



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/659,472	10/24/2012	MING TUNG LAU	CN920110096US1_8150-0310	1027
52021	7590	02/04/2020	EXAMINER	
Cuenot, Forsythe & Kim, LLC 20283 State Road 7 Ste. 300 Boca Raton, FL 33498			CHANG, JULIAN	
			ART UNIT	PAPER NUMBER
			2455	
			NOTIFICATION DATE	DELIVERY MODE
			02/04/2020	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ibmptomail@iplawpro.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MING TUNG LAU and WAI MAN LEE

Appeal 2019-000965
Application 13/659,472
Technology Center 2400

Before JAMES B. ARPIN, MIRIAM L. QUINN, and
DAVID J. CUTITTA II, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a), the rejections of claims 26–49. Final Act. 2.² Claims 1–25 are cancelled. Appeal Br. 2. We have jurisdiction under 35 U.S.C. § 6(b).

Because the claims lack adequate written description, we enter a new

¹ “Appellant” here refers to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party-in-interest as IBM Corporation. Appeal Br. 1.

² In this Decision, we refer to Appellant’s Appeal Brief (“Appeal Br.,” filed May 31, 2018) and Reply Brief (“Reply Br.,” filed November 19, 2018); the Final Office Action (“Final Act.,” mailed January 2, 2018) and the Examiner’s Answer (“Ans.,” mailed September 17, 2018); and the originally-filed Specification (“Spec.,” filed October 24, 2012). Rather than repeat the Examiner’s findings and determinations and Appellant’s contentions in their entirety, we refer to these documents.

ground of rejection under 35 U.S.C. § 112, ¶ 1, and procedurally reverse the rejections under 35 U.S.C. § 103(a).

STATEMENT OF THE CASE

Appellant’s claimed subject matter relates to Instant Messaging (“IM”) system processing, including obtaining contents of an IM session, identifying participants of the IM session, extracting keywords of the IM session from the contents, and associating the keywords and the participants with the corresponding IM session. Spec., Abstract.

As noted above, claims 26–49 stand rejected. Claims 26, 34, and 42 are independent. Appeal Br. 25 (claim 1), 26–27 (claim 34), 28–29 (claim 42) (Claims App.). Claims 27–33 depend directly or indirectly from claim 26; claims 35–41 depend directly or indirectly from claim 34; and claims 43–49 depend directly or indirectly from claim 42. *Id.* at 25–30.

Claim 34 recites “[a] computer hardware system, comprising: a hardware processor configured to initiate the following executable operations,” which performs functions, substantially as recited in claim 26. *Id.* at 26–27. Claim 42 recites “[a] computer program product, comprising: a computer readable hardware storage device³ having stored therein program code, the program code, which when executed by a computer hardware system, causes the computer hardware system to perform” functions,

³ Claim 42 does not recite expressly that the storage device is non-transitory (Appeal Br. 28 (Claims App.); *see* Spec. ¶¶ 35–37), nor does the Examiner determine the scope of claim 42’s recitation of the “computer readable hardware storage device.” When prosecution resumes, the Examiner should determine whether claim 42 encompasses non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356–57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter).

substantially as recited in claim 26. *Id.* at 28–29. The Examiner relies on the same references and substantially similar arguments in rejecting claims 26, 34, and 42 (Final Act. 6–12), and Appellant does not contest the rejections of claims 27–49 separately from claim 26 (Appeal Br. 8, 21, 22). Therefore, we focus our analysis on independent claim 26.

Claim 26, reproduced below with disputed limitations emphasized, is representative.

26. A computer-implemented method, comprising:

identifying participants of a plurality of different sessions between different sets of users in a single-platform communication system;

extracting, automatically and from the plurality of different sessions; keywords;

generating, automatically and based upon the extracted keywords, a plurality of different clusters of the plurality of different sessions; and

causing, on a client computer system, the plurality of different clusters to be concurrently visual depicted, wherein

at least a first cluster and a second cluster of the plurality of different clusters include *both keywords and participants that are both mutually exclusive to each other*, and

the single-platform communication system is an instant messaging system.

Id. at 25 (emphasis added).

REFERENCES AND REJECTIONS

The Examiner relies upon the following references in rejecting the claims:

Name⁴	Number	Pub'd/Issued	Filed
Newman	US 2004/0113953 A1	June 17, 2004	Dec. 16, 2002
Dholakia	US 2009/0307319 A1	Dec. 10, 2009	June 9, 2008
Chatani	US 2010/0125633 A1	May 20, 2010	Sept. 18, 2009
Bansal	US 2010/0318620 A1	Dec. 16, 2010	June 16, 2009
Amidon	US 9,122,645 B1	Sept. 1, 2015	Dec. 20, 2006

Specifically, the Examiner rejects claims 26–30, 32, 34–38, 40, 42–46, and 48 under 35 U.S.C. § 103(a) as obvious over the combined teachings of Dholakia, Chatani, and Newman (Final Act. 6–14); claims 31, 39, and 47 under 35 U.S.C. § 103(a) as obvious over the combined teachings of Dholakia, Chatani, Newman, and Bansal (*id.* at 14); and claims 33, 41, and 49 under 35 U.S.C. § 103(a) as obvious over the combined teachings of Dholakia, Chatani, Newman, and Amidon (*id.* at 15).

Because we determine that reversal of the rejection of independent claim 26 is dispositive with respect to the Examiner's rejections, except for our ultimate decision, we do not discuss the merits of the rejections of claims 27–49 further herein. We review the appealed rejection of independent claim 26 for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). We address the rejection of claim 26 below.

⁴ All reference citations are to the first named inventor only.

ANALYSIS

1. Non-Obviousness of Claim 26 Over Dholakia, Chatani, and Newman

As noted above, the Examiner rejects independent claim 26 as obvious over the combined teachings of Dholakia, Chatani, and Newman. Final Act. 6–12. Specifically, the Examiner finds that Dholakia teaches:

a computer-implemented method, comprising:

identifying participants of a plurality of different sessions between different sets of users in a single-platform communication system;

extracting, automatically and from the plurality of different sessions keywords; [and]

generating, automatically and based upon the extracted keywords, a cluster of the plurality of different sessions; . . .

wherein the single-platform communication system is an instant messaging system,

as recited in claim 26. *Id.* at 6–7 (citing Dholakia ¶¶ 14, 27, 38, Fig. 2 (steps 206, 218)).

The Examiner acknowledges, “Dholakia fails to teach causing, on a client computer system, the plurality of different clusters to be concurrently visually depicted, wherein at least a first cluster and a second cluster of the plurality of different clusters include both keywords and participants that are both mutually exclusive to each other.” *Id.* at 7. However, the Examiner finds Chatani teaches or suggests “causing, on a client computer system, the plurality of different clusters to be concurrently visually depicted, wherein at least a first cluster and a second cluster of the plurality of different clusters include . . . participants that are both mutually exclusive to each other.” *Id.* (citing Chatani ¶ 30, Fig. 2).

Chatani's Figure 2 is reproduced below.

FIG.2

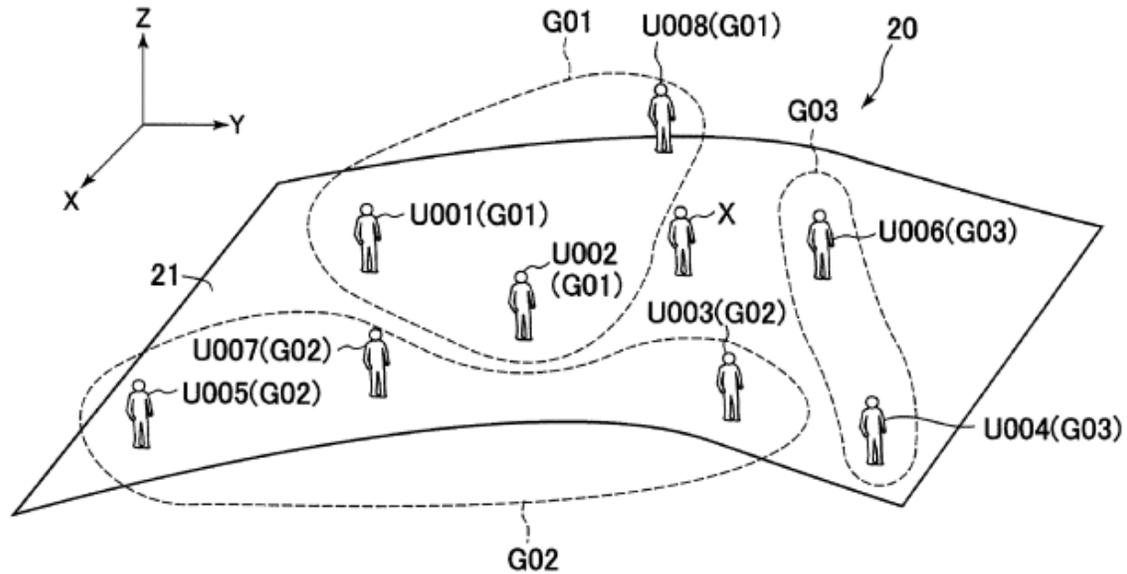


Figure 2 “is a perspective view showing an example of a virtual space.”

Chatani ¶ 12. In particular, Chatani explains:

FIG. 2 is a perspective view showing one example of the virtual space. As shown in the diagram, a game stage 21 is placed in the virtual space 20 and avatars U001 to U008 are placed on the game stage 21. Each avatar is correlated to any game terminal 14, and moves on the game stage 21 according to an operation carried out by a user using an operating device equipped to the correlated game terminal 14.

Id. ¶ 20. Thus, Chatani teaches mutually exclusive clusters G01, G02, and G03 of participants U001–U008 on a client computer system, i.e., game terminal 14. The Examiner further finds that a person of ordinary skill in the relevant art would have had reason to combine the teachings of Dholakia and Chatani “to incorporate a virtual space, as taught by Chatani, into Dholakia, in order to allow a user to easily discern the topics of respective conversations.” Final Act. 7–8; *see* Ans. 4–7 (citing Chatani ¶ 23).

The Examiner also acknowledges that the combined teachings of Dholakia and Chatani “fail[] to teach that at least a first cluster and a second cluster of the plurality of different clusters include keywords mutually exclusive to each other.” Final Act. 8. However, the Examiner finds that “Newman teaches at least a first cluster and a second cluster of the plurality of different clusters include keywords mutually exclusive to each other.” *Id.* (citing Newman, Fig. 2). Moreover, the Examiner concludes “[i]t would have been obvious for one of ordinary skill in the art at the time of the invention to incorporate a list of frequent keywords, as taught by Newman, into Dholakia-Chatani, in order to allow a user to easily discern the topic of a cluster.” *Id.*; see Newman ¶ 102 (describing keyword list 112), Fig. 1.

Appellant raises numerous challenges to the proposed combination of the teachings of Dholakia, Chatani, and Newman. We are persuaded that one of these challenges shows dispositive Examiner error.

Newman’s Figure 2 is reproduced below.

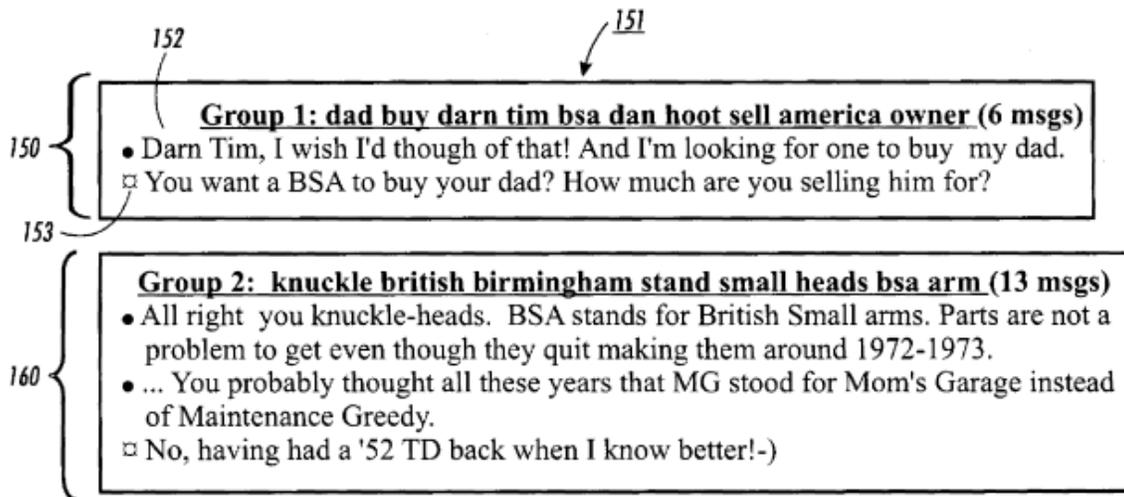


FIG. 2

Figure 2 depicts two groups forming “the second part of an overview of a

93-message discussion.” Newman ¶ 65.

Referring to Newman’s Figure 2, Appellant notes that each group’s keyword lists includes the term “bsa.” Appeal Br. 19. Thus, Appellant contends Newman does not teach keyword lists that are “mutually exclusive,” and a person of ordinary skill in the art would not understand the combined teachings of Dholakia, Chatani, and Newman to teach “at least a first cluster and a second cluster of the plurality of different clusters include *both* keywords and participants that are *both* mutually exclusive to each other.” *Id.* at 19–20, 25 (Claims App.) (emphasis added).

The Examiner responds that Newman’s Figure 3 depicts Groups 3 and 4, which do not have shared keywords. Ans. 7. The Examiner finds

the fact that the groups (i.e., clusters) of messages of Newman are derived from a common group of messages does not change the teaching or rationale for which Newman is relied upon. In particular, Newman discloses that “archived discussions pay varying amounts of attention to the ostensible subject and initial contribution, and often branch into several subtopics, so the reader cannot assume, based only on the ostensible subject, whether any portion of the discussion is actually of interest, and, if so, what parts of the discussion.”

Id. at 7–8 (quoting Newman ¶ 20 (describing background art)). Newman’s Figures 1–3 depict Groups 0–4, each of which contains part of a 93-message discussion. Newman ¶¶ 64–66. Thus, read in context, Newman’s Figures 1–3 teach or suggest only that clusters could include mutually exclusive or non-exclusive (i.e., shared) keywords.

Referring to newly cited Figure 3 of Newman, the Examiner explains, “[w]hile Newman generates clusters of messages differently from the claimed invention and Dholakia does not negate the benefits of displaying a plurality of clusters based on keywords.” Ans. 8. Appellant notes, “[t]he

Examiner has presented an explanation as to *why* it would have been obvious to include keywords with the different clusters. However, the Examiner has not presented an explanation as to *why* it would have been obvious to include keywords that are mutually exclusive to each other, as claimed.” Reply Br. 8–9 (emphases added). We agree.

At best, the Examiner shows that a person of ordinary skill in the relevant art *could* have combined the teachings of Dholakia, Chatani, and Newman to achieve claimed method, including the disputed limitation. However, it is not sufficient proof of obviousness to show that a combination *could* have been made. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006))). At worst, the Examiner relies on the claim limitations to impermissibly guide the combination of the references’ teachings to achieve the recited methods. *See Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1369 (Fed. Cir. 2012) (“On the basis of this evidence, hindsight provides the only discernable reason to combine the prior art references. Unless one knew that negative pressure *could* be used to treat wounds, there *would* be no reason to combine the prior art to arrive at the claimed device and methods.” (emphases added)).

To show the methods recited in claim 26 are obvious, the Examiner must demonstrate that the combined teachings of Dholakia, Chatani, and Newman teach or suggest all of the recited limitations *and* that a person of ordinary skill in the relevant art would have had reason to combine those

teachings in the manner proposed to achieve the claimed methods. The Examiner fails to do so here, and Appellant persuades us that the Examiner erred in rejecting claim 26, as obvious over the combined teachings of Dholakia, Chatani, and Newman. Consequently, we do not sustain the obviousness rejection of claim 26.

2. *Claims 27–49*

Each of claims 34 and 42 includes substantially similar limitations to the disputed limitations of claim 26 discussed above. Appeal Br. 26–27, 28–29 (Claims App.). Each of claims 27–33, 35–41, and 43–49 depends directly or indirectly from independent claim 26, 34, or 42. *Id.* at 25–30. As noted above, Appellant challenges the rejection of independent claims 34 and 42 for substantially the same reasons as claim 26 and of the dependent claims for the same reasons as their base claims. *See* Appeal Br. 8, 21, 22. Because we are persuaded the Examiner erred with respect to the obviousness rejection of claim 26, we also are persuaded the Examiner erred with respect to the obviousness rejections of claims 27–49. For this reason, we do not sustain the Examiner’s rejections of those claims.

NEW GROUNDS OF REJECTION OF CLAIMS 26–49 UNDER
37 C.F.R. § 41.50(B)

We make the following new grounds of rejection:

- Claims 26–49 are rejected under 35 U.S.C. § 112, ¶ 1, as lacking adequate written description.

35 U.S.C. § 112, ¶ 1, provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is

most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

As our reviewing court has explained,

The ‘written description’ requirement implements the principle that a patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor’s obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed.

Capon v. Eshhar, 418 F.3d 1349, 1357 (Fed. Cir. 2005).

Claim 26 recites a computer-implemented method comprising steps including:

causing, on a client computer system, the plurality of different clusters to be concurrently visual depicted, wherein
at least a first cluster and a second cluster of the plurality of different clusters include *both keywords and participants that are both mutually exclusive to each other*

Appeal Br. 25 (emphasis added). Appellant added claims 26–49 by an Amendment filed on May 1, 2017. In that Amendment, Appellant does not state where support for this limitation is found in the Specification.

The Specification’s drawings depict clusters with non-exclusive keywords and participants (Spec., Fig. 4a) and clusters of both mutually exclusive and non-exclusive keywords and participants (*id.*, Fig. 4b). However, apart from claims 26, 34, and 42, we do not find where the Specification describes clusters including both keywords and participants “that are both *mutually exclusive* to each other.” In fact, the Specification does not include the phrase “mutually exclusive” in describing the visually depicted clusters. Nor do we see how the Specification addresses generating clusters that result in the specifically claimed clusters with keywords and

participants that are “both mutually exclusive to each other.” Therefore, we reject independent claims 26, 34, and 42, and the claims dependent therefrom, under 35 U.S.C. § 112, ¶ 1, for lack of adequate written description.

DECISIONS

1. The Examiner erred in rejecting claims 26–49 under 35 U.S.C. § 103(a) as obvious over the combined teachings of Dholakia, Chatani, and Newman, alone or in combination with the teachings of Bansal or Amidon.
2. We determine that claims 26–49 are unpatentable under 35 U.S.C. § 112, ¶ 1, as lacking of adequate written description.
3. Thus, on this record, claims 26–49 are unpatentable.

CONCLUSION

For the above reasons, we reverse the Examiner’s decision rejecting claims 26–49 as obvious over the combined teachings of Dholakia, Chatani, and Newman, alone or in combination with the teachings of Bansal or Amidon, but we determine claims 26–49 are unpatentable as lacking adequate written description.

In summary:

Claims Rejected	35 U.S.C. §	References/Basis	Affirmed	Reversed	New Ground
26–30, 32, 34– 38, 40, 42–46, 48	103(a)	Dholakia, Chatani, Newman		26–30, 32, 34– 38, 40, 42–46, 48	
31, 39, 47	103(a)	Dholakia, Chatani,		31, 39, 47	

		Newman, Bansal			
33, 41, 49	103(a)	Dholakia, Chatani, Newman, Amidon		33, 41, 49	
26-49	112, ¶ 1	Written Description			26-49
Overall Outcome				26-49	26-49

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, 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 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. . . .
- (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01. No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

REVERSED; 37 C.F.R. § 41.50(b)