

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte ALESSANDRO MUTI, BRIAN J. MOORE, ANTHONY ANDREAS CICCONE  
and DARSHATKUMAR A. SHAH

---

Appeal No. 2006-2065  
Application No. 09/761,399

---

ON BRIEF

---

Before KRASS, RUGGIERO and SAADAT, Administrative Patent Judges.  
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-27.

The invention pertains to processing information transfer requests (ITRs) transmitted via incompatible data communication systems. The invention reformats an incompatible ITR in order that the ITR may successfully traverse the data communications systems and generate a desired response.

Representative independent claim 13 is reproduced as follows:

13. A data packet adapted to be transmitted from a first computer process to a second computer process, comprising:

information related to an information transfer request (ITR) formatted in one or more first protocols so that the ITR contains formatting information sufficient to translate the ITR into a second protocol.

The examiner relies on the following reference:

Dukach et al. (Dukach) 6,609,159 Aug. 19, 2003  
(filed Nov. 30, 1998)

Claims 1-10 and 13-27 stand rejected under 35 U.S.C. §102 (e) as anticipated by Dukach.

Claims 11 and 12 stand rejected under 35 U.S.C. §103 as unpatentable over Dukach.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

### OPINION

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

The examiner points to column 4, lines 28-52, column 14, lines 37-46, column 20, line 64 through column 21, line 3, and column 21, lines 40-55 of Dukach as evidence of anticipation of most of the independent claims.

Independent claim 1 calls for a system for processing an ITR. There must be an identification as to whether an ITR formatted in a second format produced a desired response and an altering of that ITR to an ITR formatted in another format so that the desired response may be produced.

Appellants argue that Dukach does not describe any identifying component for identifying whether an ITR formatted in a second format produced a desired result because Dukach is not evaluating the responses to ITRs, nor is Dukach identifying whether an ITR in one format produces a desired result and, if not, altering the ITR to another format to produce that desired response. Appellants point out that Dukach is merely performing a conversion from one format to another, disparate, format.

We agree with appellants.

We have reviewed the applied reference, especially the portions cited by the examiner, and find that although Dukach pertains to conversion between protocols, it offers no guidance whatsoever with regard to evaluating whether ITRs formatted in a particular format produce a desired result.

Accordingly, since Dukach fails to describe at least one element of independent claim 1, we will not sustain the rejection of claim 1, or of claims 2-6, dependent thereon, under 35 U.S.C. §102 (e).

Independent claim 13 recites a data packet comprising an ITR where the ITR itself contains formatting information sufficient to translate the ITR into a second protocol, from the first protocol in which it is formatted.

Dukach certainly converts from one format into another in communication between a front end server and a back end server using a first protocol and in communication between the front end server and a client using a second protocol, and performing conversions between protocols when relaying communications the back end and clients (see column 4, lines 28-35).

Appeal No. 2006-2065  
Application No. 09/761,399

The examiner argues that protocol information in the request header (pointing to column 22, lines 5-28 of Dukach) is interpreted to be the sufficient information needed to translate into the second format (see page 12 of the answer). The examiner's rationale appears to be reasonable and, in view of the broad nature of the claimed subject matter and no response from appellants in the reply brief to the examiner's reasoning, we tend to agree with the examiner's interpretation.

Therefore, we will sustain the rejection of claim 13 under 35 U.S.C. §102 (e).

For similar reasons, we will also sustain the rejection of claim 14 under 35 U.S.C. §102 (e).

We will not sustain the rejection of claims 15-23 under 35 U.S.C. §102 (e) because independent claim 15 requires "evaluating a response to the first ITR." For the reasons supra, with regard to independent claim 1, we find nothing in Dukach regarding evaluating any response to an ITR.

Independent claims 7 and 24 recite a system and method for processing an ITR, that method comprising the steps of recognizing an ITR reformatted in a first format, with the first format being an earlier formatting version than the original formatting version of the ITR; and then processing the reformatted ITR to produce a desired result.

The examiner points to column 22, lines 5-28, of Dukach and explains that the front end server of Dukach determines the format of the client request by checking the request header. The examiner further explains that in one embodiment Dukach teaches the determination of the request to be in HTTP 1.1 or HTTP 1.0 format and then translates the request's HTTP/1.1 header into the proper format for a

Appeal No. 2006-2065  
Application No. 09/761,399

corresponding HTTP 1.0 or HTTP 1.1 header. Since column 2, lines 12-20, of Dukach explicitly discloses that the HTTP 1.1 is a newer protocol version of HTTP 1.0, the examiner concludes that Dukach teaches “one or more first formats being earlier versions than an original formatting version of the ITR” (see page 11 of the answer). The examiner explains that the front end server in Dukach is interpreted to be the claimed component for “recognizing” that identifies the format of the request. Therefore, the examiner concludes that Dukach teaches “recognizing an ITR reformatted in one or more first formats, the one or more first formats being earlier formatting versions than an original formatting version of the ITR.”

Appellants argue that Dukach does not disclose that a component can recognize that an ITR is a modified ITR. Appellants recognize that the examiner states that the front end server of Dukach determines whether a request is in HTTP 1.1 or HTTP 1.0 formats, but appellants assert that “the request as received by the front end server is not a reformatted ITR, but rather is an original ITR” (reply brief-page 3).

We will not sustain the rejection of claims 7 and 24, and, hence, claims 8-10 and 25-27, under 35 U.S.C. §102 (e).

As we read the claim language, “recognizing an ITR reformatted in one or more first formats...,” such language requires a recognition not only of an ITR, but also a recognition that such ITR has been reformatted from a previous, original, format. This is in accordance with the disclosure in Figure 6 and page 11 of the instant specification.

Appeal No. 2006-2065  
Application No. 09/761,399

The examiner interprets the front end server of Dukach as being the claimed component for “recognizing” that identifies the format of the request. While that interpretation is not unreasonable, in our view, the front end server merely recognizes the format of the ITR. It does not recognize, as claimed, that that ITR has been “reformatted” in any way. Accordingly, we find that the examiner has not set forth a *prima facie* case of anticipation.

With regard to claims 11 and 12, we will not sustain the rejection of these claims under 35 U.S.C. §103 since Dukach does not describe the recognition of an ITR having been reformatted, as required by independent claim 7 and we find no reason to conclude that it would have been obvious to do so.

We have sustained the rejection of claims 13 and 14 under 35 U.S.C. §102 (e) but we have not sustained the rejection of claims 1-10, and 15-27 under 35 U.S.C. §102(e) and we have not sustained the rejection of claims 11 and 12 under 35 U.S.C. §103.

Accordingly, the examiner’s decision is affirmed-in-part.

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

Appeal No. 2006-2065  
Application No. 09/761,399

AFFIRMED-IN-PART

ERROL A. KRASS )  
Administrative Patent Judge )  
 )

Appeal No. 2006-2065  
Application No. 09/761,399

JOSEPH F. RUGGIERO  
Administrative Patent Judge

MAHSHID D. SAADAT  
Administrative Patent Judge

)  
)  
) BOARD OF PATENT  
) APPEALS  
) AND  
) INTERFERENCES  
)  
)  
)  
)

EK/gw

AMIN & TUROCY, LLP  
24<sup>TH</sup> FLOOR, NATIONAL CITY CENTER  
1900 EAST NINTH STREET  
CLEVELAND, OH 44114