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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/971,979	12/16/2015	Elvis Abreu	APC001	5704

66068 7590 08/24/2020

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EXAMINER	
HUA, QUAN M	

ART UNIT	PAPER NUMBER
2645	

NOTIFICATION DATE	DELIVERY MODE
08/24/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ELVIS ABREU and OSVALDO RODAMEZ ABREU

Appeal 2019-000860
Application 14/971,979
Technology Center 2600

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and LARRY J. HUME, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant[1] filed a Request for Rehearing ("Request") under 37 C.F.R. § 41.52(a)(1) for reconsideration of our Decision on Appeal, mailed June 23, 2020 ("Decision"). Our Decision affirmed the Examiner's decision rejecting claims 1–6, 9–12, 14–17, 20–26, 28, and 31–43 as being obvious under 35 U.S.C. § 103, over the cited combinations of references. Our Decision also affirmed the Examiner's decision rejecting claim 43 under 35 U.S.C. § 112(a) as lacking written description support.

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[1] 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 All Phase Consulting, Inc. *See* Appeal Br. 3.

In the Request, Appellant does not substantively traverse the analysis set forth in our Decision. Instead, Appellant urges that our analysis of the Examiner's obviousness rejections in our Decision qualifies as an undesignated new grounds of rejection.

In particular, Appellant cites *to Honeywell Int'l Inc. v. Mexichem Amanc Holding S.A*. (865 F.3d 1348, 1354 (Fed. Cir. 2017)), and argues that the Board has violated the notice provisions of the Administrative Procedure Act (5 U.S.C. § 551 et seq.), because we have changed the thrust of the Examiner's obviousness rejections in at least the following ways:

(1) Regarding Rejection C of independent claims 1 and 20, Appellant argues that our claim construction in our Decision improperly construes the word "and" as an "or." Request 3–5.

(2) Regarding Rejection B of independent claim 14 and Rejection C of independent claim 40, Appellant argues that our claim construction in our Decision construed the claim term "action module" under 35 U.S.C. § 112(f) for the first time in the prosecution history. Request 5–6.

(3) Appellant argues that our designation of the level of skill of a PHOSITA in our Decision creates a new ground of rejection because it affects the issues of combinability and hindsight. Request 6–8.

We have reviewed Appellant's arguments in the Request, our Decision, and have again reviewed the Examiner's obviousness rejections, and the Examiner's responses to Appellant's arguments as set forth in the Answer. On this record, we are not persuaded that we misapprehended or overlooked any points in rendering our Decision.

However, Appellant's new argument that our Decision contains an undesignated new ground of rejection is expressly permitted under 37 C.F.R.

§ 41.52(a)(4). In support, Appellant advances three principal arguments, as follows:

Request Argument (1)

Under Appellant's argument (1), and regarding Rejection C of independent claims 1 and 20, we disagree with Appellant that our claim construction in our Decision (12) improperly construes the word "and" as an "or." *See* Request 3–5. As stated in our Decision at page 11:

Claims 1 and 20 recite the same call management options, identified herein as limitations **A** and **B**:

> *performing one or more executable actions* on one or more of the incoming calls and the playing of the media on the user device by the uninterrupted media play and call management system *based on the processed selection* of the one of the one or more of the call management options, the call management options comprising:
>
> [**A**] accepting the incoming call while supporting the continued playing of the media on the user device; and
>
> [**B**] sending a message indicating an availability of the user device only for the text communication for the duration of the playing of the media.

Claim 1 (emphasis and bracketed labeling added).

As addressed in our Decision at page 12, we emphasize that the language of claim 1 merely requires: "*performing one or more executable actions* . . . based on the *processed selection* of the **one** of the **one** or more of the *call management options*" **A** and **B** (emphasis added). Independent claim 20 also recites: "*performing one or more executable actions* . . . based on the *processed selection* of the **one** of the **one** or more of the *call management options* **A** and **B** (emphasis added).

Therefore, we restate and clarify that claims 1 and 20 merely require the cited combination of references to teach or suggest "performing one or more executable actions on one or more of the incoming calls . . . based on the processed selection of the **one** of the **one or** more of the *call management options*, the call management options comprising:" **A** and **B**, meaning that under the broadest reasonable interpretation (BRI),[2] *either* call management option **A**, or call management option **B** must be selected, *but not requiring the* "processed selection" of *both call management options* **A** and **B**.[3] (emphasis added). *See* Decision 12.

Accordingly, we disagree that our claim construction regarding claims 1 and 20 constitutes a new ground of rejection, and we deny Appellant's request under Argument (1) that it be treated as a new ground of rejection.

Request Argument (2)

Under Request Argument (2), and regarding Rejection B of independent claim 14 and Rejection C of independent claim 40, we agree with Appellant that our claim construction in our Decision construed the claim term "action module" under 35 U.S.C. § 112(f) for the first time in the prosecution history. Request 5–6.

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[2] Throughout this opinion, we give the claim limitations the broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

[3] When a claim covers several alternatives, the claim may be unpatentable if any of the alternatives within the scope of the claim are taught by the prior art. *See Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001); *see also Schumer v. Lab. Computer Sys., Inc.*, 308 F.3d 1304, 1311 (Fed. Cir. 2002) (citing *Brown v. 3M*, 265 F.3d at 1352).

Although we do not agree as a general matter that routine *de novo* review of the Examiner's claim construction by the Board constitutes a new ground of rejection, to the extent that our application of *Williamson v. Citrix Online*, *LLC* (792 F.3d 1339, 1349 (Fed. Cir. 2015)) and 35 U.S.C. § 112(f) in the first instance on appeal has, *arguendo*, significantly changed the thrust of the affected rejections, procedural due process requires notice and a fair opportunity to respond.[4]

Accordingly, we agree to modify our Decision to the extent that we designate our Decision a **new ground of rejection** under 37 C.F.R. § 41.50(b) for the affected claims, specifically including Rejection B of independent claim 14 (which recites an "action module") and its associated dependent claims, including Rejection B of claims 15, 21–23 and 28, Rejection E of claims 16 and 24, Rejection G of claim 17, Rejection I of claim 25, and Rejection L of claim 26.

Because Rejection C of independent claim 40 also recites an "action module" we likewise designate our Decision regarding Rejection C of independent claim 40 as a new ground of rejection under 37 C.F.R. § 41.50(b).

[4] "[T]he ultimate criterion of whether a rejection is considered 'new' in a decision by the [B]oard is whether [applicants] have had fair opportunity to react to the thrust of the rejection." *In re Leithem*, 661 F.3d 1316, 1319 (Fed. Circ. 2011) (alterations in original) quoting *In re Kronig*, 539 F.2d 1300, 1302–03 (CCPA 1976) (holding no new ground of rejection when the Board relied on the same statutory basis and the same reasoning advanced by the examiner). *See also Honeywell Int'l Inc. v. Mexichem Amanc Holding S.A.*, 865 F.3d 1348, 1354 (Fed. Cir. 2017).

Request Argument (3)

Under Argument (3), Appellant urges that our new designation of the level of skill of a PHOSITA[5] in our Decision creates a new ground of rejection because it affects the issues of combinability and hindsight. Request 6–8.

As argued by Appellant: "In prosecution, the Examiner never defined the person of ordinary skill in the art. The first definition in the prosecution of the present application of the person of ordinary skill in the art occurs in the Decision on Appeal on page 24." *Id.* at 7.

Although the Declarant *Alejandra Martinez Cuevas* attests that a "Bachelor's Degree in Computer Science" plus relevant experience qualifies the Declarant as "an expert in the field of media play and call management systems" (Declaration 1), we have not made any finding regarding the level of skill of an *expert* in the art.

We have merely found that a bachelor's degree in computer science plus relevant experience would be "representative of the level of *ordinary* skill in the art as applicable to this appeal." Decision 24–25 (emphasis added). Therefore, we do not agree with Appellant that we have conflated the level of skill of an expert in the art with the level of *ordinary* skill in the art as applicable to this appeal. *See* Request 7, footnote 2. We have thus considered the educational level of active workers in the field. We do not agree with Appellant that our factual finding regarding the level of *ordinary* skill in the art as applicable to this appeal (Decision 24–25) constitutes a

[5] PHOSITA means a "Person Having Ordinary Skill in the Art."

new ground of rejection. Therefore, we deny Appellant's Request as articulated under Request argument (3).

DECISION

We have reconsidered our Decision, in light of Appellant's arguments in the Request, and are not persuaded that we misapprehended or overlooked any points in rendering our Decision.

We grant Appellant's Request for Rehearing *only to the extent* that we have reconsidered our Decision and have modified it to be a **new ground of rejection** under 37 C.F.R. § 41.50(b), as applicable **only** to the affected claims under Appellant's Request Argument (2), specifically including Rejection B of independent claim 14 (which recites an "action module") and its associated dependent claims, including Rejection B of claims 15, 21–23 and 28, Rejection E of claims 16 and 24, Rejection G of claim 17, Rejection I of claim 25, and Rejection L of claim 26.

Because independent claim 40 also recites an "action module" we likewise designate our Decision regarding Rejection C of independent claim 40 as a new ground of rejection under 37 C.F.R. § 41.50(b). Claim 40 has no dependent claims.

Correction of Typographical Error — ERRATUM

As noted in our Decision on page 32, footnote 6: "We note the Examiner omitted claims 41 and 42 from the heading of Rejection C on page 40 of the Final Action. However, the Examiner provided a detailed statement of rejection for claims 41 and 42 under the Rejection C heading on page 56 of the Final Action. We have made appropriate correction herein."

This correction was made for Rejection C on page 5 of our Decision, in which the list of "Claims Rejected" by the Examiner under Rejection C is correctly shown as: "1–4, 9, 20, 32, 40–42."

The list of "Claims Rejected" by the Examiner under Rejection C is also correctly shown as "1–4, 9, 20, 32, 40–42" in the DECISION SUMMARY table on page 33 of our Decision.

However, the "Affirmed" column for Rejection C on page 33 of our Decision inadvertently omits claims 41 and 42. This omission of claims 41 and 42 is a typographical error.

We therefore additionally modify our Decision to correct this typographical error in which the incomplete list of claims "1–3, 4, 9, 20, 32, 40" under the "Affirmed" column for Rejection C is modified on page 33 of our Decision to read: "1–4, 9, 20, 32, 40–42."

As modified, this corrects the DECISION SUMMARY table on page 33 to agree with our holding on page 32 of our Decision: "we sustain the Examiner's obviousness Rejection C of claims 1–4, 9, 20, 32, and 40–42."

We make no other changes or modifications to our Decision.

Section 41.50(b) provides that "[a] new ground of rejection pursuant to this paragraph **shall not be considered final for judicial review**." Thus, WITHIN TWO MONTHS FROM THE DATE OF THIS REHEARING DECISION, Appellant must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the newly rejected claims:

> (1) *Reopen prosecution.* Submit an **appropriate amendment** of the claims so rejected **or new evidence** relating to the claims so rejected, **or both**, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner;[6] **or**
>
> (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record.

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). *See* 37 C.F.R. § 41.50(f).

[6] Regarding option (1), "*Reopen prosecution*," and particularly regarding the requirement to submit *an amendment and/or new evidence*, please note MPEP 1214.01(I): "If the appellant submits an argument without either an appropriate amendment or new evidence as to any of the claims rejected by the Board, *it will be treated as a request for rehearing* under 37 C.F.R. 41.50(b)(2)." If for any reason Appellant desires to reopen prosecution before the Examiner *without submitting an amendment and/or new evidence*, a Request for Continued Examination (RCE) that complies with 37 C.F.R. § 114 will remove the application from the jurisdiction of the Board under 37 C.F.R. § 41.35, and will reopen prosecution before the Examiner.

MODIFIED DECISION SUMMARY

Outcome of Decision on Rehearing:

Rej	Claims Rejected	35 U.S.C. §	Reference(s)/ Basis	Denied	Granted	New Grounds
B	14, 15, 21–23, 28	103	Cannon, Eide, Ort, Kim '278, Luehrig	14, 15, 21–23, 28		14, 15, 21–23, 28
C	1–4, 9, 20, 32, 40–42	103	Cannon, Ort, Kim '278, Luehrig	1–4, 9, 20, 32, 40–42		40
E	16, 24	103	Cannon, Eide, Ort, Kim '278, Luehrig, Kim '401	16, 24		16, 24
G	17	103	Cannon, Eide, Ort, Kim '278, Luehrig, Kim '401, Carion	17		17
I	25	103	Cannon, Eide, Ort, Kim '278, Luehrig, Sommer	25		25
L	26	103	Cannon, Eide Ort, Kim '278, Luehrig, Dorcey	26		26
	Overall Outcome			1–4, 9, 14–17, 20–26, 28, 32, 40–42		14–17, 21–26, 28, 40

Final Outcome of Appeal after Rehearing:

Rej	Claims Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Rev	New Ground
A	43	112(a)	Written Description	43		
B	14, 15, 21–23, 28	103	Cannon, Eide, Ort, Kim '278, Luehrig	14, 15, 21–23, 28		14, 15, 21–23, 28
C	1–4, 9, 20, 32, 40, 41, 42	103	Cannon, Ort, Kim '278, Luehrig	1–4, 9, 20, 32, 40, 41, 42		40
D	5, 33, 36	103	Cannon, Ort, Kim '278, Luehrig, Kim '401	5, 33, 36		
E	16, 24	103	Cannon, Eide, Ort, Kim '278, Luehrig, Kim '401	16, 24		16, 24
F	6, 31	103	Cannon, Ort, Kim '278, Luehrig, Kim '401, Carion	6, 31		
G	17	103	Cannon, Eide, Ort, Kim '278, Luehrig, Kim '401, Carion	17		17
H	11, 34	103	Cannon, Ort, Kim '278, Luehrig, Sommer	11, 34		
I	25	103	Cannon, Eide, Ort, Kim '278, Luehrig, Sommer	25		25
J	10	103	Cannon, Ort, Kim '278, Luehrig, Hannum	10		
K	12, 35	103	Cannon, Ort, Kim '278, Luehrig, Dorcey	12, 35		
L	26	103	Cannon, Eide Ort, Kim '278, Luehrig, Dorcey	26		26
M	37, 38	103	Cannon, Ort, Kim '278, Luehrig, Incoming Mail	37, 38		
N	39	103	Cannon, Ort, Kim '278, Luehrig, Yeh	39		
O	43	103	Cannon, Ort, Kim '278, Luehrig, Vendrow	43		

Rej	Claims Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Rev	New Ground
	Overall Outcome			1–6, 9–12, 14–17, 20–26, 28, 31–43		14–17, 21–26, 28, 40

GRANTED IN PART; 37 C.F.R. § 41.50(b)