

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES RUSSELL GODWIN and
MICHAEL C. WANDERSKI

Appeal 2008-0130
Application 10/439,867
Technology Center 2100

Decided: June 30, 2008

Before HOWARD B. BLANKENSHIP, ALLEN R. MACDONALD, and
ST. JOHN COURTENAY III, *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 1-20. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM IN PART. We also enter new grounds of rejection against claims 2 and 16 under the provisions of 37 C.F.R. § 41.50(b).

THE INVENTION

The disclosed invention relates generally to the fields of portals and portlets. More specifically, Appellants' invention is directed to the styling of a portal view in the display of a pervasive agent (See Spec. 1, para. 0001).

Independent claim 1 is illustrative of the invention:

1. A method for rendering a portal view in conformity with a portal style for display in a pervasive agent, the method comprising the steps of:

loading a style sheet defining a theme for the portal;

mapping visual rendering attributes for said defined theme to markup language tags specific to a specific type of pervasive agent;

parsing portlet rendering logic for a specified portlet to identify embedded style attribute references;

replacing selected ones of said embedded style attribute references in said portlet rendering logic with mapped ones of said markup language tags; and,

compiling said portlet rendering logic for use in producing a view for said specified portlet.

THE REFERENCES

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

Anuff	US 6,327,628 B1	Dec. 4, 2001
Lynch	US 6,558,431 B1	May 6, 2003
Griffin	US 2003/0126558 A1	Jul. 3, 2003

THE REJECTIONS

1. Claims 7-14 stand rejected under 35 U.S.C. § 101.
2. Claims 1, 5, 7-15, and 19, stand rejected under 35 U.S.C. § 102(b) as being anticipated by Anuff.
3. Claims 2, 6, 16, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anuff in view of Griffin.
4. Claims 3, 4, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anuff in view of Griffin and Lynch.

ANALYSIS

35 U.S.C. § 101

Claims 7-14

We consider the Examiner's rejection of claims 7-14 as being directed to non-statutory subject matter.

Appellants assert that claims 7 and 12 are directed to a server system and a server, which are devices. Therefore, Appellants contend that claims 7-14 are directed to statutory subject matter (App. Br. 4).

We broadly but reasonably construe a "server" as a provider of services. Under this construction, a server that provides services is not limited solely to hardware embodiments. This claim construction is fully consistent with Appellants' Specification at paragraph 0036 ("The present invention can be realized in hardware, software, or a combination of hardware and software.").

Although the preambles of claims 7 and 12 recite a "portal server system" and a "portal server," respectively, preambles are not necessarily given patentable weight unless the elements recited within the body of the

claim give life to the preamble. Otherwise, the preamble is merely a statement of intended use.

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999).

In the case before us, we note that the preambles of claims 7 and 12 do not recite limitations supported in the body of the claims. Thus, the preamble limitations do not give life, meaning or vitality to either of claims 7 and 12. Therefore, we conclude that the preambles of claims 7 and 12 are merely statements of intended use.

Moreover, as noted by the Examiner, the claims are not embodied in a manner so as to be executable (Ans. 3). As discussed *supra*, Appellants admit that the invention "can be realized in hardware, software, or a combination of hardware and software" (Spec. 16, para. 0036). Thus, the invention recited in claims 7-14 could be implemented in software per se. As noted by our reviewing court, when a claim does not invoke a machine, § 101 requires some kind of transformation or reduction of physical subject matter. *See In re Comisky*, 499 F. 3d 1365, 1377 (Fed. Cir. 2007) (citing *In re Schrader*, 22 F.3d 290, 295 (Fed. Cir. 1994)).

Based on the record before us, we conclude that claims 7-14 do not sufficiently invoke a machine or a transformation of subject matter, and are therefore unpatentable under 35 U.S.C. § 101.

Anticipation under 35 U.S.C. § 102

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted). “It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that references are nonetheless inherent in it. ‘Under the principals of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.’” *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002).

FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Anuff

1. Anuff teaches that a portal comprises an HTML web page (Anuff col. 3, ll. 44-45).
2. Anuff teaches that the HTML web page (“front page”) presents a predetermined layout of encapsulated modules containing resources available to users (Anuff col. 3, ll. 44-47).
3. Anuff describes communication devices as personal computers, workstations, web access devices, and the like to view informational content (Anuff col. 3, ll. 4-8).

4. Anuff teaches that HTML data is embedded in the Module View class and an XML inclusion module, retrieves an XML style sheet (col. 7, ll. 5-20).

Specification

5. The Specification describes a “pervasive device” as including handheld computers, cellular phones, and the like,” (Spec. 2, ¶[0005]).
6. The Specification does not define “theme.” Instead the Specification refers to “various styling themes” and “one or more visual themes” (Spec. p. 3, ¶[0007] and p. 10, ¶[0021]). Thus, the Specification provides no detailed description of the term “theme.”

Claim Construction

“[T]he PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). As noted by the Examiner, the term “theme” is not further defined in claim 1 (Ans. 8, ll. 13-16). Further, Appellants’ Specification broadly refers to themes as styling themes and visual themes (*See* Spec. p. 3, ¶[0007] and p. 10, ¶[0021]). Accordingly, we broadly but reasonably construe the claimed “theme” as the look and feel of an interface.

Independent claim 1

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

Appellants contend that Anuff fails to teach a style sheet defining a theme for the portal as recited in claim 1 (Reply Br. 5). More specifically, Appellants contend that Anuff does not teach a "defined theme" for a portal (*id.*). Given our aforementioned construction of the claimed "theme" as broadly corresponding to the look and feel of an interface, we agree with the Examiner's finding that Anuff discloses "themes" as recited in claim 1.

Appellants further contend that "Anuff considers a module and a portal to be different wherein the module is only part of the portal, . . ." (Reply Br. 6) (underline in original).

As disclosed by Anuff, a portal comprises (i.e., includes) an HTML web page, and each page presents a predetermined layout of encapsulated modules (FF 1-2). We find that the HTML web page disclosed by Anuff (col. 3, l. 44) defines the formatting and layout of the web page portal, and is therefore reasonably a type of "style sheet" for Anuff's web page portal (col. 3, ll. 44-47). Moreover, we note that Anuff discloses that "[m]odules are objects that encapsulate a specific, bounded portion of content at a network address" (col. 6, ll. 22-25). Anuff further discloses that modules are each of a "module type" that has an associated "module descriptor [that] gets its initial data from an XML document . . . [where the] module descriptor provides another point for the customization of the portal server" (col. 6, ll. 38-39 and ll. 41-43). As pointed out by the Examiner, Anuff also expressly discloses "an XML style sheet [that] generates the HTML for display as the content of a module" (Ans. 9, ¶3; *see also* Anuff, col. 7, ll. 19-20).

Therefore, we conclude that Appellants have not shown error in the Examiner's reading of the claimed "style sheet" on Anuff's XML document. Accordingly, we find that Anuff anticipates the argued limitations of "a style sheet defining a theme for a portal" (claim 1).

Appellants further contend that Anuff fails to teach "a specific type of pervasive agent" as recited in claim 1. As noted by the Examiner, Appellants broadly define a pervasive agent as "handheld computers, cellular phones, and the like" (FF 5). Thus, the language of the Specification lends to a broad but reasonable interpretation of a pervasive agent that reads on the communication devices described in Anuff. Therefore, we agree with the Examiner that the claimed pervasive agent is disclosed by Anuff.

We further agree with the Examiner's determination that a pervasive agent of a "specific type" broadly but reasonably includes a communication device that is HTML-enabled (versus XML-enabled). Firstly, we note that the term "type" is not defined in the claims. In addition, Anuff teaches that HTML (or XML) content is viewed by using browser applications that are executed on communication devices (see col. 3, ll. 8-13). Thus, based at least on the above, we find that Anuff discloses the claimed limitations of a defined theme to markup language tags (i.e., XML and HTML) (see FF 4) specific to a specific type of pervasive agent (i.e., HTML versus XML enabled communication devices).

Appellants further contend that the Examiner failed to prove that Anuff identically discloses a specific type of pervasive agent, or inherently discloses the claimed pervasive agent (App. Br. 8). However, as discussed above, given the breadth of the Appellants' description of the "pervasive

agent,” (e.g., “. . . and the like”, *see* FF5) we find that the Examiner broadly but reasonably interpreted the pervasive agent to read on the communications device described in Anuff. Further, based on the record before us, we reject Appellants’ assertion that the Examiner has relied on inherency with regards to this element.

Based at least on the above, we conclude that Appellants have not shown the Examiner erred in rejecting independent claim 1. Thus, we sustain the Examiner’s rejection of claim 1 as being anticipated by Anuff.

Dependent Claim 5

We consider next the Examiner’s rejection of claim 5 as being anticipated by Anuff. Appellants contend that the Examiner failed to provide a *prima facie* case of anticipation because the “Response to Arguments” section of the Final Office Action did not include a response to Appellants’ arguments (App. Br. 11). Further, Appellants contend that the Appellants do not have a burden to respond to an incomplete rejection (Reply Br. 9).

We disagree on both counts. To the contrary, 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). Based upon our review of the record before us, Appellants have failed to meet their burden before the Board of showing specific error in the Examiner’s findings of fact. *See also* 37 C.F.R. § 41.37(c)(vii) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”). *See also* 37 C.F.R. § 1.111(b).

Specifically, in the Brief, Appellants do not make any arguments to distinguish the limitations of claim 5 from the portions of Anuff that were cited in the Examiner's rejection of claim 5 (Ans. 5). We further note that the Reply Brief also fails to present arguments that serve to distinguish the limitations of claim 5 from Anuff (*see also* Reply Br. 8-9). On this record, we conclude that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection. Therefore, we sustain the Examiner's rejection of dependent claim 5 as being anticipated by Anuff.

Claims 7, 9, and 10

We consider next the Examiner's rejection of independent claim 7 and dependent claims 9 and 10 as being anticipated by Anuff. Although Appellants have argued these claims separately, the arguments contained therein are substantially the same allegations discussed above regarding claim 5 (*see* App. Br. 11-13). Accordingly, we sustain the Examiner's rejection of claims 7, 9, and 10 as being anticipated by Anuff for the same reasons discussed above regarding claim 5.

Claims 8, 11-15, and 19

We consider next the Examiner's rejection of claims 8, 11-15, and 19 as being anticipated by Anuff. We note that Appellants have grouped these claims as standing or falling together with independent claim 1, even though claims 8 and 11 depend directly or indirectly from independent claim 7, and claims 13 and 14 depend from independent claim 12, and claim 19 depends from independent claim 15 (App. Br. 7). Since we have sustained the

Examiner's rejection of independent claim 1 as being anticipated by Anuff, we also sustain the Examiner's rejection of claims 8, 11-15, and 19 as being anticipated by Anuff for the same reasons discussed above regarding claim 1.

Obviousness under 35 U.S.C. § 103

Dependent Claims 2 and 16

We consider next the Examiner's rejection of claims 2, 6, 16, 20, as being unpatentable over Anuff in view of Griffin. We *pro forma* reverse the rejections of claims 2 and 16 in light of the new ground of rejection discussed below.

Dependent Claims 6 and 20

Similar to the discussion *supra* regarding claims 5, 7, 9, and 10, Appellants fail to provide any substantive arguments to distinguish the limitations recited in claims 6 and 20 over the cited references (App. Br. 15-16). In fact, claim 20 is not addressed at all. Thus, Appellants have not met their burden of showing the Examiner erred in rejecting claims 6 and 20. Therefore, we sustain the Examiner's rejection of claims 6 and 20 as being unpatentable over Anuff and Griffin.

Dependent Claims 3, 4, 17 and 18

We consider next the Examiner's rejection of claims 3, 4, 17, and 18 as being unpatentable over Anuff in view of Griffin and Lynch. Appellants contend that the secondary Griffin and Lynch references do not cure the argued deficiencies of Anuff (App. Br. 16).

In response, we see no deficiencies with Anuff, as discussed *supra*. Therefore, we sustain the Examiners rejection of claims 3, 4, 17, and 18 as being unpatentable over Anuff in view of Griffin and Lynch.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not shown the Examiner erred in rejecting claims 7-14 under 35 U.S.C. § 101 as being directed to non-statutory subject matter,

Likewise, we conclude that Appellants have not met their burden of showing that the Examiner erred in rejecting claims 1, 5, 7-15, and 19 under 35 U.S.C. § 102(b) for anticipation.

We also conclude that Appellants have not met their burden of showing that the Examiner erred in rejecting claims 3, 4, 6, 17, 18 and 20 under 35 U.S.C. § 103(a) for obviousness.

We *pro forma* reverse the Examiner's obviousness rejections of claims 2 and 16 in light of the new grounds of rejection set forth *infra*.

NEW GROUND OF REJECTION

35 U.S.C. § 103

Using our authority under 37 C.F.R. § 41.50(b), we reject claims 2 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Anuff and in view of Griffin and Lynch.

Claims 2 and 16

Our reviewing court has reaffirmed that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 127 S. Ct. 1727, 1739).

Here, we conclude that the combination of Anuff, Griffin and Lynch renders obvious the limitations recited in claims 2 and 16. In particular, we find that the combination of Anuff and Griffin teaches or suggests all of the elements recited in claims 2 and 16, except the limitation of purging unsupported tags. Lynch is directed to storing valid and invalid markup language in strict and relaxed table. Lynch teaches that invalid or unsupported structures may be manually deleted by the user (col. 3 ll. 35-37). In addition, Lynch teaches that “correctable invalid HTML may be automatically rewritten (not preserved)” (i.e., purged) (*Id.* ll. 37-40). Therefore, we conclude that claims 2 and 16 are unpatentable over Anuff, Griffin, and Lynch.

DECISION

We affirm the Examiner’s decision of rejecting claims 1, 3-15, and 17-20. We *pro forma* reverse the Examiner’s rejection of claims 2 and 16.

With respect to the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides that “Appellant may file a single request for rehearing within two months from the date of the original decision of the Board.”

In addition to affirming the Examiner's rejection(s) of one or more claims, 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. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

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If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

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