UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WEIJIA ZHANG and RICHARD BALL LANDAU

Appeal 2008-2067
Application 10/281,793
Technology Center 2100

Decided: November 6, 2008

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, 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.

THE INVENTION

Appellants' invention relates generally to the field of interfacing programs. More particularly, Appellants' invention is directed to a method and system for connecting a program to an application programming interface (Spec. 1).

Independent claim 1 is illustrative:

1. A system for translating between a user program layer and an application programming interface, the system comprising:

a user program function interface having plural functions callable by the user program layer;

a template text file having a map of relationships between the functions and application programming interface functions;

a function constructor interfaced with the user program function interface and the template text file, the function constructor operable to apply the template text file to a function called by the user program to construct a function formatted for the application programming interface;

a connector operable to communicate the formatted function to the application programming interface and to receive a response from the application programming interface;

translation rules operable to translate application programming interface output to a user program format; and

a parser interfaced with the connector and the user program function interface, the parser operable to apply the translation rules to the application programming interface response to translate the response to a user program format.

THE REFERENCES

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

Tuatini	US 2002/0035645 A1	Mar. 21, 2002
Jarossay	US 5,734,907	Mar. 31, 1998

EXTRINSIC EVIDENCE

The Examiner considers a Wikipedia description of an "application programming interface" (API) as extrinsic evidence in support of the rejections (Ans. 14).

THE REJECTIONS

1. Claims 1-3, 5, 6, 10-14, and 16-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tuatini.
2. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tuatini.
3. Claim 7-9, 15, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tuatini in view of Jarossay.

CONTENTIONS BY APPELLANTS

Appellants contend that the Examiner erred in rejecting independent claims 1, 13, and 18 as being anticipated by Tuatini because "Tuatini does not explicitly disclose an API [application programming interface], let [alone a] translation between an API and a user program." (App. Br. 3).

EXAMINER'S RESPONSE

Regarding the claimed application programming interface (API), the Examiner points to the broader description of an API on page 2, lines 16-18 of Appellants' Specification (Ans. 16). The Examiner states that it is the "action layer" disclosed by Tuatini that "interfaces with a service." (Ans. 17). The Examiner clarifies that Tuatini's "action layer" is the API, "rather than the service being the API" (Ans. 17, ¶3).

ISSUE(S)

We consider the issue of whether Appellants have shown that the Examiner erred in rejecting independent claims 1, 13, and 18 as being anticipated by Tuatini. More specifically, we consider the following question:

> Have Appellants shown that the Examiner erred in finding that the argued limitations of an application programming interface and translation between an application programming interface and a user program are disclosed by the Tuatini reference?

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). "Anticipation of a patent claim requires a finding that the claim at issue 'reads on' a prior art reference." *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d

1342, 1346 (Fed Cir. 1999) ("In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.") (internal citations omitted).

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)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

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). Therefore, we look to Appellants' Briefs to show error in the proffered prima facie case.

FINDINGS OF FACTS

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

The Tuatini reference

1. Tuatini discloses "[a]n application includes action handlers and view handlers. The action handlers implement the business logic of the application, and the view handlers control the formatting of the results returned by the business logic" (para. [0043]).

2. Tuatini discloses "[i]n one embodiment, the action layer includes an action handler for each action that is serviced by the application (para. [0050]).
3. Tuatini discloses "[t]he action layer inputs a request message in the normalized format, performs its business logic, and outputs a response message in the normalized format" (para. [0049]).
4. Tuatini discloses "[t]he view layer 405 is responsible for converting the response message from the normalized format to the client format 408" (para. [0049]).

GROUPING OF CLAIMS

Claims 1-20

Based on the arguments presented in Appellants' Briefs, we decide the appeal of claims 1-20 on the basis of claim 1 alone. We note that Appellants present the same arguments directed to each of independent claims 1, 13, and 18, in the Briefs. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ANALYSIS

Issue

We decide the question of whether Appellants have shown that the Examiner erred in finding that the argued limitations of an application programming interface and translation between an application programming interface and a user program are disclosed by the Tuatini reference.

Claim Construction

We begin our analysis by broadly but reasonably construing the claimed "application programming interface" in light of Appellants' Specification. *See In re Bigio* at 1324. We note that Appellants specifically argue in the principal Brief that "[t]he Examiner's reasoning is contradicted by Applicant's background" Appellants specifically refer to the Specification at page 2, lines 16-18 (App. Br. 3, ¶3). For convenience, we reproduce this portion of the Specification here:

> Application programming interfaces basically convert data from one compiled version to another but generally lack any active or programmable component that changes procedures applied to data.

(Spec. 2, ll. 16-18).

However, as pointed out by the Examiner (Ans. 15), Appellants' Specification supports a broader construction of the term application programming interface, as follows:

> The application programming interface then typically acts as interpretive layer that *mediates* between the *user program* and the *defined application* by ensuring that data shared between the user program and defined application is *consistent*.

(Spec. 2, ll. 10-13, emphasis added by the Examiner).

When we further look to Appellants' Specification for *context*, we note that Appellants broadly define an application programming interface as a suite of routines that aid in the development of compatible applications, as follows:

> To aid in the development of compatible applications, application programming interfaces (API) and application servers are typically defined to provide a suite of routines and protocols for linking software components together.

(Spec. 2, ll. 5-7).

As a matter of claim construction, we decline to consider the extrinsic evidence offered by the Examiner (Wikipedia, Ans. 14), and we are not permitted to read limitations from the Specification into the claims. *See In re Van Geuns* at 1184. Consistent with Appellants' disclosure, we broadly but reasonably construe the claim term "application programming interface" as a set or suite of routines (i.e., functions) that may be called by an application (i.e., user program) to provide services (i.e., output) that have been requested by the application.

We note that the Examiner has read the claimed application programming interface on Tuatini's "Action Layer 400" (Tuatini, Fig. 4, para. [0049]; *see also* Ans. 17, ¶3). Tuatini discloses that the action layer inputs a request message, performs its business logic, and outputs a response message (FF 1). Tuatini further discloses an embodiment where the action layer includes an action handler (i.e., routine or function) for each action that is serviced by the application (FF 2). Therefore, we find that Tuatini's "action layer" comprises a set of routines (i.e., action handler functions) that are called by an application (i.e., client or user program) to provide services (i.e., output) that have been requested by the application. Given the aforementioned claim construction, we find no error with the Examiner's determination that Tuatini's Action Layer 400 is an application programming interface, as claimed.

Regarding the argued translation between an application programming interface and a user program, we note that Tuatini discloses "[t]he action layer inputs a request message in the normalized format, performs its business logic, and outputs a response message in the normalized format." (para. [0049]) (FF 3). Tuatini further discloses that "[t]he view layer 405 is responsible for converting the response message from the normalized format to the client format 408" (para. [0049]) (FF 4). Therefore, we find that Tuatinis's view layer 405 performs a format conversion (i.e., a translation) of the response message where the response message is output from Tuatini's Action Layer 400, which is an application programming interface, as discussed above. We note that in the rejection at the top of page 5 of the Answer, the Examiner has relied on Tuatini's response that is formatted (i.e., translated).

Regarding the Reply Brief, we note that Appellants' argument that "[n]othing in Tuatini indicates that the support occurs at a source code level" is not directed to claimed subject matter (*see* Reply Br. 2, ¶1). As discussed *supra*, we have not considered the Wikipedia extrinsic evidence proffered by the Examiner (*see* Ans. 14). After considering the record before us, we find the weight of the evidence supports the Examiner's anticipation rejection regarding the specific limitations argued by Appellants in the Briefs.

For at least the aforementioned reasons, we find that Tuatini discloses an application programming interface and translation between an application programming interface and a user program. Therefore, we find Tuatini meets the argued limitations of representative claim 1 and also the equivalent limitations recited in each of independent claims 13 and 18.

Only those arguments actually made by Appellants have been considered in this decision. With respect to all claims before us on appeal, arguments which Appellants could have made but chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004).

Because we find that Appellants have not met the burden of showing error in the Examiner's prima facie case of anticipation, we sustain the Examiner's rejection of representative claim 1 (and claims 2-3, 5, 6, 10-14, and 16-19, that fall therewith) as being anticipated by Tuatini. Because Appellants do not argue the dependent claims separately, we also sustain the Examiner's rejection of claim 4 as being unpatentable over Tuatini, and the rejection of claims 7-9, 15, and 20, as being unpatentable over Tuatini in view of Jarossay.

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 rejecting claims 1-3, 5, 6, 10-14, and 16-19, as being anticipated by Tuatini under 35 U.S.C. § 102(e).

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 rejecting claim 4 as being unpatentable over Tuatini under 35 U.S.C. § 103(a).

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 rejecting claims 7-9, 15, and 20 as being unpatentable over Tuatini in view of Jarossay under 35 U.S.C. § 103(a).

Therefore, claims 1-20 are not patentable.

DECISION

We affirm the Examiner's decision rejecting claims 1-20.

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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