

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS FIEDLER and JUERGEN REMMEL

Appeal 2008-1683
Application 10/746,963
Technology Center 2100

Decided: September 30, 2008

Before JAMES D. THOMAS, JOSEPH L. DIXON,
And ST. JOHN COUNTENAY III, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 24. We have jurisdiction under 35 U.S.C. § 6(b).

As best representative of the disclosed and claimed invention, independent claim 1 is reproduced below:

1. A method comprising:

generating a first application by providing a definition of an object representing a first set of attributes of a first collection of data elements and a first set of operations on the first collection, each data element in the first collection having the attributes and a list of the operations in common with other data elements from the first collection;

extending the definition of the object with a second definition, the second definition comprising a second set of attributes of the data elements or a list of second set of operations on the data elements;

receiving from the client a request to execute an operations from the first set of operations or the second set of operations on one or more data elements from the first collection, the request having input parameters;

checking the request against the definition and the second definition;

executing, with a first set of parameters, the operation on the one or more data elements of the first collection, the operation resulting in output parameters; and

sending a second set of parameters.

The following reference is relied on by the Examiner:

Harper US 5,717,925 Feb. 10, 1998

Claims 1 through 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Harper.

Rather than repeat the positions of the Appellants and the Examiner, we refer to the Brief and Reply Brief for Appellants' positions, and to the Answer for the Examiner's positions.

OPINION

We reverse the outstanding rejection under 35 U.S.C. § 102(b) because the subject matter encompassed by the claims on appeal must be reasonably understood without resort to speculation. Presently, speculation and conjecture must be utilized by us and by the artisan inasmuch as the claims on appeal do not adequately reflect what the disclosed invention is. Note *In re Steele*, 305 F.2d 859, 862 (CCPA 1962). Note also *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). There are several reasons for this reversal.

Because we conclude that there are significant ambiguities with respect to each independent claim 1 and 13, and therefore their respective dependent claims, we reject all claims on appeal, claims 1 through 24, under the second paragraph of 35 U.S.C. § 112, pursuant to our authority under 37 C.F.R. § 41.50(b)

At the outset, according to the Summary of the Invention at page 7 of the Brief, the initial third of this page appears to attempt to correlate the subject matter of the generating clause of representative independent claim 1 on appeal to the Specification as filed. Among the cited portions at pages 9 through 11 of the Specification as filed, there appears to be no basis for the feature of “generating a first application by providing a definition of an object representing a first set of attributes. . . .” According to the noted portion of the Specification, there appears to be no disclosed basis for the generating function per se among the noted teachings relied upon as a basis

for this feature claimed. There appears to be no device or disclosed element that performs a generating function per se, other than perhaps speculating that a human performs it alone.

In claim 1 on appeal, there is no antecedent bases for “the client.” The claim as a whole is so abstract in its recitation as to be indefinite. We cannot determine its metes and bounds since we can not ascertain the scope of the claim which comprises substantially only labels of data or descriptions of data including the term “attributes,” “data elements,” the various “collections,” and including input/output/first set/second set of “parameters.” The feature of sending a second set of parameters appears to be undefined and unclear as to their origin.

On the other hand, independent claim 13 has several recitations utilizing the word “to” such as to relate to future acts that may never occur. It is unclear what is meant by a server program that is configured “to” execute certain enumerated, “following” verbs. The mere recitation of the word “provide,” the word “extend”, etc. also appears to imply to the reader that those features relate to future acts that may never occur since the word “to” is merely implied. Claim 13 does not appear to be recited in the present tense.

The subject matter of the claims on appeal, for the most part, fails to exhibit a functional relationship with a substrate and therefore does not affect the manner in which the processes are performed. Although some labeled terms are used in the methodology, others are not. Non-functional descriptive material is treated as analogous to printed matter cases where what is printed on a substrate bears no functional relationship to the

substrate and is given no patentable weight. *See In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (“Where the printed matter is not functionally related to the substrate, printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight.”). *See also Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1003, *aff’d* Rule 36 Jun 12, 2006). The Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). *See also Ex parte Nehls*, <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071823.pdf> (BPAI Jan. 28, 2008); *Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 205) (nonprecedential)(191 Fed. Appx. 959 (Fed. Cir. 2006)).

The subject matter of independent claim 13 and its dependent claims through claim 24 essentially are hybrid claims which are directed to a system with apparatus recitations of two computers but essentially recite in the body of the claim a method corresponding to the subject matter of independent claim 1 on appeal. Dependent claim 24 even recites in its preamble the method of claim 13 instead of the system of claim 13. Note *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005).

Claims 1 through 24 are also rejected under 35 U.S.C. § 112, first paragraph, as being based upon a non-enabling disclosure. Based upon our initial remarks in the last rejection, there appears to be no disclosed basis of Appellants' contribution to the feature of "generating" a first application. Correspondingly, the mere "providing" to a client program an application in independent claim 13 falls in the same category. It appears that the application that is recited to be generated or otherwise provided already exists according to the disclosed invention. The same may be said of the "generation" of a second application as recited correspondingly in dependent claims 12 and 24 on appeal.

Lastly, we also reject claims 1 through 12 under 35 U.S.C. § 101 as being directed to programs or software concepts per se, and are therefore nonstatutory. The features of independent claim 1 do not require the use of a machine or otherwise recite a machine or computer implemented method, thus presenting a situation where a human being may perform the recited functionalities in the body of each claim. Even if it may be fairly stated that the claimed method may produce a concrete, useful, and tangible result, the result is still operations upon very abstract data constructs or data structures themselves, apparently by software elements or otherwise. There is no transformation of any underlying tangible subject matter to a different state or thing. Note the reasoning in *In re Comiskey*, 499 F.3d 1365, 1377-79 (Fed. Cir. 2007). These considerations flow through to the dependent claims 2 through 12 as well.

In summary, we have reversed the rejection of all claims on appeal under 35 U.S.C. § 102. Once properly definite claims are presented as a result of any subsequent prosecution in this application, the actual prior art applied by the Examiner in this appeal may also be appropriate should that arise. Additionally, any other prior art may be appropriate to apply as well. We have introduced three new grounds of rejection within 37 C.F.R. § 41.50(b). These include a rejection of all claims on appeal, claims 1 through 24, under the second paragraph of 35 U.S.C. § 112, as well as a separately stated rejection of these claims under the first paragraph of 35 U.S.C. § 112. Additionally, we have set forth a rejection of claims 1 through 12, under 35 U.S.C. § 101.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (2007). 37 C.F.R. § 41.50(b) provides "[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. . . .

Appeal 2008-1683
Application 10/746,963

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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