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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SRINIVASA R. **KOPPOLU**, C. DOUGLAS HODGES,
BARRY B. MacKICHAN, RICHARD McDANIEL, RAO V. REMALA,
and ANTONY S. WILLIAMS¹

Appeal No. 2005-1431
Application 09/442,070² for reissue of Patent 5,801,701³

HEARD: November 14, 2005

Before MARTIN, HANLON, and DELMENDO, Administrative Patent Judges.

MARTIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 40-50 for failing to satisfy the written description and enablement requirements of 35 U.S.C. § 112, first paragraph. Also, the specification and the proposed new drawing figures stand objected to

¹ The real party in interest is Microsoft Corporation. Brief at 10.

² Filed November 16, 1999.

³ This patent, which issued from Application 08/707,684, purports to be a divisional of Application 08/229,264, filed April 15, 1994, (now Patent 5,613,058), which is identified as a continuation-in-part of Application 07/984,868, filed December 1, 1992 (abandoned).

under 35 U.S.C. § 251 for containing new matter and the specification stands objected under 37 CFR § 1.75(d)(1) for failing to provide clear support or antecedent basis for some of the terms in claims 40-50. Claims 1-39 have been allowed. We affirm.

In addition, we are entering a new ground of rejection under § 112, first paragraph, for lack of written description support for the terms "hypermedia environment" and "hypermedia document."

A. Related proceedings

The reissue application was filed with claims 1-49, of which claims 1-39 are the unamended claims of original Patent 5,801,701 (hereinafter "'701 patent" or "appellants' patent"), for which reissue is sought.⁴ Claims 40-49 as filed were exact copies of claims 1-10, respectively, of Doyle et al. (Doyle) Patent 5,838,906,⁵ which were copied for the purpose of provoking an interference with that patent.⁶ The Doyle patent is the basis for an infringement action brought in the U.S. District Court for the Northern District of Illinois by The Regents of the University of California and its exclusive licensee, Eolas Technologies, Inc. (hereinafter

⁴ Reissue claim 50 was added later.

⁵ Issued November 17, 1998, based on an application filed October 17, 1994.

⁶ Generally speaking, it is not necessary for an applicant to copy claims to institute an interference with a patent. An interference will be appropriate if the application and the patent include claims which recite "interfering subject matter." See 37 CFR § 41.203(a) (2006) ("Interfering subject matter. An interference exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa.>").

collectively "Eolas") against Microsoft Corporation: Eolas Technologies, Inc. v. Microsoft Corp., No. 99 C 0626 (N.D. Ill.). Specifically, Eolas asserted infringement of the Doyle patent claims by Microsoft's Internet Explorer program.

The district court, pursuant to Markman v. Westview Instruments, 517 U.S. 370, 34 USPQ2d 1321 (1996), entered a memorandum opinion and order construing the following phrase from Doyle patent claims 1 and 6: "wherein said object has type information associated with it utilized by said browser to identify and locate an executable application." Eolas Technologies, Inc. v. Microsoft Corp., No. 99 C 0626, 2000 WL 1898853 (N.D. Ill. Dec. 29, 2000), at *4 (not reported in F.Supp.2d). The court's construction of these terms was based in part on arguments made during the prosecution history of the Doyle patent to distinguish the claims from appellants' U.S. Patent 5,581,686, referred to by the court as "the Koppolu patent," which has the same disclosure as the '701 patent.⁷ Id. at *11-13, 16. The court construed "executable application" to mean "any computer program code, that is not the operating system or a utility, that is launched to enable an end-user to directly interact with data." Id. at *14. Regarding the phrase "utilized by said browser to identify and locate," the court held that "the functions of utilizing the type information to identify and locate the executable application must be performed by the browser, not the operating system as in Koppolu's OLE [Object Linking and Embedding]." Id. at *18.

⁷ Appellants' '686 patent, like their '701 patent, purports to be a continuation of Application 08/229,264, filed April 15, 1994.

Subsequent to issuance of the district court's order providing the above interpretations, appellants amended reissue claims 40 and 45 (copies of Doyle claims 1 and 6, respectively) in the instant reissue application proceeding by deleting the phrase "by said browser." Second Preliminary Amendment⁸ at 5. Following a jury finding that Microsoft infringed claims 1 and 6 of the Doyle patent, the district court entered judgment in favor of Eolas.⁹

On appeal, the Federal Circuit (a) held that the district court improperly granted JMOL in Eolas' favor on Microsoft's anticipation and obviousness defenses and improperly rejected Microsoft's inequitable conduct defense and (b) accordingly vacated the district court's decisions and remanded for further proceedings on those issues. Eolas Technologies, Inc. v. Microsoft Corp., 399 F.3d 1325, 1328, 1341, 73 USPQ2d 1782, 1785, 1795 (Fed. Cir. 2005). In addition, the Federal Circuit affirmed the district court's construction of "executable application" in the Doyle claims, id. at 1336, 73 USPQ2d at 1791, and agreed with the district court that Microsoft's proposed construction, limiting "executable application" to stand-alone programs, does not comport with the entire technological and temporal context for this term. Id. at 1337, 73 USPQ2d at 1792. Furthermore, the Federal Circuit held that Microsoft had waived its right to argue on appeal that the district court erred by instructing the jury as follows regarding the meaning of "utilized by said browser to identify and locate":

⁸ Paper No. 16.

⁹ The district court's decision on post-trial motions is reported as Eolas Technologies Inc. v. Microsoft Corp., 70 USPQ2d 1939 (N.D. Ill. 2004) (not reported in F.Supp.2d).

Utilized by said browser to identify and locate means that the enumerated functions are performed by the browser. . . . The inventors contemplated the browser's use of some outside resources such as the operating system as operating systems are always involved in the operation of computer programs. Nevertheless it must be the browser, not the operating system, that must do the heavy lifting of identifying and locating

Id. at 1331, 1338, 73 USPQ2d at 1787, 1792-93. However, as noted above, the reissue claims before us have been amended to delete the "by said browser" language.

The Doyle patent was until recently the subject of Reexamination Control No. 90/006,831, a Director-initiated reexamination proceeding under 37 CFR § 1.520. On June 6, 2006, a reexamination certificate was issued confirming the patentability of Doyle patent claims 1-10, which were not amended during the reexamination proceeding and which constitute all of the Doyle patent claims.

The Doyle patent is also currently involved in Reexamination Control No. 90/007,858, initiated at the request of a third party.

The Regents of the University of California, the owner of the Doyle patent, have filed several protests during the examination of the reissue application before us.

B. The principal issue in this appeal

The principal issue presented by this appeal is a determination of which parts of The Windows Interface: An Application Design Guide, Microsoft Corp., 1992 (hereinafter "Windows Interface document"), which is the subject of an express incorporation by reference in

the '701 patent, are available to provide written description support under 35 U.S.C. § 112, first paragraph, for the claimed subject matter.¹⁰

C. Appellants' patent disclosure

Appellants' patent discloses a computer system and method (col. 2, ll. 55-57) for editing a compound document which is generated by a first application and includes linked or embedded data generated by one or more other applications. Col. 7, ll. 38-41.

Referring to Figures 1 and 2, a compound document 101 named VAC1.DOC includes (a) text 104 created by a word processing program, (b) scheduling data 102 generated as a chart by a project management program 201, and (c) budgeting data 103 generated by a spreadsheet program 204. Col. 1, l. 22 to col. 2, l. 11.

The compound document 101 as a whole is referred to as a "container" object, and the project management and spreadsheet objects 102 and 103 which are embedded or linked therein are "containe" objects. Col. 7, ll. 46-53. An application that creates a compound document (e.g., Microsoft Word®, hereinafter "Word") is referred to as a container or client application, and an application that creates and manipulates containee objects (e.g., Microsoft Excel®, hereinafter "Excel") is referred to as a server application. Col. 8, ll. 50-53. In a preferred embodiment, application programs ("applications") cooperate using object linking and

¹⁰ "[N]ew matter rejections of claims under § 251 have been reviewed on the basis of a § 112 analysis, that is, on whether a claim found support in an original patent." In re Rasmussen, 650 F.2d 1212, 1214, 211 USPQ 323, 326 (CCPA 1981) (citing In re East, 495 F.2d 1361, 1366, 181 USPQ 716, 719 (CCPA 1974)).

embedding (OLE) facilities to create and manipulate the compound documents. Col. 8, ll. 47-50.¹¹

Figure 3 shows a compound document which is similar to the compound document depicted in Figure 1 and in which the spreadsheet object is described as an embedded object. Col. 8, ll. 25-26. Word treats embedded data as simple bitmaps that Word displays with a BitBlt operation when rendering the compound document on an output device. Col. 2, ll. 3-6. The main window 301 of the Word display, which shows the compound document after it has been opened by Word, includes: (a) a title bar 302 reading "Microsoft Word - VAC1.DOC"; (b) a menu bar 303 with the standard Word menu groups (File, Edit, View, Insert, Format, Tools, Table, Window, and Help); and (c) a client window 304, which includes the native text of the document as well as the embedded Excel spreadsheet object 305 and the embedded scheduling object (unnumbered). Col. 8, ll. 3-14. It appears that any embedded and linked objects (e.g., the Excel spreadsheet object) are displayed automatically whenever Word is used to open the compound document.

¹¹ OLE is defined as follows in Microsoft Press Computer Dictionary 278 (2d ed. 1994): **OLE** . . . ; acronym for object linking and embedding, a way to transfer and share information among applications. When an object (such as an image file created with a paint program) is linked to a compound document (such as a spreadsheet or a document created with a word-processing program), the document contains only a reference to the object; any changes made to the contents of a linked object will be seen in the compound document. When an object is embedded in a compound document, the document contains a copy of the object; any changes to the contents of the original object will not be seen in the compound document unless the embedded object is updated.

A user requests actions by first selecting an object and then selecting an action (e.g., a menu item) to be performed upon the object. Col. 11, ll. 13-16. Selection may be made by using the mouse to double-click on the object (col. 8, ll. 15-18) or the menu item. When the user indicates that the budgeting data is to be edited, the word processing program (Word) determines which application should be used to edit the budgeting data (e.g., the Excel spreadsheet program) and launches (starts up) that application; the user can then manipulate the budgeting data using the launched application, and changes are reflected in the compound document. Col. 7, ll. 55-62. The same procedure is used whether the budgeting data is stored as an embedded object or a linked object. Col. 7, ll. 62-63.

Figure 8 shows the contents of the drop-down Edit menu group when it is selected following selection of the Excel object; the available options include an entry 803 entitled "Microsoft Excel Worksheet Object Edit." If the Edit menu group is selected without previously selecting an Excel object, entry 803 does not appear. Col. 11, ll. 28-29.

Figure 4 shows the appearance of the compound document after the user has selected the Excel object and selected "Microsoft Excel Worksheet Object Edit" from the drop-down Edit menu. The title bar changes to read "Microsoft Excel - Worksheet in VAC1.DOC," the Excel object becomes highlighted by a hatched border pattern 406, the menu bar shows a different set of menu groups (i.e., File, Edit, Formula, Format, Data, Options, Macro, Window, and Help), and a rectangular spreadsheet selection cursor 408 appears which permits selection of an item within the spreadsheet object 405 to be edited using the menu bar. Col. 8, ll. 25-46. As shown in Figure 9, these menu groups comprise a composite menu bar 901 consisting of Word menu

groups 902 and 905 and Excel menu groups 903, 904, and 906. Col. 11, ll. 54-59. Figure 10 collectively designates the menu groups Formula, Format, Data, Options, and Macro menu groups as an Object group and shows it separated from the preceding Edit group by a Container group (e.g., View menu). The preferred order of the menu groups is described in the following passage, which appellants argue operates as an incorporation by reference of the entire Windows Interface document:

In a preferred embodiment, the container and server application menus are interleaved in the final composite menu bar, according to the Microsoft application user interface style guidelines, which is [sic] specified in "The Windows Interface: An Application Design Guide," Microsoft Corp., 1992, which is herein incorporated by reference. Specifically, in the composite menu bar 1003, the groups are arranged left to right in the following order: File, Edit, Container, Object, Window, and Help.

Col. 12, ll. 13-21 (emphasis added).

Applications are preferably provided with an implementation-independent Application Programming Interface (API) that provides object linking and embedding (OLE) functionality. Col. 8, l. 65 to col. 9, l. 1. The API is a set of functions that are invoked by container and server applications to manage, among other things, the setup and initialization necessary for container applications to send and receive messages and data to and from server applications. Col. 9, ll. 1-5. The API provides functions to invoke server applications to manipulate contained objects. Col. 9, ll. 5-7. Furthermore, in a preferred embodiment, the in-place interaction API is implemented using the capabilities of the underlying window system, which in the discussion of the invention is assumed to be similar to the Microsoft Windows 3.1 operating system

("Windows"), although one skilled in the art will appreciate that the present invention can be implemented in a different underlying window system. Col. 12, ll. 23-30.

The '701 patent does not explain whether the disclosed computer system and method are to be practiced on a stand-alone computer or on a network computer or both.

C. The prosecution history relevant to the incorporation by reference issue

Claim 40 as amended by the "Second Preliminary Amendment"¹² reads as follows. We have underlined some of the language the examiner contends lacks written description support in the '701 patent:

40. A method for running an application program in a computer network environment, comprising:

providing at least one client workstation and one network server coupled to said network environment, wherein said network environment is a distributed hypermedia environment,

executing, at said client workstation, a browser application, that parses a first distributed hypermedia document to identity text formats included in said distributed hypermedia document and for responding to predetermined text formats to initiate processing specified by said text formats,

utilizing said browser to display, on said client workstation, at least a portion of a first hypermedia document received over said network from said server,

wherein the portion of said first hypermedia document is displayed within a first browser-controlled window on said client workstation,

wherein said first distributed hypermedia document includes an embed text format, located at a first location in said first distributed

¹² Paper No. 16.

hypermedia document, that specifies the location of at least a portion of an object external to the first distributed hypermedia document,
wherein said object has type information associated with it to identify and locate an executable application external to the first distributed hypermedia document, and
wherein said embed text format is parsed by said browser to automatically invoke said executable application to execute on said client workstation in order to display said object and enable interactive processing of said object within a display area created at said first location within the portion of said first distributed hypermedia document being displayed in said first browser-controlled window.

The "Preliminary Amendment"¹³ filed with the application inserted definitions of a number of terms following column 66, line 41 of the specification and proposed to add new drawing Figures 57 and 58, which are copies of Figures 9.2 and 9.3 from page 170 (in Chapter 9) of the Windows Interface document.

In an April 26, 2001, first Office action,¹⁴ the examiner (a) refused to approve the new drawings and objected to the amendment to the specification as introducing new matter and (b) rejected claims 40-49 under 35 U.S.C. § 112, first paragraph, on the ground that various claim terms, including the "network" terms, lack written description support.

¹³ Paper No. 1.

¹⁴ Paper No. 18.

Appellants responded with "Amendment A,"¹⁵ which deleted the definitions inserted by the preliminary amendment and inserted in their place the textual information from Chapters 5 and 9 of the Windows Interface document, which appellants asserted is incorporated by reference in its entirety by the following passage in the '701 patent. Amendment A at 3. Appellants also deleted proposed new drawing Figures 57 and 58 and submitted new proposed drawing Figures 57-91, described as copies of the drawings in Chapters 5 and 9 of the Windows Interface document.

In an Office action mailed September 10, 2001,¹⁶ which was the first of two final Office actions, the examiner (a) refused entry of all of proposed new drawing Figures 57-91 and objected to the amendment of the specification for containing new matter in violation of 35 U.S.C. § 251 and (b) repeated the § 112 written description support rejection. Specifically, the examiner held that the only material incorporated by reference from the Windows Interface document by the '701 patent and thus properly added to the reissue application is the Chapter 5 material which relates to the order of the menu items. Paper No. 21, at 6. As support for restricting the incorporation by reference to that material, the examiner cited MPEP § 608.01(p), In re de Seversky, 474 F.2d 671, 674, 177 USPQ 144, 146 (CCPA 1967), and Advanced Display Systems, Inc. v. Kent State University, 212 F.3d 1272, 54 USPQ2d 1673 (Fed. Cir. 2000), which he characterized as holding that an incorporation by reference of a document is effective only to

¹⁵ Paper No. 20.

¹⁶ Paper No. 21.

the extent the incorporating language includes a specific identification of the material being incorporated by reference from the document. Paper No. 21, at 5-6. He then held that

the applicants' incorporation by reference statement clearly directs to the arrangement of menus, i.e., where[] menus appear in a menu bar, not the menus themselves or the functions of the menus. Therefore only the teaching of menus arrangement style in the document is incorporated into the specification.

Id. at 8. The incorporated material to which the examiner refers appears in Chapter 5 but not Chapter 9 of the Windows Interface document.

The foregoing objections and rejection for lack of written description support for claims 40-49 were adhered to in an October 19, 2001, supplemental final Office action,¹⁷ which cited In re Saunders, 444 F.2d 599, 602-03, 170 USPQ 213, 216-17 (CCPA 1971) as additional support for restricting the incorporation by reference to the specifically identified subject matter.

Appellants' January 16, 2002, response¹⁸ to the supplemental final Office action further amended the specification by adding text from three documents that are the subject of the following incorporation-by-reference passage in the '701 patent:

In a preferred embodiment, the in-place interaction API is implemented using the capabilities of the underlying window system. The present invention is described assuming the underlying window system is similar to the Microsoft Windows 3.1 operating system ("Windows"), although one skilled in the art will appreciate that the present invention can be implemented in a different underlying window system. The Microsoft Windows 3.1 operating system is described in "Programmer's Reference, Volume 2: Functions," Microsoft Corp., 1992;

¹⁷ Paper No. 23.

¹⁸ Paper No. 25.

"Programmer's Reference, Volume 3: Messages, Structures, and Macros," Microsoft Corp., 1992; and "Guide to Programming," Microsoft Corp., 1992, which are herein incorporated by reference.

'701 patent, col. 12, lines 23-36 (emphasis added). The examiner has not objected to the addition of this material to the specification.

In a March 7, 2002, "Decision on Petition"¹⁹ the Director of Technology Center 2100 dismissed a petition by appellants requesting a ruling on the effect of the incorporation by reference provisions in the '701 patent. The Director dismissed the petition with respect to the Windows Interface document because that question is tied to the rejection for lack of descriptive support and thus appealable rather than petitionable, citing MPEP § 608.04(c)²⁰ and Ex parte Raible, 8 USPQ2d 1709 (Bd. Pat. App. & Int. 1988). Decision on Petition at 2. The petition was dismissed as moot with respect to the other documents because the examiner had not objected to the amendment adding material from those documents. Id. at 3-4.

¹⁹ Paper No. 31.

²⁰ That provision read (and still reads) as follows:

608.04(c) Review of Examiner's Holding of New Matter

Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancelation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also. 37 CFR 1.181 and 37 CFR 1.191 afford the explanation of this seemingly inconsistent practice as affecting new matter in the specification.

MPEP § 608.04(c) (8th ed., Aug 2001).

The examiner's May 14, 2002, Office action,²¹ which was not made final, repeated (a) the objection to the addition of some of the text from Chapter 5 and all of the text from Chapter 9 of the Windows Interface document for containing new matter, (b) the refusal to enter the proposed new drawings, and (c) the rejection under § 112, first paragraph, for lack of descriptive support. In addition, the examiner added a new objection to the specification for failing to provide proper antecedent bases for the claim terms at issue, citing MPEP § 608.01(o) and 37 CFR § 1.175(d)(1). Paper No. 33, at 4. As support for the proposition that an incorporation by reference is effective only with respect to specifically identified subject matter, he cited only Saunders and Raible. Paper No. 33, at 8-10. In addition, he added a new ground of rejection of claims 40-49 under § 112, first paragraph, for a lack of enablement. Id. at 6-7.

Appellants' August 19, 2002, Amendment C²² added a new claim 50 modeled on claim 40 but omitting the "network" terminology.

In a November 14, 2002, decision entitled "On Petition,"²³ the Deputy Commissioner for Patent Examination Policy denied a May 7, 2002, petition by appellants to direct the Director of Technology Center 2100 to review the merits of the examiner's objection to the specification and proposed drawings for containing new matter.

²¹ Paper No. 33.

²² Paper No. 37.

²³ Paper No. 35.

D. The final Office action

The objections and rejections set forth in the previous Office action are repeated as to claims 40-49 and also entered against new claim 50 in the March 3, 2003, final Office action²⁴ from which this appeal was taken.

In addition to the rejections, the objection for new matter is clearly within our jurisdiction because it involves the merits of the rejection for lack of written description support. MPEP § 608.04(c). Also, the objection under 37 CFR § 1.75(d)(1) has sufficient nexus to the merits of that rejection to permit its consideration.

E. The grouping of claims

Claims 41-44 depend on independent claim 40, and claims 46-49 depend on independent claim 45. Independent claim 50 has no dependent claim or claims. Appellants treat claims 40-49 as standing or falling together for purposes of this appeal (Brief at 11) and of those claims argue the merits of only claim 40. Claim 50 is argued separately. The examiner likewise limits his arguments to claims 40 and 50. We will accordingly restrict our discussion to those two claims.

F. The incorporation by reference issue

The principal question before us is whether language which incorporates by reference a document per se while discussing the relevance of only a portion thereof is effective with respect to the entire document or with respect to only the discussed material.

²⁴ Paper No. 41.
(Continued on next page.)

The version of MPEP § 608.01(p) that was in effect on the September 4, 1996, filing date of the application that matured into the '701 patent read in pertinent part as follows:

In addition to other requirements for an application, the referencing application should include an identification of the referenced patent, application, or publication. Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found.

MPEP § 608.01(p) at 600-62 to 600-64 (6th ed., rev. 2, July 1996) (emphasis added; copy enclosed). Appellants argue that the examiner erred by treating the sentence underlined above as mandatory rather than permissive, citing as support In re Goodwin, 43 USPQ2d 1856, 1858 (Comm'r Pats. & Trademarks 1997) (unpublished); In re Lund, 376 F.2d 982, 989, 153 USPQ 625, 631 (CCPA 1967); General Electric Co. v. Brenner, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968); MPEP § 2163.07; and the following PTO notices: (a) Guidelines for Incorporation by Reference in Patent Applications, 34 Fed. Reg. 883 (Jan. 18, 1969), reprinted in 859 Off. Gaz. Pat. Office 346 (Feb. 11, 1969) (Attachment D to brief); and (b) Response to Comment 34, Changes to Patent Practice and Procedure – Final Rule, 62 Fed. Reg. 53,132, 53,145-46 (Oct. 10, 1997), reprinted in 1203 Off. Gaz. Pat. & Trademark Office 63, 75 (Oct. 21, 1997) (Attachment E to brief) ("1997 Final Rule Notice"). Brief at 20-24. However, it is evident from events which have occurred subsequent to the filing of appellants' brief that the Director of the PTO gives the above-underlined language in MPEP § 608.01(p) a permissive interpretation. In the current version of that provision, the term "should" in the first sentence quoted above has been changed to "must" while the term "should" in the second sentence has remained unchanged:

In addition to other requirements for an application, the referencing application *>must< include an identification of the referenced patent, application, or publication. >See 37 CFR 1.57(b)(2)[.]< Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be.

MPEP § 608.01(p) (8th ed., rev. 4, Oct. 2005) (emphasis added).²⁵ The basis for the change, i.e., 37 CFR § 1.57(b)(2), became effective on October 21, 2004. Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan --

²⁵ The paragraph which includes the language quoted above reads in pertinent part as follows:

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. In re de Seversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). >37 CFR 1.57(b)(1) limits a proper incorporation by reference (except as provided in 37 CFR 1.57(a)) to instances only where the perfecting words "incorporated by reference" or the root of the words "incorporate" (e.g., incorporating, incorporated) and "reference" (e.g., referencing) appear. The requirement for specific root words will bring greater clarity to the record and provide a bright line test as to where something is being referred to is an incorporation by reference. The Office intends to treat references to documents that do not meet this "bright line" test as noncompliant incorporations by reference and may require correction pursuant to 37 CFR 1.57(g). If a reference to a document does not clearly indicate an intended incorporation by reference, examination will proceed as if no incorporation by reference statement has been made and the Office will not expend resources trying to determine if an incorporation by reference was intended. < In addition to other requirements for an application, the referencing application *>must< include an identification of the referenced patent, application, or publication. >See 37 CFR 1.57(b)(2)[.]< Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found.

MPEP § 608.01(p) (8th ed., rev. 4, Oct. 2005).

Final Rule, 69 Fed. Reg. 56,482 (Sept. 21, 2004), reprinted in 1278 Off. Gaz. Pat. & Trademark Office 67 (Oct. 12, 2004). Section 1.57(b) reads:

§ 1.57 Incorporation by reference

.....
(b) Except as provided in paragraph (a) of this section, an incorporation by reference must be set forth in the specification and must:

- (1) Express a clear intent to incorporate by reference by using the root words "incorporat(e)" and "reference" (e.g., "incorporate by reference"); and
- 2) Clearly identify the referenced patent, application, or publication.

Not only does Section 1.57(b) fail to additionally require identification of the particular part or parts of the referenced document which are being incorporated by reference, the commentary to the final rulemaking notice explains that such identification is permissive:

The Office recommends that particular attention be directed to specific portions of referenced documents where the subject matter incorporated may be found if large amounts of material are incorporated.

69 Fed. Reg. at 56,501, 1287 Off. Gaz. Pat. & Trademark Office at 82 (emphasis added). In light of this commentary, appellants appear to be correct to conclude that the MPEP § 608.01(p) language "[p]articular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found" is permissive rather than mandatory.

The question remains, however, whether this permissive approach is consistent with the requirements of the statutes, see Molins PLC v. Textron, Inc., 48 F.3d 1172, 1180 n.10, 33 USPQ2d 1823, 1828 n.10 (Fed. Cir. 1995) ("While the MPEP does not have the force of law,

it is entitled to judicial notice as an official interpretation of statutes or regulations as long as it is not in conflict therewith.") (citing Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1439, 221 USPQ 97, 107 (Fed. Cir. 1984)), and more particularly with the requirements of 35 U.S.C. § 112, first paragraph,. We begin by noting that in General Electric, the D.C. Circuit addressed the question of

[w]hether the Commissioner of Patents has the authority, under the applicable statutes and regulations, to issue a patent upon an application which incorporates, by reference, in its disclosure, substantial portions of a disclosure of an existing patent? If he does have such power, to what extent may "incorporation by reference" be permitted?

407 F.2d at 1261, 159 USPQ at 337. The court held:

The duty to superintend the issuance of patents resides in the Commissioner by statute. In exercising those duties the Commissioner is given wide discretion based upon his experience and expertise and the courts should not disturb his rulings unless a clear abuse of that discretion is manifest. However, the question before this Court arises not out of an abuse of discretion but upon the limits of discretion. In that regard, we hold that the Commissioner has the authority to issue a patent upon an application wherein the disclosure incorporates, by reference, (and relies thereon) certain portions of a disclosure of an existing patent provided that this information relied upon is available to the public.

Id. at 1262, 159 USPQ at 338 (footnote omitted; emphasis added). The court did not elaborate on its language "incorporates, by reference (and relies thereon) certain portions of a disclosure."²⁶

²⁶ The court further held that an incorporation by reference which satisfies the requirements of 35 U.S.C. § 112 will necessarily satisfy the requirements of 35 U.S.C. § 154, which read:

35 U.S.C. § 154 (1964). Contents and term of patent.
(Continued on next page.)

In In re Hawkins, 486 F.2d 569, 179 USPQ 157 (CCPA 1973), the CCPA discussed the General Electric decision as follows:

[T]he [General Electric] court considered the difficulties presented when applicants incorporate by reference information contained in other sources, such as patents, publications, etc. After reviewing the cases on the subject and the practicalities of the situation, the court concluded that the practice did indeed have longstanding basis in the law, and that necessarily the Commissioner of Patents is vested with wide discretion to formulate rules and guidelines governing its use, thereby to prevent its abuse.

486 F.2d at 573, 179 USPQ at 161 (emphasis added.) Hawkins neither discusses nor adopts General Electric's "incorporates, by reference, (and relies thereon) certain portions of a disclosure" standard.

During oral argument in the instant appeal, counsel was invited to file a paper addressing Advanced Display. Appellants timely filed such a paper, entitled "Supplement to Appellants' Reply to Examiner's Answer" (hereinafter "Supplemental Reply"), which addresses not only Advanced Display but also Ultradent Products, Inc. v. Life-Like Cosmetics, Inc., 127 F.3d 1065, 44 USPQ2d 1336 (Fed. Cir. 1997), which appellants characterize as more pertinent to the issue.²⁷

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specifications for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.
Id. at 1263, 159 USPQ at 338 (emphasis by the court.)

²⁷ Counsel was not invited to, and did not, address Atmel Corp. v. Information Storage Devices, Inc., 198 F.3d 1374, 53 USPQ2d 1225 (Fed. Cir. 1999), wherein the court held that "the (Continued on next page.)

Subsequent to the filing of the Supplemental Reply, the Federal Circuit addressed the requirements for an incorporation by reference in Cook Biotech, Inc. v. ACell, Inc., 460 F.3d 1365, 79 USPQ2d 1865 (Fed. Cir. 2006). Cook Biotech was an appeal from the district court's denial of post-trial motions pertaining to claim construction, infringement, and the adequacy of the jury verdict form subsequent to a jury finding that ACell, Inc.'s ("ACell's") commercial product, ACellVet™, infringed U.S. Patent 5,554,389 ("the '389 patent"). One of the questions before the Federal Circuit was whether ACell was correct to argue that the claim language "the luminal portion of the tunica mucosa" should be given the definition it has in Patent No. 4,902,508 ("the '508 patent"), which is the subject of the following incorporation-by-reference passage in the '389 patent:

The preparation of UBS from a segment of urinary bladder is similar to the procedure for preparing intestinal submucosa detailed in U.S. Pat. No. 4,902,508, the disclosure of which is expressly incorporated herein by reference. A segment of urinary bladder tissue is first subjected to abrasion using a longitudinal wiping motion to remove both the outer layers (particularly the abluminal smooth muscle layers) and the luminal portions of the tunica mucosa layers--the epithelial layers). The resulting submucosa tissue has a thickness of about 80 micrometers, and consists primarily (greater than 98%) of a cellular, eosinophilic staining (H&E stain) extracellular matrix material. Occasional blood vessels and spindle cells consistent with fibrocytes are scattered randomly throughout the tissue. . . .

district court correctly held that structure supporting a means-plus-function claim under § 112, ¶ 6 must appear in the specification," id. at 1381, 53 USPQ2d at 1229, which the Federal Circuit construed for § 112, ¶ 6 purposes as not including subject matter incorporated by reference into the specification. Id. at 1382, 53 USPQ2d at 1230-31.

'508 patent, col. 2, ll. 17-30 (emphasis added). The Federal Circuit held that it was proper to rely on the '508 patent for the definition:

The term "epithelial layers" may arguably be subject to two interpretations. . . . Even accepting that the disclosure in the '389 specification itself is less than clear as to which interpretation is correct, the second important disclosure of the '389 specification is dispositive. As noted, the '389 patent specification expressly incorporates by reference the procedure for preparing intestinal submucosa from the '508 patent.

"Incorporation by reference provides a method for integrating material from various documents into a host document . . . by citing such material in a manner that makes clear that the material is effectively part of the host document as if it were explicitly contained therein." Advanced Display Sys., Inc. v. Kent State Univ., 212 F.3d 1272, 1282 [54 USPQ2d 1673, 1679] (Fed. Cir. 2000) (citations omitted). "To incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various documents." Id. (citations omitted). Whether and to what extent material has been incorporated by reference into a host document is a question of law. Id.

The relevant portions of the '508 patent specification are as follows: . . .

As this disclosure makes clear: (1) "the luminal portion of the tunica mucosa" is represented by "layer G" in Figure 1 of the '508 patent, and (2) layer G in that figure corresponds to the lamina epithelialis mucosa and its lamina propria. . . .

Cook Biotech, 460 F.3d at ___, 79 USPQ2d at 1872-73 However, because the court was not called upon to determine whether the incorporation by reference is effective with respect to subject matter in the '508 patent other than the disclosed procedure for preparing intestinal submucosa, for which it was specifically cited, the court's quotation of Advanced Display's admonition that "[t]o incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various documents" arguably constitutes dictum rather than a holding.

The same criticism does not, however, apply to Advanced Display, as appellants contend. Supplemental Reply at 8. Advanced Display was a declaratory judgment action brought by Advanced Display Systems (ADS) for a judgment of invalidity against a West patent assigned to Kent State University (Kent), which action was consolidated with an action charging infringement of that patent. ADS argued that the West patent is invalid for anticipation by a U.S. patent to Hass, taking into account the subject matter incorporated by reference therein, and for obviousness.²⁸ The jury determined that the West patent was invalid for anticipation by the Hass patent and for obviousness and was not infringed. 212 F.3d at 1280, 54 USPQ2d at 1678.

On appeal, Kent argued that the magistrate judge committed legal error by instructing the jury to determine which material was incorporated by reference into the Haas patent for purposes of anticipation. Id. at 1281, 54 USPQ2d at 1679.²⁹ The Federal Circuit agreed with Kent, holding that "[w]hether and to what extent material has been incorporated by reference into a host document is a question of law," id. at 1283, 54 USPQ2d at 1680, after explaining that the law requires a specific identification of the material which is being incorporated by reference from the source document:

Incorporation by reference provides a method for integrating material from various documents into a host document—a patent or printed publication in an

²⁸ The Federal Circuit noted that during the trial, ADS never contended that the material expressly set forth in the Hass patent alone would anticipate the West patent claims. 212 F.3d at 1284, 54 USPQ2d at 1680.

²⁹ In view of Kent's failure to make a motion for JMOL at the close of evidence or following the jury verdict, the Federal Circuit held it would not disturb the jury's factual determinations. 212 F.3d at 1281, 54 USPQ2d at 1678.

anticipation determination-by citing such material in a manner that makes clear that the material is effectively part of the host document as if it were explicitly contained therein. See General Elec. Co. v. Brenner, 407 F.2d 1258, 1261-62, 159 USPQ 335, 337 (D.C. Cir.1968); In re Lund, 54 C.C.P.A. 1361, 376 F.2d 982, 989, 153 USPQ 625, 631 (CCPA 1967). To incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various documents. See In re [de] Seversky, 474 F.2d 671, 674, 177 USPQ 144, 146 (CCPA 1973) (providing that incorporation by reference requires a statement "clearly identifying the subject matter which is incorporated and where it is to be found"); In re Saunders, 58 C.C.P.A. 1316, 444 F.2d 599, 602-03, 170 USPQ 213, 216-17 (CCPA 1971) (reasoning that a rejection for anticipation is appropriate only if one reference "expressly incorporates a particular part" of another reference); National Latex Prods. Co. v. Sun Rubber Co., 274 F.2d 224, 230, 123 USPQ 279, 283 (6th Cir. 1959) (requiring a specific reference to material in an earlier application in order have that material considered part of a later application); cf. Lund, 376 F.2d at 989, 153 USPQ at 631 (holding that a one sentence reference to an abandoned application is not sufficient to incorporate material from the abandoned application into a new application).

212 F.3d at 1282, 54 USPQ2d at 1679 (emphasis added). Significantly, the court additionally held that the magistrate's referral of the incorporation by reference question to the jury constituted prejudicial error:

In the present case, determining what material was incorporated by reference into the Haas patent was a critical question of law for the magistrate judge to resolve before submitting the factual issue of anticipation to the jury. Indeed, during trial, ADS never contended that the material explicitly set forth in the Haas patent alone would anticipate the West patent. Rather, ADS's anticipation argument hinged on the combination of the Haas patent and the material potentially incorporated therein. The magistrate judge, however, failed to address the legal question; instead, he left that determination for the jury. This misallocation of responsibility goes to the core of an anticipation determination when, if incorporation by reference is at issue, the court must determine what material constitutes the single, prior art document. Consequently, because the instruction vitiated Kent's right to have a pivotal legal question resolved by the court, we hold that the legal error was prejudicial.

Id. at 1283-84, 54 USPQ2d at 1680-81 (emphasis added).

Appellants argue that Advanced Display's requirement for a specific identification of the part or parts of a document which are being incorporated by reference should be understood as limited to situations which do not involve an express incorporation by reference. Supplemental Reply at 8. As support for this view, appellants note, correctly, the absence of an express incorporation by reference in de Seversky, Saunders, or Lund. Supplemental Reply at 9-11. This argument is unconvincing because, although not noted by the Federal Circuit, Advanced Display involved express incorporations by reference, including:

The first portion of the practice of the present invention, i.e., applying an electrical field to a liquid crystalline material in either the Grandjean or focal-conic texture of the cholesteric mesophase to transform the material into the nematic mesophase, the applied electrical field being within the cholesteric to nematic electrical field range of said liquid crystalline material, is amply described in U.S. Pat. No. 3,652,148, hereby expressly incorporated by reference. While that patent is generically directed to the broader invention of transforming an optically negative liquid crystalline material into an optically positive liquid crystalline material by applying an electrical field across the material, the lists of liquid crystalline materials and mixtures thereof, the description of cell fabrication, the electrical field strengths required for phase transformation, etc., are described in detail in U.S. Pat. No. 3,652,148. These need not be elaborated upon herein. Furthermore, a whole host of liquid crystalline materials and mixtures thereof typically suitable for providing a liquid crystalline material in the Grandjean or focal-conic textures of the cholesteric mesophase are listed in U.S. Pat. Nos. 3,704,056 and 3,680,950 hereby expressly incorporated by reference.

Hass patent, col. 3, l. 49 to col. 4, l. 4 (emphasis added). In addition, the Hass patent states:

The optically active material can be either mesomorphic or non-mesomorphic, as is well-known in the art. See, for example, U.S. Pat. No. 3,909,114, hereby

expressly incorporated by reference, at Columns 5 and 6 thereof, for a listing of a whole host of nematic and mesomorphic and non-mesomorphic optically active materials which can be utilized.

Hass patent, col. 6, ll. 38-44 (emphasis added). Furthermore, as in the instant appeal, the incorporation by reference is applied to the document per se rather than merely to the material therein which is specifically discussed in the incorporating language. In our view, it is reasonable to assume that had the court been of the view that an express incorporation by reference of a document per se is necessarily effective with respect to the entire contents of the document, the opinion would have so stated. Also, the court presumably would have further held that as a result the magistrate judge's referral of the incorporation issue to the jury, which presumably held that sufficient material was incorporated by the Hass patent to result in anticipation of the West claims, did not constitute prejudicial error.

Appellants, on the other hand, cite Ultradent, decided before Advanced Display, as support for construing their express incorporation by reference of the Windows Interface document as effective with respect to the entire document even though the incorporating language specifically discusses only the manner of interleaving menu items, which appears only in Chapter 5. Supplemental Reply at 5. The issue before the Federal Circuit in Ultradent was whether the district court, in denying a motion for the entry of partial summary judgment against claims of Ultradent Patents 5,098,303 and 5,234,342 on the ground of anticipation by any one of a U.S. patent to Rosenthal, a U.S. patent to Munro which refers to the Rosenthal patent, and an article to Haywood and Heymann, erred in construing the scope and content of that prior art.

The claims in question recited a tooth bleaching method employing a composition containing, inter alia, "carboxypolymethylene," a term the district court construed, without objection by the parties, as limited to "a slightly acidic vinyl polymer with active carboxyl groups" (emphasis added). Ultradent Products, Inc. v. Life-Like Cosmetics, Inc., 924 F.Supp. 1101, 1109, 39 USPQ2d 1969, 1975-76 (D. Utah 1996). The Munro patent discloses and claims a process for bleaching teeth using a dental splint (i.e., tray) that is filled with a bleaching composition and applied to the tooth surfaces.³⁰ Munro does not claim credit for inventing the bleaching composition, instead claiming to "have discovered that peroxide compounds, which have been commercially available for a number of years and used by professionals and others for a wide variety of purposes have an unexpected result when used in a very specific manner." Munro, col. 1, l. 66 to col. 2, l. 2. According to Munro,

[t]he commercial product PROXIGEL, described in U.S. Pat. No. 3,657,413 issued on Apr. 18, 1972 to M. W. Rosenthal, which patent is hereby incorporated herein by reference, is one attempt to overcome the problems of hydrogen peroxide by using urea peroxide in a slowly dispersable glycerol based solvent. This combination, according to the above-mentioned patent, improves sustained nascent oxygen release. It is the nascent oxygen release which is believed to cause the antiseptic and/or cleansing effect of the peroxide.

³⁰ Claim 1 of the Munro patent reads:

1. The process of brightening teeth comprising the steps of:
obtaining a substantially liquid tight splint to cover the tooth or teeth to be brightened;
placing within said splint a brightener agent at the location within said splint associated with the tooth surfaces to be brightened; and
placing the splint containing said brightener agent around the tooth or teeth to be brightened.

PROXIGEL, which is manufactured by Reed & Carnrick, is a 10% solution of carbamide peroxide in a water free gel base.

Munro, col. 2, ll. 10-22 (emphasis added).³¹ Munro explains that

[i]n contrast to the prior art, the process of this invention begins with a professional making a splint for the user. The splint is, advantageously, made from a clear, very thin plastic material and is designed to extend onto the user's gingiva and to fit tightly thereto so as to minimize air or saliva from impacting the enclosed teeth. The splint is designed to fit one or more teeth as desired. The user then places a drop or two of the cleanser solution [(]such as the peroxide based PROXIGEL solution discussed above) into the splint and places the splint, with the solution inside, around the tooth or teeth and over a portion of the gingiva.

Id. at col. 2, l. 60 to col. 3, l. 3.

Rosenthal discloses "an antiseptic composition comprising urea peroxide, glycerol, and a carboxypolymethylene polymer," col. 1, ll. 24-25, and expresses a preference for the neutral salts thereof:

The preferred carboxypolymethylene polymers incorporated in such compositions are copolymers of from 97.5 to 99.8 percent by weight of acrylic acid and from 0.2 to 2.5 percent by weight of polyallyl sucrose having at least two allyl groups per sucrose molecule. Desirably, such polymers are employed as the neutral salts thereof. By "neutral" is meant that the pH of a 1 weight percent solution of the salt of the polymer has a pH of from about 5 to about 9, and preferably from about 6 to about 8.

Rosenthal, col. 3, ll. 22-32 (emphasis added). Moreover, Rosenthal's claim 1, the sole independent claim, recites, inter alia, "a pharmaceutically acceptable neutral salt of a carboxypolymethylene polymer."

³¹ This incorporating language is not quoted or discussed in the Federal Circuit's opinion.

The district court held that "Rosenthal, Munro (incorporating Rosenthal by reference), and the Haywood and Heymann article all disclose the use of Rosenthal compositions which include a gel including a pharmaceutically acceptable neutral salt of a carboxypolymethylene polymer," 924 F.Supp. at 1115, 39 USPQ2d at 1979 (emphasis added), and concluded that "because none of the prior art references disclose the use of a composition containing slightly acidic vinyl polymer with active carboxyl groups, none anticipate claim 1 of the '303 patent." Id. at 1115, 39 USPQ2d at 1979-80.

The Federal Circuit held the district court's construction of the Rosenthal disclosure to be erroneous:

Although Rosenthal states that a neutralized salt of carboxypolymethylene is the preferred form of the polymer, the disclosure of Rosenthal is not limited to the neutralized salt. Rather, the patent refers to carboxypolymethylene in general as the thickening agent for the claimed composition. The district court thus erred by construing the scope of the Rosenthal disclosure as limited to the preferred embodiment.

127 F.3d at 1068, 44 USPQ2d at 1339. In addition, as pointed out by appellants in the instant appeal, the court rejected Ultradent's argument that Munro's incorporation by reference of Rosenthal is limited to Proxigel, Rosenthal's commercial embodiment:

The Munro patent incorporates by reference the entire contents of the Rosenthal disclosure. Ultradent's assertion that Munro "says nothing" about the Rosenthal compositions and merely discloses using the commercial embodiment of the Rosenthal patent is contrary to the rules of practice, which permit incorporation of prior art by reference. See United States Department of Commerce, Patent and Trademark Office, Manual of Patent Examining Procedures § 608.01(p) (6th ed. 1996) (discussing incorporation-by-reference procedures).

27 F.3d at 1069, 44 USPQ2d at 1339-40 (emphasis added). Appellants therefore appear to be correct to characterize Ultradent as holding that "an incorporation by reference statement substantially like Appellants' is effective to incorporate the entire document referenced by the statement." Supplemental Reply at 5.

We are unable to reconcile this Ultradent holding with Advanced Display, which cites Ultradent only for the proposition that "[m]aterial not explicitly contained in the single, prior art document may still be considered for purposes of anticipation if that material is incorporated by reference into the document." Advanced Display, 212 F.3d at 1282, 54 USPQ2d at 1679. Where two Federal Circuit decisions, neither en banc, are in conflict, it is necessary to determine which, if either, of the decisions is consistent with CCPA precedent. See South Corp. v. United States, 690 F.2d 1368, 1369, 215 USPQ 657, 657 (Fed. Cir. 1982) (CCPA and Court of Claims decisions are binding precedent in Federal Circuit until overruled en banc). Unfortunately, the CCPA decisions cited in Advanced Display do not assist in resolving this question one way or the other, as none involve language which purports to incorporate an entire document by reference while discussing only a portion thereof. Instead, in de Seversky and Lund the question was whether an incorporation by reference of material from an earlier application had occurred.³² In Saunders, the question was whether a "particular part," namely, Example I(a), of a

³² See Lund, 376 F.2d at 988, 153 USPQ at 631 ("[W]e do not think that the single sentence by which Margerison refers to his earlier application -- 'The present application is a continuation-in-part application of our application Serial No. 763,806, filed September 29, 1958 (now abandoned)' -- is sufficient in and of itself to render Example 2 of the abandoned application part of the patent disclosure as if fully set out therein."); de Seversky, 474 F.2d (Continued on next page.)

Bailey application was incorporated by reference into a Hostettler application relied on by the examiner as anticipatory prior art.³³ The incorporating language at issue read as follows:

The above-described siloxane-oxyalkylene block copolymers can be prepared in accordance with the procedures described and claimed in the copending application of D. L. Bailey and F. M. O'Conner, Serial No. 417,935, filed December 14, 1953.

455 F.2d at 603, 170 USPQ at 217. Based on the manner in which Hostettler described the invention, the court held that a person skilled in the art would have understood the phrase "[t]he above-described siloxane-oxyalkylene block copolymers" to be referring to material in Bailey which does not include Example I(a). Id.

Nor is any specific guidance on the question before us provided by Hawkins, In re Voss, 557 F.2d 812, 816-17, 194 USPQ 267, 269-70 (CCPA 1977), or In re Hughes, 550 F.2d 1273, 193 USPQ 141 (CCPA 1977), all decided after Saunders.³⁴

at 674, 177 USPQ at 146 ("To be sure, the statement that an application is a continuation-in-part, or a continuation, or a division, or in part a continuation of another application is in a broad sense a 'reference' to the earlier application, but a mere reference to another application, or patent, or publication is not an incorporation of anything therein into the application containing such reference for the purposes of the disclosure required by 35 U.S.C. 112.").

³³ The court phrased the issue this way: "The section 102 rejection in this case can be sustained only on the theory that Hostettler expressly incorporates a particular part of Bailey by reference." 444 F.2d at 602, 170 USPQ at 216. This is apparently the basis for Advanced Display's characterization of Saunders as "reasoning that a rejection for anticipation is appropriate only if one reference 'expressly incorporates a particular part' of another reference." 212 F.3d at 1282, 54 USPQ2d at 1680.

³⁴ Hawkins involved the following incorporation by reference language: "These novel compounds may for example be used in the production of valuable monomers for example by the processes described in copending British applications 36107/66, 42756/66, 46971/66, 49699/66, (Continued on next page.)

Thus, no CCPA or Court of Claims decision of which we are aware provides clear support for either Advanced Display or Ultradent. However, Advanced Display's requirement that "[t]o incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various documents," 212 F.3d at 1282, 54 USPQ2d at 1679 (citation omitted), comports with General Electric's holding that "the Commissioner has the authority to issue a patent upon an application wherein the disclosure incorporates, by reference, (and relies thereon) certain portions of a disclosure of an existing patent provided that this information relied upon is available to the public," 407 F.2d at 1262, 159 USPQ at 338 (emphasis added), which holding was based on the court's consideration of the requirements of 35 U.S.C. § 112, including the written description requirement. Id. at 1261, 159 USPQ at 337. Although not stated in General Electric, it is evident that the absence of a specific identification of the material of the source document that is being incorporated by reference and an explanation of what it is being relied on to show will make it difficult for examiners, the public, and the courts to determine which material the inventor considered to be part of his or her invention when the application was filed.

50324/66, 10070/67, and 10071/67." 486 F.2d at 571, 179 USPQ at 159. Voss concerned the language "[r]eference is made to United States Patent No. 2,920,971, granted to S.D. Stookey, for a general discussion of glass-ceramic materials and their production." 557 F.2d at 815, 194 USPQ at 269. Hughes involved the language "reference is made to application Ser. No. 131,108 for complete descriptions of methods of preparing aqueous polymeric dispersions applicable in the hereinafter described invention." 550 F.2d at 1275, 193 USPQ at 143 (emphasis omitted).

See Cordis Corp. v. Medtronic AVE, Inc., 339 F.3d 1352, 1364, 67 USPQ2d 1876, 1885 (Fed.

Cir. 2003) (emphasis added):

Paragraph 1 of section 112 of the Patent Act provides that the "specification shall contain a written description of the invention." To fulfill the written description requirement, the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed. Lockwood v. Am. Airlines, Inc., 107 F.3d 1565, 1572 [41 USPQ2d 1961, 1966] (Fed. Cir. 1997); In re Gosteli, 872 F.2d 1008, 1012 [10 USPQ2d 1614, 1618] (Fed. Cir. 1989).

"It is not sufficient for purposes of the written description requirement of § 112 that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose." Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966. See also Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1330, 65 USPQ2d 1385, 1397 (Fed. Cir. 2003) ("The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is therefore required to 'recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.' [Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555,] 1561, 19 USPQ2d [1111,] 1115 [(Fed. Cir. 1991)] (citation omitted)." Separating incorporations by reference from the written description requirement of § 112, first paragraph, by permitting applicants to incorporate by reference entire documents without an explanation of what they are being relied on to show would invite the wholesale incorporation by reference of large numbers of documents and correspondingly increase the burden on examiners, the public, and the courts to determine the metes and bounds

of the application disclosures. See *Advanced Display*, 212 F.3d at 1283, 54 USPQ2d at 1680 ("[I]f incorporation by reference comes into play in an anticipation determination, the court's role is to determine what material in addition to the host document constitutes the single reference. The factfinder's role, in turn, is to determine whether that single reference describes the claimed invention.").

For the foregoing reasons, we will apply the law on incorporation by reference as stated in *Advanced Display* and repeated in *Cook Biotech*.

Appellants' argument that MPEP § 2163.07(b)³⁵ "expressly authorizes the incorporation by reference of an entire document," Brief at 20, is unconvincing because an incorporation by reference must satisfy the specificity requirement of *Advanced Display*. Nor does appellants'

³⁵ The version of this provision that was in effect when the brief was filed read:
2163.07(b) Incorporation by Reference

Instead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. Replacing the identified material incorporated by reference with the actual text is not new matter. See MPEP § 608.01(p) for Office policy regarding incorporation by reference.

MPEP 2163.07 (8th ed., rev. 1, Feb. 2003) (emphasis added). In the current version, the last sentence has been amended to read:

See >37 CFR 1.57 and< MPEP § 608.01(p) for Office policy regarding incorporation by reference. See MPEP § 2181 for the impact of incorporation by reference on the determination of whether applicant has complied with the requirements of 35 U.S.C. 112, second paragraph when 35 U.S.C. 112, sixth paragraph is invoked.

MPEP § 2163.07(b) (8th ed., rev. 4, Oct. 2005) (emphasis added).

position find support in the commentary to the 1997 Final Rule Notice (Attachment E to brief), of which appellants' brief (at 21) reproduces only the following text:

Nevertheless, an applicant may incorporate by reference the prior application by including, in the continuing application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference."

1997 Final Rule Notice, Response to Comment 34, 62 Fed. Reg. at 53,146 (1st col.), 1203 Off. Gaz. Pat. & Trademark Office at 75 (Appendix E, 2d page). This commentary is limited to the situation in which an application incorporates by reference an earlier application of which it purports to be a continuation or divisional and thus has no relevance to the incorporation-by-reference issue presented by this appeal. In any event, as explained above, the effect of appellants' incorporation by reference must be judged in light of Advanced Display.

Finally, appellants contend that the examiner's objection to the amendment adding material from the Windows Interface document is inconsistent with his failure to object to the amendment adding three volumes of material from one of the other documents which is expressly incorporated by reference. Brief at 23. The examiner's failure to object to those materials, which appellants do not allege to be cumulative to the material relied on in Chapter 9 (addressed *infra*), has not been shown to be relevant to the merits of the examiner's objection to the Chapter 9 material.

Turning now to the scope of appellants' incorporation by reference, as already noted, the incorporating language reads as follows:

In a preferred embodiment, the container and server application menus are interleaved in the final composite menu bar, according to the Microsoft

application user interface style guidelines, which is specified in "The Windows Interface: An Application Design Guide," Microsoft Corp., 1992, which is herein incorporated by reference. Specifically, in the composite menu bar 1003, the groups are arranged left to right in the following order: File, Edit, Container, Object, Window, and Help.

'701 patent, col. 12, ll. 50-21. We agree with the examiner that the only material this passage incorporates by reference from the Windows Interface document is the material in Chapter 5 ("Menus") that relates to the order of interleaving of the menu groups in the composite menu bar. For example, page 88 explains that "On the menu bar, generally File appears first, followed by Edit (if supported). Help is generally the last menu on the bar," while page 97 explains that the Window menu "should be the last menu before Help."

As a result, the remainder of Chapter 5 and all of Chapter 9 ("Object Linking and Embedding") constitute new matter to the extent they add anything to the disclosure of the original patent (including the menu group interleaving guidelines from the Windows Interface document) and thus cannot be relied on to provide written description support for any of claims 40-50.

G. The merits of the rejection based on the written description requirement of 35 U.S.C. § 112, first paragraph

As explained in Reiffin v. Microsoft, 214 F.3d 1342, 1346, 54 USPQ2d 1915, 1917 (Fed. Cir. 2000), written description support can be either express or inherent:

Compliance of the '603 and '604 patents with the written description requirement requires that the specifications of these patents describe the inventions claimed in these patents. Thus, for example, the 1990 application considered as a whole must convey to one of ordinary skill in the art, either explicitly or inherently, that Mr. Reiffin invented the subject matter claimed in the '603 patent. See Vas-Cath [Inc. v. Mahurkar], 935 F.2d [1555,] 1563, 19

USPQ2d [1111,] 1116 [(Fed. Cir. 1991)]; Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (descriptive matter may be inherently present in a specification if one skilled in the art would necessarily recognize such a disclosure).

See also Tronzo v. Biomet, Inc., 156 F.3d 1154, 1159, 47 USPQ2d 1829, 1834 (Fed. Cir. 1998) ("In order for a disclosure to be inherent . . . the missing descriptive matter must necessarily be present in the . . . application's specification such that one skilled in the art would recognize such a disclosure."). It is therefore necessary to distinguish between inherency, which can be relied on to establish written description support, and obviousness, which cannot. Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966.

Reissue claims are given their broadest reasonable interpretation. In re Reuter, 651 F.2d 751, 756, 210 USPQ 249, 253 (CCPA 1981). Where, as here, application claims have been copied from a patent for the purpose of provoking an interference, the application claims must be construed in light of the originating patent disclosure for purposes of making an ex parte determination of whether the claims have written description support in the copier's application. See In re Spina, 975 F.2d 854, 856, 858, 24 USPQ2d 1142, 1144-45 (Fed. Cir. 1992); accord, Rowe v. Dror, 112 F.3d 473, 479 n.2, 42 USPQ2d 1550, 1554 n.2 (Fed. Cir. 1997). Consequently, the claims will be given their broadest reasonable interpretation consistent with the disclosure of the Doyle patent, which has a filing date of October 17, 1994.

The question of whether appellant's '701 patent provides written description support for the claims thus construed is to be judged as of the September 4, 1996, filing date of Application 08/707,684, which issued as the '701 patent.³⁶

1. The "network" limitations

There is no dispute regarding the meanings of the terms "network" and "network server," which are not defined in the Doyle specification but are defined as follows in Microsoft Press Computer Dictionary 327, 329, 430 (3d ed. 1997):³⁷

network . . . n. A group of computers and associated devices that are connected together by communications facilities. . . .

network server . . . n. See server.

server . . . n. 1. On a local area network (LAN), a computer running administrative software that controls access to the network and its resources, such as printers and disk drives, and provides resources to computers functioning as workstations on the network. 2. On the Internet or other network, a computer or program that responds to commands from a client. . . .

The examiner's position is that (a) one skilled in the art would have understood appellants' patent to be disclosing "an improvement over [a] prior art compound document, in a single workstation environment; as set forth in [the] Background of the Invention. See the '701 [patent], col. 1, line 22 - col. 2, line 43," Final Action at 9, and (b) that "no teaching explicitly or

³⁶ Inasmuch as appellants are not trying to antedate a reference, it is not necessary to consider whether the claims thus construed have descriptive support in the parent or grandparent application.

³⁷ Copies of these definitions were enclosed with the April 26, 2001, Office action (Paper No. 18).

implicitly related to network environment, distributed hypermedia, hyperlink, network server, network browser,[or] browser application can be found in the '701 disclosure or drawings that may lead one of skill[] in the art to the networking aspect of the disclosed in-place activation of [a] containee object." Id. We do not agree that the '701 patent specifically discloses a single-workstation environment; the patent does not explain whether the disclosed software is to be run on (1) a stand-alone computer, (2) a computer which is part of a computer network, or (3) both types of computers.

On the other hand, we also do not agree with appellants that one skilled in the art would have understood from the '701 patent's discussion of object linking and embedding in a windowing environment that the disclosed invention is intended for use in a network environment. Specifically, appellants argue that

the specification describes a computing or "window environment" for object linking and embedding (OLE) that was known to function in both network and stand-alone environments. Keeping in mind the specification's reliance o[n] the "parlance" of object oriented programming (Col. 7, lines 38-50), one of ordinary skill in the art would view the general references to a "window environment" in the specification to encompass both local and network environments. For example, the specification speaks in terms of a "windowing operating system environment (Col. 13, lines 63-65), an "object-oriented environment" (Col. 42, lines 26-27), "the Microsoft Windows 3.1 environment" (Col. 52, lines 57-59), and "a container window environment " (Abstract, lines 1-3). There is not a reference to a "stand-alone" environment.

Brief at 37. As evidence that persons skilled in the art recognized that OLE can be used for linking files over a network, appellants quote the following passages from Paul Klemond, Taking the Bull by the Horns: Investigating Object Linking and Embedding, Part I, 7 Microsoft Systems Journal 19, 21 (Mar./Apr. 1992) (Attachment I to the brief) (appellants' emphasis):

- ***"Linking is particularly valuable when the linked-to document is shared on a network file server."***
- "OLE's linked objects work with LAN-stored files transparently and seamlessly. This is ***because files on network drives are indistinguishable from files stored on local disk drives to the operating system.***"
- "In the linked object scenario described above, you created a linked object in the word processor document using schedule data from a spreadsheet. This is ***particularly powerful when the spreadsheet is stored on a file server*** and accessible to everyone across the network working on the project."

Appellants also quote the following passage from page 169 of Chapter 9 of the Windows

Interface document as evidence of the knowledge of persons skilled in the art:

When the user links information from a source document into a container document, the information appears inside the container as if it had been physically copied there. . . . Links provide an effective way for documents on a local drive or documents distributed over machines on a network to share information.

Brief at 38.

While we agree with appellants that the foregoing evidence "supports the conclusion that one of ordinary skill in the art appreciated that OLE functioned in both network and stand-alone environments," *id.* at 39, that showing, as noted by the examiner, is sufficient to establish only the obviousness of using the disclosed software in a network environment; it fails to demonstrate that a person skilled in the art would have understood appellants' patent to be inherently (i.e., necessarily) disclosing the use of a network computer to run that software, as required to show written description support for the "network" limitations. *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966. This conclusion is not altered by the fact that object linking and embedding

is disclosed in the context of a windowing environment, which has not been shown to necessarily imply the presence of a network environment.

The examiner is therefore correct to conclude that appellants' patent fails to provide express or inherent support for the following "network" limitations in claim 40:

- (a) "a network computer environment" and "said network environment";
- (b) "one network server"; and
- (c) "document received over said network from said server."

For the same reasons, the '701 patent fails to disclose a "distributed hypermedia document" (claim 40) (emphasis added), which is a hypermedia document having embedded data objects located on different computers in a network. See Doyle patent, column 5, lines 24-34 ("The Internet . . . is a 'distributed' system because data objects that are imbedded within a document may be located on many of the computer systems connected to the Internet.").³⁸

2. "at least one client workstation"

The phrase "at least one client workstation" appears in claims 40 and 50. The term "client workstation" is not defined in the Doyle specification. Appellants contend it is broad enough to read on a stand-alone computer; the examiner construes it to mean a network computer. See Final Action at 7 "(The limitation 'client workstation' [is] defined as a computer

³⁸ The examiner appears to agree with appellants' view that their disclosed compound document is a hypermedia document. We disagree for the reasons given infra in the new ground of rejection.

that access[es] shared network resources provided by another computer (Microsoft Press))."

Appellants' response to the examiner's position as follows:

There is no further identification of the authority, and the third [sic, second] edition of the Computer Dictionary by Microsoft Press (1994) does not have definitions of the phrase "client workstation." However, the dictionary does have definitions for the terms "client" and "workstation," neither of which require a network connection. A copy of the pages from the dictionary including the definitions is attached under Tab H.

Brief at 40. Those definitions read as follows:

client In object-oriented programming, a member of a class (group) that uses the services of another class to which it is not related. In computing, a client is a process (roughly, program or task) that requests a service provided by another program---for example, a word processor that calls on a sort routine built into another program. The client process uses the requested service without having to "know" any working details about the other program or the service itself. Compare child, descendant; see also inheritance.

On a shared local area network, a computer that accesses shared network resources provided by another computer (called a server). See also client/server architecture, server.

workstation In general, a combination of input, output, and computing hardware that can be used for work by an individual. More often, however, the term refers to a powerful stand-alone computer of the sort used in computer-aided design and other applications requiring a high-end, usually expensive, machine (\$10,000 and up) with considerable calculating or graphics capability. Increasingly, workstation is also used to refer to a microcomputer or terminal connected to a network.

While these definitions considered separately do not define "client" or "workstation" as necessarily referring to a network device, the term "client workstation" construed in light of both definitions clearly does. The only paragraph of the "client" definition which is applicable to a hardware device, such as a workstation, is the second, which explains that a client computer is a network computer. Likewise, the modification of the term "workstation" by "client" makes it

clear that the last definition of "workstation," which refers to a network microcomputer or terminal, is the only appropriate one. This interpretation is consistent with the Doyle patent, which explains: "Typically, a computer on the Internet is characterized as either a 'client' or 'server' depending on the role that the computer is playing with respect to requesting information or providing information. Client computers are computers that typically request information from a server computer which provides the information." Doyle, col. 4, ll. 32-37. In contrast, all of the uses of "client" in appellants' patent are consistent with the first paragraph of definitions of that term, which apply to computer processes. See, e.g., column 8, line 7 ("client window 304"), column 8, line 28 ("client window 404"), column 8, lines 50-51 ("a container (or client) application"), column 50, lines 27-29 ("each containee object in a container is associated with a client site in the container object"), and column 32, lines 42-43 ("the function invokes the SetClientSite method of the containee object").

We therefore agree with the examiner that the term "client workstation" in claims 40 and 50 refers to a network workstation and thus lacks written description support in appellants' patent for the reasons given in the discussion of the "network" limitations.

Attachment C to the brief is a proposed amendment filed pursuant to 37 CFR § 1.196(c)³⁹ to (1) amend claim 50 by replacing "client workstation" with "computer" and (2) add new

³⁹ Section 1.196(c), which was replaced effective September 13, 2004, by 37 CFR § 41.50(c), read as follows:

(c) Should the decision of the Board of Patent Appeals and Interferences include an explicit statement that a claim may be allowed in amended form, appellant shall have the right to amend in conformity with such statement which
(Continued on next page.)

dependent claims 51-57 in the event we conclude that "client workstation" refers to a network workstation and lacks written description support. Brief at 41. We are declining appellants' invitation to make such a recommendation.

3. A "computer environment"

The examiner and appellants appear to agree that the term "computer environment" in claim 50 is broad enough to encompass a network computer or a stand-alone computer. The examiner, citing The Gentry Gallery, Inc. v. The Berkline Corp., 134 F.3d 1473, 1479-80, 45 USPQ2d 1498, 1503 (Fed. Cir. 1998), contends that the '701 patent fails to provide written description support for this broad term because it discloses only a stand-alone computer. Final Action at 7-8; Answer at 10-11. This argument is unconvincing for several reasons. First, as explained above, the examiner has correctly construed the term "client workstation" in claim 50 as limited to a network computer. Second, the examiner's reliance on Gentry Gallery is misplaced even assuming "client workstation" is broad enough to encompass stand-alone and network workstations. As correctly noted by appellants (Brief at 40), Johnson Worldwide

shall be binding on the examiner in the absence of new references or grounds of rejection.

The replacement provision, § 41.50(c), reads as follows:

(c) The opinion of the Board may include an explicit statement of how a claim on appeal may be amended to overcome a specific rejection. When the opinion of the Board includes such a statement, appellant has the right to amend in conformity therewith. An amendment in conformity with such statement will overcome the specific rejection. An examiner may reject a claim so-amended, provided that the rejection constitutes a new ground of rejection.

Assoc., Inc. v. Zebco Corp., 175 F.3d 985, 993, 50 USPQ2d 1607, 1613 (Fed. Cir. 1999), explains that Gentry Gallery concerns "the situation where the patent's disclosure makes crystal clear that a particular (i.e., narrow) understanding of a claim term is an 'essential element of [the inventor's] invention.' [134 F.3d at 1479,] 45 USPQ2d at 1503." No such clear language appears in appellants' patent. The examiner has therefore failed to satisfy his burden of demonstrating a lack of written description support for the "computer environment" limitation in claim 50, whether or not the Chapter 9 material is considered to be new matter.

4. A "browser application"

Claim 40 recites a "browser application" that (a) "parses a first distributed hypermedia document to identify text formats included in said distributed hypermedia document"; and (b) "respond[s] to predetermined text formats to initiate processing specified by said text formats." Claim 50 includes similar language but omits the network term "distributed." Appellants, without an apparent challenge by the examiner, read the term "hypermedia document" from claim 50 onto their compound document.⁴⁰

The Doyle patent gives several examples of "browser" programs (col. 3, lines 15) without offering a definition of a "browser" program or application. Appellants argue that "[i]n 1994 a 'browser' was simply anything functioning to browse through files or databases, and the applications described in the specification [e.g., Word] certainly do that." Brief at 28. In support, appellants note that the 1994 edition of the Microsoft Press Computer Dictionary fails to

⁴⁰ We disagree with this position for the reasons given below in the new ground of (Continued on next page.)

include the term "browser" and defines "browse" as follows: "To scan a database or a list of files, either for a particular item or for anything that seems to be of interest; generally, an activity that implies observing, rather than changing, information." Brief at 28. According to appellants,

[e]ven assuming The Windows Interface document is not part of the specification, it is still evidenced in the record that Word was known to have a browsing function and, therefore, understood in 1994 to be a "browser." In this regard, Figs. 3, 4 and 11 depict Word as the application supporting a compound document.

Brief at 29.

The examiner, on the other hand, construes "browser application" to be "a client application that enables the user to view HTML document[s] on the WWW [World Wide Web] or another network (Microsoft Press)" and correctly notes that no such application is disclosed in the '701 patent. Final Action at 7; Answer at 10. A copy of the definition on which he relies has not been provided by the examiner. We assume the examiner is relying on the third (i.e., 1997) edition of the Microsoft Press Computer Dictionary, which at page 64 defines "browser" as "See Web browser" and at page 505 defines "web browser" as follows:

Web browser . . . n. A client application that enables a user to view HTML documents on the World Wide Web, another network, or the user's computer; follow the hyperlinks among them; and transfer files. Text-based Web browsers, such as Lynx, can serve users with shell accounts but show only the text elements of an HTML document; most web browsers, however, require a connection that can handle IP packets but will also display graphics that are in the document, play audio and video files, and execute small programs, such as Java applets or ActiveX controls, that can be embedded in HTML documents. Some Web browsers require helper applications or plug-ins to accomplish one or

rejection.

more of these tasks. In addition, most current Web browsers permit users to send and receive e-mail and to read and respond to newsgroups. Also called browser. See also ActiveX controls, helper application, hyperlink, Internet Explorer, Java applet, Lynx, Mosaic, Netscape Navigator, plug-in.

Microsoft Press Computer Dictionary 64, 505 (3d ed. 1997) (copy enclosed). Inasmuch as these definitions were published two years after Doyle's October 1994 filing date, they fail to show how the terms "browser" and "browser application" as used in Doyle would have been construed at that time. We are therefore reversing the rejection to the extent it is based on the term "browser application."

4. An "embed text format"

Claim 50 specifies that "said first hypermedia document includes an embed text format, located at a first location in said first hypermedia document, that specifies the location of at least a portion of an object external to the first hypermedia document." Claim 40 describes the "distributed hypermedia document" in similar terms.

As the term "embed text format" is not defined in Doyle⁴¹ and has not been shown to have a special meaning in the art, we are construing it as broad enough to read on any embedded information which performs the recited function of specifying the location of at least a portion of an object external to the document.

Appellants (Brief at 32) would have us read the embed text format on the handle 604 in the data structure 601 (Figure 6), which presumably is embedded in the compound document.

⁴¹ In the Doyle patent, this term appears to refer to the "embedded program link 214" in hypermedia document 212 in Figure 5 (col. 9, ll. 30-39).

The data structure 601 contains "a class identifier 603, handle 604 to the storage for the object, and data 605 for tracking the state of the object." '701 patent, col. 9, l. 58 to col. 10, l. 3. The examiner responds to appellants' position as follows:

A careful review of the specification fails to reveal any teaching related to the claimed limitation "*an embedded [sic] text format*". The data structure 601 of pointers, class ID, and handles is certainly not an embedded *text format* as argued by the appellants. More certainly, [it] is not an "*embedded text format*" which [is] "*located at a first location in said first distributed hypermedia document,*" and which "*specifies the location of at least a portion of an object external to the first distributed hypermedia document*" embodied in a "*network environment*" of claim 40 or similar recitation in claim 50 ([illegible] client workstation coupled to a computer environment, the client workstation executes [illegible] browser application that parses a hypermedia document to identify text format, etc...).

Answer at 17. The examiner's position is not persuasive. His assertion that "[t]he data structure 601 of pointers, class ID, and handles is certainly not an embedded text format as argued by the appellants" (emphasis omitted) is not supported by any definition of "embed text format" which would preclude appellants' reliance on handle 604. The mere fact that the '701 patent does not employ the term "embed text format" is insufficient to establish a lack of descriptive support. See Cordis, 339 F.3d at 1364, 67 USPQ2d at 1885 ("The disclosure as originally filed does not, however, have to provide in haec verba support for the claimed subject matter at issue.") (citing Fujikawa v. Wattanasin, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996)). The remainder of the examiner's response appears to be based on the "distributed hypermedia document," "computer environment," and "client workstation" limitations discussed above rather than specifically on an interpretation of the "embed text format" limitation. The examiner therefore has not established that handle 604 fails to provide descriptive support for the recited

"embed text format" independently of whether the "network," "client workstation," and "distributed hypermedia" limitations have descriptive support, which they do not.

5. Other limitations

Appellants also explain why they believe the '701 patent provides written description support the remaining claim limitations, including "type information," "parses . . . to identify text formats," "responding to predetermined text formats to initiate processing specified by said text formats," "automatically invoc[ing] said executable application to execute on said client workstation in order to display said object executable application," and "enabling interactive processing of said object." Brief at 28-31, 33-36. The examiner has not adequately explained why these particular limitations lack descriptive support independently of whether the "network," "client workstation," and "distributed hypermedia" limitations have descriptive support.

6. Conclusion

Because we agree with the examiner that the '701 patent fails to provide written description support for the "network," "client workstation," "and "distributed hypermedia" limitations, the rejection for lack of written description support is affirmed with respect to independent claims 40 and 50 and also with respect to claims 41-49, which are not separately argued. 37 CFR § 41.37(c)(vii).

H. The 35 U.S.C. § 112, first paragraph, rejection for non-enablement

A specification is enabling if it teaches those skilled in the art how to make and use the full scope of the claimed invention without "undue experimentation." In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). The initial burden on the issue of enablement rests on the examiner:

When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application If the PTO meets this burden, the burden then shifts to the applicant to provide suitable proofs indicating that the specification is indeed enabling. [In re Marzocchi, 439 F.2d [220,] 223-24, 169 USPQ [367,] 369-70 [(CCPA 1971)].

Wright, 999 F.2d at 1561-62, 27 USPQ2d at 1513. The examiner explained the rationale for the rejection as follows:

The applicants did not even disclose or suggest, explicitly or implicitly, any teaching related to [a] network environment, or distributed hypermedia, hyperlink, network server, or network browser for parsing of format text in a distributed hypermedia document. Thus even if one of skill in the art is fully aware of [nearly illegible, networking?] aspect and functionality of OLE as argued by the applicants, [the] lack[] of any teaching or suggestion related to network environment does not warrant the appellants' allegation of possession of the invention as claimed, and it would not enable one of ordinary skill in the art to make and use the applicants' teaching of in-place interaction with containee objects in network environment as recited in claims 40-50 without an undue experimentation.

Answer at 19. This statement of the basis for the rejection fails to satisfy the examiner's initial burden of proof because it merely repeats the basis for the written description rejection. It does not necessarily follow from the fact that appellants' patent fails to disclose a computer network, a network server, a network browser application, or distributed hypermedia document (all features

known in the art) that a person skilled in the art, using the claims as a guide⁴² and having knowledge of such features, would have required undue experimentation to make and use the claimed subject matter. If the examiner is of the opinion that undue experimentation would have been required to implement a particular feature recited in the claims, e.g., using the browser to parse a hypermedia document for an embed text format, the rejection should specifically identify the feature and explain why undue experimentation would have been required.

The rejection of claims 40-50 under the enablement requirement of 35 U.S.C. § 112, first paragraph is therefore reversed as to all claims.

I. The objections

In view of our affirmance of the rejection of claims 40-50 under 35 U.S.C. § 112, first paragraph for lack of written description support, we are also affirming the new matter objection under 35 U.S.C. § 251 to extent it is directed to (a) all of the text and drawings from Chapter 9 of the Windows Interface document and (b) all of the text and drawings from Chapter 5 of the Windows Interface document except for the material which relates to the order of interleaving of menu groups. We also affirm the objection to the specification under 37 CFR § 1.75(d)(1) to the extent it is directed to the "network," "client workstation," and "distributed hypermedia" limitations recited in claims 40-50.

⁴² For the purpose of evaluating a rejection for lack of enablement, the rejected claims are presumed to have written description support.

J. New ground of rejection

Pursuant to our authority under 37 CFR § 41.50(b), we are entering a new ground of rejection of claims 40-50 under 35 U.S.C. § 112, first paragraph, for failing to provide written description support for the terms "hypermedia environment" and "hypermedia document," which appear in independent claims 40, 45, and 50

"Hypermedia" documents when used in an interactive format permit a user to selectively activate links in the document in order to retrieve and display the corresponding linked objects:

hypermedia The integration of graphics, sound, video, or any combination into a primarily associative system of information storage and retrieval. Hypermedia, especially in an interactive format where choices are controlled by the user, is structured around the idea of offering a working and learning environment that parallels human thinking—that is, an environment that allows the user to make associations between topics rather than move sequentially from one to the next, as in an alphabetic list. Hypermedia topics are thus linked in a manner that allows the user to jump from subject to related subject in searching for information. For example, a hypermedia presentation on navigation might include links to such topics as astronomy, bird migration, geography, satellites, and radar. If the information is primarily in text form, the product is hypertext; if video, music, animation, or other elements are included, the product is hypermedia. See also hypertext.

Microsoft Press Computer Dictionary 202 (2d ed. 1994) (emphasis added) (Attachment G to brief). Doyle specifically restricts the terms "hypertext document" and "hypermedia document" to interactive environments:

A hypertext document is a document that allows a user to view a text document displayed on a display device connected to the user's computer and to access, retrieve and view other data objects that are linked to hypertext words or phrases in the hypertext document. In a hypertext document, the user may "click on," or select, certain words or phrases in the text that specify a link to other documents, or data objects. In this way, the user is able to navigate easily among

data objects. The data objects may be local to the user's computer system or remotely located over a network. . . .

. . . When graphics, sound, video or other media capable of being manipulated and presented in a computer system is used as the object linked to, the document is said to be a hypermedia document. A hypermedia document is similar to a hypertext document, except that the user is able to click on images, sound icons, video icons, etc., that link to other objects of various media types, such as additional graphics, sound, video, text, or hypermedia or hypertext documents.

Id. at col. 1, l. 61 to col. 2, l. 2 and col. 2, ll. 17-27 (emphasis added). Doyle's Figure 1, reproduced below, shows an example of a hypermedia document 10 containing an image icon 22, a sound icon 24, and hypertext 20 and 26 (designated by underlining), any of which links can be clicked on by the user (i.e., reader) to cause retrieval and display of the linked information.

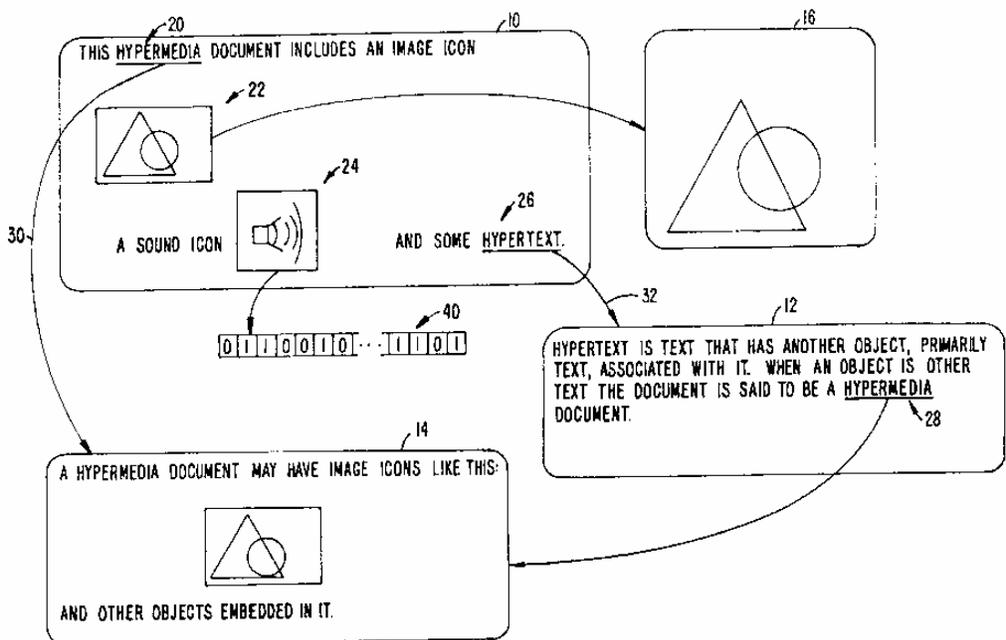


FIG. 1. PRIOR ART

Doyle reads the term "browser software" on the software that permits the user to selectively retrieve and display the linked objects in the hypermedia document:

When the user clicks on image icon 22 browser software executing on the user's computer system retrieves the corresponding full image, e.g., a bit map, and displays it by using external software called a "viewer." This results in the full image, represented by image 16, being displayed on the screen.

Doyle patent, col. 3, ll. 3-8.⁴³

The '701 patent fails to disclose a hypermedia environment or a hypermedia document.

Appellants argue that the compound document depicted in their Figures 3 and 4 is a "hypermedia" document because

the API described in the present specification supports an environment in which documents created by an application program (e.g., Word) link to and display data objects (e.g., Excel data) existing outside of the documents and created by different application programs (e.g., Excel). The linked objects may be text or graphical objects such as spreadsheets (e.g., an Excel spreadsheet in Figs[.]3 and 4).

Brief at 27. The fact that appellants' compound document includes text and links to Excel graphics is insufficient in and of itself to satisfy the above definition of a "hypermedia document." Appellants' compound document does not include hypertext or icons or any other indicia which can be selectively activated (e.g., clicked on) by the user to cause retrieval and display of the corresponding linked objects, as required by the definition. In appellants' compound document, each embedded or linked object (e.g., the Excel spreadsheet object) is

⁴³ However, Doyle does not offer a definition of "browser software" or "browser application," let alone clearly define either term as being restricted to use with hypermedia documents.

automatically retrieved (if linked) and automatically displayed as part of the compound document (see Fig. 3) when the document is opened by Word.

The '701 patent therefore fails to provide § 112, first paragraph, written description support for the terms "hypermedia environment" and "hypermedia document" in independent claims 40, 45, and 50. Those claims are therefore rejected on that ground, as are dependent claims 41-44 and 46-49.

L. Summary

The examiner's rejection of claims 40-50 under the written description requirement of 35 U.S.C. § 112, first paragraph, is affirmed, as are (a) the objection to the specification under 37 CFR § 1.75(d)(1) and (b) the objection to the proposed new drawing figures and to the specification to the extent it has been amended to include text (other than the menu group interleaving guidelines) from Chapters 5 and 9 of the Windows Interface document as constituting new matter under 35 U.S.C. § 251.

The rejection of claims 40-50 under the enablement requirement of § 112, first paragraph, is reversed.

We have entered a new ground of rejection of claims 40-50 under the written description requirement of 35 U.S.C. § 112, first paragraph.

M. Appellants' options in light of the new ground of rejection

37 CFR § 41.50(b) explains:

(b) . . . A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board makes a new ground of rejection, the appellant, within **two months** from the date of the

decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

(Emphasis of "two months" added.)

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR §§ 41.50(f) and 41.52(b).

AFFIRMED; 37 CFR § 41.50(b)

JOHN C. MARTIN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
ADRIENE LEPIANE HANLON)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
ROMULO H. DELMENDO)	
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JCM/jcm

Appeal No. 2005-1431
Application 09/442,070

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Enclosures:

- (a) MPEP 608.01(p) at 600-62 to 600-64 (6th ed., rev. 2, July 1996).
- (b) Microsoft Press Computer Dictionary 64, 505 (3d ed. 1997).