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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES PATTERSON and NATHAN MOODY

Appeal 2016-004967
Application 13/103,813
Technology Center 2100

Before JOHN A. JEFFERY, MELISSA A. HAAPALA, and
KAMRAN JIVANI, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 1–27. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellants' invention allows third parties to make executable extensions or “add-ons” to electronic books available to users. In one aspect, the extensions interact with content to provide related functionality. *See generally* Abstract; Spec. ¶¶ 2, 73, 102. Claim 1 is illustrative:

1. An electronic book reader, comprising:

an ordering subsystem configured to obtain an electronic book and an executable extension providing functionality relating to the electronic book,

wherein the electronic book is published by a first publisher and executable extension is published by a second publisher that is different from the first publisher;

an annotation subsystem, operably coupled with the ordering system, configured to associate the executable extension with the electronic book; and a display subsystem configured to display a portion of the electronic book including content with which the executable extension can interact, the display subsystem further configured to launch the executable extension, wherein the executable extension interacts with the content to provide functionality related to the content.

THE REJECTIONS

The Examiner rejected claims 1–6 and 8 under 35 U.S.C. § 102(e) as anticipated by Ho (US 2011/0087955 A1; Apr. 14, 2011). Final Act. 2–5.¹

The Examiner rejected claim 7 under 35 U.S.C. § 103(a) as unpatentable over Ho and Taub (US 2008/0317346 A1; Dec. 25, 2008). Final Act. 6.

The Examiner rejected claims 9–14, 17–23, and 26 under 35 U.S.C. § 103(a) as unpatentable over Ho and Pallakoff (US 2012/0147055 A1; June 14, 2012). Final Act. 6–10.²

¹ Throughout this Opinion, we refer to (1) the Final Rejection mailed October 1, 2014 (“Final Act.”); (2) the Appeal Brief filed May 20, 2015 (“App. Br.”); (3) the Examiner’s Answer mailed February 26, 2016 (“Ans.”); and (4) the Reply Brief filed April 7, 2016 (“Reply Br.”).

² There is a typographical error in the header of this rejection. Although claims 15 and 24 are listed in the summary paragraph, the body of the rejection does not include these claims.

The Examiner rejected claims 15 and 24 under 35 U.S.C. § 103(a) as unpatentable over Ho, Pallakoff, and Auguste (US 2012/0001844 A1; Jan. 5, 2012). Final Act. 10–11.

The Examiner rejected claim 27 under 35 U.S.C. § 103(a) as unpatentable over Ho, Taub, and Auguste. Final Act. 11–12.

The Examiner rejected claims 16 and 25 under 35 U.S.C. § 103(a) as unpatentable over Ho, Pallakoff, and Taub. Final Act. 12.

THE ANTICIPATION REJECTION

The Examiner finds that Ho’s electronic book (“e-book”) reader has every recited element of claim 1 including the recited display subsystem where an executable extension interacts with content to provide content-related functionality. Final Act. 3–4. According to the Examiner, as the reader moves to a certain page or section in Ho’s e-book, an audio file is played automatically. Final Act. 3.

Appellants argue that Ho does not disclose an executable extension that interacts with content to provide content-related functionality as claimed. App. Br. 7–8; Reply Br. 2–4. According to Appellant, because Ho displays predetermined annotations that are independent from the displayed e-book content, they do not interact despite their simultaneous display. App. Br. 9–10; Reply Br. 2–4. Appellants add that because Ho’s annotations and content are “separate and static,” the content/functionality of each is not changed by the presence of the other and, therefore, there is no interaction with the content. Reply Br. 4.

ISSUE

Under Section 102, has the Examiner erred in rejecting claim 1 by finding that the display subsystem of Ho's e-book reader is configured to launch an executable extension that interacts with content to provide functionality related to the content?

ANALYSIS

We begin by construing the key disputed limitation of claim 1 reciting, in pertinent part, that the executable extension *interacts* with the content to provide content-related functionality. Our emphasis on “interacts” underscores that this dispute turns on the meaning of this word.

The Specification does not define the term “interact,” unlike other terms whose definitions leave no doubt as to their meaning. *See, e.g.*, Spec. ¶¶ 116–18 (defining “one embodiment,” “comprises,” “including,” “or,” “a,” “an,” etc.). To be sure, paragraph 102 of the Specification describes various interactions that are used between an add-on and an e-reader device including, in various embodiments, (1) reading attributes of the current book in which the add-on is running; (2) initial launch conditions; (3) read/write services (e.g., optical recognition to “read” sheet music, and audio streaming to play the corresponding audio); and (4) UI interactions. On page 8 of the Reply Brief, Appellants refer to paragraph 35 of the Specification that describes an embodiment where an extension reads a passage of displayed sheet music, and provides an audio rendition of that music. Although these various exemplary interactions inform our interpretation of the term “interact” in the context of the disclosed invention, the term is not so limited.

The term “interaction” is defined, in pertinent part, as “[t]he act or state of two or more entities influencing each other.” Steven M. Kaplan, *WILEY ELECTRICAL & ELECTRONICS ENGINEERING DICTIONARY* 380 (2004). Indeed, this mutual influence associated with interaction is not limited to electrical engineering, but arises in many different situations—even patent prosecution. *See In re Cuozzo Speed Technologies, LLC*, 793 F.3d 1268, 1286 (Fed. Cir. 2015) (noting that examiners and applicants *interact* during examination to define the invention to distinguish prior art).

Given this plain meaning, we see no error in the Examiner’s reliance on Ho’s functionality in paragraph 75 that plays audio files, such as mp3 annotations, when an e-book page is read. Notably, as the reader moves to a *certain page or section*, an audio file is played automatically. Ho ¶ 75. Because the executable extension that plays the audio file is influenced by content *associated with a certain page or section* by triggering playback responsive to displaying those particular pages or sections, the extension effectively interacts with that content. Moreover, the content associated with a certain page or section is likewise influenced by the extension by augmenting that content with audio annotations.

So even assuming, without deciding that Ho’s audio annotations are predetermined and distinct from the displayed e-book content as Appellants contend (App. Br. 8), nothing in the claim precludes their interaction under the term’s broadest reasonable interpretation. Appellants’ arguments to the contrary (App. Br. 7–8; Reply Br. 2–4) are unavailing and not commensurate with the scope of the claim.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 1, and claims 2–6 and 8 not argued separately with particularity.

THE OBVIOUSNESS REJECTION OVER HO AND PALLAKOFF

We also sustain the Examiner's obviousness rejection of claims 9–14, 17–23, and 26 over Ho and Pallakoff. Final Act. 6–10. Because Appellants (1) reiterate Ho's alleged shortcomings regarding the recited extension that interacts with the content, and (2) add that Pallakoff does not cure those purported deficiencies (*see* App. Br. 8–9; Reply Br. 4–5), we are not persuaded by these arguments for the reasons previously discussed.

THE OBVIOUSNESS REJECTION OVER HO, TAUB, AND AUGUSTE

We also sustain the Examiner's obviousness rejection of claim 27 over Ho, Taub, and Auguste. Final Act. 11–12. Claim 27 recites that the content with which the extension can interact is sheet music, and the functionality related to the content is providing audio playback corresponding to the sheet music. Despite Appellants' arguments to the contrary (App. Br. 9–10; Reply Br. 5–6), we see no error in the Examiner's reliance on the cited references' collective teachings in this regard. As noted previously, Ho's system plays an audio file automatically as the reader moves to a certain e-book page or section in paragraph 75. Moreover, Auguste teaches that e-book readers can display sheet music in paragraphs 1 and 7.

Given these collective teachings, then, playing audio corresponding to sheet music displayed at certain pages or sections of an e-book as the Examiner proposes (Final Act. 12; Ans. 4) would have been at least an obvious variation. Appellants' arguments regarding Auguste's individual shortcomings in this regard (App. Br. 9–10) do not show nonobviousness

where, as here, the rejection is based on the cited references' collective teachings. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Appellants' contentions that the cited prior art does not teach or suggest the recited interaction (Reply Br. 5–6) are likewise unpersuasive for the reasons previously discussed.

THE OTHER OBVIOUSNESS REJECTIONS

We also sustain the Examiner's obviousness rejections of claims 7, 15, 16, 24, and 25. Final Act. 6–10, 12. Because these rejections are not argued separately with particularity, we are not persuaded of error in these rejections for the reasons previously discussed.³

CONCLUSION

The Examiner did not err in rejecting (1) claims 1 and 6–8 under Section 102, and (2) claims 2–5 and 9–27 under Section 103.

DECISION

The Examiner's decision rejecting claims 1–27 is affirmed.

³ The Examiner omits claim 16 (from which claim 15 depends) in the rejection over Ho, Pallakoff, and Auguste, but instead rejects claim 16 over Ho, Pallakoff, and Taub (Final Act. 12). However, these inconsistencies are not contested and are, therefore, waived. *See Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir. 2008) (“When the appellant fails to contest a ground of rejection to the Board, . . . the Board may treat any argument with respect to that ground of rejection as waived.”).

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED