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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SIGRAM SCHINDLER¹

Appeal 2019-003733
Application 14/294,825
Technology Center 2100

Before ROBERT E. NAPPI, JEAN R. HOMERE, and JAMES R. HUGHES,
Administrative Patent Judges.

NAPPI, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 33 through 52, which constitute all of the pending claims. Appeal Br. 2. Claims 1–32 have been canceled. *Id.* We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). According to Appellant, SIGRAM SCHINDLER BETEILIGUNGSGESELLSCHAFT MBH is the real party in interest. Appeal Br. 2.

CLAIMED SUBJECT MATTER

The claimed subject matter relates generally to an innovation expert system to present automatically or interactively a legal argument chain in response to a question being asked. Spec. 5. Claim 33 is reproduced below.

33. A computer implemented innovation expert system (IES) configured to be executed in at least one of a configuration-mode and a real-time mode, the innovation expert system comprising:

a processor;

memory for storing data relating to the operation of the innovation expert system, the stored data comprising:

a given data structure (DS) derived from a given claimed invention (CI and its technical teaching TT.0 respectively) and its corresponding/peer prior art documents (called reference set RS); and

fragmented arguable subtests (ASTs) logically comprised by the data structure, the fragmented arguable subtests (ASTs) comprising the results of the claimed invention's FSTP test, wherein the FSTP test comprises a set of tests for evaluating a claimed invention under substantive patent law, and wherein the instantiation of the fragmented arguable subtests provides access to the respective parts the FSTP test results;

at least one input/output device for interacting with at least one user in at least one of a configuration mode and a real-time mode;

program instructions stored on the memory for execution by the processor, the program instructions comprising:

first program instructions to provide a user interface entity (UIE) via the input/output device for enabling a user to input/access a set of legal argument chains (LACs) of the given claimed invention to show that the claimed invention satisfies substantive patent law (SPL), wherein a legal argument chain (LAC) is derived from one or more arguable subtests (ASTs)

and comprises a presentation of one or more arguable subtests (ASTs), the instantiation of which facilitates decision making as to a claimed invention's satisfying of substantive patent law, wherein the user interface entity comprises a plurality of user interface entities, the plurality of user interface entities each comprising synchronously accessible components including:

a knowledge representation user interface entity (KR-UIE), any instantiation of it enables structuring and controlling the presentation of any of the LAC's by an appropriate choice of the logics of the AST's;

a human interaction user interface entity (HI-UIE), any instantiation of it enables determining the multimedia aspects and didactic presentation of any of the legal argument chains; and

an interaction control user interface entity (IC-UIE), any instantiation of it enables structuring and controlling the presentation of any part of any legal argument chain;

second program instructions for enabling, in configuration mode, a user to generate or modify, for a selected one of the plurality of these three user interface entities, the synchronously accessible components, by:

automatically deriving, based on user input, a selected user interface entity of the plurality of user interface entity; and

automatically prompting a user to input:

into the knowledge representation user interface entity (KR-UIE) of the selected user interface entity, a presentation of one or more fragmented arguable subtests logically comprised by the given data structure derived from the given claimed invention,

into the human interaction user interface entity (HI-UIE) of the selected user interface entity, how the knowledge representation user interface entity is to be presented as a legal argument chain via the input/output device, and

into the interaction control user interface entity (IC-UIE) of the selected user interface entity, what interactive control a user has for a legal argument chain presentation; and

third program instructions for automatically presenting, in real-time mode, a legal argument chain, based on the fragmented argument subtests, by executing the selected user interface entity in real-time and combining the fragmented argument subtests to form the legal argument chain.

EXAMINER'S REJECTIONS²

The Examiner rejected claims 37 and 48 under 35 U.S.C. § 112(b) as being indefinite. Final Act. 4.

The Examiner rejected claims 33 through 52 under 35 U.S.C. § 103(a) as being unpatentable over Szygenda (US 2008/0086507 A1; April 10, 2008); Manual of Patent Examining Procedure (MPEP) in view of Hexel (Rene Hexel et al., *"Powerpoint to the People": Suiting the World to the Audience*, pp. 49–50 (2004)), and further in view of Cisco (Cisco, *Sharing a Screen, Documents or Whiteboard in Cisco Unified Meeting Place*, Release 7.0, pp. 1–20 (December 9, 2009)). Final Act. 5–16.³

DISCUSSION

² Throughout this Decision we refer to Appellant's Specification filed June 3, 2014 ("Spec."); Appeal Brief filed July 30, 2018 ("Appeal Br."); Reply Brief filed April 8, 2019 ("Reply Br."); Final Office Action mailed November 30, 2019 ("Final Act."); and the Examiner's Answer mailed February 6, 2019 ("Answer").

³ We note the statement of the rejection on page 5 of the Final Action does not include claims 38 and 47, However the detailed findings in support of the rejection identify claims 38 and 47 on pages 13, and 15 of the Final Action identifies that these claims are included in the rejection under 35 USC § 103.

Rejection under 35 U.S.C. § 112(b)

The Examiner rejects claims 37 and 48 under 35 U.S.C. § 112(b) as “the plurality of user interface entities are subdivided into user interface entity steps, whereby invoking one of the plurality of user interface entities causes executing at least one of the corresponding user interface entity steps and whereby any step defined in both config-mode and real-time mode may be applied” which renders the claims indefinite. It is not clear to examiner how a user interface entity is subdivided into user interface entity steps and how does user interface entity step differ from the user interface entity. However there no instructions on what is consider a subdivision also.

Final Act. 4.

Appellant argues the Examiner’s rejection of claims 37 and 48 under 35 U.S.C. § 112(b) is in error because the limitations in question are clear when interpreted in light of the Specification. Appeal Br. 15. According to Appellant, the Specification discusses that the user interface entities can be subdivided into user interface entity steps, which differ from the user interface entity. *Id.* (citing paragraphs 19 and 30 of the published application (US 2014/0365385 A1; December 11, 2014), (citations found on pages 2 and 3 of the Specification)).

Appellant’s arguments have persuaded us of error in the Examiner’s rejection. The Office “determines the scope of claims . . . not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005). Applying the broadest reasonable interpretation of a claim, then, the Office establishes a prima facie case of indefiniteness with a rejection explaining how the metes and bounds of a pending claim are not

clear because the claim contains words or phrases whose meaning is unclear. *See In re Packard*, 751 F.3d 1307, 1310 (Fed. Cir. 2014).

Here, each of claims 37 and 48 further limits independent claims 33 and 43 by identifying that the user interface entities are subdivided into user interface entity steps, and that invoking a user interface entity causes executing of at least one of the steps. We see no ambiguity in these claim limitations, the user interface entity steps and user interface entities are different items. Further, the claims and Specification clearly identify that the entities are subdivided into user entity steps which are executed when the entities are invoked. Spec. 3. Thus, we do not sustain the Examiner's rejection of claims 37 and 48 under 35 U.S.C. § 112(b) as being indefinite.

Rejection under 35 U.S.C. § 103

Appellant argues the Examiner's obviousness rejection of claims 33 through 52 is in error as a) the references do not teach a "data structure derived from a claimed invention's technical teachings and corresponding prior art documents as well as fragmented arguable subtests (ASTs) logically comprised by the data structure, the fragmented arguable subtests (ASTs) comprising the results of the claimed invention's FSTP test," or b) a user interface entity for enabling the user to input a set of legal argument chains. Appeal Br. 17. Appellant argues that:

Szygenda is directed to an automated letters patent analysis support system. . . .

. . . In contrast, the IES recited in the present application has no end result at all, but eventually is capable of instantly replying to ANY question about a claim invention's satisfying an SPL^{FFOLLIN} by automatically reproducing at least one LAC

(in at least one predefined presentation) verbally/graphically proving that this is true.

Appeal Br. 17–18 (emphasis omitted). Appellant additionally argues that the skilled artisan would not combine the references. Appeal Br. 19–20.

Appellant asserts:

In particular, incorporating the process of MPEP 2103 into Szygenda would significantly alter the principle of operation of Szygenda. That is Szygenda is intended to narrowly determine a prior art list, not a full patentability determination. Accordingly, one of skill in the art would not seek to alter Szygenda by incorporating features such as determining whether the claimed invention represents patent-eligible subject matter, determining whether the claims of the application adequately set forth the invention, determining whether the claims comply with novelty and non-obviousness requirements, and communicating the findings to the Appellant.

Appeal Br. 20.

The Examiner responds to Appellant’s arguments stating “Appellant's interpretation of Szygenda is narrow and incorrect. While the Szygenda reference deal with prior art searching it also deals with mapping claims limitations to prior which discloses anticipations in the form of 102 and 103 rejections.” Answer 6 (citing Szygenda Figures 13–15 and ¶ 37). Further the Examiner notes that paragraphs 36 and 37 of Szygenda identify that other aspects, such as indefiniteness and antecedent basis and validity issues, suggest that the system can be used for more than prior art issues. Answer 7.

Appellant’s arguments have not persuaded us of error in the Examiner’s rejection. We have reviewed the cited teachings of Szygenda cited by the Examiner and concur with the Examiner’s findings. We further note that Appellant’s arguments are not commensurate with the scope of representative claim 33. The claim does not recite that the IES “is capable

of instantly replying to ANY question about a claim invention[],” as argued by Appellant. Appeal Br. 18 (emphasis omitted). Representative claim 33 states “ a . . . memory for storing data . . . comprising . . . a given data structure . . . derived from a . . . claimed invention . . . and its technical teaching . . . [a] fragmented arguable subtest . . . the fragmented arguable subtest . . . comprising the results of the claimed invention’s FSTP test.”⁴ The claim, further, recites “automatically presenting, in real-time mode, a legal argument chain, based on the fragmented argument subtests.” The claim is not limited to replying to any question. Szygenda teaches a system that indicates when a single reference or combination of references contains all of the key parameters of a given claim. *See* Szygenda ¶ 37. This shows that Szygenda teaches a data structure derived from a claimed invention and its technical teachings. It also discusses determining whether a single reference or combination of references contains the elements of the claim; an arguable subtest with the results of a test under substantive patent law (whether a reference anticipates a claim or only makes certain limitations obvious). In combination with the MPEP, the skilled artisan would recognize these are analyses under 35 U.S.C. § 102 and 35 U.S.C. § 103. Further, Szygenda teaches the user may add, modify, or delete results to refine or modify the search, which suggests a using a user interface to modify the data. Szygenda ¶ 38. Accordingly, Appellant’s arguments have not persuaded us the Examiner erred in finding that the combination of the references teaches the disputed limitation.

⁴ We understand the “FSTP” to be a test for evaluating claimed invention under substantive patent law. However, should there be further prosecution of the claims, the Appellant should define this acronym.

Further, we are not persuaded of error by Appellant's argument concerning the motivation to combine Szygenda and the teachings of the MPEP. Appellant's argument is premised upon Szygenda not performing a full patentability determination which, as discussed above, is not commensurate with the scope of the claim. Further, we concur with the Examiner that Szygenda, in paragraph 36, suggests analysis of other substantive patent law issues. Thus, Appellant's arguments have not persuaded us that the skilled artisan would not modify the teachings of Szygenda with the MPEP because it would significantly alter the principle operation of Szygenda. Rather, as discussed above, Szygenda provides suggestion that other substantive patent law issues, many of which are discussed in the MPEP, could be included in the system. Accordingly, Appellant has not persuaded us of error in the Examiner's rejection of representative claim 33 and we sustain the Examiner's obviousness rejection of claim 33 and claims 34 through 52, which are grouped with claim 33.

We note that for the first time in the Reply Brief, Appellant additionally argues that "Szygenda also fails to disclose presentation of the different User Interface Entities (UIEs), namely Knowledge Representation User Interface Entity 'KR-UIE', Human Interaction User Interface Entity 'HI-UIE' and Interaction Control User Interface Entity 'IC-UIE'." Reply Br. 3. We have not considered this argument as it is waived. This new argument could have been presented in the Appeal Brief, was not prompted by the Examiner's Answer, and is not based on any new arguments or grounds of rejection in the Examiner's Answer. As a result, Appellant has waived such untimely argument because Appellant has not shown good cause for belatedly raising the new argument. *See* 37 C.F.R. § 41.41(b)(2).

CONCLUSION

In summary:

Claim Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
37, 48	112(b)	Indefiniteness		37, 48
33–37, 39–46, 48–52	103	Szygenda, MPEP, Hexel, Cisco	33–52	
Overall Outcome			33–52	

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner’s decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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).

AFFIRMED