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51414 
GOODWIN PROCTER LLP
PATENT ADMINISTRATOR
100 Northern Avenue
BOSTON, MA 02210

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GLENN.WILLIAMS@GOODWINPROCTER.COM
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAULO ALEXANDRE GRILO ROSADO, CARLOS MANUEL GREGORIO ALVES, GONCALO BRUNO ALBERTO DA VEIGA, PAULO JOSE FERRO TAVARES, LUCIO EMANUEL REPRESAS FERRAO, NUNO FILIPE CAMPANTE CARVALHO DE FERREIRA TELES, and RODRIGO LEAL DE FARIA DE SOUSA COUTINHO

Appeal 2015-002465
Application 12/143,423
Technology Center 2100


MacDONALD, Administrative Patent Judge.

DECISION ON APPEAL
STATEMENT OF THE CASE


Exemplary Claims

Exemplary claims 1, 2, and 7 under appeal read as follows (emphasis and formatting added):

1. A system for enabling submission of user feedback, the system comprising:
   
an extension to an application that is configured for execution on a computing system,
   
   the extension for operation with the application and configured for invocation during execution of the application by a user selection of the extension in order to submit user feedback on a feature of the application substantially contemporaneously with a presentation of the feature to the user during execution of the application,
   
   the user feedback being directed towards improving the feature of the application, and

   the extension operable to visually identify a location of the feature on a user’s screen and to display on the user’s screen textual input, received from the user providing the user feedback, concerning the feature.

2. The system of claim 1, wherein the extension is further configured to capture contents of the user’s screen at the time the user feedback is submitted.

7. The system of claim 4, wherein the application tool is further configured to reply to the user feedback.
Rejections on Appeal


2. The Examiner rejected claims 8, 9, 24, and 25 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Berg and Ramamurthy et al. (US 2006/0184410 A1; publ. Aug. 17, 2006).²

3. The Examiner rejected claims 14, 15, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Berg and Goodman et al. (US 2006/0059253 A1; publ. Mar. 16, 2006).³

Appellants’ Contentions

1. Appellants contend the Examiner erred in rejecting claim 1 under 35 U.S.C. § 102(e) because:

   Berg describes a user feedback functionality that is displayed to the user upon the occurrence of automatic and pre-defined trigger events (such as a cursor inadvertently remaining idle over a particular form field for a specified period of time), rather than upon, as the Appellants claim, a user selection of the feedback functionality itself (i.e., a user selection of the extension). In fact, Berg specifically teaches away from the Appellants’ claimed

¹ Separate patentability is argued for claims 1, 2, and 7. Separate patentability is not argued for claims 3–6, 10–13, 17–23, 26–28, 32, and 33. Except for our ultimate decision, the Examiner’s rejection of claims 3–6, 10–13, 17–23, 26–28, 32, and 33 is not discussed further herein.

² Separate patentability is not argued for claims 9, 24, and 25. Except for our ultimate decision, the Examiner’s rejection of these claims is not discussed further herein.

³ Separate patentability is not argued for claims 15, 29, and 30. Except for our ultimate decision, the Examiner’s rejection of these claims is not discussed further herein.
invention, and disparages the Appellants’ approach, by stating that in Berg’s invention “the automatic functionality provides for the capture of user feedback without user input or user selection of the feedback functionality, thereby increasing the probability of capturing user feedback.” In other words, Berg specifically seeks to avoid the very solution that the Appellants claim.

App. Br. 7, footnotes omitted.

In particular, Appellants’ interpretation that the claim limitation “a user selection of the extension” requires a user-initiated action or selection to invoke the extension, such as a user selection of a button, a menu, or another selectable visual element, is supported by Appellants’ specification at paragraph [0033].

Reply Br. 5.

2. Appellants contend the Examiner erred in rejecting claim 1 under 35 U.S.C. § 102(e) because:

Berg does not describe, teach, or suggest “display[ing] on the user’s screen textual input, received from the user providing the user feedback, concerning the feature” on which the user feedback is submitted. Rather, as illustrated in FIGS. 1 and 8 of Berg, Berg only appears to enable the user to submit his or her feedback through the selection of radio buttons and/or checkboxes. In discussing this element of the Appellants’ claims, the Examiner refers to paragraph [0049] and FIG. 8 of Berg. However, in that paragraph and figure, Berg is describing the process of generating a listener object for a web page (i.e., the process of creating the user feedback functionality that will later be employed in connection with the web page), not the process of actually employing the user feedback functionality itself. As such, it is the developer of the user feedback functionality that is inputting the text “Why are you having trouble with your birth year?” and the like, not the end-user providing the user feedback, as recited in the Appellants’ independent claims 1 and 17.

App. Br. 7–8, footnotes omitted.
3. Appellants contend the Examiner erred in rejecting claim 2 under 35 U.S.C. § 102(e) because:

Paragraphs [0028] and [0029] of Berg, which were cited by the Examiner in rejecting those claims, only state that “FIG. 1 is a screenshot of a web page 100 and an exemplary querybox 102 with user input options” (emphasis added) and that “[u]ser selection and submission of a response via the querybox is communicated to the listener server.” Those paragraphs simply do not mention that Berg’s feedback functionality itself may be employed to capture the contents of a user’s screen at the time the user feedback is submitted, as recited in Appellants’ claim[2]. Nor does any other portion of Berg describe, teach, or suggest such a feature.

App. Br. 8–9, footnote omitted.

4. Appellants contend the Examiner erred in rejecting claim 7 under 35 U.S.C. § 102(e) because:

The Examiner indicates that paragraph [0014] of Berg states “requesting user input specific to an element of the web page,” but it is clear that paragraph [0014], when read in full, in fact only states that the content received from the listener server includes a prompt for requesting user input specific to an element of the web page when that web page is later sent to the user. Thus, there is no description, teaching, or suggestion in paragraph [0014] of Berg of actually receiving user feedback or of “replying to the user feedback,” as recited in Appellants’ dependent claim[7].

App. Br. 10, footnote omitted.

5. Appellants contend the Examiner erred in rejecting claim 8 under 35 U.S.C. § 103(a) because:

Ramamurthy . . . fails to describe, teach, or suggest invocation of an extension to an application program during execution of the application program for the purpose of providing user feedback, and thus necessarily also fails . . . to describe, teach, or suggest such an invocation by a user selection of the extension.
Moreover, . . . Ramamurthy fails to describe, teach, or suggest an extension to an application program that displays on the user’s screen textual input, received from the user providing the user feedback, concerning the feature on which the user feedback is submitted. The Examiner . . . relies on Ramamurthy only for the propositions that Ramamurthy teaches blocking the transmission of confidential information and providing details to the user concerning non-confidential information prior to a transmission of such non-confidential information.

App. Br. 11–12, emphasis and footnote omitted.

6. Appellants contend the Examiner erred in rejecting claim 14 under 35 U.S.C. § 103(a) because:

Goodman does not describe, teach, or suggest invocation of an extension to an application program during execution of the application program for the purpose of providing user feedback, and thus necessarily also fails . . . to describe, teach, or suggest such an invocation by a user selection of the extension. Moreover, . . . Goodman fails to describe, teach, or suggest an extension to an application program that displays on the user’s screen textual input, received from the user providing the user feedback, concerning the feature on which the user feedback is submitted. Rather, Goodman appears to instead describe “an architecture for a netcentric computer system” – in particular, “[a]n execution architecture, a development architecture, and an operations architecture for a netcentric computing system.” The Examiner . . . relies on Goodman only for the proposition that Goodman teaches identifying the location of, and thereafter accessing and modifying, source code for the application program.

App. Br. 12–13, emphasis and footnote omitted.
Issues on Appeal

Did the Examiner err in rejecting claims 1, 2, 7, and 24 as being anticipated under 35 U.S.C. § 102(e) because Berg fails to describe the limitations argued by Appellants?

Did the Examiner err in rejecting claims 8 and 14 as being obvious?

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments (Appeal Brief and Reply Brief) that the Examiner has erred.

As to Appellants’ above contention 4 directed to claim 7, we agree. As argued by Appellants, Berg does not describe a “reply to the user feedback” as required by claim 7.

As to Appellants’ above contention 1, we disagree. Appellants’ arguments are not commensurate with the scope of the claim language. Contrary to Appellants’ argument that the claim requires “selection of a button, a menu, or another selectable visual element” (Reply Br. 5), the claim language “by a user selection of the extension” in no way limits how the user provides the selection. We conclude that an artisan would recognize two primary forms of selection (active selection as Appellants argue and passive selection as shown in Berg at paragraph 28). The claim before us encompasses every way of selecting including the passive way shown in the portions of Berg cited by the Examiner. We concur with the conclusion reached by the Examiner. Further, contrary to Appellants’ teaching away
argument, Berg teaches explicitly at paragraph 39 (last three sentences) that active selection (e.g., onclick, keyboard events) may be used by the user.⁴

As to Appellants’ above contention 2, we disagree. Again, Appellants’ arguments are not commensurate with the scope of the claim language. Appellants point out, “as illustrated in FIGS. 1 and 8 of Berg, Berg only appears to enable the user to submit his or her feedback through the selection of radio buttons and/or checkboxes.” App. Br. 7. Figure 1 of Berg shows that a check box may be used by a user to select the textual input “I’m concerned about identity theft.” See also Berg ¶ 50. That the text is pre-written by the software developer, as argued by Appellants, is of no moment. The claim language “textual input” encompasses every way of preforming “textual input” including selecting that text from a pre-written list. Nothing more is required by the claim.

As to Appellants’ above contention 3, we disagree. Again, Appellants’ arguments are not commensurate with the scope of the claim language. Appellants state “the extension captures the contents of the user’s screen at the time the user feedback is submitted” and “the application tool may replicate the visual identification of the location of the feature on the user’s screen and/or may replicate the visual appearance of the textual input received from the user and displayed on the user’s screen.” Spec. ¶ 10 (emphasis added). The breadth of claim 2 encompasses such textual input feedback being captured. Appellants acknowledge that Berg provides the capture of such user feedback. App. Br. 7.

⁴ Appellants are reminded that a teaching away argument is not germane to an anticipation rejection. See Twin Disc, Inc. v. U.S., 10 C1. Ct. 713, 728 (Cl. Ct. 1986) (quoting In re Self, 671 F.2d 1344 (CCPA 1982)).
As to Appellants’ above contention 5, we disagree. We conclude that Appellants’ argument overlooks the actual reasoning of the Examiner’s rejections. Instead, Appellants attack the Ramamurthy reference singly for lacking “user selection” and “textual input” teachings that the Examiner relied on a combination of references to show. As we discuss above, the Examiner correctly relied on Berg for “user selection” and “textual input” teachings. It is well established that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 426 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 1097 (Fed. Cir. 1986). The effect of Appellants’ argument is to raise and then knock down a straw man rejection of claim 8 that was never made by the Examiner in that the Examiner did not rely solely on Ramamurthy as argued. In other words, Appellants argue Examiner findings that were never made. This form of argument is inherently unpersuasive to show Examiner error. Our reviewing court requires that references must be read, not in isolation, but for what they fairly teach in combination with the prior art as a whole. Merck, 800 F.2d at 1097.

As to Appellants’ above contention 6, we disagree. Again, we conclude that Appellants’ argument overlooks the actual reasoning of the Examiner’s rejections. Instead, Appellants attack the Goodman reference singly for lacking “user selection” and “textual input” teachings that the Examiner relied on a combination of references to show. Again, as we discuss above, the Examiner correctly relied on Berg for “user selection” and “textual input” teachings.
CONCLUSIONS

(1) The Examiner has not erred in rejecting claims 1–6, 10–13, 17–22, 26–28, 32, and 33 as being anticipated under 35 U.S.C. § 102(e).

(2) The Examiner has not erred in rejecting claims 8, 9, 14, 15, 24, 25, 29, and 30 as being unpatentable under 35 U.S.C. § 103(a).

(3) Appellants have established that the Examiner erred in rejecting claims 7 and 23 as being anticipated under 35 U.S.C. § 102(e).

(4) Claims 1–6, 8–15, 17–22, 24–30, 32, and 33 are not patentable.

(5) Claims 7 and 23 have not been shown to be unpatentable.

DECISION

The Examiner’s rejection of claims 7 and 23 as being anticipated under 35 U.S.C. § 102(e) is reversed.

The Examiner’s rejection of claims 1–6, 10–13, 17–22, 26–28, 32, and 33 as being anticipated under 35 U.S.C. § 102(e) is affirmed.

The Examiner’s rejections of claims 8, 9, 14, 15, 24, 25, 29, and 30 as being unpatentable under 35 U.S.C. § 103(a) are affirmed.

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).

AFFIRMED-IN-PART