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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN CHARLES COPE

Appeal 2010-010698
Application 12/035,584
Technology Center 2400

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III,
and CARLA M. KRIVAK, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1, 3, 8-11, 13, 16, and 17. Claims 2, 4-7, 12, 14, and 15 have been cancelled. (App. Br. 2). We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

STATEMENT OF THE CASE

Appellant's claimed invention is directed to "methods, apparatus and computer programs for enabling tracking of a user's sequence of Web Browser requests when navigating within a single Web site." (Abstract).

Independent claim 13 is representative of the subject matter on appeal:

13. A method for tracking a plurality of Web Browser requests for access to resources within a particular Web site, the requests having been sent from a Web Browser to a Web server for accessing resources within the Web site and then having been redirected to a request tracker separate from the Web server, the method implemented by the requests tracker comprising:

determining a session identifier,

logging the request together with the session identifier, and

redirecting the request back to the Web server for processing,

said determining, logging and redirecting steps being performed externally to the Web server and the Web Browser.

REJECTIONS

The Examiner rejected claim 1 under 35 U.S.C. § 101 on the ground of statutory double patenting based upon claim 1 of Cope (US 7,346,703 B2).

The Examiner rejected claims 13, 16, and 17 under 35 U.S.C. § 102(b) as being anticipated by Dustan (US 5,884,312).

The Examiner rejected claims 1 and 8-11 under 35 U.S.C. § 103 based upon the combined teachings and suggestions of Pandya (US 6,671,724 B1) and Dustan.

The Examiner rejected claim 3 under 35 U.S.C. § 103 based upon the combined teachings and suggestions of Dustan, Pandya, and Pogue (US 6,112,240).

ANALYSIS

Statutory Double Patenting Rejection of Claim 1

At the outset we observe that the assignee of record of the cited Cope '703 patent and the real party in interest of the instant application on appeal are the same: International Business Machines Corporation. The Cope '703 patent and the application on appeal and also share the same inventive entity: Inventor Brian Charles Cope, a resident of Great Britain.

In a statutory double patenting rejection under 35 U.S.C. § 101, the issue is whether the *same* invention is being claimed twice. The “same invention” means *identical* subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186, 197 (1894). As expressed by the court in *In re Vogel*, 422 F.2d 438, 441 (CCPA 1970), “[a] good test, and probably the only objective test, for ‘same invention,’ is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention.”

We agree with Appellant (referring to the claim chart provided on pages 6-7 of the principal Brief):

Referring to the underlined portion of the above chart, for claim 1 of the '703 Patent to be literally infringed, these (underlined) limitations would necessarily be present. However, if these limitations are not present, claim 1 of the '703 Patent would not be literally infringed, yet claim 1 of the present application would be literally infringed. Thus, there exists a claim in the present application that can be literally infringed without literally infringing a corresponding claim in the '073 Patent. Therefore, as guided by the above-reproduced test, a

rejection of claim 1 of the present application for double patenting based upon claim 1 of the '703 Patent is not proper.

(App. Br. 7-8).

See also MPEP §804(II)(A) (“A reliable test for double patenting under 35 U.S.C. [§]101 is whether a claim in the *application* could be literally infringed without literally infringing a corresponding claim in the *patent*.”) (Emphasis added).

Because the broader scope of claim 1 of the present application on appeal could be literally infringed without infringing the narrower scope of claim 1 of the '703 patent (which recites several limitations that are the *same* as application claim 1, and also several *additional* limitations that are *not recited* in application claim 1), we reverse the Examiner’s statutory double patenting rejection under 35 U.S.C. § 101 of application claim 1 over claim 1 of Cope.

Anticipation Rejection of claims 13, 16, and 17

Based on Appellant’s arguments, we decide the appeal of the anticipation rejection of claims 13, 16, and 17 on the basis of representative claim 13. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Issue: Under § 102, did the Examiner err in finding that Dustan discloses the disputed limitation of “redirecting the request back to the Web server for processing,” within the meaning of representative claim 13?

Appellant’s position, as articulated on page 9, line 7 through page 13, line 3 of the principal Brief, is that Dustan fails to either explicitly or inherently teach this redirecting limitation. In the Reply Brief, Appellant summarizes the objections to the Examiner’s finding of anticipation:

First, the alleged request (i.e., "an account number and password which is encrypted") has already been presented to the web server 20. Since Dustan fails to teach that this request is deleted within the web server 20 prior to sending the request to the database server 22, it is not necessary to send the request back to the database server 22 because the request already resides within the web server 20.

Second, Dustan explicitly refers to returning control back to the logon script 110 (which is within the web server 20). The Examiner has produced no substantial evidence to support a finding that the alleged request (i.e., "an account number and password which is encrypted") needs to be sent back to the logon script in order for control to be returned back to the logon script 110. One can easily envision a functional data structure, different than the request, that is sent back to the logon script 110 by which control is returned back to the logon script 110.

(Reply Brief 6-7).

At the outset, we observe that claim 13, is directed to “[a] method for tracking a *plurality* of Web Browser *requests* . . . the *requests* having been sent from a Web Browser to a Web server for accessing resources within the Web site and then having been redirected to a request tracker separate from the Web server” We observe that when the “*plurality* of Web browser *requests*” is later referenced in claim 13 (“logging *the* request . . . , and redirecting *the* request”) the language of the claim is imprecise as to which *particular* request of the *plurality* of *requests* is being logged and redirected.

Turning to the Dustan reference, we find at least the portion of column 14 referred to by the Examiner (Ans. 18) describes the invention as claimed:

For example, when a user initially logs on, web server program 68 initiates logon script 110 which prompts the user to

enter an account number and a password. Once this information is received at web server program 68, logon script 110 accesses database management system 88 and provides the corresponding account number and password. Logon script 110 instructs database management system 88 to execute a logon stored procedure 120 to assist with the logon process. Logon stored procedure 120, under the control of database management system 88, accesses a user table 132 and verifies the provided account number and password. Also, log on stored procedure 120 accesses an activity log table 134 and *generates a record reflecting the logon event*. If the account number and password are verified, *control returns to logon script 110*. Logon script 110 may then generate a main menu of the brokerage application and provide it to the client as a web page.

(Dustan, col. 14, ll. 51-67).

Referring to the aforementioned (col. 14) description of Dustan's Figure 3, we find a session identifier is determined (the user account number¹ is verified by logon stored procedure 120 using activity log table 134 depicted within database server 104; Dustan, col. 14, l. 61), the request is logged with the session identifier ("generates a record reflecting the logon event"; Dustan, col. 14, ll. 63-64, as performed by activity log table 134 which is also depicted within database server 104), and the request is *redirected to the web server for processing* ("If the account number and password are verified, *control returns to logon script 110*"; Dustan col. 14, ll. 64-65, where logon script 110 is depicted as being part of web server 102). Thus, we find the recited *determining, logging, and (disputed)*

¹ Cf. Appellant's Specification, p. 11, ll. 6-9: "The logging process logs the request details together with a session identifier (which may be an explicit session identifier or an *identifier* of the client system or *end user*)" (Emphasis added).

redirecting steps are performed *externally* to web server 102 and the web browser (Dustan, Fig. 3, web browser client).

Notwithstanding Appellant's arguments, on this record, we find the weight of the evidence supports the Examiner's finding of anticipation. Therefore, we sustain the anticipation rejection of representative claim 13. Claims 16 and 17 (not separately argued) fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Claims 1 and 8-11 rejected under §103

Based on Appellant's arguments, we decide the appeal of the obviousness rejection of claims 1 and 8-11 on the basis of representative claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Regarding claim 1, Appellant contends:

Similar to claim 13, independent claim 1 recites forwarding the request back to the Web server for processing. To teach these particular limitations, the Examiner relied upon Dustan. However, as noted above, Dustan fails to teach this particular limitation. Therefore, the Examiner has mischaracterized the scope and content of the applied prior art. For above-described reasons, the Examiner has failed to establish that the claimed invention, as recited in claims 1 and 8-11 would have been obvious within the meaning of 35 U.S.C. § 103. Applicant, therefore, maintains that the Examiner has failed to establish that the claimed invention, as recited in claims 1 and 8-11, would have been obvious, within the meaning of 35 U.S.C. § 103, based upon the combination of Pandya and Dustan.

(App. Br. 13).

Because we find no deficiencies with Dustan, we sustain the Examiner's obviousness rejection of representative claim 1 for the same

reasons discussed above regarding claim 13. Claims 8-11 (not separately argued) fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Dependent Claim 3 rejected under §103

Appellant contends:

Claim 3 depends from independent claim 1, and Appellant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness based upon Pandya and Dustan. The tertiary reference to Pogue does not cure the argued deficiencies of Pandya and Dustan. Accordingly, even if one having ordinary skill in the art were motivated to modify Pandya in view of Dustan and Pogue, the proposed combination of references would not yield the claimed invention. Appellant, therefore, respectfully submits that the imposed rejection of claim 3 under 35 U.S.C. § 103 for obviousness based upon Pandya in view of Dustan and Pogue is not viable. (App. Br. 14).

Because we find no deficiencies with the base combination of Dustan and Pandya (*see* discussion above), we sustain the Examiner's obviousness rejection of dependent claim 3 for the same reasons discussed above regarding claim 13.

DECISION

We reverse the Examiner's rejection under §101 of claim 1 on the ground of statutory double patenting.

We affirm the Examiner's rejection under § 102 of claims 13, 16, and 17.

We affirm the Examiner's rejections under § 103 of claims 1, 3, and 8-11.

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Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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).

ORDER
AFFIRMED

pgc