



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/949,568	09/24/2004	Harri Lakkala	P1777US00	3228
11764	7590	03/13/2013	EXAMINER	
Ditthavong Mori & Steiner, P.C. 44 Canal Center Plaza Suite 322 Alexandria, VA 22314			CHEEMA, UMAR	
			ART UNIT	PAPER NUMBER
			2444	
			NOTIFICATION DATE	DELIVERY MODE
			03/13/2013	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@dcpatent.com
ipadmin@dcpatent.com



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HARRI LAKKALA, RIKU SUOMELA,
and ILKKA SALMINEN

Appeal 2011-001526
Application 10/949,568
Technology Center 2400

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

PETTIGREW, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1, 2, 4-9, 11-16, 18-28, 30-35, 37-42, 44-52, 79, 80, and 82-85. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part. We also enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

Appellants' Invention

Appellants' invention is directed to an apparatus and method for creating, storing, and using personal information relating to a real-world, earth-shaking event ("ESE") event. Spec. 1. Claims 1 and 27 are illustrative of the invention (formatting added):

1. A method, comprising:
 - [(a)] receiving a message of an event at a user device;
 - [(b)] creating at the user device metadata relating to the event in response to the received message of the event and storing the created metadata in a memory at the device;
 - [(c)] collecting content data in response to receiving the message of the event to generate a content data set relating to the message of the event; and
 - [(d)] adding the created metadata to the content data set.

27. A user device, comprising:
 - [(a)] a memory device for storing a program; and
 - [(b)] a processor in communication with the memory device, the processor is configured with the program to:
 - [(i)] control receiving a message of an event at the user device;
 - [(ii)] control at the user device creation of metadata relating to the event in response to the received

message of the event and control storing the created metadata in the memory device;

[(iii)] control collection of content data in response to the received message of the event to generate a content data set relating to the message of the event; and

[(iv)] control adding of the created metadata to the content data set.

Rejection on Appeal

The Examiner relied upon the following prior art in rejecting the claims on appeal:

Keyes	US 6,516,427 B1	Feb. 4, 2003
Pather	US 7,177,859 B2	Feb. 13, 2007
Kovacs	EP 1 296 253 A1	Mar. 26, 2003

The Examiner rejected claims 1, 2, 4-9, 11-16, 18-28, 30-35, 37-42, 44-52, 79, 80, and 82-85 under 35 U.S.C. § 103(a) as being unpatentable over Pather, Keyes, and Kovacs.

ISSUE ON APPEAL

Did the Examiner err in rejecting claims 1, 2, 4-9, 11-16, 18-28, 30-35, 37-42, 44-52, 79, 80, and 82-85 under 35 U.S.C. § 103(a) because the combination of Pather, Keyes, and Kovacs fails to disclose or suggest creating at the user device metadata relating to the event in response to the received message of the event and collecting content data in response to the received message of the event?

NEW GROUND OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection for claims 27, 28, 30-35, 37-42, 44-52, and 80 under 35 U.S.C. § 112, second paragraph, for indefiniteness. Specifically, we construe “a processor . . . configured . . . to” perform various control functions, as recited in independent claim 27, as a “means-plus-function” limitation subject to 35 U.S.C. § 112, sixth paragraph, and conclude that the Specification’s failure to disclose an algorithm corresponding to the recited functions renders the claim indefinite under 35 U.S.C. § 112, second paragraph.

FINDINGS OF FACT

Appellants’ Invention

1. The Specification discloses that the present invention may be implemented in user device 100a, which may be a wireless or wired device that has been enabled to communicate over a network. Examples include a hand-held wireless telephone, a personal digital assistant, a laptop or personal computer, a set-top box, a digital camera or camcorder, a digital audio device, a television, a digital radio device, a digital video recorder, a wrist watch, and a global positioning system receiver. Spec. 3-4; Fig. 1.

2. The Specification states that user device 100a may receive notice of a real-world, earth-shaking event (“ESE”) from an event provider 120. Spec. 4, 8; Fig. 3 (step 302).

3. The Specification discloses that once notice of an event has been received, user device 100a may create an ESE data set in response to a notification of the event. Spec. 5, 9; Fig. 3 (steps 306, 308). This may

involve collecting content, e.g., “the user manually creating video, image, audio or text data using device 100a,” or “device 100a automatically sending context information using sensors that are either integral or peripheral to the device.” Spec. 5; *see also* Spec. 14; Fig. 3 (step 322).

4. The Specification discloses that user device 100a creates metadata for use in storing and retrieving an ESE data set. Spec. 14; Fig. 3 (step 320). “The metadata may be based on the name, description, time and date information, location information and/or the like.” Spec. 14.

5. The Specification discloses that the “metadata is added to the collected content by way of, e.g., embedding it within the content, storing it with the content or otherwise associating it with the content.” Spec. 14; Fig. 3 (step 324).

6. The Specification discloses that “[u]ser device 100a may also include a CPU 200 and associated memory 205 containing programming for controlling, in accordance with the present invention, data processing and transfer operations among the various elements of device 100a via a data transfer bus 250.” Spec. 6.

Dictionary Definitions

7. AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 1398 (4th ed. 2006) (defining “processor” as “2. *Computer Science* **a.** A computer. **b.** A central processing unit. **c.** A program that translates another program into a form acceptable by the computer being used.”).

8. MICROSOFT COMPUTER DICTIONARY 92 (5th ed. 2002) (defining “central processing unit” as “CPU”); *id.* at 132 (defining “central processing unit” as “[a]cronym for **central processing unit**. The computational and control unit of a computer. The CPU is the device that interprets and

executes instructions . . . By definition, the CPU is the chip that functions as the ‘brain’ of a computer. In some instances, however, the term encompasses both the processor and the computer’s memory or, even more broadly, the main computer console (as opposed to peripheral equipment).”).

PRINCIPLES OF LAW

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 Comm’ns, 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, 1373 (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 construction under § 112, sixth paragraph, *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*

A claim limitation interpreted in accordance with 35 U.S.C. § 112, sixth paragraph, is construed to cover the corresponding structures, materials, or acts disclosed in the specification (and their equivalents) that perform the claimed function. *Personalized Media*, 161 F.3d at 703. For a computer-implemented claim limitation interpreted under § 112, sixth paragraph, the corresponding structure 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 Techs. Australia Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008). 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 23 (5th ed. 2002). An 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. DirecTV Group, Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008).

An indefiniteness 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

Claim Construction – Claim 27

Claim 27 recites a user device comprising (a) a memory device for storing a program and (b) a processor in communication with the memory device and configured with the program to (i) “control receiving a message of an event at the user device,” (ii) “control at the user device creation of metadata relating to the event in response to the received message of the event and control storing of the created metadata in the memory device,”

(iii) “control collection of content data in response to the received message of the event to generate a content data set relating to the message of the event,” and (iv) “control adding of the created metadata to the content data set.” The “processor” limitation is set forth using functional language, raising the issue whether the limitation should be treated as a “means-plus-function” limitation under 35 U.S.C. § 112, sixth paragraph. The absence of the word “means” creates the strong rebuttable presumption that the inventors did not intend the “processor” limitation to be governed by § 112, sixth paragraph. *See Flo Healthcare*, 697 F.3d at 1373. To determine whether the presumption is overcome, we must decide whether the term “processor” as used in claim 27 is one that connotes structure, or is instead a verbal construct devoid of structure that is used as a substitute for the term “means for.” *See Lighting World*, 382 F.3d at 1360.

First, we consider how a skilled artisan would understand the term “processor” as used in claim 27. Based on our review of dictionary definitions, we conclude that a skilled artisan would not recognize “processor” as the name of a sufficiently definite structure for performing the control functions recited by the “processor” limitation. Rather, a person skilled in the art of computer programming would recognize the term “processor” to mean a general purpose computer, a central processing unit (“CPU”), or a program that translates another program into a form acceptable by the computer being used. FF7, FF8; *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 interpretation is consistent with Appellants’ Specification, which refers only to a CPU, without providing a definition of “processor” or any additional

description sufficient to inform a skilled artisan that the term connotes a sufficiently definite structure. FF6; *see Lighting World*, 382 F.3d at 1361 (consulting specification to determine whether a claim term denotes structure).

We also consider whether the control functions performed by the processor in claim 27 are functions typically found in a commercially available off-the-shelf processor. If a general purpose processor would be capable of performing the claimed functions, then a skilled artisan might understand the claim term “processor” to provide sufficient structure for performing those functions. *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). In this case, however, we conclude that at least two of the functions performed by the processor in claim 27—controlling the collection of content data and controlling the creation of metadata—are not typical functions found in a general purpose processor and would require additional programming of the processor to implement. Therefore, unlike the claimed “control unit” comprising “a CPU and a partitioned memory system” that was held to provide sufficient structure to perform the claimed function of “controlling the communication unit,” *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 claimed control functions cannot be executed by a general purpose processor without

additional programming. Accordingly, the claimed “processor” alone is not sufficient structure to perform the functions in claim 27.

The term “processor” also appears in claim 27 by itself without a structural modifier, which is further evidence that the term is a nonce word that is not recognized as the name of structure. *See Flo Healthcare*, 697 F.3d at 1374 (holding that “the generic term ‘mechanism’ standing alone may connote no more structure than the term ‘means,’” but the term “height adjustment mechanism” designates a class of generally-understood structures). Nor does claim 27 include any structure connected to the processor that would indicate the processor itself is a sufficiently definite structure. Claim 27 is 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. In contrast, claim 27 does not recite any structure connected to the “processor” other than a memory device, which is not sufficient for performing the control recited functions. Nor does claim 27 recite the specific steps that the processor undertakes to perform the recited control functions.

The term “processor” in claim 27 is also different from the claim terms “circuit” and “circuitry,” which have been held to denote sufficiently definite structure to avoid the application of § 112, sixth paragraph. *See*

MIT, 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). The term “circuit” coupled with a description in the claims of the circuit’s operation typically conveys the structural arrangement of the circuit’s components. *See MIT*, 462 F.3d at 1355; *Linear Tech.*, 379 F.3d at 1320; *Apex*, 325 F.3d at 1373. In contrast, the recited processor and claim language here do not convey to a person skilled in the art anything about the internal components, structure, or specific operation of the processor.

For these reasons, we conclude that the term “processor” as used in claim 27 is a non-structural term that would not be understood by a skilled artisan as having sufficiently definite structure to perform the recited control functions. The term is used as merely a substitute for the term “means for” associated with recited functional language and thus invokes the application of § 112, sixth paragraph. We also conclude that dependent claims 28, 30-35, 37-42, 44-52, and 80 contain no additional language connoting structure sufficient to perform the recited functions, nor do they recite specific steps that the processor undertakes to perform the recited functions. These claims, therefore, are also interpreted under § 112, sixth paragraph.

*New Ground of Rejection under 35 U.S.C. § 112,
Second Paragraph – Claim 27*

Having concluded that the “processor” limitation in claim 27 invokes the application of § 112, sixth paragraph, we now consider whether Appellants’ Specification discloses sufficient corresponding structure for performing the claimed control functions. *See Aristocrat*, 521 F.3d at 1333. Because the limitations of claim 27 are computer-implemented and cannot

all be performed by a general purpose computer without any special programming, we must determine whether the Specification discloses an algorithm that transforms a general purpose processor into a special purpose processor that performs the claimed functions. *Id.*; *cf. Katz*, 639 F.3d at 1316.

The only portion of the Specification that describes the processor and its associated functions provides that the user device may include a CPU and a memory “containing programming for controlling, in accordance with the present invention, data processing and transfer operations among the various elements” of the user device. FF6. That description is merely a general statement that fails to mention the specific control functions recited in claim 27, much less provide any detailed steps as to how the processor would perform functions such as controlling creation of metadata and controlling collection of content data.

The Specification does contain a flow chart illustrating a process by which content data and metadata are created, stored, and used. FF2-FF5 (citing Fig. 3). However, the flow chart presents the process at a high level without reference to the control functions to be performed by the processor. Even if the steps shown in the flow chart could somehow be understood as corresponding to the functions ascribed to the claimed processor, the flow chart and accompanying description in the Specification would simply be restating the claimed functions without conveying to a skilled artisan how the processor ensures that the functions are performed. As such, the Specification fails to disclose an algorithm that transforms the general purpose processor into a special purpose processor programmed to perform

the control functions recited in claim 27. *See Blackboard*, 574 F.3d at 1384; *Aristocrat*, 521 F.3d at 1334.

Because Appellants' Specification fails to disclose an algorithm for performing the functions recited in the "processor" limitation of claim 27, it fails to describe sufficient corresponding structure as required for a limitation interpreted under 35 U.S.C. § 112, sixth paragraph. Accordingly, we enter a new ground of rejection of claim 27 as being unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 28, 30-35, 37-42, 44-52, and 80 depend from claim 27 and therefore are also indefinite under 35 U.S.C. § 112, second paragraph. As such, we also enter a new ground of rejection of claims 28, 30-35, 37-42, 44-52, and 80 on this same basis.

Rejection under 35 U.S.C. § 103(a) – Claim 1

In rejecting independent claim 1 under 35 U.S.C. § 103(a), the Examiner finds that Pather substantially discloses the claimed invention, including receiving a message of an event at a user device, collecting content data and creating metadata relating to the event, and adding the metadata to the collected content data. Ans. 4, 10-11; Pather, col. 2, ll. 53-64; col. 7, l. 55 – col. 8, l. 30; col. 21, ll. 24-31; col. 23, ll.3-15. The Examiner finds, however, that Pather does not teach that (i) metadata relating to the event is created *at the user device and in response to the received message of the event*, and (ii) content data is collected *in response to receiving the message of the event*. Ans. 4-6. The Examiner relies on Keyes and Kovacs for these features and concludes that the claimed invention would have been obvious over the combination of Pather, Keyes, and Kovacs. Ans. 5-6, 11-12.

Appellants contend that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a) because the combination of references does not teach “collecting content data *in response to receiving the message of the event*” or “creating *at the user device* metadata relating to the event *in response to the received message of the event*,” as recited in claim 1. App. Br. 4-10. Appellants specifically challenge some of the Examiner’s findings regarding Kovacs and Keyes and further contend that the Examiner does not provide a rational basis for combining Pather and Keyes.

We have reviewed the Examiner’s § 103(a) rejection in light of Appellants’ arguments that the Examiner has erred. We disagree with Appellants’ conclusions.

First, Appellants argue that Kovacs teaches content data collection that occurs *automatically*, not *in response to receiving a message of an event*, as recited in claim 1. App. Br. 7. We disagree. Kovacs discloses a recording device, such as a digital camera or camcorder, that collects electronic content (i.e., a recording) and includes a module for gathering context information from which metadata relating to the recording can be created. Kovacs, ¶¶ [0011], [0024], [0032]. Metadata is then stored with the recording (i.e., the collected content data). Kovacs, ¶¶ [0011], [0032]. Appellants rely on the following statement in Kovacs: “[w]henever a recording device records electronic content, the context gathering module **automatically** gathers the current context of the recording device” App. Br. 7 (quoting Kovacs, ¶ [0032]) (emphasis added by Appellant). While this sentence describes the automatic nature of *context-gathering* in Kovacs, it does not teach that *content data* is collected automatically, as Appellants assert. Instead, as set forth in claim 1, the recording device in

Kovacs starts collecting content data (i.e., begins a recording) in response to a received message of an event (e.g., a signal from the User Control Unit to start a recording). *See* Kovacs, ¶ [0041].

Appellants further argue that Kovacs does not teach creating metadata *in response to a received message of an event*, as recited in claim 1. App. Br. 7. A careful review of the Examiner's rejection, however, shows that the Examiner does not rely on Kovacs for such a teaching but rather relies on Keyes. Ans. 5, 11-12. Therefore, Appellants' arguments with respect to Kovacs do not show error in the Examiner's rejection.

Next, Appellants allege error in the Examiner's findings regarding Keyes. Keyes discloses a peripheral device that sends a message to a remote diagnostic device in the event of a malfunction. Keyes, col. 4, ll. 29-36; Fig. 2A. The remote diagnostic device sends a response message to the peripheral device that causes a diagnostic application on the peripheral device to execute a particular diagnostic subroutine, producing results that can be sent to the remote diagnostic device. Keyes, col. 4, ll. 42-57; Fig. 2B.

Appellants state that the Examiner appears to be equating the response message of Keyes to the metadata relating to the event that is created at the user device in claim 1. App. Br. 8. Based on this understanding, Appellants contend that Keyes's response message, consisting of instructions to execute a diagnostic subroutine resident on the peripheral device or executable code for diagnosing the cause of a peripheral device malfunction, cannot be reasonably interpreted as metadata relating to the event, nor is it created at the peripheral device. *Id.*

Based on our review of Keyes and the Examiner's Answer, we understand the Examiner to be equating the response message received at the

peripheral device in *Keyes* to the *message of the event* received at the user device in Appellants' claim 1, rather than the metadata created at the user device. Ans. 5. Receipt of the response message in *Keyes* causes the peripheral device to execute a diagnostic subroutine that produces results relating to the device malfunction, just as receipt of the event message in claim 1 causes the user device to create metadata relating to the event. *See Keyes*, col. 4, ll. 42-57; Fig. 2B. Thus, Appellants' argument, which is based on a misunderstanding of the Examiner's rejection, does not demonstrate that the Examiner erred in relying on *Keyes*.

Finally, Appellants contend that "the Examiner did not provide any basis to establish that the skilled artisan would have been realistically led by anything in [Pather] or [Keyes] to modify the subscription-based notification system of [Pather] to include any teaching of a system for remote diagnosis of peripheral device malfunctions disclosed in [Keyes]." App. Br. 9. The Examiner, however, cites *Keyes* for the general concept that data creation at a user device may be triggered by receipt of an event message, rather than for *Keyes*'s specific teachings relating to remote diagnosis of peripheral device malfunctions. Ans. 5. Appellants have not presented any persuasive arguments or evidence that a person of ordinary skill in the art would not have had the knowledge and skills rendering him capable of combining the features of *Keyes* and *Pather* to have metadata creation triggered by an event message and performed at the user device rather than at a central location. *See DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006).

For the foregoing reasons, we sustain the Examiner's § 103(a) rejection of claim 1, as well as the rejection of dependent claims 2, 4-9, 11-

16, 18-26, and 79, for which Appellants have not made separate, detailed arguments. We also sustain the Examiner's § 103(a) rejection of claim 82, which contains similar limitations, as well as dependent claims 83-85, for which Appellants have not made separate, detailed arguments.

For the reasons discussed in the previous section, claims 27, 28, 30-35, 37-42, 44-52, and 80 are indefinite. Therefore, we reverse, *pro forma*, the Examiner's § 103(a) rejection of these claims 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 the functions recited in independent claim 27, there is no way to determine whether any prior art discloses the same or equivalent structure to the structure encompassed by claim 27. 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 claim 27, which contains similar limitations to claim 1, as well as the rejection of dependent claims 28, 30-35, 37-42, 44-52, and 80, for which Appellants have not made separate, detailed arguments.

DECISION

The Examiner's decision to reject claims 1, 2, 4-9, 11-16, 18-26, 79, and 82-85 under 35 U.S.C. § 103(a) is affirmed. The Examiner's decision to reject claims 27, 28, 30-35, 37-42, 44-52, and 80 under 35 U.S.C. § 103(a) is reversed *pro forma*.

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection for claims 27, 28, 30-35, 37-42, 44-52, and 80 under 35 U.S.C. § 112, second paragraph.

Section 41.50(b) provides that “[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 the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground 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

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 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, the 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.

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).

Appeal 2011-001526
Application 10/949,568

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

msc