

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARVIND KUMAR, MURALI SUNDAR,
and ALOK PRAKASH

Appeal 2008-0620
Application 10/194,626
Technology Center 2100

Decided: June 27, 2008

Before HOWARD B. BLANKENSHIP, JAY P. LUCAS, 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 1-24. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE INVENTION

The disclosed invention relates generally to apparatus, systems, and methods used for data processing and computer user interface management. More particularly, Appellants' invention is directed to providing multiple users of a service with individual, customized access to the service, as well as presenting the appearance of a managed single-user interface to each user (Spec. 1).

Independent claim 1 is illustrative:

1. An apparatus, comprising:
 - a services object manager (SOM);
 - a portal server to communicatively couple to the SOM and to receive access to service objects comprising instantiated schema constructs exposed by the SOM; and
 - a domain information provider to communicatively couple to the SOM and to instantiate the service objects upon activation of at least one service associated with the service objects.

THE REFERENCE

The Examiner relies upon the following reference as evidence in support of the rejections under sections 102 and 103:

Nielsen US 6,055,570 Apr. 25, 2000

THE REJECTIONS

1. Claims 19-24 stand rejected under 35 U.S.C. § 101 as being directed to non statutory subject matter (i.e., a signal).
2. Claims 1-24 stand rejected under 35 U.S.C. § 101 as being directed to non statutory subject matter (i.e., a computer program per se).
3. Claims 1-22 and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nielsen.
4. Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nielsen.

ANALYSIS

Claims 19-24 (first-stated rejection under § 101)

Regarding independent claim 19, we note that a computer-readable medium (or media) having computer-executable instructions is directed to statutory subject matter so long as the language of a claim is not supported in the Specification with nonstatutory embodiments (i.e., signals, transmission mediums and the like). *See In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007) (A claim directed to computer instructions embodied in a signal is not statutory under 35 U.S.C. § 101).

Here, Appellants' Specification discloses that computer readable media (that includes computer storage media and communications media) is intended to broadly encompass modulated data signals including carrier waves (Spec. 13). Appellants contend that an article of manufacture is a

statutory product under § 101 (App. Br. 9). However, Appellants' argument ignores the use of the word "including" in the claim: i.e., "[a]n article comprising a machine-accessible medium *including* a computer storage medium . . ." (claim 19, emphasis added). Because the scope of the claimed "computer storage medium" encompasses carrier waves, it is our view that Appellants' claims broadly read on signals and other nontangible transmission mediums. Therefore, we conclude that independent claim 19 and associated dependent claims 20-24 are directed to nonstatutory subject matter.

Claims 1-24 (second-stated rejection under § 101)

The Examiner also rejects claims 1-24 as being directed to non statutory subject matter under 35 U.S.C. § 101 on the basis that these claims are directed to a computer program per se (Ans. 3-6).

The Examiner notes that Appellants' Specification discloses that article 254 is described as comprising a "machine-accessible medium having associated data . . ." (Ans. 15; *see also* Spec. 13, ll. 26-27). Thus, the Examiner reasons that the "portal server" recited in each of Appellants' independent claims is a software server, because portal server 226 is clearly shown in Appellants' Figure 2 as being included in article 254 (Ans. 15).

In response, Appellants aver that the claimed "portal server" constitutes a machine and a product having a physical structure (App. Br. 9, ¶2). Regarding claims 13-18, Appellants contend that the claimed subject

Appeal 2008-0620
Application 10/194,626

matter, as a series of activities, comprises a process that is statutory under 35 U.S.C. § 101 (App. Br. 9-10).

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. As pointed out by the Examiner, portal server 226 is clearly shown in Appellants’ Figure 2 as part of article 254 that is described in Appellants’ Specification as “an article 254 comprising a machine-accessible medium having associated data . . .” (Ans. 15; *see also* Spec. 13, ll. 26-27). Therefore, we find the evidence of record supports the Examiner’s position that the claimed portal server shown in Appellants’ Figure 2 is not limited to hardware embodiments, but also broadly encompasses software embodiments. On this record, we conclude that Appellants have not met the burden of showing that the Examiner erred regarding claims 1 and 3-6. Because Appellants have not presented arguments specifically addressing the limitations of associated dependent claims 2 and 7, we conclude that Appellants have not met the burden of showing that the Examiner erred regarding these claims. Regarding claims 2 and 7, arguments that Appellants could have made but chose not to make in the Briefs are deemed to have been waived. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004).

Regarding independent claim 8, we decline to construe the “service management apparatus” as being limited to hardware because it appears to

Appeal 2008-0620
Application 10/194,626

include only software components, as claimed. See our discussion of claim 1 *supra*. On this record, we conclude that Appellants have not met the burden of showing that the Examiner erred regarding independent claim 8 and associated dependent claims 9-12.

Regarding claims 13-18, these claims recite a method for performing tasks or activities without integrating a machine (e.g., a computer), or constituting a process of manufacture, or an alteration or transformation of physical subject matter. Therefore, the nature of the subject matter claimed may be broadly but reasonably considered to be a mental process since the claims do not recite a tangible embodiment. Because these claims on appeal are not tied to a machine or other statutory subject class, we conclude that Appellants have not shown error in the Examiner's rejection under 35 U.S.C. § 101. *See In re Comiskey*, 499 F.3d 1365, 1376 (Fed. Cir. 2007).

Regarding claims 19-24, see our discussion above.

For at least the aforementioned reasons, we sustain the Examiner's rejection of claims 1-24 under 35 U.S.C. § 101.

PRINCIPLES OF LAW - Anticipation

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).

Independent claims 1, 8, 13, and 19

Regarding the anticipation rejection of independent claims 1, 8, 13, and 19, Appellants contend that three limitations (L1-L3) are not disclosed by Nielsen, as follows:

Nielsen describes a system for monitoring changes to web site content, not, for example, [L1] "a portal server to . . . receive access to service objects comprising instantiated schema constructs exposed by the SOM" and a [L2] "domain information provider to . . . instantiate the service objects upon activation of at least one service associated with the service objects" as claimed by the Appellant. Similarly, Nielsen does not describe [L3] "exposing at least one subscribed service object comprising an instantiated schema construct and associated with the subscribed service to a portal server" as claimed by the Appellant.
(App. Br. 11). (Emphasis added).

We note that limitations L1 and L2 are recited in independent claims 1 and 8 and limitation L3 is recited in independent claims 13 and 19. However, when we look to Appellants' supporting argument that follows, Appellants merely cite to portions of the Specification that are shown as indented paragraphs on page 11 of the principal Brief. In the Reply Brief, Appellants restate the same portions of the Specification (Reply Br. 3). We decline to read these limitations from the Specification into the claims. *See E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003). (Limitations appearing in the Specification but not recited in the claim are not read into the claim.).

Claim Construction

During prosecution, “the 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)).

Regarding Appellants’ contention that Nielsen’s tables (Figs. 10A-10C) fail to describe objects or instantiation of objects, we broadly but reasonably construe “objects” as comprising data and associated operations where instantiation occurs at the moment when memory space is allocated (*see* App. Br. 12, ¶2). After considering the record before us, we conclude that Appellants’ objects that are described in the Specification as “modules constituting a service to a customer” are not limited to “objects” as that term is used in object-oriented programming environments (*see* Spec. 5, 1.14).

Our broad but reasonable construction is clearly supported by the portion of Appellants’ Specification that expressly states that programs can be alternatively structured in a procedure-orientated format using a procedural (i.e., non object-oriented) language, as follows:

One of ordinary skill in the art will further understand the various programming languages which may be employed to create one or more software programs designed to implement and perform the methods disclosed herein. The programs can be structured in an object-orientated format using an object-oriented language such as Java, Smalltalk, or C++.

Alternatively, the programs can be structured in a procedure-orientated format using a procedural language, such as COBOL or C . . . However, as will be appreciated by one of ordinary skill in the art upon reading this disclosure, the

teachings of various embodiments of the present invention are *not limited to any particular programming language or environment . . .*
(Spec. 12, l. 22 through 13, l. 3, emphasis added).

Because the scope of Appellants' claims is clearly not limited to object-oriented environments, we find Appellants' argument unpersuasive that Nielsen's tables (Figs. 10A-10C) do not teach objects or instantiation of objects (*see* App. Br. 12, ¶2). To the contrary, we find Nielsen's tables are modules constituting a service to the customer (i.e., user) comprising data and associated operations where instantiation occurs at the moment when memory space for each table is allocated. *See also TiVo, Inc. v. EchoStar Communications Corp.*, 516 F.3d 1290, 1307 (Fed. Cir. 2008) (Software claims in patent on technology that enabled television users to "time-shift" television signals were not limited to embodiments employing object-oriented programming on the basis that "neither the written description nor the claims anywhere state or imply that the invention must use object-oriented programming . . .").

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 of independent claims 1, 8, 13, and 19 as being anticipated by Nielsen. Therefore, we sustain the Examiner's rejection of these claims as being anticipated by Nielsen.

Appeal 2008-0620
Application 10/194,626

Dependent claims 2-7, 9-12, 14-18, 20-22, and 24.

Appellants have not presented any substantive arguments directed separately to the patentability of dependent claims 2-7, 9-12, 14-18, 20-22, and 24. Therefore, we sustain the Examiner's rejection of these claims as being anticipated by Nielsen for the same reasons discussed *supra* regarding independent claims 1, 8, 13, and 19, respectively. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

Dependent claim 23

Regarding the Examiner's rejection of dependent claim 23 under 35 U.S.C. § 103(a), Appellants contend that limitation L3 (i.e., "exposing at least one subscribed service object comprising an instantiated schema construct and associated with the subscribed service to a portal server") as claimed by independent claim 19 (from which claim 23 depends) is not taught or suggested by Nielsen (App. Br. 13; *see also* claim 23).

In response, we have fully addressed limitation L3 regarding independent claim 19 above. Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of dependent claim 23 as being unpatentable over Nielsen for the same reasons discussed *supra* regarding independent claim 19.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not met their burden of showing that the Examiner erred in

Appeal 2008-0620
Application 10/194,626

rejecting claims 1-24 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 1-22 and 24 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 claim 23 under 35 U.S.C. § 103(a) for obviousness.

DECISION

We affirm the Examiner's decision rejecting claims 1-24 under 35 U.S.C. § 101 as being directed to non statutory subject matter.

We affirm the Examiner's decision rejecting claims 1-22 and 24 under 35 U.S.C. § 102(b) for anticipation.

We affirm the Examiner's decision rejecting claim 23 under 35 U.S.C. § 103(a) for obviousness.

Appeal 2008-0620
Application 10/194,626

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

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