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EXAMINER

SCOTT, RANDY A

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAUL F. MCMAHAN, CHRISTOPHER J. SCHAUBACH, and
ROBERT T. UTHE¹

Appeal 2012-008911
Application 11/307,838
Technology Center 2400

Before: MURRIEL E. CRAWFORD, ANTON W. FETTING, and
MICHAEL W. KIM, *Administrative Patent Judges.*

KIM, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1, 3–7, 9, 10, 12, 15, 16, and 18–20. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6.

The invention relates generally to a form multiplexer for a portal environment and method and system for handling or managing submission of inputs from multiple portlets of a portal page. Spec. ¶ 1.

¹ Appellants assert that the real party in interest is International Business Machines (IBM) Corporation. App. Br. 1.

Independent claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. A method to manage inputs from multiple portlets of a portal page, comprising:

gathering any inputs, by a computer, from forms associated with portlets other than a form associated with a portlet that is being submitted by the computer; and

appending each gathered input to the form being submitted by the computer with an identifier of the form to which the gathered input belongs, the identifier comprising a unique key,

wherein the unique key is registered with a form multiplexer by each portlet in response to each portlet being created and wherein gathering any inputs and appending each gathered input to the form being submitted is performed by computer usable program code associated with the form being submitted.

Claims 16 and 18–20 are rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter.

Claims 1, 3, 10, and 16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Facemire (US 2006/0225091 A1, pub. Oct. 5, 2006) in view of Tomasic (US 2006/0235690 A1, pub. Oct. 19, 2006) and Burns (US 2004/0107404 A1, pub. June 3, 2004).

Claim 4 is rejected under 35 U.S.C. § 103(a) as unpatentable over Facemire in view of Tomasic, Burns, and Notarius (US 2002/0123957 A1, pub. Sep. 5, 2002).

Claims 5–7, 12, 18, and 19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Facemire in view of Tomasic, Burns, and Timmons (US 2005/0050021 A1, pub. Mar. 3, 2005).

Claims 9 and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Facemire in view of Tomasic, Burns, and Braun (US 2007/0156871 A1, pub. July 5, 2007).

Claim 15 is rejected under 35 U.S.C. § 103(a) as unpatentable over Facemire in view of Tomasic, Burns, and Secrist (US 2005/0166188 A1, pub. July 28, 2005).

We AFFIRM-IN-PART.

ANALYSIS

Non-Statutory Subject Matter Rejection of Claims 16 and 18–20

We are not persuaded the Examiner erred in asserting that claims 16 and 18–20 are directed impermissibly to non-statutory subject matter. App. Br. 6; Reply Br. 2–3. Appellants assert that independent claim 16 recites a computer usable storage medium, whereas paragraphs 12 and 13 of the Specification only refer to a “computer usable or computer readable medium.” Accordingly, Appellants appear to be asserting that whatever ambiguity concerning the nature of the medium may exist in the cited portions of the Specification are abrogated by the addition of the word “storage,” which clearly brings the subject matter of claims 16 and 18–20 into the realm of statutory subject matter. We disagree. As an initial matter, we are unpersuaded that there is a substantive difference between the recited “computer usable storage medium” and the “computer usable or computer readable medium” set forth in the cited portions of the Specification, for we are unclear as to how a medium is usable or readable by computer if it is not capable of storage. Given this, the cited portions of the Specification inject ambiguity as to the metes and bounds of “computer usable storage medium” that persuades us the Examiner’s assertions are correct. For example, the

Specification discloses “an entirely software embodiment,” which would encompass non-statutory signals. Furthermore, the Specification discloses that the medium could be “paper,” and that the disclosed list of media is “non-exhaustive,” which we are persuaded would lead one of ordinary skill to believe that the recited medium is extremely broad, and thus may encompass non-statutory signals.

Appellants further cite *Ex parte Bash* and *Ex parte Hu* in support of their positions. We note that those two cases are non-precedential Board decisions, and that they have fact patterns and procedural postures that differ from those set forth in the instant proceeding.

Obviousness Rejection of Claims 1, 3, 10, and 16

We are persuaded the Examiner erred in asserting that a combination of Facemire, Tomasic, and Burns discloses or suggests “appending each gathered input to the form being submitted by the computer with an identifier of the form to which the gathered input belongs,” as recited in independent claim 1. App. Br. 7–10; Reply Br. 3–5. Independent claims 10 and 16 recite similar corresponding limitations.

As an initial matter, we note that independent claim 1 recites two forms: (1) a form being submitted by the computer and (2) other forms from which input is gathered. Given this, we construe the aforementioned limitations as requiring two distinct items to be appended to the form being submitted by the computer: (1) “gathered input” from other forms and (2) “an identifier of the form to which the gathered input belongs,” where “the form” is the “other forms.”

The Examiner cites paragraphs 29, 34–36, 43, and 116 of Tomasic as corresponding to the aforementioned claim limitations. Ans. 5–6, 14–15.

The aforementioned portions of Tomasic disclose receiving input data from user 102, for example, from an e-mail, an instant message (IM), a pager message, a message recorded on a phone, a web page, a hyperlink, a short message service (SMS) message, a document, a publishing syndication field, a blog, a speech-to-text generated message, and/or any other form of communication. Tomasic ¶ 32. Tomasic then discloses analyzing the input data and selecting a form responsive to the request represented by the input data from user 102. Tomasic ¶ 34. The list of forms from which the form is selected may be indexed. Tomasic ¶ 43. The form may then be filled with information responsive to the input data. Tomasic ¶ 34. This process may be assisted by intermediary agent 108, and intermediary agent 108 may include information extracted from forms or the input data. Tomasic ¶ 36.

Appellants assert that the aforementioned portions of Tomasic only discloses information corresponding to the recited “gathered input” being appended to a form by “filling it in,” but does not disclose anything that would correspond properly to the recited “identifier” also being appended to the form. We agree. The Examiner does cite paragraph 29 of Tomasic as disclosing an “identifier,” however, the Examiner has not articulated how this “identifier” is appended to the form of Tomasic. Indeed, we are unclear as to the relationship between that “identifier” of Tomasic and its form generation process. The Examiner also asserts that it would not be possible to identify sought after information if no identifier was present for that information. We agree. That assertion is misplaced, however, as just because an identifier is necessary to identify sought after information, it does not follow that the identifier itself would then need to be appended also to the form to which the sought after information is appended.

We do not sustain the obviousness rejection of independent claims 1, 10, and 16, or dependent claim 3.

Obviousness Rejection of Claims 4–7, 9, 12, 15, and 18–20

Claims 4–7, 9, 12, 15, and 18–20 all depend ultimately from one of independent claims 1, 10, and 16. The additional references cited to reject these claims are not cited to remedy the aforementioned deficiency regarding the rejections of independent claims 1, 10, and 16. Accordingly, for the same reasons we do not sustain the rejections of independent claims 1, 10, and 16, we also do not sustain the rejection of dependent claims 4–7, 9, 12, 15, and 18–20.

DECISION

The decision of the Examiner to reject claims 16 and 18–20 is AFFIRMED.

The decision of the Examiner to reject claims 1, 3–7, 9, 10, 12, and 15 is REVERSED.

AFFIRMED-IN-PART

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