UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARKUS A. PETER, SHABANA ANSARI.
PETER EBERLEIN, and MARKUS SCHMIDT-KARACA

Appeal 2012-001144
Application 11/540,470
Technology Center 2100

Before JEAN R. HOMERE, JOHNNY A. KUMAR, and
DANIEL N. FISHMAN, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) of the final rejection of claims 1–23.[1] We have jurisdiction under 35 U.S.C. § 6(b). We reverse and enter a new ground for rejection pursuant our authority under 37 C.F.R. § 41.50(b).

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[1] In this Opinion, we refer to the Appeal Brief ("Br.," filed March 31, 2011), the Examiner's Answer ("Ans.," mailed July 13, 2011), and the original Specification ("Spec.," filed September 29, 2006).

STATEMENT OF THE CASE

THE INVENTION

Appellants' invention relates to attachment-based mass data input and output for a distributed application system. Spec. Abstract.

Claim 1, reproduced below, is illustrative:

> 1. An article comprising a machine-readable storage medium storing instructions for interactive, attachment-based data management, the instructions operable to cause one or more computers to:
>
> receive a request from a logically remote client via a network interface, the request indicating a data file and a business object associated with a business application, the business object comprising at least one object attribute, the business object separate and distinct from the data file;
>
> update the business object with a message in a format associated with the business application based on the data file, the message referencing a logical location of the data file;
>
> map at least a portion of the data file to at least one keyword associated with the business object;
>
> identify, based on the mapped portion of the data file, a handler object communicably coupled to an integration middleware logically situated between the business application and a remote repository;
>
> store the data file in the remote repository; and
>
> update a dependent object associated with the business object with a logical location of the data file in the remote repository.

THE REJECTIONS

Claims 1 and 15 are rejected under 35 U.S.C. § 102(e) as anticipated by Schneider (US 2006/0053195 A1).

Claim 12 is rejected under 35 U.S.C. § 103(a) as unpatentable over Schneider and Tortolani (US 6,317,750 B1).

Claims 2, 3, 6, 7, 8, 9, 16, 17, and 20–22 are rejected under 35 U.S.C. § 103(a) as unpatentable over Schneider and Sastri (US 2003/0037061 A1).

Claims 13 and 14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Schneider, Tortolani, and Sastri.

Claims 4, 5, 18, and 19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Schneider, Sastri, and Cabrera (US 2005/0203949 A1).

Claims 10, 11, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schneider and Cabrera.

THE ANTICIPATION REJECTION

ISSUE

Appellants' arguments present the following dispositive issue: Has the Examiner erred by finding Schneider teaches, explicitly or inherently, every element in independent claims 1 and 15?

ANALYSIS

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). "These elements must be arranged as in the claim under review, but this is not an 'ipsissimis verbis' test." *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990) (citations omitted). Appellants argue Schneider fails to teach several limitations recited in independent claims 1 and 15. *See* Br. 12–19.

Independent claim 1 recites a number of complex details and relationships between elements and thus, we summarize the salient features of claim 1 as follows. Claim 1 includes receipt of a request indicating a business object and an associated data file. The business object and data file are separate and distinct from one another and the business object is updated with a message that references a logical location of the data file. A portion of the data file is mapped to a keyword associated with the business object and the mapped portion is stored in a remote repository by a handler object that is identified by the mapped portion. A dependent object is associated with the business object and is updated with the location of the data file (the mapper portion) in the remote repository.

Although Schneider clearly involves objects (e.g., collaboration objects, *see* ¶¶ 93, 94) and data files (*see, e.g.*, Abstract), we agree with Appellants that the Examiner's "allegations made in the Final Action that various components of *Schneider's* system <u>do</u> teach or suggest the features of claims 1 and 15 fail to show that such components have the specific relationships as those features recited in the claims." Br. 13. For example, the Examiner finds Schneider teaches receipt of a request from a client. Ans. 5 (citing ¶ 60); *see also* Ans. 19–20 (citing ¶¶ 17 and 60). The Examiner then finds Schneider teaches the request indicating a data file and a business object associated with a business application, the business object comprising at least one object attribute, the business object separate and distinct from the data file. Ans. 5–6 (citing ¶¶ 258 and 266). Appellants argue, "[t]here is no **tie or reference** to *Schneider's* activity plan [(¶ 258)] and/or workflow [(¶ 266)] in the discussion of requests [(¶ 60)]. In short, there has been no showing in the Final Action that *Schneider's* activity plan

and/or workflow are received as a request from a logically remote client." Br. 14. We agree with Appellants. The Examiner's findings fail to explain how the login or access request (Schneider ¶ 60) in any way indicates a business plan and data file that the Examiner reads on Schneider's workflow or activity plan (Schneider ¶¶ 258, 266) as recited in claim 1.

Further, claim 1 recites "update the business object with a message in a format associated with the business application based on the data file, the message referencing a logical location of the data file." The Examiner finds Schneider paragraphs 73 and 94 teach this feature. Ans. 5–6. The Examiner further explains the business object now reads on a collaboration object—apparently referring to Schneider paragraph 94 defining a collaboration object as "any object that coordinates, facilitates or tracks actions o [sic] the participants" (Ans. 19)—and reads the recited data file as "any type of data file" (*id*., citing Schneider ¶ 86). Initially, we question how this reading of "business object" as a "collaboration object" relates to the prior reading of a business object as reading on an activity plan (Schneider ¶ 258) or workflow (Schneider ¶ 266). Although the Examiner may be implying activity plans and workflows are examples of collaboration objects, and hence examples of business objects, such an implication calls for us to speculate as to the Examiner's intent. Furthermore, although Schneider paragraph 86 discloses "place data files," the Examiner does not explain how such data files are related to business objects as now read on Schneider's collaboration objects.

The Examiner further explains Schneider paragraphs 93–99 disclose updating a data file and sending a message to other users to indicate the change. *Id*. The Examiner then contends, "[t]he business object is seen as the collaboration object. So the status of the data file (collaboration object)

is changed with a message." *Id.* Thus, the Examiner appears to read the updating of a data file as equivalent to updating of a business object although the claim clearly requires the data file and business object are separate and distinct elements.

Appellants argue nothing in the messaging features of Schneider (¶¶ 93–99) discloses changing or updating any object or reference to a logical location of a separate and distinct data file as required by claim 1. Br. 15. We agree. The Examiner bears the initial burden of presenting a prima facie case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). A prima facie case is established when the party with the burden of proof points to evidence that is sufficient, if uncontroverted, to entitle it to prevail as a matter of law. *See Saab Cars USA, Inc. v. United States*, 434 F.3d 1359, 1369 (Fed. Cir. 2006). Here, that burden has not been met in a manner enabling proper review. For us to sustain the Examiner's rejection, we would need to resort to impermissible speculation or unfounded assumptions or rationales to cure the deficiencies in the factual bases of the rejection before us. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

On the record before us, the Examiner's analysis is not sufficient without further explanation. Accordingly, we agree with Appellants that the Examiner erred by finding Schneider teaches, explicitly or inherently, every element in independent claim 1. Independent claim 15 is rejected for the same reasons (Ans. 5), and Appellants present essentially the same arguments (Br. 18–20). Thus, for the same reasons as claim 1, we are persuaded the Examiner erred in rejecting claim 15.

THE OBVIOUSNESS REJECTIONS

Claims 2–11 depend from claim 1. Claims 16–23 depend from claim 15. Claims 2–11 and 16–23 are rejected over Schneider in combination with other references. The other references are not relied upon by the Examiner to cure the above-identified deficiencies of Schneider and thus, for similar reasons as claims 1 and 15 discussed above, we are persuaded the Examiner erred in rejecting claims 2–11 and 16–23.

Independent claim 12 includes similar recitations to claims 1 and 15 and is rejected over Schneider and Tortolani. The Examiner does not rely on Tortolani to cure any of the above-identified deficiencies in Schneider and thus, for essentially the same reasons as claims 1 and 15, we are persuaded of error in the rejection of independent claim 12 and claims 13 and 14, dependent from claim 12.

NEW GROUNDS OF REJECTION UNDER 37 C.F.R. § 41.50(b)

CLAIMS 1–14 REJECTED UNDER § 101

Transitory signals are unpatentable as non-statutory subject matter under § 101. *See In re Nuijten*, 500 F.3d 1346, 1356–57 (Fed. Cir. 2007). Consistent with U.S. Patent & Trademark Office policy, "[t]he broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent." *See* U.S. Patent & Trademark Office, *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010)

(hereinafter, *Subject Matter Eligibility of Computer Readable Media*); *see also Ex parte Mewherter*, 2013 WL 4477509 (PTAB May 8, 2013) (precedential).

Claims 1 and 12 recite a "machine-readable storage medium." Appellants' Specification is silent as regards defining "machine-readable storage medium." Accordingly, the broadest reasonable construction of "machine-readable storage medium" encompasses a transitory, propagating signal and, therefore, claims 1 and 12 are directed towards non-statutory subject matter and are rejected under 35 U.S.C. § 101. Claims 2–11 depend from claim 1. Claims 13 and 14 depend from claim 12. Thus, claims 2–11, 13, and 14 are rejected for the same reason.

DECISION

For the reasons discussed above, the rejections of claims 1–23 are reversed.

We enter a new ground of rejection for claims 1–14 under 35 U.S.C. § 101.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that "[a] new ground of rejection . . . shall not be considered final for judicial review."

Section 41.50(b) also provides that Appellants, 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.

37 C.F.R. § 41.50(b).

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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