



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/166,991	06/27/2005	Richard H. Stern	P57491	8974
	7590 06/18/2008			
Robert E. Bushnell Suite 300 1522 K Street, N.W. Washington, DC 20005-1202			EXAMINER MOSSER, KATHLEEN MICHELE	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 06/18/2008	DELIVERY MODE 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.

DETAILED ACTION

In response to the amendment filed 06/26/2008, claim 23 has been cancelled; claims 1-13, 16-19, 24 and newly added claim 25 are pending.

Claim Objections

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 claimed process must contain a sufficient tie to a machine, article of manufacture or a composition of matter. *In re Comiskey*, 84 USPQ2d 1670 (Fed. Cir. 2007). In *Comiskey*, the court provided guidance on the determination of patentable subject matter under 35 U.S.C. § 101. The court explained that "[t]he prohibition against patenting of abstract ideas has two distinct (though related) aspects." *Id.* at 1376. The court stated that, "[f]irst, when an abstract concept has no claimed practical application, it is not patentable Second, the abstract concept may have a practical application." *Id.* In the latter case where the abstract concept has a claimed practical application, the court noted "[i]n that context [of process claims directed to industrial processes], the Supreme Court has held that a claim reciting an algorithm or abstract idea can state statutory subject matter only if, as employed in the process, it is embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e. a machine, manufacture, or composition of matter. 35 U.S.C. § 101." *Id.*

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. The Specification does not appear to define any terms in the claimed process steps in a manner inconsistent with the plain usage of that term in the art. As plainly understood in the art, the claimed steps do not appear to be embodied in and do not appear to operate on, transform, or otherwise involve a machine, manufacture, or composition of matter. For example, to one of ordinary skill in the art, the phrase "causing to be visibly displayed to, or perceived by" broadly covers any means to cause a person to visualize a picture. That would include forming the image in the mind, i.e. a mental step. "Following the lead of the Supreme Court, this court [the Court of Appeals for the Federal Circuit] and our predecessor court [Court of Customs and Patent Appeals] have refused to find processes patentable when they merely claim a mental process standing alone and untied to another category of statutory subject matter even when a practical application was claimed." *Id.* at 1378. Claim 1 has a practical application, i.e., an industrial application, the treatment of patients. Claim 1 has three process steps that each recite similar language (i.e. "causing") that are not tied to another category of statutory subject matter and could be performed in the mind. As such, given the broadest reasonable construction of the claim in light of the specification as it would be interpreted by one of ordinary skill in the art, it would appear that each step of the claimed process covers subject matter which is not "embodied in, operates on, transforms or otherwise involves another class of statutory subject matter." *Id.* at 1376. As such, claim 1 is not directed to statutory subject matter." 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 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.
2. Claims 1, 13, 16, and 18 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

3. Applicant's arguments filed 02/26/2008 have been fully considered but they are not fully persuasive. The examiner has attempted to maintain the formatting and titling used by the applicant to address each of the arguments presented by the applicant. It is noted however, that in some instances heading are consolidated for the sake of brevity/

Claim Objections

The previous objections to the claims are withdrawn in view of the amendments to the claims.

Claim Rejections

I. 35 USC §101 and §112, 1st paragraph utility rejection

A. Claims 1-14, 18-19, and 23-24

The previous rejection of the claims has been withdrawn as the applicant has reasonably shown that their is a split opinion within the scientific community regarding the use of catharsis theory in the treatment of individuals. As there is not substantial evidence which further supports the community

adopting the views stated in the Bushman reference, the asserted utility of the present invention is being considered credible.

B. Claims 3-11, 13-14 and 24

1. Reasonable expectation of success

The applicant asserts that the examiner has failed to meet the burden of proof required to meet make the above assertion. Applicant asserts that the "minority view" of the Bushman reference is not substantial for providing such evidence. Though the examiner acknowledges that the Bushman reference does not provide substantial evidence to show that the described process employing well-known catharsis theories will never have a beneficial affect on a patient, the Bushman reference does raise reasonable question as to whether an application of catharsis theory will always or more often than not result in the transformation as claimed by the applicant.

2-3. Incorrect equation of concreteness to reasonable expectation of success and arguments concerning the concreteness of the invention

The applicant asserts that the examiner's equation of a reasonable expectation of success to the concreteness of the invention is unsupported, and further, in section 3 of the arguments, provides a different definition of concrete and arguments related thereto. From MPEP §2106:

"Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. 112, paragraph 1, where the invention cannot operate as intended without undue experimentation. See *infra*."

The above citation clearly shows that the examiner's equating of a reasonable expectation of success to the concreteness of the invention is supported by both prior case law and current USPTO practice and

procedure. As such, the applicant's arguments relating to a different definition of concreteness are considered moot.

II. 35 USC §112

The previous rejection of the claims is withdrawn for the same reasons stated above with respect to the previous 101 rejection for lack of utility.

III. Claim rejections under 35 USC §103-obviousness

A. Enablement of the bumhat reference

The applicant asserts that the bumhat reference does not contain an enabling disclosure because it is only an idea for a "neat" technology for someone else to "invent or develop it". According to MPEP 2121: "When the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. In re Sasse, 629 F.2d 675, 207 USPQ 107 (CCPA 1980)" Though the examiner acknowledges that the bumhat reference does not explicitly describe the exact computer programs, algorithms, or linked procedures required to implement the invention, the ability to make these programs is well within the ordinary skills of a computer programmer with experience in user interfaces. Scanning technologies, such as those needed to upload a picture of one's boss, were at the time of the references posting well-known in the art. The interaction techniques needed allow a user to manipulate the doll, or stick it with pins are common techniques known in at least the art of video game development and used throughout other areas computer interfacing. To support this assertion the examiner has cited the "Why its good to laugh at bin-Laden". In the abstract of this article the author references that in 2001, gamers were able to download images of Bin-laden into various video games. Applicant has not shown how the implementation of a program as described in the bumhat reference would be outside the abilities of one of ordinary skill in the art, the presumption of enablement is maintained.

B. bumhat's teaching and/or suggestion of the Invention

Applicant asserts that the bumhat's lack of teaching a therapy program for a person because of their suffering as an adverse reaction to a personal interaction with a second person is a major omission.

Applicant further asserts that a manner of treating the "rebellious homicidal impulses" asserted in the bumhat reference are not the same as reducing "fear, anxiety, feelings of helplessness, powerlessness, vulnerability, etc." of the claimed invention. The features being relied upon by the applicant to assert novelty/non-obviousness are each recitations of the intended use of the invention, particularly with respect to claim 1, are all recitations of the intended use of the invention. The applicant further asserts that there is no nexus to make the jump of obviousness as asserted by the examiner. However, the applicant has admitted in paragraph 6 of the specification of the specification, that the use of voodoo dolls is known for this type of treatment. In fact, the only downfall the applicant asserts to this process is the mass marketing of dolls with various appearances, and not necessarily allowing a personalized appearance of the individual. Both of these downfalls are overcome by the bumhat invention as it is a computerized simulation and allows for the user to download any image they wish. The applicant has even gone so far as to state that the disclosed invention has the same effects as known voodoo (see paragraph 9). As such, the rejection of the claims under 35 USC §103 asserting that using the invention of the bumhat for the purposes asserted by the claims would have been obvious to one of ordinary skill in the art are maintained. The examiner notes that the applicant makes several further assertions of features not taught by bumhat in several of the dependent claims (see pages 26 and 27 of the response), however a majority of these claims have not been rejected on the basis of the bumhat reference, and as such the arguments concerning such are moot.

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.

Application/Control Number:
11/166,991
Art Unit: 3714

Page 9

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

June 14, 2008

Notice of References Cited	Application/Control No. 11/166,991	Applicant(s)/Patent Under Reexamination STERN, RICHARD H.	
	Examiner Kathleen Mosser	Art Unit 3714	Page 1 of 1

U.S. PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A US-			
	B US-			
	C US-			
	D US-			
	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	"Why it's good to laugh at bin Laden"; Sam Leith, The daily Telegraph; London (UK), Nov 22, 2001. pg. 25
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.