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PERKINS COIE LLP - SEA General
PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

EXAMINER
DUNCAN, DELAINE M

ART UNIT	PAPER NUMBER
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NOTIFICATION DATE	DELIVERY MODE
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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):

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Office Action Summary	Application No. 13/794,814	Applicant(s) BOWLES, MARK VINCENT	
	Examiner DELAINE DUNCAN	Art Unit 3689	AIA (First Inventor to File) Status No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *January 6, 2016*.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

5)☒ Claim(s) *9-31* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *9-31* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a)☐ All b)☐ Some** c)☐ None of the:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b) Paper No(s)/Mail Date _____.

3) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

4) ☐ Other: _____.

DETAILED ACTION

In view of the Appeal Brief filed on January 6, 2016, PROSECUTION IS HEREBY REOPENED. New Grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/JANICE MOONEYHAM/

Supervisory Patent Examiner, Art Unit 3689

DETAILED ACTION

1. The present application is being examined under the pre-AIA first to invent provisions.

2. This communication is a Non-Final Office Action on the merits in response to communications filed January 6, 2016. Claims 9-31 are currently pending in the application and are considered below.

Response to Arguments

3. Applicant's arguments submitted January 6, 2016 in the Appeal Brief (hereinafter "Ap. Br.") have been fully considered.

Section 101 Rejection

4. Applicant's arguments regarding the 35 USC 101 rejection of claims 9-31 have been fully considered but are not persuasive. Applicant argues the claims are not directed towards an abstract idea because the claims are directed to combinations of specific operations performed by a "special-purpose, unmanned kiosk" and therefore could not possibly preempt the abstract idea at least because purchasing/selling an electronic device does not necessitate use of a kiosk, and under the streamlined eligibility analysis the claims are eligible. Ab. Br. 8-9. The examiner respectfully disagrees. The claims do not recite that the kiosk is unmanned. Nor is the kiosk special-purpose. The kiosk recited in the claims is generic and merely "provided". The remaining functions just occur in an area of the kiosk. The kiosk does not perform any functions as cited. Therefore, Applicant is arguing features which are not claimed. Additionally, preemption is not a stand-alone test for eligibility. Questions are inherent in and resolved by the two-part framework from *Alice* and *Mayo*. Moreover, while the claim may not 100% preempt the abstract idea, the absence of complete preemption does not demonstrate that a claim is eligible.

See May 2016 Subject Matter Eligibility Memo, Pg. 7. Streamlined eligibility also does not apply here. The instant claims do not recite some complex manufacturing process or recite some robotic arm assembly. Regardless, the examiner asserts that the outcome would be the same under the streamline eligibility and the two-part framework. See July 2015 Update: Subject Matter Eligibility, Pg. 9. Since the claims do not recite a complex manufacturing process or robotic arm assembly, and the results of the analysis would be the same under the two-part framework, the claims are analyzed under the two-part framework (see 101 rejection below). Since the claims are directed towards an abstract idea and do not recite significantly more, the claims would also not be eligible under the streamlined eligibility analysis. Also, merely applying the purchasing/selling of an electronic device to a particular environment, i.e., at a kiosk, does not make the idea any less abstract. Courts have found claims directed towards abstract ideas that do not necessitate for instance the use of computers but have still found the claims ineligible. See, e.g., *Alice*, *Versata*. Therefore, these arguments are not persuasive.

5. Applicant also argues that even if the claims are directed towards an abstract idea, the claims nonetheless amount to "significantly more" than the abstract idea. Ap. Br. 10. Applicant argues the functions of electrically inspecting an electronic device and acquiring (Claim 9), transferring (claim 21), and erasing (claim 27) personal data from an electronic device via an electrical connector are meaningful limitations that amount to significantly more. The examiner respectfully disagrees. Applicants recite a generic "electrical connector" for "inspecting" an electronic device and receiving data from the device. The functions of inspection are not disclosed. Therefore, given their broadest reasonable interpretation merely involves extra-solution data-gathering. Further, receiving and transferring information over a network are

functions that have been identified as well-understood, routine and conventional (see July 2105 Update: Subject Matter Eligibility, Pg. 7). Using a generic "connector" to perform its intended and known function of connecting to a device and collecting or removing data does not amount to significantly more. See *Content Extraction* (recitation of a generic scanner to perform its intended function of collecting data did not amount to significantly more). Taking the claim limitations as a whole, the method merely describes a process that could otherwise be performed manually, but performing it at a kiosk using generic components. The "computer-implemented" does not limit the claim because it is recited in the preamble and does not perform any steps of the method. See MPEP 2111.02. Therefore, the claims as a whole merely amount to applying an abstract idea to a particular environment. These arguments are not persuasive.

Section 112, Second Paragraph, Rejection

6. Applicant's arguments regarding the 35 USC 112, second paragraph, rejection of claims 9-31 have been considered but are not persuasive. The claims were rejected under 35 USC 112, second paragraph, because the claims recite a "computer-implemented" method. However, a computer is not recited within the method or recited as included in the kiosk. Also, some steps of the method cannot be performed by a computer, e.g., a computer cannot provide a kiosk. Nonetheless, Applicant argues the claims are definite because the specification makes it clear that a computer is used to control components of the kiosk. Ab. Br. 11-12. Limitations from the specification are not read into the claims. See MPEP 2173.05(q). Some steps in the claim are disclosed as performed manually (see, e.g., [00014]) and some steps cannot be performed by a computer, e.g., providing a kiosk. Therefore, these arguments are not persuasive.

Section 103 Rejections

7. Applicant's arguments regarding the 103(a) rejection of claims 9 and 27 that the combination of Banerjee, Cooke and Boutsikakis fail to disclose "electrically inspecting an electronic device and acquiring (claim 9) or erasing (claim 27) personal data from the electronic device via an electrical connector" (Ap. Br. 19) are persuasive. However, the claims are newly rejected under 103(a). See below.

8. Applicant's arguments regarding the 103(a) rejection of claim 21 that the combination of Banerjee, Cooke, Lundy and Boutsikakis (for motivation) fail to disclose "electrically inspecting [a] first electronic device via [a] first electrical connector while the first electronic device is in [an] inspection area" (Ap. Br. 21) are persuasive. However, the claims are newly rejected under 103(a). See below.

9. Applicant presents no additional arguments regarding the 103(a) rejections of claims 10-20, 22-26 and 28-31 (Ap. Br. 22-25). However, the claims are newly rejected under 103(a). See below.

Priority

10. The present application is a Continuation-In-Part (CIP) Application of U.S. Patent Application No. 13/693032 filed December 3, 2012, which is a CIP of US Application No. 13/438924, filed April 4, 2012, which claims priority to US Provisional Application No. 61/472611, filed April 6, 2011, which is a CIP of US Patent Application 12/785465, filed May 23, 2010, which is a CIP of US Patent Application 12/727624, filed March 29, 2010, which is a CIP of US Patent Application 12/573089, filed October 2, 2009, which claims priority to US Provisional Applications 61/102304, filed October 2, 2008 and 61/183510, filed June 2, 2009.

Claim 21 has a priority date of **December 3, 2012** because certain features including the second connector on the outside of the kiosk cannot be found in earlier applications. Similarly, the examiner is unable to find support in earlier filed applications to show acquiring personal data or erasing personal data via the electrical connector. Therefore, the claims are entitled to a priority date of **December 3, 2012.** If Applicant thinks that the claims should be afforded an earlier priority date, the examiner requests that Applicant show where the features of the independent claims are supported.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on nonstatutory double patenting provided the reference application or patent either is shown to be commonly owned with the

examined application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. See MPEP § 717.02 for applications subject to examination under the first inventor to file provisions of the AIA as explained in MPEP § 2159. See MPEP §§ 706.02(l)(1) - 706.02(l)(3) for applications not subject to examination under the first inventor to file provisions of the AIA. A terminal disclaimer must be signed in compliance with 37 CFR 1.321(b).

The USPTO Internet website contains terminal disclaimer forms which may be used. Please visit www.uspto.gov/patent/patents-forms. The filing date of the application in which the form is filed determines what form (e.g., PTO/SB/25, PTO/SB/26, PTO/AIA/25, or PTO/AIA/26) should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to www.uspto.gov/patents/process/file/efs/guidance/eTD-info-I.jsp.

Claims 9-31 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-6, 9-13, 15 and 20-27 of copending U.S. Application No. 13/693032. Although the claims at issue are not identical, they are not patentably distinct from each other because the claims are directed towards similar systems/methods for transferring and erasing personal data from an electronic device within an inspection area of a kiosk using an electrical connector, purchasing the device, and moving the device to a storage receptacle after acquiring the personal data. While the claims in the '032 application do not have an offer and acceptance, the claims do involve the purchasing of the electronic device, where offer and acceptance would have been obvious when purchasing a device from a user for a value.

This is a provisional nonstatutory double patenting rejection because the patentably indistinct claims have not in fact been patented.

Claim Rejections - 35 USC § 101

35 U.S.C. § 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. **Claims 9-31** are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

When considering subject matter eligibility under 35 U.S.C. § 101, it must be determined whether the claim is directed to one of the four statutory categories of invention, i.e., process, machine, manufacture, or composition of matter. If the claim does fall within one of the statutory categories, it must then be determined whether the claim is directed to a judicial exception (i.e., law of nature, natural phenomenon, and abstract idea), and if so, it must additionally be determined whether the claim is a patent-eligible application of the exception. If an abstract idea is present in the claim, any element or combination of elements in the claim must be sufficient to ensure that the claim amounts to significantly more than the abstract idea itself. Examples of abstract ideas include fundamental economic practices; certain methods of organizing human activities; an idea itself; and mathematical relationships/formulas. *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*, 573 U.S. ____ (2014).

In the instant case, the claims are directed towards processes.

Next, the claims are directed towards an abstract idea. The claims (9, 21 and 27, which are similar in scope) recite, in part, methods for receiving a device in an inspection area,

inspecting the device, presenting an offer to purchase the device, receiving acceptance of the offer, acquiring (claim 9), transferring (claim 21) or erasing (claim 27) personal data from the device, and moving the device to storage. While some claim limitations add a degree of particularity, i.e., providing a kiosk and electrically inspecting the device, the majority of the claims are directed towards the underlying abstract idea of receiving a device, inspecting the device, offering to purchase the device, receiving an offer to purchase the device, and acquiring, transferring, or erasing personal data from the device. This concept is considered to be directed towards an abstract idea because the concept is similar to concepts that have been identified by courts as abstract, e.g., concepts relating to the economy and commerce (*buySAFE*), concepts relating to managing transactions between people (*buySAFE*), concepts relating to sales activities (*Ultramercial*), and concepts relating to processes of organizing inforamation such as data recognition and storage (*Content Extraction*). Moreover, inspecting an item for purchase, making an offer, accepting the offer, and removing personal effects from the item is a well-known fundamental economic activity, e.g., when buying a home or car, items are inspected, offers are made and accepted and personal effects are acquired, transferred or removed. Here, the claimed concept is similar. Therefore, the claims are directed towards an abstract idea.

Finally, the claims are analyzed to determine whether the additional elements of the claim, considered separately and as a whole, amount to significantly more than the abstract idea. The additional elements include a “kiosk”, electronic devices, a "remote storage location" and electrical connectors. The "computer-implemented" limitation does not limit the claim because it is recited in the preamble and constitutes the intended use. See MPEP 2111.02. The additional elements are recited at a high level of generality and are merely recited to perform their intended

functions. The examiner notes that the functions merely take place in an inspection area of a generic "kiosk" and the kiosk is not recited as performing any of the function. “Providing” a kiosk could be just positioning a kiosk in room. Receiving a device in an inspection area could include placing a device on a surface. Using an electrical connector to inspect an electronic device, or acquire, transfer or remove data from the device are functions that are well-understood, routine and conventional. See July 2015 Update: Subject Matter Eligibility, Pg. 7. Moreover, the description provided in the specification merely states that these functions take place using an electrical connector and do not disclose these functions are requiring anything other than routine and conventional activity. The specification describes electrical inspection as ‘preferably’ being done by generic electrical analysis software to obtain data about the device (specification, [00079]). The broadest interpretation of this element includes a generic component performing extra-solution data gathering activity. Presenting offers and accepting offers could be done orally, and moving a device to storage could be performed manually. Thus, taken alone, the additional elements do not amount to significantly more than the above-identified judicial exception (the abstract idea). Looking at the limitations as an ordered combination adds nothing that is not already present when looking at the elements taken individually. There is no indication that the combination of elements improves the functioning of a computer or improves any other technology. Therefore, the claims are ineligible under 101.

For the same reasons set forth with respect to claim 9, Claims 21 and 27 do not amount to significantly more than the abstract idea.

The dependent claims are merely reciting further embellishment of the abstract idea and do not amount to anything that is significantly more than the abstract idea itself.

Therefore, claims 9-31 are rejected under 35 U.S.C. 101.

Claim Rejections - 35 USC § 112, First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112(a):

> (a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

The following is a quotation of the first paragraph of pre-AIA 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. **Claims 9-31** are rejected under 35 U.S.C. 112(a) or 35 U.S.C. 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for pre-AIA the inventor(s), at the time the application was filed, had possession of the claimed invention.

a. Claims 9, 21 and 27 recite "electrically inspecting the electronic device" via an electrical connector. The examiner asserts that Applicant has failed to sufficiently describe this step to convey to one of ordinary skill in the art that Applicants were in possession of the claimed invention. MPEP 2161.01 requires a description of the algorithm, or a description of a sufficient number of species, to support functional claim language. Here, the specification does not provide any algorithm to show how the device is inspected or what that inspection entails. At [00079], the specification merely states

that "electrical analysis software" is preferably utilized. However, there is no description as to what this software is or what other types of inspection could be utilized. Such a disclosure does not reasonably convey that Applicants were in possession of electrically inspecting a device. Such a description also does not disclose a sufficient number of species to show possession of such a broad genus claim of any and all ways of electrically inspecting a device using an electrical connector. Therefore, the claims recite limitations that fail to satisfy the written description requirement. Claims 10-20, 22-26 and 28-31 are rejected because they depend from claims 9, 21 and 27.

b. Claim 21 recites "a second electrical connector outside the inspection area" and "transferring personal data ... to the second electronic device via the second electrical connector" that is outside the inspection area. The examiner is unable to find support for this limitation in the disclosure. Therefore, the claim is rejected as containing new matter.

c. Claim 22 recites "the second electronic device is a mobile storage device". The examiner is unable to find support for this limitation in the disclosure. Therefore, the claim is rejected as containing new matter.

d. Claims 16, 24 and 29 recite that the transfer of data, acquisition of data, or erasing of data occurs "while the user is prevented from accessing the electronic device". The examiner is unable to find support for this limitation in the claims. In fact, the opposite is disclosed. See, e.g., [00065] (access door 130 "provides access to an inspection area 106 for electronic devices"); FIG. 1 and FIG. 8, 8C. Therefore, the claims are rejected as containing new matter.

Claim Rejections – 35 U.S.C. § 112, second paragraph

The following is a quotation of 35 U.S.C. 112(b):
(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. **Claims 9-31** rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention.

a. Claims 9, 21 and 27 are rejected as indefinite. The claims recite a "computer-implemented method" in the preamble but there is no computer recited in the method or steps that are performed by a computer. Also, some steps recited cannot be performed by a computer, e.g., "providing a kiosk". Therefore, it is unclear whether the method is actually implemented by a computer and which steps are manual. Claims 10-20, 22-26 and 28-31 are rejected due to their dependency from claims 9, 21 and 27.

b. Claim 22 is rejected as indefinite because the metes and bounds of an "electronic device" that is a "mobile storage device" are unclear. The specification does not explicitly define an "electronic device" and there is no disclosure of a "mobile storage device". The specification does disclose a memory card. Is this an electronic device? If it is, the metes and bounds of what an electronic device includes is unclear because the disclosure of the specification that an electronic device includes a "Smart Phone, mobile phone, tablet computer, IPOD® device, MP3 Player, GPS device, e-reader, etc."

(specification at [00061]). One of ordinary skill in the art would not include a memory card in this group. Clarification is requested as to what the metes and bounds of electronic device includes and what Applicant means by "mobile storage device".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. **Claims 9-11, 14-17, 19 and 20** are rejected under 35 U.S.C. § 103(a) as being unpatentable over Banerjee et al. (US 2003/0204289), hereinafter "Banerjee" in view of Stoecker (US 2007/0129906), SimplySellular.com, "Get CASH for your old cell phone" (for motivation), and Shi et al. (US 8,200,736), hereinafter "Shi".

As per claim 9, Banerjee discloses a computer-implemented method for recycling consumer electronic devices (see [0028] (presenting items for sale at vending machine, to be

resold); [0030] (items include "camera equipment" and "electronic equipment"); [0063-64] (kiosk and method controlled by computer) comprising:

providing a kiosk at [0007] (automated vending machine ("AVM")), **wherein the kiosk includes—**

a housing at [0007]; FIG. 9 (showing housing); [0030-31]**;**

an inspection area within the housing at [0031] (items are place in a common receptacle); see also [0028] and [0043] (items are inspected when in the AVM), **and**

a storage receptacle within the housing at [0031], [0033] (items are moved to storage compartments); FIG. 9 (showing compartments)**;**

receiving, from a user of the kiosk, an electronic device at [0030-31] (items are received into the AVM; items include camera/electronic equipment)**;**

presenting, to the user, an offer to purchase the electronic device at [0034] and [0068] (vending machine makes an evaluation/appraisal of what it is willing to pay for the item and the "seller 101-102 can receive an appraisal", where the price the AVM is willing to pay is interpreted as an offer); see also [0071] ("A seller 101-102 can receive an offer for purchase of the item")**; and**

moving the electronic device to the storage receptacle at [0031], [0033] (items are moved to compartments)**.**

(A) Banerjee does not disclose <u>an electrical connector within the inspection area</u> or <u>electrically inspecting the electronic device via the electrical connector while the electronic device is in the inspection area.</u>

Banerjee does disclose a kiosk for accepting items for purchase, including electronic equipment, and evaluating a price that the kiosk is willing to pay for the item, the price based on the condition of the received item (see [0034]).

Analogous reference Stoecker discloses a kiosk for inspecting electronic equipment. The kiosk includes **an electrical connector within an inspection area** at [0021] ("One or more imaging device connections 42 may be provided, including wired connections such as Universal Serial Bus (USB) cables, etc, … One or more test fixtures 46 are provided, enabling an imaging device to be tested at the kiosk"); see also [0023] ("The user brings 70 an imaging device to a kiosk, places 72 the imaging device in the kiosk and connects the imaging device according to instructions provided by the kiosk"); see also [0012] (imaging device includes mobile phone) and [0015] (number of different connectors)**; and electrically inspecting the electronic device via the electrical connector while the electronic device is in the inspection area** at [0023] ("The kiosk performs 82 the tests and displays the results to the user … The user disconnects 84 the imaging device and is finished"); see also [0013] and [0017] (testing the device's condition)**.**

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the kiosk of Banerjee to include an electrical connector within the inspection area and the step of electrically inspecting the electronic device via the electrical connector while the electronic device is in the inspection area as taught in Stoecker. Banerjee discloses appraising an item's value based on its condition, and accepting electronic equipment for purchase. Stoecker discloses a method/system for evaluating the condition of electronic equipment. Analogous reference SimplySellular provides a motivation as to why it would have been obvious to combine Banerjee and SimplySellular: so that a fair and accurate price can be determined

based on the condition of electronic equipment, including how the device functions and works (see SimplySellular, Pg. 1, "Simply Sellular may make an offer for 75, 50, 25, or 0 percent of the original value of the handset based on the handset's condition and its resale value). Additionally, electronically inspecting the electronic device using a connector would have been advantageous to Banerjee which receives a description for an item. Evaluating the results of an electrical inspection of a device would reduce fraud. Additionally, providing such functionality at the kiosk while the device is in an inspection area would have been obvious because of the motivation to decrease inconvenience and inefficiency as it would eliminate the need for the device to be delivered to a facility for testing (Stoecker, [0004]). Such a combination would have also been obvious under *KSR* Rationale A since the combination of is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately (the kiosk in Banerjee, the connector in Stoecker) and one of ordinary skill in the art would have recognized that such a combination would have yielded predictable results.

(B) Banerjee does not *explicitly* disclose <u>receiving, from the user, an acceptance of the offer.</u> Banerjee does disclose providing an appraisal value to the user from the AVM that the AVM is willing to pay for the received item (see [0034]) and then dispensing cash for the item (see [0034]). Additionally, sellers and purchasers can negotiate a purchase price for an item online, then buyer would transfer money to the seller when the item has been picked up (see [0073], [0078], and [0087]).

The examiner asserts that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Banerjee to include receiving, from the user, an

acceptance of the offer. Such a combination would have been obvious because of the advantage to give the user a choice whether he/she would like to sell an item, thereby increasing customer satisfaction. Moreover, the examiner asserts that offer and acceptance are well-known economic practices when purchasing and selling an item, e.g., including pawn shops, car dealerships, and real estate purchases. Therefore, it would have been obvious to receive acceptance of the offer before payment; without it, there would be no agreement from the seller to sell and give up their item.

(C) Banerjee does not explicitly disclose acquiring personal data from the electronic device via the electrical connector; transferring the personal data to a remote storage location; and moving the electronic device to the storage receptacle after acquiring the personal data.

Analogous reference Stoecker discloses that it was known in the art before the invention to **acquire data from the electronic device via the electrical connector; and transfer the data to a remote storage location** at [0023] ("The kiosk transmits 86 data about the imaging device such as the model, test results and kiosk location to the server for storage and logging")**.**

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Banerjee to include acquiring data from the electronic device via the electrical connector and transferring the data to a remote storage location as taught in Stoecker. Such a combination would have been obvious because of the motivation to transmit test results for storage and logging (Stoecker, [0023]), which would aid in development, maintenance and marketing efforts (Stoecker, [0025]).

While Stoecker does not explicitly disclose acquiring and transferring *personal* data from the electronic device, analogous reference Shi discloses that it was known in the art at the time of

the invention to acquire and transfer **personal data** from a mobile phone using an electrical connector **to a remote storage location** at Col. 8, Ln. 42-67 (USB connector coupled to mobile device connected to a computer with a USB device and downloading data from the mobile device); see also Col. 6, Ln. 37-53 ("personal data may be transferred from the mobile handset memory 205 to the VSIM database via the VSIM server 102... Transferred personal data is stored by the VSIM server 102 in files located within the VSIM database"); Col. 2, Ln. 55-67 (describing the personal data that can be transferred).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Banerjee, in combination with Stoecker, to include acquiring personal data from the electronic device via the electrical connector and transferring the personal data to a remote storage location, as taught in Shi, because of the motivation to eliminate the need to reprogram new phones when a user wishes to replace, exchange or upgrade their equipment (Shi, Col. 3, Ln. 49-55). It would have been obvious to incorporate this functionality in Banerjee because a user is turning in their electronic equipment for sale and may want to replace their equipment, so having their personal information available for download would decrease cost and effort, and make the user less reluctant to trade in their old device (Shi, Col. 3, Ln. 6-12). Such a combination would have also been advantageous to allow users to easily restore their personal data from an old phone to a new phone when users update their mobile handset equipment (Shi, Col. 10, LN. 43-46). Moreover, it would have been obvious to simply substitute the type of data transferred from the user's electronic device in Stoecker for the data in Shi and one of ordinary skill in the art would have recognized that such a simple substitution would have yielded predictable results.

Banerjee does not explicitly disclose moving the electronic device to the storage receptacle after acquiring the personal data.

However, as shown above, it would have been obvious to acquire the personal data from a user's electronic device that is turning their device into the kiosk to be sold. Banerjee discloses that the item/device is transferred to a storage receptacle after it is purchased. The examiner asserts that it would have been obvious to one having ordinary skill in the art at the time of the invention to move the device to the storage receptacle after acquiring the personal data, so that the device will not have to be retrieved back from storage and the information transferred later but could be transferred when the device is received, thereby increasing customer convenience and efficiency.

As per claim 10, the combination of Banerjee, Stoecker, SimplySellular and Shi discloses the limitations of claim 9. Banerjee further discloses **wherein the electronic device is a first electronic device** at [0030] (electronic equipment)**.** Stoecker and Shi also discloses this feature (Stoecker, [0012] and Shi, Col. 2, Ln. 1-9). The combination further discloses that it was known in the art before the invention to **transfer the personal data from the remote storage location to a second electronic device** at Shi, Col. 2, Ln. 1-9 (downloading personal data from one mobile handset to a server, then provisioning a new mobile handset by uploading the personal data from the server); see also Col. 6, Ln. 37-53 and Col. 10, Ln. 43-57 (downloading and storing information from a first mobile handset to a server and storing the data on a database, then uploading the stored data to a new device)**.**

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination to include wherein the electronic device is a first electronic

device and transferring the personal data from the remote storage location to a second electronic device as taught in Shi, because of the motivation to allow users to restore all of their personal data from an old mobile handset to a new mobile handset (Shi, Col. 10, Ln. 43-46) at any time (Shi, Col. 6, Ln. 54-59). This would be advantageous for users of the kiosk of Banerjee who are turning in their old electronic equipment to have their personal data stored and available for transfer to a new device.

As per claim 11, the combination of Banerjee, Stoecker, SimplySellular and Shi discloses the limitations of claim 10. The combination further discloses **wherein the second electronic device is a new electronic device *at a retail store that sells new electronic devices*** at Shi, Col. 6, Ln. 37-53 and Col. 10, Ln. 43-57 (downloading and storing information from a first mobile handset to a server and storing the data on a database, then uploading the stored data to a new device); Col. 13, Ln. 9-34 ("mobile handset may be purchased *at any location...* thereby giving users flexibility to purchase phones *from the store of their choice"*).

[Examiner note: the examiner notes the italicized limitations are non-functional descriptive material since where the new phone is located does not materially alter the method in any way or provide any functionality to the method; rather, the method would be performed in the same manner regardless of where the second device was located, see MPEP 2111.05. Also, the type of store, i.e., retail, does not materially alter the method and would be performed in the same way regardless of the particular type of store; therefore, these limitations are afforded little if any patentable weight].

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination to further include wherein the second electronic device is a

new electronic device at a retail store that sells new electronic devices as taught in Shi, because of the motivation to allow users to restore all of their personal data from an old mobile handset to a new mobile handset that they purchase at any store of their choice (Shi, Col. 10, Ln. 43-46; Col. 13, Ln. 9-34). This would be advantageous for users of the kiosk of Banerjee who are turning in their old electronic equipment to have their personal data stored and available for transfer to a new device that they want to purchase from a store.

As per claim 14, the combination of Banerjee, Stoecker, SimplySellular and Shi discloses the limitations of claim 9. The combination further discloses **providing, to the user, a link for retrieving the personal data from the remote storage location** at Shi, Col. 5, Ln. 23-27, 44-49 and Col. 15, Ln. 7-15 (users can access their personal data from the remote storage location using an Internet link and entering credentials in a web page).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination to further include providing, to the user, a link for retrieving the personal data from the remote storage location as taught in Shi because of the motivation to have access to their personal data over the Internet in case they do not have access to the information otherwise because they turned in their old device (Shi, Col. 15, Ln. 8-15), enable easy provisioning of data to a new device, and enhance security of the personal information (Shi, Co. 10, Ln. 44-67).

As per claim 15, the combination of Banerjee, Stoecker, SimplySellular and Shi discloses the limitations of claim 9. Banerjee does not explicitly disclose <u>wherein the electronic device is a mobile phone.</u>

Banerjee does discloses accepting items such as electronic equipment (see [0030).

Combined reference Stoecker, which also discloses accepting electronic items, further discloses **wherein the electronic device is a mobile phone** at Stoecker, [0012] ("mobile phone").

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination to include that the electronic device is a mobile phone as shown in Stoecker in order to increase the types of items that could be received and resold, thereby increasing potential users and profit. Moreover, it would have been obvious to simply substitute the electronic equipment of Banerjee with a mobile phone of Stoecker, and one of ordinary skill would have recognized that such a combination would have yielded predictable results.

As per claim 16, the combination of Banerjee, Stoecker, SimplySellular and Shi discloses the limitations of claim 9. The combination does not explicitly disclose <u>wherein acquiring the personal data from the electronic device via the electrical connector includes acquiring the personal data from the electronic device via the electrical connector after receiving the acceptance of the offer and while the user is prevented from accessing the electronic device.</u>

The combination does disclose acquiring personal data from an electronic device via an electronical connector, receiving acceptance of an offer, and preventing a user from accessing the electronic device (see Banerjee, [0031], [0034], [0043]).

Banerjee discloses purchasing an item from a user. The item is received and payment is dispensed ([0034]). The item is then stored in the AVM (Banerjee, [0031], [0034], [0043]). The combination further discloses that it would have been obvious to accept an offer before

dispensing payment, transferring data while the user is at the kiosk (Stoecker), and the need to transfer personal data from a device when a user intends to trade in or replace their device (Shi, Col. 3, Ln. 49-56).

It would have been obvious to one having ordinary skill in the art at the time of the invention to prevent a user from accessing the electronic device after acceptance of the offer. The examiner asserts that it would have been common sense not to let a user have access to the item that they just sold at a vending machine that purchased the item. Otherwise, the user could take it back and the vending machine would lose money. It would also have been obvious to not transfer data from the device while the user is at the kiosk and not until after a user has agreed to sell the device in case the user wants to not sell the device and continue to use the device. Therefore, the examiner asserts that it would have been obvious to acquire the personal data from the electronic device via the electrical connector after receiving the acceptance of the offer and while the user is prevented from accessing the electronic device to increase efficiency and prevent fraud. Moreover, the mere rearrangement of steps would have been obvious because the order of the steps would not change the end result. See MPEP 2144.04 and *In re Burhans* (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results).

As per claim 17, the combination of Banerjee, Stoecker, SimplySellular and Shi discloses the limitations of claim 9.

Banerjee further discloses **dispensing cash to the user at the kiosk** at [0034] (dispensing cash); [0078-79] (seller accepts AVM's payment to purchase the item, kiosk dispenses cash).

Banerjee does not explicitly disclose dispensing cash to the user at the kiosk after receiving the acceptance of the offer.

However, the examiner asserts that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination include dispensing the case after receiving the acceptance of the offer. Such a combination would have been obvious because of the advantage that doing so would prevent the user from taking the money without having agreed to sell or give up their device, thereby saving money and fraud. Moreover, the examiner asserts that it is well known to wait to pay for an item until after an acceptance of the offer amount has been received, e.g., at pawn shops, car dealerships and real estate deals. Therefore, it would have been obvious to receive acceptance of the offer before payment; without it, there would be no agreement from the seller to sell and give up their item.

As per claim 19, the combination of Banerjee, Stoecker, SimplySellular and Shi discloses the limitations of claim 10. The combination further discloses **wherein the first electronic device is a first mobile phone** at Shi, Col. 2, Ln. 1-9 (mobile handset) and **the second electronic device is a second mobile phone** at Shi, Col. 2, Ln. 1-9 (transferring data from one mobile handset to a storage location, then to another mobile handset); see also Col. 6, Ln. 37-53 and Col. 10, Ln. 43-57 (downloading and storing information from a first mobile handset to a server and storing the data on a database, then uploading the stored data to a new device).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination to include wherein the first electronic device is a first mobile phone and the second electronic device is a second mobile phone as taught in Shi,

because of the motivation to allow users to restore all of their personal data from an old mobile handset to a new mobile handset (Shi, Col. 10, Ln. 43-46) at any time (Shi, Col. 6, Ln. 54-59). This would be advantageous for users of the kiosk of Banerjee who are turning in their old electronic equipment to have their personal data stored and available for transfer to a new device.

As per claim 20, the combination of Banerjee, Stoecker, SimplySellular and Shi discloses the limitations of claim 9. The combination further discloses **providing, to the user, a web location for retrieving the personal data from the remote storage location** at Shi, Col. 5, Ln. 23-27, 44-49 and Col. 15, Ln. 7-15 (users can access their personal data from the remote storage location using an Internet link and entering credentials in a web page).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination to further include providing, to the user, a web location for retrieving the personal data from the remote storage location as taught in Shi because of the motivation to have access to their personal data over the Internet in case they do not have access to the information otherwise because they turned in their old device (Shi, Col. 15, Ln. 8-15), enable easy provisioning of data to a new device, and enhance security of the personal information (Shi, Co. 10, Ln. 44-67).

16. **Claim 12** is rejected under 35 U.S.C. § 103(a) as being unpatentable over Banerjee in view of Stoecker, SimplySellular and Shi, and in further view of Bhumkar et al. (US 2007/0276911).

As per claim 12, the combination of Banerjee, Stoecker, SimplySellular and Shi discloses the limitations of claim 10.

The combination does not explicitly disclose wherein transferring the personal data from the remote storage location to the second electronic device includes transferring the personal data from the remote storage location to the second electronic device by email.

The combination does disclose transferring personal data from an electronic device to a remote storage location to a second electronic device (Shi, Col. 2, Ln. 1-9).

Analogous reference Bhumkar discloses that it was known in the art before the invention to **transfer personal data from a remote storage location to a second electronic device by email** at Abstract, [0048], [0067], [0086] (emailing contacts stored on a web server to a second electronic device)**.**

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination, which includes transferring personal data from one a remote storage location to another electronic device, to include transmitting the data via email as taught in Bhumkar. Such a combination would have been obvious because "E-mail is the most used application on the internet, so this mechanism provides an easy and ubiquitous method for members to ... send contacts and events to their phones" (Bhumkar, [0133]). Moreover, it would have also been obvious to simply substitute the data transfer method of the combination for the data transfer in Bhumkar, and one of ordinary skill in the art would have recognized that the results of such a substitution would have been predictable.

17. **Claim 13** is rejected under 35 U.S.C. § 103(a) as being unpatentable over Banerjee in view of Stoecker, SimplySellular and Shi, and in further view Boutsikakis (US 2004/0242216), hereinafter "Boutsikakis".

As per claim 13, the combination of Banerjee, Stoecker, SimplySellular and Shi discloses the limitations of claim 10. The combination does not explicitly disclose wherein the second device is a computer belonging to the user.

The combination does disclose transferring data from one device to a mobile storage to a second device. In Shi, the second device is a mobile handset that can be connected to a computer to enable the uploading/downloading of information to the device (see Shi, Col. 8, Ln. 42-67).

Nevertheless, analogous reference Boutsikakis discloses that it was known to transfer personal data from one device to a second device, **wherein the second electronic device is a computer belonging to the user** at [0033] ("If the user has selected to transmit data, the systems and methods retrieve the selected data… and transmit the data using the… connector circuit"); [0036], [0041] (devices such as mobile phones and personal computers are connected via cable);.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination, which includes transferring personal data from one electronic device to a remote storage to a second electronic device, to include wherein the second electronic device is a computer belonging to the user as taught in Boutsikakis, so that data from an old device could be transferred to a user for convenient receipt the information from another device, such as a computer (Boutsikakis, [0014]), which would increase the number of devices information could be transferred to, thereby increasing flexibility. Moreover, users turning in old devices would be more reluctant to turn them in if their information stored on the old phone was going to be transferred to second devices such as personal computers (Boutsikakis, [0006]). Also, it would have been obvious to simply substitute the second electronic device of the

combination for a computer as taught in Boutsikakis and one of ordinary skill in the art would have recognized that such a substitution would have yielded predictable results.

18. **Claim 18** is rejected under 35 U.S.C. § 103(a) as being unpatentable over Banerjee, Stoecker, SimplySellular and Shi, and in further view of Taylor (US 2009/0190142).

As per claim 18, the combination of Banerjee, Stoecker, SimplySellular and Shi discloses the limitations of claim 9. The combination does not explicitly disclose automatically disconnecting the electrical connector from the electronic device after receiving the acceptance of the offer.

The combination does disclose a kiosk having an electrical connector for connecting an electronic device for electrical inspection (Stoecker), disconnecting the device (Stoecker, [0023]), and transferring data (Shi). The combination further discloses receiving acceptance of an offer to purchase an item including electronic equipment (Banerjee).

Analogous reference Taylor discloses a kiosk having a connector for connecting an electronic device (see FIG. 1) and discloses that it was known in the art before the invention to **automatically disconnect an electrical connector from an electronic device** at [0046] ("Once the data has been transmitted to the kiosk, the PCA substrate (430) is moved away from the data port (700) of the data storage device (120) thus disconnecting the connector (420) from the data port (700) of the data storage device (120)").

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination to include the concept of automatically disconnecting an electrical connector from the electronic device as taught in Taylor, in order to decrease human

error and damage (Taylor, [0036]). Moreover, MPEP 2144.04 and *In re Venner* state that automating a manual activity is obvious when the automation would not yield a different result.

The examiner asserts it would have further been obvious to disconnect the electrical connector from the electronic device after receiving acceptance of the offer, so that the device can be retained by the AVM/kiosk and the AVM/kiosk can accept the next item.

19. **Claims 21-23 and 25** are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stoecker in view of RMS Communications Group, "RMS Communications Group Inc. opens cell phone kiosk at Ocean City Mall in Toms River, N.J.", hereinafter "RMS" and Turner (US 6,041,229).

As per claim 21, Stoecker discloses a computer-implemented (see Stoecker, [0011], kiosk includes *computer equipment*) method, comprising:

providing a kiosk at [0011] ("kiosk"), **wherein the kiosk includes –**

a housing at [0011] ("kiosk" refers to a *structure* including computer equipment and a user interface to which a camera may be connected and maintained by a user or store clerk")**;**

an inspection area within the housing at [0021] ("One or more *test fixtures* 46 are provided, enabling an imaging device to be tested at the kiosk")**; and**

a first electrical connector within the inspection area at [0015] ("The imaging device I/O database 32 may also provide information instructing the user on how an imaging device should be connected to the kiosk (e.g., 12), such as which of a number of available connectors should be used"); see also [0021] ("One or more imaging device

connections 42 may be provided, including wired connections such as Universal Serial Bus (USB) cables, etc.”)**;**

receiving, from a user of the kiosk, a first electronic device at [0023] (“The user brings 70 an imaging device to a kiosk”); [0012] (imaging devices include mobile phones)**;**

electrically inspecting the first electronic device via the first electrical connector while the first electronic device is in the inspection area at [0017]; [0023] (tests are performed to a device connected via a cable)**;**

transferring data from the first electronic device via the first electrical connector to a second device at [0021]; [0023] (information from the device is transferred from the electrical connector to an external storage database on a server or written to removable media that may be provided to the user, e.g., CD burner)**; and**

relinquishing the second device to the user after transferring the data at [0021] (removable media device is given to the user)**.**

(A) Stoecker does not explicitly disclose <u>presenting, to the user, an offer to purchase the first electronic device; or receiving, from the user an acceptance of the offer; and retaining the first electronic device at the kiosk after transferring the data.</u>

Stoecker does disclose a kiosk for inspecting an electronic device, the kiosk positioned at shopping malls and in-store kiosks ([0014])

Analogous reference RMS discloses that it was known in the art before the invention to provide a kiosk, receive electronic devices, **present offers to purchase the electronic devices and receive acceptance of the offers** at Pg. 1 (describing a kiosk that allows a user to sell their device at the kiosk and at the kiosk, cash is paid to a user for their mobile phones and “RMS will

pay between $3 and $90 for each useable phone", where the examiner asserts that the kiosk offering to purchase phones and the payment of cash for the phone would include an offer and acceptance as these are well-known economic practices when purchasing and selling an item, e.g., including pawn shops, car dealerships, and real estate purchases, and without an acceptance of the offer there would be no purchase).

The examiner asserts it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Stoecker to include presenting offers to purchase electronic devices and receiving acceptance of the offers as taught in RMS. Such a combination would have been obvious to provide users a way to get money for their phone when they may be unusable or can be refurbished (RMS, Pg. 1). Moreover, such a combination would have been obvious since the claimed invention is merely a combination of old elements and in the combination each element would have performed the same function as in combination, and one of ordinary skill in the art would have recognized that such a combination would have yielded predictable results. Including such steps in Stoecker would have been advantageous because Stoecker discloses that a user can view test results for their device (See [0017]). Providing users with the option to sell a device that may be in poor condition would have increased user convenience and efficiency, as the kiosk in Stoecker can already be placed in retail stores. Therefore, it would have been obvious to retain the device at the kiosk after the transfer of data so that the kiosk owners would be able to keep the phone that they paid for, and a user would be offered cash in exchange for their device.

(B) Stoecker does not explicitly disclose <u>a second electrical connector outside the inspection area; receiving, from the user a second electronic device; and transferring personal</u>

data from the first electronic device; and relinquishing the second electronic device to the user after transferring the data.

Analogous reference Turner discloses a unit that can be used at a telephone dealer's premises. Turner discloses **a first electrical connector and a second electrical connector; receiving, from a user, a first electronic device; electrically inspecting the first electronic device via the first electrical connector; receiving, from the user, a second electronic device; and transferring personal data from the first electronic device via the first electrical connector to the second electronic device via the second electrical connector; and relinquishing the second device to the user after transferring the data** at FIG. 1; Col. 2, Ln. 54-67; Col. 3, Ln. 7-33 ("When a user returns a faulty telephone to the dealer... the dealer can use the data transfer unit to transfer the configuration information from the faulty telephone to a replacement telephone" and describing the dealer connecting the first electronic device to the first connector and inspecting the phone's stored memory to determine the model and type, then controlling the functions of the first device); Col. 4, Ln. 1-14 (relinquishing the replacement telephone to the user.

The examiner asserts that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Stoecker, in combination with RMS, to include a first electrical connector and a second electrical connector; receiving, from a user, a first electronic device; electrically inspecting the first electronic device via the first electrical connector, transferring personal data from the first electronic device via the first electrical connector to the second electronic device via the second electrical connector; and relinquishing the second device to the user after transferring the data, as taught in Turner. Such a combination would have been

obvious because of the motivation to allow a user to transfer personal data from one electronic device to replacement electronic device, which would increase customer satisfaction and convenience (Turner, Co. 1, LN. 22-28 and Col. 3, Ln. 7-12). Incorporating such functions in Stoecker would have been advantageous since Stoecker provides a kiosk that tells a user how their device is functioning, and that the kiosk could be placed at a retail store. For instance, if the user found out that his/her device were performing poorly and the device is under warranty, he/she could transfer their personal preference and other information from the faulty device to a new replacement device, as taught in Turner. This would greatly increase efficiency, convenience and sales. Retaining the first device and relinquishing the second device would have been obvious because of the motivation to keep the faulty device for refurbishing, resale or recycling (Turner, Col. 3, LN. 13-32, RMS, Pg. 1) and relinquishing the second device to the user after transferring the data would have been obvious so that the user can use the new replacement phone with their personal data.

(C) Stoecker, in combination with RMS and Turner, does not explicitly disclose that the first electrical connector is within the inspection area and the second electrical connector is outside the inspection area.

Stoecker does disclose a test fixture within a kiosk for inspecting a device. Turner discloses a mechanism for transferring data between devices that includes two electrical connectors, the first electrical connector connected to a first device and configured to inspect the first device, and a second electrical connector configured to connect to a second electronic device, and transferring personal data between the first and second devices. The examiner asserts that it would have been obvious to merely arrange the elements so that one of the cables

of Turner is within the inspection area of Stoecker, for instance, within the testing fixture, while a store clerk has the other connector and transfer device of Turner right outside of the testing fixture, and one of ordinary skill in the art would have recognized that such a simple arrangement of elements would have been obvious and there would be no unexpected result by having one electrical connector within an area where a device is inspected and another right outside. See MPEP 2144.04. This would increase convenience and efficiency as the device under test would not have to be held or moved.

As per claim 22, the combination of Stoecker, RMS and Turner discloses the limitations of claim 21. The combination further discloses **wherein the first electronic device is a mobile phone; and the second electronic device is a mobile storage device** at Turner, Col. 2, Ln. 54 - Col. 3, Ln. 33 (first electronic device is a mobile phone and second electronic device is data transfer unit which has a memory or a replacement mobile phone).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination to include wherein the first electronic device is a mobile phone; and the second electronic device is a mobile storage device, as taught in Turner because of the motivation to transfer personal information from a faulty device to a new replacement device (Turner, Col. 3, Ln. 7-12).

As per claim 23, the combination of Stoecker, RMS and Turner discloses the limitations of claim 21. The combination further discloses **wherein the first electronic device is a mobile phone and the second electronic device is a second mobile phone** at Turner, Col. 2, Ln. 54 -

Col. 3, Ln. 33 (first electronic device is a mobile phone and second electronic device is data transfer unit which has a memory or a replacement mobile phone).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination to include wherein the first electronic device is a mobile phone; and the second electronic device is a mobile storage device, as taught in Turner because of the motivation to transfer personal information from a faulty device to a new replacement device (Turner, Col. 3, Ln. 7-12).

As per claim 25, the combination of Stoecker, RMS and Turner discloses the limitations of claim 21.

The combination further discloses **dispensing cash to the user at the kiosk** at RMS, Pg. 1 (cash is given to a user at the kiosk).

While RMS does not explicitly disclose dispensing cash to the user at the kiosk after receiving acceptance of the offer, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination, which includes offering to purchase an electronic device and receiving acceptance of the offer, to further include dispensing the cash to the user at the kiosk after receiving the acceptance of the offer so that a user receives the money that he/she agreed upon as payment for the electronic device. Moreover, the examiner asserts that it is well known to pay for an item that a user has agreed to sell and to wait to pay for an item until after an acceptance of the offer amount has been received, e.g., at pawn shops, car dealerships and real estate deals.

20. **Claim 24** is rejected under 35 U.S.C. § 103(a) as being unpatentable over Stoecker, RMS and Turner, and in further view of Ninomiya et al. (JP 2003/230229 (A)), hereinafter "Ninomiya").

The combination of Stoecker, RMS and Turner discloses the limitations of claim 24. The combination does not explicitly disclose transferring the personal data from the first electronic device via the first and second electrical connectors to the second electronic device while the user is prevented from accessing the first electronic device.

The combination does disclose a kiosk for inspecting an electronic device, and transferring personal data from a first electronic device to a second electronic device via electronic connectors.

Analogous reference Ninomiya discloses a kiosk that transfers data from a first device (the mobile phone) to a second electronic device (the kiosk computer) via a connector **while the user is prevented from accessing the first electronic device** at Abstract, Drawing on the First Page (Showing a drawer for enclosing and locking the first electronic device while the device is charged, where the examiner asserts that data regarding the charging of the device would be transmitted, as well as the data to charge the device).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination to include transferring data from the first electronic device via the first and second electrical connectors to the second electronic device *while the user is prevented from accessing the first electronic device*, as taught in Ninomiya. Such a combination would have been obvious because of the motivation to increase security (Ninomiya, Abstract). Such a combination would have also been advantageous to increase safety as an electronic

device hooked to electronic connectors and receiving data is not safe for users to unplug the device early, which could damage the devices.

21. **Claim 26** is rejected under 35 U.S.C. § 103(a) as being unpatentable over Stoecker, RMS and Turner, and in further view of Taylor.

As per claim 26, the combination of over Stoecker, RMS and Turner discloses the limitations of claim 21. The combination does not explicitly disclose automatically disconnecting the first electrical connector from the electronic device after receiving the acceptance of the offer.

The combination does disclose a kiosk having an electrical connector for connecting an electronic device for electrical inspection and disconnecting the device (Stoecker, [0023]). The combination further discloses receiving acceptance of an offer to purchase an item including electronic equipment (Banerjee).

Analogous reference Taylor discloses a kiosk having a connector for connecting an electronic device (see FIG. 1) and discloses that it was known in the art before the invention to **automatically disconnect an electrical connector from an electronic device** at [0046] ("Once the data has been transmitted to the kiosk, the PCA substrate (430) is moved away from the data port (700) of the data storage device (120) thus disconnecting the connector (420) from the data port (700) of the data storage device (120)").

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination to include the concept of automatically disconnecting an electrical connector from the electronic device as taught in Taylor, in order to decrease human

error and damage (Taylor, [0036]). Moreover, MPEP 2144.04 and *In re Venner* state that automating a manual activity is obvious when the automation would not yield a different result.

The examiner asserts it would have further been obvious to disconnect the electrical connector from the electronic device after receiving acceptance of the offer, so that the device can be retained by the AVM/kiosk and the AVM/kiosk can accept the next item.

22. **Claims 27-30** are rejected under 35 U.S.C. § 103(a) as being unpatentable over Banerjee in view of Stoecker, SimplySellular (for motivation), and Boutsikakis.

As per claim 27, Banerjee discloses a computer-implemented method for recycling consumer electronic devices (see [0028] (presenting items for sale at vending machine, to be resold); [0030] (items include "camera equipment" and "electronic equipment"); [0063-64] (kiosk and method controlled by computer) comprising:

providing a kiosk at [0007] (automated vending machine ("AVM")), **wherein the kiosk includes—**

a housing at [0007]; FIG. 9 (showing housing); [0030-31]**;**

an inspection area within the housing at [0031] (items are place in a common receptacle); see also [0028] and [0043] (items are inspected when in the AVM), **and**

a storage receptacle within the housing at [0031], [0033] (items are moved to storage compartments); FIG. 9 (showing compartments)**;**

receiving, from a user of the kiosk, an electronic device at [0030-31] (items are received into the AVM; items include camera/electronic equipment)**;**

presenting, to the user, an offer to purchase the electronic device at [0034] and [0068] (vending machine makes an evaluation/appraisal of what it is willing to pay for the item and the

"seller 101-102 can receive an appraisal", where the price the AVM is willing to pay is interpreted as an offer); see also [0071] ("A seller 101-102 can receive an offer for purchase of the item"); **and**

moving the electronic device to the storage receptacle at [0031], [0033] (items are moved to compartments).

(A) Banerjee does not disclose <u>an electrical connector within the inspection area</u> of the kiosk or <u>electrically inspecting the electronic device via the electrical connector while the electronic device is in the inspection area.</u>

Banerjee does disclose a kiosk for accepting items for purchase, including electronic equipment, and evaluating a price that the kiosk is willing to pay for the item, the price based on the condition of the received item (see [0034]).

Analogous reference Stoecker discloses a kiosk for inspecting electronic equipment. The kiosk includes **an electrical connector within an inspection area** at [0021] ("One or more imaging device connections 42 may be provided, including wired connections such as Universal Serial Bus (USB) cables, etc, … One or more test fixtures 46 are provided, enabling an imaging device to be tested at the kiosk"); see also [0023] ("The user brings 70 an imaging device to a kiosk, places 72 the imaging device in the kiosk and connects the imaging device according to instructions provided by the kiosk"); see also [0012] (imaging device includes mobile phone) and [0015] (number of different connectors); **and electrically inspecting the electronic device via the electrical connector while the electronic device is in the inspection area** at [0023] ("The kiosk performs 82 the tests and displays the results to the user … The user disconnects 84 the imaging device and is finished"); see also [0013] and [0017] (testing the device's condition).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the kiosk of Banerjee to include an electrical connector within the inspection area and the step of electrically inspecting the electronic device via the electrical connector while the electronic device is in the inspection area as taught in Stoecker. Banerjee discloses appraising an item's value based on its condition, and accepting electronic equipment for purchase. Stoecker discloses a method/system for evaluating the condition of electronic equipment. Analogous reference SimplySellular provides a motivation as to why it would have been obvious to combine Banerjee and SimplySellular: so that a fair and accurate price can be determined based on the condition of electronic equipment, including how the device functions and works (see SimplySellular, Pg. 1, "Simply Sellular may make an offer for 75, 50, 25, or 0 percent of the original value of the handset based on the handset's condition and its resale value). Additionally, electronically inspecting the electronic device using a connector would have been advantageous to Banerjee which receives a description for an item. Evaluating the results of an electrical inspection of a device would reduce fraud. Additionally, providing such functionality at the kiosk while the device is in an inspection area would have been obvious because of the motivation to decrease inconvenience and inefficiency as it would eliminate the need for the device to be delivered to a facility for testing (Stoecker, [0004]). Such a combination would have also been obvious under *KSR* Rationale A since the combination of is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately (the kiosk in Banerjee, the connector in Stoecker) and one of ordinary skill in the art would have recognized that such a combination would have yielded predictable results.

(B) Banerjee does not *explicitly* disclose receiving, from the user, an acceptance of the offer. Banerjee does disclose providing an appraisal value to the user from the AVM that the AVM is willing to pay for the received item (see [0034]) and then dispensing cash for the item (see [0034]). Additionally, sellers and purchasers can negotiate a purchase price for an item online, then buyer would transfer money to the seller when the item has been picked up (see [0073], [0078], and [0087]).

The examiner asserts that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Banerjee to include receiving, from the user, an acceptance of the offer. Such a combination would have been obvious because of the advantage to give the user a choice whether he/she would like to sell an item, thereby increasing customer satisfaction. Moreover, the examiner asserts that offer and acceptance are well-known economic practices when purchasing and selling an item, e.g., including pawn shops, car dealerships, and real estate purchases. Therefore, it would have been obvious to receive acceptance of the offer before payment; without it, there would be no agreement from the seller to sell and give up their item.

(C) Banerjee does not explicitly disclose erasing personal data from the electronic device via the electrical connector after receiving acceptance of the offer; and moving the electronic device to the storage receptacle after erasing the personal data.

Combined reference Stoecker, which discloses the electrical connector, discloses acquiring data from the electronic device via the electrical connector; and transferring the data to a remote storage location (see [0023] ("The kiosk transmits 86 data about the imaging device

such as the model, test results and kiosk location to the server for storage and logging”). Stoecker does not disclose erasing personal data from the device via the connector.

However, analogous reference Boutsikakis discloses that it was known in the art before the invention to **erase personal data from an electronic device via an electrical connector** at [0070-71] (“the device may be programmed to erase the data after it has been transmitted and stored in the new device"); see also [0033], [0045], FIG. 3A-3C.

The examiner asserts that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Banerjee, in combination with Stocker, to further include erasing personal data from the electronic device via the electrical connector as taught in Boutsikakis. Such a combination would have been obvious because of the motivation to erase data from an old device when a user gets a new device (Boutsikakis, [0070]) and to manage the erasing of copyrighted data, thereby decreasing liability (Boutsikakis, [0071]). It would have been obvious to incorporate this functionality in Banerjee because a user is turning in their electronic equipment for sale to others and may not want their personal information left on the phone such as their address or contacts. Erasing the data would increase privacy. Moreover, using a connector to erase data is a “convenient way for a user to transmit either all or selected portions of information from one device to another” (Boutsikakis, [0014]), thereby enhancing efficiency and customer convenience.

Banerjee does not explicitly disclose erasing the data <u>after receiving acceptance of the offer</u> and moving the electronic device to the storage receptacle <u>after erasing the personal data.</u>

However, as shown above, it would have been obvious to erase personal from a user’s electronic device that is turning their device into the kiosk to be sold and that it would have been

obvious to receive acceptance of an offer. Banerjee discloses that the item/device is transferred to a storage receptacle after it is purchased. The examiner asserts that it would have been obvious to one having ordinary skill in the art at the time of the invention to erase the data after receiving acceptance of the offer so that a user would not lose their stored information until after they have agreed to relinquish and sell the phone. Otherwise, the user would be reluctant to place the item in the AVM. This would reduce the risk of losing a user's data greatly. Also, it would have been obvious to move the device to the storage receptacle after erasing the personal data, so that the device will not have to be retrieved back from storage and the information erased later but could be transferred when the device is received, thereby increasing customer convenience and efficiency.

As per claim 28, the combination of Banerjee, Stoecker, SimplySellular and Boutsikakis discloses the limitations of claim 27. Banerjee does not explicitly disclose <u>wherein the electronic device is a mobile phone.</u>

Banerjee does discloses accepting items such as electronic equipment (see [0030).

Combined reference Stoecker, which also discloses accepting electronic items, further discloses **wherein the electronic device is a mobile phone** at Stoecker, [0012] ("mobile phone").

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination to include that the electronic device is a mobile phone as shown in Stoecker in order to increase the types of items that could be received and resold, thereby increasing potential users and profit. Moreover, it would have been obvious to simply substitute the electronic equipment of Banerjee with a mobile phone of Stoecker, and one of

ordinary skill would have recognized that such a combination would have yielded predictable results.

As per claim 29, the combination of Banerjee, Cooke and Boutsikakis discloses the limitations of claim 27. The combination does not explicitly disclose wherein erasing the personal data from the electronic device via the electrical connector includes erasing the personal data from the electronic device via the electrical connector while the user is prevented from accessing the electronic device.

As shown in claim 27, the combination does disclose transferring personal data from an electronic device via an electronical connector, receiving acceptance of an offer. The combination also discloses analyzing an item and preventing a user from accessing the electronic device (see Banerjee, [0031], [0034], [0043]).

Banerjee discloses purchasing an item from a user. The item is received and payment is dispensed ([0034]). The item is then stored in the AVM (Banerjee, [0031], [0034], [0043]). The combination further discloses that it would have been obvious to accept an offer before dispensing payment, transferring data while the user is at the kiosk (Stoecker), and the need to erase personal data from a device (Boutsikakis).

It would have been obvious to one having ordinary skill in the art at the time of the invention to prevent a user from accessing the electronic device after acceptance of the offer. The examiner asserts that it would have been common sense not to let a user have access to the item that they just sold at a vending machine that purchased the item. Otherwise, the user could take it back and the vending machine would lose money. It would also have been obvious to not erase data from the device while the user is at the kiosk and not until after a user has agreed to

sell the device in case the user wants to not sell the device and continue to use the device. Doing so would ensure that data is not erased prematurely. Therefore, the examiner asserts that it would have been obvious to erase the personal data from the electronic device via the electrical connector after receiving the acceptance of the offer and while the user is prevented from accessing the electronic device to increase efficiency and prevent fraud. Moreover, the mere rearrangement of steps would have been obvious because the order of the steps would not change the end result. See MPEP 2144.04 and *In re Burhans* (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results).

As per claim 30, the combination of Banerjee, Stoecker, SimplySellular and Boutsikakis discloses the limitations of claim 27. Banerjee further discloses **dispensing cash to the user at the kiosk** at [0034] (dispensing cash); [0078-79] (seller accepts AVM's payment to purchase the item, kiosk dispenses cash).

Banerjee does not explicitly disclose dispensing cash to the user at the kiosk <u>after receiving the acceptance of the offer.</u>

However, the examiner asserts that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination include dispensing the case after receiving the acceptance of the offer. Such a combination would have been obvious because of the advantage that doing so would prevent the user from taking the money without having agreed to sell or give up their device, thereby saving money and fraud. Moreover, the examiner asserts that it is well known to wait to pay for an item until after an acceptance of the offer amount has been received, e.g., at pawn shops, car dealerships and real estate deals.

Therefore, it would have been obvious to receive acceptance of the offer before payment; without it, there would be no agreement from the seller to sell and give up their item.

23. **Claim 31** is rejected under 35 U.S.C. § 103(a) as being unpatentable over Banerjee, Stoecker, SimplySellular and Boutsikakis, and in further view of Taylor.

As per claim 31, the combination of Banerjee, Stoecker, SimplySellular and Boutsikakis discloses the limitations of claim 27. The combination does not explicitly disclose automatically disconnecting the first electrical connector from the electronic device after receiving the acceptance of the offer.

The combination does disclose a kiosk having an electrical connector for connecting an electronic device for electrical inspection and disconnecting the device (Stoecker, [0023]). The combination further discloses receiving acceptance of an offer to purchase an item including electronic equipment (Banerjee).

Analogous reference Taylor discloses a kiosk having a connector for connecting an electronic device (see FIG. 1) and discloses that it was known in the art before the invention to **automatically disconnect an electrical connector from an electronic device** at [0046] ("Once the data has been transmitted to the kiosk, the PCA substrate (430) is moved away from the data port (700) of the data storage device (120) thus disconnecting the connector (420) from the data port (700) of the data storage device (120)").

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination to include the concept of automatically disconnecting an electrical connector from the electronic device as taught in Taylor, in order to decrease human

error and damage (Taylor, [0036]). Moreover, MPEP 2144.04 and *In re Venner* state that automating a manual activity is obvious when the automation would not yield a different result.

The examiner asserts it would have further been obvious to disconnect the electrical connector from the electronic device after receiving acceptance of the offer, so that the device can be retained by the AVM/kiosk and the AVM/kiosk can accept the next item.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DELAINE DUNCAN whose telephone number is (571)270-5234. The examiner can normally be reached on 8:30 am - 5:00 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DELAINE DUNCAN/
Examiner, Art Unit 3689

/JANICE MOONEYHAM/
Supervisory Patent Examiner, Art Unit 3689