

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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte*, YUAN-CHI CHANG, HOWARD C. CHIN, CHUNG-SHENG LI,  
and CARSTEN E. MYTROEN.

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Appeal No. 2007-0332  
Application No. 10/316,312  
Technology Center 2100

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Decided: March 28, 2007

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Before MAHSID D. SAADAT, ALLEN R. MACDONALD and JEAN R.  
HOMERE, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-9, 14-21, and 27-30. Claims 10-13 and 22-26 have been cancelled.

## THE INVENTION

The disclosed invention relates to an information engine supporting both keyword searches and parametric searches. Keyword search engines are typically used to search for data in unstructured documents, such as HTML pages, Portable Document Format (PDF) pages, and word processor documents. Parametric search engines, on the other hand, are typically used to search through structured documents, such as databases, that contain information formatted into predefined categories or fields. Parametric searches often involve arithmetic comparison operators such as: “less than,” “greater than,” and “equal to” (i.e., <, >, and =). The present invention teaches a solution by introducing a middleware layer on top of a generic text search solution that provides parametric search capabilities using traditional keyword search engines (Specification 1-2).

Representative claim 1 is illustrative:

1. A method for enabling parametric searches on source data using a text search engine, the method comprising:

extracting at least one data unit from the source data;  
automatically translating the data unit into at least one keyword parametric entry; and  
storing the keyword parametric entry in a surrogate document at a search engine server.

## THE REFERENCES

The Examiner relies upon the following references as evidence of anticipation:

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Chipman	US 6,799,174 B2	Sep. 28, 2004
Bailey	US 6,820,076 B2	Nov. 16, 2004

## THE REJECTIONS

The following rejections are on appeal before us:

1. Claims 1-9, 14-21, and 27-30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Chipman.
2. Claims 1, 14, 27, and 28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Bailey.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Brief and the Answer for the respective details thereof.

## OPINION

Only those arguments actually made by Appellants have been considered in this decision. It is our view, after consideration of the record before us that the evidence relied upon does not support the Examiner's rejection of the claims on appeal. Accordingly, we reverse. In addition, we have *sua sponte* set forth new grounds of rejection for independent claim 1 pursuant to our authority under 37 C.F.R. § 41.50(b).

### Independent claim 1 (Chipman)

We consider first the Examiner's rejection of independent claim 1 as being anticipated by Chipman.

Appellants argue that Chipman does not teach translating data extracted from a data source into parametric entries (Br. 6).

The Examiner disagrees. The Examiner notes that Chipman uses a web crawler to extract data, pointing to fig. 2 (“Web Crawler 205”), and col. 9, lines 8-10. The Examiner further notes that Chipman discloses a data translator, pointing again to fig. 2 (“protocol translator 204”) and also to the protocol translator described at col. 12, l. 25 (Answer 8).

We begin our analysis by noting the particular sequence of steps recited by the method of claim 1, where the extracting step is recited *before* the translating step. “Unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one.” *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1342-43, 59 USPQ2d 1401, 1416 (Fed. Cir. 2001), citing *Loral Fairchild Corp. v. Sony Corp.*, 181 F.3d 1313, 1322, 50 USPQ2d 1865, 1870 (Fed. Cir. 1999) (stating that “not every process claim is limited to the performance of its steps in the order written.”). In the instant case, we note that the antecedent basis for the step of “translating *the data unit*” is established by the preceding step of “extracting at least *one data unit* from the source data” (claim 1, emphasis added). Therefore, we conclude the language of claim 1 does require an order of steps, i.e., the step of *extracting at least one data unit* must be performed *before* the step of *translating the data unit*.

Because the language of claim 1 requires the extracting step to be performed *before* the translating step, we conclude that the logic of the Examiner’s rejection fails to meet the language of the claim. In particular, we note that Chipman’s web crawler 205 (col. 9, ll. 8-9) is implemented by the user (i.e., customer) to retrieve web pages that have *previously* been encoded or “translated” (by a supplier) to conform to a special “predefined protocol,” such as the protocol designated using the <UC> tag in one

preferred embodiment (col. 7, ll. 6-43). We note that Chipman's protocol translators facilitate *supplier publication* of HTML pages that comply with the special protocol (col. 10, ll. 39-42 and col. 12, ll. 19-36). Accordingly, we find that Chipman's step of translation for publication occurs *before* the user (i.e., customer) can view the supplier data using a web browser.

To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim.

*Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). In the instant case, we conclude that the rejection formulated by the Examiner relies upon Chipman's steps of translating and extracting that occur in *reverse sequence* to the sequence of steps required by the language of claim 1. Because the Examiner's rejection has failed to show every limitation (i.e., step) of the claimed invention *arranged as in the claim*, we agree that the Examiner has not met the burden of establishing a *prima facie* case of anticipation with respect to claim 1. Accordingly, we will reverse the Examiner's rejection of independent claim 1 as being anticipated by Chipman.

Nevertheless, after carefully considering the Examiner's rejection and the entire Chipman reference, we find an alternate reading of independent claim 1 on the Chipman patent. Therefore, pursuant to our authority under 37 C.F.R. § 41.50(b), we have *sua sponte* set forth new grounds of rejection for claim 1 *infra*.

Independent claim 14 (Chipman)

We consider next the Examiner’s rejection of independent claim 14 as being anticipated by Chipman.

Appellants argue that the data translator of Chipman does not translate data extracted from the crawler (Br. 12).

We note that the Examiner’s response for claim 1 is also directed to claim 14 (Answer 8).

We further note that the language of claim 14 also requires the step of extracting to be performed *before* the step of translating. In particular, we note the antecedent basis for “translate *the data unit*” is established by the preceding step of “a crawler configured to extract at least *one data unit* from the source data” (claim 14, emphasis added). Because the language of claim 14 requires the extracting step to be performed *before* the translating step, the logic of the Examiner’s rejection fails to meet the language of the claim. Therefore, we will reverse the Examiner’s rejection of independent claim 14 as being anticipated by Chipman for the same reasons discussed *supra* with respect to independent claim 1.

Because we have reversed the Examiner’s rejection of independent claims 1 and 14 as being anticipated by Chipman, we will not sustain the Examiner’s rejection of any of the dependent claims under appeal. Therefore, we will reverse the Examiner’s rejection of dependent claims 2-9, and 15-21 as being anticipated by Chipman.

Independent claim 1 (Bailey)

We consider next the Examiner’s rejection of independent claim 1 as being anticipated by Bailey.

Appellants argue that Bailey does not disclose “automatically translating the data unit into at least one keyword parametric entry,” as claimed (Br. 16).

The Examiner disagrees. The Examiner asserts that a system that performs both parametric and keyword searches transforms (i.e., translates) data to the two different formats required by each search request (Answer 12).

While we agree with the Examiner that Bailey discloses a system that is capable of performing both parametric and keyword searches (col. 9, ll. 9-11), we find no specific disclosure in Bailey of automatically translating a data unit into at least one *keyword parametric entry*, as required by the language of claim 1. Bailey does disclose generic *language translation* at col. 9, line 13; however, it is well settled that a genus (i.e., a generic language translation) cannot anticipate a species (i.e., translating a data unit into at least one *keyboard parametric entry*). *See Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1377, 77 USPQ2d 1321, 1326 (Fed. Cir. 2005) (“disclosure of a broad genus does not necessarily specifically disclose a species within that genus.”) (internal citation omitted). Accordingly, we will reverse the Examiner’s rejection of claim 1 as being anticipated by Bailey.

Independent claim 14 (Bailey)

We consider next the Examiner’s rejection of independent claim 14 as being anticipated by Bailey.

Appellants argue that Bailey does not disclose “a crawler configured to extract at least one data unit from the source data,” as claimed (Br. 18).

The Examiner does not specifically rebut Appellants’ point of argument (Answer 11-12). In the rejection, the Examiner corresponds the claimed “crawler” (i.e., web crawler) to the *web browser* disclosed by Bailey at col. 3, line 60 (Answer 6).

Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted). In the instant case, we find that the claimed “crawler” does not fairly read on a web browser. We note that a web crawler is a program that browses the World Wide Web (WWW) in a methodical, *automated* manner. In contrast, a web browser only browses WWW locations specified by a particular URL address entered by the user. Accordingly, we will reverse the Examiner’s rejection of claim 14 as being anticipated by Bailey.

Claims 27-30

We next address the issue of whether claims 27-30 have been examined (Br. 4). We note that claims 27-30 were added by the amendment

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received on Aug. 26, 2005. We note that the Final Rejection (mailed Nov. 23, 2005) fails to address new claims 27-30 on the merits. In the Answer, the Examiner asserts that claims 27-30 were, in fact, examined, and the omission in the Final Rejection was the inadvertent result of a typographical error (Answer 8).

We find no support in the record that the claims were examined. We find before us *new grounds of rejection* for claims 27-30, set forth for the *first time* in the Examiner's Answer. Specifically, the Examiner has set forth new grounds of rejection (in the Answer) for claims 27-30 as being anticipated by Chipman, and claims 27 and 28 as being anticipated by Bailey. Appellants have anticipated the new grounds of rejection in the Brief by indicating that any rejection of claims 27-30 is improper and should be reversed (Br. 4). Because Appellants have not had an opportunity to traverse the new grounds of rejection on the merits, we *pro forma* reverse the Examiner's rejection of claims 27-30.

#### NEW GROUNDS OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we have *sua sponte* set forth new grounds of rejection for independent claim 1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Decision:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States

before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Chipman (U.S. Patent 6,799,174).

Instant claim 1

Chipman U.S. Pat. 6,799,174

1. A method for enabling parametric searches on source data using a text search engine, the method comprising:	Chipman discloses a method whereby a supplier 105 (col. 12, ll. 19-20) has the capability to publish protocol-compliant pages (i.e., identified with a unique tag such as the <UC> tag (col. 7, ll. 15-22) that enable parametric searches (col. 5, l. 30, col. 9, ll. 50-62) that inherently (i.e., necessarily) require text searching to match a particular parameter (e.g., “Price,” “Length,” or “Width,” col. 7, ll. 20-22) that is subsequently used to perform a numeric (i.e., parametric) comparison (col. 9, ll. 50-62).
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extracting at least one data unit from the source data;	Chipman discloses extracting at least one data unit 408 from legacy databases 406 (i.e., the source data), <i>see fig. 4, col. 12, ll. 23-28.</i>
automatically translating the data unit into at least one keyword parametric entry; and	Chipman discloses using protocol translator 402 to automatically translate data unit 408 into at least one keyword parametric entry of the type identified with the <UC> tag, as shown in col. 7, ll. 15-22. <i>See also fig. 4 and col. 12, ll. 22-36.</i>
storing the keyword parametric entry in a surrogate document at a search engine server.	Chipman discloses storing the keyword parametric entry (i.e., represented using the <UC> “special protocol tag”) in a HTML page 404 (i.e., surrogate document) embodying the data and the special protocol tags at a web server 403 (i.e., search engine server). <i>See also fig. 4 and col. 12, ll. 32-36.</i>

## OTHER ISSUES

The Board of Patent Appeals and Interferences is a review body, rather than a place of initial examination. We have made a rejection above

under 37 C.F.R. § 41.50(b). We leave it to the Examiner to determine the appropriateness of any further rejections based on the Chipman reference alone or in combination with any other prior art references.

## DECISION

In summary, we have reversed the Examiner's rejection of all the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-9, 14-21, and 27-30 is reversed.

We have entered a new grounds of rejection against claim 1 under 37 C.F.R. § 41.50(b).

As indicated *supra*, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (amended effective September 13, 2004, by final rule notice 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. & Trademark Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides that "A new ground of rejection . . . shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that 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) 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 . . .

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- (2) Request that the proceeding be  
reheard under § 41.52 by the Board  
upon the same record . . .

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

REVERSED.  
37 C.F.R. § 41.50(b).

PGC

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