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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BERNA EROL and JONATHAN J. HULL

Appeal 2011-001143
Application 11/461,109
Technology Center 2100

Before: ALLEN R. MACDONALD, LINDA E. HORNER, MICHAEL W.
KIM, BARBARA A. BENOIT, and LYNNE E. PETTIGREW,
Administrative Patent Judges.

KIM, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1 and 3-20¹. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART, and enter a NEW GROUND of rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

The claims are directed to techniques for identifying one or more objects from digital media content and comparing them to one or more objects specified by a machine readable identifier (Spec., para. [0001]). Claims 1 and 18, reproduced below, are illustrative of the claimed subject matter:

1. A computer-implemented method performed by a data processing system of processing digital media content, the method executed by a computer and comprising:
 - determining, from a machine readable identifier, a first object descriptor associated with an object, the first object descriptor specifying one or more features of content within the object;
 - determining a set of one or more objects from the digital media content;
 - generating an object descriptor for each object in the set of objects, each object descriptor specifying one or more features of content within an object from the set;

¹ The Appellants and the Examiner agree that claim 2 is cancelled and claims 1 and 3-20 are pending (App. Br. 2; Ans. 3). The Claims Appendix included with the Amendment After Final filed January 22, 2010 lists claims 1 and 3-20, of which claims 1, 18, and 19 are independent. This coincides with the Summary of Claimed Subject Matter in the Appeal Brief, which lists claims 1, 18, and 19 as independent (App. Br. 3-6). However, the Claims Appendix in the Appeal Brief lists claims 1-18 and 20, of which claims 1, 17, and 18 are independent. Accordingly, we will treat that Claims Appendix as being in error, and will refer to the numbering in the Claims Appendix included with the Amendment After Final filed January 22, 2010.

identifying at least one object descriptor from the object descriptors determined for the set of objects that matches the first object descriptor determined from the machine readable identifier; and

performing an action in response to identifying the at least one object descriptor that matches the first object descriptor.

18. A system comprising:

a reader adapted to read a machine readable identifier;

and

a processor adapted to:

determine, from the machine readable identifier, a first object descriptor associated with an object, the first object descriptor specifying one or more features of content within the object;

determine a set of one or more objects from digital media content;

generate an object descriptor for each object in the set of objects, each object descriptor specifying one or more features of content within an object from the set;

identify at least one object descriptor from the object descriptors determined for the set of objects that matches the first object descriptor determined from the machine readable identifier; and

perform an action in response to identifying the at least one object descriptor that matches the first object descriptor.

Claim 20 is rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

Claims 1 and 3-20 are rejected under 35 U.S.C. § 103(a) as unpatentable over King (US 2006/0026140 A1, pub. Feb. 2, 2006).

ISSUES

Did the Examiner err in asserting that “calculating a metric for each object in the set of objects, the metric providing a *measure of similarity* between an object descriptor for an object in the set and the first object descriptor; and comparing the metric for each object against a threshold to determine whether an object descriptor associated with the metric matches the first object descriptor,” as recited in dependent claim 20, fails to comply with the written description requirement?

Did the Examiner err in asserting that King discloses or suggests both a “machine readable identifier” and an “object descriptor” determined from the machine readable identifier, as recited in independent claim 1²?

Did the Examiner err in asserting that King discloses or suggests “calculating a metric for each object in the set of objects, the metric providing a measure of similarity between an object descriptor for an object in the set and the first object descriptor; and comparing the metric for each object against a threshold to determine whether an object descriptor associated with the metric matches the first object descriptor,” as recited in dependent claim 20?

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

² We choose independent claim 1 as representative of claims 1 and 3-17. 37 C.F.R. § 41.37(c)(1)(vii).

Specification

FF1. The Specification discloses that “according to one technique, for each object descriptor in the set of object descriptors generated for objects determined from the media content, a distance metric is calculated for that object descriptor and each object descriptor in the set of object descriptors decoded from a machine readable identifier, where the distance metric between two object descriptors provides a measure of the similarity or matching between the two object descriptors. For any two object descriptors, the distance metric calculated for the pair may then be compared to a preset threshold to determine if the two object descriptors are to be considered as matching” (para. [0037]).

FF2. The Specification discloses that “[a] machine readable identifier 114 encapsulates information related to a set of one or more objects. Machine readable identifiers may be embodied in different forms such as barcodes, information stored in radio frequency identifier (RFID) tags, and the like” (para. [0022]).

FF3. The Specification discloses that “[a]n object descriptor identifies an object by specifying one or more features (or characteristics) of the object. Various different types of objects may be specified, possibly for different media content types. Examples of objects include but are not limited to a document fragment (for a digital document content), an image, a slide, a person (for a photograph), a speech pattern (for audio content), a motion (for video content), etc.” (para. [0024]).

FF4. Non-limiting examples of digital media content in the Specification include an image, audio information, and video information (para. [0004]).

ANALYSIS

Written Description Rejection of Dependent Claim 20

We are persuaded the Examiner erred in asserting that “calculating a metric for each object in the set of objects, the metric providing a *measure of similarity* between an object descriptor for an object in the set and the first object descriptor; and comparing the metric for each object against a threshold to determine whether an object descriptor associated with the metric matches the first object descriptor,” as recited in dependent claim 20, fails to comply with the written description requirement. There is some dispute as to whether this rejection is still pending (Ans. 7, 17; Reply Br. 2-3; page 2 of Advisory Action mailed February 18, 2010). Regardless of the exact status of the rejection, pages 7-8 of Amendment After Final filed January 22, 2010 identifies paragraph [0037] of the Specification as providing written description support for the aforementioned aspect of dependent claim 20. We agree (FF1). *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991) (the test for determining compliance with the written description requirement is “whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the . . . claimed subject matter.’”) Accordingly, insofar as this rejection may still be pending, it is not sustained.

Obviousness Rejection of Independent Claim 1

We are not persuaded the Examiner erred in asserting that King discloses or suggests both a “machine readable identifier” and an “object descriptor” determined from the machine readable identifier, as recited in independent claim 1 (App. Br. 8-13; Reply Br. 3-7). The Examiner asserts that the barcode itself in King corresponds to the recited “machine readable identifier,” while the Universal Product Code (hereinafter “UPC”) associated with the barcode itself corresponds to the recited “object descriptor” (Ans. 21-24; 27-28). In the alternative, the Examiner asserts that the barcode/UPC corresponds to the recited “machine readable identifier,” and the product “Paper Towels/Toilet Paper/Air Freshener” corresponds to the recited “object descriptor” (Ans. 21-24; 27-28). Either construction would meet the definitions of “machine readable identifier” and “object descriptor” set forth in the Specification (FF2, FF3).

Appellants assert that King’s references to a barcode are to identify a document using an identification number, and that an identification number is not “a first object descriptor” because the identification number does not specify “one or more features of content within the object”; it only identifies the document (App. Br. 10; Reply Br. 4-6). However, identity is a feature. Thus, an identification number identifying a document (i.e., object) is specifying “one or more features of content within the object.” For similar reasons, Appellants’ arguments as to why text patterns, fingerprints, facial features, and RFID are machine readable identifiers that do not include object descriptors (App. Br. 11-12) are unpersuasive.

Using text patterns as an example, Appellants assert that King does not disclose or suggest “identifying at least one object descriptor from the

object descriptors determined for the set of objects that matches the first object descriptor determined from the machine readable identifier,” as recited in independent claim 1 (App. Br. 12). Specifically, Appellants assert that simply searching the Internet for a matching text pattern is not the same as matching a specific text pattern from a discrete set of text patterns.

However, independent claim 1 recites “determining a set of one or more objects from the digital media content,” without providing any definition as to the limits of digital media content (FF4). Accordingly, under a broadest reasonable construction, searching for a specific text pattern in a “set” of text patterns may include searching among all text patterns on the Internet.

Also using text patterns as an example, Appellants assert that “[t]he Examiner also does not explain how the text is a “first object descriptor **determined from the machine readable identifier**” (App. Br. 12-13; emphasis original; Reply Br. 6-7). However, the text itself is the machine readable identifier, and the text pattern is the object descriptor. Again, the definitions of machine readable identifier and object descriptor are extremely broad (FF2, FF3).

We sustain the rejection of independent claim 1. As Appellants provide the same arguments concerning independent claim 19, we will also sustain its rejection.

Obviousness Rejection of Dependent Claim 20

We are not persuaded the Examiner erred in asserting that King discloses or suggests “calculating a metric for each object in the set of objects, the metric providing a measure of similarity between an object descriptor for an object in the set and the first object descriptor; and

comparing the metric for each object against a threshold to determine whether an object descriptor associated with the metric matches the first object descriptor,” as recited in dependent claim 20 (App. Br. 14; Reply Br. 7-8). We agree with the Examiner that “the MATCHING of King suggests a measure of similarity. There has to be a metric to match. There has to be a measure of similarity to perform matching. Thus, King does in fact teach ‘calculating a metric of similarity between the scanned text and the matching text obtained through a search engine’” (Ans. 29). In a simplest form, the metric for matching would be “exact” with the threshold for matching also being “exact.”

NEW GROUNDS OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we newly reject independent claim 18 under 35 U.S.C. § 112, second paragraph, for indefiniteness. Specifically, we construe processor in “a processor adapted to” as a nonce word invoking § 112, sixth paragraph, and find that the Specification does not disclose sufficient structure, in the form of a general purpose processor and an algorithm, corresponding to “perform an action in response to identifying the at least one object descriptor that matches the first object descriptor,” as required by *Aristocrat Techs. Australia Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008).

FINDINGS OF FACT

Specification

FF5. The Specification discloses that “[p]rocessor 102 may communicate with the other subsystems using one or more buses. The various subsystems depicted in Fig. 1A may be implemented in software, or hardware, or combinations thereof” (para. [0019]).

FF6. Memory subsystem 104 may be configured to store the basic programming and data constructs that provide the functionality of system 100. For example, software code modules or instructions 112 that provide the functionality of system 100 may be stored in memory 104. These software modules or instructions may be executed by processor 102 (para. [0020]).

FF7. Processing for decoding and extracting the information from a machine readable identifier may be performed by processor 102 (para. [0023]).

FF8. Various different types of actions may be initiated or performed in response to identifying the at least one object descriptor that matches the first object descriptor. Examples of actions include annotating the media content, performing an action using the media content, updating a database, sending a message, invoking a URL, or other like actions. Metadata information, if any, associated with the matching object descriptor in information 116 decoded from machine readable identifier 114 may be used as part of the action (paras. [0006]-[0008], [0026], [0040]-[0041], [0068], [0070], [0079], [0081]).

PRINCIPLES OF LAW

Analysis of Whether Computer-Implemented

Claim Limitations Invoke 35 U.S.C. § 112, Sixth paragraph

Special rules of claim construction allow for claim limitations drafted in functional language and are set forth in 35 U.S.C. § 112, sixth paragraph, which provides for:

[a]n element in a claim for a combination may be expressed as a means or step for performing a specified function *without the recital of structure, material, or acts in support thereof*, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. § 112, sixth paragraph (emphasis added). While this provision permits a claim limitation to be set forth using solely functional language, it operates to restrict such claim limitations to those structures, materials, or acts disclosed in the specification (or their equivalents) that perform the claimed function. *Personalized Media Communications, LLC v. Int'l Trade Comm'n*, 161 F.3d 696, 703 (Fed. Cir. 1998)

The Federal Circuit has established that use of the term “means” is central to the analysis of whether a claim limitation should be interpreted in accordance with 35 U.S.C. § 112, sixth paragraph: use of the word “means” creates a rebuttable presumption that the inventor intended to invoke § 112, sixth paragraph, whereas failure to use the word “means” creates a rebuttable presumption that the inventor did not intend the claims to be governed by § 112, sixth paragraph. *Id.* at 703-04; *Flo Healthcare Solutions, LLC v. Kappos*, 697 F.3d 1367 (Fed. Cir. 2012).

When an inventor has not signaled an intent to invoke § 112, sixth paragraph by using the term “means,” the presumption against its invocation is strong but can be overcome if “the claim term fails to recite sufficiently definite structure or else recites function without reciting sufficient structure for performing that function.” *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1358 (Fed. Cir. 2004) (quoting *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1369 (Fed. Cir. 2002) (internal quotation marks and citation omitted)). A claim limitation that “essentially is devoid of anything that can be construed as structure” can overcome the presumption. *Flo Healthcare*, 697 F.3d at 1374. The presumption may be overcome by a claim limitation that uses a non-structural term that is “simply a nonce word or a verbal construct that is not recognized as the name of structure” but is merely a substitute for the term ‘means for’ associated with functional language. *Lighting World*, 382 F.3d at 1360. Claim language that further defines a term that otherwise would be a nonce word can denote sufficient structure to avoid a § 112, sixth paragraph construction, *MIT v. Abacus Software*, 462 F.3d 1344, 1354 (Fed. Cir. 2006), as can a claim limitation that contains a term that “is used in common parlance or by persons of skill in the pertinent art to designate structure.” *Lighting World*, 382 F.3d at 1359. Nor will claim language invoke a § 112, sixth paragraph construction if persons of ordinary skill in the art reading the specification understand the term to be the name for a structure that performs the function, even when the term covers a broad class of structures or identifies the structures by their function. *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583 (Fed. Cir. 1996) (“Many devices take their names from the functions they perform.”).

*Indefiniteness Analysis for Computer-Implemented
Claim Limitations Interpreted Under
35 U.S.C. § 112, Sixth Paragraph*

The structure corresponding to a 35 U.S.C. § 112, sixth paragraph, claim limitation for a computer-implemented function must include the algorithm needed to transform the general purpose computer or processor disclosed in the specification into the special purpose computer programmed to perform the disclosed algorithm. *Aristocrat*, 521 F.3d at 1333. Thus, the specification must sufficiently disclose an algorithm to transform the general purpose computer or processor to a special purpose processor programmed to perform the disclosed algorithm. *Id.* at 1338. An algorithm is defined, for example, as “a finite sequence of steps for solving a logical or mathematical problem or performing a task.” Microsoft Computer Dictionary, Microsoft Press (5th ed. 2002). Applicant may express the algorithm in any understandable terms including as a mathematical formula, in prose, in a flow chart, or “in any other manner that provides sufficient structure.” *Finisar Corp. v. DirectTV Group, Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008).

A rejection under § 112, second paragraph, is appropriate if the specification discloses no corresponding algorithm associated with a computer or processor. *Aristocrat*, 521 F.3d at 1337-38. Mere reference to a general purpose computer or processor with appropriate programming without providing an explanation of the appropriate programming, or to “software” without providing detail about the means to accomplish the software function, is not an adequate disclosure. *Id.* at 1334; *Finisar*, 523 F.3d at 1340-41. In addition, simply reciting the claimed function in the

specification, while saying nothing about how the computer or processor ensures that those functions are performed, is not a sufficient disclosure for an algorithm which, by definition, must contain a sequence of steps.

Blackboard, Inc. v. Desire2Learn, Inc., 574 F.3d 1371, 1384 (Fed. Cir. 2009).

If the specification explicitly discloses an algorithm, the sufficiency of the disclosure must be determined in light of the level of ordinary skill in the art. *Aristocrat*, 521 F.3d at 1337. The specification must sufficiently disclose an algorithm to transform a general purpose processor to a special purpose processor so that a person of ordinary skill in the art can implement the disclosed algorithm to achieve the claimed function. *Id.* at 1338.

ANALYSIS

Section 112, sixth paragraph

The issue is whether the term “a processor adapted to” as used in claim 18 is a verbal construct devoid of structure that is used as a substitute for the term “means for” and so invokes the application of § 112, sixth paragraph. Claim 18 recites a system comprising a reader and “a processor adapted to” perform several steps, including “perform an action in response to identifying [] at least one object descriptor that matches the first object descriptor.” As such, failure to recite the word “means” creates the strong presumption that the inventor did not intend the limitation “a processor adapted to” to be governed by § 112, sixth paragraph. To see whether the presumption is overcome, we look to how a skilled artisan would understand “processor,” whether the limitation recites sufficient structure, material, or

acts for achieving the recited functions, and whether the term “processor” is modified by functional language.

We begin with a dictionary definition of a “processor,” which would be recognized, by a skilled artisan in computer programming, as a computer, a central processing unit, or a program that translates another program into a form acceptable by the computer being used.³ *See Lighting World*, 382 F.3d at 1360-61 (consulting dictionaries to determine whether a claim term has a generally understood meaning that denotes structure). This comports well with references to “processor” in the Specification, which in the aggregate, amounts to “software, or hardware, or combinations thereof” that execute “software modules or instructions” (FF5-FF7). *CCS Fitness*, , 288 F.3d at 1366 (claim terms are properly construed to include limitations not otherwise inherent in the term when the Specification “clearly set[s] forth a definition of the disputed claim term”). Given this dictionary definition and complementary examples in the Specification, we find that the “processor” recited in claim 18 is a non-structural term that would not be recognized by a skilled artisan as the name of a sufficiently definite structure for implementing the “perform” function recited above. As such, the term “processor” at least initially appears to be merely a substitute for the term “means for” associated with recited functional language.

To confirm whether the presumption against such a substitution is overcome, we look to determine whether the functions performed by the processor are typical functions found in a commercially, available off-the-shelf processor, which would weigh against invoking § 112, sixth paragraph.

³ American Heritage Dictionary of the English Language 1398 (4th ed. 2006) (defining processor).

See In re Katz Interactive Call Processing Patent Litigation, 639 F.3d 1303, 1316 (Fed. Cir. 2011) (functions such as “processing,” “receiving,” and “storing” that can be achieved by any general purpose computer without special programming do not require disclosure of more structure than the general purpose processor that performs those functions). If the functions performed by the processor are not typical functions found in a processor, we look to see whether the claim recites sufficient, structure, material, or acts for achieving the specified function. If so, § 112, sixth paragraph should not be applied. Also weighing against invoking § 112, sixth paragraph would be when the term processor includes a structural modifier, such as a “height-adjustment” processor. To that end, we find that none of the above factors apply to the “processor” recited in claim 18. A commercially, available off-the-shelf processor would not be able to “perform an action in response to identifying the at least one object descriptor that matches the first object descriptor,” as recited in claim 18. Other than the functional language itself, claim 18 does not recite sufficient structure, material, or acts for achieving the specified function. In particular, the aforementioned limitation only recites that an action is performed “in response to identifying the at least one object descriptor that matches the first object descriptor,” and thus is merely a condition that is not structure, material, or even an act. And finally, the term “processor” in claim 18 does not include any structural modifiers.

Unlike a recited circuit coupled with a description of the circuit’s operation in the claims, which has been found to connote sufficient structure to avoid application of § 112, sixth paragraph, here the recited processor and claim language does not recite anything to describe the “perform” operation.

Accord MIT v. Abacus Software, 462 F.3d at 1354-56; *Linear Tech. Corp. v. Impala Linear Corp.*, 379 F.3d 1311, 1320–21 (Fed. Cir. 2004); *Apex Inc. v. Raritan Comp., Inc.*, 325 F.3d 1364, 1374 (Fed. Cir. 2003).

Unlike the claims in *Inventio AG v. ThyssenKrupp Elevator Americas Corp.*, 649 F.3d 1350, 1359-60 (Fed. Cir. 2011), in which the claimed “computing unit” that was held to connote sufficiently definite structure was claimed to be connected to a modernizing device and to generate a destination signal for transmission to the modernizing device and was further claimed to be connected to floor terminals of the elevator system and evaluate incoming call reports, destination floors, and identification codes to generate the destination signal for processing by the modernizing device, the claim here nakedly recites “a processor” without a modifier, the claim does not recite structure other than being connected to a reader, which is not sufficient for performing the recited function, and the claim does not recite, and the written description does not delineate, the internal components of the processor or in another way convey structure to skilled artisans to support a conclusion that process is not a purely functional limitation (FF5-FF7).

And unlike a claimed control unit that further recited “a CPU and a partitioned memory system” to provide sufficient structure to perform the recited “controlling the communication unit” function and so avoid invoking § 112, sixth paragraph, *see LG Elecs., Inc. v. Bizcom Elecs., Inc.*, 453 F.3d 1364, 1372 (Fed. Cir. 2006), *rev'd on other grounds*, *Quanta Computer, Inc. v. LG Elecs., Inc.*, 553 U.S. 617 (2008), here the “perform” function is not a function that can be executed solely by a general-purpose processor and a reader.

As such, we conclude that the term “processor” is a non-structural term that would not be understood by a skilled artisan as having sufficiently definite structure to perform the recited functions and, therefore, is used as a substitute for the term “means for” and so invokes the application of § 112, sixth paragraph.

Section 112, second paragraph

Given that “a processor adapted to” recited in independent claim 18 invokes § 112, sixth paragraph, the structure in the Specification corresponding to a 35 U.S.C. § 112, sixth paragraph, claim limitation for a processor-implemented function must include an algorithm, for performing the recited function, that transforms the general purpose processor to a special purpose processor programmed to perform the disclosed algorithm. *Aristocrat*, 521 F.3d at 1333, 1338. The Specification must disclose an algorithm that addresses each functional limitation. *Default Proof Credit Card Sys., Inc. v. Home Depot U.S.C., Inc.*, 412 F.3d 1291, 1298 (Fed. Cir. 2005) (“[w]hile corresponding structure need not include all things necessary to enable the claimed invention to work, it must include all structure that actually performs the recited function.” (citing *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1119 (Fed. Cir. 2002))). Accordingly, the Specification must disclose a sufficient algorithm for all recited functional claim limitations, including “perform an action in response to identifying the at least one object descriptor that matches the first object descriptor,” as recited in independent claim 18.

The only portions of the Specification that disclose any details related to “perform an action in response to identifying the at least one object

descriptor that matches the first object descriptor” relates to prose describing certain exemplary actions that may be performed in response to identifying a match (FF8). However, these myriad of examples are, in effect, an impermissible attempt to claim every way to “perform an action” under the sun, and do not constitute a sequence of steps of a particular algorithm required to meet the definiteness requirements of § 112, second paragraph. *ePlus, Inc. v. Lawson Software, Inc.*, 700 F.3d 509, 519 (Fed. Cir. 2012) (“[t]here is no instruction for using a particular piece of hardware, employing a specific source code, or following a particular algorithm. There is therefore nothing in the specification to help cabin the scope of the functional language in the means for processing element: The patentee has in effect claimed everything that generates purchase orders under the sun. The system claims are therefore indefinite.”); *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1384 (Fed. Cir. 2009); *Finistar*, 523 F.3d at 1385 (quoting *In re Freeman*, 573 F.2d 1237, 1245–46 (CCPA 1978)) (“[e]ven described ‘in prose,’ an algorithm is still ‘a step-by-step procedure for accomplishing a given result’”).

Accordingly, we find that independent claim 18 is indefinite because the Specification fails to disclose corresponding structure for the means-plus-function limitation “a processor adapted to . . . perform an action in response to identifying the at least one object descriptor that matches the first object descriptor”.

Obviousness Rejection of Independent Claim 18

For the reasons discussed above, independent claim 18 is indefinite. Therefore, we reverse, *pro forma*, the Examiner's § 103(a) rejection of independent claim 18 because it was necessarily based on speculation and assumptions as to the scope of the claims. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). Specifically, as there is no algorithm disclosed in the Specification corresponding to "perform[ing] an action in response to identifying [] at least one object descriptor that matches the first object descriptor," as recited in independent claim 18, there is no way to determine whether any prior art discloses the same or equivalent structures to the structure encompassed by claim 18 . Of course, if these claims were not construed under § 112, sixth paragraph, and therefore were not indefinite under § 112, second paragraph, we would sustain the Examiner's § 103(a) rejection of independent claim 18, which contains similar limitations to independent claim 1, for which Appellant has not made separate, detailed arguments.

DECISION

The Examiner's rejection of claim 20 under 35 U.S.C. § 112, first paragraph is REVERSED.

The Examiner's rejection of claims 1, 3-17, 19, and 20 under 35 U.S.C. § 103(a) is AFFIRMED.

The Examiner's rejection of claim 18 under 35 U.S.C. § 103(a) is REVERSED *pro forma*.

We newly reject claim 18 under 35 U.S.C. § 112, second paragraph, for indefiniteness.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner....

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record....

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board." Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Patent Trial and Appeal Board for final action on the affirmed rejection, including any timely request for rehearing thereof.

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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-IN-PART; 37 C.F.R. § 41.50(b)

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