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14/996,917	01/15/2016	Joseph Carrafa	103343-0019	4877
1923	7590	06/19/2020	EXAMINER	
MCDERMOTT, WILL & EMERY LLP The McDermott Building 500 North Capitol Street, N.W. Washington, DC 20001			PICHLER, MARIN	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JOSEPH CARRAFA and DAVID HOWARD GOLDBERG

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Appeal 2019-005245  
Application 14/996,917  
Technology Center 2800

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Before JEFFREY T. SMITH, JULIA HEANEY, and LILAN REN,  
*Administrative Patent Judges.*

HEANEY, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE<sup>1</sup>

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>2</sup> appeals from the Examiner's decision to reject claims 11–18. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> This Decision refers to the Specification filed Jan. 15, 2016 (“Spec.”), Final Office Action dated Dec. 14, 2018 (“Final Act.”), Appeal Brief dated Mar. 20, 2019 (“Appeal Br.”), Examiner’s Answer dated June 10, 2019 (“Ans.”), and Reply Brief dated June 28, 2019 (“Reply Br.”).

<sup>2</sup> We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as JAND, Inc. Appeal Br. 3.

We REVERSE.

CLAIMED SUBJECT MATTER

The claims are directed to a mobile device used for administering an eye examination. Spec. 1. Claim 11, the sole independent claim on appeal, is reproduced below with italics indicating the limitation argued by Appellant:

11. A mobile device comprising:

a camera;

a user interface comprising a visual display;

a memory comprising instructions; and

a processor coupled to the camera, the processor configured to execute the instructions to:

capture a first image of an object using the camera set to a fixed focusing distance;

determine, with reference to the first image, an absolute size of the object;

capture a second image of the object using the camera;

determine, with reference to the second image, a distance from the mobile device to the object;

*provide, via the user interface, an indication via the display to move the mobile device relative to the object;* and

receive, via the user interface, input from the mobile device in response to an eye examination program.

Appeal Br. 13 (Claims Appendix).

## REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Garcia	US 2014/0300722 A1	Oct. 9, 2014
Limon	US 2016/0120402 A1	May 5, 2016
Schubart <sup>3</sup>	US 2017/0135571 A1	May 18, 2017

## REJECTION

Claims 11–18 are rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Schubart, Limon, and Garcia. Final Act. 3.

## OPINION

The Examiner finds that Schubart teaches a mobile device comprising all of the elements of claim 11, except that Schubart does not explicitly disclose that the mobile device provides “an indication via the display” or that its camera is “set to a fixed focusing distance” for capturing a first image, as recited in claim 11. Final Act. 3–5 (citing Schubart ¶¶ 10–17, 20, 25, 28, 30, 34, 36, 44, 50–53, 63–65). The Examiner further finds that Schubart teaches an indication “to move the mobile device relative to the object” as recited in claim 11, because Schubart’s mobile computer includes various testing distances where the optotype sizes are scaled for each of the different testing distances. *Id.* at 4 (citing Schubart ¶¶ 22, 24, 25, 42–44, 59, 66, 68).

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<sup>3</sup> The Examiner relies upon US 2017/0135571 A1 as the closest English language equivalent to WO 2015/197149 A1.

The Examiner further finds that Limon teaches a system for measurement of refractive error of an eye based on subjective distance metering, which provides an indication through a display to move the mobile device relative to the object or to move the object relative to the mobile device. *Id.* at 5 (citing Limon 5 ¶¶ 126, 127, Figs. 3A, 3B). The Examiner determines that it would have been obvious to one of ordinary skill in the art to have used Schubart’s display to provide an indication to the subject, “in order to provide instructions to the subject through the screen for eye examination and measuring.” *Id.*

With regard to the second feature missing from Schubart, the Examiner finds Garcia teaches an image based measurement tool where the digital camera is set to a fixed focusing distance. *Id.* at 5–6 (citing Garcia ¶¶ 120, 121). The Examiner determines that it would have been obvious to one of ordinary skill in the art to have set Schubart’s camera at a fixed focal length in order to compute the predicted distance of the object from the camera. *Id.* at 6.

Appellant argues that while Schubart teaches a mobile computer that may be set up at an arbitrary distance from the test subject and Limon teaches that the UI may request the subject to distance from the mobile device display, neither reference teaches an indication to move the mobile device relative to the object. Appeal Br. 8–10. Specifically, Appellant argues that Limon teaches moving the subject away from the mobile device, but claim 11 requires moving the mobile device relative to the object. Reply Br. 2–3.

Appellant’s argument persuasively identifies reversible error. Although Schubart and Limon teach moving the subject relative to display

or the mobile device, none of the references teaches moving the display of the mobile device with respect to the object, as required by claim 11.

Schubart does not teach moving the mobile device relative to the object, because it describes integrating the object (i.e. the optotype) into the mobile device. The Examiner's finding that Schubart teaches an indication to move the mobile device relative to the object (*see* Final Act. 4) is not supported by Schubart because sizing of the optotypes on Schubart's mobile device display is dependent upon the distance of the mobile device from the subject, with an arbitrary test distance set at 1–10m. Schubart ¶¶ 25, 68. Similarly, Limon does not teach moving the mobile device relative to the object because it teaches that the object image is integrated into the mobile device, and the user is instructed to move the mobile device relative to the subject's eye. Limon ¶¶ 135–137, Figs. 3A, 3B.

Because both Schubart and Limon teach integrating the mobile device with the display showing the object image, the distance between the object and the mobile device cannot be changed. Moreover, the Examiner's rationale for combining Limon's feature of providing instructions to the subject via the display with Schubart's device (i.e., "in order to provide instructions via the screen to subject for eye examination and measuring" (Final Act. 5)) is insufficient, because Schubart already provides an indication via its display. Accordingly, we reverse the rejection of claim 11.

We reverse the rejection of dependent claims 12–18 for the same reasons as discussed above.

## CONCLUSION

The Examiner's rejection is REVERSED.

DECISION SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
11-18	103	Schubart, Limon, Garcia		11-18

REVERSED