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

7590 01/06/2006
Robert E. Bushnell
Suite 300
1522 K Street, N.W.
Washington, DC 20005-1202

EXAMINER

HARRIS, CHANDA L

ART UNIT PAPER NUMBER

3715

DATE MAILED: 01/06/2006

CA Response Due:
6 April 2006

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

Office Action Summary	Application No. 11/166,991	Applicant(s) STERN, RICHARD H.	
	Examiner Chanda L. Harris	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 27 June 2005.
- 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) 1-20 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4a) Of the above claim(s) _____ is/are withdrawn from consideration.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 and 16-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1-20 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 27 June 2005 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 (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/27/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14 and 16-19, drawn to a method for providing mental therapy, classified in class 434, subclass 236.
- II. Claim 15, drawn to a method for providing mental therapy for an AIDS patient having feelings of victimization, classified in class 434, subclass 236.
- III. Claim 20, drawn to cards, classified in class 40, subclass 124.01.

The inventions are distinct, each from the other because of the following reasons:

1. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation.
2. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation.
3. This application contains claims directed to the following patentably distinct species of the claimed invention: Group II (Claim 15).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently Group I (Claims 1-14 and 16-19), generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group III, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group III, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. During a telephone conversation with Robert Bushnell on 12/13/05 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-14 and 16-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15 and 20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

1. The disclosure is objected to because of the following informalities:

- p.6, line 20: "previously has" should be -- previously had --.

Appropriate correction is required.

- If Applicant intends to have consideration for any of the references disclosed

in the specification, Applicant needs to submit them on an Information Disclosure Statement (PTO-1449). For example, p.31, line 8, recites, "See, e.g., M.S. George et al. ...". In addition, Applicant must submit copies of all non-patent literature references that Applicant wants considered, and if they are electronic documents, Applicant must follow the guidelines set forth for citing electronic documents in MPEP 707.05 (e).

2. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

3. The use of the trademarks PALM PILOT, JAVA, ADOBE ACROBAT, FLASH, REALPLAYER, IRFANVIEW, WINDOWS 98, THUMBSPLUS have been noted in this application. Applicant is required to review the specification for any other instances of trademarks and make the appropriate corrections. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

4.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use. Particularly, Applicant is requested to place par. [0036] in the order specified below under heading (e).

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 112

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

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-14 and 16-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, it does not appear as if the invention could be practiced to produce a concrete result without undue experimentation. The factors set forth for a determination of undue experimentation are set forth in MPEP 2164.01(a), following the analysis in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). In this case, the examiner has considered each of these factors in arriving at the conclusion that the invention could not produce a concrete result without undue experimentation. The evidence in the application file has been considered for each of the factors as a whole and all of the factual considerations have been weighed. Specifically, the intended operation of the process is to provide mental therapy. The factors used in the process are subjective in nature with any result of the process being speculative at best. Applicant has not set forth any evidence or direction in the record that would lead one of ordinary skill in the art to be able to use the disclosed methods of and system for providing mental therapy and arrive at a specific, predictable result. The very low predictability of this invention due to the subjective nature of the elements used therein, coupled with the lack of direction provided by the specification and the subjective nature of the invention far out-weigh all other *Wands* factors when considering the necessity for undue experimentation.

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.

Claims 1-14 and 16-19 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 what Applicant means to claim by "or perceived by." Does Applicant mean perceive as 1) to become aware of directly through any of the senses or perceive as 2) to achieve understanding of or apprehend? Applicant already recites "visibly displayed", so does Applicant mean to encompass any of the other senses. Appropriate distinction is required.

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.

Claims 1-14 and 16-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

To satisfy section 35 USC 101 requirements, the claims must be for a practical application of the 101 judicial exception, which can be identified in various ways:

- The claimed invention "transforms" an article or physical object to a different state or thing.
- The claimed invention otherwise produces a useful, concrete and tangible result.

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 "determining whether said fear, anger, or negative thoughts or feelings of said first person have been reduce, and if not, returning to step 2", the first person's sentiments never change, than the first person is never transformed to a different state.

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 repeatable (e.g., causing said first person to undergo a transformation of mental state, said transformation comprising a reduction of said feelings of fear, powerlessness, vulnerability, or anger or providing a reduction of said fear, anger, or negative thoughts or feelings, or a reduction of or at least a partial discharge of said negative cathexis).

As indicated above, the claims are not considered to set forth patentable eligible subject matter and therefore are considered to be non-statutory.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Russell et al. (US 5,195,917)

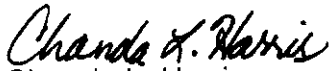
- tear-apart stress relief doll and method
- Lamson (US 6,425,764)
 - virtual reality immersion therapy for treating psychological, psychiatric, medical, educational and self-help problems
- Sloane et al. (US 5,813,863)
 - interactive behavior modification system
- Knight et al. (US 5,676,551)
 - emotional modulation of a human personality within the context of interpersonal relationship

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanda L. Harris whose telephone number is 571-272-4448. The examiner can normally be reached on M-F 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. 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).


Chanda L. Harris
Primary Examiner
Art Unit 3715

Notice of References Cited	Application/Control No. 11/166,991	Applicant(s)/Patent Under Reexamination STERN, RICHARD H.	
	Examiner Chanda L. Harris	Art Unit 3715	Page 1 of 1

U.S. PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A US-5,676,551	10-1997	Knight et al.	434/236
*	B US-5,813,863	09-1998	Sloane et al.	434/236
*	C US-6,425,764	07-2002	Lamson, Ralph J.	434/236
*	D US-5,195,917	03-1993	Russell et al.	446/97
	E US-			
	F US-			
	G US-			
	H US-			
	I US-			
	J US-			
	K US-			
	L US-			
	M US-			

FOREIGN PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N				
	O				
	P				
	Q				
	R				
	S				
	T				

NON-PATENT DOCUMENTS

*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U
	V
	W
	X

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.