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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EDWIN W. PETERS, SHERRY L. PLATEK,
NITTY T. PULIKAN, BALAJI RANGANATHAN, LIVIU RODEAN,
BALASUBRAMANIAN SIVASUBRAMANIAN,
and ERIC WOODS

Appeal 2019-002736
Application 14/523,250
Technology Center 2100

Before ST. JOHN COURTENAY III, ERIC S. FRAHM, and
CATHERINE SHIANG, Administrative Patent Judges.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from a Final rejection of claims 21–30. Claims 1–20 are canceled. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We reverse.

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 IBM Corporation. *See* Appeal Br. 1.

STATEMENT OF THE CASE ²

Introduction

Appellant’s claimed invention relates generally “to note taking within a virtual meeting.” (Spec. ¶ 1).

Independent Claim 21

21. A computer-implemented method within a computer hardware system, comprising:

a hardware processor configured to initiate the following executable operations:

receiving a first meeting user notes from a first participant of a virtual meeting;

receiving a second meeting user notes from a second participant of the virtual meeting;

[L] *analyzing text of the first and second meeting user notes to identify key elements therein;*

cross-referencing the analysis of the text of first and second meeting user notes to identify a common key element in the analysis thereof that is common to both the first and second meeting user notes; and

generating consolidated system notes that include the common key element, wherein

the identifying of a key element includes establishing that each key element meets a predetermined threshold of significant.

Appeal Br. 17, “CLAIMS APPENDIX.” (Bracketed lettering added and disputed limitations “L” emphasized).

² We herein refer to the Final Office Action, mailed June 1, 2018 (“Final Act.”); Appeal Brief, filed Oct. 10, 2018 (“Appeal Br.”); the Examiner’s Answer, mailed Jan. 2, 2019 (“Ans.”), and the Reply Brief, filed Feb. 19, 2019 (“Reply Br.”).

References

The prior art relied upon by the Examiner as evidence is:

Name	Reference	Date
Kansal	US 2009/0119246 A1	May 7, 2009
Agapi et al.	US 2009/0271438 A1	Oct. 29, 2009
Yoshida et al.	US 2007/0013945 A1	Jan. 18, 2007
Bingaman et al.	US 2006/0233334 A1	Oct. 19, 2006
Moran et al.	US 6,018,346	Jan. 25, 2000

Rejections

- A. Claims 21–30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting (OTDP) as being unpatentable over claims 28–47 of copending Application No. 13/838,731.
- B. Claims 21–23, 26, 27, and 30 are rejected as being unpatentable under pre-AIA 35 U.S.C. § 103(a) over Kansal in view of Agapi et al. (“Agapi”).
- C. Claims 24 and 25 are rejected as being unpatentable under pre-AIA 35 U.S.C. § 103(a) over Kansal, Agapi, and Yoshida et al. (“Yoshida”).
- D. Claim 28 is rejected as being unpatentable under pre-AIA 35 U.S.C. § 103(a) over Kansal, Agapi, and Bingaman et al. (“Bingaman”).
- E. Claim 29 is rejected as being unpatentable under pre-AIA 35 U.S.C. § 103(a) over Kansal, Agapi, and Moran et al. (“Moran”).

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Prior Decision

PTAB Appeal 2016-008464, Application No. 14/523,250, decided April 28 2017. Examiner affirmed.

Related Appeals

This appeal is related to PTAB Appeal 2019-002741, stemming from co-pending Application No. 13/838,731. (Appeal Br. 1). *See* March 16, 2020 Board Decision: Examiner Affirmed. The instant appeal and Appeal 2019-002741 have the same assignee (IBM Corporation), and are filed by the same inventive entity (Peters et al.).

This appeal is also related to PTAB Appeal 2016-004945 (Application No. 14/216,682) (Notice of Allowance mailed Dec. 10, 2019) and PTAB Appeal 2016-004920 (Application No. 13/839,038) (Notice of Allowance mailed Dec. 17, 2019). These appeals also have the same assignee (IBM Corporation), and are filed by the same inventive entity (Peters et al.).

ANALYSIS

We have considered all of Appellant's arguments and any evidence presented. In our analysis below, we highlight and address specific findings and arguments for emphasis.

Rejection A of Claims 21–30 under Provisional Non-statutory OTDP

When all other rejections on appeal have been reversed, and the only remaining rejections are provisional non-statutory OTDP rejections, it is

premature to address the provisional rejections. *Ex Parte Moncla*, 95 USPQ2d 1884, 1885 (BPAI 2010) (precedential).

Here, we reverse *infra* the Examiner's Rejections B, C, D, and E, of claims 21–30, over the cited prior art, for the reasons discussed below. Therefore, the only remaining rejection on appeal is the provisional non-statutory OTDP Rejection A of claims 21–30.

However, we **do not reach** provisional OTDP Rejection A of claims 21–30 to decide this appeal, following the precedential authority of *Moncla*, 95 USPQ2d at 1885.

Rejection B of Independent Claim 21 under § 103

Issues: Under 35 U.S.C. § 103, we focus our analysis on the following argued limitations that we find are to be dispositive regarding Rejection B of claims 21–23, 26, 27, and 30:

Did the Examiner err by finding that Agapi teaches or suggests the disputed, dispositive limitations “L”:

“analyzing text of the first and second meeting user notes to identify key elements therein;

cross-referencing the analysis of the text of first and second meeting user notes to identify a common key element in the analysis thereof that is common to both the first and second meeting user notes; and

generating consolidated system notes that include the common key element, wherein

the identifying of a key element includes establishing that each key element meets a predetermined threshold of significant,”

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within the meaning of representative claim 21?³ (emphasis added). *See* Final Act. 5–6.

Appellant contest limitations “L” of claim 21, by contending:

[T]he Examiner has not specifically identified those teachings within Agapi being relied upon by the Examiner and mapped those teachings to the limitations at issue. Rather, the Examiner generally refers to paragraphs [0008] and [0057] of Agapi *without explanation*.

Appeal Br. 8 (emphasis added).

Secondly, Appellant contends that the Examiner’s obviousness analysis represented:

no more than the Examiner repeating the limitations at issue as the “rational underpinning.” In essence, the Examiner is merely arguing that it would have been obvious to include “X” for the purpose of having “X.” This is not a rational underpinning — it is *circular reasoning*,

Appeal Br. 11 (emphasis added).

Regarding the first contention, and based upon our review of the record, we agree with Appellant that the Examiner’s mapping of the disputed limitations is unclear, because the Examiner supports the rejection with a grouping of citations, without providing a clear mapping of the

³ We give the contested claim limitations the broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

individual claim terms to the corresponding specific feature(s) found in Agapi. *See* Final Act. 5–6.

We note the Board is a reviewing body that does not perform initial examination. To show obviousness (or anticipation), the Examiner must provide a clear mapping of each claim limitation to the corresponding specific feature found in the reference, which the Examiner must identify with particularity.⁴

In our review of the Answer, we find Examiner’s responses are duplicative and insufficient to establish a prima facie case of obviousness. The Examiner merely reproduces, verbatim, a number of portions of Agapi being relied upon, without further clarifying how the “cross-referencing” and the “identifying” limitations “L” are taught or suggested by Agapi. *See* Ans. 8–10 (emphasis added).

Appellant also contends Agapi does not store an identified topic keyword “as part of the generation of consolidated system notes.” Appeal Br. 9; Reply Br. 4. We find the Examiner does not clearly explain in the Final Action or the Answer how Agapi teaches or at least suggests the disputed limitation of “*generating consolidated system notes that include the common key element.*” Claim 21 (emphasis added).

The prima facie burden has therefore not been met, and the rejection does not adhere to the minimal requirements of 35 U.S.C. § 132(a), “when a

⁴ *See* 37 C.F.R. § 1.104(c)(2) (“When a reference is complex or shows or describes inventions other than that claimed by the applicant, *the particular part relied on must be designated as nearly as practicable.* The pertinence of each reference, if not apparent, *must be clearly explained* and each rejected claim specified.” (emphasis added)).

rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990).

Regarding Appellant’s second contention, we also agree with Appellant that Examiner has not provided an adequate reason based on rational underpinnings to explain why a skilled artisan would have been led to modify the teachings of Kansal with those of Agapi to arrive at the claimed invention of claim 21.

In the Final Office Action (6–7), we find the Examiner simply concludes, without any explanation or justification, that a “skilled artisan would have been motivated to improve[] Kansal” solely for the purpose of implementing the disputed limitations “L”. Final Act. 6–7 (reciting limitations “L”, verbatim).

However, “rejections on obviousness grounds 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.” *KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).⁵

Therefore, we find some degree of speculation would be required to affirm the Examiner on this record. We decline to engage in speculation.

⁵ See *In re NuVasive, Inc.*, 842 F.3d 1376, 1383 (Fed. Cir. 2016) (“‘[C]onclusory statements’ alone are insufficient and, instead, the finding must be supported by a ‘reasoned explanation.’” (internal citation omitted)); see also *In re Chaganti*, 554 Fed. Appx. 917, 922 (Fed. Cir. 2014) (“It is not enough to say that . . . to do so would ‘have been obvious to one of ordinary skill.’ . . . Such circular reasoning is not sufficient—more is needed to sustain an obviousness rejection.”).

“A rejection . . . must rest on a factual basis . . .” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). “The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *Id.*

Accordingly, for essentially the same reasons argued by Appellant in the Briefs, as further discussed above, we are constrained on this record to reverse the Examiner’s § 103 Rejection B of independent claim 21 and dependent claims 22, 23, 26, 27, and 30, rejected on the same basis, and depending therefrom.

Rejections C, D, and E of Dependent Claims 24, 25, 28 and 29 under § 103

In light of our reversal of the rejections of claims 21 and 27, *supra*, we also reverse obviousness Rejections C, D, and E under § 103 of claims 24, 25, 28, and 29, which variously and ultimately depend from claim 21 or claim 27. On this record, the Examiner has not shown how the additionally cited secondary references overcome the aforementioned deficiencies of the base combination of Kansal and Agapi, as discussed above regarding claim 21.

CONCLUSIONS ⁶

The Examiner erred with respect to the obviousness Rejections B, C,

⁶ Given that we have affirmed the Examiner’s 35 U.S.C. § 101 rejection for similar claims in copending Appeal 2019-002741 (mailed Mar. 16, 2020) as being patent ineligible, we leave it the Examiner in the event of further prosecution, *including any review prior to allowance*, to consider a rejection

D, and E of claims 21–30, over the cited prior art of record, and we do not sustain the rejections.

We **do not reach** the Examiner’s provisional Rejection A of claims 21–30, on the ground of nonstatutory obviousness-type double-patenting. *See Moncla*, 95 USPQ2d at 1885 (precedential).

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
21–23, 26, 27, 30	103	Kansal, Agapi		21–23, 26, 27, 30
24, 25	103	Kansal, Agapi, Yoshida		24, 25
28	103	Kansal, Agapi, Bingaman		28
29	103	Kansal, Agapi, Moran		29
Overall outcome				21–30

REVERSED

under 35 U.S.C. § 101 under the Director’s 2019 Revised Guidance for all claims 21–30 on appeal. Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See Manual of Patent Examining Procedure (MPEP) § 1213.02.*