

Remarks

Reconsideration of the above-captioned application is respectfully requested. The fact that Applicant has focused its comments distinguishing the present claims from the applied references and countering certain rejections must not be construed as acquiescence in other portions of rejections not specifically addressed.

A. Obviousness rejections, Claims 1, 2, 4-6, 9-12, 17, 18, 20, and 21 based on Al-Shaykh (“Al”) and Yamaguchi

i. Independent Claims 1, 9, and 17

Claim 1 recites in part that the instructions are executable by the processor to determine a second device different from the first device on which to present the output based at least in part on ***identification by the first device of the second device as having a relatively larger display*** on which to present the output than the first device. Claim 9 recites in part that the method includes ***determining*** a device at which to present the output at least in part ***based on the device having a relatively larger display*** on which to present the output than the apparatus. Claim 17 recites that the instructions are executable for determining a second device on which to present the output based at least in part on ***identification of the second device as having a relatively larger display*** on which to present the output than the first device.

After conceding that Al does not disclose the limitations at issue, the rejections resort to Yamaguchi’s paragraphs 7, 8, and 36. However, the problem with these portions of Yamaguchi is

the same problem with AI that has already been conceded by the examiner – the relied-upon portions of Yamaguchi fail to disclose, taking Claim 1 as an example, *identification* of a relatively larger display by a device.

Paragraph 7 at best discloses that images can be sent to a television or other host display and that the television/host display “provides” a large venue display of the images relative to the small LCD display of a cell phone. What is missing from this paragraph is any sort of disclosure of a device that actually *identifies* the television/host display as having a relatively larger display in a way fairly approaching Claims 1 and 17 or of a method including *determining* a device at which to present the output at least in part *based on* the device having a relatively larger display in a way fairly approaching Claim 9. In fact, it appears paragraph 7 merely *assumes* images get sent to the television/host display without any sort of identification or determination regarding the size of the television/host display being performed. Accordingly, an explicitly recited step from the claims is altogether missing from Yamaguchi’s paragraph 7.

Yamaguchi’s paragraph 8 is even further afield. It merely indicates that images can be displayed on Yamaguchi’s host display and can be downloaded to a requesting cell phone or camera. So, it too fails to disclose anything fairly approaching the limitations at issue. Moreover, paragraph 8 does not even have 16 lines as the careless rejections allege (see, e.g., page 3 of the Office Action). Paragraph 8 is not on page 2 of the reference as the rejections allege, either.

As for paragraph 36 of Yamaguchi, at best relied-upon lines 5-9 disclose image data being uploaded to the host display or received from the host display. Again nothing is disclosed that

indicates Yamaguchi's device *identifies* the host display as having a "relatively larger display" than something else in a way fairly approaching Claims 1 and 17 or that it makes any sort of *determination* that is *based on* the host display having a "relatively larger display" than something else in a way fairly approaching Claim 9. So, here too an explicitly recited step from the claims is altogether missing from the relied-upon portion of the reference. The rejections of all claims merit reversal for the foregoing reasons alone.

ii. Claims 4 and 20

Claim 4 recites in part that the instructions are executable to determine a second device different from the first device on which to present the output based at least in part on *identification* by the first device of the second device as having a relatively larger display *with a relatively higher resolution than the first device*. Here too the relied-upon portion of the reference fails to disclose any such identification. Specifically, Yamaguchi's paragraph 40 only indicates that the display 560 can have a "greater resolution". No determinations or identifications are disclosed at this portion as being made *based on* the "greater resolution". Reversal of the rejection of Claim 4 is appropriate.

Additionally, Applicant notes that since Claim 20 has been summarily rejected on similar grounds as Claim 4, its rejection also merits reversal at least for the foregoing reasons.

iii. Claim 5

This claim recites that the instructions are executable by the processor to determine the second device on which to present the output at least in part based on a determination that the second device is on a list of approved output devices *that is configured by a user*. Al's Figure 10 has been relied-upon for the rejection of this claim, with it being alleged that "available renderers 7" somehow reads on this limitation. However, Figure 10 on its face fails to disclose how this presentation of "available renderers" might have been made, much less does it specifically indicate that this allegedly analogous "list" was *configured by a user*. Reversal is appropriate.

iv. Claims 6 and 21

Claim 6 recites that the instructions are executable to determine the second device on which to present the output at least in part based on a determination of *an application to be launched to present the output*. It has been alleged that Al's paragraph 163 discloses the foregoing. However, it does not.

This paragraph at best indicates that a target rendering device may be selected based on the "media in context" in the video player application. This paragraph says nothing about launching the video player application, much less that any *determination* is made involving *an application to be launched* to present the "media in context". This paragraph stands for nothing more than the proposition that a video player application exists in Al. Reversal of the rejection of Claim 6 is appropriate.

Additionally, Applicant notes that since Claim 21 has been summarily rejected on similar grounds as Claim 6, its rejection also merits reversal at least for the foregoing reasons.

v. *Claim 11*

Claim 11 recites that the determining the device at which to present the output is based at least in part on identification by the apparatus of the device as having a relatively larger display with a relatively higher resolution than the first device. In contrast, the relied-upon portion of Yamaguchi's paragraph 40 only indicates that the display 560 can have a "greater resolution". No determinations or identifications are disclosed at this portion as being made *based on* the "greater resolution". Reversal is appropriate.

vi. *Claim 12*

Claim 12 recites that the determining the device at which to present the output is based at least in part a determination of an application to be launched to present the output. It has been alleged that Al's paragraph 163 discloses the foregoing. However, it does not.

This paragraph at best indicates that a target rendering device may be selected based on the "media in context" in the video player application. This paragraph says nothing about launching the video player application, much less that any *determination* is made involving *an application to be launched* to present the "media in context". This paragraph stands for nothing more than the proposition that a video player application exists in Al. Reversal is appropriate.

B. Obviousness rejections, Claim 16 based on Al, Yamaguchi, and Jackson

Claim 16 does not simply recite “a determination that the device is observable to a person” as indicated at page 9 of the May 5, 2017 Office Action. It recites determining a device at which to present the output at least in part based on a determination that the device is observable to a person *while the determining of the device at which to present the output is performed*. The portion of the claim emphasized in the preceding sentence has not even been acknowledged in the Office Action, let alone adequately addressed using evidence. Furthermore, the relied-upon portion of Jackson’s col. 13 merely discusses updating information “in anticipation of viewing by the user” and thus fails to fairly approach the limitations at issue. Reversal is appropriate for failure to recognize and adequately address all limitations of Claim 16.

C. Motivations to combine, all obviousness rejections

All of the obviousness rejections supply a wholly inadequate motivation to combine the references. For one, none of the rejections cite any evidence in support of the proffered motivations to combine. But without such evidence, the motivations to combine appear to be nothing more than conclusory allegations while using Appellant’s claims as a convenient template from which to impermissibly work backward. Indeed, these allegations are precisely the type of conclusory ones prohibited by *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) at 418.

Taking the rejections of the independent claims as an example, the proffered motivation to combine the references is to “present the output in a substantially larger display for improved or enhanced image presentation.” That’s it. No evidence. The Office Action simply moves on to other rejections from there. That is wholly insufficient according to controlling law on obviousness.

First, in addition to precisely these types of conclusory allegations being prohibited by the U.S. Supreme Court in *KSR, supra.*, the *KSR* Court also indicated that there must be some articulated reasoning with some rational underpinning to support a legal conclusion of obviousness, *KSR, supra.* at 418-419. This standard, while perhaps somewhat nebulous, is not unmoored from evidence. According to the Court, the “rational underpinning” is to be drawn from “inferences and creative steps that a person of ordinary skill in the art would employ” to arrive at the claims, and the Court noted that petitioner KSR Int’l Co. actually provided evidence of such when presenting its case.

As to the present rejections, they have failed to demonstrate a legally sufficient “rational underpinning” for concluding that a modification to the references to arrive at the claims can safely be drawn from “inferences and creative steps that a person of ordinary skill in the art would employ” because there has been no *evidence* placed on the record as to what those inferences and creative steps might be. Rather, the rejections merely allege, absent any citation to evidence predating the present application’s filing date, that the Examiner presently sees reasons for the proposed combinations. However, the Court in *KSR supra.* was not so limitless, instead indicating the following: “The question is... whether the combination was obvious to a person with ordinary skill in the art. Under the correct analysis, any need or problem known in the field of endeavor *at the time of*

invention and addressed by the patent can provide a reason for combining the elements in the manner claimed [emphasis added].” *KSR, supra.* at 420.

Accordingly, because the rejections do not demonstrate that the alleged motivations to combine the references were evident in Appellant’s field of endeavor at the time of Appellant’s filing date rather than when the rejections themselves was made, reversal is appropriate per *KSR*.

In addition to the foregoing, the obviousness rejections also fail to comply with recent precedent from the Court of Appeals for the Federal Circuit (CAFC). *In re Nuvasive, Inc.*, 842 F.3d 1376 (Fed. Cir. 2016) is instructive here. In *Nuvasive*, the CAFC reversed the PTAB for an inadequate motivation to combine references to support an illegal obviousness finding. The CAFC observed that the PTO must articulate a rational connection between the facts found and the holding it makes, which is not satisfied when the PTAB never articulated *why* the additional information of the secondary references would benefit a person having ordinary skill in the art (“PHOSITA”) when implementing the primary reference or *how* the PHOSITA would use that information when implementing the primary reference. *Nuvasive, supra.* at 1384. This results in a failure to articulate a reason why the PHOSITA would have been motivated to modify the references. *Nuvasive, supra.* at 1384-1385.

Accordingly, in addition to running afoul of *KSR*, the obviousness rejections also fail to rise to even the deficient level found to be inadequate in *Nuvasive*, instead articulating rationales not alleged to be present in any reference and without sufficiently explaining why those rationales would

lead to the motivation to combine the secondary references (e.g., Yamaguchi and Jackson) with the primary reference (A1) when implementing the primary reference.

Even more recently, the CAFC's precedential opinion in *Personal Web Technologies, LLC v. Apple, Inc.*, 2016-1174 (Fed. Cir. 2017) approvingly cites *Nuvasive* and expands on it in reversing a PTAB conclusion of obviousness based on two references because the PTAB's reasoning was deficient in its finding that a relevant skilled artisan would have had a motivation to combine the references in the way claimed and would have had a reasonable expectation of success in doing so. At page 11 of the slip opinion, the CAFC noted that the PTAB merely stated that a person of ordinary skill in the art reading the references would have understood that the combination would have allowed for the selective access features of one reference to be used with the features of the other reference, which was deficient because it says "no more than that a skilled artisan, once presented with the two references, would have understood that they *could be* combined [emphasis original]. And that is not enough: it does not imply a motivation to pick out those two references and combine them to arrive at the claimed invention. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) ('[O]bviousness concerns whether a skilled artisan *not only could have made but would have been motivated* to make the combinations or modifications of prior art to arrive at the claimed invention [emphasis original].')

The foregoing from *Personal Web Technologies* is in conformance with *Nuvasive* itself, which indicated that "the PTAB never actually made an explanation-supported finding that *the evidence* affirmatively proved that the PHOSITA *would have* sought this additional information

[emphasis added]”, *Nuvasive, supra.* at 1384. Indeed, the obviousness allegations made against the claims of the present application are particularly akin to the insufficient allegations in *Nuvasive* and *Personal Web Technologies*. Again taking the rejections of the independent claims as an example, the proffered motivation to combine the references is to “present the output in a substantially larger display for improved or enhanced image presentation.” At most, that amounts to an allegation that a PHOSITA *could have* made the proposed combinations once presented with the two references, not that a PHOSITA *would have been motivated* to make the proposed combinations as proven *using evidence*.

Even more recently than that, on May 11, 2017 the CAFC again criticized a lack of evidence when the Patent Office made an obviousness rejection: “But the Board did not cite any evidence, either in the asserted prior-art references or elsewhere in the record, with sufficient specificity for us to determine whether a person of ordinary skill in the art would have been so motivated.” *Rovalma, S.A. v. Bohler-Edelstahl GMBH & Co.*, Appeal No. 2016-2233, page 10 of the slip opinion.

Accordingly, in addition to the identifications/determinations from the claims being altogether missing from the references as demonstrated in the preceding sections, the rejections also fail to provide legally sufficient motivations to combine the references. Reversal is appropriate.

D. Conclusion

The remaining rejections merit reversal at least for reasons set forth above. The PTO has tried four times now to reject the limitations at issue, all without success. One rejection was even a

reopening of prosecution after Applicant appealed other rejections that were also inadequate. It's time for the PTO to allow the case.

Notwithstanding allowance being the only appropriate action from the PTO moving forward, Applicant nonetheless notes that it does not agree with various other positions taken in the current rejections and preserves the right to address those positions specifically and individually in the future, such as in another appeal if those positions persist and another appeal becomes necessary.

Also, note that at least because independent Claims 9 and 17 have not been amended herein and because independent Claim 1 has merely been amended to recite at least one processor, any subsequent Office Action containing new grounds of rejection with respect to these claims and made final would be improper. MPEP 706.07(a).

Further, note that in the event another rejection is made against Claims 1, 9, or 17 that contains a new claim construction and/or rationale, that claim construction and/or rationale would also constitute a new ground of rejection that cannot be made final because it would rely on "new facts and rationales not previously raised to the applicant by the examiner." *In re Leithem*, 661 F.3d 1316, 1319 (Fed. Cir. 2011). See also *In re Stepan Co.*, 660 F.3d 1341, 1344 (Fed Cir. 2011) and *In re Kumar*, 418 F.3d 1361, 1367-68 (Fed. Cir. 2005).

Applicant hereby rescinds any disclaimer that may have arisen for any reason including by way of amendment, cancelation, election, or argument in any prior paper in this or any related application.

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The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

Respectfully submitted,

/John L. Rogitz/

John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

JLR:jg