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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/014,031	10/11/2017	9313456	32983-00022	1956
33772	7590	06/15/2020	EXAMINER	
MCDONALD HOPKINS LLC			KE, PENG	
600 Superior Avenue, East			ART UNIT	
Suite 2100			PAPER NUMBER	
CLEVELAND, OH 44114-2653			3992	
			MAIL DATE	
			DELIVERY MODE	
			06/15/2020	
			PAPER	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NSIXTY LLC
Patent Owner and Appellant

Appeal 2019-003777
Reexamination Control 90/014,031
Patent 9,313,456
Technology Center 3900

Before JOHN A. JEFFERY, MARC S. HOFF, and ERIC B. CHEN,
Administrative Patent Judges.

CHEN, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Appeal 2019-003777
Reexamination Control 90/014,031
Patent 9,313,456

Appellant requests rehearing under 37 C.F.R. § 41.52 of the Decision on Appeal, entered January 10, 2020 (“Decision” or “Dec.”), which affirmed the Examiner’s final rejection of claims 1–21.

To clarify the record with respect to the rejection of independent claim 12 under 35 U.S.C. § 103, our Decision has been designated a new ground pursuant to our authority under 37 C.F.R. § 41.50(b).

Thus, the Request for Rehearing is *granted in part*.

DISCUSSION

Independent Claim 12

First, with respect to the limitation “mobile device,” Appellant argues the following:

The Board, however, seems to suggest that the term “mobile device” must include all possible “input devices” and “message recording devices.” There is no legal support for this conclusion and the doctrine of claim differentiation makes the Board’s construction legally erroneous. . . .

Thus, claim 12 must add a further limitation, which means that the term “mobile device” necessarily does not include all “input devices” or “message recording devices.”

(Req. for Reh’g 3.)

To adopt Board’s construction would be the same as taking the language out of the dependent claims and shoehorning it into claim 1, which would be legal error.

(*Id.* at 4.)

However, in an amendment after final, filed September 27, 2018, Appellant amended dependent claim 12, such that claim 12 was rewritten in independent form. In an Advisory Action, mailed October 16, 2018, the Examiner entered Appellant’s amendment to dependent claim 12.

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Moreover, in the “Claims Appendix” of Appellant’s Appeal Brief, claim 12 was rewritten in independent form, with the status “Previously Presented.” (Br. 26.) Accordingly, the doctrine of claim differentiation is inapplicable. Thus, our construction of independent claim 12 was based upon Appellant’s claim amendment, filed September 27, 2018, rather than “taking the language out of the dependent claims and shoehorning it into claim 1.”

Second, with respect to the limitation “mobile device,” Appellant argues the following:

The Board . . . applies a circular definition of “mobile device” as “devices appropriately sized for [a] mobile device.” This definition reads in a size limitation without ever defining what a “mobile device” actually is.

(Req. for Reh’g 4.)

However, page 16 of our Decision states the following:

While the ’456 patent provides numerous examples for both “input device” and “message recording devices,” not all such devices can be used for a “mobile device,” such as cell phones or PDAs, due to size limitations. Thus, we interpret “the input device or the message-recording device comprises a mobile device” as devices appropriately sized for [a] mobile device, for example, *as smaller-scale keyboard, touch screen monitor, camera, or video camera.*

(Dec. 16 (emphasis added).) Thus, Appellant’s argument that “[t]he Board . . . applies a circular definition of ‘mobile device’ as “devices appropriately sized for [a] mobile device” is unsupported by our Decision.

Third, with respect to the limitation “mobile device,” Appellant argues that “[n]othing in the intrinsic evidence or extrinsic evidence supports that mobile devices require a size limitation” and “[t]here is no suggestion

that keyboards or touchscreens are larger or smaller than mobile devices anywhere in the specification.” (Req. for Reh’g 5.)

However, pages 15–16 of our Decision states the following:

With respect to the claim limitations “input devices,” “message recording devices,” and “mobile device,” the ’456 patent further describes the following:

. . .

Many cell phones, PDAs [personal digital assistants], and other electronic devices provide a convenient and direct way of communicating a photo or video message to an individual. For example, many cell phones are equipped with digital cameras for recording photos or videos. Additionally, many phones allow an electronic photo or video file to be sent to another cell phone via a text or an email or uploaded directly to the Internet.

(Col. 1, ll. 42–48.) While the ’456 patent provides numerous examples for both “input device” and “message recording devices,” not all such devices can be used for a “mobile device,” such as cell phones or PDAs, due to size limitations.

Accordingly, one of ordinary skill in the art would recognize that “cell phones”¹ or “PDAs,”² as disclosed in column 1, lines 42–43 of the ’456

¹ One technical definition of “smart phone” (or “wireless phone”) is “[a] hybrid between a wireless telephone and a personal digital assistant (PDA)” which “integrate wireless telephones with many of the personal organizational functions of PDAs . . . to lightweight palm-style computers.” MICROSOFT® COMPUTER DICTIONARY 485 (5th ed. 2002).

² Likewise, one technical definition of “PDA” is “[a] lightweight palmtop computer designed to provide specific functions like personal organization (calendar, note taking, database, calculator, and so on) as well as communications.” *Id.* at 396.

patent, are smaller in size than keyboard 22 or display 24, as illustrated in Figure 2 of the '456 patent.

Fourth, with respect to the limitation “mobile device,” Appellant argues that “the Decision ignores the wealth of case law that shows that persons of ordinary skill would know that the term mobile device has nothing to do with size, but rather that the device is a telecommunications device.” (Req. for Reh’g 5.)

However, we construe the limitation “mobile device” in the context of the entire limitation “wherein at least one of the *input device* or the *message-recording device* comprises a *mobile device*” (emphasis added), instead of as an isolated claim term with no relationship with the input device and the message-recording device.

Last, with respect to the limitation “mobile device,” Appellant argues that “the Examiner did not allege that Massarsky’s kiosk was a mobile device because it ‘integrated’ a keyboard into a larger unit,” but “rather, cited Massarsky’s as a mobile device because it has wheels.” (Req. for Reh’g 6.)

With respect to the limitation “wherein at least one of the input device or the message-recording device comprises a mobile device,” the Examiner provides the following statements:

Massarsky teaches the kiosk includes wheels or castors.
(see Massarsky fig. 3)

(Final Act. 19.)

And Massarsky teaches such mobile device because Massarsky’s Kiosk can be moved. (see Massarsky fig. 3) It is clear from the figure [3], Massarsky’s Kiosk is not designed to be permanently bolted to a specific location.

(*Id.* at 31.)

Therefore, one of skill in the art would know by looking at the figure [3 of Massarsky] such design would provide mobility for the kiosk.

(*Id.* at 32.) From the Examiner’s statements, we are unable to determine if the Examiner’s findings with respect to claim 12 are based upon: (i) the kiosk being movable because of the wheels, and thus, such kiosk is a “mobile device”; or (ii) the “input device” and “message-recording device” (i.e., “mobile devices”) are “integrated” into the “portable kiosk” as a single larger unit. Thus, because of this ambiguity, we designate our Decision a new ground of rejection so the Examiner can clarify the record, and to provide Appellant with the opportunity to respond with claim amendments, additional arguments, or additional evidence.

Independent Claim 1

First, with respect to the limitation “portable kiosk,” Appellant argues the following:

[T]he Board made a distinction between kiosks “mounted or secured to a wall” (non-portable kiosk) and the “stand-alone kiosks” of Figures 2 and 3 (“portable kiosk”). . . . The Decision, however, misinterprets column 5, lines 4–13 and Figures 2 and 3 so that the kiosk of claim 3 would be excluded from the definition of a “portable kiosk.”

(Req. for Reh’g 7.)

Accordingly, the distinction that the Decision makes between “stand-alone kiosks” as portable and “wall-mounted kiosks” as not portable is not supported by the specification. The portable kiosk 12 of Figure 3 is both a wall-mounted and stand-alone kiosk in different preferred embodiments.

(*Id.* at 9.)

However, page 7 of our Decision states the following:

As illustrated in Figures 2 and 3, the height of message-recording device 20 (e.g., digital video camera) or display 24, which allows a user to watch a video communication, can be approximated as the height of the user. Thus, under the broadest reasonable interpretation consistent with the Specification, we interpret “portable” as “capable of being carried or moved about,” which *includes stand-alone kiosk 12 (e.g., unsecured to walls), such kiosk 12 having the approximate height of the user.*

(Dec. 7 (emphasis added).) Thus, Appellant’s statement that “the Board made a distinction between kiosks ‘mounted or secured to a wall’ (non-portable kiosk) and the ‘stand-alone kiosks’” such that “the kiosk of claim 3 would be excluded from the definition of a ‘portable kiosk’” is unsupported by our Decision. Our statement that “we interpret ‘portable’ . . . [to] include[] stand-alone kiosk 12 (e.g., unsecured to walls), such kiosk 12 having the approximate height of the user” does not mean that all other embodiments from the ’456 patent are excluded.

Second, with respect to the limitation “portable kiosk,” Appellant argues the following:

Further, the Decision maintains the Examiner’s disregard of the prosecution history. The Decision alleges that the Appellant has “not explained how the location of such photobooth/e-mail center 10 is relevant to portability.” The Appellant described that “public kiosk” was clearly and unequivocally disclaimed during examination, which the Examiner and Board have not addressed.

(Req. for Reh’g 9 (citations omitted).)

However, pages 11–12 of our Decision state the following:

Last, Appellant argues the following:

The original Examiner understood that the specification defines the term “portable kiosk” as not a standard kiosk or a public kiosk, and as kiosk that requires more than the ability to be moved with a wheel. We know this because the original Examiner cited U.S. Pat. Pub. No. 2002/0106620 to Barnum during prosecution, which identifies wheels 120. The original USPTO Examiner then allowed the ’456 Patent to issue because these wheels did not make Barnum’s kiosk a “portable kiosk,” even though Barnum was movable.

A review of the original prosecution history for Application No. 14/084,258 indicates that Barnum was cited on form PTO-892 (“Notice of References Cited”), in which the original Examiner stated “[t]he prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.” In other words, the original Examiner did not provide any reasons for allowing the original claims over Barnum. Accordingly, Appellant’s argument that “[t]he original USPTO Examiner then allowed the ’456 Patent to issue because these wheels did not make Barnum’s kiosk a ‘portable kiosk,’ even though Barnum was movable” is unsupported by the prosecution history.

(Dec. 11–12 (citations omitted).) Thus, Appellant’s argument that “Appellant described that ‘public kiosk’ was clearly and unequivocally disclaimed during examination, which the Examiner and Board have not addressed”³ is unsupported by our Decision.

³ Appellant’s argument that “‘public kiosk’ was clearly and unequivocally disclaimed during examination” (Req. for Reh’g 9) is an apparent disclaimer of a preferred embodiment. In particular, the ’456 patent discloses that “[f]or example, a kiosk 12 located at a baseball park may include a camera positioned to record a user such that the baseball field or other recognizable land mark is seen in the background.” (Col. 3, ll. 63–66.) Moreover, Appellant’s Appeal Brief states that “NSixty’s customers . . . provide these

Last, with respect to the limitation “associate the captured media data with the identification information associated with the user,” Appellant argues the following:

The Decision alleges that the Examiner cited Belz for the claim term “associate the captured media data with the identification information associated with the user.” . . . The flaw here is that the Examiner first applied Belz in its Answer. This means that the Appellant could not rebut the Examiner’s new assertion with any evidence or argument.

(Req. for Reh’g 10.)

In the Final Action, mailed June 27, 2018, for the limitation “an input device integrated within the portable kiosk configured to receive identification information associated with a user,” the Examiner stated that “Belz teaches having a username and password for data upload” and cited “Belz col. 2, lines 1–12.” (Final Act. 15–16.) Accordingly, Appellant’s argument that “the Examiner first applied Belz in its Answer,” is unsupported by the Final Action.

Dependent Claim 17

With respect to the limitation “social network,” Appellant argues the following:

portable kiosks to patrons at entertainment venues, sporting events, tourist attractions, and trade shows” and “[u]sers of the claimed portable kiosks have found them so innovative that national brands, such as Major League Baseball (MLB), the National Basketball Association (NBA), the National Association for Stock Car Auto Racing (NASCAR), NCAA Collegiate Athletic organizations, and the National Football League (NFL) Super bowl Village have all leased or bought NSixty portable kiosks.” (Br. 4.)

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[T]he Examiner did not allege that Belz discloses a social network during reexamination. The Examiner's citation to Belz in the Answer, thus, is an unsupported conclusion. Absent a rejection based on Belz, there was no way for the Appellant to rebut application findings cannot be sustained.

(Req. for Reh'g 12 (citations omitted).)

However, the Examiner's Answer states the following:

Merriam Webster defines "Social Network" as "an online service or site through which people create and maintain interpersonal relationship." Woodworth and Belz teach such online service because they allow users to share media and digital information to maintain their interpersonal relationship. (see Woodworth col. 8, lines 3–30, col. 10, lines 5–12; Belz col. 2, lines 1–12).

(Ans. 7–8 (footnote omitted).) Accordingly, Appellant's argument that "the Examiner did not allege that Belz discloses a social network during reexamination" is unsupported by the Examiner's Answer.

CONCLUSIONS

The Request for Rehearing has been considered. As discussed previously, we *grant* the Request for Rehearing to designate our Decision a new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b). The Request for Rehearing is otherwise *denied*. Accordingly, the Request for Rehearing is *granted in part*.

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).

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Outcome of Decision on Rehearing:

Claims	35 U.S.C §	Basis	Denied	Granted
1-16, 18-21	103	Hoyt, Belz, Massarsky		1-16, 18-21
17	103	Hoyt, Belz, Massarsky, Davis		17
Overall Outcome				1-21

Final Outcome of Appeal after Rehearing:

Claims	35 U.S.C. §	Basis	Affirmed	Reversed
1-16, 18-21	103	Hoyt, Belz, Massarsky	1-16, 18-21	
17	103	Hoyt, Belz, Massarsky, Davis	17	
Overall Outcome			1-21	

REHEARING GRANTED IN PART
37 C.F.R. § 41.50(b)

tkl

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Reexamination Control 90/014,031
Patent 9,313,456

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