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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BAHRAM G. KERMANI

Appeal 2013-000409
Application 12/277,778
Technology Center 2100

Before JOHN A. EVANS, HUNG H. BUI, and NORMAN H. BEAMER,
Administrative Patent Judges.

BUI, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant¹ seeks our review under 35 U.S.C. § 134(a) of the Examiner's final rejection of claims 1–22. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.²

STATEMENT OF THE CASE

¹ The Real Party in Interest is Alcatel-Lucent.

² Our decision refers to Appellant's Appeal Brief filed May 21, 2012 ("App. Br."); Reply Brief filed September 17, 2012 ("Reply Br."); Examiner's Answer mailed August 14, 2012 ("Ans."); Non-Final Office Action mailed February 29, 2012 ("Non-Final Act."); and original Specification filed November 25, 2008 ("Spec").

Appellant's Invention

Appellant's invention relates to methods and systems for abstracting an electronic document that allows a reader to choose between various levels of abstraction for the electronic document, thereby permitting that reader to read the electronic document according to his or her personal needs, preferences or time constraints. Spec. 2:16–20. According to Appellant, an electronic document can include, for example, an email, a word document, a book, an article, and encyclopedia and other document stored in electronic form. *Id.* at 4:15–17. “[A]n electronic document may [also] be abstracted by removing words, sentences, paragraphs, sections and the like, thereby shortening the electronic document and allowing economic uses of the electronic document.” *Id.* at 7:18–21. In particular, a user of the electronic document is prompted to select at least one abstracted version of the electronic document. A set of instructions is selected, and the selected abstracted version of the electronic document is created by executing the selected set of instructions. The abstracted version of the electronic document is then outputted in a predetermined format. *Id.* at 3:16–23 and Abstract.

Illustrative Claim

Claims 1, 12, and 22 are independent claims. Claim 1 is illustrative of Appellant's invention and is reproduced with disputed limitations emphasized below:

1. A method of abstracting an electronic document, comprising:
responsive to a subject matter of interest selection,
creating an abstracted version of the electronic document by executing one or more sets of generic instructions

corresponding to a level of abstraction associated with the electronic document;

storing a list of words specific to a selected generic set of instructions from the one or more generic sets of instructions associated with the level of abstraction;

examining each element of the electronic document and comparing the examined element to the stored list of words to thereby replace each examined element with a corresponding predetermined replacement; and

outputting the abstracted version of the electronic document in a predetermined format.

App. Br. 21–24, (emphasis added) (Claims Appendix).

Evidence Considered

Sotomayor	US 5,708,825	Jan. 13, 1998
Kudrolli et al.	US 6,279,018 B1	Aug. 21, 2001
Grefenstette	US 6,289,304 B1	Sept. 11, 2001

Examiner's Rejections

(1) Claims 1, 2, 7–13, and 17–22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sotomayor and Kudrolli. Non-Final Act. 3–23.

(2) Claims 3–6 and 14–16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sotomayor, Kudrolli, and Grefenstette. Non-Final Act. 23–27.

Issue on Appeal

Based on Appellant's arguments, the dispositive issue on appeal is whether the Examiner erred in rejecting claims 1, 2, 7–13, and 17–22 under 35 U.S.C. § 103(a) as being unpatentable over Sotomayor and Kudrolli. In particular, the appeal turns on whether the Examiner's combination of

Sotomayor and Kudrolli teaches or suggests “creating an abstracted version of the electronic document by executing one or more sets of generic instructions corresponding to a level of abstraction associated with the electronic document,” as recited in claim 1, and similarly recited in claims 12 and 22. App. Br. 7–17; Reply Br. 2–4.

ANALYSIS

With respect to claim 1, the Examiner finds Sotomayor discloses a method of abstracting an electronic document including the disputed limitations: (1) “creating an abstracted version of the electronic document by executing *one or more sets of generic instructions* corresponding to a level of abstraction associated with the electronic document” and (2) “storing a list of words specific to *a selected generic set of instructions from the one or more generic sets of instructions* associated with the level of abstraction.” Non-Final Act. 3–5(emphasis added)(citing Sotomayor 8:26–36, 11:19–55, 12:39–67, 13:5–41, 14:15–67, 15:50–67, and Figs. 7–8). The Examiner acknowledges Sotomayor does not teach replacing each examined element with a corresponding predetermined replacement, but relies on Kudrolli for disclosing the missing feature to support the conclusion of obviousness. *Id.* at 5–6 (citing Kudrolli 4, 9:40–45, 12, Abstract, Fig. 20 “an option for compulsorily replacing phrases with their commonly used acronyms in the text”).

Appellant contend: (1) the combination of Sotomayor and Kudrolli fails to teach or suggest “executing one or more sets of generic instructions corresponding to a level of abstraction associated with the electronic document,” (2) the Examiner’s construction of “one or more sets of generic

instructions” is incorrect, (3) the Examiner fails to account for “a selected generic set of instructions” from the one or more generic sets of instructions associated with the level of abstraction, and (4) the Examiner fails to provide a proper motivation for combining Sotomayor with Kudrolli. Ans. 7–17. In support of the claim construction, Appellant argues the Specification provides:

a clear context for persons skilled in the art to understand the term “one or more sets of generic instructions” as comprising instructions for removing grammatical articles, adjectives, adverbs, for contracting grammatical verb clauses and for abbreviating well known phrases, bodies, governments or entities.

App. Br. 10 (emphasis added). According to Appellant, this set of generic instructions is different from Sotomayor’s list of unused words, anchor insertion, phrase-index objects and the like. *Id.* at 10.

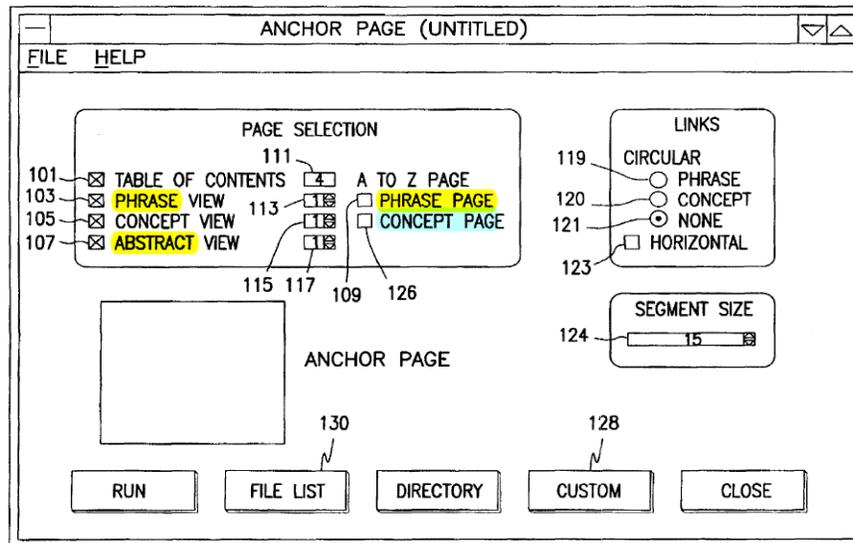
We do not find Appellant’s arguments persuasive. Rather, we find the Examiner has provided a comprehensive response, supported by a preponderance of evidence, to each of the contentions raised by Appellant. Ans. 4–21. As such, we adopt the Examiner’s findings and explanations provided therein. *Id.* For additional emphasis, we note claim terms are given their broadest reasonable interpretation consistent with the specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). The term “one or more sets of generic instructions” is not expressly defined by Appellant’s Specification; rather, such term is described in general as instructions for abstracting an electronic document. For example, Appellant’s Specification describes:

The generic set of instructions 30ca may be instructions for removing grammatical articles (e.g., a, an, the), removing grammatical adjectives (e.g., big, high, heavy), removing grammatical adverbs (e.g., always, very, shortly), contracting grammatical verb clauses (e.g., is not, are not, would not), abbreviating well known phrases, bodies, governments or entities (e.g., United States, Internal Revenue Service, New York), and other sets of instructions that may be executed to abstract electronic documents generally.

Spec. 6:12–18. According to Appellant, “an electronic document 30b may be abstracted by removing words, sentences, paragraphs, sections and the like, thereby shortening the electronic document and allowing economic uses of the electronic document.” *Id.* at 7:18–21 (emphasis added).

In the absence of an explicit definition from Appellant’s Specification, the Examiner has interpreted the term “one or more sets of generic instructions” as encompassing Sotomayor’s instructions to abstract an electronic document, as shown in Fig. 7, including “removing suffixes of words, comparing source document words against a special/regular lexicon dictionary, parsing a source document, generating an abstract, comparing words weights with a threshold, or any software or program routine or sub routine used to generate abstract or summary pages.” Ans. 7–8 (citing Sotomayor 8:26–36, 11:19–55, 12:39–67, 13:5–41, 14:15–67, 15:50–67, and Figs. 7–8).

Fig. 7 of Sotomayor is reproduced below with additional markings for illustration.



Sotomayor’s Fig. 7 shows a user interface screen to allow a user to abstract an electronic document, including automatically extracting key topics (concepts or phrases) from the document and creating summary pages containing various abstractions of information, including: (1) abstract, (2) concept, (3) phrase, and (4) table of contents.

Contrary to Appellant’s arguments, instructions to create each of these summary pages as shown in Sotomayor’s Fig. 7 require “removing words, sentences, paragraphs, sections and the like, thereby shortening the electronic document and allowing economic uses of the electronic document” as described by Appellant’s Spec. 7 (emphasis added). As such, we find the Examiner’s interpretation of the term “one or more sets of generic instructions” reasonable and consistent with Appellant’s Specification.

We also recognize that the Examiner must articulate some “reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007). However, the Examiner’s reasoning need not appear in, or be suggested by, one or more of the references on which the Examiner relies upon. Instead, a

reason to combine teachings from the prior art “may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved.” *WMS Gaming Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1355 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“Under the correct [obviousness] analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007). In the instant appeal, the Examiner has provided rationale supporting the combination, i.e., “for the purpose [of] abbreviating text in order to enable users to read reports or documents faster as disclosed by Kudrolli.” *See* Ans. 16 (citing Kudrolli 9:40–45). Appellant has not demonstrated the Examiner’s rationale is erroneous or why a person of ordinary skill in the art *would not* have reached the conclusions reached by the Examiner. *See DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006) (“[T]he proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.”) (emphasis added). Consequently, we are not persuaded that the Examiner failed to articulate a rationale for combining Sotomayor and Kudrolli. Nor has Appellant presented any evidence showing that combining the prior art was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418–19).

For the reasons set forth above, Appellant has not persuaded us of any error in the Examiner's rejection of independent claim 1, and similarly, independent claim 22. Accordingly, we sustain the Examiner's rejection of claims 1 and 22 as well as dependent claims 2–11, which Appellant does not argue separately.

With respect to claim 12, which is identically to claim 1, except for the use of “means-plus-function” limitations, Appellant argues the “means for” limitations of claim 12 requires the Examiner to consider the specific structures described in Appellant's Specification and such structures as disclosed by Appellant cannot be disregarded. App. Br. 17–18. However, Appellant has not explained what those structures are disclosed by Appellant's Specification. In fact, Appellant's Specification is devoid of any description of any structure because these functions are performed by software or instructions executed by a processor installed in either a computer 20 or a host server 40, as shown in Fig. 1. These instructions are also executed by a processor installed in a computer, shown in Figs. 2A–2B of Sotomayor. Accordingly, we sustain the Examiner's rejection of claim 12 and its dependent claims 13–21, which Appellant does not argue separately, for the same reasons discussed in connection with claim 1.

OTHER ISSUES

In the event of further prosecution of this application, this panel suggests that the Examiner consider the following rejections: (1) claims 1–22 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, i.e., an abstract idea in light of the two-steps framework set out in the Supreme Court decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S.Ct.

2347 (2014); (2) claims 12–21 under 35 U.S.C. § 112, 6th paragraph, as being indefinite in light of the Federal Circuit *en banc* decision in *Williamson v. Citrix Online, LLC*, 2013-1130, 2015 WL 3687459 at *8 (Fed. Cir. June 16, 2015) (holding the term “[m]odule’ is a well-known nonce word that can operate as a substitute for ‘means’ in the context of § 112, para. 6,” and in the absence of a corresponding structure disclosed in the specification, is considered indefinite under the 2nd paragraph of 35 U.S.C. § 112); and claim 22 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, i.e., carrier waves (*see* ¶ 68 of Appellant’s Specification) in light of the Board precedential decision in *Ex parte Mewherter*, 107 USPQ2d 1857 (PTAB 2013) (precedential) (expanded panel).

CONCLUSION

On the record before us, we conclude that the Examiner has not erred in rejecting claims 1–22 under 35 U.S.C. § 103(a).

DECISION

As such, we AFFIRM the Examiner’s final rejection of claims 1–22. 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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