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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 | P57491 | 8974 |
| | 7590 12/09/2008 | | | |
| Robert E. Bushnell Suite 300 1522 K Street, N.W. Washington, DC 20005-1202 | | | EXAMINER MOSSER, KATHLEEN MICHELE | |
| | | | ART UNIT 3715 | PAPER NUMBER |
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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.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 11/166,991 | Applicant(s) STERN, RICHARD H. | |
| | Examiner Kathleen Mosser | Art Unit 3715 | |

-- 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 08/18/2008.
- 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, 24 and 25 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4a) Of the above claim(s) _____ is/are withdrawn from consideration.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, 24 and 25 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) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to the amendment filed 08/18/2008, claims 1-14, 16-19, 24 and 25 are pending; claims 15 and 20-23 having been previously cancelled.

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.

1. Claims 1-14, 24 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a process. In order to be considered patent eligible under 35 USC §101 a process must (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. It is emphasized that the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility; that the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity; and that the transformation must be central to the purpose of the claimed process. The claims are directed to a therapy or treatment process, they do not act to transform a particular article to another state. Further, the steps of the claims are not directly tied to any particular machine. Claim 1 has three process steps: (1) causing to be visibly displayed to, or perceived by, particular images to a first person (2) causing to be visibly displayed to, or perceived by, another particular image to a first person and (3) causing to be visibly displayed to, or perceived by an interaction of the first and second image. None of these steps are performed with the use of a specific machine. The amendments to the claims dated 08/18/2008 added the phrase "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" This feature is not critically tied to the rest of the method does not impose sufficient and meaningful limits on the claimed process, and is merely an

insignificant extra-solution activity, as this article of manufacture is merely a storage medium on which images are stored. The dependent claims fail to further correct this problem. Though they may include some recitations of computer or "machine" type applications, these recitations are only nominal recitations, and do not make a tie to another statutory class of subject matter as required to be eligible for patent protection.

Claims 3-11, 13-14 and 24 are further 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 (previously cited), 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.
2. Claims 1 and 13 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.

Claim 13 recites substantially identical features to claim 1 but recites 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 and 13, the concept of using a voodoo doll to perform malicious acts to 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.

3. Claims 16-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges et al (US 6012926). Hodges teaches a system for the treatment of an individual relating to several anxiety

disorders, the system including: a selection unit comprising means for permitting a first person to select a photographic image, a person display unit that causes images to be visibly displayed, an object display unit that causes second images to be displayed and a translator unit for causing interactions between the images (described in the description of how the VR environment is created and interacted with, in at least col. 6: 35-55); a sensor unit adapted to measure physiological parameters representative of anxiety (col. 11: 7-19) and a comparator unit coupled to the sensor unit, adapted to receive sensor output data, to compare said sensor output signal to a reference (col. 8: 56- col. 9: 9). This section includes teaching that the comparator determines if the output signal has fallen below said reference by a predetermined amount and for actuating the translation unit unless the amount is sufficient (see all col. 8: 35-55), as in claim 17. The use of a processing device between all of the above components is shown in at least Figure 1 (claim 18). The use of a sound system (claim 19) for outputting audio information during the treatment is shown in at least col. 5: 15-31.

Hodges does not teach that the image selected by the user is an image of a person actually known to the individual with whom the person has had a prior adverse interpersonal interaction, that the second image is a representation of an object that has a harming potential, or that the sound is a phrase, manta or incantation. However, these differences are only found in the nonfunctional data being displayed on a screen. Data showing various images is not structurally related to the display on which it is made. Thus, this descriptive material will not distinguish the claimed invention from the prior art in term of patentability. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any type of image in the system as taught by Hodges because such images do not alter how the system functions and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Response to Arguments

4. Applicant's arguments filed 08/18/2008 have been fully considered but they are not persuasive.

101-Rejections

Applicant asserts the amendments to the claims overcome the requirement that the invention be tied to another statutory class. As explained in the rejection of the invention above, the tie to a particular machine must be of a significant nature. The recitation of where the images of the system are stored does not impart such a substantial tie. As such the rejection is maintained. Applicant asserts that the basis for the examiner's rejection is improperly applied. Further the applicant asserts on page 12 of the remarks that the guidelines relied upon in making the rejection are "simply wrong". These arguments do not confirm with current practice, as they fail to address the flaws in the examiner's rejection, and instead challenge the basis of the rejection. As such they are effectively moot. The applicant further argues against the use of the Bushman reference as supporting evidence in making the rejection for lacking a concrete result. In making these assertions the applicant makes a number of discouraging remarks regarding the credibility and scientific facts of the Bushman teachings. Regardless of this, Bushman does constitute a scientific finding within the field of catharsis theories. Further, the examiner notes that the theory of catharsis treatment is not being rejected in the current application. The rejection of the claims begins with the language of claim 3, which makes the claim that a user's state of mind will be changed from one state to another through after completing the steps of the method. The general process of treating a user (as recited in claim 1) has not been rejected for the lack of a concrete result or reasonable expectation of success. Applicant has not shown that the claimed transformation of state, as recited in the rejected claims, provides for a reasonable expectation of success. The bushman reference is used as supportive evidence that the use of catharsis theory does not reasonably produce the claimed change in state.

103-Rejections

Applicant makes the assertion that Bumhat is not a legitimate prior art as 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". Further asserting that no one trying to solve the problems of the instant invention would have been able to find and/or apply it to the area. The bumhat reference is an electronic document. An electronic publication, including an on-line database or Internet publication, is considered to be a "printed publication" within the meaning of 35 U.S.C. 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 227, 210 USPQ 790, 795 (CCPA 1981). The applicant has admitted that it is known within the applicant's field of invention that it is known in the field that sticking pins into dolls is a known treatment methodology. It would not be unexpected that one practicing the therapy arts would be considering researching, using electronic database searches such as Google, for looking for articles, publications, blogs, public discussion forums, etc. related to the topic of providing visual representations of individuals to a person being treated. The bumhat reference readily appears in these searches, and would thus have been available to one of ordinary skill in the art.

The applicant further challenges the examiner's characterizations that the specification teaches the use of "voodoo dolls" as therapy. The examiner acknowledges that the applicant has not explicitly recited that the previous "stuffed dolls" are voodoo dolls. However, these sections of the specification do, very clearly, states that sticking pins into a stuffed doll or similar object as an outlet for cathexis is and has been known in the field. Applicant further goes on to state the "entertaining and relieving" aspects of the sections of the specification are different that the "treatment and therapy" of the instant invention. The applicant states that this is not a serious for of therapy. However, the "relief" of a feeling, emotion, ect, is exactly the intent of catharsis based therapy. Though the applicant is attempting to apply this to individuals which are subjects of abuse, not each claim is directed to this specific application. Claim 1, merely recites that the method is used for treatment of feelings of fear, anxiety, helplessness, powerlessness, or vulnerability. This use of the invention appears to be consistent in scope with those processes admitted to in the prior art.

Applicant asserts that the preambles of the claimed invention give life and meaning to the invention. However, the applicant has failed to show how the preamble of the claims actually breathes life and meaning into the claimed limitations. Merely stating that there would be no reason to perform the steps of the claimed invention unless the user knew what the purpose of them was. The steps of the claims could be performed absent this recitation of intended use. The applicant has failed to show how the recitation of intended use in the preamble of the claims actually ties to the steps being performed, and constitute more than the intent of the method (treatment). The claimed method steps could easily be performed as part of an experiment, not actual treatment, with the same potential effects. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc.v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir.1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir.1997) In the instant invention, the steps of the method provide for a complete invention absent their intended use as treatment or with specific individuals.

Lastly, applicant makes several assertions that the "art of record" fails to show specific features. However, these features are addressed in the rejection of the claims. The applicant has failed to show how the cited rejection and rationales shown therein, fail to provide a prima facie case of obviousness. The rejection of claims 16 and 18 is withdrawn in view of the amendments to the claims.

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, Xuan Thai can be reached on (571) 272-7147. 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 3715

December 06, 2008