

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 CHENHUEI J. CHIANG,
SHYH-MEI F. HO, JENNY CHENGYIN HUNG,
and BENJAMIN JOHNSON SHEATS

Appeal 2006-3356
Application 10/244,722
Technology Center 2100

Decided: March 12, 2007

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and
JAY P. LUCAS, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-9 and 13-36, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The claims are directed to translating computer client request formats.
Claim 29 is illustrative:

29. A computer-implemented method for accessing MFS-based IMS applications, comprising the acts of:

receiving a client request from a client program via an MFS XML adapter; and

returning a response to the client program via the MFS XML adapter at least in part by using a MFS message output descriptor to translate information from a MFS IMS component to XML.

The Examiner relies on the following prior art references to show unpatentability:

Kuno	US 2003/0120730 A1	June 26, 2003
Najmi	US 6,753,889 B1	June 22, 2004

Microsoft Press, "Computer Dictionary," Third Edition, p. 371, 1997.

The rejections as presented by the Examiner are as follows:

1. Claims 1-6, 13-16, and 29-33 are rejected under 35 U.S.C. § 102(b) as being anticipated by Najmi.
2. Claims 7, 8, 17, 18, 20-27, 34, and 35 are rejected under 35 U.S.C § 103(a) as unpatentable over Najmi.
3. Claims 9, 19, 28, and 36 are rejected under 35 U.S.C § 103(a) as unpatentable over Najmi and Kuno.

OPINION

Najmi describes a business to business (B2B) message adapter generation tool for use in describing a B2B message adapter in an enterprise computer system. In one embodiment, the enterprise computer system is a J2EE (JAVA 2 Enterprise Edition) based enterprise computer system. The B2B messenger is coupled to a JAVA Message Service API that provides an interface between the B2B messenger and the various business components included in the J2EE based enterprise computer system. The B2B messenger subscribes to a JAVA Messenger Service (JMS) topic. A subscription manager receives a JMS message and directs a message adapter to modify the JMS message into a format consistent with a receiving partner based upon the corresponding subscription rule and a corresponding document template (B2B schema). The message adapter is provided by the B2B message adapter generation tool that takes as its input two classes, a sender message format and a receiver message format that are heuristically analyzed to form a correspondence mapping between the two formats.

Najmi col. 3, l. 49 - col. 4, l. 27.

Najmi depicts, in Figure 1, a Business to Business to Customer system 100. The system includes a J2EE based computer system (e-business) 102 for communication with associated partners regardless of their respective transport protocols or document schemas. The reference notes, however, that respective systems can be in any technology other than J2EE. Najmi col. 4, l. 58 - col. 5, l. 5; col. 12, ll. 22-30. Figure 2 (col. 6, l. 3 - col. 7, l. 8) depicts an Enterprise JAVA Bean (EJB) implementation of e-business 102,

which may use Web technology that includes HTML or XML elements and Web browsers.

A principal issue in this case is whether Najmi describes, as recited in representative claim 29, an MFS XML adapter and an MFS message output descriptor within the meaning of the claims.

According to Appellants' specification, MFS is a facility of the IMS (information management system) transaction management environment that formats messages to and from many types of terminal devices -- i.e., message format service-based information system applications, or MFS-based IMS applications. (Specification 1:14-17.) The Examiner finds that Najmi's system provides the same functionality of the MFS adapter as claimed. The Examiner further finds that Najmi's B2B schema provides the same functionality as the MFS output descriptor that is claimed. (Answer 4-5.) Appellants state that "[a]ll structural and functional equivalents to the elements of the above-described preferred embodiment that are known or later come to be known to those of ordinary skill in the art are expressly incorporated herein by reference and are intended to be encompassed by the present claims." (Specification 17:10-13.)

Appellants contend, and the Examiner does not dispute, that Najmi does not contain the literal language "MFS adapter" or "MFS message output descriptor." Appellants have not, however, persuasively explained why the systems described by Najmi are not functionally equivalent to the claimed "adapter" or "descriptor."

Claim 29 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Najmi. The claim recites receiving a client request from a

client program via an “MFS XML” adapter, and returning a response to the client program via the adapter at least in part using an MFS output descriptor to translate information from a MFS IMS component to XML. The claim requires translation of information between a legacy (“MFS”) application and a later (“XML”) application.

The Examiner might have rejected the claim under 35 U.S.C. § 103(a), in view of Najmi’s teachings regarding the need for automated electronic transactions for multiple partners having different formats and protocols (e.g., col. 1, ll. 46-65), its description of the B2B message adapter generation tool, and a prior art description of an MFS-based system. We presume that Appellants would have acknowledged that the artisan at the time of invention would consider the teachings of Najmi as applicable to a business partner that happens to have an MFS-based system. However, we can sustain the § 102 rejection that *has* been applied without departing from the principles of anticipation, on three separate bases.

First, as we have indicated, Appellants assert that the claims cover all structural and functional equivalents of the claimed adapter and output descriptor and have not persuasively rebutted the Examiner’s relevant findings.

Second, MFS-based IMS applications were known in the prior art, as evidenced in this record (e.g., Appellants’ background statement in the specification). The artisan would have appreciated that the message adapter described by Najmi is applicable to translating transactions between a legacy MFS-based system and a system that sends and receives information in XML format. Najmi places the artisan in possession of the invention as

broadly claimed. “A reference anticipates a claim if it discloses the claimed invention ‘such that a skilled artisan could take its teachings *in combination with his own knowledge of the particular art and be in possession of the invention.*’” *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) (quoting *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962)).

Third, the particular claimed formats (MFS, XML) do not change the underlying function of the machine receiving a request and returning a response. The data that are received and returned consist of what has come to be known as nonfunctional descriptive material, as described in Manual of Patent Examining Procedure (MPEP) § 2106.01 (8th Ed., Rev. 5, Aug. 2006). The content of the nonfunctional descriptive material carries no weight in the analysis of patentability over the prior art. *Cf. In re Lowry*, 32 F.3d 1579, 1583, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (“Lowry does not claim merely the information content of a memory.”). The process of claim 29 is anticipated by the process described by Najmi; the particular formats of the data processed have no function in the invention claimed.

Appellants further allege (Br. 6) that Najmi fails to describe translating a request to MFS XML at least in part using a MFS message input descriptor, as recited in instant claim 1. While the reference describes translating requests between different formats, Najmi does not use the literal term “MFS message input descriptor.” However, the correspondence mapping between two different formats is sufficient to meet the terms of “message input descriptor” (and “message output descriptor”). Further, as

we have noted, the literal term “MFS” does not represent a patentable distinction on this record.

Appellants submit (Br. 8) that Najmi fails to teach translating a client request to MFS using an external reference pointer to a MFS source file, as recited in claim 20. The claim recites translating the client request to MFS “using at least one external reference pointer to a MFS source file” Najmi describes (col. 8, ll. 13-30) a message adaptor 408 (Fig. 4) that reformats a received message to a form expected by a partner system, based upon information stored in a B2B schema database 410. Najmi thus teaches translating a client request using information in a database. The teaching is sufficient to demonstrate the obviousness of using an external reference pointer to a source file. We agree with Appellants to the extent that Najmi does not use the literal term “MFS” as an exemplary format, but the artisan would have appreciated that the method described by Najmi was not limited by the particular source and destination formats for translation.

With respect to claim 9, Appellants argue (Br. 9) that the Examiner’s finding of a motivation from the prior art for combining the teachings of Najmi and Kuno is without any supporting citation to the prior art. Najmi, however, teaches client requests comprising extensible mark-up language (XML) documents -- e.g., column 6, lines 14 through 16 and column 8, lines 32 through 45 -- which is sufficient to show unpatentability of the claim.

CONCLUSION

We have considered all of Appellants’ arguments but are not persuaded that any claim has been rejected in error. We sustain the rejection of claims

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1-6, 13-16, and 29-33 under 35 U.S.C. § 102(b) and the rejection of claims 7, 8, 9, 17, 18-28, and 34-36 under 35 U.S.C § 103(a).

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

AFFIRMED

KIS

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