APPLY NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.
--- | --- | --- | --- | ---
11/166,991 | 06/27/2005 | Richard H. Stern | P57491 | 8974

Robert E. Bushnell
Suite 300
1522 K Street, N.W.
Washington, DC 20005-1202

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SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE
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3 MONTHS | 03/23/2007 | PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

OA Response Due:

23 June 2007
### Office Action Summary

<table>
<thead>
<tr>
<th>Application No.</th>
<th>Applicant(s)</th>
</tr>
</thead>
<tbody>
<tr>
<td>11/166,991</td>
<td>STERN, RICHARD H.</td>
</tr>
<tr>
<td>Examiner</td>
<td>Kathleen Mosser</td>
</tr>
<tr>
<td>Art Unit</td>
<td>3714</td>
</tr>
</tbody>
</table>

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**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply is specified above, the maximum statutory period will apply and any reply must be filed within the period permitted by 37 CFR 1.136(b) or before the statutory period is extended by the examiner.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(a).

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**Status**

1) ☒ Responsive to communication(s) filed on **07/31/2006**.
   2a) ☐ This action is FINAL.
   2b) ☒ This action is non-final.

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

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**Disposition of Claims**

4) ☒ Claim(s) 1-4, 6-14 and 16-22 is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) ____ is/are allowed.

6) ☒ Claim(s) 1-4, 6-14 and 16-22 is/are rejected.

7) ☐ Claim(s) ____ is/are objected to.

8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

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**Application Papers**

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

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

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

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

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

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**Priority under 35 U.S.C. § 119**

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

   a) ☐ All  b) ☐ Some  c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.
   2. ☐ Certified copies of the priority documents have been received in Application No. _____
   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

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

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**Attachment(s)**

1) ☐ Notice of References Cited (PTO-822)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____

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

5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

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U.S. Patent and Trademark Office
PTOL-326 (Rev. 7-05)
DETAILED ACTION

In response to the amendment filed 07/31/2006, claims 1-14, 16-19, 21 and 22 are pending; claims 15 and 20 having been previously cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-12, 21 and 22 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. Claim 1 recites "making a determination... based on user-derived input". However, nowhere in the claim is a procedure for receiving user-derived input recited, nor is it clear from the claims what the input is in response to or how such input is used in the determination. As such it is unclear, from the claims, exactly how the claimed method is intended to receive input and operate to perform the function as claimed. Claims 2-12 are rejected for their incorporation of this ambiguity and for failing to correct the deficiency.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

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

2. Claims 1-14, 21 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a claimed method to be patentable it must show a practical application of an otherwise abstract idea. Such a practical application may be demonstrated
through either a (a) physical transformation; or (b) other useful, concrete and tangible result. A physical transformation can be shown if the method as claimed physically transforms an article or physical object to a different state or thing. In the instant invention, such a transformation does not occur, as the method steps are all directed to providing therapy to a user, through either a machine or other mental process. With respect to claims 1 and 13, the claims fail to show a tangible result. For a result to be tangible it must be appreciable by the user in the real-world. In reference to claim 1, the result of the claim is in making a determination. The result of this determination is never communicated to the user. Further, the claims fail to define what occurs should the result of the determination be negative.

Further, for a process to be concrete it must have a result that can be substantially repeatable or the process must substantially produce the same result again. In other words, there must be a reasonable expectation of success that the claim will function to produce the recited result. The independent claims recite, inter alia, that the first person will undergo a transformation of mental state such that there is a reduction in their feelings of fear, powerlessness, vulnerability or anger. There is no evidence that such a result will occur through the process as claimed, nor is it shown that such a result will occur a majority of the time. The method, although potentially successful, may reasonably function in the exact opposite manner as intended (i.e. the user may become more angry with the second person and develop feelings of rage or a need for revenge). As the result of the method can not be reasonably assured, the claims fail to produce a concrete result. Each of dependent claims 2-14 and 22 fails to rectify this deficiency and are rejected for the same reasons.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
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).

1. [Claims 1,3,13,16-17,21-22]: 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].

2. [Claims 2-4]: 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].

3. [Claim 5]: Regarding Claim 5, Larson discloses wherein at least one step is carried out by a machine (inherent by a tape). See p.3, [0045].

4. [Claims 6,18]: Regarding Claims 6 and 18, 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].

5. [Claim 7]: Regarding Claim 7, Larson discloses wherein said image of an object is embodied in an animated graphics file, said file embodying an audiovisual work that is performed on said computer display when said first person engaged in a prespecified action on an input device operatively coupled to said processing unit. See p.3, [0044].

6. [Claims 10-12,14,19]: Regarding Claims 10-12,14, and 19, 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]).

Claim Rejections - 35 USC § 103

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

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

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larson in view of Official Notice.
[Claim 9]: Regarding Claim 9, Larson discloses a step of logging on to the Internet (i.e., website). See p.3, [0044].

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, the examiner takes OFFICIAL NOTICE that the use of e-commerce or web based sales are well-known to those of ordinary skill in the art. The Larson invention discloses an embodiment where the user can download a story (paragraph 44). It would have been obvious to one of ordinary skill in the art at the time of invention to allow for the distribution of such stories through traditional e-commerce techniques, including receiving payment over the network, as such allows for mass market distribution of products.

**Response to Arguments**

3. Applicant’s arguments filed 07/31/2006 have been fully considered but they are not persuasive.

**Arguments against the rejection under 35 USC §112, second paragraph**

Applicant asserts that the rejection is improper based upon the fact that the examiner was capable of making an interpretation of the claims, and applied art against the claims. Under the premise of “compact prosecution” examiners are required to attempt to discern a reasonable interpretation of the claims for consideration of the claims against all possible grounds of rejection. The mere fact that the examiner was capable of making an interpretation of the claims does not mean the claims inherently are definite or meet all other statutory requirements for patentability. Applicant has failed to show where, the logic of the examiner’s rejection was flawed, or how the claim language itself clearly defines the invention.

**Arguments against the rejection under 35 USC §101**

The examiner has more clearly described the position and rationale as to how the claims fail to recite a useful, concrete and tangible result. In applicant’s arguments against the rejection, the examiner notes that the claimed feature of changing the state of the person is positively
recited in the claim, thus asserting that the method will achieve the intended result. The rejection is based on similar grounds and rationale that prevents claims that are directed to “curing” a disease as opposed to methods of “treating” a disease. In the former the claim makes an assertion that the process will succeed or is guaranteed to succeed for the intended purpose. Absent objective evidence that the method succeeds in a vast majority of circumstance the result is not reasonably expected, and such a claim is not concrete. The latter however, states that the process is being used as a treatment of the disease, and makes no claim that the disease will be alleviated. It is reasonable to expect that given a specific diagnosed diseased that the method may be repeatable used as a manner of treating it, regardless of the success in the process to treat it.

Arguments against the rejections under 35 USC §102

Claim 1:

Applicant asserts that Larson fails to teach the features of a second person with whom the first person has had interpersonal interaction with, that the user desires therapy, and that the image appears to cause harm to the second person. In support of the first argument the applicant relies upon several citations from the specification which define specific embodiments of the "second person" and specific "personal interaction". The applicant asserts that the "monster" of Larson does not meet this requirement as the creature is imaginary. However, the examiner asserts that in the mind of the first person (the child) the monster is substantially real, and the interaction (ie being scared by it) is an interpersonal reaction in the sense that the child believes that such has occurred. For the user the contact with the monster is real as is the monster, therefor the child views the monster as the second person and believes that such interpersonal interactions have occurred. Although applicant assertion that Larson fails to explicitly teach that the child wishes to have their fear reduced, such is an implicit teaching. It is the examiner's position that by participating in the activities of the Larson invention the child is expressing their desire to have their fears overcome. Applicant lastly argues that the invention of Larson fails to show an image of a potential object being manipulated in such a manner that said object appears to harm said
second person. In the invention of Larson the child is spraying a mixture which they believe to be capable of causing harm (or discomfort) to the monster in such a manner as to banish the monster from the child's bedroom, etc. In this context the child is in effect causing a potential harmful object (the mixture which is harmful to the monster) to come in contact with the second person in such a manner as to have the second person be harmed.

Claim 13:

Applicant argues that Larson fails to teach that the user is a victim of spousal abuse. However, this limitation is merely the intended use of the claimed invention and does not impart any specific binding structure on the claimed method.

Claims 5, 6, and 16-18:

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Claims 2-4:

In response to applicant's argument that Larson fails to teach the effects of the treatment, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In the instant case the features being claimed are the intended results of the method. It is the examiner's position that the invention of Larson and that of the claimed invention are substantially identical.

Claims 10-12, 14, and 19:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the definition of a mantra) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Official Notice:
The examiner has clarified the position of official notice taken in the previous office, to support a prima facie case of obviousness. This action is made non-final in part, so as to allow applicant the opportunity to properly challenge the basis of the finding. Applicant is reminded that a proper challenge to the finding must conform to the requirements described in MPEP §2144.03.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Mosser whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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

Kathleen Mosser  
Primary Examiner  
Art Unit 3714

March 19, 2007