

The opinion in support of the decision being entered today
was **not** written for publication and
is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WALTER G. BRIGHT and ERIC ENGSTROM

Appeal No. 2005-2338
Application No. 09/754,001

ON BRIEF

Before: RUGGIERO, GROSS and NAPPI, **Administrative Patent Judges**.

NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 24. For the reasons stated *infra* we affirm-in-part the examiner's rejection of these claims.

Invention

The invention relates to a system where a user of a service provider is given a unique identifier. As a result of the user having this unique identifier, the user is able to access several online services through an online service provider without having to manage a logon id and password pair. See page 8 of appellants' specification.

Claim 1 is representative of the invention and is reproduced below:

1. A method comprising:
 - receiving a request from a client to access a subscribed online service of a subscriber at an online service provider, said request comprising a globally unique identifier (GUID) of the subscriber;
 - determining if the GUID is associated with the subscriber; and
 - facilitating access to the subscribed online service of the subscriber if the GUID is associated with the subscriber.

References

The references relied upon by the examiner are:

Teper et al. (Teper)	5,815,665	September 29, 1998
Strandberg	US 2002/0161589 A1	October 31, 2002 (filed September 15, 1998)

Rejection at Issue

Claims 1 through 4, 6, 9 through 13, 15 through 20, and 22 through 24 stand rejected under 35 U.S.C. § 102 as being anticipated by Teper. Claims 5, 7 through 8, 14 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Teper in view of Strandberg.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and the examiner, and for the reasons stated *infra* we sustain the examiner's rejections of claims 1, 6, 9 through 11, 15 through 18, and 22 through 24 under 35 U.S.C. § 102, and the examiner's rejection of claims 7, 8, and 21 under 35 U.S.C. § 103. However, we will not sustain the examiner's rejections of claims 2 through 4, 12 through 13, 19 and 20 under 35 U.S.C. § 102 and the examiner's rejection of claims 5 and 14 under 35 U.S.C. § 103.

Grouping of the claims.

At the outset, we note that appellants' arguments group the claims in four (4) groups. On pages 4 through 9 of the brief appellants provide arguments directed to claim 1 and assert that the other claims rejected under 35 U.S.C. § 102 are allowable for the same reasons. On pages 9 and 10 appellants provide arguments as to why the limitations common to claims 2, 12 and 19 are not taught by Teper. On pages 10 and 11 of the brief, appellants provide

arguments as to why the limitations common to claims 3, 13 and 20 are not taught by Teper. On page 11 of the brief appellants provide arguments as to why the limitations common to claims 5, 14 and 21 are not obvious over Teper and Strandberg. Accordingly, we will address these claims as grouped by appellants' arguments.

**Rejection of claims 1, 6, 9 through 11, 15 through 18,
and 22 through 24 under 35 U.S.C. § 102**

Appellants argue, on page 5 of the brief, that the claim term GUID must be given its plain meaning as understood by those of ordinary skill in the art.

Appellants assert:

The term "GUID" is a well-known term of art among those of ordinary skill. As previously explained to the Examiner, its plain meaning can be clearly established referencing e.g. the following excerpt of its definition from the well-known website Webopedia, which states

Short for ***G*lobally *U*nique *I*dentifier**, ... to identify a particular component, application, file, database entry, and/or user. For instance, a Web site may generate a GUID and assign it to a user's browser to record and track the session. A GUID is also used ... to identify COM, DLLs ... Windows also identifies user accounts by a username (computer/domain and username) and assigns it a GUID. Some database administrators even will use GUIDs as primary key values in databases.

GUIDs can be created in a number of ways, but usually they are a combination of a few unique settings based on specific point of time (e.g., an IP address, network MAC address, clock data/time, etc.). (Underlining added by appellants)

Further, on page 6 of the brief, appellants provide the following explanation and argument:

Thus in the context of user identifiers, a GUID uniquely identifies a user globally, across ALL systems/services, like AOL, Yahoo, MSN,

eTrade etc. However as explained in the background section of the application, prior art services like AOL, Yahoo, MSN, eTrade etc. do not employ GUID to uniquely identify users. Each of these prior art services merely require identifiers that are unique within their respective universes.

A user can register with AOL, Yahoo etc[.] using the same identifier, provided it is not already in use by others in each of the respective services. However, it is well known, some of the popular user identifiers, like “Hot Dude” identifies different users in different services, as a first user registers “Hot Dude” with AOL first, and another user registers “Hot Dude” with Yahoo first. In sum, prior art services DO NOT use globally unique user identifiers, they merely require user identifiers that are unique in their respective domains or universes.

Here, Teper’s domain or universe is trusted brokering services, an improvement over brokering services offered by Charles Schwabe [*sic* Schwab], Meryll [*sic* Merrill] Lynch, and the like. Nothing in Teper suggests that Teper has a need to require user id uniqueness beyond Teper’s own domain. In fact, nothing in Teper suggests that Teper’s user identifier is anything but a conventional user identifier employed by broker services of the Charles Schwabe [*sic* Schwab], Meryll [*sic* Merrill] Lynch, and the like.

The examiner states on page 3 of the answer that GUID reads on Teper’s “unique ID”.

We concur with the examiner and we decline to use the extrinsic definition for GUID appellants provide in determining the scope of claim 1. In analyzing the scope of the claim, office personnel must rely on appellants’ disclosure to properly determine the meaning of the terms used in the claims. **Markman v. Westview Instruments, Inc.**, 52 F3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995). “[I]nterpreting what is *meant* by a word in a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” (emphasis original) **In re Cruciferous Sprout Litigation**, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing **Intervet**

America Inc v. Kee-Vet Laboratories Inc., 12 USPQ2d 1474, 1476 (Fed. Cir. 1989). Initially we note that appellants' specification does not define the term GUID, but rather states "[g]eneration of identifiers such as GUIDs, which may involve adding date and time to a serial number of a device in a client, is known and accordingly will not be discussed further." We decline to accept appellants' asserted definition as there is no date associated with the Webopedia definition so we are unable to ascertain if the definition is one that would be used as of the date of filing of the application. Additionally, our reviewing court has stated that they view "extrinsic evidence in general as less reliable than the patent and its prosecution history in determining how to read claim terms, for several reasons. First, extrinsic evidence is by definition not part of the patent and does not have the specification's virtue of being created at the time of patent prosecution for the purpose of explaining the patent's scope and meaning" ***Phillips v. AWH Corp.***, 415 F3d 1303, 1308 75 USPQ2d 1321, 1330 (Fed. Cir. 2005). Further, we note that the definition is not commensurate with appellants' arguments, we do not find that the definition limits GUID to "uniquely identifies a user globally across All systems/services" as argued by appellants, on page 6 of the brief. At best the definition simply identifies that the identifier can be used for several purposes to globally identify data, to what universe the term "global" applies is not clear.¹

We determine the scope of the claim limitation Global Unique Identifier to

¹ Independent of the evidence of record we conducted a search of various sources of technical definitions and found no definition that supports appellants' assertion that a GUID "uniquely identifies a user globally across All systems/services."

be a user identifier that is unique to an online service provider and allows the user access to several on line services. Our interpretation of this limitation is consistent with the appellants' specification which states, on page 8, referring to the GUID, "a user is able to access several online services through an online service provider without having to manage a logon ID and password pair."

Emphasis added. Throughout appellants' specification we find that the discussion of GUID is limited to an online provider to allow a user to access a plurality of services, see e.g. pages 9 and 10 of appellants' specification. Thus we find no discussion of the GUID being used across all systems and being unique across all systems, rather we find that appellants' specification discusses the identifier being unique to the service provider and silent as to being unique to other service providers.

We find that Teper teaches a system whereby a user can access service provider web sites on the Internet, and the user does not give his personal information for billing to the service providers but rather an online broker site is used to handle user authentication and billing. Thus, the user can access and use the services of several online service providers while using only one account, with the online broker. See Teper Column 2, lines 31 through 48. In Teper's system the user registers with the online broker and his personal and billing information is kept with the online broker. See column 2, lines 57-67. The user is assigned a unique ID. See column 3, line 1. When a user contacts a service provider's web site, a series of communications occur where the user ID and password are transferred to the service provider. The service provider then

contacts the online broker, who authenticates the user. See column 2 lines 5-30.

The authentication may identify if the user has a subscription to the service providers' online publications. See column 3, lines 60-64. Thus, we find that Teper teaches assigning a unique identifier to a user, that the user can be a subscriber and that the unique identifier is unique to all users of the online broker. By extension the unique identifier is unique to all the service provider web sites which make use of the online broker. As such, even though claim 1 does not require that the unique identifier be unique to more than one service provider, we find that Teper's unique identifier is unique to more than one service provider.

On page 7 of the brief, appellants argue that even if Teper's unique identifier were considered to meet the GUID limitation Teper does not teach the limitation of "receiving a request from a client ... comprising a globally unique identifier (GUID) of the subscriber." (Underlining added by appellants). Further appellants argue, on pages 7 and 8 of the brief:

Teper discloses inclusion of the "unique ID" with the "negotiate" message (col. 9, lines 50-55). However, the "negotiate" message cannot be read as "a request to access a subscribed online service at an online service provider." The reason being, under Teper, the subscribed online services of a subscriber are not made known to an online service provider until a user is authenticated. See col. 11, lines 15-20.

We are not convinced by this argument. While we concur with appellants that one of the purposes of Teper's system is to maintain anonymity of the user, and that the service providers do not know who the users are, rather the service provider only knows that they are authorized, we find no limitation in claim 1

which requires the identity of the user be apparent to the service provider. The claims require that the request include the user/subscriber identifier; whether or not the service provider can directly interpret the identifier is not addressed in the claims. We find that Teper, in column 9, lines 50-55, discusses the initial communication with a service provider when the user “attempts to use the SP [service provider’s] service,” we consider an attempt to use a service to be a request. Teper teaches that this transmission includes a negotiate message which includes the user’s unique ID. Thus, we find that Teper teaches a request which includes a unique user/subscriber identifier as claimed.

Lastly, on page 8 of the brief appellants state that:

The law is also well settled that if there was anticipation, **there should have been symmetry with infringement**, “[t]hat which infringes if later, anticipates if earlier”, see e.g. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781 (Fed. Cir. 1983), cert denied, 465, U.S. 1026 (1984). In other words, if Teper, in particular the cited passages have taught an element that anticipated the required element of claim 1, then Appellants should be able to find Teper, in particular, the cited passage infringing, had Teper been later than the application on appeal.

However, no such infringement can be found in the cited passage.

As Appellants has explained in a prior response, an infringing method must employ a **GUID** that uniquely identifies a user across all systems, all services, all communities and so forth. Since, Teper’s unique identifier is merely unique within Teper’s community, Teper does not infringe on Appellants’ claim.

In response the examiner states “infringement is beyond the scope of examination.”

We concur with the examiner. Initially, we find no quotation in ***Kalman v. Kimberly-Clark Corp.*** which states “that which infringes if later, anticipates if

earlier”, nor do we consider the case to stand for such a proposition.

Additionally, infringement deals with the claims of a patent. When construing patent claims our reviewing court has said it is an old axiom that patents “are to receive a liberal construction, and under the fair application of the rule, *ut res magis valeat quam pereat*, are, *if practicable*, to be so interpreted as to uphold and not to destroy the right of the inventor,” ***Nazomi Communications Inc. v. ARM Holdings PLC***, 403 F.3d 1364, 1368, 74 USPQ2D 1458, 1461 (Fed. Cir. 2005, (citing ***Turrill v. Mich. S. & N. Ind. R.R.***, 68 U.S. 491, 510 (1863) (emphasis original)). However, appellants’ claims have not been allowed and are not issued as a patent. There can be no infringement as there are no patent claims in question. Thus, we can make no findings concerning infringement. Additionally, as stated *supra* we find that Teper does teach the use of a GUID based upon the broadest reasonable interpretation of the claim term. The standard for claim interpretation before the office is different than for infringement, before the office claims are given their broadest reasonable interpretation consistent with the specification. ***In re Etter***, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). Thus, we are not persuaded by appellants’ arguments. Accordingly, we sustain the examiner’s rejection of claim 1. As appellants have not provided separate arguments for claims 6, 9 through 11, 15 through 18, and 22 through 24, we sustain the examiner’s rejection of these claims under 35 U.S.C. § 102.

Rejection of claims 2, 3, 4, 12, 13, 19 and 20 under 35 U.S.C. § 102

We next consider the rejection of claims 2, 12 and 19 as being anticipated by Teper. Appellants argue on page 9 of the brief:

[C]laims 2, 12 and 19 are further patentable over Teper, because Teper failed [*sic* fails] to teach the required “receiving of a request for roaming capability” as well as “the request comprising an e-mail address” (hereinafter “**request²**”).

In paragraph 2 of the rejection, the Examiner continued to assert that Teper teaches “roaming capability” because the Examiner interprets the term to mean “access to online services is being made available to more than one user, due to Applicants’ disclosure in page 11, 3rd paragraph of the specification.... Instead person [of] ordinary skill in the art would clearly understand “roaming” to mean a user being able to access the one or more service from any client in any location, especially in view of other complementary usage of the term throughout the specification.

In response the examiner states, on page 7 of the answer: “Tamer [*sic* Teper] discloses accessing the Internet using a Service Provider is deemed to be accessed anywhere in the world and further describes email capability. See 7:40-65; 8:1-20.”

We disagree with the examiner. Claim 2 includes the limitation “determining if a request for roaming capability is received, said request for roaming capability includes an e-mail address.” Claims 12 and 19 contain similar limitations. Thus, we find that the scope of these claims includes a determination of whether there is a request for roaming. As appellants assert, we find that appellants’ specification on page 11 identifies that roaming is the ability for users to access and utilize one or more services from any client or location. We concur with the examiner and find that Teper teaches that the Internet can be used and that the user can access service providers from many locations. However, we

find no disclosure in the sections cited by the examiner of a determination of whether a request is a request for roaming capability which contains an email address. Accordingly, we will not sustain the examiner's rejection of claims 2, 12 and 19 under 35 U.S.C. § 102.

Claims 3 and 4 are dependent upon claim 2 and claim 13 is dependent upon claim 12. We reverse the examiner's rejection of these claims 35 U.S.C. § 102 for the reasons discussed *supra* with respect to claims 2 and 12.

Next we consider the rejection of claim 20 under 35 U.S.C. § 102.

Appellants argue on page 10 of the brief:

Claims 3, 13 and 20 are also further patentable over Teper, because Teper failed to teach the required limitation of "said facilitating comprises sending an email, including the GUID associated with the subscriber, to the email address." The limitation does not merely recites [*sic recite*] transmission of email. As discussed earlier, it requires the employment of an email having the GUID, sent to an email address associated with a "roaming capability" to make possible roaming for the user ("said facilitating comprises").

Col. 9, lines 55-57 merely teach sending billing statements to a user via email. In the cases of col. 10, lines 51-57 and col. 3, lines 14-16, neither contain any teaching that has anything to do with email, and certainly not the recited required use of the email, having a GUID to effectuate roaming access.

In response the examiner asserts, on page 7 of the answer, that Teper discloses that the GUID is sent in a message to the user, citing column 9, lines 50-60 and column 10, lines 25 to 54.

We agree with appellants. Claim 20 is dependent upon claim 18 and includes limitations for an apparatus that stores machine executable instructions, which operate to receive a request from a client to access a subscribed online service of an online service provider, and to send an e-mail, including the GUID

associated with the subscriber to an e-mail address. Contrary to appellants' arguments we find no limitation in claim 20 directed to facilitating roaming capability.² Nonetheless, we do not find that Teper teaches that the GUID is sent to a user in an e-mail. The sections of Teper, which the examiner cites, discuss the contact between the service provider and the user to establish authenticity of the user. The communications between the service provider and user make use of cryptographic messages. However, we find no teaching in Teper that the unique identifier is provided in an e-mail. Accordingly, we will not sustain the examiner's rejection of claim 20 under 35 U.S.C. § 102.

Rejection of claims 5, 7, 8, 14 and 21 under 35 U.S.C. § 103

Claims 5 and 14 are dependent upon claims 2 and 12 respectively. Claims 5 and 14 are rejected under 35 U.S.C. § 103 as obvious over Teper and Strandberg. The examiner's rejection is set forth on pages 5 and 6 of the answer. The examiner has not asserted, nor do we find that Strandberg teaches the claim limitation of "determining if a request for roaming capability is received, said request for roaming capability includes an email address." Accordingly, we will not sustain the examiner's rejection of claims 5 and 14 for the reasons discussed *supra* with respect to claims 2 and 12.

² We note that claim 20 is dependent upon claim 18. Claim 18 does not include a limitation directed to roaming nor does it provide antecedent support for claim 20's recitation of "the e-mail address." However, claim 19 does contain a limitation directed to roaming and provides antecedent basis for "the e-mail address."

Finally we consider the rejection of claim 21 under 35 U.S.C. § 103.

Appellants argue on page 11 of the brief that:

[c]laims 5, 14, and 21 are further patentable over Teper and Strandberg, because both failed to teach or suggest the required limitation of “said facilitating comprises sending an email with a uniform resource locator (URL) of the online service provider to the email address.” The limitation does not merely recite sending either an email or a URL. Instead the limitation clearly recites require [*sic*] “the transmission of an email with the URL of the service provider to make possible roaming (“said facilitating comprises”)”

Col. 9, lines 38-46 of Teper may have disclosed URL of a service provider but col. 9, lines 55-57 of Teper merely disclosed “emailing the billing statement” to the subscriber. There is no teaching in either reference of “emailing the URL of the service provider.” In particular, there is no teaching in either reference on “emailing the URL of the service provider” to enable roaming by the subscriber.

Appellants’ arguments are not commensurate with the scope of claim 21.

As discussed *supra*, we reverse the examiner’s rejection of claims 5 and 14 because of limitations directed to a request for roaming capability, however we do not find that claim 21 contains such a limitation. Claim 21 is dependent upon claim 18 and contains the limitation of sending an email with a uniform resource locator (URL), Internet address, of the online service provider.³ Further, we note that the examiner identifies, on page 8 of the brief, that Strandberg, not Teper,

³ We note that claim 21 is dependent upon claim 18. Claim 18 does not include a limitation directed to roaming nor does it provide antecedent support for claim 21’s recitation of “the e-mail address.” However, claim 19 does contain a limitation directed to roaming and provides antecedent basis for “the e-mail address.”

discloses emailing a URL to the user. We find that Strandberg states in paragraph 20 “to electronically connect to the URL address of the Web page 120 provided in the electronic mail sent to the interested party.” Thus, while we agree with appellants that Teper, in column 9, lines 38-46 and 55-57, does not disclose emailing a URL to the user, we find that Strandberg does teach this limitation. Accordingly, we sustain the examiner’s rejection of claim 21 under 35 U.S.C. § 103.

Finally, we note that appellants’ arguments, on pages 11 and 12 of the brief, do not directly address claims 7 and 8 nor indirectly address any of the limitations of claims 7 and 8. Claim 7 is dependent upon claim 1 and claim 8 is dependent upon claim 7. Accordingly, we sustain the examiner’s rejection of claims 7 and 8 under 35 U.S.C. § 103 for the reasons stated supra with respect to claim 1.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief or by filing a reply brief have not been considered and are deemed waived by appellants (see 37 CFR § 41.37(c)(vii)). Support for this rule has been demonstrated by our reviewing court in *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1528-1529 (Fed. Cir. 2002) wherein the Federal Circuit stated that because the appellant did not contest the merits of the rejections in his brief to the Federal Circuit, the issue is waived. *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

Other Issues

As noted in footnotes there are several limitations in the claims, which lack antecedent basis. Appellants and the examiner should insure that these discrepancies are rectified in the application.

In summary, we sustain the examiner's rejections of claims 1, 6, 9 through 11, 15 through 18, and 22 through 24 under 35 U.S.C. § 102, and the examiner's rejection of claims 7, 8, and 21 under 35 U.S.C. § 103. However, we will not sustain the examiner's rejections of claims 2 through 4, 12 through 13, 19 and 20 under 35 U.S.C. § 102 and the examiner's rejection of claims 5 and 14 under 35 U.S.C. § 103. The decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

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Administrative Patent Judge)	
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ANITA PELLMAN GROSS)	APPEALS AND
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