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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NEC CORPORATION
Patent Owner and Appellant

Appeal 2020-003235
Reexamination Control 96/000,221
United States Patent 9,601,078 B2
Technology Center 3900

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

JEFFERY, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. §§ 134 and 306 the Examiner's decision to reject claims 1 and 7–16. We have jurisdiction under 35 U.S.C. §§ 134 and 306.²

We AFFIRM.

¹ Appellant identifies the real party in interest as NEC INTELLECTUAL PROPERTY CENTER AMERICA. Appeal Br. 2.

² On May 18, 2020, Appellant waived attendance at an oral hearing scheduled for this appeal on May 27, 2020.

STATEMENT OF THE CASE

This proceeding is a supplemental examination of United States Patent 9,601,078 (“the ’078 patent”), issued to Ryo on March 21, 2017.

The ’078 patent’s invention controls displaying interrupt events, such as incoming calls, by considering privacy when an electronic device, such as a mobile phone, outputs image data to an external display device. To this end, the interrupt notification is selected or limited based on attributes relating to an electronic device and an external display device. *See generally* ’078 patent, col. 2, ll. 8–25; col. 8, l. 1 – col. 12, l. 5. Claim 1 is illustrative of the invention and is reproduced below:

1. An electronic device comprising:
 - a storage unit configured to store the image data;
 - a controller configured to read the image data from the storage unit;
 - an image output processor configured to output the image data to an external display device in synchronization with the electronic device; and
 - an interrupt notification processor configured to notify an interrupt event to the external display device,wherein the image output processor selects or limits interrupt notification relating to the interrupt event based on at least one of a first attribute relating to the electronic device and a second attribute relating to the external display device, thus outputting the interrupt notification to the external display device.

THE REJECTIONS

The Examiner rejected claims 1 and 7–16 under 35 U.S.C. § 305 as enlarging the reexamined patent’s claims. Final Act. 3–4.³

The Examiner rejected claim 1⁴ under 35 U.S.C. § 112(b) or pre-AIA 35 U.S.C. § 112, second paragraph as indefinite. Final Act. 5.

The Examiner rejected claim 8 under 35 U.S.C. § 112(d) or pre-AIA 35 U.S.C. § 112, fourth paragraph as being of improper dependent form. Final Act. 6.

The Examiner rejected claims 1, 7–10, and 12 under 35 U.S.C. § 102(b) as anticipated by Kimura (US 2009/0209296 A1; published Aug. 20, 2009). Final Act. 6–12.

The Examiner rejected claims 1, 7, 9, 10, 14, and 15 under 35 U.S.C. § 102(b) as anticipated by Marley (US 2007/0139514 A1; published June 21, 2007). Final Act. 12–17.

The Examiner rejected claims 11 and 13 under 35 U.S.C. § 103 as unpatentable over Marley and Kabuanik (CN101197890 A; published Aug. 11, 2008) (“CN ’890”). Final Act. 18–22.

³ Throughout this opinion, we refer to (1) the Final Rejection mailed April 4, 2018 (“Final Act.”); (2) the Appeal Brief filed October 3, 2018 (“Appeal Br.”); (3) the Examiner’s Answer mailed December 31, 2018 (“Ans.”); and (4) the Reply Brief filed February 28, 2019 (“Reply Br.”).

⁴ Although the Examiner rejects independent claim 1 as indefinite, the Examiner nonetheless omits claims 9–13 that would also be indefinite due to their dependency from claim 1. Despite this inconsistency, we nonetheless reproduce the Examiner’s rejection as articulated on page 5 of the Final Office Action and restated on page 3 of the Answer.

Appeal 2020-003235
Reexamination Control 96/000,221
Patent US 9,601,078 B2

The Examiner rejected claim 16 under 35 U.S.C. § 103 as unpatentable over Marley and Toda (US 2008/0019494 A1; published Jan. 24, 2008). Final Act. 22–24.

THE IMPROPER BROADENING REJECTION

The Examiner finds that the amendment to independent claims 1 and 7 on October 3, 2017 improperly broadened the claims by eliminating (1) the previously-recited image data acquisition part that acquires data, and (2) various limitations in the “wherein” clause including replacing the previously-recited refusing plural information with limiting interrupt notification. Final Act. 3–4; Ans. 4–6. The Examiner adds that, unlike the previous independent claims, the current independent claims do not specify when the output processor makes the claimed determination. Ans. 6.

Appellant argues that not only is the currently-claimed controller not broader than the patented image data acquisition part, the currently-claimed “wherein” clause is also not broader than the patented limitation. Appeal Br. 8. According to Appellant, the Examiner incorrectly treats the previous limitation of “selects or refuses a plurality of information” and the amended limitation of “selects or limits interrupt notification” as applying to the same step, such that the amended term “limits” broadens the previous term “refuses.” Reply Br. 4–5. Appellant emphasizes, however, that this interpretation is incorrect because the amended limitation refers to the result, namely selecting or limiting the interrupt notification, that is said to “flow” from the original limitation and, therefore, does not change the claim’s scope. Reply Br. 5. Appellant adds that claims 1 and 7 are not broader than

Appeal 2020-003235
Reexamination Control 96/000,221
Patent US 9,601,078 B2

the patented claims with respect to the timing of executing the interrupt notification process. Reply Br. 6–7.

ISSUE

Has the Examiner erred by finding that claims 1 and 7–16 impermissibly broaden the patented claims under 35 U.S.C. § 305?

ANALYSIS

We begin by noting that the test for determining whether a reexamined claim is broader than an original claim under 35 U.S.C. § 305 is the same as that under 35 U.S.C. § 251 for determining whether reissue claims filed more than two years after issuance of the original patent are broader than the original claims. *Quantum Corp. v. Rodime, PLC*, 65 F.3d 1577, 1582 n.4 (Fed. Cir. 1995); accord Manual of Patent Examining Procedure (MPEP) §§ 2250, 2258(III)(A) (9th ed. Rev. 08.2017, Jan. 2018). As with § 251 in reissue, § 305 is interpreted strictly in this regard to prohibit *any* broadening claim amendments, even those that narrow the claim in other respects. *See Predicate Logic, Inc. v. Distributive Software, Inc.*, 544 F.3d 1298, 1303 (Fed. Cir. 2008); *see also Medtronic, Inc. v. Guidant Corp.*, 465 F.3d 1360, 1374 (Fed. Cir. 2006). That is, a claim in a reissue or reexamination proceeding is broader in scope than the original claims if it contains within its scope *any* conceivable apparatus or process which would not have infringed the original patent. *See Medtronic*, 465 F.3d at 1374.

That is the case here. As noted below, on October 3, 2017, claim 1 was amended as follows:

1. (currently amended): An electronic device comprising:

a storage unit configured to store the image data;

[an image data acquisition part]a controller configured to [acquire]read the image data from the storage unit;[and]

an image output processor configured to output the image data to an external display device[,] in synchronization with the electronic device; and

an interrupt notification processor configured to notify an interrupt event to the external display device.

wherein[, when an interrupt event occurs while the image output processor outputs the image data to the external display device,] the image output processor [selects or refuses a plurality of information]selects or limits interrupt notification relating to the interrupt event based on at least one of [an]a first attribute [of the interrupt event]relating to the electronic device and [an]a second attribute [of]relating to the external display device, thus outputting [selected information]the interrupt notification to the external display device.

Amendment to claim 1 filed on October 3, 2017

As shown above, Appellant's amendment revised every clause of claim 1 including, among other things, replacing the recited image data acquisition part configured to *acquire* image data with a controller configured to *read* the image data from a storage unit configured to store data. That is, despite the Examiner's findings to the contrary (Final Act. 3–4), the controller's image data acquisition function was *narrowed* to a

particular *way* to acquire data, namely reading it from storage. Therefore, this aspect of the claimed invention was narrowed—not broadened—as the Examiner apparently acknowledges in the Answer. *See* Ans. 4 (“[T]he Examiner agrees that the claimed ‘controller’ is not necessarily broader than the patented ‘image data acquisition part’”).

We do, however, agree with the Examiner that Appellant’s amendment effectively broadened the last clause of claim 1, namely the “wherein” clause. *See* Final Act. 4; Ans. 5–6. The ’078 patent’s original “wherein” clause is reproduced below with our emphasis:

wherein, *when* an interrupt occurs *while* the image output processor outputs the image data to an external display device, the image output processor *selects or refuses a plurality of information relating to the interrupt event* based on at least one of an attribute *of* the interrupt event and an attribute *of* the external display device, thus outputting *selected information* to the external display device.

’078 patent, col. 22, ll. 3–10.

Our emphasis on the terms “when” and “while” underscores two key temporal limitations pertaining to the recited image output processor, namely that it selects or refuses information relating to the interrupt event not only *when* an interrupt occurs, but also that this interrupt occurs *while* the processor outputs image data to the display device.

But after amendment, claim 1 now recites, in pertinent part, “wherein, the image output processor *selects or limits interrupt notification* relating to the interrupt event based on at least one of a first attribute *relating to the electronic device* and a second attribute *relating to* the external display

device, thus outputting the *interrupt notification* to the external display device.”

Although Appellant’s amendment narrowed the previously-recited selected and outputted information to a particular *form* of that information, namely an interrupt notification, the amendment nonetheless broadened the limitation in other respects by (1) removing the particular time when this information selection occurs, namely *when* an interrupt event occurs *while* the processor outputs image data to the display device; and (2) changing the attributes’ respective relationships to their associated elements.

That the claim now recites that the image output processor is configured to output the image data to the display device in synchronization with the electronic device as Appellant indicates (Reply Br. 6–7) is of no consequence here, for this recited synchronization does not specify the particular time when information selection occurs, namely *when* an interrupt event occurs *while* the processor outputs image data to the display device as originally claimed. To the extent Appellant contends otherwise, we disagree.

Furthermore, the first recited attribute is now recited, quite broadly, as merely *relating to the electronic device* rather than being specifically “*of the interrupt event*” as originally claimed. Moreover, the second recited attribute is now recited, quite broadly, as merely *relating to the external display device* rather than being *of that device* as originally claimed.

Simply put, an attribute *relating to* the recited electronic device as now claimed includes, but is not limited to, attributes of the device’s associated interrupt events. This increased attribute coverage is unlike

patented claim 1 where the first recited attribute is limited specifically to that *of* the interrupt event. Similarly, an attribute *relating to* the recited display device as now claimed includes, but is not limited to, attributes *of* that device, but also can include other attributes that merely *relate to* that device. This increased attribute coverage is unlike patented claim 1 where the second recited attribute is limited specifically to that *of* the display device.

Therefore, despite Appellant’s amendment narrowing the claim in some respects, it nonetheless broadened the claim in other respects—a broadening that is impermissible under § 305. *See Predicate Logic*, 544 F.3d at 1303; *see also Medtronic*, 465 F.3d at 1374. We reach the same conclusion regarding independent claim 7 that was amended similarly.

Therefore, we are not persuaded that the Examiner erred in rejecting claims 1 and 7–16 under § 305.

THE INDEFINITENESS REJECTION

Because Appellant does not contest the Examiner’s indefiniteness rejection of claim 1⁵ (*see* Appeal Br. 9; Final Act. 5; Ans. 7), we summarily sustain this rejection. *See* MPEP § 1205.02 (“If a ground of rejection stated by the examiner is not addressed in the appellant’s brief, appellant has waived any challenge to that ground of rejection and the Board may summarily sustain it, unless the examiner subsequently withdrew the rejection in the examiner’s answer.”).

⁵ As noted previously, the Examiner rejects only independent claim 1 as indefinite, and omits dependent claims 9–13 that would also be indefinite due to their dependency from claim 1.

THE IMPROPER DEPENDENT CLAIM REJECTION

Although Appellant does not contest the Examiner’s improper dependent claim rejection of claim 8 under § 112(d) (*see* Appeal Br. 9; Final Act. 6; Ans. 7), we do not summarily sustain this rejection as we did for the uncontested indefiniteness rejection, but rather reverse it because it is improper on its face.

Claim 8 is independent—not dependent. Claim 8 recites, with our emphasis, “[a] non-transitory computer-readable *storage media* having stored a program causing a computer of an electronic device to implement the image data output processing method according to claim 7.” Our emphasis underscores that the claim, when read as a whole, is directed to computer-readable storage media—an article of manufacture that is in a different category of subject matter under 35 U.S.C. § 101 than that for independent claim 7 whose recited method falls in the process category. *See* 35 U.S.C. § 101.

Although claim 8 incorporates independent claim 7’s limitations by reference, that does not mean that it depends from claim 7. That is, when read as a whole, claim 8 is not intended to *further limit* independent claim 7 under 37 C.F.R. § 1.75(c), but merely incorporate the limitations of claim 7 by reference, thus precluding the need to articulate every word of those incorporated limitations expressly—a common shorthand claim drafting technique. *See, e.g., Guidelines for Examination* § 3.8, European Patent Office (Oct. 1, 2019), https://www.epo.org/law-practice/legal-texts/html/guidelines/e/f_iv_3_8.htm (“A claim containing a reference to

another claim is not necessarily a dependent claim One example of this is a claim referring to a claim of a different category (e.g. ‘Apparatus for carrying out the process of claim 1 . . .’, or ‘Process for the manufacture of the product of claim 1 . . .’”).

Here, claim 8 merely specifies what the program stored on the media does when that program is executed at some future time, namely that the program causes the electronic device’s computer to implement claim 7’s image data output processing method. When read as a whole, then, claim 8 is directed to the storage media—a manufacture—not the process that happens when the program on that media is executed. In fact, this execution need not occur at all to satisfy the claim: rather, the claim is satisfied by merely providing storage media, such as a disk, with the recited program stored thereon.

Because claim 8 is independent—not dependent—the Examiner’s rejection under § 112(d) is improper. Although Appellant does not contest this rejection, it is nonetheless factually and legally unsound and, therefore, no reasonable mind could accept it. *See generally Consolidated Edison Co. v. N.L.R.B.*, 305 U.S. 197, 229 (1938) (defining “substantial evidence” as such relevant evidence as a reasonable mind might accept as adequate to support a conclusion); *see also In re Gartside*, 203 F.3d 1305, 1312 (Fed. Cir. 2000) (quoting this definition).

Therefore, the Examiner erred in rejecting claim 8 under § 112(d).

THE ANTICIPATION REJECTION OVER KIMURA

The Examiner finds that Kimura discloses an electronic device with every recited element of independent claim 1 including an image output processor that selects or limits interrupt notification relating to an interrupt event based on at least one of (1) a first attribute relating to the electronic device, namely the clock time when a connection is established with the electronic device that determines a call's priority; and (2) a second attribute relating to an external display device, namely each display device's arrangement with respect to the driver's and passenger's seats, respectively. Final Act. 6–8; Ans. 12–14.

Appellant argues that, in rejecting the claim, the Examiner misconstrued the “at least one of” limitation to recite that the interrupt notification is selected or limited based on either the first or second attributes. Reply Br. 7–11. According to Appellant, because the “at least one of” limitation applies only to the first attribute, the recited interrupt notification selection or limitation is based on both attributes—not just one. Reply Br. 8. Appellant adds that Kimura does not disclose the recited attributes, let alone select or limit an interrupt notification based on those attributes as claimed. Appeal Br. 9–12; Reply Br. 14–17. Appellant argues various other recited limitations summarized below.

ISSUES

Under § 102, has the Examiner erred by finding that Kimura discloses:

(1) the image output processor selecting or limiting an interrupt notification relating to an interrupt event based on at least one of a first attribute relating to the electronic device and a second attribute relating to an external display device as recited in claim 1 (“the interrupt notification limitation”)?

(2) the limitations recited in claims 9 and 12?

ANALYSIS

Claims 1, 7, and 8

We begin by noting that the Examiner and Appellant construe the disputed interrupt notification limitation in claim 1 quite differently. The Examiner construes the recited interrupt notification being selected or limited based on *at least one of* (1) a first attribute relating to the electronic device, and (2) a second attribute relating to the external display device. *See* Final Act. 8; Ans. 12–14. Under this construction, selecting or limiting the interrupt notification need only be based on *either* the first *or* the second attribute to satisfy the claim. *See* Ans. 12.

Appellant, on the other hand, construes the interrupt notification limitation such that the “at least one of” term applies only to the first attribute, such that the interrupt notification is selected or limited based on *both* attributes—not just one. *See* Reply Br. 8. In other words, Appellant construes the recited interrupt notification being selected or limited based on (1) *at least one of* a first attribute relating to the electronic device, *and* (2) a second attribute relating to the external display device. *See id.*

On this record, we see no error in the Examiner’s broader construction. First, Appellant’s argument regarding the alleged impropriety of the Examiner’s construction was first raised in the Reply Brief—not the Appeal Brief—and is waived as untimely under 37 C.F.R. § 41.41(b)(2). *Compare* Appeal Br. 9–12 *with* Reply Br. 8, 14–17. Nor has good cause been shown to raise these new arguments in the first instance in the Reply Brief, particularly since the Examiner refers to the recited attributes *in the alternative* on page 8 of the Final Office Action from which this appeal was taken. In fact, Appellant’s arguments in the Appeal Brief were limited solely to the Examiner’s alternative construction, and said nothing about the claim requiring that recited interrupt notification be based on *both* attributes as alleged in the Reply Brief. *Compare* Appeal Br. 11 (“Appellant respectfully submits that Kimura provides no disclosure whatsoever in relation to selecting or limiting an interrupt notification relating to the interrupt event based on an attribute of *either* the electronic device *or* the external display device.”) (emphasis added) *with* Reply Br. 7–17. That Appellant emphasizes the words “both” and “and” in connection with the attributes on which the interrupt notification is based on pages 7, 8, and 10 of the Reply Brief—an emphasis that the Appeal Brief lacks—is telling in this regard.

Nevertheless, even if this argument was timely raised—which it was not—we still find it unpersuasive. First, construing the “*at least one of*” term—a term synonymous with “*one or more*”⁶—to apply only to the first

⁶ See *Howmedica Osteonics Corp. v. Wright Medical Technology, Inc.*, 540 F.3d 1337, 1344 (Fed. Cir. 2008).

attribute as Appellant proposes (Reply Br. 8) runs counter to that attribute's *singular*—not plural—recitation. Notably, the claim recites both attributes in the singular form, namely “*a* first attribute” and “*a* second attribute.” Given these singular terms considered in the claim's context that effectively groups these individual attributes, the “at least one of” phrase in the interrupt notification limitation more naturally aligns with the Examiner's construction, namely that the interrupt notification is selected or limited based on *at least one of* (1) a first attribute relating to the electronic device, *and* (2) a second attribute relating to the external display device. *See* Final Act. 8; Ans. 12–14.

To the extent that Appellant contends that the cited passages in the Specification somehow preclude the Examiner's construction and require Appellant's proposed narrower construction (*see* Reply Br. 8–11), we disagree. Nor will we import this description into the claims. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc) (“[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments. . . . [C]laims may embrace different subject matter than is illustrated in the specific embodiments in the specification.”) (Citations and internal quotation marks omitted).

Under the Examiner's broader reasonable construction, we see no error in the Examiner's finding that Kimura anticipates the interrupt notification limitation. First, we see no error in the Examiner's mapping the recited first attribute to the clock time when a connection is established with the electronic device that determines a call's priority in Kimura's paragraph

61 and Figure 18B. *See* Final Act. 8; Ans. 13. This temporal attribute at least *relates to* the electronic device, namely the in-vehicle hands-free apparatus 1 under the Examiner’s mapping (Final Act. 7), at least with respect to the associated incoming call priority determination and notification. *See* Kimura ¶¶ 57–61; Fig. 18B.

As shown in Kimura’s Figure 18B, the incoming call notification is not only selected to indicate a priority call, but the notification is also limited in that regard, particularly when comparing this priority-based notification with the display in Figure 18A that lacks this particular notification. In short, Kimura’s priority-based interrupt notification in Figure 18B is, at least in one implementation, based at least on clock time—a temporal attribute that, as noted in paragraph 61, is used to grant priority to the phone with the earlier clock time.

For this reason alone, Kimura anticipates the interrupt notification limitation given the limitation’s alternative language where the claim is satisfied by the interrupt notification being selected or limited based on *either* attribute—not both—consistent with the Examiner’s interpretation.

Nevertheless, we are also unpersuaded of error in the Examiner’s finding that the interrupt notification is *also* selected or limited based on a second attribute, namely each display device’s arrangement with respect to the driver’s and passenger’s seats, respectively, in Kimura’s paragraph 68. *See* Final Act. 8 (noting this alternative basis); Ans. 13. This arrangement-based attribute at least *relates to* an external display device, not only regarding its arrangement with respect to the vehicle and its occupants, but also distributing information to those devices based on that arrangement.

See Kimura ¶ 68. In this sense, then, the interrupt notification is not only selected for display to particular vehicle occupants, namely the driver and passengers, respectively, but the notification is also effectively limited by distributing it to only the intended recipients in the vehicle. *See* Kimura ¶ 68.

In short, Kimura's interrupt notification, namely that associated with an incoming call under the Examiner's mapping (*see* Final Act. 8), is effectively selected or limited based on either attribute. Appellant's contention that Kimura lacks the recited attributes, but merely uses information that identifies connected telephones (Reply Br. 16), is unavailing and not commensurate with the scope of the claim that does not preclude Kimura's relied-upon disclosure for teaching the recited attributes.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 1, and claims 7 and 8 not argued separately with particularity.

Claims 9, 10, and 12

We also sustain the Examiner's rejection of claim 9 reciting, in pertinent part, the interrupt notification processor comprises (1) an information selecting part configured to select or limit the interrupt notification, where the notification represents internal or external interrupt events, and (2) an information superposing part configured to superpose the interrupt notification over the image data. Final Act. 10–11. We also sustain the Examiner's rejection of claim 12 reciting that the information superposing part adjusts the interrupt notification's brightness to that of the image data.

Although Appellant contends that Kimura does not disclose the recited limitations, Appellant does not explain why this is so, but rather argues CN '890's alleged deficiencies in this regard—a reference that was not cited in either anticipation rejection. *See* Appeal Br. 12–14; Ans. 14–17 (noting this inconsistency). That is, Appellant does not argue Kimura's alleged shortcomings in connection with the anticipation rejection of claims 9 and 12 with particularity to show error in the Examiner's associated findings. *See* 37 C.F.R. § 41.37(c)(1)(iv) (noting that an argument that merely points out what a claim recites is unpersuasive). *Accord In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[T]he Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”).

Therefore, we are not persuaded that the Examiner erred in rejecting claims 9 and 12. We reach the same conclusion regarding claim 10 that is also not argued separately with particularity.

THE ANTICIPATION REJECTION OVER MARLEY

Claims 1, 7, 9, and 10

We also sustain the Examiner's anticipation rejection of claim 1 over Marley. Final Act. 12–14. Although Appellant contends that Marley does not disclose the recited limitations (Appeal Br. 9–10), Appellant does not explain why this is so, but rather argues the alleged deficiencies of *CN '890 and Kimura* in this regard—references that are inapposite to the Examiner's anticipation rejection that is based solely on Marley. *See* Appeal Br. 9–12;

Ans. 8 (noting this inconsistency). Although the Examiner restates the rejection after correctly articulating this inconsistency in the Answer, this restatement is substantially similar to the rejection articulated in the Final Office Action despite reproducing Marley's Figures 1 and 4—figures that are likewise referred to in the rejection. *Compare* Final Act. 12–14 *with* Ans. 9–12.

That is, Appellant does not argue Marley's alleged shortcomings in connection with the anticipation rejection of claim 1 with particularity to show error in the Examiner's associated findings. *See* 37 C.F.R. § 41.37(c)(1)(iv) (noting that an argument that merely points out what a claim recites is unpersuasive). *Accord Lovin*, 652 F.3d at 1357.

Furthermore, Appellant's arguments regarding Marley's alleged shortcomings with respect to the Examiner's anticipation rejection of claim 1 made for the first time on pages 11 to 14 of the Reply Brief are waived as untimely, for these arguments were not raised in the Appeal Brief. *See* 37 C.F.R. § 41.41(b)(2). Nor has good cause been shown to raise these new arguments in the first instance in the Reply Brief, particularly given the striking similarity between the Examiner's response to arguments in the Answer and the rejection as noted above.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 1, and claims 7, 9, and 10 not argued separately with particularity.

Claims 14 and 15

We also sustain the Examiner's rejection of claim 14 reciting (1) recording a playback position of the image data on the storage unit when

operated manually by the user; (2) carrying out a specific operation with the electronic device; (3) upon detecting a termination of the specific operation, resuming a time-shift playback for the image data at the playback position. Although Appellant contends that *CN '890 and Kimura* do not disclose the recited limitations—references that are inapposite to the Examiner's anticipation rejection based solely on Marley. *See* Appeal Br. 15; Ans. 18 (noting this inconsistency). Although the Examiner also restates the rejection after correctly articulating this inconsistency in the Answer, this restatement is substantially similar to the rejection despite reproducing Marley's Figure 5—a figure that is likewise referred to in the rejection. *Compare* Final Act. 16–17 *with* Ans. 17–19.

That is, Appellant does not argue Marley's alleged shortcomings in connection with the anticipation rejection of claim 14 with particularity in the Appeal Brief to show error in the Examiner's associated findings. *See* 37 C.F.R. § 41.37(c)(1)(iv) (noting that an argument that merely points out what a claim recites is unpersuasive). *Accord Lovin*, 652 F.3d at 1357.

Furthermore, Appellant's arguments regarding Marley's alleged shortcomings pertaining to the Examiner's anticipation rejection of claim 14 that were made for the first time on page 14 of the Reply Brief are waived as untimely, for these arguments were not raised in the Appeal Brief. *See* 37 C.F.R. § 41.41(b)(2). Nor has good cause been shown to raise these new arguments in the first instance in the Reply Brief, particularly given the striking similarity between the Examiner's response to arguments in the Answer and the rejection as noted above.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 14, and claim 15 not argued separately with particularity.

THE OBVIOUSNESS REJECTION OVER MARLEY AND CN '890

Claim 11

We also sustain the Examiner's obviousness rejection of claim 11 over Marley and CN '890. Final Act. 18–21. Claim 11 depends from claim 9 and recites, in pertinent part, (1) the first attribute relates to a secret setting how to limit the interrupt notification based on a relationship between a user and its communicating partner, and (2) the second attribute relates to a private or public usage for the external display device and/or image data type.

Although Appellant contends that CN '890 *and Kimura* do not disclose the recited limitations, Appellant not only fails to explain why this is so, but this contention is inapposite to the Examiner's proposed combination that is based on Marley and CN '890—not CN '890 and Kimura. *See* Appeal Br. 13; Ans. 20 (noting this inconsistency). Although the Examiner restates the rejection after correctly articulating this inconsistency in the Answer, this restatement is substantially similar to the rejection articulated in the Final Office Action. *Compare* Final Act. 19–21 *with* Ans. 20–21.

That is, Appellant does not argue the alleged shortcomings of Marley and CN '890 in connection with the obviousness rejection of claim 11 with particularity in the Appeal Brief to show error in the Examiner's associated findings and conclusions. *See* 37 C.F.R. § 41.37(c)(1)(iv) (noting that an

argument that merely points out what a claim recites is unpersuasive).

Accord Lovin, 652 F.3d at 1357.

Furthermore, Appellant's arguments regarding CN '890's alleged shortcomings pertaining to the Examiner's obviousness rejection of claim 11 that were made for the first time on pages 18 and 19 of the Reply Brief are waived as untimely, for these arguments were not raised in the Appeal Brief. *See* 37 C.F.R. § 41.41(b)(2). Nor has good cause been shown to raise these new arguments in the first instance in the Reply Brief, particularly given the striking similarity between the Examiner's response to arguments in the Answer and the rejection as noted above.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 11.

Claim 13

We also sustain the Examiner's rejection of claim 13 that depends from claim 11 and further recites the information selecting part limits the interrupt notification to a predetermined message according to the secret setting in the external display device's public usage.

First, Appellant's arguments in the Appeal Brief do not squarely address—let alone persuasively rebut—the Examiner's particular findings from CN '890 in the rejection for teaching or suggesting the recited limitations. In the rejection, the Examiner cites three different portions of CN '890, namely (1) the paragraph spanning pages 6 and 7; (2) Figure 6; and (3) pages 10 and 11. Final Act. 21. The Examiner's findings in this regard include details of CN '890's call notification process. *Id.*

Appellant, however, quotes a single phrase from the last paragraph of CN '890's page 10 regarding the disclosed television set's sensor sensing adding a new viewer and a current viewer's departure and, based on this single phrase, Appellant contends that CN '890 does not disclose or suggest the recited limitation. *See* Appeal Br. 14–15.

Notably, Appellant's single quoted phrase from CN '890's paragraph 10 on page 14 of the Appeal Brief pertains to a feature that *increases processing speed*—a functional qualifier in the first sentence of CN '890's paragraph 10 that Appellant omits from the quote. Nevertheless, Appellant's argument does not squarely address—let alone persuasively rebut—the Examiner's reliance on the details of CN '890's call notification process, let alone the *additional* relied-upon disclosure from CN '890, namely (1) the paragraph spanning pages 6 and 7; (2) Figure 6; and (3) the remainder of pages 10 and 11. *See* Final Act. 21.

In the Answer, the Examiner reiterates this reliance on CN '890's call notification process that varies a displayed notification based on (1) a user management table setting, and (2) viewers' detected facial characteristics. *See* Ans. 22–23 (quoting the paragraph spanning CN '890's pages 6 and 7). As noted above, the Examiner also relied on this disclosure in the rejection. *See* Final Act. 21.

In the Reply Brief, however, Appellant contends for the first time that CN '890 does not limit the interrupt notification as claimed, but rather bars it completely for incoming calls from users not registered in the management table. *See* Reply Br. 18–19. Notably, Appellant provides no pinpoint citations from CN '890 to support this new argument. *See id.*

This argument does not persuasively rebut the Examiner's findings and conclusions. First, Appellant's new argument regarding CN '890's alleged shortcomings in the Reply Brief was not raised in the Appeal Brief and is, therefore, waived as untimely. *See* 37 C.F.R. § 41.41(b)(2). Nor has good cause been shown to raise these new arguments in the first instance in the Reply Brief, particularly given the striking similarity between the Examiner's response to arguments in the Answer and the rejection as noted above. Although the Examiner reproduces the three notification methods shown in CN '890's Figures 8 to 10 in the Answer, these figures merely show their respective displays and are, therefore, substantively commensurate with the relied-upon call notification functionality in the rejection. *Compare* Ans. 23–24 *with* Final Act. 21–22. Therefore, to the extent Appellant contends that the Examiner's reproducing CN '890's Figures 8 to 10 in the Answer somehow provides good cause to justify the new argument on pages 18 and 19 of the Reply Brief, we disagree.

Nevertheless, even if this new argument in the Reply Brief was timely presented—which it was not—we still find it unpersuasive. On this record, Appellant's contentions do not persuasively rebut the Examiner's finding that CN '890's call notification process *varies* a displayed notification based on (1) a user management table setting, and (2) viewers' detected facial characteristics. *See* Ans. 22–23 (quoting the paragraph spanning CN '890's pages 6 and 7). This notification variation effectively limits the notification to a predetermined message according to those secret settings.

Appellant's contention that CN '890 does not limit the interrupt notification as claimed, but rather bars it completely for incoming calls from

users not registered in the management table (Reply Br. 18–19) is unavailing and not commensurate with the scope of the claim. In short, Appellant does not persuasively rebut the Examiner’s finding that CN ’890 at least suggests limiting the interrupt notification as claimed by *varying* a displayed notification based on settings and viewers’ facial characteristics as noted above. *See* Ans. 22–23.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 13.

THE OBVIOUSNESS REJECTION OVER MARLEY AND TODA

We also sustain the Examiner’s obviousness rejection of claim 16 over Marley and Toda. Final Act. 22–24. Claim 16 depends from claim 14 and further recites, in pertinent part, displaying a time bar on the external display device indicating (1) the playback position of the image data with the electronic device, and (2) another playback position of the image data played back with the external display device.

Appellant contends that *CN ’890 and Kimura* do not disclose or suggest the recited limitations, and that these references’ deficiencies are not remedied by Marley or Toda. Appeal Br. 15–16. Appellant not only fails to explain why this is so, but this contention is inapposite to the Examiner’s proposed combination that is based on Marley and Toda—not CN ’890 and Kimura. *See* Ans. 25–26 (noting this inconsistency). Although the Examiner restates the rejection after correctly articulating this inconsistency in the Answer, this restatement is substantially similar to the rejection articulated in the Final Office Action despite reproducing Toda’s Figures

Appeal 2020-003235
Reexamination Control 96/000,221
Patent US 9,601,078 B2

9(a) and 9(b)—figures that are likewise referred to in the rejection.

Compare Final Act. 22–24 *with* Ans. 26–27.

That is, Appellant does not argue the alleged shortcomings of Marley and Toda in connection with the obviousness rejection of claim 16 with particularity in the Appeal Brief to show error in the Examiner’s associated findings and conclusions. *See* 37 C.F.R. § 41.37(c)(1)(iv) (noting that an argument that merely points out what a claim recites is unpersuasive).

Accord Lovin, 652 F.3d at 1357.

Furthermore, Appellant’s arguments regarding Toda’s alleged shortcomings pertaining to the Examiner’s obviousness rejection of claim 16 that were made for the first time on pages 19 to 22 of the Reply Brief are waived as untimely, for these arguments were not raised in the Appeal Brief. *See* 37 C.F.R. § 41.41(b)(2). Nor has good cause been shown to raise these new arguments in the first instance in the Reply Brief, particularly given the striking similarity between the Examiner’s response to arguments in the Answer and the rejection as noted above.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 16.

CONCLUSION

The Examiner’s decision to reject claims 1 and 7–16 is affirmed.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 7-16	305	Improper Broadening	1, 7-16	
1	112(b)	Indefiniteness	1	
8	112(d)	Improper Dependent Claim Form		8
1, 7-10, 12	102(b)	Kimura	1, 7-10, 12	
1, 7, 9, 10, 14, 15	102(b)	Marley	1, 7, 9, 10, 14, 15	
11, 13	103	Marley, CN '890	11, 13	
16	103	Marley, Toda	16	
Overall Outcome			1, 7-16	

REQUESTS FOR EXTENSIONS OF TIME

Requests for extensions of time in this proceeding are governed by 37 C.F.R. § 1.550(c). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

Appeal 2020-003235
Reexamination Control 96/000,221
Patent US 9,601,078 B2

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Notice of References Cited	Application/Control No.	Applicant(s)/Patent Under Patent Appeal No.	
	Examiner	Art Unit	Page 1 of 1

U.S. PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A US-			
	B US-			
	C US-			
	D US-			
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Guidelines for Examination

[Part F – The European Patent Application](#) → [Chapter IV – Claims \(Art. 84 and formal requirements\)](#)

→ [3. Kinds of claim](#)

3.8 Independent claims containing a reference to another claim or to features from a claim of another category

A claim containing a reference to another claim is not necessarily a dependent claim as defined in [Rule 43\(4\)](#). One example of this is a claim referring to a claim of a different category (e.g. "Apparatus for carrying out the process of claim 1 ...", or "Process for the manufacture of the product of claim 1 ..."). Similarly, in a situation like the plug and socket example of [F-IV, 3.2\(i\)](#), a claim to the one part referring to the other co-operating part (e.g. "plug for co-operation with the socket of claim 1 ...") is not a dependent claim. In all these examples, the division carefully considers the extent to which the claim containing the reference necessarily involves the features of the claim referred to and the extent to which it does not. Indeed, objections on the grounds of lack of clarity and failure to state the technical features ([Rule 43\(1\)](#)) apply to a claim which simply says "Apparatus for carrying out the process of claim 1". Since the change of category already makes the claim independent, the applicant is required to set out clearly in the claim the essential features of the apparatus.

The same is true for a claim which says "Method for using an apparatus according to claim 1". The method claim, formulated as a use claim, lacks the steps that are carried out in order to use the apparatus (see [F-IV, 4.16](#)) and is therefore not clear.

For claims directed to computer-implemented inventions, in which independent claims often comprise references to other independent claims, see [F-IV, 3.9](#).

The subject-matter of a claim in one category may also to some extent be defined in terms of features from another category; therefore an apparatus may be defined in terms of functions it is able to perform, provided the structure is made sufficiently clear; or a process may be defined in terms of essential structural features of the apparatus for carrying it out; or an element of an apparatus may be defined in terms of how it is made. However, in the wording of these claims and in the assessment of the claimed subject-matter, a clear distinction must be maintained between product claims (for a device, apparatus or system) and process claims (for a process, activity or use). For example, a claim for an apparatus cannot normally be limited only by the manner in which the apparatus is used; for this reason, a claim which simply reads "Apparatus Z, when used for carrying out process Y" is also objected to on the grounds of lack of clarity and failure to state the technical features (Rule 43(1)).

No separate examination for the novelty and inventive step of a process claim for producing a product is necessary, provided that:

- all features of the product as defined in the product claim inevitably (see also G-VII, 13) result from the claimed process (see F-IV, 4.5, and T 169/88), and
- the product claim is patentable.

This also applies in the case of a claim for the use of a product, when the product is patentable and is used with its features as claimed (see T 642/94). In all other instances, the patentability of the claim referred to does not necessarily imply the patentability of the independent claim containing the reference. If the process, product and/or use claims have different effective dates (see F-VI, 1 and 2), a separate examination may still be necessary in view of intermediate documents (see also G-VII, 13).

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