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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/827,670	08/17/2015	Zeke Koch	P2187-US	4342
108982	7590	07/02/2020	EXAMINER	
SBMC 116 W. Pacific Avenue Suite 200 Spokane, WA 99201			HUANG, CHENG-FENG	
			ART UNIT	PAPER NUMBER
			2497	
			NOTIFICATION DATE	DELIVERY MODE
			07/02/2020	ELECTRONIC

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ZEKE KOCH, BALDO FAIETA, JEN-CHAN CHIEN,
MARK M. RANDALL, OLIVIER SIRVEN,
PHILIPP KOCH, and DENNIS G. NICHOLSON

Appeal 2019-002111
Application 14/827,670
Technology Center 2400

Before ALLEN R. MacDONALD, JEAN R. HOMERE, and
ERIC B. CHEN, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–7, 9, 10, and 13–22. Appeal Br. 3. Claims 8, 11, and 12 have been cancelled. *Id.* at 25–28 (Claims App). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellant identifies the real party in interest as Adobe Systems, Inc. Appeal Br. 3.

CLAIMED SUBJECT MATTER

Claims 1 and 9 are illustrative of the claimed subject matter
(emphasis, formatting, and bracketed material added):

1. In a digital medium environment for control of content creation by at least one computing device of a content creation service, a system comprising:
 - [A.] a content creation module implemented at least partially in hardware of a processing system and computer-readable storage media of the at least one computing device to expose functionality via a user interface to create content;
 - [B.] a fingerprint generation module implemented at least partially in hardware of the processing system and the computer-readable storage media of the at least one computing device to generate a fingerprint of an image received by the content creation module as part of creating the content; and
 - [C.] a licensing module implemented at least partially in hardware of the processing system and the computer-readable storage media of the at least one computing device to:
 - [i.] *use the fingerprint to determine whether the received image is available for licensing* via a content sharing service and
 - [ii.] output a result of this determination for display by the content creation module in the user interface along with the exposed functionality to create the content and without leaving a display of the exposed functionality and a display of the received image in the user interface.

9. In a digital medium environment for control of content creation by at least one computing device of a content creation service, a system comprising:
 - [A.] a content creation module implemented at least partially in hardware of a processing system and computer-readable storage media of the at least one computing device to expose functionality via a user interface to create content;
 - [B.] a watermark identification module implemented at least partially in hardware of the processing system and the computer-readable storage media of the at least one computing device to detect a watermark included in an image received by the content creation module as part of creating the content and identify a content sharing service that corresponds to the detected watermark; and
 - [C.] ***a licensing module*** implemented at least partially in hardware of the processing system and the computer-readable storage media of the at least one computing device ***to provide an option*** within a user interface ***generated by the content sharing service to license the image from the identified content sharing service***, the user interface generated by the content sharing service is displayed within and without navigating away from the user interface used to create the content by the content creation module.

REFERENCES²

The Examiner relies on the following references:

Name	Reference	Date
Yacobi	US 7,047,413 B2	May 16, 2006
Neil	US 7,127,106 B1	Oct. 24, 2006
Weiskopf	US 2007/0168513 A1	July 19, 2007
Masters	US 2016/0180193 A1	June 23, 2016

REJECTIONS

A.

The Examiner rejects claims 1–3 and 15–22, under 35 U.S.C. § 103 as being unpatentable over the combination of Weiskopf and Masters. Final Act. 10–18.

Appellant argues separate patentability for claim 1. To the extent that Appellant discusses claim 15, Appellant merely repeats or references the arguments directed to claim 1. Appeal Br. 17–19. To the extent that Appellant discusses claims 2, 3, and 16–22, Appellant merely references the arguments directed to claims 1, 9, and 15. Appeal Br. 23–24. Such a repeated argument (or referenced argument) is not an argument for “separate patentability.” Thus, Appellant does not present separate arguments for claims 2, 3, and 15–22. We select claim 1 as the representative claim for this rejection. Except for our ultimate decision, we do not address the merits of the § 103 rejection of claims 2, 3, and 15–22 further herein.

² All citations herein to patent and pre-grant publication references are by reference to the first named inventor only.

B.

The Examiner rejects claims 5–7, 9, 10, 13, and 14 under 35 U.S.C. § 103 as being unpatentable over the combination of Weiskopf, Masters, and Yacobi. Final Act. 18–26.

Appellant argues separate patentability for claim 9. Appeal Br. 19–23. We select claim 9 as the representative claim for this rejection. Appellant does not argue separate patentability for claims 5–7, 10, 13, and 14. To the extent that Appellant discusses claims 5–7, 10, 13, and 14, Appellant merely references the arguments directed to claims 1 and 9. Appeal Br. 23. Such a referenced argument is not an argument for “separate patentability.” Except for our ultimate decision, we do not address the merits of the § 103 rejection of claims 5–7, 10, 13, and 14 further herein.

C.

The Examiner rejects claim 4 under 35 U.S.C. § 103 as being unpatentable over the combination of Weiskopf, Masters, and Neil. Final Act. 18.

To the extent that Appellant discusses claim 4, Appellant merely references the arguments directed to claims 1, 9, and 15. Appeal Br. 24. Such a repeated argument (or referenced argument) is not an argument for “separate patentability.” Thus, the rejection of this claim turns on our decision as to claim 1 (from which claim 4 depends). Except for our ultimate decision, we do not address the merits of the § 103 rejection of claim 4 further herein.

OPINION

We have reviewed the Examiner’s rejections in light of Appellant’s Appeal Brief and Reply Brief arguments.

A. Claim 1

A.1.

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103.

First, there is no description in Masters of any method or system that determines whether a received image is available for licensing. . . .

Second, as Masters fails to describe or suggest determining “whether the received image is available for licensing . . . ,” the feature of outputting “a result of this determination for display . . . with the exposed functionality . . . without leaving a display of the exposed functionality and a display of the received image . . .” by logical consequence, also does not exist. All a user in Masters does is view items advertised for sale by a retailer or internet store from various perspectives before making a purchase decision. . . .

Weiskopf fails to cure the deficiency of Masters. Weiskopf describes a method or system of “enabling a content provider and its users to easily manage licenses . . . for selected or provided content.” [See Weiskopf at ¶ [0014] (emphasis added).] To that end, Weiskopf uniquely identifies content provided to users by digital identifiers or fingerprints and notifies the user if he is currently licensed to use the content, whether his previous license has expired, whether a license to use the selected content is unavailable, and if content that is similar to the one the user is interested in licensing is available. [See *Id.*] While Weiskopf’s system determines whether a customer has licensed content that has been provided to him, there is no description or suggestion of a system or method with the content creation module, fingerprint generation module, and licensing module functioning as recited in claim 1.

Appeal Br. 13–14.

We are unpersuaded by Appellant’s argument. Appellant does not address the actual reasoning of the Examiner’s rejection. Instead, Appellant attacks the Masters reference singly for lacking a teaching that the Examiner relied on a combination of Weiskopf and Masters to show. In particular, the rejection does not rely on Masters for teaching the “whether the received image is available for licensing . . .” (Appeal Br. 13) aspect disputed by Appellant. Rather, the Examiner relied on Weiskopf to show “a licensing module . . . to use the fingerprint to determine whether the received image is available for licensing via a content sharing service” (Final Act. 10), and relied on Masters to show it was known to output a result . . . for display by the content creation module in the user interface along with the exposed functionality to create the content and without leaving a display of the exposed functionality and a display of the received image in the user interface (Final Act. 11). The Examiner then reasoned that it would have been obvious to modify the content licensing of Weiskopf to include functionality from Masters’ content creation. Final Act. 11. One cannot show nonobviousness by attacking references individually when the rejection is based on a combination of references. *In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *see also In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (explaining the relevant inquiry is whether the claimed subject matter would have been obvious to those of ordinary skill in the art in light of the *combined teachings* of those references).

A.2.

Also, Appellant raises the following argument in contending that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103.

Additionally, the user in Masters views a preview image of the shoe rack—likely temporarily—in order to help him make a purchase decision. [See Masters at ¶ [0095].] As such, the user also *cannot be said to “create content”* as recited in claim 1.

Appeal Br. 13 (emphasis added).

We note that Masters states:

As previously described, augmented reality techniques *can be used to present a modified version of a received image* to a user. This modified version of the received image may illustrate how the recommended item can be used with items illustrated in the received image.

Masters ¶ 40 (emphasis added).

In some cases, the image generator **358 creates a new image** based on the received image and the one or more models of items. In other cases, the image generator **358 may modify the received image** by replacing portions of the received image or overlaying one or more models of items over portions of the received image.

Masters ¶ 42 (emphasis added).

We are unpersuaded by Appellant’s argument. Contrary to Appellant’s argument, we determine that Masters does “create content” as required by claim 1.

A.3.

Further, Appellant raises the following argument in contending that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103.

[R]egarding the motivation to combine the references, the Examiner asserts that:

It would have been obvious to one having ordinary skill in the art before the effective filing date of the

claimed invention to combine the teachings of Masters with the disclosure of Weiskopf. The motivation/suggestion would have been to *use[] augmented reality to preview how* an item may be used in conjunction with another item in a particular context.

Office Action, p. 11. The motivation, however, fails to have the requisite rational underpinning to support the legal conclusion of obviousness. In particular, the Examiner's motivation fails to address the features recited in claim 1 entirely, stating simply that "an item may be used in conjunction with another item in a particular context." [See Office Action at p. 11.] Such a statement could be applied literally to any field, technology, or concept.

Appeal Br. 15–16 (emphasis added).

We are unpersuaded by Appellant's argument. Although initially Appellant quotes the Examiner's entire motivation statement, Appellant then highly truncates that statement and asserts that highly truncated motivation "fails to have the requisite rational underpinning." As with the Keller-type argument discussed above, this form of argument does not address the actual reasoning of the Examiner's rejection.

A.4.

Furthermore, Appellant raises the following argument in contending that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103.

[W]hile Weiskopf may discuss licensing images, the Examiner's interpretation of Weiskopf as teaching "whether . . . [a] received image is available for licensing via a content sharing service . . ." conflicts with the Examiner's interpretation of ". . . a result of this determination . . ." which also relates to determining "whether . . . [a] received image is available for licensing . . ." In other words, the Examiner has conflicting interpretations of the same feature recited in claim 1. Such conflicting interpretations cannot be reconciled.

Masters also fails disclose creating content as recited in claim 1 because claim 1 requires outputting “. . . a result of this determination along with the exposed functionality to create the content . . . ” Instead, Masters simply enables a user to view a preview image of an item as part of a 3D model prior to making a purchase decision.

Reply Br. 6.

[T]he motivation to combine Weiskopf and Masters lacks a rational underpinning needed to support an obviousness conclusion. Previewing how one item is used with another item says nothing about how or why a determination of “whether . . . [a] received image is available for licensing via a content sharing service . . . ” is performed. This feature of claim 1 also provides a distinct advantage that is absent from the cited references – enabling a user to interact with a content creation service, obtain images for licensing, and using these images to create content.

Reply Br. 8.

As to Appellant’s above assertions, we are not persuaded that the Examiner erred. These Reply Brief arguments were not previously argued in the Appeal Brief, or newly raised by the Examiner in the Answer. Rather, these are belated arguments that reasonably should have been raised in the original Appeal Brief.

In the absence of a showing of good cause by Appellant, we decline to consider an argument raised for the first time in the Reply Brief, as the Examiner has not been provided a chance to respond. *See* 37 C.F.R. § 41.41(b)(2) (2012); *In re Hyatt*, 211 F.3d 1367, 1373 (Fed. Cir. 2000) (noting that an argument not first raised in the brief to the Board is waived on appeal); *Ex parte Nakashima*, 93 USPQ2d 1834, 1837 (BPAI 2010) (informative) (explaining that arguments and evidence not timely presented in the principal brief will not be considered when filed in a reply brief, absent a showing of good cause explaining why the argument could not have

been presented in the principal brief); *Ex parte Borden*, 93 USPQ2d 1473, 1477 (BPAI 2010) (informative) (“Properly interpreted, the Rules do not require the Board to take up a belated argument that has not been addressed by the Examiner, absent a showing of good cause.”). Appellant has provided no showing of good cause.

B. Claim 9

B.1.

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 9 under 35 U.S.C. § 103.

There is no description in Masters of any method or system that is designed to “provide an option . . . to license . . . [an] image.” [*See* Claim 9.]

Appeal Br. 20.

This argument repeats the argument made as to claim 1. We are unpersuaded by Appellant’s argument for the reasons already discussed above as to claim 1.

B.2.

Also, Appellant raises the following argument in contending that the Examiner erred in rejecting claim 9 under 35 U.S.C. § 103.

Yacobi fails to disclose or suggest a licensing module as recited in claim 9. Instead, Yacobi’s specification discusses in detail the manner in which its watermarking process improves on the traditional spread-spectrum watermarking.

Appeal Br. 21.

We are unpersuaded by Appellant’s argument. As discussed above, Appellant does not address the actual reasoning of the Examiner’s rejection. Instead, Appellant attacks the Yacobi reference singly for lacking a teaching that the Examiner relied on a combination of Weiskopf, Masters, and Yacobi

to show. In particular, the rejection does not rely on Yacobi for teaching the “licensing module” (Appeal Br. 21) aspect disputed by Appellant. Rather, the Examiner relied on Weiskopf to show “a licensing module . . . to provide an option generated by the content sharing service to license the image from the identified content sharing service” (Final Act. 21), and relied on Masters to show it was known to use a content creation module and a display content (Final Act. 22), and relied on Yacobi to show it was known to use a watermark identification module (Final Act. 23). The Examiner then reasoned that it would have been obvious to modify the content licensing of Weiskopf to include functionality from Masters’ content creation (Final Act. 22) and from Yacobi’s watermarking (Final Act. 23).

Again, one cannot show nonobviousness by attacking references individually when the rejection is based on a combination of references. *Merck*, 800 F.2d at 1097; *Keller*, 642 F.2d at 425 (explaining the relevant inquiry is whether the claimed subject matter would have been obvious to those of ordinary skill in the art in light of the *combined teachings* of those references).

B.3.

Further, Appellant raises the following argument in contending that the Examiner erred in rejecting claim 9 under 35 U.S.C. § 103.

Additionally, the user in Masters likely temporarily views a preview image of a shoe rack (one that is likely already licensed or authorized) in order to make a purchase decision. [See Masters at ¶ [0095].] As such, the user ***does not “create content”*** as recited in claim 9.

Appeal Br. 20–21 (emphasis added).

As above, we note that Masters states:

As previously described, augmented reality techniques *can be used to present a modified version of a received image* to a user. This modified version of the received image may illustrate how the recommended item can be used with items illustrated in the received image.

Masters ¶ 40 (emphasis added).

In some cases, the image generator **358** *creates a new image* based on the received image and the one or more models of items. In other cases, the image generator **358** *may modify the received image* by replacing portions of the received image or overlaying one or more models of items over portions of the received image.

Masters ¶ 42 (emphasis added).

We are unpersuaded by Appellant’s argument. Again, contrary to Appellant’s argument, we determine that Masters does “create content” as required by claim 9.

B.4.

Furthermore, Appellant contends that the Examiner erred in rejecting claim 9 under 35 U.S.C. § 103(a) because:

[R]egarding the motivation to combine the references, the Examiner asserts that:

It would have been obvious to one having ordinary skill in the art before the effective filing date of the claimed invention to combine the teachings of Yacobi with the combined teaching of Weiskopf and Masters. The motivation/suggestion would have been *to facilitate rights enforcement of digital goods using watermarks*.

[See Office Action at p. 23.]

The motivation, however, fails to have the requisite rational underpinning to support the legal conclusion of obviousness. Specifically, the motivation fails to state a reason why the skilled artisan would combine the references in a manner that to yield the features recited in the claim 9. . . .

The Examiner’s motivation fails to adequately discuss the features recited in claim 9. Instead, it generically states that the motivation would have been to “facilitate rights enforcement of digital goods using watermarks.” [See Office Action at p. 23.] Such a motivation lacks the requisite rational underpinning to support an obviousness conclusion because it entirely fails to address why one of ordinary skill in the art would combine Weiskopf, Masters, and Yacobi to design a system that displays images and features in the manner recited in claim 9. Such features have the distinct advantage allowing a user to “remain in the context of the content creation service and obtain images available for licensing for inclusion as part of the content,” which is achievable primarily because of the way in which the content creation module, water identification module, and licensing module recited in claim 9 operate in conjunction with one another. [See Application at ¶¶ [0018], [0070], and [0072].]

Appeal Br. 22–23 (emphasis added).

We are unpersuaded by Appellant’s argument. Again, Appellant truncates the Examiner’s motivation statement and asserts the truncated motivation “fails to have the requisite rational underpinning.” First, Appellant fails to acknowledge the first part (the motivation to combine Weiskopf and Masters) of the overall motivation. Final Act. 22. Then Appellant partially truncates the second part (the motivation to combine Weiskopf/Masters and Yacobi) of the overall motivation by not including the citation to the Abstract of Yacobi. Final Act. 23. As before, this form of argument does not address the actual reasoning of the Examiner’s rejection.

CONCLUSION

The Examiner has not erred in rejecting claims 1–7, 9, 10, and 13–22 as being unpatentable under 35 U.S.C. § 103.

The Examiner’s rejections of claims 1–7, 9, 10, and 13–22 as being unpatentable under 35 U.S.C. § 103 are **affirmed**.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–3, 15–22	103	Weiskopf, Masters	1–3, 15–22	
5–7, 9, 10, 13, 14	103	Weiskopf, Masters, Yacobi	5–7, 9, 10, 13, 14	
4	103	Weiskopf, Masters, Neil	4	
Overall Outcome			1–7, 9, 10, 13–22	

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED