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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SEYMOUR RAPAPORT, JEFFREY A. RAPAPORT,
KENNETH ALLEN SMITH, JAMES BEATTIE, and GIDEON GIMLAN¹

Appeal 2020-000346
Application 12/854,082
Technology Center 2100

Before ROBERT E. NAPPI, ELENI MANTIS MERCADER, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant filed a Request for Rehearing under 37 C.F.R. § 41.52 on July 20, 2020 (hereinafter “Request”), requesting that we reconsider our Decision on Appeal of June 1, 2020 (hereinafter “Decision”). In the Decision, we reversed the Examiner’s rejections of claims 1, 5, 12, 15, 21 through 30, 32, 33, and 36 through 40 under 35 U.S.C. § 112, first paragraph; claims 1 and 5 under 35 U.S.C. § 112 second paragraph; claims 1

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). According to Appellant, Jeffrey A. Rapaport, is the real party in interest. Appeal Br. 3.

and 36 through 40 under 35 U.S.C. § 103 based upon Turski, Schoenberg and Sacco; claims 2 through 4, 6 through 10, and 18 through 20 under 35 U.S.C. § 103 based upon Schoenberg Macadaan and Neely; and claims 5, 12 through 17, and 32 through 35 under 35 U.S.C. § 103 based upon Sacco and Schoenberg. We affirmed the Examiner's rejections of claims 18 through 20, 26 through 28, and 31 under 35 U.S.C. § 112, first paragraph; claims 2 through 4, 6 through 10, and 12 through 24 under 35 U.S.C. § 112 second paragraph; claims 21 through 24 under 35 U.S.C. § 102 based upon Elder; and claims 25 through 31 under 35 U.S.C. § 103 based upon Schoenberg and Elder.

We reconsidered our Decision in light of Appellant's Request for Rehearing, but we decline to modify the Decision.

ISSUES AND ANALYSIS

Appellant requests rehearing based on several points allegedly misapprehended or overlooked in the by the Board when it affirmed the 35 U.S.C. § 103 rejections. Request 2. We will address each point in the order presented in the Request.

First Point

Appellant's first argued point is that Board misapprehended Appellant's statements in the Appeal Brief, which rely upon arguments made outside of the Appeal Brief, as requesting a *de novo* review and that this constitutes a global error that is overlooked by the Board. Request 2–11. Appellant presents several rationales to support this argument.

First, Appellant argues that these statements were rebuttal evidence, in the form of specification evidence, which the Examiner refused to consider

and mischaracterized as “lengthy arguments.” Request 2–6 (Appellant’s ¶¶ 1b–1c) (citing *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 959 F.3d 1091 (Fed. Cir. 2020) and several non-precedential PTAB decisions).

These arguments have not persuaded us of to change the Decision. In *McRO*, the “specification evidence” discussed is the specification of the application. *McRO* at 1099. Our decision did consider the Specification as evidence when Appellant provided specific arguments identifying portions of the Specification. However, as stated in the Decision:

Throughout the Briefs Appellant’s arguments also reference arguments not made in the Briefs but presented in prior communications with the Examiner. *See, e.g.*, Appeal Br. 17 (“[a]ll this by the way is argued and backed up with supporting evidence to a greater level of detail in the earlier filed response RE7/2018 which the Examiner has elected to summarily dismiss as ‘lengthy arguments.’ See pg. 27 of RE7/2018 (‘Be that as it may, ... ’). RE7/2018 is part of the record.”). These arguments, presented in papers other than the Briefs, have not been considered as they are not before us. *See* 37 C.F.R. § 41.37(iv) (“any arguments or authorities not included in the appeal brief will be refused consideration by the Board for purposes of the present appeal”).

Decision 5 (footnote omitted). The discussion of “specification evidence” in *McRO* does not contradict this holding. Thus, we did not overlook the arguments, rather we identified they were not properly before us. Had Appellant wanted the Board to consider arguments made in prior responses to the Examiner, Appellant should have presented those arguments in the Appeal Brief as required by 37 C.F.R. § 41.37. Appellant’s argument that on page 17 of the Brief, that a) they incorporated the prior arguments in the brief; b) that they asserted the Examiner failed to address these arguments; and c) that a) and b) constitute rebuttal evidence, is nothing more than an

attempt to circumvent 37 C.F.R. § 41.37(iv). Further, Appellant has not shown that the arguments presented in prior responses could not have been presented in the Appeal Brief, and as such they were waived. Accordingly, Appellant's arguments in ¶¶ 1b–1c of the Request have not persuaded that we overlooked arguments raised by Appellant in the Briefs.

Second, Appellant argues that numerous times on the record Appellant identified Figure 2 as providing support for the claimed recitation of “spatial and/or hierarchical” organization. Request 6 (Appellant's ¶ 1d), Appellant asserts this “was merely one example of a wholesale refusal by the Examiner to respond to all the rebuttal evidence” and asserts the response to the Examiner dated July 9, 2018 cites to additional “specification evidence” which was not considered by the Examiner. Request 7.

These arguments are not persuasive of error in the Decision. We did consider Appellant's arguments in the Appeal Brief, identifying Figure 2 and Figures 5A and 6 as providing written-description support for the “spatial and/or hierarchical organization” limitation. *See* Decision 7 and 8, reversing the Examiner's rejection as it applies to this limitation. However, as discussed above, any other arguments in the July 9, 2018, response to the Examiner, were not before us and as such were not considered. Accordingly, Appellant's argument ¶ 1d of the Request have not persuaded that we overlooked arguments raised by Appellant in the Briefs.

Third, Appellant argues that the response to the Examiner dated July 9, 2018 is incorporated by reference into the Appeal Brief and does not appear to be a rule against such incorporation by reference.

Request 8 (Appellant's ¶ 1e).

As discussed above, the Decision cited 37 C.F.R. § 41.37(iv) which clearly states, "any arguments or authorities not included in the appeal brief will be refused consideration by the Board for purposes of the present appeal." The citations and arguments made in the July 9, 2018 were not presented in the Appeal Brief. Nor has Appellant identified any authority that permits incorporation by reference of prior arguments. Accordingly, Appellant's argument ¶ 1e of the Request have not persuaded that we overlooked arguments raised by Appellant in the Briefs.

Fourth, Appellant argues that with respect to the written-description rejection the Appellant provided rebuttal evidence in the July 9, 2018 response to the Examiner. Request 8–10 (Appellant's ¶ 1f). In these arguments, Appellant identifies portions of the Specification asserted to provide support of the limitations identified by the Examiner as lacking written-description support. *Id.*

These arguments have not persuaded us we misapprehended or overlooked arguments made in the prior decision. Appellant's arguments in paragraph 1f (i) assert we correctly determined the limitation "spatially and/or hierarchical organization." We note that this determination in the decision was based upon arguments made in the Appeal Brief, not based upon arguments made in the July 9, 2018 response to the Examiner. Decision 6–7. Appellant's arguments in paragraph 1f (ii) assert the limitation directed to "headline column" was identified in the July 9, 2018 response to the Examiner in paragraph 99. Request 8. The Appeal Brief included no argument that the limitation

was supported in paragraph 99. As such, we did not overlook this argument as Appellant did not present it to us in accordance with 37 C.F.R. § 41.37(iv). Appellant makes similar arguments in paragraphs 1f (iii–vix). As identified in the Decision, we considered not only the portions of the Specification cited in the arguments but also those in the “Summary of the Claimed Subject Matter” portion of the Appeal Brief. Decision 7–8. The paragraphs of the Specification asserted in the Request as providing written-description support for rejected claim limitations were also not identified in the Summary of the Claimed Subject Matter section of the Appeal Brief. Accordingly, Appellant’s arguments in ¶¶ 1f (i–vix) of the Request have not persuaded us that we overlooked arguments raised by Appellant in the Briefs.

Second Point

Appellant’s second argued point is that the Decision’s discussion on page 18, as to why we reversed the Examiner’s rejection of claim 2 under 35 U.S.C. § 112, second paragraph, is confusing. Request 11. On page 18 of the Decision, we merely identified that we disagreed with the Examiner’s rationale that is it not clear if the “vote” and “guess” are the same (*see e.g.*, Answer 30), as we do not see any confusion. Thus, Appellant’s arguments directed to the second point have not persuaded that we misapprehended or overlooked arguments raised by Appellant in the Briefs, and we do not change the Decision.

Third Point

Appellant's third argued point is that the Decision simplified the definition of "community-controlled topic space." Request 11. Appellant cites to the July 9, 2018 response to the Examiner as asserting that topic space is community controlled due to automatically repeated updating and not just based on plural users as identified on page 16 of the Decision. Request 11–12.

These arguments have not persuaded us to change the Decision. This point is premised upon arguments presented in the July 9, 2018 response to the Examiner and not an argument raised in the Appeal Brief. As such, Appellant did not present it to us in accordance with 37 C.F.R. § 41.37(iv). Thus, Appellant's arguments directed to the third point have not persuaded that we misapprehended or overlooked arguments raised by Appellant the Briefs, and we do not change our decision.

Fourth Point

Appellant's fourth argued point is that the discussion on page 6 of the Decision addressing Figure 2's Topic Center Owned Note Exchanges (TCONES) is a conclusion unsupported by evidence of record. Request 12. Appellant asserts that the decision erred in discussing item 225 as being a topic space; rather Appellant asserts it is a platform and the TCONES 216 do not extend outside topic space 215. Request 12.

We are not persuaded of error by these arguments. Initially, we note that the statement cited by Appellant is on page 8 of the Decision

and not page 6 as argued by Appellant. Further, these statements are in support of a reversal of the Examiner's written-description rejection. Appellant's Specification in numerous places discuss items 215 and 225 as spaces for topics and identifies item 220 as a platform. *See e.g.*, Specification ¶¶ 85, 86, 104, and 119. Thus, not persuading us we misunderstood item 225 as a topic space. Further, regarding Appellant's statement about the TCONES extending outside the topic space, the Decision did not discuss the TCONES extending outside the topic space. The Decision merely stated that "Figure 2 depicts Topic Center Owned Note Exchanges (TCONES) which extend in the z direction (i.e., perpendicular to the topic space) and as such represent a spatial organization of the data." Decision 8. Thus, Appellant's arguments directed to the fourth point have not persuaded that we misapprehended or overlooked arguments raised by Appellant the Briefs, and we do not change our decision.

CONCLUSION

For the aforementioned reasons, Appellant's contentions have not persuaded us to change our Decision with respect to the rejections under 35 U.S.C. § 112, 35 U.S.C. § 102, and 35 U.S.C. § 103

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).

REQUEST FOR REHEARING DENIED

Outcome of Decision on Rehearing:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Denied	Granted
1, 5, 12, 15, 18-33, 36-40	112, first paragraph	Written Description	18-20, 26-28, 31	
1-10, 12-40	112, second paragraph	Indefinite	2-4, 6-10, 12-40	
21-24	102	Eder	21-24	
25-31	103	Schoenberg, Eder	25-31	
Overall Outcome			2-4, 6-10, 12-40	

Final Outcome of Appeal after Rehearing:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 5, 12, 15, 18-33, 36-40	112, first paragraph	Written Description	18-20, 26-28, 31	1, 5, 12, 15, 21-30, 32, 33, 36-40
1-10, 12-40	112, second paragraph	Indefinite	2-4, 6-10, 12-40	1, 5
21-24	102	Eder	21-24	
1, 36-40	103	Turski, Schoenberg, Sacco		1, 36-40
2-4, 6-10, 18-20	103	Schoenberg, Macadaan, Neely		2-4, 6-10, 18-20
5, 12-17, 32-35	103	Sacco, Schoenberg		5, 12-17, 32-35
25-31	103	Schoenberg, Eder	25-31	
Overall Outcome			2-4, 6-10, 12-40	1, 5