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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MATTHEW DAVID ANGORN, MASANAO  
HOMMA, DANIEL JONATHAN REISS, and ROBERT  
MATOUSEK

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Appeal 2019-000497  
Application 13/460,045  
Technology Center 2100

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Before ALLEN R. MACDONALD, MICHAEL J. ENGLE, and  
IFTIKHAR AHMED, *Administrative Patent Judges*.

AHMED, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1–19 and 21–31, which are all of the claims pending in the application. Claims 32–39 have been cancelled. App. Br. 10; Mar. 8, 2018 Advisory Act (entering amendment cancelling claims 32–39). We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). According to Appellant, the real party in interest is American Greetings Corporation. App. Br. 5.

*Technology*

The application relates generally “electronic greeting service and, more particularly, to systems, methods, and apparatuses for creating, displaying, editing, distributing and viewing of high-resolution electronic greeting cards or ‘ecards.’” Spec. 1.

*Illustrative Claims*

Claims 1 and 11 are illustrative and reproduced below with certain limitations at issue emphasized:

1. An electronic greeting card system including an application downloadable to a portable computing device comprising:

a server:

a paper greeting card;

a code printed on the paper greeting card;

***an electronic greeting card application program that is downloaded to the portable computing device from the server in response to the portable computing device scanning the code on the paper greeting card;***

a category of greeting cards provided by the electronic greeting card application;

a greeting card within the category of greeting cards, wherein the greeting card comprises four pages, with at least one of the four pages having an option to customize, and each of the four pages being electronically movable by a recipient by a touch of a finger; and

a means for selecting a medium to be used to send the greeting card from a group of sending media provided by the electronic greeting card application.

11. An electronic greeting card application for a portable computing device, comprising:

a category of greeting cards;

at least one greeting card within the category of greeting cards, wherein the at least one greeting card comprises four pages, with at least one of the four pages having an option to customize, and each of the four pages being electronically movable by a recipient by a touch of a finger;

a means for previewing the greeting card; and

*a means for selecting a medium to be used to send the greeting card.*

#### REJECTIONS

Claims 1, 2, 4, 7, and 8 stand rejected under 35 U.S.C. § 103(a) as obvious over the combination of Bienstock (US 2006/0075033 A1; Apr. 6, 2006); Petschnigg (US 2010/0175018 A1; July 8, 2010); Aslanian (US 7,702,542 B2; Apr. 20, 2010); Miller (US 2009/0070213 A1; Mar. 12, 2009); and Linder (Brad Linder, “*How to Scan QR Codes to Download Android Apps*,” Mobiputing.com (Apr. 1, 2010)). Final Act. 5–17.

Claims 11 and 16–18 stand rejected under 35 U.S.C. § 103(a) as obvious over the combination of Bienstock and Petschnigg. Final Act. 19–25.

Claims 3, 5, 6, 9, 10, 12–15, 19, and 21–31 stand rejected under 35 U.S.C. § 103(a) as obvious over various combinations of Bienstock, Petschnigg, and other references. Final Act. 15–19, 23–36.

## ISSUES

Did the Examiner err in finding a person of ordinary skill in the art would have had reason to combine Bienstock, Petschnigg, Aslanian, Miller, and Linder in the manner recited by the limitations of claim 1?

Did the Examiner err in finding that Bienstock teaches or suggests “a means for selecting a medium to be used to send the greeting card,” as recited in claim 11?

## ANALYSIS

### *§ 103 Rejection of Claim 1*

Independent claim 1 recites multiple limitations related to “an electronic greeting card application,” including “an electronic greeting card application program that is downloaded to the portable computing device from the server in response to the portable computing device scanning the code on the paper greeting card.”

The Examiner finds claim 1 obvious over the combination of Bienstock, Petschnigg, Aslanian, Miller, and Linder. Final Act. 5–12.

Appellant contends that in rejecting claim 1 as obvious over the combination of *five* different references, the Examiner provides “no stated reason why one of ordinary skill in the art would combine these particular references.” App. Br. 22. Appellant argues that the primary reference in the Examiner’s rejection, Bienstock, “relates to a *module* or *add-on* integral to an existing email client of a computer,” and “there would be no purpose for combining Bienstock with references that disclose features relating to acquiring an *independent application* or sending media via channels other than email.” App. Br. 24 (citing Bienstock ¶¶ 4–6, 28) (emphasis added). In fact, Appellant contends, Bienstock teaches away from the combination of

elements recited in claim 1 because one of Bienstock's system's touted features is that it allows a user to "create a multi-media message without requiring the sender to operate a separate multi-media program that runs as an application independent of the email application." *Id.* (quoting Bienstock ¶ 28) (emphasis omitted). Because "Bienstock is wholly directed to an email system," Appellant explains, "one cannot simply tack on to Bienstock[']s system] additional methods of sending a greeting card other than by email," in the manner that the Examiner did by combining Bienstock with Aslanian. *Id.* at 25. According to Appellant, "[o]ne of ordinary skill in the art would have no reason or motivation for providing 'multiple options for sending of an electronic greeting card,' . . . other than by email, because Bienstock *is* an email system." *Id.* Likewise, Appellant argues, the Examiner's reasoning in combining Bienstock with Linder is flawed because Linder's teaching of downloading software "is simply not applicable to Bienstock which operates as a feature of an existing email client, no download required." *Id.* at 26. In sum, Appellant concludes, "Bienstock relates to an email system, not a stand-alone application, and thus there is no reason or motivation for combining Bienstock with other references that relate to features that would have no relation to an email system." *Id.*

In response, the Examiner finds that "Bienstock in [and] of itself is an electronic greeting card application in that it comprises a series of applets that when combined or integrated with an email application can be used as an electronic greeting card application." Ans. 8. The Examiner determines that "Bienstock, by virtue of its ability to be integrated with an email application, suggests that the email application is extensible," and is "able to accept any number of add-ons or plug-ins to carry out additional functions,"

e.g., using the text messaging or facsimile functionality disclosed in Aslanian. Ans. 8–9. Likewise, the Examiner finds, an extensible Beinstock email application could have been combined with the disclosures of Linder and Miller to “provide[] a mechanism by which Bienstock’s applets may have been obtained by scanning a code printed on a paper greeting card that links to applet such that the user may then download the applet and incorporate it into th[at] email application.” *Id.* at 10.

We are not persuaded that a person having ordinary skill in the art would have a reason to combine the specific references in the manner determined by the Examiner. We agree with Appellant that Bienstock addresses shortcomings of separate applications. *See* Bienstock ¶¶ 4–6. One problem that Bienstock addresses “is that the [greeting card] multi-media file may require recording with a multi-media program *that runs separately* from an email program such that the recorded file *must be merged* with the email program.” *Id.* ¶ 6 (emphasis added). As Appellant points out, one of the benefits of Bienstock’s invention is that it

allows the sender to create a multi-media message without requiring the sender to operate a *separate* multi-media program that runs as an application independent of the email application. The present invention is able to provide *this feature* by integrating multi-media functionality with the email interface so that the user can easily add multi-media elements to the email while operating inside the email application. This *integrated* approach for multi-media messaging is provided when the user clicks on a “multi-media mail” button 40 included on the GUI. *Id.* ¶ 28 (referring to Fig. 2) (emphasis added).

Thus, we agree with Appellant that Bienstock fails to disclose a separate electronic greeting card application program, and instead discloses

an integrated feature of an existing email client. App. Br. 24. We are therefore not persuaded that a person of ordinary skill in the art would have been motivated to extend the application program disclosed in Beinstock in the manner proposed by the Examiner.

Even if we agree with the Examiner that Bienstock discloses “a series of applets that when combined or integrated with an email application can be used as an electronic greeting card application” (Ans. 8), that “electronic greeting card application” would be the larger email application itself. We are not persuaded that a person of ordinary skill in the art would have modified that email application to add additional methods of sending a greeting card in the manner disclosed by Aslanian, or combined that application with the disclosures of Linder and Miller such that the email application (not the applets alone) could be downloaded to the portable computing device from the server in response to the portable computing device scanning the code on the paper greeting card, as recited by claim 1. *See Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993 (Fed. Cir. 2017) (explaining that it is not enough “that a skilled artisan, once presented with the two references, would have understood that they *could be* combined,” because that “does not imply a motivation to pick out those two references and combine them to arrive at the claimed invention”) (citing *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015)). Such modifications to Bienstock would have changed the principle operation method of Bienstock’s email system, and we therefore find error in the Examiner’s reasoning.

Thus, we agree with Appellant that the Examiner has not shown that a person of ordinary skill in the art would have had reason to combine

Bienstock with Petschnigg, Aslanian, Miller, and Linder in the manner recited by the limitations of claim 1. Accordingly, given the record before us, we do not sustain the Examiner’s rejection of independent claim 1 and dependent claims 2–10.

*§ 103 Rejection of Claim 11*

Independent claim 11 recites a “means for selecting a medium to be used to send the greeting card.” The Examiner construes the corresponding structure for this claim limitation under 35 U.S.C. § 112, paragraph six as follows:

For claim 11, limitation 4, “*a means for selecting a medium to be used to send the electronic greeting card*”, pages 20-23, paragraphs [0083]-[0089] describe the ***various means or options by which an electronic greeting card may be sent*** by a sender to a recipient utilizing the electronic greeting card application (see definition of mobile application or “app,” p. 5, [0024]) executing on a portable (e.g. mobile) computing device (see Fig. 1, p. 5, [0025] for definition of “computer” or “processing unit”).

Final Act. 4 (emphasis added). Next, the Examiner determines that Bienstock teaches this means plus function limitation because Bienstock “describes [a] method an[d] system for creating and sending electronic mail messages that include multi-media files.” Final Act. 23.

Appellant argues that “the Examiner ***identically*** construed the means-for-selecting-a-medium limitations of claims 1 and 11,” and that the Examiner “acknowledges that neither Bienstock nor Petschnigg teach the limitation ***for claim 1.***” App. Br. 29 (emphasis added). Appellant contends that “[t]he same reasoning applies to claim 11, and thus the rejection for claim 11 should be withdrawn.” *Id.* According to Appellant, “the act of ‘selecting’ axiomatically requires (‘various’) options,” and “[t]he

Examiner’s position regarding claim 11, that the ‘various means or options’ required by the means-for-selecting-a-medium limitation can be met by the single available medium of email, is flawed.” *Id.*

In response, the Examiner notes that “this limitation in claim 11 only requires a means for selecting a medium, whereas this limitation in claim 1 requires selecting a medium *from a group of mediums.*” Ans. 12 (emphasis added). The Examiner finds that distinction between the two claims mandates that “[c]laim 11 does not require a group of mediums, just a selectable single medium.” *Id.* The Examiner therefore determines that “[a] single selectable button for sending an email, as in Bienstock’s send button . . . reads on this limitation in claim 11.” *Id.* (citing Bienstock, Fig. 3, label 78).

Appellants respond that “[t]he Examiner’s new argument that pushing a send button satisfies the limitation does not comport with description in the specification, which the Examiner cites as the structure for limitation, at ¶¶ 83–89 of the Application.” Reply Br. 7.

We are persuaded that the Examiner has erred. As the Examiner recognized with respect to claim 1, “*Bienstock* appears to only consider sending its greeting card multi-media file as an electronic card via email and does not provide for sending *via a group of sending media.*” Final Act. 9. In fact, as discussed above, *Bienstock* is directed at a feature or add-on that plugs into an existing email client application. *See* *Bienstock* ¶ 8 (“a user can compose an email message in the email application and create and/or add a multi-media file to the email message from the email application, such as without exiting the email application or in the same window as in which the email message is composed”); *see also id.* at Fig. 3. Thus, in *Bienstock*,

the medium for sending the greeting card is already selected for the user as email, and the single selectable button for sending the email that the Examiner points to (*id.*, Fig. 3, label 78) merely sends the greeting card. In contrast, the corresponding structure identified by the Examiner for this claim limitation requires providing the user with “the various means or options by which an electronic greeting card may be sent.” Final Act. 4 (citing Spec. ¶¶ 83–89); *see also* Spec. Fig. 14. It is not clear from the record before us that Bienstock’s system provides the user an ability to *select* “a means or option by which an electronic greeting card may be sent,” as required by the Examiner’s construction, but instead just provides a user with a single button to *use* the pre-selected option of email to send an electronic greeting card. We therefore agree with Appellant that Bienstock fails to teach or suggest a means for selecting a medium to send the greeting card, as required by claim 11.

The Examiner also does not rely on Petschnigg as teaching this claim limitation in support of the obviousness rejection based on Bienstock and Petschnigg. Accordingly, given the record before us, we do not sustain the Examiner’s rejection of independent claim 11 and dependent claims 12–19 and 21–31.

## DECISION

For the reasons above, we reverse the Examiner’s decision rejecting claims 1–19 and 21–31.

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 2, 4, 7, 8	103	Bienstock, Petschnigg, Aslanian, Miller, Linder		1, 2, 4, 7 and 8
3	103	Bienstock, Petschnigg, Aslanian, Miller, Linder, Batchelder		3,
5	103	Bienstock, Petschnigg, Aslanian, Miller, Den Boer		5
6	103	Bienstock, Petschnigg, Aslanian, Miller, Linder, McCrory,		6
9	103	Bienstock, Petschnigg Aslanian, Miller, Linder, AmericanGreetings.com		9
10	103	Bienstock, Petschnigg Aslanian, Miller, Linder, Silverbrook		10
11, 16–18	103	Bienstock, Petschnigg		11, 16, and 18
21, 22	103	Bienstock, Petschnigg, Den Boer		21 and 22

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
12–14	103	Bienstock, Petschnigg, AmGr		12–14
15	103	Bienstock, Petschnigg, Parker		15
19	103	Bienstock, Petschnigg, Batchelder		19
23–25	103	Bienstock, Petschnigg, Moss		23–25
26–30	103	Bienstock, Petschnigg Aslanian		26–30
31	103	Bienstock, Petschnigg Silverbrook		31
<b>Overall Outcome</b>				<b>1–19 and 21–31</b>

REVERSED