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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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11/166,991

06/27/2005

Richard H. Stern

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7590 11/29/2007
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EXAMINER

MOSSER, KATHLEEN MICHELE

ART UNIT PAPER NUMBER

3714

MAIL DATE DELIVERY MODE

11/29/2007

PAPER

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

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 11/166,991 | Applicant(s) STERN, RICHARD H. | |
| | Examiner Kathleen Mosser | Art Unit 3714 | |

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

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 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 NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 June 2007.
- 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.

Disposition of Claims

- 4) Claim(s) 1-14, 16-19, 23 and 24 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 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.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) 1-14, 16-19, 23 and 24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

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(s) 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.

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.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

In response to the amendment filed 06/15/2007, claims 21 and 22 have been cancelled; claims 1-14, 16-19 and newly added claims 23 and 24 are pending.

Claim Objections

1. Claims 23 and 23 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

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, 16-19 and 23-24 are 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.

Applicant asserts that the utility of the instant invention is to alleviate fear, anger, or other negative thoughts or feelings that the user has towards a specific second person, see paragraph 009, and further asserts that through using the claimed methodologies and devices the user state of mind of the user will be transformed so as to achieve at least a partial discharge of the cathexis. "*Does Venting Anger Feed or Extinguish the Flame? Catharsis, Rumination, Distraction, Anger and Aggressive Responding*", by Brad J. Bushman (herein after the Bushman article), shows a detailed study including 600 participants. The article acknowledges that catharsis theory is well-known in the psychological community but shows substantial evidence to conclude that venting anger/aggression does not result in a

discharge of the negative feelings. On page 725, in the left hand column, second full paragraph, as study showing that questions as to the effectiveness of catharsis theory have been raised as early as 1959. In the rumination study group, the participants are allowed to visualize their antagonist (in this instance a fictitious partner) while hitting a punching bag. The study shows that this group of participants maintained the most negative energy or angry emotions at the conclusion of the experiment. This article clearly challenges the utility of catharsis treatments in their ability to relieve fear, anger, or other negative feelings a person has towards another. Given such evidence the examiner has concluded that the asserted utility of the instant invention is not credible.

The examiner further notes that the prior art does not tend to challenge this finding. The Virtual Voodoo deal below is merely a device for venting anger, frustration, etc. It does not claim to lessen or remove the negative feelings. The next closest prior art is the Larson et al reference. As argued repeatedly by applicant this invention is drawn to help a child overcome a fear of non-existent creatures, by causing the child to believe they have vanquished the monsters to another realm. In contrast, the instant invention is intended for use between actual persons, not elements of a child's imagination.

3. Claims 1-14, 16-19 and 23-24 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

4. Claims 3-11, 13-14 and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite features which require that the person's "state" will change from one of having negative feelings towards a second person, to one of reduced negative feelings. Such results are not concrete. In order to be concrete the result of the method must have a reasonable expectation of success. However, as shown by the Bushman article cited above, such a resulting change in state is not reasonably expected.

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 negated by the manner in which the invention was made.

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

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1, 13, 16, 18, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Virtual Voodoo Dolls" (webpost of "bumhat", September 11, 2002).

Virtual Voodoo Dolls teaches a computer based system and method including: causing to be visual displayed to a first person an image of an actual, living second person actually personally known to said first person (the person's boss); causing to be visibly displayed to said first person an image of an object having an actual potential for harming the second person (an image of a pin); and causing said image of said 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 person (poking the doll with pins); as in claims 1, 16, 18 and 23.

Claims 13 and 24 recite substantially identical features to claim 1 but recite that the second person is present of former spouse of said first person, and that said first person is a victim of spousal abuse. The device disclosed in the prior art is clearly not limited to a picture of a boss. One of ordinary skill in the art would readily recognize that any picture could be scanned into the system and would have

the same resulting effect (a virtual 3D doll of the individual in the photo). As such the modification of the system to use a photo of a spouse is deemed obvious as it merely applying the known technique of scanning a photo of a person's boss, to a photo of a spouse and would yield a predictable result. The feature of the first person being a victim of spousal abuse is considered to be a limitation to the intended use of the method and is not given patentable weight.

Though "Virtual Voodoo Dolls" does not explicitly teach said first person having, in respect to said second person, because of an actual prior adverse interpersonal interaction between the first person and said second person, an initial level of fear, anger, or negative thoughts or feelings as to which said first person desires treatment, as in claims 1, 13 and 16, the concept of using a voodoo doll to perform malicious acts a person with whom one has had a negative experience is impeccably well-known in modern culture. As the post specifically mentions using a picture of a person's boss and sublimating "rebellious homicidal impulses" it is clear that the picture of the person is intended to be that with which a negative event has occurred leaving the person having anger towards the individual.

Response to Arguments

6. Applicant's arguments filed 06/15/2007 have been fully considered but they are not persuasive.

I. Arguments concerning previous 35 U.S.C 112 rejections (pages 9-11)

These rejections are withdrawn in view of the amendments to the claims

II. Arguments related to the rejection of the claims under 35 U.S.C. 101 (pages 12-40)

With respect to elements A-F of the arguments, the rejection of the claims based upon tangibility have been withdrawn in view of the amendments to the claims.

With respect to elements G and H, the examiner is required to consider applications and examine claims in view of those guidelines published by the office and reproduced within the MPEP. The examiner does not have the authority to comment on the legality of such decisions, and will not address such arguments in this response. Applicant further relies upon a Board decision to *Bilski*, the examiner notes that such decision was not published as being precedential, and the decisions therein are not *per*

se binding. Further, for those claims which still recite that a change of state will occur, the rejection of the claims has been amended to rely upon an evidential article showing that catharsis therapy does not necessarily produce the results as claimed in the instant invention.

Applicant further asserts that the claims meet the requirement for a transformation. Applicant's arguments to this point are premised on an argument related a user's "state"-of-mind. However, the concept of altering the state of an object refers to making a physical transformation, such a curing rubber. Not to the mere alteration of a person's mental processes.

III-IV. Arguments concerning the prior art (pages 41-61)

The prior art of Larson is withdrawn in view of the amendment to the claims, as such the arguments related to the Larson reference and the prior rejections based upon such are considered moot.

V. Statements regarding newly added claims 23 and 24 (pages 61 and 62)

Applicant makes a preliminary assertion that the claims are statutory based upon the decision in *Warmerdam*. The courts decision in *Warmerdam* is related to a machine programmed to perform a specific process where the method claims were found to be merely abstract ideas. This is not the case of the claims of the instant application. The pending claims are rejected for failure to provide a concrete result. As the fact pattern of the two cases are substantially different *Warmerdam* does not necessarily apply.

Conclusion

This action is made non-final in view of the newly discovered article to Bushman and the resulting rejections under 35 U.S.C. §101. The rejections based upon the bumhat post, were necessitated by the amendments to the claims.

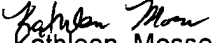
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Mosser whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

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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

November 26, 2007