I emphasize that the Examiner’s rejection is based upon the *combined* teachings and *suggestions* of the cited references.

In the Appeal Brief, Appellants merely address Edd by citing to column 1, lines 14–17, which summarize: “[t]he invention is generally related to the management of electronic content, in particular, to the management of electronic content organized into a website and accessible via a network such as the Internet.” App. Br. 12.

However, Appellants fail to address the Examiner’s specific findings regarding Edd’s description at column 3, lines 26–29. Non-Final Act. 5. To the extent that Appellants address the Examiner’s findings regarding Edd in the Reply Brief (page 3, paragraph 1) by *merely reproducing them*, the arguments which follow are not supported by any citations to specific portions of Edd:

In contrast, in Edd, there is a first content that is reviewed (first country version of a content item), and based on the review of

the first content, the access to a second content (second country version of the **same** content item) is controlled. Accordingly, Edd requires multiple versions of the **same** content, but not multiple portions of the content. Importantly, in Edd, the first of these multiple versions is reviewed to control access to the second version of the multiple versions. This is conceptually entirely different from as single media item being reviewed to control access to a part of the single media item. In view of the above, a mapping of the "modified first country version" in Edd to the "first portion of the media item" as claimed is improper.

Reply Br. 3, ¶ 2. (emphasis omitted, emphasis in bold added).

Without any specific evidentiary support, Appellants arguments are merely conclusory. It is well settled that mere attorney arguments and conclusory statements, which are unsupported by factual evidence, are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (attorney argument is not evidence); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); *see also Ex parte Belinne*, 2009 WL 2477843, at *3–4 (BPAI Aug. 10, 2009) (informative).

Applying this reasoning here, I find Appellants' arguments are merely conclusory and do not meet the burden of persuasion to show error in the Examiner's prima facie case of obviousness.

The Ayers Reference

I find the Examiner's additional reliance on Ayers is essentially cumulative with Edd. *See, for example*, Ayers at paragraph 75:

The user interface can be a part of a social networking web interface and/or application. The video files are stored in a remote server, cataloged and *readily reviewable* by the parties who are the participants. The video file may be

shared with *others with permission from one or more of the participants.*

(emphasis added).

Thus, I find Ayers also teaches or suggests that “media items” (e.g., video files) are also “viewable” by “others” with permission from the one or more participants “*prior to completion of a pending review of the media item*” (i.e., the video file that is being currently reviewed by any of the parties who are the participants), within the meaning of independent claims 1 and 8, and as similarly recited in independent claim 15, under a broad but reasonable interpretation.

I also observe that Ayers’ paragraph 68 (not relied upon by the Examiner, but very near paragraph 75), expressly describes: “The Reviewing Stage includes playback of the recorded composite images and/or video for viewing by both parties.”

If the video media item is viewable *during* the “Reviewing Stage” as described in Ayers (*id.*), I find the media item is also “viewable *prior to completion* of a pending review of the media item,” within the scope of each of independent claims 1, 8, and 15.

Similarly, I find claims 15 and 16 in Shapiro (page 20) teach or suggest time delayed access for the inmate-provided (or non-inmate-provided) video communication which allows the media item to be “viewable *prior to completion* of a pending review of the media item” (i.e., until censored and interrupted by the correctional facility staff that is monitoring the video stream in advance of the time-delayed viewing by the inmate or the non-inmate recipient), within the scope of independent claims 1, 8, and 15.

Shapiro's independent claim 12 recites: "obtain[ing] digital video content for inmates or non-inmates." Shapiro's claims 15 and 16, which depend directly from claim 12, are reproduced below:

15. The system of claim 12, wherein the **delay** is sufficient to enable correctional facility staff to **monitor** and **interrupt** the video digital content if the digital video content contains non-authorized content.

16. The system of claim 12, wherein the digital content is streaming video content, the digital video content stored by the server software for a **delay period** sufficient to enable correctional facility staff to **monitor** and **interrupt the stream** if non-authorized content is streamed.

(emphasis added).

The Examiner relies on claims 15 and 16 of Shapiro in the Non-Final Action, at page 3. I emphasize again that the Examiner's rejection is based upon the *combined* teachings and *suggestions* of the cited references.

Our reviewing court further guides: "the question under 35 USC 103 is not merely what the references expressly teach but what they would have *suggested* to one of ordinary skill in the art at the time the invention was made." *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989) (quoting *In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976)). (Emphasis added); *see also* MPEP § 2123.

Similar to my discussion above regarding Edd, Appellants fail to address the Examiner's specific findings regarding Ayers. *See* Non-Final Act. 5–6:

Ayers teaches determining that a first portion of the media item is viewable prior to completion of a pending review of the media item (Paragraph 11, 75[, and] 77). It would have been obvious

to one of ordinary skill in the art at the time of applicant's invention was made to implement Ayers's teaching in Shapiro, Edd and Harper's teaching to come up with determining first portion of the media item prior to completion of pending review of the media item. The motivation doing so would be to preview the media/video therefore, the length of the media can set or preset (Paragraph 77).

Non-Final Act. 5–6.

In the Appeal Brief, Appellants merely assert: “Ayer[s] is directed to methods and systems for understanding face-to-face human interactions. *See* Ayers, Abstract. However, Ayers does not cure what Shapiro, Harper, and Edd lack.”

Again, I find this is mere attorney argument, unsupported by any factual evidence in support, and thus is unpersuasive and entitled to little probative value. *See Geisler*, 116 F.3d at 1470.

Appellants further argue:

Although the Examiner cites paragraphs [0011], [0075], and [0077] of Ayers, the Examiner fails to point out how the cited paragraphs teach or disclose claimed features. Moreover, it is completely unclear how and where Ayers teaches “determining that a first portion of the media item is viewable prior to completion of a pending review of the media item,” because the cited paragraphs appear to be entirely unrelated to the claim limitation. In other words, the rejection is not clearly articulated and Appellant is unable to respond completely. This is a violation of the goal of examination.

App. Br. 13–14.

However, the Examiner’s reliance on paragraph 11 needs no explanation regarding how it *teaches or discloses* the claimed features, as Appellants assert. *Id.*

Ayers' paragraph 11 describes "Prison **inmates** preparing for reentering society after years of incarceration." (emphasis added). Each of Appellants' independent claims 1, 8, and 15 recites "an inmate" in the respective preamble to the claim. Appellants fail to persuasively traverse address the Examiner's findings regarding paragraph 11 of Ayers. Moreover, I find Ayers' mention of *prison inmates* evidences that Ayers is analogous art to Appellants' claimed invention. Ayers, at paragraph 75, describes reviewing "media items" (i.e., video files), as recited in each of Appellants' independent claims 1, 8, and 15:

The user interface can be a part of a social networking web interface and/or application. The video files are stored in a remote server, cataloged and readily *reviewable* by the parties who are the participants. The video file may be *shared with others with permission from one or more of the participants*.

Ayers ¶ 75 (emphasis added).

Thus, I find Ayers (¶ 75), at least suggests that *while* participants are reviewing the video file(s), such video file(s) may also be shared with *others* with permission from *one or more* of the participants, i.e., the video file(s) may be shared with others "*prior to completion of a pending review of the media item.*" Claim 1 (emphasis added). Thus, the video file being currently reviewed by any of the participants may be shared with others during the review, but *prior to completion of the pending review*.

Appellants fail to persuasively traverse address the Examiner's findings regarding paragraph 75 (and paragraph 77) of Ayers. Non-Final Act. 5–6. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). Appellants only mention Ayers once in the Reply Brief (2): "None of Harper

(U.S. Patent No. 7,742,582), Edd (U.S. Patent No. 8,086,952) and Ayers (U.S. Patent Publication No. 2012/0276513) cure what Shapiro lacks.”

Appellants advance no substantive arguments regarding Ayers in the Reply Brief.

Contrary to Appellant’s contentions (App. Br. 13–14), it is my view that the Examiner has met the notice requirement for a prima facie case, pursuant to 35 U.S.C. § 132(a). The Federal Circuit has held, “the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007).

[A]ll that is required of the office to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of [35 U.S.C.] § 132. As the statute itself instructs, the examiner must “notify the applicant,” “stating the reasons for such rejection,” “together with such information and references as may be useful in judging the propriety of continuing prosecution of his application.”

In re Jung, 637 F.3d 1356, 1363 (Fed. Cir. 2011).

This burden is met by “adequately explain[ing] the shortcomings it perceives so that the applicant is properly notified and able to respond.” *Hyatt*, 492 F.3d at 1370. It is only “when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection” that the prima facie burden has not been met and the rejection violates the minimal requirements of 35 U.S.C. § 132. *Chester v. Miller* 906 F.2d 1574, 1578 (Fed. Cir. 1990).

Such is not the case presented here, i.e., a violation of the minimal notice requirements of 35 U.S.C. § 132(a). In my view, the Examiner's prima facie case has not been substantively and persuasively rebutted by Appellants. Moreover, Arguments not made are waived. *See* 37 C.F.R. 41.37(c)(1)(iv).

Lastly, in my view: “*determining that a first portion of the media item is viewable prior to completion of a pending review of the media item,*” as recited in similar form in independent claims 1, 8, and 15, is nothing more than a **predictable result** in light of the **combined** teachings and suggestions of the references as relied upon by the Examiner. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 401 (2007) (“[A] combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

Therefore, for at least the aforementioned reasons, I find the Examiner's underlying factual findings and ultimate legal conclusion of obviousness are supported by a preponderance of the evidence regarding the disputed “determining” clause limitations:

“*determining that a first portion of the media item is viewable prior to completion of a pending review of the media item,*” as recited in independent Claims 1, 8, and,

“*determine that a first portion of the media item is viewable prior to completion of a pending review of the media item,*” as recited in independent Claim 15.

Last-recited “wherein” clause of Independent Claims 1, 8, and 15

For at least the reasons discussed below, I find the following similar “wherein” clause limitation is taught or suggested by the Examiner’s proffered combination of Shapiro, Harper, Edd, and Ayers:

“wherein the first portion of the media item is accessible to the recipient prior to receiving the review results and inaccessible to the recipient subsequent to receiving the review results.”

Claims 1, 8, and 15.

In reviewing the Appeal Brief, I do not see where this “wherein” clause is specifically and separately argued, although there is admittedly some overlap with the “determining” clause above. Regarding this “wherein” clause limitation, I agree with and adopt the Examiner’s underlying factual findings and ultimate legal conclusion of obviousness. Non-Final Act. 5–6.

As also found by the Examiner: “In claim 12 of [the] Shapiro reference, Shapiro further teaches making *the first portion of the media item accessible to the recipient based on the first portion being placed in the conditionally viewable repository for the inmate* ([see] claim 12 limitation “distribute the digital video content ... if approved” and “obtain the distributed digital video . . . [and] present the video content). Non-Final Act. 3–4.

Given the evidence relied upon by the Examiner (*id.*), what is claimed would have been a predictable result: if the inmate-provided video content is not approved (i.e., censored by the staff of the correctional facility —

Shapiro, claim 12), it would have been “*inaccessible to the recipient subsequent to receiving the review results.*” Claims 1, 8, and 15.

The Examiner finds: “In Paragraph 214, Shapiro teaches media content is inaccessible to the recipient subsequent to receiving the review result (i.e. moved to [a] different location for deletion).” Non-Final Act. 5.

To the extent that some of the features relied upon by the Examiner in the Shapiro, Harper, Edd, and Ayers references overlap and thus are cumulative, I again emphasize that the rejection is based upon the *combined* teachings and suggestions of the cited references.

On this record, I am not persuaded of error regarding the Examiner’s legal conclusion of obviousness, as pertaining to the last recited “wherein” clause limitation of claim 1. Moreover, this “wherein” clause (recited in each of independent claims 1, 8, and 15) does not appear to be specifically and separately argued by Appellants in either the Appeal Brief or the Reply Brief. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Regarding the Examiner’s proffered combination of references, the Supreme Court provides clear guidance that “when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and **yields no more than one would expect** from such an arrangement, the combination is obvious.” *KSR*, 550 U.S. at 417 (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)) (emphasis added).

The Supreme Court further guides:

Invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent . . . unless more ingenuity and skill were required in making or applying the said improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree

of skill and ingenuity which constitute the essential elements of every invention.

Dunbar v. Myers, 94 U.S. 187, 197 (1876) (citing *Hotchkiss v. Greenwood*, 52 U.S. 248, 267 (1850)). I note that *Hotchkiss* was cited multiple times with approval by the Supreme Court in *KSR*, 550 U.S. at 406, 415, and 427.

The Supreme Court cites the obviousness statute, and emphasizes:

Section 103(a) **forbids issuance of a patent** when “the differences between the subject matter sought to be patented 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, 550 U.S. at 406 (emphasis added).

This guidance is applicable here. For at least the aforementioned reasons, and based upon a preponderance of the evidence, I am not persuaded that Appellants have shown that the Examiner’s legal conclusion of obviousness is in error.

Additional Issues

Given that the claims at issue are intended to restrict communications between a non-inmate citizen and an inmate who is incarcerated in a federal, state, or local prison, questions arise as to the public policy of granting a patent (i.e., a legal monopoly for a limited term) to a non-government entity to similarly “regulate” (i.e., via enforcement of any patent granted) a form of communication already regulated or controlled by state, local, and federal

prison officials, under applicable laws, and under the protections afforded by our Constitution.⁵

Although a private patent owner would be the potential actor (and not the government), a question arises as to whether the patent system (and federal patent laws) can be used by a private entity to place any strictures on a state's police power to regulate and maintain control over inmate communications within the state's prison system.⁶

State sovereign immunity under the Eleventh Amendment extends to all parts of the state entity, including, for example, state universities. Although a state-owned prison operated by state employees would presumably assert state sovereign immunity as an affirmative defense against patent infringement, that defense would not extend to a privately operated prison, or to a prison operated as a publicly-traded corporation.

When a convicted individual walks through the prison entrance, personal liberty is surrendered, including the right to unrestricted communications. There are legitimate reasons for restricting such inmate

⁵ See e.g., Holtz, Titia A., “REACHING OUT FROM BEHIND BARS: THE CONSTITUTIONALITY OF LAWS BARRING PRISONERS FROM THE INTERNET”, 67 Brook. L. Rev. 855, (2002). See also, e.g., OHIO REV. CODE ANN. § 5145.31C(1) (regulating state inmate Internet use).

⁶ See e.g., *Turner v. Safley*, 482 U.S. 78, 85 (1987) (“Where a state penal system is involved, federal courts have, as we indicated in *Martinez*, additional reason to accord deference to the appropriate prison authorities. See *id.*, at 405, 94 S.Ct., at 1807.”) (citing *Procunier v. Martinez*, 416 U.S. 396, 413–414 (1974)).

communications, as described in paragraphs 22–24 of Appellants’ Specification, and as dictated by the courts.⁷

However, what if a patent grant as applied to a **private** prison system is used to enforce restrictions on other types of inmate communications, such as contact with an outside defense attorney? Notably, Appellants’ claims are silent regarding any exceptions that would respect privileged attorney-client communications.

What if non-inmate friends and relatives (“recipient[s]” — claim 1) attempting to have the inmate exonerated of the crime are censored by **private** prison officials, in accordance with “a method for reviewing communications of an inmate” (claim 1), such that their ability to mount an effective appeal is eviscerated, due to a restricted ability to communicate with the inmate?

And what entity polices the **private** prison censors who are implementing a restricted communications policy under license to the patent owner?

More generally, Appellants’ claims, if patented, amount to a government grant (i.e., a legal monopoly for a limited time) to a private entity (the patent owner) to restrict communications (speech) in a manner in accordance with the scope of the claims.

⁷ See e.g., *Turner*, 482 U.S. at 89 (“when a prison regulation impinges on inmates’ constitutional rights, the regulation is valid if it is reasonably related to legitimate penological interests.”).

Significantly, the scope of Appellants' claims is **not limited solely to prison facilities**:

Examples of controlled facilities (e.g., controlled facility (100)) include, but are not limited to, detention environments (e.g., jails, prisons, etc.), immigration detention centers, military centers, government secure sites, law enforcement holding structures, secure business complexes, and psychiatric hospitals.

Spec. ¶ 21.⁸

Appellants also provide a broad, non-limiting, exemplary description of what an “inmate” is within the scope of the claims:

In one or more embodiments of the invention, *an inmate is a person within a controlled facility (100) who is subject to one or more restrictions, primarily to his or her freedom or rights.* Examples of inmates include, **but are not limited to**, prisoners, wards of the state, parolees, employees working in a secure business complex, temporary or long-term internees, patients, military personnel, uncharged suspects, and refugees. Inmate restrictions may be part of a court imposed sentence on an inmate, while others may be specific to the controlled facility (100) in which the inmate resides. Restrictions may include limitations on an inmate's physical movement (i.e., physical restrictions) and limitations on the inmate's ability to communicate (i.e., communication restrictions). Communication restrictions include inmate use restrictions, inmate target restrictions, and device use restrictions.

Spec. 22 (emphasis added).

Further, the scope of the claims is not limited to the preferred embodiments described in the Specification. *See Phillips*, 415 F.3d at 1323.

⁸ *See also* Spec. ¶ 19 (“In general, embodiments of the invention provide a method and system for facilitating communication between inmates in a controlled facility and outsiders. Embodiments of the invention may include interactions with a secure **social network**.”) (emphasis added).

Regarding the broader applications of Appellants' claims to restrict communications (speech) among various individuals who are not *prison* inmates, *see, e.g., Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1322 (Fed. Cir. 2016), Judge Mayer, concurring:

“[T]he Constitution protects the right to receive information and ideas. ... This right to receive information and ideas, regardless of their social worth, is fundamental to our free society.” *Stanley v. Georgia*, 394 U.S. 557, 564 (1969) (citations omitted). Patents, which function as government-sanctioned monopolies, invade core First Amendment rights when they are allowed to obstruct the essential channels of scientific, economic, and political discourse. *See United States v. Playboy Entm't Grp., Inc.*, 529 U.S. 803, 812 (2000) (“The distinction between laws burdening and laws banning speech is but a matter of degree.”); *see also In re Tam*, 808 F.3d 1321, 1340 (Fed. Cir. 2015) (en banc) (explaining that the government may impermissibly burden speech “even when it does so **indirectly**”).

Id. (emphasis added).

“Suppression of free speech is no less pernicious because it occurs in the digital, rather than the physical, realm.” *Id.* at 1323. “Like all congressional powers, the power to issue patents and copyrights is circumscribed by the First Amendment. *See Golan v. Holder*, 132 S. Ct. 873, 889–93 (2012); *Eldred v. Ashcroft*, 537 U.S. 186, 219–21 (2003).” *Intellectual Ventures I*, 838 F.3d at 1323, Judge Mayer, concurring.

I find this reasoning is applicable here, particularly because the scope of Appellants' claims *is not limited solely to inmates in prison facilities*. *See supra*, Spec. ¶ 21.

Moreover, dependent claim 12 recites: “wherein the **review process** is performed by **a software reviewer.**” (emphasis added).

Welcome to the new age of patented methods of censorship by machines over human speech, and patented machine-imposed restrictions on our selective ability to communicate with other humans!

Did our founding fathers ever contemplate such a bizarre scenario when they drafted the Bill of Rights? No. The first amendment only limits the power of the *government* to restrict speech — not machines.⁹ I can only speculate as to whether the founding fathers ever contemplated that a patent grant (from the government) might be enforced by a private patent owner to restrict speech in ways that the government itself could not.

This slippery slope is a threat to personal liberty. Even prison inmates do not surrender *all* of their constitutional rights when the iron door slams shut and locks. And we should be mindful that at least some of them are innocent, a victim of a wrongful conviction, as evidenced by the many who have been exonerated in light of DNA evidence not available at the time of the trial.

Although my concerns regarding such **indirect burdens** which restrict speech in a manner involving the patent system are serious enough to mention here, the resolution of such questions is outside the jurisdiction of this PTAB panel. These concerns have no bearing on my legal conclusion of the obviousness of the patent claims on appeal.

⁹ “Congress shall make no law . . . abridging the freedom of speech, or of the press” Amendment I.

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Therefore, the **important issues** regarding freedom of speech that are raised by this appeal are left to adversely affected parties to resolve in the courts in similar cases.

I respectfully dissent from the Majority opinion and cast my vote as a member of the panel to affirm the Examiner's rejection of all claims on appeal.