

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ATLE HEDLOY

Appeal 2012-008147
Application 12/987,939
Technology Center 2100

Before ELENi MANTIS MERCADER, CARL W. WHITEHEAD JR., and
JASON J. CHUNG, *Administrative Patent Judges*.

MANTIS MERCADER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

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Appellant requested a rehearing of our Decision dated March 03, 2015, wherein we affirmed the rejections of claims 1–6.

Appellant contends that we narrowly focused our opinion on the disputed claim limitation of “analyzing in a computer process textual information in the document electronically displayed on the cell phone to identify a portion of that textual information as first contact information, without user designation of a specific part of the electronically displayed textual information to be subject to the analyzing,” as recited in claim 1, and we overlooked that the claim also requires “in a document configured to be stored with textual information for later retrieval” (Req. Reh’g 4).

In particular, Appellant argues that because the limitation recites “a document configured to be stored with textual information for later retrieval,” the textual information that is subject to the “analyzing” process must be in an entity (i.e., the document) that is “configured to be stored . . . for later retrieval” (Req. Reh’g 4). According to Appellant, the Board takes the position that the smaller box is a “document” within the meaning of claim 1 (Req. Reh’g 5). Appellant points to the Board’s agreement with the Examiner who “mapped the electronic contact information within the smaller box to ‘textual information in the document electronically displayed,’ as recited in claim 1 (Ans. 15)” (Dec. 5–6) (Req. Reh’g 7). Appellant argues that nothing in the Figures (referring to Dec. 6–7, Spencer’s Figs. 4–5 and col. 9, ll. 5–50) and the recited passage relied on by the Board demonstrates that the smaller box of Spencer is a “document configured to be stored with textual information for later retrieval” (Req. Reh’g 7–8). According to Appellant, rather than being part of the textual display portion 206, the smaller box in Figure 4 is created solely to display

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intermediate results in parsing, and thus, storage of the contents of the smaller box is unnecessary (Req. Reh’g 10).

Appellant asserts that this argument is not new because it was first presented in the Reply Brief page 12, arguing that the passage emphasized with the smaller box in Figure 4 of Spencer is a window giving results of parsing, and thus, not part of the original e-mail (Req. Reh’g 10–12). Appellant concludes that the smaller box is not a “document” as required by claim 1 (Req. Reh’g 10–12).

Appellant further argues that if the document is considered the entire e-mail, to parse a document for contact information using the Spencer system, the user must select the part of the document containing the contact information to be parsed, and yet, the claim limitation of “without user designation of a specific part of the electronically displayed textual information to be subject to the analyzing” rules out this possibility (Req. Reh’g 12–15).

We note that Appellant did not raise in the original Appeal brief the argument that claim 1 also requires “in a document configured to be stored with textual information for later retrieval” (*see* App. Br. 12–20). To the extent that Appellant raised the argument that the smaller box does not constitute a “document,” that argument was raised as admitted by Appellant, for the first time in the Reply Brief page 12 (Req. Reh’g 10). Only arguments made by Appellant in the original Appeal Brief were considered in our decision. Arguments raised for the first time on appeal in the Reply Brief are deemed waived. *See Optivus Tech., Inc. v. Ion Beam Appl’ns S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (“[A]n issue not raised by an appellant in its opening brief, . . . is waived.”) (citations and quotation marks omitted);

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see also Ex parte Scholl, No. 2007-3653, slip op. at n.13 (BPAI Mar. 13, 2008) (informative), available at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd073653.pdf>. Thus, the newly raised argument that the limitation “in a document configured to be stored with textual information for later retrieval” is not met by Spencer and the argument that the smaller box does not constitute a “document,” raised for the first time in the Reply Brief, were waived by Appellant.

Nonetheless, Appellant’s characterization of our findings is misconstrued, and thus, we address Appellant’s contentions to the extent that we clarify the Examiner’s findings and our affirmance based on those findings. Contrary to Appellant’s contention, the Board never took the position that the smaller box as being the “document” within the meaning of claim 1 (*see* Req. Reh’g 5). While Appellant equated the textual information inside the smaller box of message 206 of Spencer as the “*specific* part of the electronic displayed textual information” (emphasis added), we agreed with the Examiner that the textual information inside the smaller box of message 206 of Spencer constituted the “*textual information* in the document electronically displayed” for analysis (*see* Ans. 14 and Dec. 6). That does not mean that the document which we view as the message 206 of Spencer does not constitute the document, but only that the textual information in the smaller box constitutes the information of the document that will be analyzed. Even if we were to agree with Appellant that Figure 4’s smaller box already indicates results of parsing because of the heading “ARRAY OF FIELD” values, this does not negate that for the parsing to begin there is a selection of that portion of the document for parsing analysis. Just because that snap shot of Figure 4 was taken after the

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processing started it does not vacate the finding that there was a user selection of that portion of the document that triggers the parsing (*see* col. 9, ll. 24–27 stating that “a user may select electronic contact information from within the electronic information section 206” (i.e., corresponding to the claimed “textual information in the document electronically displayed”)).

We further agreed with the Examiner that field labels such as name, phone number, fax number, and their values are automatically recognized and extracted from the textual information without any user designation of *a specific portion of the text* (see Ans. 14 and Dec. 5–7), and thus, meeting the claim limitation of “analyzing in a computer process *textual information in the document* electronically displayed on the cell phone to identify a portion of that textual information as first contact information, *without user designation of a specific part of the electronically displayed textual information* to be subject to the analyzing,” as recited in claim 1. Nowhere does the claim require that the *entire* content of the document (i.e., message 206) be analyzed but rather that *textual information in the document* be analyzed.

The claim is further met because *no specific* designation is required by the user of *each of the individual fields within the smaller box* (see Ans. 14 and Dec. 5–7). As we stated in our opinion:

[w]e agree with the Examiner (Ans. 14) that Spencer (col. 9, ll. 5–50) teaches an analyzing step by parsing the entire displayed contact information to identify different fields and field values (Ans. 14). Field labels such as name, phone number, fax number, and their values are automatically recognized and extracted from the textual information *without any user designation* of a specific portion of the text (Ans. 14). Thus, we agree with the Examiner (Ans. 14) that Spencer therefore analyzes the entire textual information (i.e., the

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electronic contact information within the smaller box of Figure 4), without user designation of *a specific part* (i.e., without user designation of *a specific field/line/sentence* within the smaller box such as "Adam B. CONROY PHONE: (999) 555-1111)"" as claimed (*see* col. 9, 11. 5–50 and Figs. 4–5). Nothing in the claim requires that the "entire textual information" (i.e., smaller box of Figure 4) cannot be user designated. Claim 1 only requires that there is no user designation *of a specific part of the electronically displayed textual information to be subject to the analyzing*.

Dec. 6–7. In other words, the claim does not preclude a general designation of *the textual information to be analyzed* (i.e., textual context of the smaller box), and only requires that there is no user designation *of the specific part of the electronically displayed textual information* (i.e., there is no *specific designation of each of the fields within the smaller box*).

Appellants' request for rehearing has been granted to the extent that our decision has been reconsidered, but such request is denied with respect to making any modifications to the decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING DENIED

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