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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 REQUEST FOR REHEARING

Pursuant to 37 C.F.R. § 41.52, Appellant¹ filed a Request for Rehearing (“Req. Reh’g”), dated February 10, 2020, seeking reconsideration of our Decision on Appeal mailed February 4, 2020 (“Dec.”), in which we reversed the Examiner’s rejection of claims 26–49 under 35 U.S.C. § 103(a) as rendered obvious over the combined teachings of Dholakia, Chatani, and Newman, alone or in combination with other references² (Final Act. 5–15³),

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 our Decision, we provide a table identifying the references upon which the Examiner relies. Dec. 4.

³ 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

but we entered a new ground rejecting claims 26–49 under 35 U.S.C. § 112, ¶ 1, as lacking adequate written description (Dec. 12–13). For the reasons given below, we deny Appellant’s request for rehearing.

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 stood 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 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;

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.

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).

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 device⁴ having stored therein program code, the program code, which when executed by a computer hardware system, causes the computer hardware system to perform” functions, substantially as recited in claim 26. *Id.* at 28–29. Each of claims 34 and 42 recites the disputed limitation in claim 26, emphasized above (*id.* at 25–29), and the Examiner relied on the same references and substantially similar arguments in rejecting claims 26, 34, and 42 (Final Act. 6–12). Appellant does not contest the rejections of claims 27–49 separately from claim 26. Appeal Br. 8, 21, 22; Req. Reh’g 2. Therefore, we again focus our analysis on independent claim 26.

⁴ See Dec. 2 n.3.

ANALYSIS

“The panel . . . reviews the obviousness rejection 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). Pursuant to 37 C.F.R. § 41.50(a)(1), “[t]he Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims *specified by the examiner*.” (Emphasis added.) Under 37 C.F.R. § 41.52(a)(1),

The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised, and Evidence not previously relied upon, pursuant to §§ 41.37, 41.41, or 41.47 are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) through (a)(4) of this section.

(Emphasis added.)

Appellant requested rehearing of our Decision for two reasons. Req. Reh’g. 2. First, although it presented three distinct and alternative challenges allegedly demonstrating error in the Examiner’s rejections of claim 26–49, we were persuaded by one of those challenges and found the demonstrated error dispositive with respect to the Examiner’s rejections. *Id.* at 3–4. Thus, Appellant contends we *overlooked* two of its challenges to the rejected claims. *Id.* at 4. Second, Appellant *disagrees* with our determination in the new grounds of rejection that claims 26–49 lack adequate written description. *Id.* at 2, 5–8. For the reasons given below, we deny the request for rehearing.

A. Alternative Challenges to the Examiner’s Rejections

In its Appeal and Reply Briefs, Appellant presented three distinct and

alternative challenges, each allegedly demonstrating error in the Examiner's rejections of claim 26–49. In its first and second challenges, Appellant disputes the Examiner's findings regarding the teachings of Chatani and Dholakia and the combination of those teachings. *See* Appeal Br. 13, 15, 17; Reply Br. 5, 7. In its third challenge, Appellant disputes the Examiner's finding that, in combination with the teachings of Chatani and Dholakia, Newman teaches or suggests “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. 17–21; Reply Br. 8–9. Appellant did not prioritize these challenges in its Appeal and Reply Briefs, nor, in particular, did it indicate that success of more than one of these challenges was necessary to demonstrate Examiner error.

Appellant now contends that we should address the first and second challenges to the Examiner's rejections because:

If, for example, the Board finds that the Examiner erred based upon either the first or second sets of arguments identified above, Appellants can delete the language at issue, which should place the claims in condition for allowance. Referring to the first full paragraph on page 8 of the appealed Fourth Office Action, the cited reference of Newman was only cited as to the language at issue. By deleting this language, the Examiner's rejection would effectively be transformed into a rejection based upon the combination with Dholakia and Chatani. However, since Appellants' first and second sets of arguments specifically addressed the combination of Dholakia and Chatani, finding error based upon either the first or second sets of arguments would result in a determination that the combination of Dholakia and Chatani fails to render, as obvious, the remaining limitations (after the limitations at issue has been deleted).

Req. Reh'g 3 (emphases added). Thus, Appellant contends that, by now addressing the alternative challenges, we might decide that the Examiner

erred for other reasons, which would allow Appellant to amend the claims during further prosecution to overcome the new grounds of rejection and to overcome effectively a different rejection from the rejection that is the subject of the appeal. Because Appellant presented its challenges in the alternative in its Appeal and Reply Briefs, we are not persuaded that we overlooked Appellant's first and second challenges in our Decision.

Moreover, Appellant may not fully appreciate the limited nature of appeals. *See* 37 C.F.R. § 41.50(a)(1) (quoted with emphasis above). In an appeal, we consider Appellant's arguments and evidence of Examiner error in the rejections that the Examiner made to the pending claims. We do not speculate on other rejections that the Examiner might make or might have made with respect to claims that were not before the Examiner and are not before us. Further, in this particular application, the limitation that we determined the Examiner failed to show is taught or suggested by Newman was added to the claims to overcome obviousness rejections based on another reference and an indefiniteness rejection. Amendment, 2, 8–9 (filed May 1, 2017); Amendment, 2, 8 (filed Nov. 9, 2017); *see* Dec. 11; *see also Ex parte Lau*, Appeal No. 2016-006050 (March 1, 2017) (affirming obviousness rejections of earlier claims in this application). Therefore, even if Appellant is correct that our ruling on the merits of the first and second challenges to the Examiner's rejections of the *pending* claims also would allow Appellant to overcome the present rejections, as well as a presumptive rejection based only on the teachings of Chatani and Dholakia of a *yet-to-be amended* claim, the result merely may be Appellant's overcoming a future rejection, but rendering the amended claim again subject to a previous rejection. These, however, are not issues for us to decide prospectively on

this record, but, instead, are appropriately addressed by Appellant and the Examiner during further prosecution.

For the reasons given above, we are not persuaded by Appellant's first reason for requesting rehearing.

B. Lack of Adequate Written Description

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*

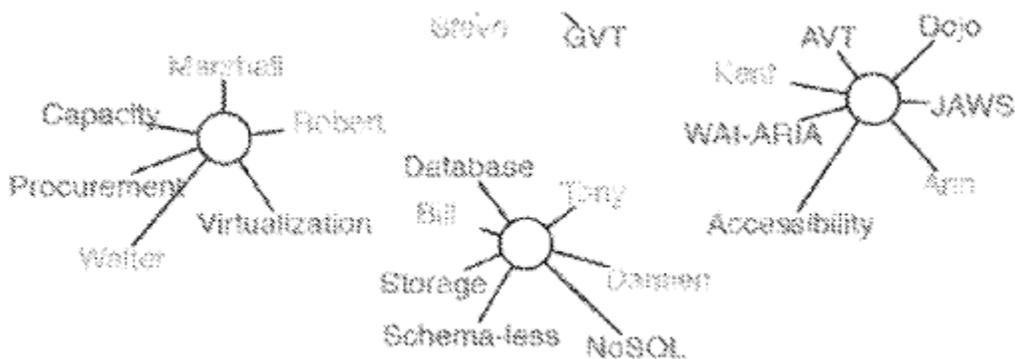
Appeal Br. 25 (emphasis added).

In our Decision, we noted the Specification's drawings depict clusters of both mutually exclusive and non-exclusive keywords and participants. Dec. 11 (discussing Spec., Figs. 4a, 4b); *see* Spec. ¶¶ 26–28. However, in our Decision, we noted that we do not find where the Specification describes clusters including *both* keywords and participants “that are both *mutually exclusive* to each other.” Dec. 11–12. Appellant disagrees. Req. Reh'g 2.

Although Appellant acknowledges that the Specification does not include the phrase “mutually exclusive” in describing the visually depicted clusters, Appellant contends the Specification need not provide *in haec verba* support for the claim language in order to supply adequate written description. *See id.* at 6; Dec. 11; *see also Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (The exact claim terms “need not be used in haec verba.”). Instead, Appellant contends that Figure 4b

provides adequate written description supporting this limitation. Req. Reh’g 6–8.

In particular, Appellant reproduces a portion of Figure 4b including three clusters, which Appellant contends shows clusters that include “*both keywords and participants that are both mutually exclusive to each other.*” *Id.* at 6. The portion of Figure 4b presented by the Appellant is reproduced below.



Id. This reproduced portion of Figure 4b shows the bottom three clusters of the drawing. Appellant explains, “[f]or ease of reference, Appellants will label the three illustrated clusters, from left to right, as Cluster A, Cluster B, Cluster C. The following table lists the participants and keywords, respectively, for Cluster A, Cluster B, and Cluster C:”

	Cluster A	Cluster B	Cluster C
Participants	Marshall, Robert, Walter	Bill, Tony, Damien	Kent, Ann
Keywords	Capacity, Procurement, Virtualization	Database, Storage, Schema-less, NoSQL	AVT, Dojo, JAWS, WAI-ARIA, Accessibility

Id. at 7. Depiction of this portion of Figure 4b and the information provided in Appellant’s table, however, present a portion of the Specification’s disclosure out of context.

Figure 4b is reproduced below in its entirety and with our annotations.

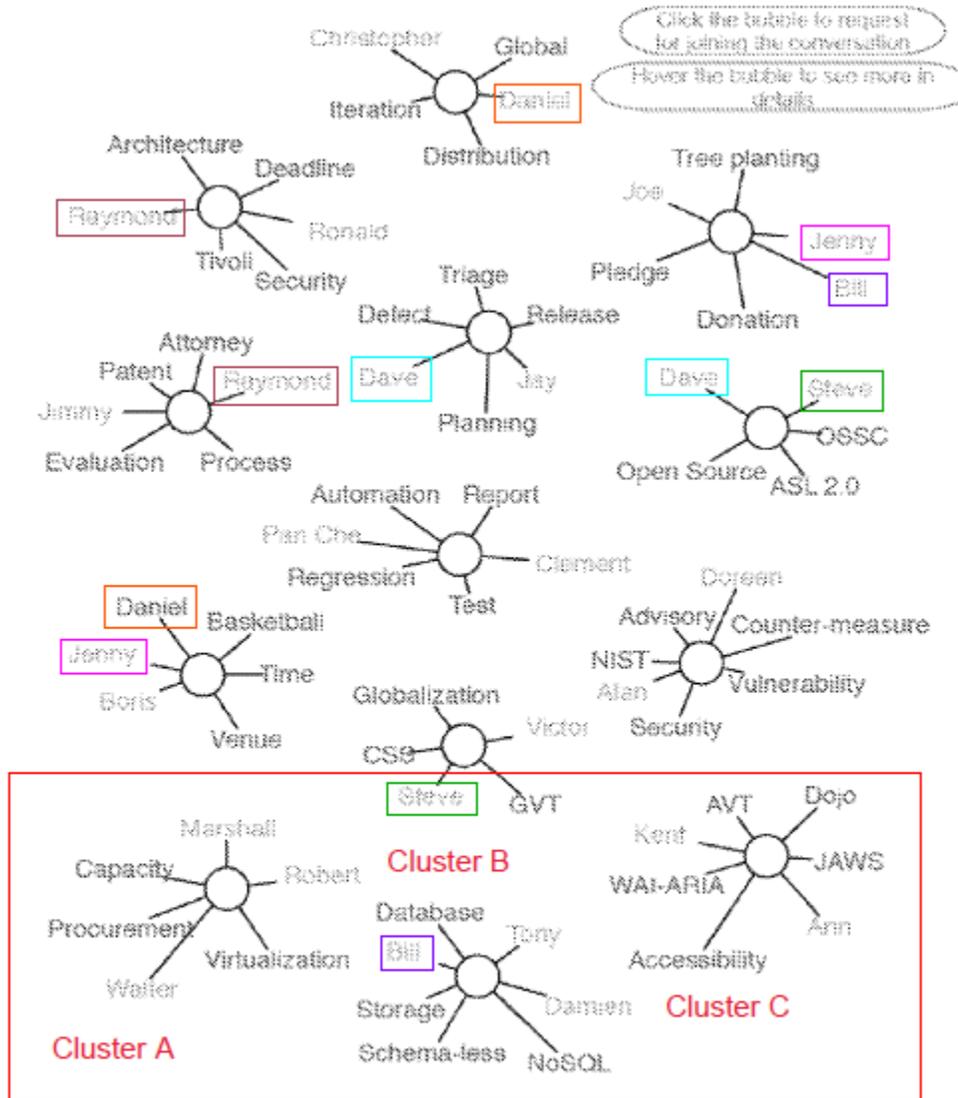


Fig. 4b

The Specification explains, “Fig. 4b simply shows an example of outputting the above association in a graph, wherein each star represents an IM session cluster, the light-colored words represent the participants of the IM session clusters, and the dark-colored words represent the keywords of the IM

session clusters.” Spec. ¶ 27; *see id.* ¶ 26, Fig. 4a (describing clusters of overlapping keywords and participants). We have enclosed the portion of Figure 4b reproduced by Appellant in a rectangle and have labeled Clusters A–C. We also have enclosed the overlapping participants of the various clusters in rectangles, including participant “Bill” of Cluster B, who also appears in another cluster that was not part of Appellant’s reproduced portion of Figure 4b. *See* Req. Reh’g 7.

Although drawings may provide adequate written description (*id.* at 7–8 (quoting MPEP § 2163(II))), we consider a drawing in its entirety and in the context of the rest of the Specification. The Specification explains:

It is noted that Figs. 4a-4b are merely examples, and the association between the keywords of the IM session, the participants of the IM session and the corresponding IM session as well as the association between the keywords of the IM session cluster, the participants of the IM session cluster and the corresponding IM session cluster can be output visually in any other manners.

Spec. ¶ 28. The Specification describes Figures 4a and 4b as mere examples and discloses that other visual outputs of participants and the IM session clusters are possible. *Id.* However, Figures 4a and 4b as a whole depict *non-exclusive* keywords or participants, or both, rather than mutually exclusive keywords or participants. We are persuaded the Specification lacks clear disclosure of “mutually exclusive” keywords and participants. Consequently, we are not persuaded the reproduced portion of Figure 4b and Appellant’s accompanying contentions satisfy the requirement of 35 U.S.C § 112, ¶ 1, to provide a written description “demonstrate[ing] that [Appellant] was in possession of the invention *that is claimed.*” *Capon v. Eshhar*, 418 F.3d 1349, 1357 (Fed. Cir. 2005) (emphasis added).

Finally, Appellant contends, because the Examiner rejected the predecessor to this limitation as indefinite, but entered a corrective amendment, the Examiner was concerned with the requirements of 35 U.S.C. § 112, ¶ 2, and presumably at that same time considered the written description requirements of 35 U.S.C. § 112, ¶ 1. Req. Reh'g 8; *see* Amendment, 2, 8 (filed Nov. 9, 2017). Consequently, because the Examiner did not reject the amended claim for lack of adequate written description then, Appellant concludes that the Examiner previously determined that the amended limitation had adequate written description in the Specification. Req. Reh'g 8. We are not persuaded that the Examiner's rejection of the claim limitation for one deficiency is proof that the Examiner expressly found the claim limitation was otherwise sufficient. Nevertheless, we have the authority to enter a new ground of rejection regardless of the Examiner's prior actions or inactions. *See* 37 C.F.R. § 41.50(b).

For the reasons given above, we are not persuaded by Appellant's second reason for requesting rehearing.

DECISION

Appellant's Request for Rehearing is denied.

Appeal 2019-000965
 Application 13/659,472

Outcome of Decision on Rehearing:

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, Newman, Bansal		31, 39, 47	
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

Final Outcome of Appeal after Rehearing:

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, Newman, Bansal		31, 39, 47	
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

DENIED