

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte CRAIG SALTER and CHRISTINA P. LAU*

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Appeal 2007-4094  
Application 10/313,284  
Technology Center 2100

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Decided: July 22, 2008

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Before JAMES D. THOMAS, ST. JOHN COURTENAY III, and  
STEPHEN C. SIU, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1, 4-10, 13-19, 21, and 22. Claims 2, 3, 11, 12, and 20 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE. We also enter new grounds of rejection against claims 1 and 4-9 under the provisions of 37 C.F.R. § 41.50(b).

## THE INVENTION

The disclosed invention relates generally to the conversion of files from one format to another. More particularly, Appellants' invention is directed to converting markup language files from one format to another (Spec.1).

Independent claim 1 is illustrative:

1. A method for converting a first markup file to a second markup file, said method comprising:

inserting tags into said first markup file, wherein said tags comprise a first tag identifying data elements to be extracted from said first markup file and a second tag identifying a portion of said first markup file which requires conversion;

generating said second markup file from the data elements extracted from said first markup file using the first tag in said first markup file; and

generating a conversion file using the second tag in said first markup file, said conversion file, when processed with said second markup file, adapted to generate a third markup file similar to said first markup file.

## THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejections:

Davis	US 5,937,160	Aug. 10, 1999
Sohota	US 2001/0056460 A1	Dec. 27, 2001

## THE REJECTION

Claims 1, 4-10, 13-19, 21, and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sohota in view of Davis.

## PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants’ Brief to show error in the proffered *prima facie* case.

## ANALYSIS

Independent claims 1, 10, and 19

We consider the Examiner’s rejection of independent claims 1, 10, and 19 as being unpatentable over Sohota in view of Davis.

Appellants contend that the cited combination of prior art does not teach inserting tags into the first markup file to identify a portion of the first markup file that requires conversion (Br. 9). Appellants also contend that

“the cited prior art also fails to teach or suggest ‘generating a conversion file’ using the second tag in the first markup file, wherein the second tag identifies a portion of the first markup file which requires conversion,” as claimed. (Br. 9).

The Examiner disagrees. The Examiner contends that the secondary Davis reference “teaches adding commands in the form of RPM tags to a markup language file to denote both the content to be replaced (equivalent to the value tag as claimed in the [i]nstant [i]nvention) and a portion of the markup file that requires conversion (equivalent to the regional tag as claimed in the [i]nstant [i]nvention.)” (Ans. 8).

We note that claim 4 (that depends upon claim 1) recites that the “first tag comprises a value tag and said second tag comprises a regional tag.” Thus, the Examiner is clearly reading *both* the claimed “first tag identifying data elements to be extracted from said first markup file” *and* the claimed “second tag identifying a portion of said markup file which requires conversion” on the single <RPM> tag disclosed by Davis. (Col. 15, ll. 5-10). Davis discloses that “[t]he <RPM> tag is the basic tag used to identify the location of a port within the HTML source file of a Web page. The Web server automatically replaces this tag with the Web page content changes provided with the incoming e-mail message.” (Davis, col. 15, ll. 6-10).

When we consider the claim as a whole, we conclude that the Examiner has erred by impermissibly mapping two distinctly claimed types of tags (i.e., a first tag identifying data elements to be extracted from said first markup file and a second tag identifying a portion of said first markup file which requires conversion) to a corresponding *single* element in the

secondary Davis reference, i.e., the <RPM> tag, as previously discussed. Moreover, we also find persuasive Appellants' argument (Br. 10, ¶3) that Davis does not disclose "identifying data elements to be extracted from the first markup file", as claimed. We agree with Appellants that Davis instead discloses *replacing* the <RPM> tag with the Web page content changes provided with the incoming e-mail message, as previously discussed. (Davis, col. 15, ll. 6-10). Therefore, for at least the aforementioned reasons, we conclude that the cited combination of Sohota and Davis does not teach nor fairly suggest the following limitations recited in each of independent claims 1, 10, and 19:

a first tag identifying data elements to be extracted from said first markup file and a second tag identifying a portion of said first markup file which requires conversion;  
(independent claims 1, 10, and 19).

Although the aforementioned deficiencies are sufficient to decide this appeal, we nevertheless find additional claim limitations that are not taught or fairly suggested by the proffered combination of Sohota and Davis.

Regarding the claim limitations of "generating a conversion file using the second tag in said first markup file," (independent claims 1, 10, and 19), the Examiner contends that Sohota teaches transforming or converting a markup language file, such as an XML file, into a displayable format using an XLST file to define the format of the data and perform the conversion (*see* Sohota, Fig. 2B, p. 6, paras. 0067-0068). (Ans. 9).

However, we note that the language of each independent claim is expressly directed to *generating* a conversion file, in addition to merely *using* the conversion file to generate a third markup file (independent claims

1, 10, and 19). Thus, based upon the evidence before us, we agree with Appellants that the cited portions of Sohota merely disclose (in reference to transforming an XML file into an HTML web page), that “[an extensible style sheet transformation (XSLT) application can be *used* to perform such a transformation.” (Sohota, para. 0067, 4<sup>th</sup> sentence, emphasis added). After considering the record before us, we concur with Appellants’ observation that the cited portion of Sohota is silent regarding how the XSLT application (i.e., conversion file) is *generated*. Therefore, we agree with Appellants that the cited combination of references do not provide a teaching or suggestion to *generate* the conversion file using the second tag in the first markup file, as required by the language of each independent claim on appeal.

Because we conclude that Appellants have met their burden of showing that the Examiner has failed to establish a *prima facie* case of obviousness, we reverse the Examiner’s rejection of independent claims 1, 10, and 19, as being unpatentable over Sohota in view of Davis. Because we have reversed the Examiner’s rejection of each independent claim on appeal, we also reverse the Examiner’s rejection of dependent claims 4-9, 13-18, 21, and 22 as being unpatentable over Sohota in view of Davis.

#### CONCLUSION OF LAW

We conclude that Appellants have met their burden of showing that the Examiner erred in rejecting claims 1, 4-10, 13-19, 21, and 22 under 35 U.S.C. § 103(a) for obviousness.

NEW GROUND OF REJECTION

35 U.S.C. § 101

Using our authority under 37 C.F.R. § 41.50(b), we reject claims 1 and 4-9 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

We conclude that claims 1 and 4-9 are not directed to eligible subject matter under 35 U.S.C. § 101 in view of *In re Comiskey*, 499 F.3d 1365 (Fed. Cir. 2007). In particular, we conclude that Appellants' claimed "method for converting a first markup file to a second markup file" (claim 1) does not require integrating a machine (e.g., a computer), or constitute a process of manufacture, or altering a composition of matter. We conclude that the steps recited in claim 1 may be embodied in software alone or could alternately be performed as mental steps where the claimed file is merely data. Therefore, the nature of the subject matter claimed may be reasonably construed as a mental process since the language of claims 1 and 4-9 broadly encompasses non-tangible embodiments. Accordingly, we conclude that these claims are directed to abstract ideas<sup>1</sup> and/or data structures per se.

In contrast, independent claim 10 recites in pertinent part: "[a] computer readable media product storing data and instructions, said data and instructions, when processed by a computer system . . ." (claim 10, preamble). When we broadly but reasonably construe the claimed "computer

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<sup>1</sup> The Supreme Court has specifically identified three categories of unpatentable subject matter: "laws of nature, natural phenomena, and abstract ideas." See *Diamond v. Diehr*, 450 U.S. 175, 185 (1981).

readable media product” in a manner consistent with Appellants’ Specification, we conclude that the scope of the claimed media is limited to tangible media embodiments such as the disclosed “floppy disk drives, tape drives, CD-ROM drives, DVD-RW drives,” and the like. (*See Spec. 9, ll. 9-10*). See also Appellants’ Specification, page 10, lines 7-9: “Although removable media 212 is illustrated as a conventional diskette[,] other removable devices such as Zip™ drives, flash cards, CD-ROMs, static memory devices and the like may also be employed.” Therefore, we conclude that independent claim 10, and associated dependent claims 13-18 are each directed to statutory subject matter.

Likewise, we conclude that independent claim 19 and associated dependent claims 21 and 22 are each directed to statutory subject matter because we find clear structural support for the claimed “means” in the computer system shown in Appellants’ Figure 1 and described in the Specification on page 9, lines 3-8, in addition to the associated algorithms depicted in Figures 4 and 5.<sup>2</sup>

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<sup>2</sup> For a computer-implemented means-plus-function claim limitation that invokes 35 U.S.C. 112, sixth paragraph, the corresponding structure is required to be more than simply a general purpose computer or microprocessor. *See Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1333 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function is the algorithm. *See WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339 (Fed. Cir. 1999). The written description of the Specification must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the disclosed algorithm that performs the claimed function. *See Aristocrat*, 521 F.3d at 1338.

## DECISION

We reverse the Examiner's decision rejecting claims 1, 4-10, 13-19, 21, and 22.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph 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) *Reopen prosecution.* 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. . . .
- (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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Applicant may express the algorithm in any understandable terms including as a mathematical formula, in prose, in a flow chart, or in any other manner that provides sufficient structure. *See Finisar Corp. v. The DIRECTV Group Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008).

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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)

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