

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
RICHARD H. STERN

APPLICATION MADE SPECIAL

Serial No.: 11/166,991

Examiner: MOSSER, K.M.

Filed: 27 June 2005

Art Unit: 3715

For: MENTAL THERAPY METHOD FOR CATHARSIS OF NEGATIVE FEELINGS

AMENDMENT

Paper No. 16

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the fifth, non-final Office action mailed on 18 June 2008 (Paper No. 15) (No. 20080611), entry of the following amendments and remarks, and re-examination and re-consideration of the application, are respectfully requested. It is noted that this application has been **made special** by an order dated November 18, 2005.

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Robert E. Bushnell

For _____
Robert E. Bushnell
Reg. No. 27,774

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IN THE CLAIMS

Pursuant to 37 CFR §121(c), the claim listing, including the text of the claims, will serve to replace all prior versions of the claims, in the application.

Please amend claims 1, 3, 16, and 17 as follows:

1 1. (Currently Amended) A method for treatment of feelings of fear, anxiety,
2 helplessness, powerlessness, or vulnerability, caused by a prior adverse interpersonal
3 interaction, said method comprising the steps of:

4 (1) causing to be visibly displayed to, or perceived by, a first person an image
5 of an actual, living second person actually personally known to said first person, said
6 first person having, in respect to said second person, because of an actual prior adverse
7 interpersonal interaction between said first person and said second person, an initial
8 level of f feelings of fear, anxiety, helplessness, powerlessness, or vulnerability, as to
9 which said first person desires said treatment;

10 (2) causing to be visibly displayed to, or perceived by, said first person an
11 image of an object having an actual potential for harming the second person; and

12 (3) causing said image of said object to touch, become located within, or
13 become near said image of said second person in a manner such that said object
14 appears to harm said second person;

15 wherein each said image is embodied in a machine readable graphics file fixed in a tangible,
16 corporeal article of manufacture from which said image can be perceived, reproduced, or
17 communicated.

18 2. (Previously Presented) The method of claim 1, further comprising:

19 (a) repeatedly monitoring said first person's level of feelings of fear, anxiety,
20 helplessness, powerlessness, or vulnerability, by receiving and monitoring information
21 representative of said first person's blood pressure, pulse rate, or sweating;

22 (b) comparing said information from before and after causing said image of an object

23 to touch, become located within, or become near said image of said second person in a manner
24 such that said object appears to harm said second person, whereby an comparison result is
25 provided; and

26 (c) reiterating the step of causing said image of an object to touch, become located
27 within, or become near said image of said second person in a manner such that said object
28 appears to harm said second person, until said comparison result shows a predetermined
29 reduction of said first person's blood pressure, pulse rate, or sweating.

1 3. (Currently Amended) The method of claim 1 ~~wherein~~:

2 (a) wherein, prior to step 1 of claim 1, said first person has a first state of mind, said
3 first state of mind characterized by thought patterns constituting or representative of feelings
4 of fear, anxiety, helplessness, powerlessness, or vulnerability, or by a negative cathexis with
5 respect to said second person; and

6 (b) further comprising, after step 3 of claim 1, a step of: (4) transforming said first
7 state of mind of said first person ~~is transformed~~ to a second state of mind of said first person,
8 said second state characterized by thought patterns constituting or representative of a reduced
9 level of said feelings of fear, anxiety, helplessness, powerlessness, or vulnerability, or by an at
10 least partial discharge of said cathexis.

1 4. (Previously Presented) The method of claim 3 wherein said method further
2 comprises transforming said first state of mind so that, in said second state of mind, said first
3 person comes to feel that he or she has imposed retribution or vengeance on said second
4 person, said transforming occurring without said first person consciously believing that his or
5 her conduct has actually caused said second person to suffer an actual physical injury.

1 5. (Previously Presented) The method of claim 3 wherein at least part of each step is
2 carried out by a machine.

1 6. (Original) The method of claim 5 wherein said image of a second person and said
2 image of an object are each located on a computer display visible to said first person, said
3 computer display operatively coupled to a programmable processing unit operatively coupled
4 to a memory, said memory storing a computer program for carrying out said method of claim
5 5.

1 7. (Original) The method of claim 6 wherein said image of an object is embodied in an
2 animated graphics file, said file embodying an audiovisual work that is performed on said
3 computer display when said first person engages in a prespecified action on an input device
4 operatively coupled to said processing unit.

1 8. (Original) The method of claim 6 wherein said image of an object is translated on
2 said display so that said image of an object appears to touch or penetrate said image of said
3 second person, and then said image of said second person is transformed so that said second
4 person appears to be bleeding or sustaining a mutilation.

1 9. (Original) The method of claim 6 further comprising:
2 a step of logging on to the Internet; and
3 an Internet-implemented step of causing a payment to be made to a vendor; and
4 wherein at least one step of said method comprises transmitting a signal over the Internet
5 between the first person and the vendor.

1 10. (Previously Presented) The method of claim 6 wherein at least one step of said
2 method is preceded, accompanied, or followed by an audible rendition of a predetermined
3 phrase, mantra, or incantation that the first person personally selected.

1 11. (Original) The method of claim 10 wherein said predetermined phrase, mantra, or
2 incantation is selected with regard to helping overcome negative feelings caused by said prior

3 adverse interpersonal interaction between said first person and said second person.

1 12. (Original) The method of claim 1 wherein at least one step of said method is
2 preceded, accompanied, or followed by an audible rendition of a predetermined phrase,
3 mantra, or incantation that is selected with regard to helping overcome negative feelings
4 caused by said prior adverse interpersonal interaction between said first person and said
5 second person.

1 13. (Previously Presented) A method for treating a victim of spousal abuse, said
2 method comprising the steps of:

3 (1) causing to be visibly displayed to, or perceived by, a first person an image of an
4 actual second person, said second person a present or former spouse of said first person, said
5 first person a victim of spousal abuse by said second person, said first person having a first
6 mental state comprising feelings of fear, anxiety, powerlessness, vulnerability, or helplessness
7 caused by said spousal abuse;

8 (2) causing to be visibly displayed to, or perceived by, said first person an image of an
9 object having an actual potential for harming the second person;

10 (3) causing said image of an object to touch, become located within, or become near
11 said image of said second person in a manner such that said object appears to harm said
12 second person; and

13 (4) transforming said first mental state of said first person to a second mental state
14 comprising a reduction of said feelings of fear, anxiety, powerlessness, vulnerability, or
15 helplessness.

1 14. (Previously Presented) The method of claim 13 wherein at least one step is
2 preceded, accompanied, or followed by an audible rendition of a predetermined phrase that
3 has been selected for use in treating a victim of spousal abuse, said phrase selected with
4 regard to helping to alleviate feelings of fear, anxiety, powerlessness, vulnerability, or

5 helplessness caused by spousal abuse.

Claim 15. (Canceled)

1 16. (Currently Amended) A machine adapted for use in treating negative thoughts or
2 feelings, or a negative cathexis, of a first person with respect to a second person, said machine
3 comprising:

4 a selection unit comprising means for permitting a first person to select a photographic
5 image of an actual, living second person who is actually personally known to
6 said first person and with respect to whom said first person has, because of
7 actual, prior adverse interpersonal interactions between said first person and
8 said second person, negative thoughts or feelings, or a negative cathexis, for
9 which said first person desires treatment;

10 a person display unit that causes to be visibly displayed to, or perceived by, said first
11 person said image of a second person;

12 an object display unit for causing to be visibly displayed to, or perceived by, said first
13 person an image of an object having an actual potential for harming said second
14 person; [[and]]

15 a translator unit for causing said image of an object to touch, become located within, or
16 become near said image of said second person, in a manner such that said
17 object appears to harm said second person;

18 a sensor unit adapted to be operatively coupled to a body part of said first person, to
19 measure a magnitude of pulse rate, blood pressure, or another physiological
20 parameter representative of fear, anxiety, or stress, and to provide a sensor
21 output signal representative of said magnitude; and

22 a comparator operatively coupled to said sensor unit, adapted to receive said sensor
23 output signal, to compare said sensor output signal to a reference, and to
24 provide a comparator output signal representative of whether said sensor output

25 signal and said reference have a predetermined relationship;
26 where said person selection unit, said person display unit, said object display unit, and said
27 translator unit cooperate, based on said comparator output signal, to influence a reduction of
28 said negative thoughts or feelings, or an at least partial discharge of said negative cathexis.

1 17. (Currently amended) The machine of claim 16, further comprising a determination
2 unit for determining whether said comparator output signal has fallen below said reference by
3 a predetermined amount, ~~first person has undergone a reduction of said negative thoughts or~~
4 ~~feelings, or a reduction of said negative cathexis~~, and for again actuating an operation of said
5 translation unit unless said comparator output signal has fallen below said reference by said
6 predetermined amount. ~~a reduction of said negative thoughts or feelings, or a reduction of said~~
7 ~~negative cathexis, has occurred.~~

1 18. (Previously Amended) The machine of claim 17 further comprising a processing
2 unit operatively coupled to a memory in which is stored a computer program for operating or
3 effectuating said image display unit, said object display unit, said translator unit, and said
4 determination unit.

1 19. (Original) The machine of claim 18 further comprising a sound system operatively
2 coupled to said processing unit and, operatively coupled to said processing unit, an
3 incantation unit for causing said sound system to make a predetermined phrase, mantra, or
4 incantation audible during at least a portion of a time when said machine is operated.

Claims 20-23. (Canceled)

1 24 (Previously Presented). The method of claim 13, wherein the step of causing said
2 image of an object to touch, become located within, or become near said image of said second
3 person in a manner such that said object appears to harm said second person is performed by a

4 programmed machine acting in response to signals from an input device operated by said first
5 person, said method further comprising:

6 (a) repeatedly monitoring said first person's level of feelings of fear, anxiety,
7 helplessness, powerlessness, vulnerability, or negative thoughts or feelings, by receiving and
8 monitoring information representative of said first person's blood pressure, pulse rate, or
9 sweating;

10 (b) comparing said information from before and after causing said image of an object
11 to touch, become located within, or become near said image of said second person in a manner
12 such that said object appears to harm said second person, whereby a comparison result is
13 provided; and

14 (c) reiterating the step of causing said image of an object to touch, become located
15 within, or become near said image of said second person in a manner such that said object
16 appears to harm said second person, until said comparison result shows a predetermined
17 reduction of said first person's blood pressure, pulse rate, or sweating.

1 25 (Previously Presented). A storage medium encoded with machine-readable
2 computer code adapted for performing the method of claim 24.

REMARKS

STATUS OF CLAIMS

Claims 1-14, 16-19, and 24-25 are pending in the application. Claims 15 and 20 were previously canceled without prejudice or disclaimer of their subject matter, because of a restriction requirement. Claims 21 and 22 were canceled in the Amendment filed on 14 June 2007. Claim 23 is now cancelled.

CLAIM AMENDMENTS

Claims 1, 3, 16 and 17 are amended by this Amendment.

CLAIM REJECTIONS

I. 35 U.S.C. § 101 - statutory subject matter

Claims 1-14, 24 and 25

Claims 1-14, 24 and 25 stand rejected under 35 U.S.C. § 101 because the claimed invention is not supported by either a credible asserted utility or a well established utility.

A. Mental Steps

All independent method claims (claims 1 and 13) stand rejected under § 101 as being directed to mental steps, as are the dependent claims that depend from them. See *In re Comiskey*, 499 F.3d 1365 (Fed. Cir. 2007). The office action states that the steps of the claimed process cover subject matter not embodied in or operating on a statutory class of subject matter.

1. Amendment

Independent process claims 1 and 13 are amended in this Amendment to add the following phrase at the end of the claim: “wherein each said image is embodied in a machine readable graphics file fixed in a tangible, corporeal article of manufacture from which said image can be perceived, reproduced, or communicated.” It is respectfully submitted that the amendment overcomes the rejection.

2. Support for Amendment

The specification as filed stated:

[0070] The term “image” means a likeness or representation of a person, animal or thing. The term includes pictorial images such as those capable of being embodied in a graphics file (jpeg, gif, png, bmp, ico, ani, etc.) of a photograph, drawing, or other picture. References to providing, accepting, or selecting an image (and like expressions) refer to providing, selecting, etc. such a graphics file (such as a jpeg or gif), or a signal or machine-readable medium embodying or representative of such a file; or providing, selecting, etc. something from which the subject matter of the image can be perceived, reproduced, or communicated.”

The last clause of the quoted passage and also the final words of the amended claim language are based on 17 U.S.C. § 101, which refers to a copy as being fixed in a material object “from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”

The inventor submits that the amendment overcomes the rejection by adding the limitation that the process is operating on an article of manufacture, such as a jpeg stored in computer memory.

B. Reasonable Expectation of Success

The office action asserts that the claimed invention is not concrete because “to be concrete the result of the method must have a reasonable expectation of success,” and as allegedly shown by the Bushman article it is not reasonable to expect catharsis therapy to work.

Preliminarily, applicant challenges the correctness of the proposition that a § 101 rejection can be based on alleged lack of reasonable expectation of success. The Federal Circuit has held that property relevant only to obviousness. See, e.g., *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1354, 65 USPQ2d 1961 (Fed. Cir. 2003) (“A showing of obviousness requires a motivation or suggestion to combine or modify prior art references, coupled with a reasonable expectation of success.”). Nevertheless, applicant will address the issue on its factual merits.

1. First, the applicant respectfully submits that concreteness has nothing to do with predictability of success. Concreteness is just the opposite of abstractness. No more, no less. The Guidelines, incorporated into the MPEP, do not have the force of law. *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).¹ As the Board recently pointed out in *Ex Parte Bilski*, No. 2002-2257, 2006 WL 4080055 (BPAI Sept. 26, 2006), now under review by an en banc Federal Circuit: “The Board is not bound by such

¹ Accord *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1180 n. 10 (Fed. Cir. 1995) (the MPEP “does not have the force of law”); *Hoechst Aktiengesellschaft v. Quigg*, 917 F.2d 522, 526, 16 USPQ2d 1549, 1552 (Fed. Cir. 1990); *Glaxo Operations UK Ltd. v. Quigg*, 894 F.2d 392, 398-99, 13 USPQ2d 1628, 1632-33 (Fed. Cir. 1990); *Ethicon Inc. v. Quigg*, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154 (Fed. Cir. 1988).

guidelines, but applies the law directly to the facts.” *Bilski*, 2006 WL 4080055, *15. Moreover, the Interim Guidelines/MPEP remarks on concreteness are badly flawed, as the *Bilski* Board specifically pointed out (*id.* at *17). The *Bilski* Board held that “concrete” means tangible and not an abstract idea – “In our opinion, the terms ‘concrete and tangible’ essentially say the same thing, that the result is not just an ‘abstract idea,’ but is ‘actual and real.’” *Bilski*, 2006 WL 4080055, *17.² This corresponds to the dictionary plain meaning of the term. The *American Heritage Dictionary of the English Language* (4th ed. 2000) defines *concrete* as follows:

1. Of or relating to an actual, specific thing or instance; particular: had the concrete evidence needed to convict.
2. Existing in reality or in real experience; perceptible by the senses; real: concrete objects such as trees.

The language from the Interim Guidelines/MPEP relied upon to support this rejection is simply wrong. Since the PTO’s Board does not agree with the rejection, the applicant respectfully submits that the rejection should be withdrawn.

In point of fact, the claimed subject matter *is* concrete. It is not abstract. It is tangible, which as the *Bilski* Board points out is just another antonym of abstract. The fear, anxiety, and stress that the claimed method seeks to treat are real world problems and treatment thereof is a practical benefit to the treated person, not an abstraction. Such treatment, as described in claim 1, is in no way like converting BCD numbers to binary numbers or like the Pythagorean

² The Examiner’s statement that the MPEP rather than the Board’s *Bilski* opinion represents the view of the PTO and therefore should be accorded superior deference relative to the Board’s *Bilski* opinion is contradicted by the fact that the Commissioner, acting through the Solicitor, has sought to uphold the Board’s *Bilski* opinion in the Federal Circuit on the basis of the Board’s opinion..

Theorem, which are typical abstract ideas. The claimed subject matter is thus concrete and tangible.

Likewise, claim 13 is a method for treating a victim of spousal abuse who is afraid of, anxious about, etc. her abusive spouse. Again, treating that condition is useful and beneficial to the abused spouse. It is concrete and tangible rather than an abstract idea. Thus, the claimed method is concrete in the dictionary sense.

2. The office action asserts that the claimed method is not concrete because Bushman says that catharsis therapy does not work. But Bushman admits that he states a minority view, running against the majority view that catharsis therapy works. Moreover, Bushman's study that purports to show that catharsis therapy doesn't work is simply junk science. The PTO therefore cannot rely on Bushman to conclude that catharsis therapy lacks a reasonable expectation of success.

The PTO cannot conclude that catharsis theory is wrong (here, lacks a reasonable expectation of success) simply on the basis of the views of one side on a contested issue, much less on the basis of the minority side. It may somehow eventually be accepted that Bushman is right and Aristotle, Freud, and all the proponents of conventional wisdom are wrong. But the mere fact that there is a difference of opinion about the efficacy of a method (such as a medical regimen or drug) – where a substantial number (let alone, a majority, as here) of practitioners believe the method is efficacious and another number of practitioners believe the opposite – does not mean that the method lacks a reasonable expectation of success.

The burden is on the PTO to show non-entitlement to a patent, including lack of a reasonable expectation of success.³ That burden is not carried just by showing that a difference of opinion presently exists over efficacy or utility (especially where the view the PTO seeks to rely on is one opposed to conventional wisdom). Cf. *In re Brana*, 51 F.3d 1560, 1566 (Fed. Cir. 1995) (“[T]he PTO has the initial burden of challenging a presumptively correct assertion of utility in the disclosure. Only after the PTO provides evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince such a person of the invention's asserted utility.”).

The proper rule is that the PTO may reject an invention as unlikely to work only when accepted scientific theory clearly rejects the theory on which the claimed invention rests – for example, perpetual motion, which contravenes accepted thermodynamics and therefore is inherently implausible. See, e.g., *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1359 (Fed. Cir. 1999) (claims found inoperable because they require violating the principle of conservation of mass); *Newman v. Quigg*, 877 F.2d 1575 (Fed. Cir. 1989) (claims to a perpetual motion machine ruled inoperable). Therefore, *Bushman* does not carry for the PTO

³ *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) (Plager, J., concurring); *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967); see also *In re Caveney*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985) (“[P]reponderance of the evidence is the standard that must be met by the PTO in making rejections.”).

its burden to show lack of reasonable expectation of success.⁴ Accordingly the rejection should be withdrawn.

Reliance on Bushman is also improper because it is methodologically defective. Bushman used a self-selected and biased sample. He used student volunteers from, his course who agreed to participate in his experiments in return for his undertaking to raise their grades in return doing so.⁵ That sample is clearly not representative of the general population.

To rely on Bushman here is comparable, in a notional case where a claimed machine relies on the theory of conservation of energy, to basing a rejection for lack of reasonable expectation of success on the views of Newman in the *Newman* case.⁶ Junk science and

⁴ There is no showing in the record that Bushman’s “cognitive neoassociationist” theory is generally accepted in the scientific community in preference to the Freudian catharsis theory. To the contrary, Bushman (at 725) concedes that the catharsis theory is generally accepted and that his own “myth buster” views reflect a minority theory. Thus, in *In re TMI Litigation*, 193 F.3d 613 (3d Cir. 1999), the Third Circuit excluded as methodologically unreliable expert testimony that relied on a novel approach to air modeling. *Id.* at 669. The court noted that in formulating his “plume dispersion” hypothesis, the expert discarded standard and generally accepted models in favor of his novel model for which there was no indication of general acceptance within the scientific community. A fortiori generally accepted theories cannot be rejected as support for likelihood of success on the basis of theories without general acceptance.

⁵ The Bushman reference on which this rejection is based, was based on a non-random, biased, and therefore non-probative sample: Bushman stated that 602 college students enrolled in his psychology courses were given extra grade credit if they agreed to participate in his study; data from two women students were removed from the data sample because they were opposed to engaging in violent behavior. This is not a scientifically acceptable sample, and any resulting data is therefore unreliable.

⁶ The proper legal test was early indicated in *In re Gazave*, 379 F.2d 973 (CCPA 1967). The court held that in the usual case, as here, where the mode of operation alleged for the invention can be readily understood and conforms to known and generally accepted principles, it is not questioned that it works, and no evidence that it is likely to work is required. On the other hand, if the alleged invention seems clearly to conflict with a recognized scientific principle as, for example, where an applicant purports to have discovered a machine producing perpetual

aberrational views are not substantial evidence. This is an independent ground why the rejection should be withdrawn.

3. Even if Bushman were valid science instead of junk science, it would still not provide a basis for concluding that the instant invention lacks a reasonable expectation of success. The Bushman reference does not address the same thing that the invention addresses: it is a case of apples versus oranges – Bushman has an experimental model that does not correspond to the factual environment of the instant invention. Accordingly, Bushman’s work does not provide a reliable basis on which to extrapolate to conclusions about the instant invention. Therefore, Bushman does not show that this invention lacks a reasonable expectation of success.

Bushman, even if believed, shows only that punching a punching bag while “ruminating” about a person at whom the bag puncher is angry or resentful (because the person unfavorably criticized the bag puncher’s essay on abortion) is less effective in reducing the bag puncher’s anger or resentment than is his ruminating about increasing his physical fitness. The invention is about a form of treatment for an abused person (such as a victim of spousal abuse), where the treatment seeks to reduce such abuse-caused feelings as fear, anxiety, helplessness, powerlessness, and vulnerability. The treatment involves moving an image of a knife, axe, or the like on a screen so that it appears to strike and harm a screen image of the abusive person (such as the abusive ex-spouse). Whatever Bushman shows

motion, the presumption that it won’t work is strong and clear evidence is required to overcome it. Id. at 978.

about resentful or petulant essay writers, it fails to show anything about the fears and anxieties that intimidated, battered spouses feel, even if Bushman is believed valid within the artificial, essay-resentment fact pattern that it addresses. It is junk science under *Daubert v. Merrell Dow Pharmaceuticals*, 509 U.S. 579 (1993), to use Bushman’s experimental model to extrapolate from Bushman’s petulant essay writers resentful of such criticism as “this is the worst essay I ever read” to this invention’s treatment of intimidated, battered spouses afraid of husbands who beat them up. Bushman addresses a problem like a hangnail while the invention is concerned with, metaphorically, an abscess. What Bushman’s experimental model rightly or wrongly terms catharsis therapy is not the kind of catharsis therapy with which the instant invention is concerned. Resentment over harsh criticism of a student’s essay is not comparable to (and is not a proper experimental model for) feelings of fear, anxiety, helplessness, powerlessness, and vulnerability, as set forth in claims 1 and 13. Therefore, Bushman’s work cannot establish that the instant invention lacks a reasonable expectation of success for purposes of a rejection.

The inadequacy of Bushman’s model for showing the lack of a reasonable expectation of success of the present invention is comparable to what the Federal Circuit addressed in *Novartis Corp. v. Ben Venue Laboratories, Inc.*, 271 F.3d 1043, 1054, 60 U.S.P.Q.2d (BNA) 1836, 1844 (Fed. Cir. 2001). There, the Federal Circuit affirmed summary judgment of noninfringement because the patentee’s expert’s computer model could not properly defeat a noninfringement summary judgment where factual evidence was lacking to show that the expert’s computer model accurately reflected the accused infringer’s process. Here,

Bushman's model of the petulant essay writer cannot be shown to accurately reflect the circumstances of the abused spouse per the present invention.

Similarly, in *Alza Corp. v. Mylan Laboratories, Inc.*, 464 F.3d 1286, 1296-97, 80 U.S.P.Q.2d 1001, 1007-08 (Fed. Cir. 2006), the Federal Circuit upheld a noninfringement judgment because the patentee's evidence of infringement was based on a model or proxy for the factual setting of the alleged infringement that was not shown to mimic that factual setting. The Federal Circuit said that "one cannot simply proclaim without proof that he has constructed an apparatus capable of mimicking pertinent environmental variables of the GI tract." *Id.* Accordingly the Federal Circuit concluded that the patentee's evidence "is irrelevant absent evidence demonstrating that the in vitro system is a good model of actual in vivo behavior." *Id.* Bushman's model of the petulant student's essay, here, is to the circumstances of the present invention as was Alza's in vitro model to the defendant Mylan's in vivo accused GI tract – there is no evidence that the essay model fits the abused-spouse circumstances of the instant case. The Bushman model therefore proves nothing relevant to this case. See *General Elec. Co. v. Joiner*, 522 U.S. 136, 144-45 (1997) (expert studies based on data that was "so dissimilar to the facts presented in this litigation" are irrelevant and inadmissible).

Either of those two basic flaws in using Bushman to show lack of utility or lack of reasonable expectation of success here would suffice to prevent basing a rejection of this invention on it. The instant rejection is not supported and therefore it should be withdrawn.

II. Claim Rejections under 35 U.S.C. § 103 - obviousness

Claims 1, 13, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Virtual Voodoo Dolls” (webpost of “bumhat”, September 11, 2002).

A. The “bumhat” Reference Is Not Legitimate, Pertinent Prior Art and It Is Not a Printed Publication

The “bumhat” so-called reference is not pertinent prior art for purposes of an obviousness rejection. bumhat is just an email sent to a bulletin board called the Halfbakery, on which members post ideas (largely inchoate) about what they think would be “neat” technology if someone else would invent or develop it. It is not a serious psychotherapy journal, abstracted, indexed, and cataloged in a manner to make it accessible to persons of ordinary skill in the art trying to solve problems in the psychotherapy art to which this invention pertains.⁷ “A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006). There is no practicable way that a person of ordinary skill in the art — trying to solve the problem, for example, of how to treat an abused ex-spouse who suffers fear and anxiety because her ex-spouse used to beat her up — would be able to find bumhat and apply it to formulating a solution of this problem. It is thus not part of the pertinent prior art. Similarly it is not a “printed publication” within the meaning of § 102.⁸

⁷ It is assumed for present purposes that a person of ordinary skill in the art is a person with a degree in psychology or its equivalent, with little or no skill in engineering or computer science.

⁸ “[P]ublic accessibility’ has been called the touchstone in determining whether a

To be considered in an obviousness analysis, a reference must be either in the field of the applicant's endeavor or reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). It is necessary to use common sense in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. See *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979). It is *not* common sense to expect that a person seriously engaged in providing therapy to disturbed persons, such as abused spouses, would consult frivolous emails sent to the Halfbakery, even if they were abstracted, cataloged, and indexed in a way useful to therapists — which in fact they are not. There is no reasonable way to expect a person of ordinary skill in the art in this field to be aware of or know how to find bumhat. One can reconstruct the invention from bumhat only by impermissibly using hindsight. Thus, in the *Oetiker* case, the Federal Circuit held that “the combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness.” 977 F.2d at 1447. That is equally true here. To use bumhat to reconstruct this invention is to do what the *Oetiker* court forbade. Because bumhat is not in the relevant prior art, the rejection is unsupported and should be withdrawn.

B. The Specification Does *Not* Admit Prior Use of Voodoo As Therapy

reference constitutes a ‘printed publication’ bar under 35 U.S.C. § 102(b).” *In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986). Accord *In re Cronyn*, 890 F.2d 1158, 13 USPQ2d 1070 (Fed. Cir. 1989) (holding that an undergraduate thesis that is deposited in a college library open to the public but that is neither cataloged nor indexed is not a printed publication because it is not accessible to the public).

The office action states (p. 8) that “the applicant has admitted in paragraph 6 of the specification that the use of voodoo dolls is known for this type of treatment.” That is an incorrect characterization of paragraph 6. That paragraph is set out in its entirety below:

[0006] It is known that one form of anger-relieving cathartic activity or discharge of negative cathexis is sticking pins into dolls supposed by the user to represent a person toward whom the user has negative feelings. Thus, a person might want to stick pins into a doll simulating bin Laden, or in an earlier era Stalin or Hitler. Some persons apparently derive emotional benefits from sticking pins into dolls representative of football players from a team rival to the user’s hometown team. See Bettendorf U.S. Pat. No. 6,663,462 (2003), “Aggression-Relieving Stuffed Doll.” This patent’s specification asserts: “Sports fans often become quite agitated or even infuriated by the performance or antics of players on their favorite sports team or the opposing team. It is both entertaining and relieving for these sports fans to have an outlet by which to vent their emotion. Therefore, it would be desirable to have a stuffed doll that simulates a sports player into which sharp pins may be inserted.” This form of behavior relies on dolls or similar tangible physical objects, and has done so since ancient times. In this connection, actual assault and battery is, of course, illegal and is usually infeasible as a means of catharsis of fear and anger, for example, that caused by spousal abuse.

As stated in paragraph 6, sticking pins in dolls (not voodoo dolls) is known in various frivolous contexts, where it presumably has a “entertaining and relieving” — *but not therapeutic or treatment* — effect on the user. For example, the ’462 patent suggests sticking pins into dolls representative of players of a rival football team, to relieve aggression. The emotional benefits, if any, that some persons may derive from sticking pins into bin Laden or football-player dolls is not a serious form of therapy. As the ’462 patent suggests, this may be “entertaining.” But that does not suggest therapeutic use of this expedient, with reference to a serious therapeutic problem such as sexual, physical, or mental abuse. In any event, reading the above-quoted text makes manifest that it does not contain any admission by the inventor

of prior therapeutic use of voodoo. Indeed, elsewhere in the specification the inventor distinguishes voodoo from the invention because voodoo has psychological effects only on persons who actually believe in its efficacy (i.e., superstitious persons) while the invention has no such requirement. See, e.g., ¶¶ 8, 9, and 66.

The specification states, in ¶ 9, that transformations of the state of mind of the user occur both in the use of the invention and in engaging in voodoo or similar practices. But a transformation of this kind also may occur at times in watching classic tragedy (according to Aristotle). That does not mean, however, that tragedy or voodoo is used to try to bring about a therapeutic effect. Indeed, neither of them is customarily or purposefully used for therapeutic purposes or by persons seeking therapy. Any such effect, if it ever occurred (and it is not documented in the art of record that it did), would be purely accidental, unintended, incidental, sporadic, and unappreciated – and therefore not of any legal effect. See *Tilghman v. Proctor*, 102 U.S. 707, 711-12 (1881).

Further, all cited references to voodoo of record indicate its use by persons who actually believe in its efficacy and who use it in order to kill or injure their enemies. No cited use of voodoo is to treat persons such as traumatized spouses in order to try to alleviate their fear, anxiety, etc. resulting from prior abuse. Accordingly, there is no admission “that the use of voodoo dolls is known for this type of treatment,” because that proposition is not true on this record.

C. Important Features of the Process Can Be Supplied Only by Hindsight

The claimed process invention has many important features not found in bumhat, and also not found in voodoo. The office action attempts to supply some of these features, without even citing additional references in support. But, to the extent that the features are supplied, they are supplied only by reconstructing the invention by light of hindsight. There is thus a failure to show, as the PTO must, that it would have been obvious to a person of ordinary skill in the art (knowing what a person of ordinary skill in the art knew) to combine all the elements of the invention, as the inventor combined them, simply on the basis of having read bumhat without recourse to hindsight.

1. The Examiner makes the point that some distinguishing features of the invention “are each recitations of the intended use of the invention.” But claims 1 and 13 are process claims. The intended use of a process is a claim limitation that patentably distinguishes such an invention. Thus a new use of an old machine or process is patentable. 35 U.S.C. § 100(b); *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 13 (Fed. Cir. 2005) (“New uses of old products or processes are indeed patentable subject matter.”); *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1375 (Fed. Cir. 2001) (holding that a preamble statement of intended use is a limitation that patentably distinguishes a new use of an old apparatus or process). In this case, the references to intended uses are not mere statements extolling the benefits of or praising the claimed processes. Rather, they describe what the process does. They are therefore material limitations and patentably distinguish the claimed subject matter over the prior art. *Catalina Marketing Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809-10 (Fed. Cir. 2002).

Moreover, these statements of intended use give meaning and purpose to the manipulative steps of the claim. Without them a person reading the claim would not know what is the reason to perform the steps. See *Griffin v. Bertina*, 285 F.3d 1029, 1033–34, 62 USPQ2d 1431 (Fed. Cir. 2002); see also *Kropa v. Robie*, 38 C.C.P.A. 858, 187 F.2d 150, 152, 88 USPQ 478, 481 (1951) (holding that a preamble is limiting when it is “necessary to give life, meaning and vitality to the claims or counts”). In *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339 (Fed. Cir. 2003), the Federal Circuit explained that a statement of intended use limits a claim when, as here, “it recites not merely a context in which the invention may be used, but the essence of the invention without which performance of the recited steps is nothing but an academic exercise.” *Id.* at 1345. There would be no point in performing the steps of claim 1, for example, unless the user knew what the purpose of them was (i.e., treating fear, anxiety, etc.), as stated in the claim’s statements of intended use. Therefore, the statements of intended use must be considered and they patentably distinguish the invention over the cited art.

2. At most, bumhat can be relevant only for what it teaches. The major omissions in bumhat of distinguishing limitations recited in the claimed process include a failure to teach or suggest the intended treatment use of the present invention. For the reasons stated in the preceding paragraphs, under the Federal Circuit precedents cited above those statements are in fact material for patentably distinguishing the claimed subject matter over bumhat. The only claims explicitly rejected as obvious are 1, 13, 16, and 18. However, claims 23 and 24 are also mentioned in the discussion part of the rejection.

Claims 1 and 13

Turning to independent claim 1, step 1, bumhat does not teach or suggest displaying an image of a second person whose adverse personal interactions with a first person have caused an initial level of feelings of fear, anxiety, helplessness, powerlessness, or vulnerability as to which said first person desires treatment. What bumhat teaches is venting aggressive impulses of homicide – not treating them. The absence of the cited claim limitations, and the total failure of any art of record to suggest them, much less suggest their combination with the other elements of the invention, obliterate any possibility of sustaining an obviousness rejection based on bumhat. See *In re Lowry*, 32 F.3d 1579, 1584-85, 32 U.S.P.Q.2d 1031 (Fed. Cir. 1994) (both obviousness and anticipation rejections reversed because the cited reference did not disclose all limitations of claimed device.

The same limitations are part of step 1 of independent claim 13, so that the same principles apply to it.

Claim 16

Claim 16 is an independent machine claim rejected as obvious over bumhat. The claim is currently amended. bumhat does not disclose or suggest the features of the amended claim. The amendment adds these further elements and limitations:

a sensor unit adapted to be operatively coupled to a body part of said first person, to measure a magnitude of pulse rate, blood pressure, or another physiological parameter representative of fear, anxiety, or stress, and to provide a sensor output signal representative of said magnitude; and

a comparator operatively coupled to said sensor unit, adapted to receive said sensor output signal, to compare said sensor output signal to a reference, and to

provide a comparator output signal representative of whether said sensor output signal and said reference have a predetermined relationship;

In addition, the previously claimed cooperation among the previously recited modules (translator unit, etc.) is now recited to be based on the comparator output signal. (As ¶ 23 of the specification indicates, one form of such cooperation is that the translator unit keeps causing the weapon image to bash the abuser image until the comparator signal shows a 5% decrease in sensor output signal.)

Dependent claim 17 is also amended, so that it now reads:

The machine of claim 16, further comprising a determination unit for determining whether said comparator output signal has fallen below said reference by a predetermined amount, and for again actuating an operation of said translation unit unless said comparator output signal has fallen below said reference by said predetermined amount.

Support for these elements is found in the specification in paragraphs 21, 23, 55, and

58. For example, paragraph 23 states:

An individual user may also use any of a number of conventional electronic devices for determining reduction of stress by measuring a physiological parameter considered representative of stress, such as blood pressure, pulse rate, or palm-sweating. For example, blood pressure or pulse rate can be measured and monitored with many automatic measuring devices now on the market. The output of such a device is advantageously fed to processing unit 14, so that the process of the invention is repeated (for example, by using a conventional “while,” “do while,” or “do until” loop in the program) unless the device indicates an appropriate reduction of blood pressure or pulse rate (for example, 5%).

Nothing in bumhat refers to or suggests the use of a sensor for pulse rate, blood pressure, or other physiological parameter representative of fear, anxiety, or stress. Nor does anything in bumhat refer to or suggest repeating the simulated mutilation of the second person

unless a predetermined reduction (e.g., 5%) of pulse rate, blood pressure, or another physiological parameter representative of fear, anxiety, or stress of the first person has occurred and registers at the sensor. These features of the claimed machine patentably distinguish it from bumhat. The subject matter of the amended machine claims is not disclosed or suggested by bumhat, and therefore would not have been not obvious to a person of ordinary skill in the art from bumhat.

Claim 18

Claim 18 depends from claim 16. For the reasons stated above, claim 16 is not obvious and therefore its dependent claims are also not obvious. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.”).

Claims 23-25

Claim 23 was cancelled. Claims 24 and 25 depend from claim 13, which is not obvious for the reasons stated above. Therefore, these dependent claims are not obvious. *In re Fritch, supra*.

No other issues remaining, reconsideration and favorable action upon all of the claims now present in the application is respectfully requested. Should any questions remain unresolved, the Examiner is requested to telephone the applicant’s undersigned attorney.

No fee is incurred by this Amendment.

APPLICATION MADE SPECIAL
SN 11/166,991 – Paper No. 16

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Respectfully submitted,

Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 K Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

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