

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WOLFGANG EIBACH and DIETMAR KUEBLER

Appeal 2008-0677
Application 09/951,237¹
Technology Center 2100

Decided: July 29, 2008

Before: HOWARD B. BLANKENSHIP, JAY P. LUCAS and
ST. JOHN COURTENAY III, Administrative Patent Judges.

LUCAS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application filed September 13, 2001. Appellants claims the benefit under 35 U.S.C. § 119 of EPO patent application 00120362.9, filed 09/16/2001. The real party in interest is International Business Machines Corporation.

STATEMENT OF CASE

Appellants appeal from a final rejection of claims 1 to 17 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).

Appellants' invention relates to client/server based system and method for processing transactions which contains a second storage device containing transaction information which helps to recover from client failures that may occur in mid-processing of the transaction so the transaction may be restarted. In the words of the Appellants:

The invention solves these objects by providing a transaction mechanism and a corresponding transaction system which allow for an end-to-end guaranteed transaction issued from a client, in particular a thin client, to a server. The underlying concept is to have the transaction controlled by the client (user) which initiated the transaction and providing transaction status information to the client therefore providing a guaranteed end-to-end transaction behavior.

The invention particularly provides, on the server side, a control queue form storing current state information of a pending transaction using a unique identifier for the client. On the client side, means are provided for setting up a connection to the control queue in case of starting a transaction and for querying the control queue for any previous transactions with the same unique identifier.

(Specification, page 6)

Claims 1 and 16 are exemplary:

1. A client/server-based data processing system for performing transactions, the system comprising

a server, having:

first data storage means for storing received transaction requests; and at least second storage means for storing current state information of a pending transaction using a unique identifier for at least one client, and

a client of the at least one client not having any transaction managing resources, the client having processing means for setting up a connection to the at least second storage means in case of starting a transaction and querying the second storage means for any previous transactions with the unique identifier being the same,

wherein the transaction requests are received from the client.

16. A data processing program for execution in a data processing system comprising software code portions for performing the following operations:

storing on a server received requests from a client having no transaction for a pending transaction in a first data storage means;

storing on the server current state information of the pending transaction in at least second data storage means using a unique identifier for the at least one client, and

setting up on the client a connection to the at least second data storage means in case of starting a transaction and querying the second data storage means for any previous transactions with the same unique identifier.

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

Blount	US 6,070,184	May 30, 2000
Mizutani	US 2003/0105813 A1	Jun. 5, 2003

REJECTIONS

R1: Claim 16 stands rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

R2: Claims 1 to 17 stand rejected under 35 U.S.C. 103(a) for being obvious over Blount in view of Mizutani. Claim 1 is representative, by virtue of it being the only claim argued under this rejection.

See 37 CFR § 41.37 (c)(1)(vii). See also *In re McDaniel*, 293 F.3d 1379, 1383 (Fed. Cir. 2002).

Appellants contend that the claimed subject matter is statutory and not rendered obvious by Blount in combination with Mizutani, for failure of the references to teach the limitations of the claims, and for failure of the references to be properly combined. The Examiner contends that each of the respective claims is properly rejected under [R1] and [R2].

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Brief and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived.

We affirm the rejections.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. §§ 101 and 103(a). One issue turns on whether a computer program is statutory subject matter without the recitation of a computer readable medium on which it is recorded. A second issue is whether the references teach the second storage means as claimed.

PRINCIPLES OF LAW

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)).

"It is common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1732 (2007).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow."

References within the statutory terms of 35 U.S.C. § 103 qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992). Two separate tests define the scope of analogous prior art: (1) whether the art is

from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); see also *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979) and *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).). 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, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a prima facie case for the rejections of Appellants' claims under 35 U.S.C. §§ 101 and 103. The prima facie case is presented on pages 4 to 9 of the Examiner's Answer. In opposition, Appellants present a number arguments.

Arguments with respect to the rejection of claim 16 under 35 U.S.C. § 101(e)[R1]

The first argument addresses the issue of statutory subject matter under 35 U.S.C. § 101. Appellants contend that the claims need merely be

“new and useful”. (Br., p. 6, top). Subsequent to the filing of the Appellants’ Brief and the Examiner’s Answer, the Court of Appeals for the Federal Circuit has issued its opinion in *In re Comiskey*, 499 F.3d 1365, (Fed. Cir. 2007). “Following the lead of the Supreme Court, this court and our predecessor court have refused to find processes patentable when they merely claimed a mental process standing alone and untied to another category of statutory subject matter even when a practical application was claimed.” *In re Comiskey*, 499 F.3d 1365, 1378 (CAFC, 2007). We have long held that a computer program with no recitation of a medium is simply a mental process, not tied to a statutory class of invention.

Claim 16 recites a data processing program alone, with no structural tie to a computer readable medium or any other article of manufacture, machine, process or composition of matter. “Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101....” *In re Nuijten*, 500 F.3d 1346, 1359 (Fed. Cir. 2007). The data processing program alone does not belong to one of those categories.

We thus do not find error in the Examiner’s rejection of claim 16 under 35 U.S.C. § 101.

Arguments with respect to the rejection
of claims 1 to 17 under 35 U.S.C. § 103(a)

Appellants have also presented a number of arguments against the rejection [R2] of claims 1 to 17. Appellants contend that the cited references of the rejection do not teach that the client has processing means “for setting up a connection to the at least second storage means in case of starting a

transaction and querying the second storage means for any previous transactions with the unique identifier being the same.”

Blount teaches a client server system for processing transactions which is resistant to disconnects where “transmission time, latency or other communication limitations reduce responsiveness of browser/server communications.”

The quoted part of the claims has a number of aspects. First, we note in Blount that a web browser (a “client not having any transaction managing resources”, as claimed) connects to a second computer, the server. (Col. 4, l. 58). A “request” [for a transaction] from the web browser is sent to, and stored in a persistent request queue on that second computer. (Id.) This is read on the “first data storage means” of the claim. Then a “client identification” is associated with the stored request, and the request is sent on to an application for processing. (Col. 4, l. 62). A response is generated by the application and stored in a server-side cache on the server. (Col. 4, l. 64). That is associated with the stored request, and provided to the client. (Id.) Thus Blount teaches a second storage means which stores state information of a pending transaction using a unique identifier for the client, as claimed. Blount is used by the Examiner to provide most of the teachings of the subject claim.

Mizutani presents another client/server architecture resistant to interruption of communications. (Abst.). In ¶39 of Mizutani, about 15 lines from the beginning of the paragraph, there starts a discussion of the session management table. The “session initialization includes extracting a client ID, such as an account for logon from the connection demand from the client

12-1, retrieving the session management table shown in Fig. 2, acquiring a new session No. on the condition that there is no same client ID, and newly entering the session No. together with the client ID and the status into the session management table.” (Mizutani, p. 5, ¶39). The Examiner uses these teachings from an analogous art to read on the claim’s language “querying the second storage means for any previous transactions with the unique identifier being the same.”

Appellants’ first contention is that the teachings of Blount and Mizutani fail to show the client querying the second storage means; that Mizutani teaches the server doing the querying of the session management table. (Br. p. 8, bottom). The Examiner responds in two ways. First she points out that the claim, read broadly yet reasonably, does not specifically require that the client queries the second storage means. Reviewing the clause in question, we find that the words of the claim² support that interpretation, that is, the processing means of the client may be interpreted to reside on the server. However, we are further persuaded by the Examiner’s second argument (Ans., p. 12, top) to the effect that the client starts the process which results in a query of the session management table, which, as the second storage means, resides on the server. By this second alternative interpretation the client starts the querying process.

² “...the client having processing means for setting up a connection to the at least second storage means in case of starting a transaction and querying the second storage means for any previous transactions with the unique identifier being the same.”

Appellants further contend that Mizutani shows a single session management table, not the claimed first and second storage means. As we indicated above, Blount clearly teaches the separate storage means.

Finally Appellants contend that there is insufficient motivation to combine the Mizutani and Blount references. In view of the lessons of *KSR Int'l Co. v. Teleflex, Inc.* (cited above) and the finding that both references address the same field of endeavor, as discussed at the beginning of this section, we fail to find error in the rejection on this count.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claim 16 for being non-statutory [R1]. We also find that the Examiner did not err in rejecting claims 1 to 17 for being obvious over Blount and Mizutani. [R2].

DECISION

The Examiner's rejection [R1] of claim 16 under 35 U.S.C. § 101 is affirmed. The Examiner's rejection [R2] of claims 1 to 17 under 35 U.S.C. § 103(a) is affirmed.

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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). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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