

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

RICHARD H. STERN

**APPLICATION MADE SPECIAL**

Serial No.: 11/166,991

Examiner: HARRIS, CHANDA L.

Filed: 27 June 2005

Art Unit: 3715

For: MENTAL THERAPY METHOD FOR CATHARSIS OF NEGATIVE FEELINGS

**AMENDMENT**

**Paper No. 9**

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

Sir:

In response to the second, non-final Office action mailed on 23 May 2006 (Paper No. 20060515), entry of the following amendments and remarks, and re-examination and reconsideration 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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**IN THE CLAIMS**

Clean Claims (1-14, 16-19, 21 and 22)

1           1. (Currently Amended) A method of providing mental therapy for reducing fear,  
2 anger, or negative thoughts or feelings caused by a prior adverse interpersonal interaction, said  
3 method comprising the steps of:

4           (1) causing to be visibly displayed to, or perceived by, a first person an image closely  
5 resembling a second person, said first person having, in respect to said second person, because  
6 of a prior adverse interpersonal interaction between said first person and said second person,  
7 an initial level of fear, anger, or negative thoughts or feelings as to which said first person  
8 desires therapy to reduce the initial level;

9           (2) causing to be visibly displayed to, or perceived by, said first person an image of a  
10 potentially harmful object;

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

14           (4) making a determination whether to repeat the third step, said determination  
15 comprising determining, based [[at least in part]] on user-derived input, whether, or to what  
16 extent, a reduction of the initial level of fear, anger, or negative thoughts or feelings of said first  
17 person has occurred.

1           2. (Original) The method of claim 1 wherein, prior to step 1 of claim 1, said first person  
2 has a first state of mind, said first state of mind characterized by thought patterns constituting  
3 or representative of fear, anger, or negative thoughts or feelings; and wherein said method  
4 further comprises transforming said first state of mind of said first person to a second state of  
5 mind of said first person, said second state characterized by thought patterns constituting or

6 representative of a reduction of said fear, anger, or negative thoughts or feelings.

1 3. (Original) The method of claim 1 wherein prior to step 1 of claim 1, said first person  
2 has a first state of mind, said first state of mind characterized by a negative cathexis with  
3 respect to said second person; and wherein said method further comprises transforming said first  
4 state of mind of said first person to a second state of mind of said first person, said second state  
5 characterized by an at least partial discharge of said cathexis.

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

1 5. (Original) The method of claim 1 wherein at least one step is carried out by a  
2 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 said  
2 display so that said image of an object appears to touch or penetrate said image of said second  
3 person, and then said image of said second person is transformed so that said second person  
4 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. (Original) The method of claim 6 wherein at least one step of said method is  
2 preceded, accompanied, or followed by an audible rendition of a predetermined phrase, mantra,  
3 or incantation.

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, mantra,  
3 or incantation that is selected with regard to helping overcome negative feelings caused by said  
4 prior adverse interpersonal interaction between said first person and said second person.

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

3 (1) causing to be visibly displayed to, or perceived by, a first person an image closely  
4 resembling a second person, said first person a victim of spousal abuse by said second person,  
5 said first person having, in respect to said second person, feelings of fear, powerlessness,  
6 vulnerability, or anger caused by said spousal abuse;

7 (2) causing to be visibly displayed to, or perceived by, said first person an image of a  
8 potentially harmful object; and

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

12 wherein, during or after said third step, said first person undergoes a transformation of mental  
13 state, said transformation comprising a reduction of said feelings of fear, powerlessness,  
14 vulnerability, or anger.

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

Claim 15. (Canceled)

1 16. (Previously Presented) A machine adapted for use in a therapy for alleviating anger  
2 or negative thoughts or feelings of a first person with respect to a second person, said machine  
3 comprising:

4 a person display unit for causing to be visibly displayed to, or perceived by, a first  
5 person an image closely resembling a second person, said first person having, in  
6 respect to said second person, because of prior adverse interpersonal interactions

7                   between said first person and said second person, fear, anger, or negative  
8                   thoughts or feelings, or a negative cathexis, as to which said first person desires  
9                   therapy;  
10                  an object display unit for causing to be visibly displayed to, or perceived by, said first  
11                  person an image of an object potentially harmful to said second person; and  
12                  a translator unit for causing said image of an 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                  said person display unit, said object display unit, and said translator unit adapted to cooperate  
16                  to influence a reduction of said fear, anger, or negative thoughts or feelings, or an at least partial  
17                  discharge of said negative cathexis.

1                  17. (Original) The machine of claim 16 further comprising a determination unit for  
2                  determining whether said first person has undergone a reduction of said fear, anger, or negative  
3                  thoughts or feelings, or a reduction of said negative cathexis, and for again actuating an  
4                  operation of said translation unit unless a reduction of said fear, anger, or negative thoughts or  
5                  feelings, or a reduction of said negative cathexis has occurred.

1                  18. (Original) The machine of claim 16 further comprising a processing unit operatively  
2                  coupled to a memory in which is stored a computer program for operating or effectuating said  
3                  image display unit, said object display unit, said translator unit, and said 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 incantation  
3                  unit for causing said sound system to make a predetermined phrase, mantra, or incantation  
4                  audible during at least a portion of a time when said machine is operated.

Claim 20. (Canceled)

1           21. (Previously Presented) The method of claim 1, comprising the following additional  
2 step after the fourth step:

3           (5) returning to the third step and reiterating the third and following steps until it is  
4 determined that a specified reduction of the initial level of fear, anger, or negative thoughts or  
5 feelings of said first person has occurred.

1           22. (Previously Presented) The method of claim 1, wherein at the time that the fourth  
2 step is currently iterated said first person has a current level of fear, anger, or negative thoughts  
3 or feelings, said method comprising the following additional step after the fourth step:

4           (5) returning to the third step and repeating the third and following steps until a time  
5 comes when it is determined that the current level of fear, anger, or negative thoughts or  
6 feelings of said first person at said time is not such that a specified reduction of the current level  
7 of fear, anger, or negative thoughts or feelings of said first person when the fourth step was last  
8 previously iterated has occurred.

## REMARKS

### STATUS OF CLAIMS

Claims 1-14, 16-19, 21 and 22 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.

### CLAIM OBJECTIONS

Claim 1 is objected to because of the following informality pointed out by the Examiner: at line 11 of claim 1 “an object” occurs in the phrase “said image of an object.” The intended referent of “an object” was the phrase on lines 9-10, “an image of a potentially harmful object.” Therefore, the current amendment replaces the phrase “an object” with the entire foregoing phrase of lines 9-10 with “said” substituted for “an.” Therefore, as amended, the reference on line 11 to the antecedent on lines 9-10 was changed to read “said image of a potentially harmful object.” In addition, “said object” on line 12 has been likewise expanded to read “said potentially harmful object.” The objection to claim 1 should therefore be withdrawn.

### CLAIM REJECTIONS

#### **I. 35 U.S.C. § 112 - indefiniteness**

The office action rejects claims 1-14, stating:

Claims 1-14 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear exactly which user “user-derived input” refers to. Also, it is not clear what Applicant means by “based at least in part on user-derived input”. What else can the determining based on?

**A. “User-derived input”**

The applicant respectfully notes, first, that the phrase “user-derived input” occurs on line 17 of claim 1, and therefore it is a limitation found in claims 1 and claims 2-12, which depend from claim 1. No such phrase occurs in claim 13 or claim 14 dependent therefrom. Accordingly, the rejection of claims 13-14 on this ground is inconsistent with the language of those claims and should therefore be withdrawn.

The applicant respectfully notes, second, that in discussing the Larson reference as anticipatory, the instant office action states: “Larson discloses making a determination whether to repeat the third step, said determination comprising determining, based at least in part on user-derived input whether, or to what extent, a reduction of the initial level of fear, anger, or negative thoughts or feelings of said first person has occurred.” This description in the office action of how Larson allegedly operates itself uses the phrase “based at least in part on user-derived input” to describe how Larson makes a “determination whether to repeat the third step.” Therefore, the office action itself shows that the phrase “user-derived input” cannot be so “insolubly ambiguous” that it is incapable of construction, see *Honeywell Int’l, Inc. v. ITC*, 341 F.3d 1332, 1338-39 (Fed. Cir. 2003), given the fact that the office action itself explains its own ruling herein in terms of that phrase. To reject a claim terminology as indefinite and then frame a further rejection in terms of that very terminology is internally inconsistent or self-contradictory, and it cannot be a permissible exercise of PTO discretion. The phrase must be definite enough to be understood by a person of ordinary skill in the art or it could not be used in the office action to explain an anticipation rejection.

Clearly, a *user-derived input* is an *input that is derived from the user*, for example, by measuring the user's (patient's) blood pressure or operating in accordance with whether the user (patient) presses YES or NO in response to a query. This is made clear in the specification of this patent application, which gives such examples of user-derived input.

One example of user-derived input information is, for example, a YES/NO user input (see ¶ [0057] ) as to whether the patient's initial level of fear, anger, etc. has been reduced. Another example is a change in the user's pulse rate or blood pressure (see, e.g., specification, ¶¶ [0023], [0058]). See Examples 3, 4, 5, and 6 (specification, ¶¶ [0055], [0057], [0058], and [0061]), which describe such a procedure with various patients. Also, see ¶¶ [0021], [0023], and [0058], which suggest 5% reduction of patient blood pressure or pulse rate as a possible rule of thumb.

For these reasons, the terminology of claims 1-14 is not indefinite and the rejection should be withdrawn.

**B. “Based at least in part on user-derived input**

The office action questions the “at least in part,” asking “What else can the determining [be] based on?” What the applicant meant to convey by his choice of language was that in the step of making a determination whether to repeat the third step, “said determination comprising determining, *based at least in part on user-derived input*, whether [reduction occurred],” the determination did not exclude taking other factors into account. For example, possibly limiting the session to 50 minutes or some other reasonable time (50 minutes being a well known, typical limit on a session of therapy); or the therapist allowing only five iterations regardless of effect.

On further reflection, however, caused by the examiner's comment in the office action, the applicant now realizes that the word "comprising" in the phrase "said determination comprising determining," already accomplishes the aforesaid purpose. Therefore, the phrase "at least in part" is redundant – given the well-established legal distinction between "consisting of" and "comprising." Therefore, by a current amendment "at least in part" is now deleted.

This aspect of the rejection is therefore obviated by deletion of the phrase to which the examiner took exception. Therefore, the deletion overcomes the rejection.

## **II. 35 U.S.C. § 101 - statutory subject matter**

**A.** The office action rejects claims 1-14 and 16-22 (all claims in case), stating:

Claims 1-14 and 16-22 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The rejection from the previous office action is maintained and is incorporated herein by reference.

In response the applicant respectfully incorporates herein by reference his response to the previous office action to this rejection.

**B.** In addition, the office action states:

It is not evident that the claimed invention transforms an article or physical object (i.e., the first person in the claimed invention) to a different state or thing. For example, if during the step of "making a determination whether to repeat the third step, said determination comprising determining, based at least in part on user-derived input, whether, or to what extent, a reduction of the initial level of fear, anger, or negative thoughts or feelings of said first person has occurred", the first person's sentiments never change, than the first person is never transformed to a different state.

**1.** This office action repeats the previous office action's rejection based on alleged lack of transformation. The office action states, "For example, if during the step of 'making a

determination whether to repeat the third step, said determination comprising determining, based at least in part on user-derived input, whether, or to what extent, a reduction of the initial level of fear, anger, or negative thoughts or feelings of said first person has occurred’, the first person’s sentiments never change, than the first person is never transformed to a different state,” which is a quote of claim 1, as amended – no other example is given and the quoted language is not present in claims not dependent from claim 1. There is no determining step in method claims 13-14, and the machine claims 16-19 do not have a determining step or an equivalent required function. (Also, machine claims are not subject to transformation requirements for purposes of § 101.) Therefore, the rejection is insupportable for claims 13-14 and 16-19, and should be withdrawn at the outset for them.

2. The rejection is speculative and hypothetical – it is based on “if” (“*if* during the step...”). Where is the support for the “if” premise? What if *not*? The examiner has the burden of proof here. E.g., *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002) (“During patent examination the PTO bears the initial burden of presenting a prima facie case of unpatentability. If the PTO fails to meet this burden, then the applicant is entitled to the patent.”) (citations omitted); *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992). If there is not substantial evidence of record on an issue, the issue must be resolved in favor of patentability. Here, no record evidence (much less substantial evidence) supports a fact finding to the effect that the first person’s sentiments never change.

Not only is there no support, but the premise is contrary to common sense. No basis exists for the speculative and unrealistic assumption that a victim of spousal abuse, for example

(or another person having fear or other negative feelings caused by a prior adverse interpersonal interaction), will fail to feel less afraid, vulnerable, or powerless after engaging in a simulated head-bashing of, or other simulated physical retaliation against, her abuser, for example, pursuant to step (3) of claim 1. Accordingly, this ground of rejection not only has not been, but cannot be, supported and should be withdrawn.

3. If the examiner's statement about the person's sentiments possibly never changing is meant to raise an operability issue, that too does not bar patentability. The possibility of the desired result (e.g., reduction of fear, etc.) not occurring for some reason does not make the process unpatentable.<sup>1</sup> Therapies do not need to work always for all patients. Thus, it is common with therapeutic method claims to call for continuing to apply the medication until the adverse symptom is reduced – for example, take two aspirins every four hours until headache goes away. The possibility that the headache will *not* go away (for any number of possible reasons – say, a head injury or a tumor) does not make such a claim nonstatutory subject matter under § 101. Moreover, not all arthritis victims benefit from a given medication, and doctors have to try out different anti-inflammatory medications on their patients to see which one, if

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<sup>1</sup> For example, in *Abbott Laboratories v. Novopharm Ltd.*, 323 F.3d 1324 (Fed. Cir. 2003), the Federal Circuit had no problem with the following claim: “10. A method for improving the bioavailability of fenofibrate in vivo, which comprises co-micronization of the fenofibrate and a solid surfactant, the said co-micronization being carried out by micronization of a fenofibrate/solid surfactant mixture until the particle size of the powder obtained is less than 15  $\mu$ .” Like the original claims objected to here, this claim describes a process in which you do something “until” a desired result occurs – reduction of particle size to below 15  $\mu$ , which in theory or principle may never happen.

any, will work for the patient.<sup>2</sup> Similarly, not all hypertension victims benefit from a given anti-hypertensive medication,<sup>3</sup> and not all depressed patients benefit from a given anti-depressant medication.<sup>4</sup> Doctors therefore have to try out different anti-hypertensive and anti-depressant

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<sup>2</sup> See, e.g., Altera Answer Series, “An Overview of Arthritis,” Article dated May 31, 2002 (“Finding the right treatment takes time and may involve trial and error until you and your doctor find what works best.”), available online at [www.assisted.com/answerseries/note011.htm](http://www.assisted.com/answerseries/note011.htm); The National Council on Aging, “Arthritis – Understanding It” (“Different treatments work best for different people, and finding the right treatment can take time, as well as a certain amount of trial and error.”), available online at [www.ncoa.org/content.cfm?sectionID=109&detail=117](http://www.ncoa.org/content.cfm?sectionID=109&detail=117).

<sup>3</sup> See, e.g., Medical News Today, “Hypertension, genes, and bad outcomes,” Article dated Nov. 22, 2005 (“There are five first-line drug classes, with probably an average of seven to eight drugs in each class, then an additional half-dozen or so other drug classes that aren’t considered first-line.... This means there are many choices for drug therapy in hypertension – a good thing – but also adds to the trial-and-error element of finding the right drug for the right person, as any specific drug has only about a 50 percent chance of being effective in a specific patient.”), available online at [www.medicalnewstoday.com/medicalnews.php?newsid=33901](http://www.medicalnewstoday.com/medicalnews.php?newsid=33901); Doctor’s Guide, “Trial And Error Helps Patients Find Best Blood Pressure Treatment,” Article dated June 11, 1999 (“Patients with high blood pressure may be able to find the drug that is best for them if they try out several different drugs before settling on one treatment, according to study in this week’s issue of *The Lancet*. Researchers have long known that people react differently to the blood pressure medications. While one drug may bring one person’s blood pressure under control, it may have little or no effect on another. As a result, finding the right drug for patients is often a process of trial and error.”), available online at [www.pslgroup.com/dg/106b42.htm](http://www.pslgroup.com/dg/106b42.htm).

<sup>4</sup> See, e.g., CBS News Healthwatch, “Depression: Drug v. Talk Therapy,” Article dated Sept. 8, 2004 (“More than 50 percent of survey respondents who took antidepressants tried two or more drugs; 10 percent tried five or more. “It really does have to be a process of trial and error... because there’s no predicting people’s response to [antidepressants]”), available online at [www.cbsnews.com/stories/2004/09/08/health/webmd/main641883.shtml](http://www.cbsnews.com/stories/2004/09/08/health/webmd/main641883.shtml); Best Doctors, Donald F. Klein, “Diagnosis and Treatment of Depression,” Article rev. Sep. 21, 2003 (“We often don’t know which medication works the best for any given patient. Some trial and error, even in the hands of the most skilled psychiatrist, is required. On average, about 60-70 percent of patients benefit from the first medication tried, and of those who do not improve, about 50-60 percent will benefit from the next medication. Unfortunately, this means that even after two medications, somewhere between 10-20 percent will still be ill.”), available online at

medications on their patients to see which one, if any, will work for the patient. The possibility of non-success does not negate patentability, and a § 101 rejection on that basis therefore cannot be sustained.<sup>5</sup>

4. This rejection is a restatement of the same argument made in the previous office action and responded to in the previous amendment, and the applicant respectfully incorporates herein by reference his prior argument in response thereto.

C. In addition, the office action states:

Moreover, it is not evident that the claimed invention provides a practical application that produces a useful, tangible and concrete result. The claimed invention cannot be useful if the first person's sentiments are never reduced. Moreover, there is no evidence that the claimed processes for providing mental therapy produce a result that is concrete (i.e., repeatable (e.g., said first person undergoes a transformation of mental state, said transformation comprising a reduction of said feelings of fear, powerlessness, vulnerability, or anger)).

This is a repetition of the previous office action's rejection, and the applicant therefore respectfully incorporates herein by reference the response thereto in his previous amendment.

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[www.bestdoctors.com/en/conditions/d/depression/depression\\_051900.htm](http://www.bestdoctors.com/en/conditions/d/depression/depression_051900.htm); The Cleveland Clinic, George Tesar, Depression and Other Mood Disorders, pub. May 29, 2002 ("There is no test available that predicts individual response to antidepressant medication in general or to any single agent. Empiric trial-and-error is necessary with a 60% to 70% chance of success with any one agent. If a trial of the first agent is unsuccessful, the diagnosis should be reviewed for accuracy and then, if depression is still present, another antidepressant should be tried."), available online at [www.clevelandclinicmeded.com/diseasemanagement/psychiatry/depression/depression.htm](http://www.clevelandclinicmeded.com/diseasemanagement/psychiatry/depression/depression.htm).

<sup>5</sup> *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571 (Fed. Cir. 1992) (test is whether invention is "totally incapable of achieving a useful result:"); *E.I. du Pont De Nemours & Co. v. Berkley & Co.*, 620 F.2d 1247, 1260 n.17 (8th Cir. 1980). See also MPEP § 2107.01 ("If an invention is only partially successful in achieving a useful result, a rejection of the claimed invention as a whole based on a 'lack of utility' is not appropriate.").

In particular, the statement about *repeatability*, excerpted from the recent draft § 101 guidelines, misstates the case-law and is unsupported by precedent. It has not been and will not be sustained in the Federal Circuit.

### III. 35 U.S.C. § 102 - anticipation

Claims 1-7, 10-14, 16-19, and 21-22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Larson et al. (US 2003/0013376). A § 102(b) anticipation rejection can be sustained only if each and every element and limitation of the claim is found in a single prior art reference. *Schumer v. Laboratory Computer Sys., Inc.*, 308 F.3d 1304 (Fed. Cir. 2002); *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999); *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997); *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997). If a single element of the invention (or a single limitation of the claim) is missing, the reference does not anticipate. *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). These rejections do not meet those legal requirements for anticipation, because Larson does not disclose all of the limitations recited in the rejected claims.

#### A. The office action states, regarding claims 1, 13, 16-17, and 21-22:

Larson discloses causing to be visibly displayed to, or perceived by, a first person an image closely resembling a second person (e.g., character), said first person having, in respect to said second person, because of a prior adverse interpersonal interaction between said first person and said second person, an initial level of fear, anger, or negative thoughts or feelings as to which said first person desires therapy to reduce the initial level on p.2, [0032], [0034]:

For instance, the child may be told or read a story, listen to an audiotape, view a video, or the like, which leads the child to believe that a monster (or other like unpleasant imagining) is present in the child's bedroom.

As gleaned elsewhere herein, one example of a character or animal that can be formed is a monster (e.g., resembling a vertebrate, invertebrate, bird, reptile, mammal, gargoyle, demon, troll, ogre, goblin, fairy, ghoul, witch, warlock, clown, werewolf, dragon, dinosaur, or mixtures of two or more thereof). The fanciful creature may also be configured in the shape of a good person, such as a super-hero, an angel, a law enforcement official, a child, or the like.

Larson discloses causing to be visibly displayed to, or perceived by, said first person an image of a potentially harmful object (e.g., spray container). See p.2, [0033]. Larson discloses causing said image of the object to touch, become located within, or become near said image of said second person in a manner such that said object appears to harm said second person. See p.3, [0044]. Larson discloses making a determination whether to repeat the third step, said determination comprising determining, based at least in part on user-derived input whether, or to what extent, a reduction of the initial level of fear, anger, or negative thoughts or feelings of said first person has occurred. See p. 5, [0070]-[0071 ].

A comparison of the text of Larson with the claim limitations of the rejected claims shows that Larson does *not*, in point of fact, disclose all of the claim limitations. Moreover, the above-quoted statements, in substantial respects, are inaccurate and do not reflect the actual facts. This is analyzed below on a claim-by-claim basis.

### **Claim 1**

#### **a. Second person, interpersonal interaction**

Claim 1 is directed to “A method of providing mental therapy for reducing fear, anger, or negative thoughts or feelings caused by a *prior adverse interpersonal interaction....*” Step 1 requires display or perception of “an image closely resembling a *second person*, said first person having, in respect to said *second person*, because of a *prior adverse interpersonal*

*interaction* between said first person and said *second person*, an initial level of fear, [etc.]...”

Step 3 requires again the “image of said *second person*.” The specification, summarizing the invention, describes the second person as, for example, a “a specific second person, who is personally known to the user and with whom the user has previously had adverse personal interactions” [0009]. The detailed description states, for example:

Image 10 embodies a photograph of a second person (such as the user’s estranged spouse), whom the user has known personally and toward whom the user has anger or other negative thoughts or feelings because of the first and second persons’ prior adverse interpersonal interactions. [0012]

See also [0063]: “this image closely resembles a specific *second person* who has caused the user to feel fear, anger, helplessness, vulnerability, or other negative feelings.”

The *American Heritage Dictionary of the English Language* (4th ed. 2004) defines *person* as follows: “1. A living human. Often used in combination: *chairperson*; *spokesperson*; *salesperson*. 2. An individual of specified character: *a person of importance*.” The same dictionary defines *interpersonal* as: “1. Of or relating to the interactions between individuals: *interpersonal skills*. 2. Existing or occurring between individuals: *interpersonal communication or conflict*.”

Therefore, the “second person” of the instant application is a real, living human being, “such as the user’s estranged spouse.” See [0012]. The “second person” of the instant application is *not* an imaginary monster such as a “gargoyle, demon, troll, ogre, goblin, fairy, ghoul,” etc. (see Larson [0034]) whom the user has in fact never met and does not even exist. A demon or troll is not a “person,” and therefore not a “second person.” The user of the instant

specification has had a real adverse interpersonal interaction with a real second person. For example, the real adverse interpersonal interaction is having been abused by the second person (see [0011], [0041], [0044], [0061]), having been given AIDS by the second person (see [0039], [0053]), or having suffered a “serious and irrevocable injury” at the hands of the second person (see [0039], [0056]). The second person of the instant invention has done real and serious harm to the first person (user). In addition, claim 1 requires that the second person be someone “whom the user has known personally.” That is a specific limitation of the claim.

In contrast, in Larson a child is afraid of an imaginary monster that has done nothing (in fact) to the child. The child has not personally known the imaginary monster. The monster has not abused, molested, beaten, or similarly harmed the child. Larson thus does not disclose the elements and limitations of claim 1, but discloses something quite different. The child has not in fact had an adverse interpersonal interaction with the monster; it has had no interpersonal interaction at all in fact, because the monster does not exist.

An abusive ex-spouse, in contrast, is no figment of the imagination. Examples could be multiplied, but it is clear that the instant invention is limited to a real second person, while Larson is directed to an imaginary monster with which or whom the child-user has not had any real *personal* or *interpersonal* experience, and whom the child-user has *not* known personally. Larson therefore does not meet the stated limitations of claim 1 described above.

**b. Desires therapy**

Further, it is a limitation of claim 1 that the first person (user) has “an initial level of fear, anger, or negative thoughts or feelings *as to which said first person desires therapy* to

reduce the initial level.” Nothing in Larson states that the child-user desires to have therapy to reduce its fear level. This limitation of claim 1 is simply not met.

**c. Appear to harm second person**

A further limitation of claim 1 is that step 2 requires “an image of a potentially harmful object,” while step 3 requires the user to manipulate the image in “a manner such that said object appears to harm said second person.” The *Random House College Dictionary* defines “harm” as: “injury; damage; hurt: *to do him bodily harm.*”

Larson discloses an “instrument” that is “configured to minimize the risk of bodily harm to the child” ([0033]). The instrument is a squirt gun or sprayer containing a fluid that may contain a fragrance, a flavorant, or something to generate bubbles (*id.*). The child is supposed to overcome its fears of the imaginary monster by spraying the monster with the fragrant, flavored, or bubbly fluid (see [0044] (“spraying a fluid at an imagined monster”). Larson does not disclose any harm or seeming harm suffered by the monster. Larson does not say that the imagined monster is injured, damaged, or hurt.

In contrast, the present invention uses knives, axes, clubs, and other lethal instruments to commit a simulated aggravated assault on the ex-spouse or other second person. A preferred application shows an ax taking off the top of the ex-spouse’s head and blood then streams down. *That* is real harm. *That* is a disclosure of using a potentially harmful object to *assault* the second person, thereby appearing to harm him, by injuring, damaging, and hurting him. But spraying an imaginary monster with a fragrant, flavored, or bubbly fluid is *not* a disclosure of potential harm or the appearance of harm. Larson does not disclose this limitation of claim 1.

**d. No anticipation of claims 1, 2-7, 10-14, 16-19, 21-22**

Larson thus fails to anticipate claim 1, under the test prescribed in *Schumer, Robertson, Schreiber, Gechter, and Kloster*. By the same token, Larson fails to anticipate all claims dependent from claim 1 – claims 2-7, 10-14, 16-19, and 21-22. See *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1296 (Fed. Cir. 2002) (“Because claim 3 is not inherently anticipated, dependent claims 4 and 5 also are not anticipated.”); *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1446 (Fed. Cir. 1984) (“Since claim 3 of the Cole patent is dependent upon claim 2, which is not anticipated, claim 3 cannot be anticipated.”). See also *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 1383 (Fed. Cir. 2000) (it is a “fundamental principle of patent law that ‘dependent claims cannot be found infringed unless the claims from which they depend have been found to have been infringed.’”) (quoting *Wahpeton Canvas Co. v. Frontier, Inc.*, 870 F.2d 1546, 1553 (Fed. Cir. 1989)).

**Claim 13**

Claim 13, step 1, has the limitation that “said first person [is] a victim of spousal abuse by said second person.” Nowhere in Larson is there any mention that the first person is a victim of spousal abuse from the second person. (Normally, the child at which Larson is directed does not have a spouse, much less an abusive spouse.) Since this limitation is missing, Larson cannot anticipate claim 13, on this further ground.

**Claim 16**

Claim 16 requires a translator unit for causing the image of the harmful object on the display to come into contact with the image of the second person on the display, in a manner

such that the harmful object appears to harm the second person. Not only is there no harm disclosed in Larson, but there is no translator unit for moving the images in a manner such that the harmful object appears to harm the second person. Since this limitation is missing, Larson cannot anticipate claim 16, on this further ground.

**Claim 17**

Claim 17 requires a determination unit for actuating the operation of the translation unit. Larson does not disclose this. Since this limitation is missing, Larson cannot anticipate claim 17, on this further ground.

**B.** The office action states, regarding claims 2-4:

Larson discloses wherein, prior to step 1 of claim 1, said first person has a first state of mind, said first state of mind characterized by thought patterns constituting or representative of fear, anger, or negative thoughts or feelings; and wherein said method further comprises transforming said first state of mind of said first person to a second state of mind of said first person, said second state characterized by thought patterns constituting or representative of a reduction of said fear, anger, or negative thoughts or feelings. See p.2, [0032] and p5.5, [0070]-[0071].

Larson does not refer to transforming or transformation. The examiner does not state what is the basis for inferring that such a transformation occurs in Larson, which is inconsistent with the examiner's denial that a transformation occurs in the instant invention, where the specification expressly recites, discusses, and teaches at length the transformation. How can the examiner assert that a transformation occurs in Larson or is disclosed in Larson (who does not claim to effectuate a transformation) while denying that a transformation occurs in the instant invention?

Furthermore, claims 2-4 depend from claim 1, which has been shown above as not anticipated because multiple claims limitations are absent from Larson. Therefore, claims 2-4 cannot be anticipated. *Trintec, supra*.

**C.** As to claim 5, see discussion of claim 1 from which claim 5 depends. As to claim 7, see discussion of claim 1 from which claim 7 depends. *Trintec, supra*.

**D.** As to claims 6 and 18, the office action states:

Larson discloses wherein said image of a second person and said image of an object are each located on a computer display visible to said first person, said computer display operatively coupled to a programmable processing unit operatively coupled to a memory, said memory storing a computer program (i.e., software) for carrying out said method of claim 5. See p. 3, [0045].

Claim 6 depends indirectly from claim 1 and contains the further limitation “wherein said image of a second person and said image of an object are each located on a computer display visible to said first person, said computer display operatively coupled to a programmable processing unit operatively coupled to a memory, said memory storing a computer program for carrying out said method of claim 5.” Larson does *not* disclose locating the images on a computer display and then carrying out the steps of claim 1 using the computer and a computer program to do so; for example, Larson does not disclose causing the images of the second person and the harmful object to come together on the screen display so that the object appears to harm the second person. Therefore, in addition to the deficiencies discussed above under claim 1, see *Trintec, supra*, these further deficiencies occur. Larson therefore cannot anticipate this invention.

Claim 18 is directed to the machine of non-anticipated claim 16 with further limitations.

These additional limitations are a CPU and computer program that operate the translator unit, making the image of the harmful object appear to coincide with the image of the second person and appear to harm the second person. Larson does not disclose this limitation. Larson therefore cannot anticipate this invention. See also *Trintec, supra*.

**E.** Regarding Claims 10-12, 14, and 19, the office action states:

Larson discloses wherein at least one step of aid method is preceded, accompanied, or followed by an audible rendition of a predetermined phrase, mantra, or incantation: It may optionally include provisions for a therapist to include reinforcement suggestions or other suggestions for overcoming the fear (p.3, [0045]).

Larson [0045] states that optionally a tape is provided on which is “a recording to play out or otherwise help enact the story.” As Larson describes it, the tape recites the story told to the child.<sup>6</sup> Larson gives an example of what that reference means by “story” in its Example 2, [0072] to [0125], pp. 5-7 of specification. It is quite a long account or recital of events.

The specification of the instant invention explains, in contrast, that the instant invention can be carried out with “one step to be either preceded, accompanied, or followed by an audible rendition of a phrase, mantra or incantation.” The instant specification explains that the phrase or mantra may appropriately be selected to fit the particular situation of the user, so that “in a case of spousal abuse the negative feeling to be overcome are those of fear, powerlessness, vulnerability, or anger caused by spousal abuse, and the example given above (“You are not

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<sup>6</sup> The American Heritage Dictionary of the English Language (4th ed. 2000) defines *story* as follows: “An account or recital of an event or a series of events, either true or fictitious.” The Merriam Webster Online Dictionary defines *story* as “**2 a** : an account of incidents or events **b** : a statement regarding the facts pertinent to a situation in question.”

helpless! You can control your life!') is selected for that purpose." See [0039]. Also, "Customization of the phrase for a given user can involve use of the name of the second person: for example, 'Take that, Greg!' or "Drop dead, Alex!"

It is thus clear that the "audible rendition of a phrase, mantra or incantation" in the terminology of the instant specification is not the same thing as a recording of the story told to the child, as in Larson. None of the words "phrase, mantra or incantation" corresponds to reciting a story as in Larson. Therefore, Larson does not disclose this limitation of the instant claims and does not anticipate this invention.

#### **IV. 35 U.S.C. § 103 - obviousness**

Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over Larson in view of Official Notice.

##### **A. All elements rule**

The office action does not purport to take official notice of the long list of limitations described above that are missing from Larson yet present in the claims. That alone torpedoes the obviousness rejection. No claim limitation can be ignored in making a patentability analysis. *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994)("The PTO must consider all claim limitations when determining the patentability of an invention over the prior art."). In *Lowry*, the PTO found the claims obvious and anticipated. The Federal Circuit reversed both determinations because the cited reference did not disclose all elements of the claimed device. *Id.* at 1584-85. This rejection similarly fails at the outset under the all elements rule.

##### **B. Official Notice**

As the office action recognizes, claim 9, which is dependent from claim 1 and is directed to a computer-implemented embodiment, contains the further limitation that there is “an Internet-implemented step of causing a payment to be made to a vendor; and wherein at least one step of said method comprises transmitting a signal over the Internet between the first person and the vendor.” The office action also recognizes that Larson does not disclose (or for that matter remotely contemplate) vending the use of the invention over the Internet. However, the office action states:

Larson does not disclose expressly an Internet-implemented step of causing a payment to be made to a vendor and wherein at least one step of said method comprises transmitting a signal over the Internet between the first person and the vendor. However, such is old and well known in the art. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the aforementioned limitation into Larson’s invention, in order to conduct business over the Internet.

The office action does not state explicitly of what it seeks to take Official Notice, so that the applicant cannot know what it is he should object to as not appropriately being the subject of such notice. Whatever it is, the applicant objects and demands proof on the record to support any facts on which the PTO seeks to rely. Furthermore, in any event, the rejection is flawed. See *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). The PTO cannot take notice that it is obvious to use hindsight to reconstruct the invention after reading the specification. The PTO has to explain on the record why it is obvious to combine the elements of the invention as the inventor combined them. The PTO must rationally show that a person of ordinary skill in the art would have had the benefit of a teaching, suggestion, or motivation in the prior art to combine all the elements of the instant invention (many different ones of which are lacking in Larson, as

explained above in the discussion of anticipation) with using the Internet to transmit signals between the user and vendor to cause the vendor to be paid in connection with the performing of the claimed therapy method.

The office action states, “[I]t would have been obvious to one of ordinary skill in the art to incorporate the aforementioned limitation into Larson’s invention, in order to conduct business over the Internet.” But the office action does not explain why a person of ordinary skill in the art would *want* to carry out this invention by means of e-commerce over the Internet. The office action cites no reference showing mental therapy or anything related to it being carried out by Internet vending means. Larson [0045] does not remotely suggest or motivate this. Nor does anything else of record herein.

What the office action is saying here is that it would have been obvious how to implement a part of the invention by e-commerce and Internet means, *if you had decided that was what you wanted to do and had already combined all the other elements of the invention*. The decisions of the Federal Circuit do not permit such hindsight determinations under § 103.

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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 Applicant's undersigned attorney.

The applicant respectfully points out that there have been at least two merits office actions herein, on shifting grounds. This application was made special because of the applicant’s age; already, he surely cannot be expected to enjoy his full patent term, given his age.

The applicant therefore respectfully requests that the PTO, without again shifting ground, either grant or else reject this application so that, in the latter event, he can within his lifetime pursue this case to the Board and then, if necessary, exhaust appellate review thereafter.

Respectfully submitted,

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