

The opinion in support of the decision being entered today  
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* DANIEL R. MALONE

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Appeal 2007-1696  
Application 10/230,745<sup>1</sup>  
Technology Center 2100

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Decided: October 23, 2007

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Before ALLEN R. MACDONALD, JAY P. LUCAS, and MARC S. HOFF,  
*Administrative Patent Judges.*

HOFF, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 1, 2, 4-7, 9, 10, and 12-24. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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<sup>1</sup> Application filed August 29, 2002. The real party in interest is VistaPrint Technologies Limited.

Appellants' invention relates to editing a document within a web browser. An editing program running in the browser supplies a substitute edit request to the browser in place of the request received from the user. The document object model (DOM) is then accessed and edited to remove the portion of the DOM related to the substitute edit request and insert appropriate tags to achieve the original edit request, simplifying revision of the DOM (Specification 4).

Claim 1 is exemplary:

1. A method for editing a markup language document displayed by a browser executing in a computer system in response to a request from a user of the system to edit one or more characters in a text element of the document, the method comprising:

creating a substitute edit request for the one or more characters that differs from the edit operation requested by the user,

supplying the substitute edit request to the browser to cause the browser to revise the document in accordance with the substitute edit request,

accessing the object model of the document after revision by the browser, and

editing the revised object model to achieve the intent of the user edit request.

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

Peck	US 2002/0188636 A1	Dec. 12, 2002
Poynor	US 2004/0205666 A1	Oct. 14, 2004

Claims 1, 2, 4-7, 9-10 and 12-24 stand rejected under 35 U.S.C. § 103(a) as being obvious over Peck in view of Poynor.

Appellants contend that the Examiner erred in his rejection because neither Peck nor Poynor teaches creating a substitute edit request for the one or more characters (selected by the user) that differs from the edit operation requested by the user, nor causing the browser to revise the document in accordance with the substitute edit request (Br. 5-6). The Examiner contends that Poynor meets these limitations of the claims, according to their broadest reasonable interpretation (Examiner's Answer 4, 8).

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).<sup>2</sup>

## ISSUE

The principal issue in the appeal before us is whether the Examiner erred in holding that Poynor teaches creating a substitute edit request that differs from an edit operation requested by the user, and subsequently

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<sup>2</sup> Appellants have 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).

causing the browser to revise the document in accordance with the substitute edit request.

## FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

### *The Invention*

1. Appellants invented a system and method for enhancing the document editing abilities of a web browser. An editing program running in the browser supplies an editing request to the browser in place of a request received from a user. The Document Object Model (DOM) is then accessed and edited to remove the portion of the DOM related to the substitute edit request and insert appropriate tags to achieve the original edit request (Specification 4).

2. In one embodiment of the invention, the substitute edit is a predetermined request that the selected characters be rendered in the color gray. The specific color is chosen only for convenience (Specification 11).

### *Peck*

3. Peck teaches a software package for editing Web-based documents, including a module for interfacing with a browser and a module for receiving from a user a selected portion of a Web-based document currently displayed by the browser and a desired editing function to be performed on the selected portion (Abstract).

*Poynor*

4. Poynor teaches a system and method for editing a file (Abstract).

5. An initial edit is effected on an original character string within a designated edit region. Subsequent instances of the original character string are identified within the edit region, and suggested edits to subsequent instances of the original character string are derived from the original edit (para. [0021]; Fig. 4).

6. At the user's suggestion, all of the suggested edits can either be automatically made, or made to only a subset of the subsequent instances, in response to a user selection command (para. [0022]; Fig. 5).

#### PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (*citing In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Thus, the Examiner must not only assure that the requisite findings are made, based on evidence of record, but

must also explain the reasoning by which the findings are deemed to support the Examiner's conclusion.

Computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. MPEP § 2106.01; See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

A series of steps which is not tied to a particular machine or apparatus, and which does not transform physical subject matter to a different state or thing, does not meet the statutory definition of a "process" and is not patentable subject matter. *Ex parte Lundgren*, 76 USPQ2d 1385, 1401 (Barrett, J, concurring-in-part and dissenting-in-part).

## ANALYSIS

Appellants note, and the Examiner concedes, that Peck does not teach creating or implementing a substitute edit request that differs from the request made by the user. Appellants argue that the Examiner erred in

stating that Poynor discloses a substitute edit request for one or more characters that differs from the edit operation requested by the user (Br. 6). The Examiner's position is that Poynor's approach, in which the computer system suggests that the user edit subsequent instances of a selected text string in the same manner as that selected, meets the claim limitation (Answer 8). The Examiner's stated rationale is that the suggested edits differ from the original edit because they are concerned with characters different (in position, if not in content) from those originally selected by the user (Answer 8). Appellants argue that Poynor suggests edits to other instances of the same characters that appear elsewhere in the document (see FF 5), but gives no hint of doing anything other than making the requested edit to the characters being edited by the user exactly as the edit is requested by the user (Br. 6).

We agree with Appellants. The claims recite (a) "creating a substitute edit request" (b) "for the one or more characters" (c) "that differs from the edit operation requested by the user." Giving these terms their broadest reasonable interpretation, the system of Poynor teaches sub-element (a), in that its suggestions to edit other instances of the text string selected by a user (FF 5) do constitute at least *potential* edits of a part of the document different from the particular part the user selected. Sub-element (b), "for the one or more characters," refers back to the earlier limitation of the user's request "to edit one or more characters." "*The*" one or more characters can thus only mean the particular, exact characters the user chose to edit. If, as argued by the Examiner, one reads "substitute edit request" to cover the other instances of the same text string in other places in the document, such

as implemented in Poynor, then by definition the “substitute edit request” does not apply to “*the one or more characters*” the user selected. Poynor thus does not teach sub-element (b). Sub-element (c) calls for a *different* edit operation than requested by the user. Poynor fails to meet this sub-element as well, because Poynor’s suggestions prompt the user to make the *same* edit operation he just made at another spot in the document (para. [0021], [0022]).

The Examiner argues further that Appellants’ arguments regarding the references’ failure to teach “a substitute edit for the characters that are the subject of the user’s current edit request” or “making any edit that is not requested by the user” are not relevant, because the features upon which Appellants rely are not recited in the rejected claims (Answer 8, 9). We are not persuaded by the Examiner’s position, because for the reasons noted *supra* we believe Appellants’ arguments accurately reflect the content of the claims.

We therefore find that neither Peck nor Poynor teach the claim limitations at issue. Because the limitations appear in every claim, we reverse the rejection of claims 1, 2, 4-7, 9, 10, and 12-24 under 35 U.S.C. § 103(a).

#### NEW GROUNDS OF REJECTION

*Rejection of claims 10 and 17-20 under 37 C.F.R. § 41.50(b).*

We make the following new grounds of rejection using our authority under 37 C.F.R. § 41.50(b).

Claims 10 and 17-20 are rejected under 35 U.S.C. § 101 as not being directed to statutory subject matter.

Independent claim 10 recites “[a] document editing program configured to run in the browser of a computer system,” the claim containing several further means-plus-function limitations of the *program*. At no point is the document editing program embodied on a computer-readable medium. There are no structural and functional interrelationships defined between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. No physical subject matter is transformed to a different state or thing. As a result, claim 10 and dependent claims 17-20 do not meet the statutory definition of a process, or any other statutory class of invention, and do not constitute eligible subject matter under 35 U.S.C.

§ 101.

#### CONCLUSION OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1, 2, 4-7, 9, 10, and 12-24.

On the record before us, claims 1, 2, 4-7, 9, 12-16, and 21-24 have not been shown to be unpatentable.

#### DECISION

The Examiner's rejection of claims 1, 2, 4-7, 9, 10, and 12-24 is reversed.

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We have entered a new ground of rejection against claims 10 and 17-20 under 37 C.F.R. § 41.50(b).

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)

KIS

VISA PRINT USA, INC.  
ATTN: PATENT COUNSEL  
95 HAYDEN AVENUE  
LEXINGTON, MA 02421