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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KEBRON G. DEJENE

Appeal 2019-006871
Application 14/168,371
Technology Center 3600

Before MURRIEL E. CRAWFORD, PHILIP J. HOFFMANN, and BRADLEY B. BAYAT, *Administrative Patent Judges.*

CRAWFORD, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the Examiner's decision to reject claims 1–9 and 11–31. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] 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 the inventor, Kebron Dejene. Appeal Br. 3.

CLAIMED SUBJECT MATTER

According to the Appellant, the "present invention relates generally to communication systems and methods and more specifically to communication systems and methods for executing agreements." Spec. ¶ 3.

The Specification describes that in agreements between two parties, "one or more parties can claim that they never executed or signed the agreement in question. If this happens, the non-repudiating party must attempt to prove that the repudiating party did sign the agreement." *Id.* ¶ 5.

In order to address efforts a non-repudiating party must undertake if the other party attempts to repudiate (*id.* ¶¶ 6–7), the invention "generates an identifier, namely, a numeric or alphanumeric number, uniquely associated with said document," and then "captures consecutive video frames of the user verbalizing the identifier that is uniquely associated with the document." *Id.* ¶ 11.

The claims recite that a "representation" of the frames may be embedded in the document. In addition, "the consecutive video frames are stored as a video file and then stored with the document." Spec. ¶ 71. Thus, a representation of "consecutive video frames" are embedded within an electronic document that is the agreement, and the agreement document is linked to a separately-stored and playable video file also containing consecutive video frames of the signer verbalizing the identifier of the agreement. The video frames can be played back with audio.[2]

[2] The Specification indicates that "initiation or interaction with the specific signature block . . . on the document initiates playback of the consecutive video *files* captured." Spec. ¶ 79 (emphasis added). Based on this, we construe that direct playback of video and audio is performed from the

In order to counter a repudiation, the "non-repudiating party can simply initiate playback of the consecutive video frames of the repudiating party to display the captured consecutive video frames of the repudiating party." *Id.* ¶ 13. For example, a party to the agreement "can simply attach the executed document and the consecutive video file to an email" to another person. *Id.* ¶ 103. The Specification describes the significance of an "identifier," in that "[i]n one embodiment, identifiers are based on a hash of the document that provides a unique identifier that can only be produced by the document." *Id.* ¶ 46. Thus, "parties cannot repudiate the fact that they executed the agreement document since consecutive video frames of each party vocalizing or verbalizing their acceptance of the document based on the unique identifier for the document." *Id.* ¶ 82.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. A method comprising:
>
> receiving, at a computer, an electronic document configured to have data forming at least one or more video-embeddable or video-associable signature areas or blocks;
>
> using said client computer to generate an electronic document dependent identifier that is dependent upon data in said electronic document configured to have text forming the at least one or more video-embeddable or video-associable signature area blocks;
>
> accepting signals from a user input device of said client computer to capture consecutive video frames of a user statement including the electronic document dependent identifier;
>
> storing by said client computer, said consecutive video frames in a video file and associating said video file with the electronic document;

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separate video *file*, not the playback of the *frames*, or representation, embedded in the document.

> integrating or embedding the consecutive video frames or a representation thereof in the at least one or more video-embeddable or video-associable signature areas or blocks as the signature of the electronic document; and
>
> upon user selection or interaction with the representation thereof in the at least one or more video-embeddable or video-associable signature areas or blocks of the electronic document, initiating playback of said video file including said consecutive video frames displaying the user statement including said electronic document dependent identifier.

REJECTIONS

The Examiner provisionally rejected claims 1–9, 11–13, 16–18, 24–28, and 30 on the ground of non-statutory double patenting over claims 1, 4, 6, 11, and 13–19 of Application 14/803,031 (now US 10,701,305 B2, issued June 30, 2020).

The Examiner rejects claims 1–8 and 11 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement.

The Examiner rejects claims 1, 2, 9, 11–23, and 25 under 35 U.S.C. § 112(b) as indefinite.

The Examiner rejects claims 1–9 and 11–31 under 35 U.S.C. § 101 as directed to a judicial exception to patentable subject matter, without "something more" in the form of an "inventive concept."

The Examiner rejects claims 1–9 and 11–21 under 35 U.S.C. § 103 as unpatentable over Smithies[3] (US 2002/0031209 A1, published Mar. 14, 2002), Udani, (US 2012/0323796 A1, published Dec. 20, 2012), Pandey (US 8,209,598 B1, issued June 26, 2012), and Carney (US 2010/0037062 A1, published Feb. 11, 2010)

[3] We refer to each patent publication only by the first named inventor.

The Examiner rejects claim 22 under 35 U.S.C. § 103 as unpatentable over Smithies, Udani, Pandey (US 8,209,598 B1, issued Jun. 26, 2012), Carney (US 2010/0037062 A1, published Feb. 11, 2010), and Bendik (US 2002/0002563 A1, published Jan. 3, 2002).

The Examiner rejects claim 23 under 35 U.S.C. § 103 as unpatentable over Smithies (US 2002/0031209 A1, published Mar. 14, 2002), Udani (US 2012/0323796 A1, published Dec. 20, 2012), Pandey, Carney, and Deyo (US 2008/0140679 A1, published June 12, 2008).

The Examiner rejects claims 24 and 25 under 35 U.S.C. § 103 as unpatentable over Smithies, Udani, Pandey, Carney, and Wang (US 2004/0143841 A1, published July 22, 2004).

The Examiner rejects claims 26–31 under 35 U.S.C. § 103 as unpatentable over Udani, Smithies, Pandey, Carney, and Wang.

Claim(s)	**35 U.S.C. §**	**Basis/Reference(s)**
1–9, 11–13, 16–18, 24–28, 30		Double Patenting
1–8, 11	112(a)	Written Description
1, 2, 9, 11–23, 25	112(b)	Indefinite
1–9, 11–31	101	Ineligibility
1–9, 11–21	103	Smithies, Udani, Pandey, Carney
22	103	Smithies, Udani, Pandey, Carney, Bendik
23	103	Smithies, Udani, Pandey, Carney, Deyo
24, 25	103	Smithies, Udani, Pandey, Carney, Wang
26–31	103	Udani, Smithies, Pandey, Carney, Wang

OPINION

Double Patenting Rejection

The Appellant does not advance any argument specific to the double-patenting rejection, instead stating, "Appellant will execute a terminal disclaimer if necessary." Appeal Br. 9.

We thus summarily sustain this rejection.

Written Description Rejection of Claims 1–8 and 11

Claim 1 recites a limitation to "generate an electronic document dependent identifier that is dependent upon data in said electronic document." Independent claims 3 and 6 recite substantially identical language. Claim 11, which depends from independent system claim 9, recites "an identifier generation module that generates the electronic document dependent identifier." Original claim 1 recited "using said client computer to generate an identifier, namely, a numeric or alphanumeric number, uniquely associated with said document."

The Examiner finds "the specification does not disclose a sufficient number of species of steps or algorithms to generate a document dependent identifier to show that Applicant had possession of at least the disclosed generate functions, let alone the entire genus of functions encompassed by the claim." Non-Final Act. 17; *see also* Answer 6.

The Appellant argues the Specification supports possession of the claim limitations, specifically at paragraphs 45 and 46 (Appeal Br. 10), and in Figure 2, steps 706–12 (Reply Br. 6).

We agree with the Appellant.

The Specification describes that "Identifier generation module 216 can be software or hardware that generates identifiers associated with agreements in accordance with the present invention. In one embodiment, identifiers are based on a hash of the document that provides a unique identifier that can only be produced by the document." Spec. ¶ 46.

These three independent claims thus broadly claim creating an identifier dependent upon data in an electronic document, which the Specification describes can be performed using a hash function.

The issue here concerns amendments of the claims, where the language changed from generating an identifier "uniquely associated" with a document, into generating an identifier *dependent upon* data in the electronic document. The Examiner is essentially arguing that the Appellant did not have possession of any method of generating this identifier based on document data that would be encompassed within the broad claim language, other than a hash function, which the Examiner asserts is not enough to demonstrate possession of the "genus" of generating an identifier dependent on data in the electronic document. Non-Final Act. 17.

However, our reviewing court explains:

> A claim will not be invalidated on section 112 grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language. That is because the patent specification is written for a person of skill in the art, and such a person comes to the patent with the knowledge of what has come before. Placed in that context, it is unnecessary to spell out every detail of the invention in the specification; only enough must be included to convince a person of skill in the art that the inventor possessed the invention and to enable such a person to make and use the invention without undue experimentation.

LizardTech, Inc. v. Earth Res. Mapping, Inc., 424 F.3d 1336, 1345 (Fed. Cir. 2005) (citations omitted).

The Examiner has not provided an explanation of why the ordinary artisan, seeing the description of a "hash of a document," would not understand that the Appellant had possession of generating an identifier that is dependent on data in the document. Instead, the Examiner argues:

> That one of skill may have understood that a hash function is used, that does not explain what hash function the appellant used if the appellant indeed used a hash function, or if the appellant did not use a hash function then what other function, steps, or algorithm were used. There is no explanation of how the electronic document and all of the possible media elements of the document (e.g., text, images, video) are treated as input to an algorithm, or even a hash function, that generates an electronic document dependent identifier.

Answer 7.

The prior art of record, however, relied upon by the Examiner, provides an indication of the understanding of the ordinary artisan. For example, Carney discloses a checksum based on a document's contents. Carney ¶ 4 ("Some known methods of protecting digital documents include calculating a checksum or signature of a digital document and providing the checksum or signature to a receiver of the digital document."). Carney also discloses "calculating . . . a hash value (i.e., a value calculated from contents of the HTML document)." *Id.* ¶ 17.

The evidence of record, therefore, provides support that the ordinary artisan would understand that the Specification's description of a hash value supports the broad supports the broad claim language, and is not limited to only methods that are specifically "a hash value." Because the evidence

indicates the ordinary artisan would understand the Appellant had possession of the broad generation of a document identifier dependent on data in the document, we do not sustain the rejection under 35 U.S.C. § 112(a).

Indefiniteness Rejection

Rather than advance arguments as to the indefiniteness rejection, the Appellant "requests the Board to hold this rejection in abeyance pending determination of the substantive rejections." Appeal Br. 10. We find untimely the Appellant's arguments in the Reply Brief directed to indefiniteness. Reply Br. 7–8. We note that these are new arguments by Appellant for the first time in the Reply Brief and they are not in response to a new argument raised by the Examiner in the Answer. *See* 37 C.F.R. § 41.41(b)(2). The Reply Brief is not an opportunity to make arguments that could have been made during prosecution, but were not. Nor is the Reply Brief an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not. *See Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative). We therefore consider these arguments raised for the first time in the Reply Brief to be waived.

Thus, we sustain the rejection under 35 U.S.C. § 112(b) of claims 1, 2, 9, 11–23, and 25.

Ineligible Subject Matter Rejection

The Examiner identifies an abstract idea in the independent claims as follows:

> capture . . . a user statement including the . . . document dependent identifier;
> upon user selection or interaction with the representation thereof in . . . signature areas or blocks of the . . . document, [and] displaying the user statement including said . . . document dependent identifier.

Non-Final Act. 28–29. The Examiner determines "[t]hese steps describe a process of memorializing and executing a contract, which is similar to concepts identified as abstract ideas by the courts," and that "these concepts relate to prudent or routine actions undertaken in the regular course of business transactions to manage risks." *Id.* at 29. The Examiner finds "the problem to which the invention is directed arises from human behavior, i.e., contract repudiation, rather than from technology." *Id.* at 30.

In analyzing the claims under Prong Two and Step 2B of the Guidance (84 Fed. Reg. 50 (2019)), the Examiner finds the following "additional elements" are "well-understood, routine, and conventional" elements:

> [A] A method comprising:
> [B] receiving, at a computer, an electronic document configured to have data forming at least one or more video-embeddable or video-associable signature areas or blocks;
> [C] using said client computer to generate an electronic document dependent identifier that is dependent upon data in said electronic document configured to have text forming the at least one or more video-embeddable or video-associable signature areas or blocks;
> [D] accepting signals from a user input device of said client computer to capture consecutive video frames of a user statement including the electronic document dependent identifier;

> [E] storing, by said client computer, said consecutive video frames in a video file and associating said video file with the electronic document;
> [F] integrating or embedding the consecutive video frames or a representation thereof in the at least one or more video-embeddable or video-associable signature areas or blocks as the signature of the electronic document; and
> [G] upon user selection or interaction with the representation thereof in the at least one or more video-embeddable or video-associable signature areas or blocks of the electronic document, initiating playback of said video file including said consecutive video frames displaying the user statement including said electronic document dependent identifier.

Non-Final Act. 31–35.

As to limitation [B] the Examiner explains:

> The Federal Circuit in *Electric Power Group* found that reciting a particular source or content of information does not by itself differentiate an abstract idea from an ordinary mental process. Although a person could not capture, store, associate, embed, or integrate consecutive frames in a video file by mental activity, there is nothing significant or meaningful about the functions performed on the video file by the computer because they are, as discussed above, well-understood, routine, and conventional functions that a generic computer can perform on data.

Non-Final Act. 34. However, we do not discern any evidence, from the Examiner's statements, that it is well-understood, routine, and conventional for a word processing document to have "video-embeddable or video-associable signature areas or blocks" of a document, as recited in limitation [B].

As to limitation [F], the Examiner finds: "Integrating or embedding video and other media files into an electronic document is widely prevalent and in common use in the relevant field, as shown by numerous references

to this function in the prior art of record." *Id.* (citing "Sherman (cl:37-48); McCurdy (0014, 39); Pulier (0027, passim); Huynh (0169); Wynn (0037); Ternasky (0016); Karman (0020, 21, 24); Pandy (c6:20-54, c9:9-c10:2); Palm (0002); Allawi (0003); Burge (0061, 86)"). The Examiner then quotes from "Pulier, 0005": "Not only are there numerous references, but they state that '[i]t is quite common today to have a video clip integrated into a document object.'" *Id.*

The Examiner's reliance on Pulier (US 2002/0083091 Al, published June 27, 2002) is unconvincing. The cited paragraph, in background, describes web page technology:

> It is quite common today to have a video clip integrated into a document object, such as a web page. These document objects, however, typically display the video in a separate window associated with a particular media player, and make no attempt to integrate the video images into the background or other parts of the document object.

Pulier ¶ 5. The Examiner has not demonstrated that the claimed "electronic document" can be construed to encompass web pages or a document object.

More importantly, this one reference alone is insufficient to establish that the operation is well-understood, routine, and conventional in the computing arts. *See Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018) ("Whether a particular technology is well-understood, routine, and conventional goes beyond what was simply known in the prior art. The mere fact that something is disclosed in a piece of prior art, for example, does not mean it was well-understood, routine, and conventional."). Also, the Examiner has not explained how the other references, cited only by a

single name each, demonstrate that the "additional element" claim limitations are all well-understood, routine, and conventional.

For this reason, the Examiner has erred in establishing a prima facie case of ineligibility under Step 2B of the Guidance. We thus do not sustain the rejection of claims under 35 U.S.C. § 101.

We note that we have not made a determination of whether the claims recite a judicial exception, or whether the claims integrate a judicial exception into a "practical application," such as by improving the authentication of electronic documents.

Obviousness Rejection of Claims 1–9 and 11–21

The Appellant asserts the "Examiner relies on Figure 6 of Smithies to disclose "an agreement or an 'electronic' document," but that "Figure 6 of Smithies does not disclose the agreement or an electronic document of any kind." Appeal Br. 22–23 (citing Non-Final Act. 51 ¶ 3); *see also* Appeal Br. 23–24 ("erroneous characterization of Smithies as providing an identifier for the agreement and Smithies does not provide such identifier.").

We are not persuaded by the Appellant's arguments, because they attack a reference the Examiner did not rely on for the claimed limitations. The Examiner finds:

> Smithies does not expressly disclose (in italics) receiving, at a computer, an *electronic* document configured to have data forming at least one or more *video-embeddable or video-associable* signature areas or blocks; using said client computer to generate a*n electronic document dependent* identifier *that is dependent upon data* in said *electronic* document.

Non-Final Act. 52. The Examiner further finds "Udani . . . specifically teaches" these claim limitations, at paragraphs 165–68. *Id.* at 53.

We are thus not persuaded by the Appellant's arguments, because although the Examiner indicates that Smithies *suggests* certain claim features, the rejection relies on the *explicit disclosure* of those limitations in Udani, not Smithies. For this reason, we sustain the rejection of claims 1–9 and 11–21 as obvious.

Rejections of Claims 22–25

The Appellant argues that none of Bendik, Deyo, or Wang "cure the deficiencies of Smithies, Udani, Pandey and Carney." As we concluded above, the Appellant has not demonstrated any shortcomings in the rejection based on Smithies, Udani, Pandey, and Carney. Therefore, we sustain the rejections of claims 22–25 as obvious.

Rejection of Claims 26–31

We are not persuaded by the Appellant's arguments that the Examiner "conflates" Smithies with the Smithies patent 6,091,835 described in background in Smithies, that relying on paragraphs 11 and 46 of Smithies is incorrect because the two paragraphs describe "different systems," and that "Smithies '209 and Smithies '835 are not properly combined." Appeal Br. 27–28.

In the rejection of claim 26 (Non-Final Act. 101–12), when establishing a motivation to modify Udani with "the user reading the identifier of a contract itself as part of the recorded media, as taught by Smithies," the Examiner finds reasons the combination would be

advantageous in both paragraphs 11 and 46 of Smithies. *Id.* 106–107. Paragraph 11 describes the Smithies '835 patent, and the Examiner draws from it that "linking the identity of the affirming party to the matter in the electronic document" would be advantageous. *Id.* Paragraph 46 describes the invention of Smithies, and the Examiner draws from it that "combining the forensic admissibility, independent archival nature, and possibility for instant notification of assent improves the utility and practicability of the recorded media approach." *Id.*

The Examiner thus does not "conflate" the two Smithies references, or combine them, but merely draws two different reasons, from two different parts of Smithies, for the combination of a feature with the Udani system. This does not demonstrate error on the part of the Examiner.

We find untimely the Appellant's argument that "the Examiner has not identified reasons that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed," such as "the combination of Carney." Reply Br. 9.

We note that these new arguments were raised by Appellant for the first time in the Reply Brief, and they are not in response to a new issue brought up by the Examiner in the Answer. *Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative). We therefore consider this argument, raised for the first time in the Reply Brief, has been waived.

For these reasons, we sustain the rejection of claims 26–31 as obvious.

CONCLUSION

The Examiner's rejections are AFFIRMED. More specifically, the indefiniteness, double patenting, and obviousness rejections are affirmed,

and the written description and subject matter ineligibility rejections are reversed.

DECISION SUMMARY

Claim(s)	**35 U.S.C. §**	**Basis/Reference(s)**	**Affirmed**	**Reversed**
1–8, 11	112(a)	Written Description		1–8, 11
1, 2, 9, 11–23, 25	112(b)	Indefinite	1–2, 9, 11–23, 25	
1–9, 11–31	101	Ineligibility		1–9, 11–31
9, 11–13, 16–18, 24–28 30		Double Patenting	9, 11–13, 16–18, 24–28, 30	
1–9, 11–21	103	Smithies, Udani, Pandey, Carney	1–9, 11–21	
22	103	Smithies, Udani, Pandey, Carney, Bendik	22	
23	103	Smithies, Udani, Pandey, Carney, Deyo	23	
24–31	103	Smithies, Udani, Pandey, Carney, Wang	24–31	
Overall Outcome			1–9, 11–31	

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