

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM KRESS BODIN

Appeal 2007-0257
Application 10/047,123¹
Technology Center 2100

Decided: May 21, 2007

Before: KENNETH W. HAIRSTON, ALLEN R. MACDONALD, and
JAY P. LUCAS, *Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals from a final rejection of claims 1 to 50 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

¹ Application was filed January 15, 2002. The real party in interest is International Business Machines Corporation (“IBM”) of Armonk, New York.

Appellant's invention relates to a method, system, and computer program to manage a groupware session so that multiple permission fields in user and asset records are considered before granting the ability to edit a document (digital asset). In the words of the Appellant:

Typical embodiments of the invention include receiving from a first client device a first digital asset record representing a first digital asset, the first digital asset record comprising a first asset access permission field identifying a first asset access permission, and receiving from the first client device a second digital asset record representing the first digital asset, the second digital asset record comprising the first asset access permission field identifying a second asset access permission. Some embodiments typically include replacing, promptly after receiving the second digital asset record, the first digital asset record with the second digital asset record, whereby the asset access permission for the digital asset is changed in near real time from the first asset access permission to the second asset access permission.

Claim 1 is exemplary:

1. A method of ad hoc data sharing, the method comprising the steps of:
 - creating at least one user record representing a user granted access to digital assets, wherein:
 - each user has a client device,
 - at least two of the client devices are wirelessly coupled for data communications to at least one computer, and
 - each user record comprises a user access privilege field identifying for each user that user's access privilege for access to digital assets;
 - receiving from client devices digital asset records representing digital assets, each digital asset record comprising:
 - at least one asset access permission field identifying a digital asset's asset access permission, and
 - a location field identifying the location of a digital asset;
 - retrieving digital assets in dependence upon the location fields in the digital asset records;

displaying the retrieved digital assets; and editing one or more of the retrieved digital assets, wherein the editing is carried out in dependence upon user access privilege and in dependence upon asset access permission.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Butler	U.S. 6,584,493 B1	Jun. 24, 2003 (filed 9/14/99)
Skinner	U.S. 6,721,740 B1	Apr. 13, 2004 (filed 6/5/98)

Rejection I: Claims 9, 10, 21, 22, 33, 34, 45, and 46 stand rejected under 35 U.S.C. § 112 paragraph 2 for being indefinite, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Rejection II: Claims 1 - 50 stand rejected under 35 U.S.C. § 103(a) for being obvious over Butler in view of Skinner.

Appellant contends that the claimed subject matter is not indefinite, and the claims are not rendered obvious by Butler alone, or in combination with Skinner, for reasons to be discussed more fully below. Additionally the Appellant contends that the Butler reference and the Skinner reference are improperly combined.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in

this decision. Arguments which Appellant could have made but chose not to make in the Brief have not been considered and are deemed to be waived.

See 37 C.F.R. § 41.37(c)(1)(vii) (2004).²

We reverse the rejections.

ISSUE

The first issue is whether Appellant has shown that the Examiner erred in rejecting the claims 9, 10, 21, 22, 33, 34, 45, and 46 under 35 U.S.C. § 112, second paragraph. More specifically, the issue concerns whether the term “in near real time” renders the cited claims indefinite. The second issue turns on whether the references Butler and Skinner teach the limitations of claims 1 to 50, and if they do, whether there is a legally sufficient justification for combining the disclosures.

FINDINGS OF FACT

Rejection 1: Findings with respect to the rejection of claims 9, 10, 21, 22, 33, 34, 45, and 46 under 35 U.S.C. § 112 paragraph 2 for being indefinite, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Examiner contends that the wording “in near real time” in the claims mentioned above is indefinite. He further states that within a

² Appellant has not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

- computer, actions take place at a level unperceivable to a human being. (Answer 3.)
2. Appellant points out that the term “in near real time” is defined in the Specification, page 21, line 25-27, where it is said, “In this specification, the term “near real time” means that an event occurs promptly, or almost immediately, from the perspective of a human being.”
 3. Appellant further points out that “Newton’s Telecom Dictionary, 19th Edition, ... includes a definition of “near real time”, which states: “Near real-time Not quite in real-time, but nearly so.”” (Br. 11.)
 4. Appellant further mentions that he has identified 171 issued U.S. patents that use the terms “near real time”, “near real-time”, or “near realtime”. (Brief 11.) It is also noted that the term appears in the Skinner reference cited by the Examiner. (Skinner, col. 1, l. 52.).
 5. With the definitions in the specification and the dictionary, and on viewing some of the other patents using the “near real time” phrase, we find the meaning of the phrase discernable.

Rejection II: Findings with respect to the rejection of claims 1 - 50 under 35 U.S.C. § 103(a) for being obvious over Butler in view of Skinner.

6. Butler teaches a collaboration system for networked users, employing a more efficient “per-host” command, control, and communications structure to allow individual users to take control of the editing and display of the document upon which the users are collaborating.

- (Butler Abstract.) Skinner teaches the active updating of data objects of interest to the users over a network. (Skinner, col. 2, Summary.)
7. Appellant contends that the combination of Butler in view of Skinner does not teach or suggest all of applicant's claim limitations. (Br. 13.) As a first example, Appellant indicates that in Butler each user does not have a client device, as claimed. We note the contrary, as in Butler, as described in column 8, line 54 *ff*, each user uses a personal computer or similar device to communicate with the host computer over a network. This personal computer can be read on the claimed client device. See the definition of client device in the specification, page 11.
 8. Appellant next contends that Butler fails to teach "receiving from client devices digital asset records representing digital assets." Examiner does point to a specific recitation in Butler to satisfy the limitation of a digital asset (Answer 13 bottom.) However, the limitation of the digital asset records representing digital assets is not so clearly shown in the reference portions cited in the Answer or the Final Rejection. A careful reading of Butler indicates that being granted temporary control of the display and the editing by the host user can indeed be read on the general concept of permissions. However no teaching is found in Butler indicating the claimed digital asset record representing the digital asset.
 9. Appellant's claim requires a permission field in the digital asset record, and a permission field in the user record. (See Claim 1 above.) In the claim, the ability to edit is dependent on the contents of both

permission fields. Reviewing the recitations in columns 16, 17, and 18 of Skinner, as relied upon in the Examiner's Final Rejection, (page 4, paragraph 6) reveals teachings of records of the digital assets, including a discussion of a permissions model for determining access permissions for different clients and users. However, we find no teaching in either reference of the two permission fields in the user record and the digital asset record, both of which are required to determine the right to edit.

10. To further explain some of the reasons for the rejection, Examiner quotes the Microsoft Computer Dictionary to indicate that many of the claimed features are considered inherent in databases. (Answer 15 – 18). Although this tribunal agrees with much of the inference the Examiner is taking from the definitions, they cannot supply the missing steps or structure of the limitations quoted above. See the *Continental Can Co.* and *Robertson* cases cited below.

PRINCIPLES OF LAW

On appeal, Appellant bears the burden of showing that the Examiner has not established a legally sufficient basis for the rejection of the claims.

“In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Patent claim is not invalid for indefiniteness unless it is insolubly ambiguous; therefore, if the meaning of a claim is discernible, the claim is sufficiently clear to avoid invalidity on indefiniteness grounds, even if interpreting the claim is difficult, and construction is one over which reasonable persons could disagree. *Bancorp Services LLC v. Hartford Life Insurance Co.*, 359 F.3d 1367, 69 USPQ2d 1996, 1999 (Fed. Cir. 2004)

An inherency teaching must be necessarily present in the structure described in the applied reference. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 20 USPQ2d 1746, 1749 (Fed Cir. 1991). The Examiner must provide extrinsic evidence, rather than an opinion, that makes clear that “the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed.Cir.1991)).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that “claims must be interpreted as broadly as their terms reasonably allow.” Our reviewing court further states, “[t]he terms used in the claims bear a ‘heavy presumption’ that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.” *Texas Digital Sys. Inc v. Telegenix Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002).

Furthermore, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

ANALYSIS

Appellant contends that Examiner erred in rejecting claims 9, 10, 21, 22, 33, 34, 45, and 46 under 35 U.S.C. § 112 paragraph 2 for being indefinite, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Considering the standard quoted above in the *Bancorp* case, and the findings of the term’s definition in the specification and frequent use in the technology, (Findings of Fact, #1 to #5), we conclude that the term “in near real time” has been sufficiently defined in the specification to allow one of ordinary skill in the art to discern its meaning. The term should be considered for examination purposes consistent with the Appellant’s definition in the specification. *See generally Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005).

Appellant contends that Examiner erred in rejecting claims 1 to 50 under 35 U.S.C. § 103(a). Reviewing the Findings of Fact cited above, we find that the references cited by the Examiner fail to establish in the prior art

certain essential claimed limitations. Neither the Butler reference, nor the Skinner reference, nor the combination of them teaches the user records and the digital asset records, each with a permission field, and the use of both fields to permit editing of the digital asset. (Findings of Fact #6 to #9.) We have considered the logic of the Examiner and the citations from the dictionary. While the latter may be useful for clarifying claim and specification language, it cannot supply structure that is not disclosed in the references. (Findings of Fact #10.)

Appellant and Examiner have differing contentions on the combinability of the Butler and Skinner references, (Br. 15 - 22.) but as we find essential elements of the claims missing from the cited references, that issue need not be addressed.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claims 9, 10, 21, 22, 33, 34, 45, and 46 under 35 U.S.C. § 112 paragraph 2 for being indefinite, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection of those claims is reversed.

Based on the Findings of Fact and Analysis above, we also conclude that the Examiner erred in rejecting claims 1 to 50 under 35 U.S.C. § 103 for being obvious over Butler in view of Skinner.

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DECISION

The Examiner's rejection of claims 9, 10, 21, 22, 33, 34, 45, and 46 under 35 U.S.C. § 112 paragraph 2 is reversed. The rejection of claims 1 to 50 under 35 U.S.C. § 103 for being obvious over Butler in view of Skinner is also reversed.

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REVERSED

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