THE IP MASTER CLASS WEBINAR SERIES

CITATIONS

SLW INSTITUTE
Building Extraordinary IP Assets

MEET THE PRESENTER

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- Senior Patent Attorney
- Over 10 years of patent prosecution and opinion drafting experience.
- Prosecution experience includes application drafting, response writing, After Final practice, and post-grant proceedings.
- Opinion drafting experience includes right-to-use, non-infringement, and invalidity opinions.
- Member of Quality Assurance teams for reviewing associate work product.

CITATIONS: TOPICS COVERED

- Introduction: The Purpose of Citations
- Citation Structure: When is the short citation appropriate?
- Difference Types of Citations: In-line, Footnotes, & Endnotes
- Choosing the Reporter: Which Reporter Do I Cite?
- Citing to Agency Materials
- Citing to Patent Literature: Patents and Published Applications

CITATIONS: TOPICS COVERED

- Everyone is Named “Smith”: Citing to Patent and Non-Patent References with the Same Author
- Citing to Non-Patent Literature References
- How and When To Quote: In-line Quotations vs. Block Quoting
- Citation Signals: What Do They Mean and How To Use Them
- Has It Been Reported: Citing to Slip Opinions

INTRODUCTION: THE PURPOSE OF CITATIONS

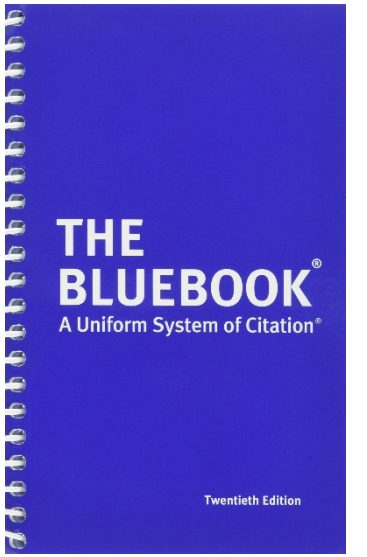
- What is the purpose of citations?
  - Authority
    - Provides legal authority for a proposition in your writing.
  - Evidence
    - Provides empirical evidence for supporting your argument in your writing.
  - Additional or background information
    - Provides additional information about the referenced material and its connection to the your argument.

INTRODUCTION: THE PURPOSE OF CITATIONS (CON'T)

- What is the purpose of citations?
  - Identification
    - Identifies the document and document part to which the writer is referring.
  - Uniformity
    - Provides consistency in identifying those documents and document parts.

INTRODUCTION: THE BLUEBOOK

- How does a writer know how to structure his or her citations?
- Go to the source: The Bluebook: A Uniform System of Citation, 20th Edition.
- Available here: https://www.legalbluebook.com/
- Every patent practitioner should have a copy in his or her library!



INTRODUCTION: CHANGES IN THE 20TH EDITION

- There are about 27 rule changes and/or revisions since the 19th edition of The Bluebook.

- The Preface of the 20th Edition lists these changes.
  - Most are not relevant to this presentation.
  - Some relevant changes are listed on the next two slides.

INTRODUCTION: CHANGES IN THE 20TH EDITION (CON'T)

- **Rule 10.2.2** clarifies that words in a case name that would be abbreviated according to table T6 should not be abbreviated if the words are part of a state, country, or other geographical unit that is the entire name of a party.
  - This rule may apply in some circumstances where the

- **Rule 10.9(a)(iii)** provides additional guidance on the formation of slip opinion short forms.
  - Rule 10 applies to cases and judicial opinions.

- **Rule 14.2(b)** has been expanded to include detailed information on citing comments to agencies.
  - Rule 14 applies to agency citations, which includes memorandum.

INTRODUCTION: CHANGES IN THE 20TH EDITION (CON'T)

- **Rule 15.9(c)** [NEW!] introduces a citation format for ebooks, stipulating that the print versions of books are authoritative, but that ebooks may be cited if they are the sole media through which the book is available.
  - This situation is becoming more prevalent as Examiner's rely on non-patent literature solely available from electronic databases and websites.

- **Rule 18.2.1(b)(ii)** provides for the direct citation of Internet sources that share the characteristics of a print source such that they can be fully cited according to another rule, whether or not the source is in print.
  - Rule 18 covers the citation of information found on the Internet. In some instances, the reference may be fully citable as if it were located in a print source. This rule states to cite the source *as if* it were found in print, but then to provide a URL for the reference.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Whenever a case is first introduced, the case should be cited in its entirety.

- A “full citation” typically includes five components
  - the name of the case;
  - the published or unpublished source in which the case can be found;
  - a parenthetical indicating the court and year of decision;
  - other parenthetical information, if any; and,
  - the subsequent history of the case, if any.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Full Citation Examples:
  - **A:** *Alice Corp. v. CLS Bank Int'l*, 110 U.S.P.Q.2d 1976 (U.S. 2014).
  - **B:** *Alice Corp. v. CLS Bank Int'l*, 110 U.S.P.Q.2d 1976, 134 S. Ct. 2347 (2014).
- **A** and **B** are both appropriate for citing in your writing.
- **B** is referred to as a "parallel citation" because it includes a citation to both the United States Patent Quarterly (USPQ) and the Supreme Court Reporter (S. Ct.).
- Notice the subtle difference between **A** and **B**.
- The name of the court is omitted from the parallel citation in **B** because the name of the court is evident from the named reporter. This is not *always* the case.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Example 1: *Alice Corp. v. CLS Bank Int'l*, 110 U.S.P.Q.2d 1976 (U.S. 2014).

> 15. The above limitations are all similar to a method of organizing human activity such as the receiving, processing, and storing data (See Alice Corp., 134 S. Ct. at 2360), and electronic record keeping (See Alice Corp., 134 S. Ct. at 2359) wherein "certain methods of organizing human activity" is used to describe concepts relating to interpersonal and intrapersonal activities, such as managing relationships or transactions between people, social activities, and human behavior; satisfying or avoiding a legal obligation; advertising, marketing, and sales activities or behaviors; and managing human mental activity.

- The first citation to any case should be the full citation, including the name of the legal reporter in which the case is found.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Example 2: *Alice Corp. v. CLS Bank Int'l*, 110 U.S.P.Q.2d 1976 (U.S. 2014).

In *Mayo Collaborative Services v. Prometheus Laboratories Inc.*, 101 U.S.P.Q.2d 1961 (U.S. 2012), the Supreme Court established a two-step analytical framework to determine whether the claims of a patent are directed to an abstract idea. One must first "determine whether the claims at issue are directed to a patent-ineligible concept." (*Alice Corp. v. CLS Bank Int'l*, 110 U.S.P.Q.2d 1976, 1981 (2014).) The Supreme Court has recognized that "all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas." (*Mayo* at 1965.)

- The author introduced the full citation of the case, but the citation is improper.

- If multiple courts are covered by the same reporter (e.g., U.S.P.Q., F.3d, etc.), you need to identify the court!

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Only *after* the full citation has been introduced, may you then use the short form of the citation.

- Three general principles for providing the short form citation:
  - Clear to the reader which authority is being referenced;
  - The full citation falls in the same general discussion; and
  - The reader will have little trouble locating the full citation.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- When using only one part name in short form, use the name of the first party.

- *Unless* the first party is a geographical unit, a governmental entity, or another type of common litigant.
  - This exception rarely applies in patent prosecution or patent litigation.

- Can shorten a longer name to a shorter name, so long as the reference remains unambiguous.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Example 1:
  - *Alice Corp. v. CLS Bank Int'l*, 110 U.S.P.Q.2d 1976, 1978 (U.S. 2014).
  - Proper forms:
    - *Alice* at 1980.
    - 110 U.S.P.Q.2d at 1980.
    - *Id.* at 1980.
  - Not proper:
    - *Alice Corp.* at 1980 (U.S. 2014).
    - *Alice Corp. v. CLS Bank* at 1980.
    - 110 U.S.P.Q.2d 1976 at 1980.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Example 2:
  - *Accenture Global Servs., GmbH v. Guidewire Software, Inc., 108 U.S.P.Q.2d 1173 (Fed. Cir. 2013)*
  - Proper forms:
    - *Accenture* at 1176.
    - 108 U.S.P.Q.2d at 1176.
    - *Id.* at 1176.
  - Not proper:
    - *Accenture Global Servs.* at 1176 (Fed. Cir. 2013).
    - *Guidewire* at 1176.
    - *Accenture v. Guidewire* at 1176.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Parallel Citations
  - Parallel citations include citing to two different reporters.
  - Parallel citations are appropriate in most circumstances.
  - If parallel citing – be consistent!
  - If parallel citing to the Court of Appeals for the Federal Circuit, cite to the United States Patent Quarterly (U.S.P.Q.) and the Federal Reporter (e.g., F.3d)
  - If parallel citing to the Supreme Court, cite to the United States Patent Quarterly and the Supreme Court Reporter.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Parallel Citations, Example 1
  - Proper: *Alice Corp. v. CLS Bank Int'l*, 110 U.S.P.Q.2d 1976, 134 S. Ct. 2347 (U.S. 2014)
  - In this first example, the parallel citation includes the citation to the United States Patent Quarterly and the Supreme Court Reporter.
  - Subsequent citations to this case should include *both* citations.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Parallel Citations, Example 2
  - Proper: *Classen Immunotherapies Inc. v. Biogen IDEC*, 100 U.S.P.Q.2d 1492, 659 F.3d 1057 (Fed. Cir. 2011)
  - In this second example, the parallel citation includes the citation to the United States Patent Quarterly and the Federal Reporter.
  - Subsequent citations to this case should include *both* citations.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Parallel Citations, Short Form
  - Similar rule applies to the case name.
    - Use the name of the first party.
    - Can shorten a longer name to a shorter name, so long as the reference remains unambiguous.
  - With parallel citations, you should include both of the reporters in the short form.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Parallel Citations, Short Form

- Example 1: *Alice Corp. v. CLS Bank Int'l*, 110 U.S.P.Q.2d 1976, 134 S. Ct. 2347 (U.S. 2014)
  - Proper:
    - *Alice*, 110 U.S.P.Q.2d at 1978, 134 S. Ct. at 2348.
    - 110 U.S.P.Q2d at 1978, 134 S. Ct. at 2348.
    - *Id.* at 1978, 134 S. Ct. at 2348

  - Improper:
    - *Alice*, 110 U.S.P.Q.2d at 1978.
    - *Alice*, 134 S. Ct. at 2348
    - *Id*.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Using "*id.*":
  - Shorthand used to refer to an immediately preceding authority.
  - If a different page is being referenced in the preceding authority, append the word "at" to "*id.*" and include the page number.
  - If using "*id.*" with a parallel citation, include both sources.
  - Don't forget to italicize (or underline) the word "*id.*" – including the period.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Using "*id.*" – Example 1: Identical citation

In analyzing claims under the *Alice/Mayo* framework, the Court of Appeals for the Federal Circuit (CAFC) has recognized that "it is of course now standard for a § 101 inquiry to consider whether various claim elements simply recite "well-understood, routine, conventional activit[ies]." (*BASCOM Glob. Internet Servs. v. AT& T Mobility, LLC*, 119 U.SP.Q.2d. 1236, 1242 (Fed. Cir. 2016).) However, "[t]he inventive concept inquiry requires more than recognizing that each claim element, by itself, was known in the art. As is the case here, an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces." (*Id.*)

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Using "*id.*" – Example 2: Same opinion, but on a different page

In *BASCOM*, the Court noted that "the limitations of the claims, taken individually, recite generic computer, network and Internet components, none of which is inventive by itself." (*BASCOM* at 1242.) Nevertheless, the Court stated, "an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces," *id.*, holding that there was nothing in the record to refute BASCOM's allegations that "the ordered combination of claim limitations that transform the abstract idea of filtering content into a particular, practical application of that abstract idea." (*Id.* at 1244.)

  - Notice the change in capitalization of "*id.*" when used as a citation clause rather than a citation sentence.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Using "*id.*" – Example 3: Same opinion, but with parallel citations

In *BASCOM*, the Court noted that "the limitations of the claims, taken individually, recite generic computer, network and Internet components, none of which is inventive by itself." (*BASCOM*, 119 U.S.P.Q.2d at 1242, 827 F.3d at 1349.) Nevertheless, the Court stated, "an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces," *id.* at 1242, 827 F.3d at 1350, holding that there was nothing in the record to refute BASCOM's allegations that "the ordered combination of claim limitations that transform the abstract idea of filtering content into a particular, practical application of that abstract idea." (*Id.* at 1244, 827 F.3d at 1352.)

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Using "*id.*" – Example 4: Two different authorities being cited in the same sentence.

To determine whether a particular exercise of non-lethal police force was reasonable, courts engage in a balancing process. (*Tennessee v. Garner*, 471 U.S. 1, 8 (1985); *see also* *Heath v. Henning*, 854 F.2d 6, 8 (2d Cir. 1988).) This process weights the nature of the exertion of force against the governmental interests at stake. (*See id.* at 9.)

- The use of "*id.*" in this instance is improper because it is unclear to which authority the "*id.*" refers.

CITATION STRUCTURE: WHEN IS THE SHORT CITATION APPROPRIATE?

- Summary
  - Always introduce a case by its full citation form first.
  - Short citation should only list the first party and after the authority has been introduced in full citation form.
  - When using parallel citations – be consistent!
  - Watch the use of "*id.*"!

DIFFERENCE TYPES OF CITATIONS: IN-LINE, FOOTNOTES, & ENDNOTES

- In *non-academic*, legal documents, citations generally appear within the text of the document immediately following the proposition they support.

- This style is sometimes referred to as “in-text” or “in-line” citation.

- The in-text or in-line citation may appear offset by parentheticals.
  - Note: The Bluebook does not actually require this, but it can be helpful in readily identifying cited sources in your writing.

DIFFERENCE TYPES OF CITATIONS: IN-LINE, FOOTNOTES, & ENDNOTES

- Footnotes should only be used in non-academic, legal documents when permitted or as required by local court rules.

- Endnotes should only be used in academic writing.

- In drafting appeal briefs, pre-appeal brief conference requests for review, or responses to Office Actions, your writing should include in-line citations or footnotes.

DIFFERENCE TYPES OF CITATIONS: IN-LINE, FOOTNOTES, & ENDNOTES

In-line Citation	Footnote
Immediately identifies the source of the proposition.	Requires that the reader move his or her attention to another portion of the page.
Allows the reader to continue the sentence or paragraph without distraction.	Can disrupt the reader and distract from the argument being presented.
Difficult to add additional or explanatory information.	Easier to add explanatory or additional information that may be relevant but not directly on point.

DIFFERENCE TYPES OF CITATIONS: IN-LINE, FOOTNOTES, & ENDNOTES

- When deciding between whether to use in-line citation or footnoting, be consistent.

- Don’t “mix ’n match” in-line citations with footnote citations.

- If using both in-line citations and footnotes, use the footnotes to add explanatory detail and the in-line citations to cite immediately to the source.

DIFFERENCE TYPES OF CITATIONS: IN-LINE, FOOTNOTES, & ENDNOTES

- Example 1: In-line Citation

In *Mayo Collaborative Services v. Prometheus Laboratories Inc.*, 101 U.S.P.Q.2d 1961, 132 S. Ct. 1289 (2012), the Supreme Court established a two-step analytical framework to determine whether the claims of a patent are directed to an abstract idea. One must first "determine whether the claims at issue are directed to a patent-ineligible concept." (*Alice Corp. v. CLS Bank Int'l*, 110 U.S.P.Q.2d 1976, 1981, 134 S. Ct. 2347, 2349 (2014).) The Supreme Court has recognized that "all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas." (*Mayo*, 101 U.S.P.Q.2d at 1965, 132 S. Ct. at 1294.)

DIFFERENCE TYPES OF CITATIONS: IN-LINE, FOOTNOTES, & ENDNOTES

- Example 2: Footnotes

In *Mayo*, the Supreme Court established a two-step analytical framework to determine whether the claims of a patent are directed to an abstract idea.[1] One must first "determine whether the claims at issue are directed to a patent-ineligible concept."[2] The Supreme Court has recognized that "all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas."[3]

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[1] *Mayo Collaborative Services v. Prometheus Laboratories Inc.*, 101 U.S.P.Q.2d 1961, 132 S. Ct. 1289 (2012).
[2] *Alice Corp. v. CLS Bank Int'l*, 110 U.S.P.Q.2d 1976, 1981, 134 S. Ct. 2347, 2349 (2014).
[3] *Mayo*, 101 U.S.P.Q.2d at 1965, 132 S. Ct. at 1294.

DIFFERENCE TYPES OF CITATIONS: IN-LINE, FOOTNOTES, & ENDNOTES

- Example 2: Improper Use of In-Line Citation and Footnotes

In *Mayo Collaborative Services v. Prometheus Laboratories Inc.*, 101 U.S.P.Q.2d 1961, 132 S. Ct. 1289 (2012), the Supreme Court established a two-step analytical framework to determine whether the claims of a patent are directed to an abstract idea. One must first "determine whether the claims at issue are directed to a patent-ineligible concept." (*Alice Corp. v. CLS Bank Int'l*, 110 U.S.P.Q.2d 1976, 1981, 134 S. Ct. 2347, 2349 (2014).) The Supreme Court has recognized that "all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas."[1] The Court of Appeals for the Federal Circuit (CAFC) has further clarified that a court "must therefore ensure at step one that we articulate what the claims are directed to with enough specificity to ensure the step one inquiry is meaningful."[2]

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[1] *Mayo*, 101 U.S.P.Q.2d at 1965, 132 S. Ct. at 1294.

[2] *Thales Visionix Inc. v. United States*, 121 U.S.P.Q.2d 1898, 1901 (Fed. Cir. 2017).

DIFFERENCE TYPES OF CITATIONS: IN-LINE, FOOTNOTES, & ENDNOTES

- Summary:
  - In-text or in-line citations is generally acceptable for non-academic, legal writing.
  - Footnotes are acceptable and, sometimes, required instead of in-line citation.
  - In-line citations allow the reader to continue reading without interruption, but footnotes are a better mechanism for providing explanation or tangentially related details.
  - Choose one and be consistent!

CHOOSING THE REPORTER: WHICH REPORTER DO I CITE?

- Preferably, a citation should cite to a reporter in which an opinion is published.

- Table 1 (T1) of The Bluebook lists the reporters that should be cited depending on the court that wrote the opinion.
  - Supreme Court: Supreme Court Reporter (S. Ct.)
  - Court of Appeals for the Federal Circuit (precedential): Federal Reporter (F. 3d)
  - Court of Appeals for the Federal Circuit (non-precedential): Federal Appendix (F. App'x)
  - District Courts: Federal Supplement (F. Supp. 3d)

CHOOSING THE REPORTER: WHICH REPORTER DO I CITE?

- What about the United States Patent Quarterly?

- This is not a reporter associated with a particular court, but with a particular *type* of case.

- Both the Manual of Patent Examining Procedure (MPEP) and Trademark Manual of Examining Procedure (TMEP) provide guidance.

CHOOSING THE REPORTER: WHICH REPORTER DO I CITE?

- MPEP § 707.06 Citation of Decisions, Orders Memorandums, and Notices
  - In citing court decisions, when it is convenient to do so, the U.S. or Federal Reporter citation should be provided; in the alternative, the USPQ citation should be given.
  - The citation of decisions which are not available to the public should be avoided.
  - It is important to recognize that a federal district court decision that has been reversed on appeal cannot be cited as authority.

CHOOSING THE REPORTER: WHICH REPORTER DO I CITE?

- TMEP § 705.05 Citation of Decisions and USPTO Publications
  - When citing court or administrative decisions, the United States Patents Quarterly (USPQ or USPQ2d) citation should be given.
  - If possible, a parallel citation to the United States Reports (U.S.), Federal Reporter (F., F.2d, or F.3d), or Federal Supplement (F. Supp. or F. Supp.2d) should also be given. The court or tribunal (2d Cir., C.C.P.A., Fed. Cir., TTAB, etc.) and the date of the decision should always be given.
  - When citing to a decision that is published and reported only in LexisNexis® and/or Westlaw®, for which there are no official print versions, the citing party should provide the name of the research service, case name, proceeding name and docket number, database identifier, court name, date, and screen, page, or paragraph numbers, if assigned.

CHOOSING THE REPORTER: WHICH REPORTER DO I CITE?

- The USPTO has typically leaned towards the United States Patent Quarterly in citing opinions.

- Practice tip: Parallel cite to both the United States Patent Quarterly and the appropriate Federal Reporter.
  - Don’t forget to properly parallel cite in the short form of the citation!

CHOOSING THE REPORTER: WHICH REPORTER DO I CITE?

- Summary:
  - Both the MPEP and the TMEP recognize the U.S.P.Q. as being a preferable reporter.
  - When in doubt, parallel cite – U.S.P.Q. and F.3d, U.S.P.Q. and F. Supp. 2d, or U.S.P.Q. and S. Ct.

CITING TO AGENCY MATERIALS

- There are four general category of materials authored by the United States Patent and Trademark Office that you might cite:
  - Communications from the Examiner;
  - Decisions by the Patent Trial and Appeal Board;
  - Memorandum published by the U.S.P.T.O.; and,
  - Notices from the U.S.P.T.O. and published in the Federal Register.

CITING TO AGENCY MATERIALS

- Communications from the Examiner:
  - Years ago, each document ("paper") in a file wrapper for a patent application was assigned a number. This number would then be used as the citation.
  - With the introduction of the Electronic File Wrapper (EFW), the USPTO has since done away with assigning paper numbers to applications.
  - How do we cite to communications from the Examiner?

CITING TO AGENCY MATERIALS

- Communications from the Examiner

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.
[redacted]	06/26/2008	[redacted]	[redacted]	6864

[redacted]

EXAMINER
WINTER, JOHN M

ART UNIT	PAPER NUMBER
3685	

NOTIFICATION DATE	DELIVERY MODE
08/11/2017	ELECTRONIC

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lhptoms@leehayes.com
usdocket@microsoft.com

CITING TO AGENCY MATERIALS

- Communications from the Examiner

Office Action Summary	Application No.	Applicant(s)	
	[redacted]	[redacted]	
	Examiner	Art Unit	AIA (First Inventor to File) Status
	[redacted]	3685	No

-- 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 MONTHS 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 6/27/2017.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ 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.

CITING TO AGENCY MATERIALS

- Communications from the Examiner:
  - Identify the communication by what the document is:
    - Non-Final Office Action;
    - Final Office Action;
    - Examiner's Reply
  - Identify the date on which the U.S.P.T.O. notified the applicant / appellant:
    - August 11, 2017
  - Identify the page where the relevant text can be found
    - Example: *Non-Final Office Action* dated August 11, 2017, p. 4.
  - After introducing the full citation of the communication, the communication may then be referenced using a short citation (e.g., "Non-Final Office Action").

CITING TO AGENCY MATERIALS

- Communications from the Examiner: Example

Claims 1-20 have been rejected under 35 U.S.C. § 103(a)(pre-AIA). In particular, claims 1-7, 9-15, and 17-20 were rejected under 35 U.S.C. § 103(a)(pre-AIA) as allegedly being unpatentable over U.S. Pat. App. Pub. No. 2014/0129942 to Rathod ("*Rathod*") in view of U.S. Pat. App. Pub. No. 2013/007596 to Vandermolen *et al.* ("*Vandermolen*"). (*Non-Final Office Action* dated May 24, 2017, p. 2.) In addition, claims 8 and 16 were rejected under 35 U.S.C. § 103(a)(pre-AIA) as allegedly being unpatentable over *Rathod* in view of *Vandermolen*, and in further view of U.S. Pat. App. Pub. No. 2010/0082683 to Law *et al.* (*Id.* at 6.)

CITING TO AGENCY MATERIALS

- Side Note: Submissions by the Applicant
  - Like with citing to the name of the communication provided by the U.S.P.T.O, Applicant documents should be cited similarly.
  - Provide the full title of the document and the date on which the document was submitted or mailed.
  - Example:
    - *Amendment and Response under 37 C.F.R. § 1.111*, submitted November 6, 2017, p. 5.
    - *Amendment and Response* at 7.
    - *Id.* at 7.

CITING TO AGENCY MATERIALS

- Decisions by the Patent Trial and Appeal Board:
  - Citation to a decision by the PTAB includes four components:
    - the case name;
    - docket number;
    - citation to secondary source (if available); and
    - the date of the decision.

CITING TO AGENCY MATERIALS

- Decisions by the Patent Trial and Appeal Board: Example

Patent Trial and Appeal Board
Precedential
Standard Operating Procedure 2

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES GERARD McAWARD, DAVID S. ZAKREWSKI,
KEVIN G. PIEL, and JONATHAN KLINGER

Appeal 2015-006416
Application 13/435,655
Technology Center 3700

Before LINDA E. HORNER, ANNETTE R. REIMERS, and
NATHAN A. ENGELS, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

CITING TO AGENCY MATERIALS

- Decisions by the Patent Trial and Appeal Board: Example
  - Full Citation:
    - *Ex parte McAward*, No. 2015-006416, 2017 Pat. App. LEXIS 8537 (P.T.A.B. August 25, 2017)
  - Short Citation:
    - *McAward*, No. 2015-006416 at 3, 2017 Pat. App. LEXIS 8537, at *2.
- When citing to an electronic database (e.g., WestLaw, Lexis, or BNA), include the document identifier and list the page number with the asterisk.

CITING TO AGENCY MATERIALS

- Memorandum published by the U.S.P.T.O.:
  - Cite to the United States Patent and Trademark Office as the institutional author;
  - Provide the title of the document or memorandum;
  - Identify the date on which the document or memorandum was published.

CITING TO AGENCY MATERIALS

- Memorandum published by the U.S.P.T.O.: Example

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MEMORANDUM

DATE: May 4, 2016

TO: Patent Examining Corps

FROM: Robert W. Bahr
Deputy Commissioner
For Patent Examination Policy

SUBJECT: Formulating a Subject Matter Eligibility Rejection and Evaluating the Applicant's Response to a Subject Matter Eligibility Rejection

The purpose of this memorandum is to provide examination instructions to the Patent Examining Corps relating to subject matter eligibility of claims under 35 U.S.C. § 101. In particular, this memorandum addresses: (i) how examiners should formulate a subject matter eligibility rejection under § 101, and (ii) how examiners should evaluate an applicant response to such a rejection. These instructions are intended to assist examiners in applying the *2014 Interim Guidance on Patent Subject Matter Eligibility* (*Interim Eligibility Guidance*) and the *July 2015 Update: Subject Matter Eligibility (July 2015 Update)*. Training will be provided to illustrate the points made in this memorandum.

CITING TO AGENCY MATERIALS

- Memorandum published by the U.S.P.T.O.: Example
  - Full citation:
    - U.S. Patent and Trademark Office, Formulating a Subject Matter Eligibility Rejection and Evaluating the Applicant's Response to a Subject Matter Eligibility Rejection (May 4, 2016)
  - Short citation:
    - Note: The Bluebook does not explicitly address internal agency memorandum.
    - In this case, choose a name that distinguishes the memorandum from other sources cited in your writing (e.g., "May 2016 Memorandum").
    - Follow short citation rules:
      1) May 2016 Memorandum at 3.
      2) *Id.* at 4.

CITING TO AGENCY MATERIALS

- Notices from the U.S.P.T.O. and published in the Federal Register:
  - Citations to the Federal Register generally have three parts:
    - The commonly used name of the rule or regulation;
    - The volume and page on which the rule or regulation (or any preceding discussion thereof) begins; and,
    - the date of the rule or regulation.

CITING TO AGENCY MATERIALS

- Notices from the U.S.P.T.O. and published in the Federal Register: Example

ACTION: Examination guidance; request for comments.

SUMMARY: The United States Patent and Trademark Office (USPTO or Office) has prepared interim guidance (2014 Interim Guidance on Patent Subject Matter Eligibility, called "Interim Eligibility Guidance") for use by USPTO personnel in determining subject matter eligibility under 35 U.S.C. 101 in view of recent decisions by the U.S. Supreme Court (Supreme Court). This Interim Eligibility Guidance supplements the June 25, 2014, Preliminary Examination Instructions in view of the Supreme Court decision in *Alice Corp.* (June 2014 Preliminary Instructions) and supersedes the March 4, 2014, Procedure For Subject Matter Eligibility Analysis Of Claims Reciting Or Involving Laws Of Nature/Natural Principles, Natural Phenomena, And/Or Natural Products (March 2014 Procedure) issued in view of the Supreme Court decisions in *Myriad* and *Mayo.* The USPTO is seeking public comment on this Interim Eligibility Guidance along with additional suggestions on claim examples for explanatory example sets.

DATES: *Effective Date:* This Interim Eligibility Guidance is effective on December 16, 2014. This Interim Eligibility Guidance applies to all applications filed before, on or after December 16, 2014.

Comment Deadline Date: To be ensured of consideration, written comments must be received on or before March 16, 2015.

for use by USPTO personnel in determining subject matter eligibility under 35 U.S.C. 101. *See* MPEP 2106 (9th ed. 2014). The USPTO has prepared this Interim Eligibility Guidance for use by USPTO personnel in determining subject matter eligibility under 35 U.S.C. 101 in view of recent decisions by the Supreme Court. The following Interim Eligibility Guidance on patent subject matter eligibility under 35 U.S.C. 101 supplements the June 25, 2014, Preliminary Examination Instructions in view of the Supreme Court Decision in *Alice Corporation Pty. Ltd.* v. *CLS Bank International, et al.*[1] (June 2014 Preliminary Instructions) and supersedes the March 4, 2014, Procedure For Subject Matter Eligibility Analysis Of Claims Reciting Or Involving Laws Of Nature/Natural Principles, Natural Phenomena, And/Or Natural Products (March 2014 Procedure)[2] issued in view of the Supreme Court decisions in *Association for Molecular Pathology* v. *Myriad Genetics, Inc.*[3] and *Mayo Collaborative Services* v. *Prometheus Laboratories Inc.*[4] Implementation of examination guidance on eligibility will be an iterative process continuing with periodic supplements based on developments in patent subject matter eligibility jurisprudence[5] and public feedback.

The USPTO is seeking written comments on this guidance, as well as additional suggestions for claim examples to use for examiner training. Further, the USPTO plans to hold a public forum in mid-January 2015 in order to discuss the guidance and next steps and to receive additional oral input. When the date and location are finalized, notice of the forum will be provided on the Office's Internet Web site (*http://www.uspto.gov*).

This Interim Eligibility Guidance does not constitute substantive rulemaking and does not have the force and effect of law. This Interim Eligibility Guidance sets out the Office's interpretation of the subject matter eligibility requirements of 35 U.S.C. 101 in view of recent decisions by the Supreme Court and the U.S. Court of Appeals for the Federal Circuit (Federal Circuit), and advises the public and Office personnel on how these court decisions impact the provisions of MPEP 2105, 2106 and 2106.01. This Interim Eligibility Guidance has been developed as a matter of internal Office management and is not intended to create any right or benefit, substantive or procedural, enforceable by any party against the Office. Rejections will continue to be based upon the substantive law, and it is these rejections that are appealable. Failure of Office personnel to follow this Interim Eligibility Guidance is not, in itself, a proper basis for either an appeal or a petition.

This Interim Eligibility Guidance offers a comprehensive view of subject matter eligibility in line with *Alice Corp, Myriad, Mayo,* and the related body of case law, and is responsive to the public comments received pertaining to the March 2014 Procedure and the June 2014 Preliminary Instructions (*see* the Notice of Forum on

CITING TO AGENCY MATERIALS

- Notices from the U.S.P.T.O. and published in the Federal Register: Example:
  - Full citation:
    - 2014 Interim Guidance on Patent Subject Matter Eligibility, 79 Fed. Reg. 74,619 (Dec. 16, 2014).
  - Short citation:
    - 2014 Interim Guidance on Patent Subject Matter Eligibility, 79 Fed. Reg. at 74,621.
    - *Id.* at 74,621.

CITING TO AGENCY MATERIALS

- Summary
  - Properly and precisely identify the Examiner (or Applicant) communication being cited.
  - For citation purposes, the author of agency memoranda is the United States Patent and Trademark Office.
  - If citing to an opinion authored by the PTAB, find out if it's been published in a reporter; if so, cite the reporter.
  - Citing to the Federal Register: Name of Regulation, Vol. No. Fed. Reg. Page No. (Date).

CITING TO PATENT LITERATURE: PATENTS AND PUBLISHED APPLICATIONS

- The Bluebook provides specific guidelines for citing to patents.
- Full citation: Cite the patent number. The filing date and/or issue date may be included.
  - Example 1: U.S. Patent No. 9,456,123 (filed Dec. 18, 2014).
- Short citation: Apostrophe followed by the last three digits.
  - Example 2: the ’123 patent

CITING TO PATENT LITERATURE: PATENTS AND PUBLISHED APPLICATIONS

- The citation form provided by the Bluebook contrasts with the Code of Federal Regulations

- 37 C.F.R. 1.104(d):
  - If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees will be stated.

  - If domestic patent application publications are cited by the examiner, their publication number, publication date, and the names of the applicants will be stated.

- In practice, the way in which patents and published applications are cited differs from the preferred Bluebook rules.

CITING TO PATENT LITERATURE: PATENTS AND PUBLISHED APPLICATIONS

- Example 1:

(12) **United States Patent**
Emmett et al.

(10) **Patent No.: US 9,456,123 B2**
(45) **Date of Patent: Sep. 27, 2016**

(54) **METHOD AND SYSTEM TO CONFIGURE MOBILE ELECTRONIC DEVICE SETTINGS USING REMOTE DATA STORE ANALYTICS**

(71) Applicant: **Xerox Corporation**, Norwalk, CT (US)

(72) Inventors: **Phillip J. Emmett**, Rochester, NY (US); **Lina Fu**, Fairport, NY (US); **Raja Bala**, Pittsford, NY (US)

(73) Assignee: **Xerox Corporation**, Norwalk, CT (US)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 22 days.

(21) Appl. No.: **14/574,809**

(22) Filed: **Dec. 18, 2014**

(65) **Prior Publication Data**

US 2016/0182805 A1 Jun. 23, 2016

(51) **Int. Cl.**

H04N 5/232	(2006.01)
G06K 9/00	(2006.01)
G06T 7/00	(2006.01)
G06K 9/22	(2006.01)

(52) **U.S. Cl.**

CPC ***H04N 5/23212*** (2013.01); ***G06K 9/00483*** (2013.01); ***G06K 9/22*** (2013.01); ***G06T 7/0018*** (2013.01); ***H04N 5/23206*** (2013.01); ***H04N 5/23232*** (2013.01)

(58) **Field of Classification Search**

6,947,609	B2	9/2005	Seeger et al.	
2001/0045986	A1	11/2001	Edwards	
2002/0186425	A1	12/2002	Dufaux et al.	
2006/0205394	A1	9/2006	Vesterinen	
2008/0079817	A1	4/2008	Murata et al.	
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2009/0024944	A1	1/2009	Louch et al.	
2009/0189999	A1	7/2009	Noh	
2009/0263028	A1	10/2009	Kwon	
2010/0026875	A1 *	2/2010	Shirai	G03B 17/18 348/335
2010/0189356	A1	7/2010	Sugita	
2010/0202026	A1	8/2010	Chiu et al.	
2011/0109770	A1	5/2011	Katoh	

(Continued)

OTHER PUBLICATIONS

Johnson et al, publication of WO 2008/118367 from the World Intellectual Property Organization, Oct. 2008.*

Shafait et al., "Document Cleanup Using Page Frame Detection", International Journal on Document Analysis and Recognition, vol. 11, No. 2, 2008, pp. 81-96.

(Continued)

Primary Examiner — Nicolas Giles
(74) *Attorney, Agent, or Firm* — Fox Rothschild LLP

(57) **ABSTRACT**

A mobile electronic device application uses various hardware parameters for operation. The application leverages calibration data from other users to determine what the parameters should be for the particular device model on which the application is installed. The application queries a

- Full citation: U.S. Pat. No. 9,456,123 to Emmett *et al.*

- Short citation: *Emmett*

CITING TO PATENT LITERATURE: PATENTS AND PUBLISHED APPLICATIONS

- When citing to a patent, cite the column and line number.

- Examples:
  - Bluebook form: U.S. Pat. No. 9,456,123, col. 3 ll. 25-38 (filed Dec. 18, 2014).
  - Alternative form 1: U.S. Pat. No. 9,456,123 to Emmett *et al.,* col. 3 ll. 25-38.
  - Alternative form 2: U.S. Pat. No. 9,456,123 to Emmett *et al.*, col. 3:25-38.

CITING TO PATENT LITERATURE: PATENTS AND PUBLISHED APPLICATIONS

- Example 2:

(19) **United States**
(12) **Patent Application Publication**
Savjani et al.

(10) **Pub. No.: US 2009/0299785 A1**
(43) **Pub. Date: Dec. 3, 2009**

(54) **METHOD, SYSTEM, AND STORAGE DEVICE FOR JOB POSTING, MATCHING, RATING, AND REFERRAL**

(75) Inventors: **Rajen Savjani**, El Lago, TX (US); **Felipe Villasenor**, Houston, TX (US)

Correspondence Address:
HULSEY IP INTELLECTUAL PROPERTY LAWYERS, P.C.
919 Congress Avenue, Suite 919
AUSTIN, TX 78701 (US)

(73) Assignee: **CACHINKO, LLC**, Houston, TX (US)

(21) Appl. No.: **12/414,291**

(22) Filed: **Mar. 30, 2009**

Related U.S. Application Data

(60) Provisional application No. 61/040,679, filed on Mar. 30, 2008.

Publication Classification

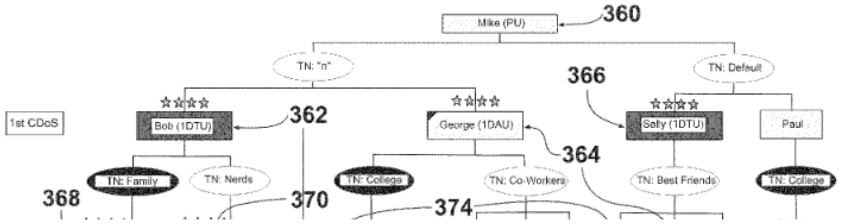
(51) **Int. Cl.**

G06Q 10/00	(2006.01)
G06Q 30/00	(2006.01)
G06Q 50/00	(2006.01)
G06F 17/30	(2006.01)
G06F 15/16	(2006.01)

(52) **U.S. Cl.** **705/7**; 705/14.16; 707/104.1; 709/206; 707/E17.048

(57) **ABSTRACT**

A job posting method, system, and storage device which allows users to create one or more talent networks each containing one or more connections, create job postings that trickle down to other users according to a set of rules, a referral system for rewarding users who recommend candidates for the job postings, and a recommendation system which allows both job posters and job seekers to have the system recommend potential candidates or jobs, as the case may be.



- Full citation: U.S. Pat. App. Pub. No. 2009/0299785 to Savjani *et al.*
- Short citation: *Savjani*

CITING TO PATENT LITERATURE: PATENTS AND PUBLISHED APPLICATIONS

- When citing to a patent application publication, be sure to include the paragraph number in which the relevant quote appears.
  - Examples:
    - *Savjani* at ¶[0005].
    - *Savjani* at [0005].
- The Bluebook does not explicitly specify how an application publication is to be cited.
- As conformity and uniformity is a driving principle, the citation format for a patent application publication should be similar to a patent citation.

CITING TO PATENT LITERATURE: PATENTS AND PUBLISHED APPLICATIONS

- Summary
  - Use the last name of the first named inventor OR the last three digits of the patent or application publication when citing to a patent or application publication.
  - When citing to a patent, identify the column and line numbers where the relevant material is found; when citing to an application publication, identify the relevant paragraph.

EVERYONE IS NAMED "SMITH": CITING TO PATENT AND NON-PATENT REFERENCES WITH THE SAME AUTHOR

- Sometimes, there will be circumstances where two patent literature references (e.g., a patent and a published application), will list the same, named inventor.

- This often happens where the references are part of a patent application family.

EVERYONE IS NAMED "SMITH": CITING TO PATENT AND NON-PATENT REFERENCES WITH THE SAME AUTHOR

- Example:

(12) **United States Patent**
Andrews et al.

(10) **Patent No.: US 9,021,040 B1**
(45) **Date of Patent: Apr. 28, 2015**

(54) **AUTOMATICALLY SELECTING ADDRESSEES FOR RECEIVING A CONTENT ITEM**

(71) Applicant: **LinkedIn Corporation**, Mountain View, CA (US)

(72) Inventors: **June H. Andrews**, Mountain View, CA (US); **Jason R. Schissel**, Mountain View, CA (US)

(73) Assignee: **LinkedIn Corporation**, Mountain View, CA (US)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by **0** days.

(21) Appl. No.: **14/229,578**

(22) Filed: **Mar. 28, 2014**

(51) **Int. Cl.**
G06F 15/16 (2006.01)
H04L 12/58 (2006.01)
H04L 12/18 (2006.01)
H04L 29/08 (2006.01)

(52) **U.S. Cl.**
CPC ***H04L 51/02*** (2013.01); ***H04L 51/32*** (2013.01); ***H04L 12/185*** (2013.01); ***H04L 12/588*** (2013.01); ***H04L 67/22*** (2013.01)

(58) **Field of Classification Search**
CPC G06Q 50/01; H04L 51/32; H04L 12/185; H04L 12/588; H04L 67/22
USPC 709/206
See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS

8,010,460	B2 *	8/2011	Work et al.	705/319
8,402,374	B1 *	3/2013	Rose	715/733
2012/0072432	A1 *	3/2012	Crosa et al.	707/748
2012/0191715	A1 *	7/2012	Ruffner et al.	707/738
2012/0191776	A1 *	7/2012	Ruffner et al.	709/204
2012/0203846	A1 *	8/2012	Hull et al.	709/206
2012/0246244	A1 *	9/2012	Mallet et al.	709/206
2013/0031090	A1 *	1/2013	Posse et al.	707/723

* cited by examiner

Primary Examiner — Larry Donaghue
(74) *Attorney, Agent, or Firm* — Park, Vaughan, Fleming & Dowler LLP

(57) **ABSTRACT**

A system, method, and apparatus are provided for distributing a content item toward target recipients solely via first degree connections (e.g., in a professional network, in a social network). For a selected content item and identified target recipients of the item, when a user initiates a message to forward or otherwise convey the content item, one or more schemes are applied to select and automatically populate the message with suitable addressees. In one scheme, values are computed for each neighbor of the sender, to indicate the value of delivering the item to that neighbor; the message is automatically addressed to the highest-value neighbors. In another scheme, user communities that encompass the target recipients are identified and the message is automatically addressed to neighbors that are best able to disseminate the item throughout a community. In another scheme a minimal set of neighbors having connections to all target recipients is identified.

24 Claims, 6 Drawing Sheets

(19) **United States**
(12) **Patent Application Publication**
Andrews et al.

(10) **Pub. No.: US 2015/0281135 A1**
(43) **Pub. Date: Oct. 1, 2015**

(54) **AUTOMATICALLY SELECTING ADDRESSEES FOR RECEIVING A CONTENT ITEM**

(71) Applicant: **LinkedIn Corporation**, Mountain View, CA (US)

(72) Inventors: **June H. Andrews**, San Francisco, CA (US); **Jason R. Schissel**, Mountain View, CA (US)

(73) Assignee: **LinkedIn Corporation**, Mountain View, CA (US)

(21) Appl. No.: **14/625,985**

(22) Filed: **Feb. 19, 2015**

Related U.S. Application Data

(63) Continuation of application No. 14/229,578, filed on Mar. 28, 2014, now Pat. No. 9,021,040.

Publication Classification

(51) **Int. Cl.**
H04L 12/58 (2006.01)

(52) **U.S. Cl.**
CPC ***H04L 51/02*** (2013.01); ***H04L 51/28*** (2013.01); *H04L 51/32* (2013.01)

(57) **ABSTRACT**

A system, method, and apparatus are provided for distributing a content item toward target recipients solely via first degree connections (e.g., in a professional network, in a social network). For a selected content item and identified target recipients of the item, when a user initiates a message to forward or otherwise convey the content item, one or more schemes are applied to select and automatically populate the message with suitable addressees. In one scheme, values are computed for each neighbor of the sender, to indicate the value of delivering the item to that neighbor; the message is automatically addressed to the highest-value neighbors. In another scheme, user communities that encompass the target recipients are identified and the message is automatically addressed to neighbors that are best able to disseminate the item throughout a community. In another scheme a minimal set of neighbors having connections to all target recipients is identified.

EVERYONE IS NAMED "SMITH": CITING TO PATENT AND NON-PATENT REFERENCES WITH THE SAME AUTHOR

- In these instances, there are generally two options for distinguishing between the references:
  - Use the last three digits of the patent or application publication to distinguish between the references; or,
  - Label the first reference, usually the primary reference, as "I" and the secondary reference as "II".

EVERYONE IS NAMED "SMITH": CITING TO PATENT AND NON-PATENT REFERENCES WITH THE SAME AUTHOR

- Example I:

Claims 1-20 have been rejected under 35 U.S.C. § 103. In particular, claims 1-20 have been rejected under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Pat. No. 9,021,040 to Andrews *et al.* ("the '040 patent") in view of U.S. Pat. App. Pub. No. 2015/0281135 to Andrews *et al.* ("the '134 application publication"). Applicant respectfully traverses these rejections.

EVERYONE IS NAMED "SMITH": CITING TO PATENT AND NON-PATENT REFERENCES WITH THE SAME AUTHOR

- Example 2:

Claims 1-20 have been rejected under 35 U.S.C. § 103. In particular, claims 1-20 have been rejected under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Pat. No. 9,021,040 to Andrews *et al.* ("*Andrews I*") in view of U.S. Pat. App. Pub. No. 2015/0281135 to Andrews *et al.* ("*Andrews II*"). Applicant respectfully traverses these rejections.

EVERYONE IS NAMED "SMITH": CITING TO PATENT AND NON-PATENT REFERENCES WITH THE SAME AUTHOR

- Example 3: Don't "mix 'n match!"

> Claims 1-20 have been rejected under 35 U.S.C. § 103. In particular, claims 1-20 have been rejected under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Pat. No. 9,021,040 to Andrews *et al.* ("*Andrews I*") in view of U.S. Pat. App. Pub. No. 2015/0281135 to Andrews *et al.* ("the '135 publication"), and in further view of U.S. Pat. No. 9,807,047 to Lawler *et al.* ("*Lawler*"). Applicant respectfully traverses these rejections.

- The citations to the '040 patent and the '135 application publication is improper because it mixes the two citation formats.

- The citation of *Lawler* is acceptable because there are no other references where Lawler is a named inventor.

EVERYONE IS NAMED "SMITH": CITING TO PATENT AND NON-PATENT REFERENCES WITH THE SAME AUTHOR

- While acceptable, the challenge with using "I" and "II" is that later references can confuse or lead the reader into misunderstanding a particular argument.
- By identifying the patent or application publication by three-digit number, you better clarify the record and leave little to misinterpretation.
- Wholly stylistic, but you should strive for clarity in writing.

EVERYONE IS NAMED "SMITH": CITING TO PATENT AND NON-PATENT REFERENCES WITH THE SAME AUTHOR

- Summary:
  - There is no "right" way to cite to patent literature documents having the same, named first inventor.
  - Strive for clarity – if there are multiple references (*i.e.*, more than two) consider referencing the documents by their last three-digit numbers rather than by inventor last name.
  - Like footnoting or citing to communications with the Patent Office, pick one format and be consistent with it.

HOW AND WHEN TO QUOTE: IN-LINE QUOTATIONS VS. BLOCK QUOTING

- As patent practitioners, we often cite to the original text of a patent or application publication in making a particular point or presenting a particular argument.

- When citing to a portion in a patent or application publication, the number of words in the portion dictates whether you should use block quoting or in-line quoting.

HOW AND WHEN TO QUOTE: IN-LINE QUOTATIONS VS. BLOCK QUOTING

- For block quoting, the threshold number of words is 50: If the portion being cited includes 50 or more words, the portion should appear as a block quote.

- Specific rules regarding block quoting:
  - The portion being quoted should be indented on the left and right sides.
  - No quotation marks are used in presenting the block quote.
  - Quotation marks appearing in the block quote should appear as in the original material. (Rare in patent literature).

HOW AND WHEN TO QUOTE: IN-LINE QUOTATIONS VS. BLOCK QUOTING

- Specific rules relating to block quoting:
  - If the first word in the block quote is the start of a paragraph in the source material, the first line of the block quote should be indented.
  - If omitting words from a cited paragraph, indicate the omission using four periods (“. . . .”).
  - If omitting one or more paragraphs from a cited portion, start a new line and indicate the omission using four periods (“. . . .”).
  - If citing in-line, the citation to the source material should be on the first line following the block quote and should be left aligned with no indentation.
  - If citing using footnotes, the footnote number should appear after the final punctuation of the quotation.

HOW AND WHEN TO QUOTE: IN-LINE QUOTATIONS VS. BLOCK QUOTING

- Example: Source Material

[0020] Members of the service have corresponding pages (e.g., web pages, content pages) on system **110**, which they may use to facilitate their activities with the system and with each other. These pages (or information provided to members via these pages) are available to some or all other members to visit in order to browse messages, announcements, and/or other information provided by or associated with the corresponding member.

[0021] Tracking server **116** monitors and records activity of system **110** and/or members (e.g., in event database **126**). For example, whenever content is served from portal **112** or content server **114** (e.g., to a client device), the tracking server may record what is served, to whom (e.g., which member), when it was served, and/or other information. Other information may include how it was delivered (e.g., via a web page, via electronic mail, via instant message). Similarly, the tracking server also records member actions regarding advertisements and/or other content presented to the members, to include identities of the member and the content acted upon, the action that was taken (e.g., click, conversion, follow-on request, visiting a page associated with a subject or provider of the content, forwarding the content), when the action was taken, etc.

members and member connections, with nodes representing members and edges representing member connections, for example, it can also identify sub-networks having any desired locus or nexus (e.g., an institution common to a set of members, a field of endeavor shared by multiple members). Thus, if a goal arises of delivering a particular content item to a particular member, but only through member connections (e.g., messages between members), the system can readily identify one or more paths to the member. The terms "sub-network" and a member/user "community" may be used interchangeably in the following discussion.

[0026] Organizations may also be members of the service (i.e., in addition to individuals), and may have associated descriptions or profiles comprising attributes such as industry (e.g., information technology, manufacturing, finance), size, location(s), goal, products, services, etc. An "organization" may be a company, a corporation, a partnership, a firm, a government agency or entity, a not-for-profit entity, an online community (e.g., a user group), or some other entity formed for virtually any purpose (e.g., professional, social, educational).

[0027] Message server **120** may host an electronic mail program, a chat or instant message program, or some other

- U.S. Pat. App. Pub. No. 2015/0281135 to Andrews *et al.*

HOW AND WHEN TO QUOTE: IN-LINE QUOTATIONS VS. BLOCK QUOTING

- Example: Block Quoting an Entire Paragraph

The Examiner cites to paragraph [0021] of *Andrews* for the teaching or suggestion of the features of claim 1. Paragraph [0021] states:

> 1 Tracking server 116 monitors and records activity of system 110 and/or members (e.g., in event database 126). For example, whenever content is served from portal 112 or content server 114 (e.g., to a client device), the tracking server may record what is served, to whom (e.g., which member), when it was served, and/or other information. Other information may include how it was delivered (e.g., via a web page, via electronic mail, via instant message). Similarly, the tracking server also records member actions regarding advertisements and/or other content presented to the members, to include identities of the member and the content acted upon, the action that was taken (e.g., click, conversion, follow-on request, visiting a page associated with a subject or provider of the content, forwarding the content), when the action was taken, etc.

2 3

4 (*Andrews* at ¶[0021].) Applicant respectfully disagrees and submits that *Andrews* does not, in fact, teach or suggest these features.

HOW AND WHEN TO QUOTE: IN-LINE QUOTATIONS VS. BLOCK QUOTING

- Example: Block Quoting a Portion of a Paragraph

The Examiner cites to portions of paragraph [0025] of *Andrews* for the teaching or suggestion of the features of claim 1. The cited section of paragraph [0025] states:

1

> Thus, if a goal arises of delivering a particular content item to a particular member, but only through member connections (e.g., messages between members), the system can readily identify one or more paths to the member. The terms "sub-network" and a member/user "community" may be used interchangeably in the following discussion.

2 3

4 (*Andrews* at ¶[0025].) Applicant respectfully disagrees with the foregoing characterization and submits that *Andrews* does not, in fact, teach or suggest these features.

HOW AND WHEN TO QUOTE: IN-LINE QUOTATIONS VS. BLOCK QUOTING.

- Summary
  - If the quotation is 50 or more words, then use a block quote.
  - Ident both sides of the block quote.
  - The first line of the block quote should be indented if the first line is also the first sentence of the paragraph being quoted.
  - Recall the difference in where the citation appears if in-line citing or footnote citing.

CITATION SIGNALS: WHAT DO THEY MEAN AND HOW TO USE THEM

- A signal is a shorthand message about the relationship between a proposition and the source or authority cited for that proposition.

- If the signal is the beginning of a citation clause, the signal should be in lower case.

- If the signal is the beginning of a citation sentence, the signal should be capitalized.
  - Example: In addition, a claim may be directed to patent-eligible subject matter where the solution arises from computer technology and specifically relates to a problem found in a computing environment. (*See DDR Holdings, LLC v. Hotels.com, LP*, 113 U.S.P.Q.2d 1097, 1105 (Fed. Cir. 2014).)

CITATION SIGNALS: WHAT DO THEY MEAN AND HOW TO USE THEM

- Common signals used in patent prosecution practice:
  - [No signal]
    - Cited authority (1) directly states the proposition, (2) identifies the source of a quotation, or (3) identifies an authority referred to in the text. No signal should be used when directly quoting an authority.
  - *E.g.*
    - The cited authority states the proposition; other authorities also state the proposition, but citation to them would not be helpful or is unnecessary.
    - *E.g.* may also be used in conjunction with other signals: *See, e.g.,*
  - *See*
    - The cited authority clearly supports the proposition.
    - Similar to citing without a signal, but the authority may not directly state the proposition being proposed.

CITATION SIGNALS: WHAT DO THEY MEAN AND HOW TO USE THEM

- Common signals used in patent prosecution practice:
  - *See also*
    - Cited authority constitutes additional source material that supports the proposition.
    - Typically used where multiple authorities have already been directly cited and discussed for a given proposition.
    - If "*see also*" is used, a parenthetical explanation is encouraged to provide support for the citation.
  - *See generally*
    - The cited authority provides helpful background information for a particular proposition, but does not state the proposition explicitly.
    - Like "*see also*," a parenthetical explanation is encouraged when "*see generally*" is used.

CITATION SIGNALS: WHAT DO THEY MEAN AND HOW TO USE THEM

- Summary
  - Signals can be useful in providing further explanation and background for a particular proposition.
  - Bolsters your argument and demonstrates that the authority being relied upon is not unique – that there are other authorities that support your proposition.

HAS IT BEEN REPORTED: CITING TO SLIP OPINIONS

- General rule for citing to a slip opinion:
  - When a case is unreported (i.e., does not appear in U.S.P.Q., F.3d, S. Ct., etc.), but available in a separately printed slip opinion.

- Citations to a slip opinion generally have four parts:
  - The party names;
  - The docket number;
  - The court; and,
  - The full date of the most recent disposition of the case (e.g., usually the date the case is decided).

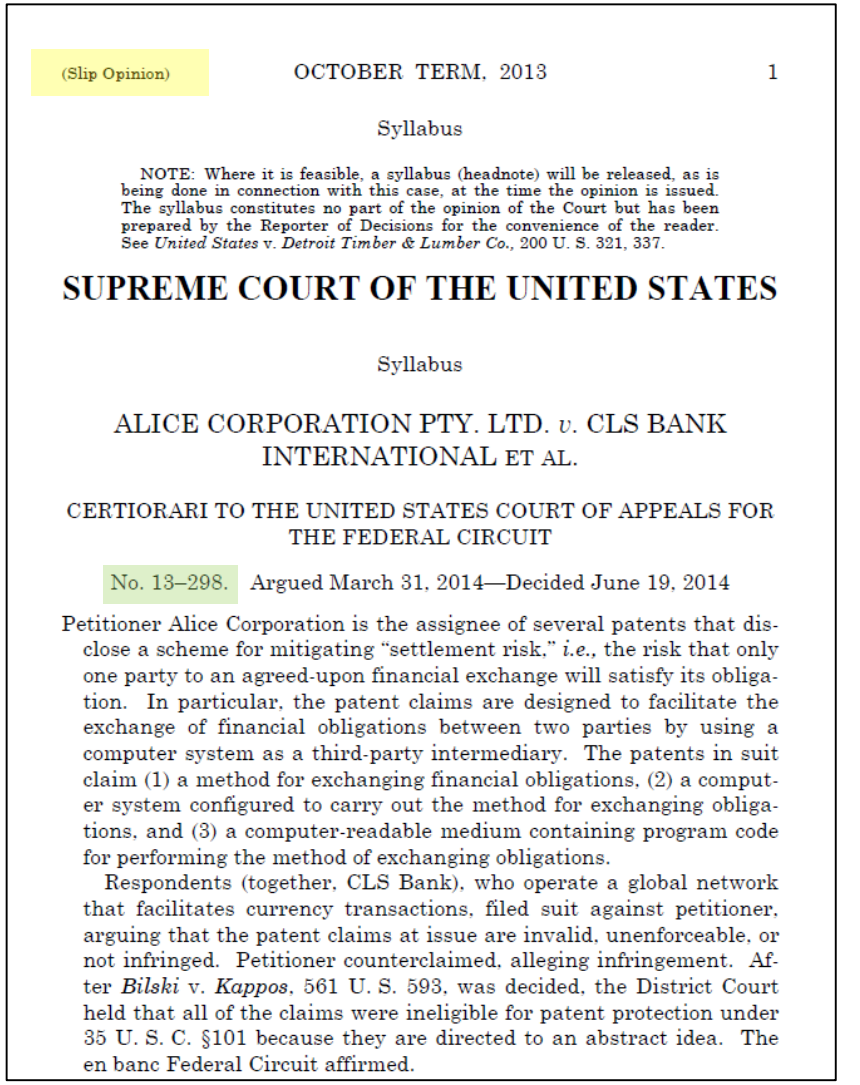
HAS IT BEEN REPORTED: CITING TO SLIP OPINIONS

- Example 1:

- Full citation:
  - *Alice Corp Pty. Ltd. v. CLS Bank Int'l*, No. 13-298 (U.S. June 19, 2014).

- Pinpoint citation:
  - *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, No. 13-298, slip op. at 4 (U.S. June 19, 2014).

- Short citation:
  - *Alice Corp*. No. 13-298, slip op. at 4.



(Slip Opinion) OCTOBER TERM, 2013 1

Syllabus

NOTE: Where it is feasible, a syllabus (headnote) will be released, as is being done in connection with this case, at the time the opinion is issued. The syllabus constitutes no part of the opinion of the Court but has been prepared by the Reporter of Decisions for the convenience of the reader. See *United States* v. *Detroit Timber & Lumber Co.*, 200 U. S. 321, 337.

SUPREME COURT OF THE UNITED STATES

Syllabus

ALICE CORPORATION PTY. LTD. *v.* CLS BANK INTERNATIONAL ET AL.

CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

No. 13–298. Argued March 31, 2014—Decided June 19, 2014

Petitioner Alice Corporation is the assignee of several patents that disclose a scheme for mitigating "settlement risk," *i.e.*, the risk that only one party to an agreed-upon financial exchange will satisfy its obligation. In particular, the patent claims are designed to facilitate the exchange of financial obligations between two parties by using a computer system as a third-party intermediary. The patents in suit claim (1) a method for exchanging financial obligations, (2) a computer system configured to carry out the method for exchanging obligations, and (3) a computer-readable medium containing program code for performing the method of exchanging obligations.

Respondents (together, CLS Bank), who operate a global network that facilitates currency transactions, filed suit against petitioner, arguing that the patent claims at issue are invalid, unenforceable, or not infringed. Petitioner counterclaimed, alleging infringement. After *Bilski* v. *Kappos*, 561 U. S. 593, was decided, the District Court held that all of the claims were ineligible for patent protection under 35 U. S. C. §101 because they are directed to an abstract idea. The en banc Federal Circuit affirmed.

HAS IT BEEN REPORTED: CITING TO SLIP OPINIONS

- Selected for Reporting, But Not Yet Reported:
  - At some point, the unreported opinion will be selected for reporting, but the reporter may not have officially published the opinion.
  - In this situation, cite to the volume of the opinion to be reported, and use underlining to indicate that the opinion has not yet been reported.
  - Parallel cite to the slip opinion and the reporter in which the opinion will appear.
  - Example 2: *Alice Corp. Pty. Ltd. v. CLS Bank Int'l,* No. 13-298, 134 S. Ct. ___ (2014).

HAS IT BEEN REPORTED: CITING TO SLIP OPINIONS

- Reporter Has Published Opinion:
  - After a reporter has published an opinion, citation to the slip opinion is no longer proper.
  - Cite to the reporter in which the opinion is published, and follow the rules discussed in earlier slides.
  - Exception:
    - Continue to cite to the slip opinion if the opinion is only available in an electronic database (e.g., Lexis, WestLaw, BNA) and unavailable in any other reporter.
    - Cite to both the slip opinion and the electronic database. If pinpoint citing, use the pagination of the electronic database.
    - Example 3: *Visual Memory LLC. v. NVIDIA Corp.*, No. 2016-2254, 2017 U.S. App. LEXIS 15187, at *7 (Fed. Cir. August 15, 2017).

HAS IT BEEN REPORTED: CITING TO SLIP OPINIONS

- Example 4:

The Supreme Court has not established a definitive rule to determine what constitutes an "abstract idea" sufficient to satisfy the first step of the Mayo/Alice inquiry.[12] Rather, both the CAFC and the Supreme Court have found it sufficient to compare claims at issue to those claims already found to be directed to an abstract idea in previous cases.[13] "[The Court] need not labor to delimit the precise contours of the 'abstract ideas' category in this case.[14] For instance, fundamental economic and conventional business practices are often found to be abstract ideas, even if performed on a computer.[15] However, as noted in the *Interim Guidance*, "***it should be recognized that the Supreme Court did not create a per se excluded category of subject matter, such as software or business methods, nor did it impose any special requirements for eligibility of***

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[8] *Alice Corporation Pty., Ltd. v. CLS Bank International, et al.* (hereinafter "*Alice*"), 573 U.S. __, 134 S. Ct. 2347 (2014) (slip op., at 6).
[9] *Enfish* (slip op., at 10).
[10] *Id.* (citing *Mayo*, 132 S. Ct. at 1293 ("For all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.").
[11] *Id.* (citations omitted).
[12] *Enfish* (slip op., at 9) (citations omitted).
[13] *Id.* (citations omitted).
[14] *Id.* (citations omitted).
[15] *Id.* (slip op., at 9-10) (citations omitted).

HAS IT BEEN REPORTED: CITING TO SLIP OPINIONS

- Summary
  - Citation to a slip opinion is appropriate when:
    - The opinion is available, BUT
    - No official has reported the opinion.
  - Once an official reporter has published an opinion, citation to the slip opinion is improper.
  - Check for publication of an opinion using an online service (e.g., Lexis, Westlaw, or BNA).
  - Include a citation to the electronic database if the slip opinion is available via the database.

QUESTIONS & DISCUSSION

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